

# Deacons Bitesize IP

## Intellectual Property

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### The word on the street: the risk of using slang in advertising

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#### Did you know?

In today's fast-paced digital world, pop culture slang terms and invented words can spread quickly through social media and email. It is not uncommon for brands wanting to create connections and grab the attention of consumers, especially a younger audience, to use popular slang to advertise their businesses or events. However, many may not realise that some slang terms could be registered as trade marks, so that the use of such slang in an advertising campaign may give rise to a potential trade mark infringement risk. For example, the term “見字飲水” (“see this drink water”) has been trending in Hong Kong during the pandemic, when people reminded one another to stay hydrated and take care of their health. However, the term has actually been registered as a trade mark since 2020.

#### Why does this matter to you?

Trade mark law, which originally protected words and logos, has expanded to include slogans and phrases and we note that there is an increasing trend to register trendy slang or catch-phrases as trade marks. The trade mark registrations may be used to prevent third parties from using the terms in their advertisements.

However, it is important to examine the facts and the trade mark registrations carefully. A trade mark registration covers a specified list of goods and services. Generally, trade mark infringement in Hong Kong requires the unauthorised use of an identical or similar mark, in relation to identical or similar goods or services covered in the trade mark registration. Even, if the marks are identical, there will not be infringement unless the goods and services are the same or similar.

Popular slang terms are often registered in Class 35 for “advertising, marketing and publicity services” because the applicants consider that the terms are being used on promotional or advertising materials. There is a general misconception that if the mark is registered for “advertising services”, then the trade mark owner has a monopoly over using the mark on any type of advertisements or marketing activities, even though the mark is in fact used to promote other goods and services.

“Advertising or publicity services” in Class 35 actually relate to the provision of services and assistance to third parties to promote or launch their goods or services. It is usually the advertising agencies or PR companies that engage in the provision of such advertising or publicity services and not the trade mark owner themselves and a registration in class 35 will not prevent another trader from using the slang term to advertise its products, nor from using the term on its products. However, it will be different if there are specific registrations for the relevant products and many registrants will apply in multiple classes.

The use of innovative and trendy phrases in advertisements can be tempting but, given the current enthusiasm for registering popular slang as trade marks, advertisers or traders seeking to use a particular phrase in their advertising campaigns, should carry out a trade mark search and conduct a formal risk assessment prior to the promotion, to avoid any infringement claim which may prevent or delay the launch of the products or event.

In addition, anyone seeking to register a cool new slang term in Hong Kong should take a closer look at the specification and make sure that it actually covers its business and not just advertising services. They should also be aware that slang terms are not always registrable as trade marks, especially if they are very descriptive, lack distinctiveness, or will not be perceived as an indication of the source of the goods or services.

## Want to know more?

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