

LEGISLATIVE COUNCIL BRIEF

TRADE MARKS BILL

INTRODUCTION

At the meeting of the Executive Council on 13 April 1999, the Council ADVISED and the Chief Executive ORDERED that the Trade Marks Bill, at the Annex, should be introduced into the Legislative Council, to provide a new regulatory framework to modernise and streamline the registration and protection of trade marks.

BACKGROUND AND ARGUMENT

The Existing Legislation

2. Hong Kong has had an independent trade mark registration system since 1873. The Trade Marks Ordinance sets out the criteria and procedures for the registration and maintenance of trade marks. There are currently more than 100,000 registered trade marks on the Hong Kong Trade Marks Register. However, most provisions under the Trade Marks Ordinance have remained largely unchanged since 1955. With the evolvement of international practice in the protection of intellectual property rights over this period, we need to modernise Hong Kong's trade marks laws. The main aims are to reduce red-tape, enable easier registration of marks, increase the range of signs that can be registered as trademarks, and provide a higher standard of protection, taking into account prevailing international developments.

THE BILL

3. The Trade Marks Bill at the Annex seeks to achieve the aims set out in paragraph 2 above. Its main provisions are summarised in paragraphs 4 to 16 below.

Registrable trade marks (Clause 3)

4. The definition of a trade mark is broadened. The new definition permits the registration of a wider range of signs as a trade mark. However, to prevent the trade marks system from being used to obtain an automatic and indefinite extension of the monopoly conferred by patent, design or copyright law, certain shapes which might be protected by other intellectual property laws will remain unregistrable. This is in line with prevailing international norms.

Relative grounds for refusal of registration (Clause 11)

5. At present a trade mark application may be refused on the basis of a prior existing registration for the same class of goods or services. In order to avoid unfair exploitation of the distinctive character of a previously registered trade mark, we propose that the owner of a previously registered trade mark may oppose the registration of a similar mark for goods or services even for a different class of goods or services.

Infringement of registered trade marks (Clauses 17, 21, 23 and 24)

6. The Bill will enhance the protection offered to registered trade marks proprietors in a number of ways. The definition of infringement will be broadened. There are also express provisions in the Bill to enable registered proprietors to apply for orders for delivery up and disposal of infringing goods, materials and articles. This will bring the remedies available to a trade mark proprietor more in line with those available for copyright, patent and registered design infringement.

7. To prevent the abuse of civil infringement proceedings by trade marks proprietors who have little ground for instigating the proceedings, there will be a remedy available to persons aggrieved by groundless threats of proceedings. This will bring our civil remedy procedures more in line with other intellectual property rights such as patents and designs.

Parallel importation of trade mark products (Clause 19)

8. We accept that any restriction of parallel importation for trade mark products should not reduce their availability to the general public or be used to impose differential pricing prejudicial to Hong Kong consumers. Given that Hong Kong is not subject to any international rights or obligations in respect of parallel importation, we propose that a trade mark proprietor would have no right to prevent parallel importation of goods bearing his mark, unless he can show that the goods have been impaired (e.g. they have deteriorated through age or have been tampered with) and the reputation of his mark is thereby adversely affected.

Assignments and the licensing of trade marks (Clauses 25-27)

9. The procedures for assignment and the licensing of registered trade marks will be simplified. The Bill contains provisions encouraging the registration of such assignments and licences with the Registrar of Trade Marks in the interest of transparency, but removes the requirement to submit detailed and possibly commercially sensitive information to the Registrar.

Convention priority (Clause 39)

10. Under the existing Trade Marks Ordinance, Hong Kong already accords priority to an applicant who has previously filed an application for registration of a trade mark in Mainland China, a Paris Convention country or a member of the World Trade Organisation. Priority will continue to be granted to such applications.

Duration of protection for a registered trade mark (Clauses 45-48)

11. A trade mark will be registered in Hong Kong for a period of 10 years from the date of registration. Registration may be renewed, on application from the proprietor, for periods of 10 years each upon the payment of a prescribed renewal fee. This standard has been widely adopted in other jurisdictions.

Collective and certification trade marks (Clauses 59 and 60, Schedules 1 and 2)

12. We propose to provide for the registration of collective trade marks. A collective mark indicates who is entitled to use the mark as opposed to indicating standards met by goods or services in which the mark is used (e.g. an association of vegetarian restaurants may allow its members to display a collective mark to show that they belong to the association).

The Bill will also continue to allow the registration of certification trade marks, which may be used to register and protect geographical indications or other marks denoting quality or origin of goods (e.g. the Woolmark). Schedules 1 and 2 to the Bill respectively set out the necessary definitions and criteria for the application and protection of collective and certification trade marks in Hong Kong.

Protection of well-known marks (Clause 61)

13. Proprietors of well-known marks will be entitled to restrain by injunction the use in Hong Kong of identical or similar marks where the use is likely to cause confusion. This right applies whether or not the owner of the mark carries on any business or has any goodwill in Hong Kong.

Multi-class Applications (Clause 90)

14. The existing law requires a separate application for each registration of a trade mark in respect of each class of goods or services to be provided under the mark. The Bill will enable the filing of multi-class applications for registration of a trade mark in several classes of goods or services in the same application. This will greatly enhance the convenience of our system to business in Hong Kong and overseas.

Transitional arrangements (Clause 96 and Schedule 3)

15. To ensure continuity in the protection of trade marks, existing registered marks will continue to be protected on the commencement of the new law. As for pending applications, the applicant will have the option of requesting the registrability of the mark to be determined under the new law.

Consequential and Related Amendments (Clause 97 and Schedule 4)

16. The Bill amends various ordinances to correct the cross-references to the existing Trade Marks Ordinance and to reflect the different terms used in the Bill. It also amends the Trade Descriptions Ordinance to create a new offence of making infringing trade mark goods outside Hong Kong for the purpose of exporting them to Hong Kong. In addition, the penalty for forging or using a false trade mark for trade or business is increased from five years to eight years. These amendments will bring the Trade Descriptions Ordinance into line with similar provisions in the Copyright Ordinance.

SUBSIDIARY LEGISLATION

17. After the Bill has been passed into law, the Director of Intellectual Property will make the Trade Marks Rules, which will set out the technical and procedural matters on the registration and maintenance of trade marks. Members may wish to note that the level of fees to be charged for the registration and related matters on trade marks will be determined nearer to the enactment of the Bill, after full consultation with trade mark and legal practitioners, and taking into account the costs of providing the services, and the prevailing economic and business environment.

LEGISLATIVE TIMETABLE

18. The legislative timetable will be –

Publication in the Gazette	16 April 1999
First Reading and commencement of Second Reading debate	5 May 1999
Resumption of Second Reading debate, committee stage and Third Reading	to be notified

BASIC LAW IMPLICATIONS

19. There are no Basic Law implications.

HUMAN RIGHTS IMPLICATIONS

20. The Department of Justice advises that the Bill is consistent with the human rights provisions of the Basic Law.

BINDING EFFECT OF THE LEGISLATION

21. On grounds of equity and the need to maintain a level playing field, the rights provided for in the Bill are to be enforceable against any public body (whether or not it is a body within the meaning of section 3 of the Interpretation and General Clauses Ordinance), public authority, private body or organ in like manner as against any individual or other person.

FINANCIAL AND STAFFING IMPLICATIONS

22. We expect that the number of trade mark registration applications will increase after the enactment of the new Trade Marks law, mainly due to the streamlined procedures. Additional resources have been provided to the Intellectual Property Department (IPD) to recruit 12 additional posts at an annual cost of \$4.7 million. IPD intends to fill these posts on non-civil service contract terms. A new trade marks computer system estimated at a cost of \$41.5 million will also be required to complement the commencement of the new Trade Marks law. IPD is now considering the option of out-sourcing part of its computer-related services to achieve greater cost-efficiency. In line with the Government's policy on fee charging, we intend to continue with a set of trade marks fees which will recover the full cost of providing the services for the registration and maintenance of trade marks (paragraph 17 above).

ECONOMIC IMPLICATIONS

23. The Bill, when enacted, will streamline the procedures for the registration and maintenance of trade marks. It will also be easier for trade mark proprietors to register and protect their marks. An effective and user-friendly regime for the protection of intellectual property rights is conducive to the long-term economic growth of Hong Kong.

PUBLIC CONSULTATION

24. The public, the relevant legal and professional organisations and trade associations were consulted on the draft Bill on two occasions in 1997 and 1998. The Legislative Council Panel on Trade and Industry was also consulted in December 1998. Their comments have been taken into account in the present Bill.

PUBLICITY

25. A press release and a Legislative Council brief will be issued on 14 April. A spokesman will be available to handle enquiries.

ENQUIRIES

26. Any enquiries on this brief should be directed to Mr WU Kam-yin, Principal Assistant Secretary for Trade and Industry at 2918 7480 or by facsimile at 2869 4420.

Trade and Industry Bureau

File Ref. : TIBCR 06/18/12

TRADE MARKS BILL

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A BILL

To

Amend and consolidate the law relating to the registration of trade marks and to provide for connected matters.

Enacted by the Legislative Council.

PART I

PRELIMINARY

1. Short title and commencement

(1) This Ordinance may be cited as the Trade Marks Ordinance.

(2) This Ordinance shall come into operation on a day to be appointed by the Secretary for Trade and Industry by notice in the Gazette.

2. Interpretation

(1) In this Ordinance, unless the context otherwise requires - “certification mark” (說明商標) has the meaning assigned by section 60(1)

(certification marks);

“collective mark” (集體商標) has the meaning assigned by section 59(1)

(collective marks);

“corporation” (法團) means any company or other body corporate, incorporated or formed either in Hong Kong or elsewhere;

“court” (法院) means the Court of First Instance;

“defensive trade mark” (防禦商標) means a trade mark registered as a defensive trade mark under section 58 (defensive trade marks);

“infringement proceedings” (反侵犯法律程序), in relation to a registered trade mark, includes proceedings under section 21 (order for delivery up) and section 23 (order for disposal);

“limitation” (限制) means any limitation of the exclusive right to the use of a trade mark given by the registration of a person as owner of the trade mark;

“official journal” (官方公報) means the publication for the time being specified under section 71(1) (power to specify official journal, etc.) as the official journal of record;

“owner” (擁有人), in relation to a registered trade mark, means the person whose name is for the time being entered in the register as the owner of the trade mark or, if there are 2 or more such persons, each of those persons;

“Paris Convention” (《巴黎公約》) means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883, as revised or amended from time to time;

“Paris Convention country” (《巴黎公約國》) means any country, territory or area designated by regulation made under section 91 (regulations) as a country, territory or area which has acceded to the Paris Convention;

“prescribed” (訂明) means prescribed or provided for by the rules;

“registered trade mark” (註冊商標) means a trade mark registered under section 45 (registration);

“Registrar” (處長) means the Registrar of Trade Marks;

“Registrar of Trade Marks” (商標註冊處處長) means the person holding that office by virtue of the Director of Intellectual Property (Establishment) Ordinance (Cap. 412);

“Registry” (註冊處) means the Trade Marks Registry in the Intellectual Property Department administered by the Registrar;

“rules” (《規則》) means rules made by the Registrar under section 90 (rules);

“trade” (行業) includes a profession;

“World Trade Organization Agreement” (《世貿協議》) means the agreement of that name done at Marrakesh in 1994, as revised or amended from time to time;

“WTO member” (世貿成員) means any country, territory or area designated by regulation made under section 91 (regulations) as a country, territory or area which has acceded to the World Trade Organization Agreement.

(2) For the purposes of this Ordinance, a sign or trade mark is taken to be applied to goods, material or any other thing if it is woven in, impressed on, worked into, affixed or annexed to, or in any manner marked on or incorporated with, the goods, material or thing.

(3) The expressions listed in the left-hand column below are defined in, or fall to be construed in accordance with, the provisions of this Ordinance listed in the right-hand column in relation to those expressions.

Expression	Relevant Provision
Convention application (公約申請)	section 39(9)
date of application for registration (註冊申請日期)	section 37(2)
date of registration (註冊日期)	section 46
earlier right (在先權利)	section 11(5)
earlier trade mark (在先商標)	section 5
exclusive licence (專用特許)	section 30
exclusive licensee (專用特許持有人)	section 30
filing date (提交日期)	section 37(1)
infringement (侵犯)	section 15

infringing articles (侵犯性物品)	section 16(4)
infringing goods (侵犯性貨品)	section 16(2)
infringing material (侵犯性物料)	section 16(3)
licence (特許)	section 30
licensee (特許持有人)	section 30
owner of an earlier right (在先權利的擁有人)	section 11(5)
owner of a well-known trade mark (馳名商標的擁有人)	section 4(2)
the register (註冊紀錄冊)	section 8(1)
registrable transaction (可註冊交易)	section 27(2)
registration (註冊)	section 8(2)
series of trade marks (一系列的商標)	section 49(3)
trade mark (商標)	section 3
use of sign (使用標誌)	section 17(5)
use of trade mark or sign (使用商品或標誌)	section 6
use (likely to cause confusion) (使用(相當可能會產生混淆))	section 7
well-known trade mark (馳名商標)	section 4(1)
WTO application (世貿申請)	section 39(9)

3. Meaning of “trade mark”

(1) In this Ordinance, a “trade mark” (商標) means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.

(2) Without affecting the generality of subsection (1), a trade mark may consist of words (including personal names), indications, designs, letters, numerals, figurative elements, the shape of goods

or their packaging, a combination of colours and any combination of such signs.

(3) A sign may constitute a trade mark even though it is used in relation to a service ancillary to the trade or business of an undertaking and whether or not the service is provided for money or money's worth.

(4) Unless the context otherwise requires, references in this Ordinance to a trade mark shall be construed as including references to a certification mark, collective mark and defensive trade mark.

4. Meaning of “well-known trade mark”

(1) References in this Ordinance to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as references to a trade mark which is well-known in Hong Kong and which is the trade mark of a person who -

- (a) is a national of, or is domiciled or ordinarily resident in, a Paris Convention country or WTO member;
- (b) has a right of abode in Hong Kong; or
- (c) has a real and effective industrial or commercial establishment in a Paris Convention country, a WTO member or Hong Kong,

whether or not that person carries on business in Hong Kong or owns any goodwill in a business in Hong Kong.

(2) References in this Ordinance to the owner of a well-known trade mark shall be construed in accordance with subsection (1).

5. Meaning of “earlier trade mark”

(1) In this Ordinance, “earlier trade mark” (在先商標), in relation to another trade mark, means -

- (a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any; or
- (b) a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Ordinance to an earlier trade mark shall be construed as including a trade mark in respect of which an application for registration has been made under this Ordinance and which, if registered, would constitute an earlier trade mark under or by virtue of subsection (1)(a), subject to its being so registered.

(3) A trade mark which is an earlier trade mark under or by virtue of subsection (1)(a) shall continue to be taken into account in determining the registrability of a later trade mark for a period of 1 year after the date on which its registration expires unless the Registrar is satisfied the trade mark has not been used in good faith in Hong Kong during the 2 years immediately preceding that date.

6. References to use of trade mark or sign

References in this Ordinance to use (or to any particular description of use) of a trade mark or sign shall be construed as including any use (or any such description of use), whether by means of a graphic representation or otherwise.

7. References to use likely to cause confusion

(1) For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

(2) For greater certainty, in determining for the purposes of this Ordinance whether the use of a sign is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with a registered trade mark.

8. Meaning of “the register” and “registration”

(1) In this Ordinance, “the register” (註冊紀錄冊) means the register of trade marks kept under section 65 (register to be kept).

(2) Unless the context otherwise requires, references in this Ordinance to registration (in particular, in the expression “registered trade mark”) shall be construed as references to registration in the register.

PART II

REGISTERED TRADE MARKS

Introductory

9. Registered trade mark a property right

(1) A registered trade mark is a property right obtained by the registration of the trade mark under this Ordinance.

(2) The owner of a registered trade mark has the rights and is entitled to the remedies provided by this Ordinance.

(3) The rights provided by this Ordinance are enforceable against any public body (whether or not it is a public body within the meaning of section 3 of the Interpretation and General Clauses Ordinance (Cap. 1)), public authority, private body or organ in like manner as against any individual or other person; and references in this Ordinance to a person who infringes a registered trade mark shall be construed accordingly.

(4) No proceedings lie to prevent, or to recover damages for, the infringement of an unregistered trade mark but nothing in this Ordinance affects the law relating to passing off.

Grounds for refusal of registration

10. Absolute grounds for refusal of registration

- (1) Subject to subsection (2), the following shall not be registered -
- (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
 - (b) trade marks which are devoid of any distinctive character;
 - (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind,

quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; and

- (d) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark in relation to goods if it consists exclusively of -

- (a) the shape that results from the nature of the goods themselves;
- (b) the shape of goods that is necessary to obtain a technical result; or
- (c) the shape that gives substantial value to the goods.

(4) A trade mark shall not be registered if it is -

- (a) contrary to accepted principles of morality; or
- (b) likely to deceive the public.

(5) A trade mark shall not be registered if, or to the extent that -

- (a) its use is prohibited in Hong Kong under or by virtue of any law; or
- (b) the application for registration of the trade mark is made in bad faith.

(6) A trade mark shall not be registered if, or to the extent that, it consists of or contains -

- (a) the national flag or its design;
- (b) the national emblem or its design;
- (c) the regional flag or its design; or
- (d) the regional emblem or its design.

(7) A trade mark shall not be registered in the cases specified in section 62 (national emblems, etc.) and section 63 (emblems, etc., of certain international organizations).

(8) Where the grounds for the refusal of registration exist in respect of only some of the goods or services for which the application for registration is made, the refusal shall apply to those goods or services only.

(9) For the purposes of subsection (6) -
“national flag” (國旗) and “national emblem” (國徽) have the same meaning as in the National Flag and National Emblem Ordinance (116 of 1997);
“regional flag” (區旗) and “regional emblem” (區徽) have the same meaning as in the Regional Flag and Regional Emblem Ordinance (117 of 1997).

11. Relative grounds for refusal of registration

- (1) A trade mark shall not be registered if -
- (a) the trade mark is identical to an earlier trade mark; and
 - (b) the goods or services for which the application for registration is made are identical to those for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if -
- (a) the trade mark is identical to an earlier trade mark;
 - (b) the goods or services for which the application for registration is made are similar to those for which the earlier trade mark is protected; and

(c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.

(3) A trade mark shall not be registered if -

(a) the trade mark is similar to an earlier trade mark;

(b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and

(c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.

(4) Subject to subsection (6), a trade mark which is -

(a) identical or similar to an earlier trade mark; and

(b) proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Hong Kong and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

(5) Subject to subsection (6), a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented -

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off); or

(b) by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (4) (in

particular, by virtue of the law of copyright or registered designs), and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an “earlier right” in relation to the trade mark.

(6) A trade mark may be refused registration on any one or more of the grounds mentioned in subsections (4) and (5) only if an objection on those grounds is raised in proceedings in opposition to the registration under section 42 (opposition proceedings) by the owner of the earlier trade mark or other earlier right.

(7) Where the grounds for the refusal of registration exist in respect of only some of the goods or services for which the application for registration is made, the refusal shall apply to those goods or services only.

(8) Nothing in this section prevents the registration of a trade mark where the owner of the earlier trade mark or other earlier right consents to the registration unless the Registrar is satisfied that the use of the trade mark, in relation to the goods or services in respect of which it is proposed to be registered, is likely to cause confusion on the part of the public.

12. Honest concurrent use, etc.

(1) Nothing in section 11 (relative grounds for refusal of registration) prevents the registration of a trade mark where the Registrar or the court is satisfied -

- (a) that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right; or

(b) that by reason of other circumstances it is proper for the trade mark to be registered.

(2) The registration of a trade mark under or by virtue of subsection (1) shall be subject to such limitations and conditions as the Registrar or the court thinks fit to impose.

(3) Nothing in this section prevents the Registrar from refusing to register a trade mark on any of the grounds mentioned in section 10 (absolute grounds for refusal of registration).

Effects of registered trade mark

13. Rights conferred by registered trade mark

(1) The owner of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in Hong Kong without his consent.

(2) The acts constituting infringement of a registered trade mark, if done without the consent of the owner, are specified in section 17 (infringement of registered trade mark) but are subject to the exceptions specified in section 18 (exceptions to infringement) and section 19 (exhaustion of rights conferred by registered trade mark).

(3) The rights of the owner of a registered trade mark have effect from the date of registration of the trade mark.

14. Disclaimers, limitations and conditions

(1) An applicant for registration of a trade mark, or the owner of a registered trade mark, may -

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation or condition.

(2) Where the registration of a trade mark is subject to a disclaimer, limitation or condition, the rights in the registered trade mark conferred by this Ordinance are restricted accordingly.

(3) Provision may be made by the rules as to the publication in the official journal and entry in the register of particulars of a disclaimer, limitation or condition.

PART III

INFRINGEMENT OF REGISTERED TRADE MARKS

Preliminary

15. References to infringement

References in this Ordinance to the infringement of a registered trade mark shall be construed as references to any infringement of the rights of the owner.

16. References to infringing goods, material or articles

(1) References in this Ordinance to infringing goods, infringing material or infringing articles shall be construed in accordance with this section.

(2) Goods are infringing goods, in relation to a registered trade mark, if the goods or their packaging bear a sign identical or similar to the registered trade mark and -

- (a) the application of the sign to the goods or their packaging constituted an infringement of the registered trade mark at the time the sign was applied;
- (b) the goods are proposed to be imported into Hong Kong and the application of the sign in Hong Kong to the goods or their packaging would constitute an infringement of the registered trade mark; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(3) Material is infringing material, in relation to a registered trade mark, if the material bears a sign identical or similar to the registered trade mark and either -

- (a) the material is used -
 - (i) for labelling goods;
 - (ii) for packaging goods;
 - (iii) as a business paper; or
 - (iv) for advertising goods or services,in such a way as to infringe the registered trade mark; or
- (b) the material is intended to be so used and such use would constitute an infringement of the registered trade mark.

(4) Articles are infringing articles, in relation to a registered trade mark, if -

- (a) the articles are specifically designed or adapted for making copies of a sign identical or similar to the registered trade mark; and
- (b) the articles are in the possession, custody or control of a person who knows or has reason to believe that they

have been or are to be used to produce infringing goods or material.

(5) Nothing in subsection (2) shall be construed as affecting the importation of goods which may be lawfully imported into Hong Kong by virtue of any law of Hong Kong.

Infringing acts

17. Infringement of registered trade mark

(1) A person infringes a registered trade mark if he uses in the course of trade or business a sign which is identical to the trade mark in relation to goods or services which are identical to those for which it is registered.

(2) A person infringes a registered trade mark if -

- (a) he uses in the course of trade or business a sign which is identical to the trade mark in relation to goods or services which are similar to those for which it is registered; and
- (b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

(3) A person infringes a registered trade mark if -

- (a) he uses in the course of trade or business a sign which is similar to the trade mark in relation to goods or services which are identical or similar to those for which it is registered; and
- (b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

(4) A person infringes a registered trade mark if -

- (a) he uses in the course of trade or business a sign which is identical or similar to the trade mark in relation to goods or services which are not identical or similar to those for which the trade mark is registered;
- (b) the trade mark has a reputation in Hong Kong; and
- (c) the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(5) For the purposes of this section a person uses a sign if, in particular, he -

- (a) applies it to goods or their packaging;
- (b) offers or exposes goods for sale under the sign;
- (c) puts goods on the market under the sign;
- (d) stocks goods under the sign for the purpose of offering or exposing them for sale or of putting them on the market;
- (e) offers or supplies services under the sign;
- (f) imports or exports goods under the sign; or
- (g) uses the sign on business papers or in advertising.

(6) Notwithstanding subsection (5), a person who applies or causes to be applied a registered trade mark, or a sign similar to a registered trade mark, to material which is intended to be used -

- (a) for labelling or packaging goods;
- (b) as a business paper; or
- (c) for advertising goods or services,

shall be treated as a party to any use of the material which infringes the registered trade mark if, at the time the trade mark or sign was applied to the material, he knew or had reason to believe that its

application to the material was not authorized by the owner of the registered trade mark or by a licensee.

(7) Nothing in subsections (1) to (6) shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the owner of the registered trade mark or a licensee, but any such use which is otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

18. Exceptions to infringement

(1) This section applies notwithstanding section 17 (infringement of registered trade mark).

(2) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered (but see section 51(9) for the effect of a declaration of invalidity of registration).

(3) A registered trade mark is not infringed by -

- (a) the use by a person of his own name or address;
- (b) the use of signs which serve to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service (for example, as accessories or spare parts),

provided the use is in accordance with honest practices in industrial or commercial matters.

(4) A registered trade mark is not infringed by the use by any person in the course of trade or business in Hong Kong of an unregistered trade mark or other sign in relation to goods or services if the unregistered trade mark or other sign has been so used in Hong Kong by that person or a predecessor in title continuously from a date preceding the earlier of -

- (a) the date of first use in Hong Kong of the trade mark which is registered;
and
- (b) the date of registration in Hong Kong of that trade mark.

19. Exhaustion of rights conferred by registered trade mark

(1) Notwithstanding section 17 (infringement of registered trade mark), a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market anywhere in the world under that trade mark by the owner or with his consent (whether express or implied or conditional or unconditional).

(2) Subsection (1) does not apply where the condition of the goods has been changed or impaired after they have been put on the market, and the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the trade mark.

Infringement proceedings

20. Action for infringement

(1) An infringement of a registered trade mark is actionable by the owner of the trade mark.

(2) Notwithstanding section 46 (date of registration), no infringement proceedings may be begun before the date on which the trade mark is in fact entered in the register.

(3) In infringement proceedings all such relief by way of damages, injunctions, accounts or otherwise shall be available to the owner of a registered trade mark as is available in respect of the infringement of any other property right.

21. Order for delivery up

(1) The owner of a registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a trade or business.

(2) No application may be made under subsection (1) after the end of the period referred to in section 22 (limitation on order for delivery up).

(3) Where the court makes an order under subsection (1), it shall also make an order under section 23 (order for disposal) unless it determines that there are grounds for not making such an order.

(4) A person to whom any infringing goods, material or articles are delivered up pursuant to an order made under subsection (1) shall, if an order under section 23 is not made at the time of the making of the order under subsection (1), retain them pending the making of an order under section 23 or the decision of the court not to make such an order.

(5) Nothing in this section affects any other power of the court.

22. Limitation on order for delivery up

(1) Except as mentioned in subsection (2), an application for an order under section 21 (order for delivery up) may not be made after the end of the period of 6 years beginning on -

- (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
- (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
- (c) in the case of infringing articles, the date on which they were made.

(2) If during the whole or part of the period referred to subsection (1) the owner of the registered trade mark -

- (a) is under a disability; or
- (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of 6 years beginning on the date on which he ceased to be under a disability or could with reasonable diligence have discovered those facts, as the case may be.

(3) In subsection (2), “disability” (無行為能力) has the same meaning as in section 22(3) of the Limitation Ordinance (Cap. 347).

23. Order for disposal

(1) Where infringing goods, material or articles have been delivered up pursuant to an order made under section 21 (order for delivery up), an application may be made to the court -

- (a) for an order that they be forfeited to such person as the court may think fit;
- (b) for an order that they be destroyed;

- (c) for an order that they be disposed of outside the channels of commerce in such a manner as the court may think fit so as to avoid any harm being caused to the owner of the registered trade mark;
- (d) for an order that they be otherwise dealt with as the court may think fit;
or
- (e) for a decision that no such order should be made.

(2) Where there is more than one person interested in the goods, material or articles, the court may make such order under subsection (1) as it thinks just, and it may, in particular, direct that the goods, material or articles be disposed of and the proceeds be divided among them as the court directs.

(3) In considering what order, if any, should be made under subsection (1), the court shall -

- (a) take into account the need for proportionality between the seriousness of the infringement and the remedies ordered;
- (b) take into account the interests of third parties; and
- (c) consider whether other remedies available in proceedings in respect of the infringement of the registered trade mark would be adequate to compensate the owner of the registered trade mark and any licensee and to protect their interests.

(4) The court shall not make an order under subsection (1) permitting the removal of a registered trade mark from any goods, material or articles to which it has been unlawfully applied unless the owner of the registered trade mark consents to the order or, in the absence of such consent, unless the court is satisfied -

- (a) that the goods, material or articles will not enter the channels of commerce once the registered trade mark has been removed from the goods, material or articles; or
- (b) having regard to the circumstances of the case, that there exist exceptional reasons to justify the removal of the registered trade mark from the goods, material or articles without the court being satisfied, or wholly satisfied, as to the matter mentioned in paragraph (a).

(5) Provision may be made by rules of court made by the Chief Justice for the purposes of this section as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled -

- (a) to appear in proceedings for an order under this section, whether or not he was served with notice; and
- (b) to appeal to the Court of Appeal against any order made under subsection (1)(a), (b), (c) or (d), whether or not he appeared.

(6) An order made under subsection (1)(a), (b), (c) or (d) shall not take effect until the end of the period within which notice of an appeal may, as provided by those rules of court, be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(7) If the court decides that no order should be made under subsection (1)(a), (b), (c) or (d), the person who had possession, custody or control of the goods, material or articles before they were delivered up pursuant to the order made under section 21 (order for delivery up) is entitled to their return.

(8) References in this section to a person having an interest in goods, material or articles include any person in whose favour an

order could be made under this section or under section 54 of the Registered Designs Ordinance (Cap. 522) or section 111 or 231 of the Copyright Ordinance (Cap. 528) (which make similar provision in relation to infringement of registered designs, copyright and rights in performances).

24. Proceedings for relief from groundless threats of infringement proceedings

(1) Where a person threatens to bring an action against another person (the “threatened person”) for infringement of a registered trade mark in respect of any use other than -

- (a) the application of the trade mark to goods or their packaging; or
- (b) the supply of services under the trade mark, any person aggrieved by the threat (the “plaintiff”) may bring proceedings before the court for relief under this section.

(2) The relief which may be applied for is any one or more of the following -

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as have been sustained by the plaintiff by reason of the threats.

(3) The plaintiff is entitled to the relief claimed under subsection (2) unless the defendant shows that the acts in respect of which the action was threatened constitute or, if done, would constitute, an infringement of the registered trade mark concerned.

(4) If the defendant shows that the acts in respect of which the action was threatened constitute or, if done, would constitute, an

infringement of a registered trade mark, the plaintiff is nevertheless entitled to the relief claimed if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat to bring an action for infringement for the purposes of this section.

(6) Proceedings for relief under this section may not be brought, or (if brought) may not proceed, if -

- (a) the registered owner of the trade mark; or
- (b) a licensee having power to bring proceedings for infringement of the trade mark,

begins an action for infringement of the trade mark against the threatened person within 28 days after the threat was first made to him and pursues that action with due diligence.

PART IV

REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY

25. Nature of registered trade mark

(1) A registered trade mark is personal property.

(2) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal property; and it is so transmissible either in connection with the goodwill of a business or independently.

(3) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply -

- (a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or in a particular locality.

(4) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is made in writing and is signed by or on behalf of the assignor or his personal representative.

(5) The requirement in subsection (4) may be satisfied in a case where the assignor or personal representative is a corporation by the affixing of the seal of the corporation.

(6) This section applies to an assignment by way of security as in relation to any other assignment.

(7) A registered trade mark may be the subject of a charge in the same way as other personal property.

(8) Nothing in this Ordinance shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

26. Co-ownership of registered trade mark

(1) Where a trade mark is registered in the name of 2 or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) Subsections (3) to (6) apply where 2 or more persons are co-owners of a registered trade mark, whether by virtue of subsection (1) or otherwise.

(3) Subject to subsection (4) and to any agreement to the contrary, each co-owner is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account

to any other co-owner, any act which would otherwise constitute an infringement of the registered trade mark.

(4) One co-owner may not without the consent of each other co-owner -

- (a) grant a licence to use the registered trade mark; or
- (b) assign or charge his share in the registered trade mark.

(5) Infringement proceedings may be brought under Part III (infringement of registered trade marks) by any co-owner, but one co-owner may not, without the leave of the court, proceed with the action unless each other co-owner is either joined as a plaintiff or added as a defendant.

(6) A co-owner who is added as a defendant as mentioned in subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in this section affects the granting of interlocutory relief on the application of one co-owner alone.

(8) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

27. Registration of transactions affecting registered trade mark

(1) On application being made to the Registrar by -

- (a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or
- (b) any other person claiming to be affected by a registrable transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions -

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant of a licence under a registered trade mark;
- (c) the granting of any security interest, whether fixed or floating, over a registered trade mark or any right in or under it;
- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and
- (e) an order of a court, or any authority recognized by the Registrar as a competent authority, transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction -

- (a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction; and
- (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 33 (rights of licensees generally), section 34 (rights of certain exclusive licensees) or section 35 (rights of sub-licensees under certain exclusive licences).

(4) Where a person becomes the owner or a licensee of a registered trade mark by virtue of a registrable transaction, then unless -

- (a) an application for registration of the prescribed particulars of the transaction is made before the end

of the period of 6 months beginning on the date of the transaction; or

- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered.

(5) Provision may be made by the rules as to -

- (a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence; and
- (b) the removal of such particulars from the register -
 - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or
 - (ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of his intention to remove the particulars from the register.

(6) Provision may also be made by the rules as to the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

28. Trust and equities

(1) No notice of any trust (whether express, implied or constructive) shall be entered in the register; and the Registrar shall not be affected by any such notice.

(2) Subject to this Ordinance, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal property.

(3) For greater certainty, nothing in this section prevents the registration of a trade mark, or the registration of particulars of a registrable transaction, in the name of a person as a trustee of a trust.

29. Application for registration of a trade mark as an object of property

(1) Sections 25 to 28 (which relate to a registered trade mark as an object of property) apply, with any necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.

(2) In section 26 (co-ownership of registered trade mark), as it applies in relation to an application for registration, the reference in subsection (1) to the registration of a trade mark shall be construed as a reference to the making of the application.

(3) In section 27 (registration of transactions affecting registered trade mark), as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Registrar of those particulars.

PART V
LICENSING OF REGISTERED TRADE MARKS

Preliminary

30. Interpretation

In this Part, unless the context otherwise requires -

“exclusive licence” (專用特許) means a licence, whether general or limited, authorizing the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorized by the licence; and “exclusive licensee” (專用特許持有人) shall be construed accordingly;

“licence” (特許) includes a sub-licence; and “licensee” (特許持有人) shall be construed accordingly.

Licences

31. Licences may be general or limited

(1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply -

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) A licence is not effective unless it is in writing and is signed by or on behalf of the grantor.

(4) The requirement in subsection (3) may be satisfied in a case where the grantor is a corporation by the affixing of the seal of the corporation.

(5) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest; and references in this Ordinance to doing anything with, or without, the consent of the owner of a registered trade mark shall be construed accordingly.

(6) A licence may authorize a licensee to grant a sub-licence.

32. Exclusive licence may provide same rights as assignment, etc.

(1) An exclusive licence may provide that the exclusive licensee shall, to such extent as may be provided by the licence, have the same rights and be entitled to the same remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

Infringement proceedings

33. Rights of licensees generally

(1) This section has effect with respect to the rights of a licensee in relation to the infringement of a registered trade mark but does not apply where or to the extent that -

(a) by virtue of section 34(2) (rights of certain exclusive licensees), the licensee has a right to bring infringement proceedings in his own name;

or

- (b) by virtue of section 35(2) (rights of sub-licensees under certain exclusive licences), a sub-licensee has the right to call on the exclusive licensee to take infringement proceedings in respect of any matter which affects the sub-licensee's interests.

(2) A licensee is entitled, unless his licence or any licence through which his interest is derived provides otherwise, by notice in writing served on the owner of the registered trade mark, to call on the owner to take infringement proceedings in respect of any matter which affects the licensee's interests.

(3) Unless the licence or any licence through which the licensee's interest is derived provides otherwise, if the owner of the registered trade mark -

- (a) refuses to do so; or
- (b) fails to do so within 1 month after being called on to do so,

the licensee may bring the proceedings in his own name as if he were the owner.

(4) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the court, proceed with the action unless the owner of the registered trade mark is either joined as a plaintiff or added as a defendant.

(5) An owner of a registered trade mark who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) Nothing in subsection (4) affects the granting of interlocutory relief on application by a licensee alone.

(7) In infringement proceedings brought by the owner of a registered trade mark, any loss suffered or likely to be suffered by

licensees shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.

34. Rights of certain exclusive licensees

(1) This section applies in relation to an exclusive licensee if, or to the extent that, by virtue of section 32(1) (exclusive licence may provide same rights as assignment, etc.), he has the same rights and is entitled to the same remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) The exclusive licensee is entitled, subject to the provisions of the licence and to this section, to bring infringement proceedings in his own name against any person other than the owner of the registered trade mark.

(3) The rights of the exclusive licensee and the remedies to which he is entitled are concurrent with those of the owner of the registered trade mark; and references to the owner of a registered trade mark in this Ordinance relating to infringement shall be construed accordingly.

(4) In infringement proceedings brought by an exclusive licensee by virtue of this section, a defendant may avail himself of any defence which would have been available to him if the proceedings had been brought by the owner of the registered trade mark.

(5) Where proceedings for infringement of a registered trade mark brought by the owner of the registered trade mark or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the owner or the exclusive licensee, as the case may be, may not, without the leave of the court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(6) A person who is added as a defendant as mentioned in subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in subsection (5) affects the granting of interlocutory relief on application by the owner of a registered trade mark or an exclusive licensee alone.

(8) Where proceedings for infringement of a registered trade mark are brought which relate wholly or partly to an infringement in respect of which the owner of the registered trade mark and an exclusive licensee have or had concurrent rights of action -

(a) the court shall in assessing damages take into account -

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) if an account of profits is directed, the court shall apportion the profits between them as the court considers just.

(9) Subsection (8) applies whether or not the owner of the registered trade mark and the exclusive licensee are both parties to the proceedings; and if they are not both parties, the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(10) The owner of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 21 (order for delivery up); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(11) Subsections (5) to (10) have effect subject to any agreement to the contrary between the owner of the registered trade mark and the exclusive licensee.

35. Rights of sub-licensees under certain exclusive licences

(1) This section applies in relation to a sub-licensee of an exclusive licensee if, or to the extent that, by virtue of section 34(2) (rights of certain exclusive licensees), the exclusive licensee has a right to bring infringement proceedings in his own name.

(2) A sub-licensee is entitled, unless his sub-licence or any licence through which his interest is derived provides otherwise, by notice in writing served on the exclusive licensee, to call on the exclusive licensee to take infringement proceedings in respect of any matter which affects the sub-licensee's interests.

(3) Unless the sub-licence or any licence through which the sub-licensee's interest is derived provides otherwise, if the exclusive licensee -

(a) refuses to do so; or

(b) fails to do so within 1 month after being called on to do so,

the sub-licensee may bring the proceedings in his own name as if he were the exclusive licensee.

(4) Where infringement proceedings are brought by a sub-licensee by virtue of this section, the sub-licensee may not, without the leave

of the court, proceed with the action unless both the exclusive licensee and the owner of the registered trade mark are either joined as plaintiffs or added as defendants.

(5) A person who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) Nothing in subsection (4) affects the granting of interlocutory relief on application by a sub-licensee alone.

PART VI

APPLICATION AND REGISTRATION PROCEDURES

Application for registration of trade mark

36. Application for registration

(1) An application for registration of a trade mark shall be filed with the Registrar in the prescribed manner.

(2) The application shall include -

- (a) a request for registration of the trade mark;
- (b) the name and address of the applicant;
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark;
- (d) a representation of the trade mark; and
- (e) such other information, documents or matter as may be required by the rules.

(3) The application shall state whether the trade mark is being used, by the applicant or with his consent, in relation to the goods or services in respect of which it is sought to be registered, and if it is not being so used, whether the applicant honestly intends to use

the trade mark, or to allow it to be used, in relation to those goods or services.

(4) The application shall be filed in one of the official languages and shall also comply with the requirements of this Ordinance and the rules as to the provision of information in, or the translation of documents into, one or both of the official languages.

(5) The application shall be accompanied by the prescribed application fee and such other fees as may be prescribed.

37. Filing date

(1) The filing date of an application for registration of a trade mark is the earliest date on which -

- (a) documents containing everything required by section 36(2)(a) to (d) (application for registration) are filed; and
- (b) the fees required by section 36(5) are paid.

(2) References in this Ordinance to the date of application for registration of a trade mark shall be construed as references to the filing date of the application for registration.

38. Classification of goods and services

(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar.

39. Claim to priority

(1) A person who has duly filed an application for the registration of a trade mark in, or in respect of, a Paris Convention country or WTO member, or his successor in title, shall enjoy, for the purpose of registering the same trade mark under this Ordinance in respect of any or all of the same goods or services, a right of priority for a period of 6 months beginning on the date of filing of the first of any such applications, subject to compliance with any prescribed conditions.

(2) If the application for registration under this Ordinance is made within the 6-month period referred to in subsection (1) -

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application or WTO application, as the case may be; and
- (b) the registrability of the trade mark shall not be affected by any use of the trade mark in Hong Kong in the period between that date and the date of the application for registration under this Ordinance.

(3) Any filing of an application for registration of a trade mark in, or in respect of, a Paris Convention country or WTO member which is equivalent to a regular national filing under the law of that Paris Convention country or WTO member, or under any bilateral or multilateral agreement to which it is a party, shall be recognized as giving rise to a right of priority.

(4) In subsection (3), “regular national filing” (正規國家提交) means a filing of an application for registration of a trade mark in, or in respect of, a Paris Convention country or WTO member that establishes the date on which the application was filed, whatever the outcome of the application may be.

(5) A subsequent application for registration of a trade mark that was the subject of a previous application, and that is filed in, or in respect of, the same Paris Convention country or WTO member, shall be considered as the first application for the purpose of determining priority if, and only if, on the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.

(6) The previous application referred to in subsection (5) may not thereafter serve as a basis for claiming a right of priority.

(7) Provision may be made by the rules as to the manner of claiming a right to priority on the basis of a Convention application or WTO application, as the case may be.

(8) A right to priority arising as a result of a Convention application or WTO application, as the case may be, may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the person's "successor in title" (所有權繼承人) shall be construed accordingly.

(9) In this section -
"Convention application" (公約申請) means an application for registration of a trade mark in, or in respect of, a Paris Convention country;
"WTO application" (世貿申請) means an application for registration of a trade mark in, or in respect of, a WTO member.

Examination and publication

40. Examination of application

(1) The Registrar shall examine whether the application satisfies the requirements for registration under this Ordinance, including any requirements imposed by the rules for the purposes of this section.

(2) For the purpose of subsection (1), the Registrar shall carry out a search of earlier trade marks to such extent as he considers necessary.

(3) If it appears to the Registrar that the requirements for registration are not met, the Registrar shall notify the applicant in writing accordingly, and give him an opportunity to make representations or amend the application within such period as the Registrar may specify.

(4) The Registrar shall refuse to accept the application if the applicant fails to respond to the notice before the end of the specified period or fails before the end of that period to -

- (a) satisfy the Registrar that the requirements for registration are met; or
- (b) amend the application so as to meet those requirements.

(5) If it appears to the Registrar that the requirements for registration are met, he shall accept the application, but the Registrar may withdraw the acceptance at any time before particulars of the application have been published under section 41 (publication of particulars of application) if it appears to him that the application has been accepted in error.

(6) The Registrar shall notify the applicant in writing of any decision made by him under subsection (4) or (5).

41. Publication of particulars of application

Where the Registrar accepts an application for registration of a trade mark under section 40 (examination of application), particulars of the application shall be published in the official journal in accordance with the rules.

Opposition, withdrawal, restriction and amendment

42. Opposition proceedings

(1) Any person may, within the prescribed period beginning on the date of publication of particulars of an application under section 41 (publication of particulars of application), give notice to the Registrar of opposition to the registration.

(2) A notice of opposition shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

43. Withdrawal or restriction of application

(1) An applicant for registration of a trade mark may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If particulars of the application have been published in accordance with section 41 (publication of particulars of application), particulars of the withdrawal or restriction shall be published in the official journal in accordance with the rules.

44. Amendment of application

(1) At the request of the applicant, the Registrar may amend an application for registration of a trade mark as provided in this section.

(2) An application for registration of a trade mark may be amended for the purpose of adding a representation of a registered trade mark to the representation of the trade mark in question but only if all of the following conditions are met -

- (a) at the time the request for amendment is made, the registered trade mark is registered in the name of the applicant;
- (b) the goods or services for which the registered trade mark is registered are identical or similar to the goods or services covered by the application; and
- (c) the date of registration of the registered trade mark is earlier than the date of application for registration of the trade mark in question.

(3) An application for registration of a trade mark may be amended in other respects but only for the purpose of correcting -

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(4) Provision shall be made by the rules for -

- (a) the publication of particulars of any amendment which affects the representation of the trade mark, or the goods or services covered by the application; and
- (b) the making of objections by any person claiming to be affected by the amendment.

Registration

45. Registration

(1) Where an application has been accepted by the Registrar under section 40(5) (examination of application) and -

- (a) no notice of opposition is given within the prescribed period referred to in section 42(1) (opposition proceedings); or
- (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the Registrar shall register the trade mark by entering the prescribed particulars in the register, unless it appears to him having regard to matters coming to his notice since he accepted the application, that it was accepted in error.

(2) On the registration of a trade mark under subsection (1), the Registrar shall issue a certificate of registration to the applicant.

(3) Notice of the registration shall be published in the official journal in accordance with the rules.

46. Date of registration

A trade mark shall be registered as of the filing date of the application for registration; and that date shall be deemed for the purposes of this Ordinance to be the date of registration of the trade mark.

47. Duration of registration

(1) A trade mark shall be registered for a period of 10 years beginning on its date of registration.

(2) Registration may be renewed in accordance with section 48 (renewal of registration) for further periods of 10 years.

48. Renewal of registration

(1) The owner of a registered trade mark may, in the prescribed manner, request the renewal of the registration of the trade mark, subject to payment of the prescribed renewal fee.

(2) Provision may be made by the rules for the Registrar to inform the owner of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration; and failing this, the request may be made and the renewal fee paid within such further period, of not less than 6 months, as may be prescribed, in which case an additional prescribed fee must also be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with this section, the Registrar shall remove the trade mark from the register.

(6) Provision may be made by the rules for the restoration of the registration of a trade mark which has been removed from the register under subsection (5), subject to such conditions, if any, as may be prescribed.

(7) Notice of the renewal or restoration of the registration of a trade mark shall be published in the official journal in accordance with the rules.

Supplementary

49. Division, merger and registration of series

(1) Provision may be made by the rules as to -

- (a) the division of an application for the registration of a trade mark into 2 or more separate applications, each of which claims the same protection under the Ordinance as the original application;
- (b) the merging of separate applications for registration of a trade mark, each of which claims the same protection under the Ordinance, into a single application;
- (c) the merging of separate registrations, each of which provides the same protection under the Ordinance in relation to the same trade mark, into a single registration; and
- (d) the registration of a series of trade marks.

(2) Without prejudice to the generality of subsection (1), provision may be made by the rules as to -

- (a) the circumstances in which, and conditions subject to which, the division of an application for registration, the merging of separate applications or registrations, or the registration of a series of trade marks, is permitted;
- (b) as to the effect of a division of an application for registration or of a merger of separate applications or registrations; and
- (c) the purposes for which an application for the registration of a trade mark is to be treated as a single

application and those for which it is to be treated as a number of separate applications.

(3) In this section, “series of trade marks” (一系列的商標) means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

PART VII

PROCEEDINGS AFFECTING REGISTRATION

Revocation, invalidity and variation

50. Revocation of registration

(1) An application for the revocation of the registration of a trade mark may be made by any person, and may be made either to the Registrar or to the court.

(2) The registration of a trade mark may be revoked on any of the following grounds, namely -

- (a) that within the period of 3 years following the actual date on which particulars of the trade mark were entered in the register under section 45(1) (registration), it has not been put to genuine use in Hong Kong by the owner or with his consent, in relation to the goods or services for which it is registered, and there are no valid reasons for non-use (such as import restrictions on, or other governmental requirements for, goods or services protected by the trade mark);

- (b) that such use has been suspended for a continuous period of at least 3 years and there are no valid reasons for non-use;
- (c) that in consequence of the acts or the inactivity of the owner, the trade mark has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the owner or with his consent, in relation to the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services; or
- (e) that there has been a contravention of or a failure to observe any condition entered in the register in relation to its registration.

(3) For the purposes of subsection (2) -

- (a) use of a trade mark includes use in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered; and
- (b) use of a trade mark in Hong Kong includes applying the trade mark to goods or to the packaging of goods in Hong Kong solely for export purposes.

(4) Subject to subsection (5), the registration of a trade mark shall not be revoked on the ground mentioned in subsection (2) (a) or (b) if the use described in that subsection is commenced or resumed after the expiry of the 3-year period and before the application for revocation is made.

(5) Any commencement or resumption of the use described in subsection (2) (a) or (b) after the expiry of the 3-year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the owner of the registered trade mark became aware that the application might be made.

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(7) Where the registration of a trade mark is revoked to any extent, the rights of the owner shall be deemed to have ceased to that extent as from -

- (a) the date of the application for revocation; or
- (b) if the Registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that earlier date.

(8) For the purposes of this section, any act that is done in Hong Kong in relation to services which are provided or to be provided outside Hong Kong and that, if done in relation to services which are provided or to be provided within Hong Kong, would constitute use of a trade mark in Hong Kong, shall be deemed to constitute use of that trade mark in Hong Kong in relation to those services.

51. Declaration of invalidity of registration

(1) An application for a declaration of invalidity of the registration of a trade mark may be made by any person, and may be made either to the Registrar or to the court.

(2) In the case of bad faith in the registration of a trade mark, the Registrar himself may apply to the court for a declaration of the invalidity of the registration.

(3) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in contravention of section 10 (absolute grounds for refusal of registration).

(4) Where the trade mark was registered in contravention of section 10(1)(b), (c) or (d), it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(5) Subject to subsections (6) and (7), the registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 11(1), (2) or (3) (relative grounds for refusal of registration) apply; or
- (b) that there is an earlier right in relation to which the condition set out in section 11(4) or (5) (relative grounds for refusal of registration) is satisfied.

(6) The registration of a trade mark may not be declared invalid under subsection (5) if -

- (a) the owner of the earlier trade mark or other earlier right has consented to the registration; and
- (b) the Registrar or the court is satisfied that there is no likelihood of confusion on the part of the public.

(7) Where a trade mark has been registered on the ground that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right, as provided for by section 12 (honest

concurrent use, etc.), the registration of a trade mark may not be declared invalid under subsection (5) unless the Registrar or the court is satisfied that in fact there had been no honest concurrent use of the trade mark' and the earlier trade mark or other earlier right.

(8) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(9) Without affecting transactions past and closed, where the registration of a trade mark is declared invalid under this section to any extent, the registration shall to that extent be deemed never to have been made.

52. Variation of registration

(1) An application for the variation of the registration of a trade mark may be made by any person, and may be made either to the Registrar or to the court.

(2) The registration of a trade mark may be varied on the ground that there has been a contravention of or a failure to observe any condition entered in the register in relation to its registration.

Alteration and surrender

53. Alteration of registered trade mark

(1) Except as provided in this section, a registered trade mark shall not be altered in the register.

(2) The Registrar may, at the request of any owner of a registered trade mark which contains or consists of the owner's name or address, allow the alteration of that name or address but only to the extent

that the alteration does not substantially affect the identity of the trade mark.

- (3) Provision may be made by the rules -
 - (a) as to the effect of any such alteration;
 - (b) for the publication in the official journal of particulars of any such alteration; and
 - (c) for the making of objections by any person claiming to be affected by it.

54. Surrender of registered trade mark

(1) The registration of a trade mark may be surrendered by the owner in respect of some or all of the goods or services for which the trade mark is registered.

- (2) Provision may be made by the rules -
 - (a) as to the manner and effect of a surrender; and
 - (b) for protecting the interests of other persons having a right in the trade mark.

Rectification, correction and amendment of the register

55. Rectification or correction

(1) Subject to subsection (2), any person having a sufficient interest may apply for the rectification of an error or omission in the register.

(2) An application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(3) An application for rectification may be made either to the Registrar or to the court.

(4) Except where the Registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question is deemed never to have been made.

(5) The Registrar may, on request made by the owner of a registered trade mark or a licensee, enter any change in his name or address, or in any other particulars identifying the owner or licensee, as recorded in the register.

(6) The Registrar may, without an application for rectification having been made to him, correct any error made by him in any entry in the register but, before doing so, he shall give notice of the proposed correction to any person who appears to him to be concerned.

(7) The Registrar may remove from the register matter appearing to him to have ceased to have effect.

56. Amendment of entries to accord with new classification, etc.

(1) Provision may be made by the rules to empower the Registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

(2) Provision may in particular be made by the rules to empower the Registrar to amend entries in the register so as to accord with the amended or substituted classification of goods or services.

(3) Where the rules empower the Registrar to amend entries in the register, provision shall also be made by the rules for -

- (a) the giving of notice to any owner of a registered trade mark who may be affected by an amendment proposed to be made by the Registrar;
- (b) the publication in the official journal of particulars of the amendments proposed to be made by the Registrar;

- (c) the making of objections, within such time as may be prescribed, by any owner of a registered trade mark claiming to be affected; and
 - (d) the filing of oppositions, within such time as may be prescribed, by any other person claiming to be affected.
- (4) Provision may also be made by the rules to empower the Registrar -
- (a) to require the owner of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of entries in the register so as to accord with any amended or substituted classification of goods or services; and
 - (b) to cancel or refuse to renew the registration of the trade mark in the event of the owner failing to do so.
- (5) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

Acquiescence in use of registered trade mark

57. Effect of acquiescence

(1) Where the owner of an earlier trade mark or other earlier right has acquiesced for a continuous period of 5 years in the use of a registered trade mark in Hong Kong, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other earlier right -

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the application for registration of the later trade mark was made in bad faith.

(2) Where subsection (1) applies, the owner of the later trade mark is not entitled to oppose the use of the earlier trade mark or the exploitation of the earlier right, as the case may be, notwithstanding that the earlier trade mark or earlier right may no longer be invoked against his later trade mark.

PART VIII

DEFENSIVE TRADE MARKS, COLLECTIVE MARKS AND CERTIFICATION MARKS

58. Defensive trade marks

(1) If a registered trade mark has been used so much in relation to all or any of the goods or services for which it is registered that it has become well-known and, as a result, its use in relation to other goods or services would be likely to detract from its distinctive character in relation to the goods or services for which it has been so used, the trade mark may, on the application of the owner of the registered trade mark made to the Registrar, be registered as a defensive trade mark in respect of any or all of those other goods or services.

(2) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if the owner of the registered trade mark does not use or intend to use the trade mark in relation to those goods or services.

(3) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if it is already registered (otherwise than as a defensive trade mark) in the name of the applicant in respect of those goods or services.

(4) A trade mark that is registered as a defensive trade mark in respect of particular goods or services may be subsequently registered (otherwise than as a defensive trade mark) in the name of the owner of the registered trade mark in respect of the same goods or services.

(5) The Registrar shall refuse an application made under subsection (1) if -

- (a) the trade mark is not registered as a trade mark in the name of the applicant; or
- (b) the extent to which the registered trade mark is being or has been used does not accord with the circumstances described in subsection (1).

(6) Any person may apply to the Registrar or to the court for the revocation of the registration of a trade mark as a defensive trade mark on any of the following grounds -

- (a) that the trade mark is not otherwise registered in the name of the owner of the registered defensive trade mark; or
- (b) that the extent to which the registered trade mark is being or has been used does not accord with the circumstances described in subsection (1),

and such revocation may be in respect of all or any of the goods or services in respect of which the registered trade mark is registered as a defensive trade mark.

(7) Section 36(3) (application for registration), section 50(2)(a), (b), (c) and (d) (revocation of registration) and such other provisions of this Ordinance as may be inconsistent with this section shall not apply in relation to defensive trade marks.

59. Collective marks

(1) A collective mark is a sign distinguishing the goods or services of members of the association which is the owner of the sign from those of other undertakings.

(2) This Ordinance applies to collective marks in the manner and to the extent specified in Schedule 1.

60. Certification marks

(1) A certification mark is a sign indicating that the goods or services in connection with which it is used are certified by the owner of the sign in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) This Ordinance applies to certification marks in the manner and to the extent specified in Schedule 2.

PART IX
PARIS CONVENTION AND WORLD TRADE ORGANIZATION AGREEMENT:
SUPPLEMENTARY PROVISIONS

61. Well-known trade marks: Article 6bis of Paris Convention

(1) Subject to section 57 (effect of acquiescence), the owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction the use in Hong Kong of a trade mark which, or the essential

part of which, is identical or similar to his trade mark, in relation to identical or similar goods or services, where such use is likely to cause confusion on the part of the public.

(2) Nothing in subsection (1) affects the continuation of any use in good faith of a trade mark which was begun before the commencement of this section.

62. National emblems, etc.: Article 6^{ter} of Paris Convention

(1) Subject to section 10(6) (absolute grounds for refusal of registration), a trade mark which consists of or contains the flag of a Paris Convention country or WTO member shall not be registered without the authorization of the competent authorities of that country or member, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization.

(2) Subject to section 10(6) (absolute grounds for refusal of registration), a trade mark which consists of or contains the armorial bearings or any other state emblem of a Paris Convention country or WTO member which is protected under the Paris Convention (including any armorial bearings or state emblems entitled to such protection by virtue of the World Trade Organization Agreement) shall not be registered without the authorization of the competent authorities of that country or member.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Paris Convention country or WTO member and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention (including any sign or hallmark entitled to such protection by virtue of the World Trade Organization Agreement), be registered in relation to goods or services which are the same as, or are of a similar kind to, those in relation to which

it indicates control and warranty, without the authorization of the competent authorities of that country or member.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorized to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorization of the competent authorities of a Paris Convention country or WTO member is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the trade mark in Hong Kong without their authorization.

63. Emblems, etc., of certain international organizations: Article 6ter of Paris Convention

(1) This section applies to -

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organizations of which one or more Paris Convention countries or WTO members are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention (including any emblem, abbreviation or name entitled to such protection by virtue of the World Trade Organization Agreement) shall not be registered without the authorization of the international intergovernmental organization concerned, unless it appears to the

Registrar that the use of the emblem, abbreviation or name in the manner proposed -

- (a) is not such as to suggest to the public that a connection exists between the organization and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organization.

(3) The provisions of this section as to emblems of an international intergovernmental organization apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorization of an international intergovernmental organization is or would be required for the registration of a trade mark, that organization is entitled to restrain by injunction any use of the trade mark in Hong Kong without its authorization.

(5) Nothing in this section affects the rights of a person whose use in good faith of the trade mark in question began before 16 November 1977 (when the relevant provisions of the Paris Convention entered into force in relation to Hong Kong).

64. Notification under Article 6ter of Paris Convention

(1) For the purposes of section 62 (national emblems, etc.), state emblems of a country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention, or as protected under the Paris Convention by virtue of the World Trade Organization Agreement, only if, or to the extent that -

- (a) the country in question has notified the World Intellectual Property Organization in accordance with

Article 6ter (3) of the Paris Convention that it desires to protect that emblem, sign or hallmark;

- (b) the notification remains in force; and
- (c) no objection to the notification has been transmitted to the World Intellectual Property Organization on behalf of Hong Kong in accordance with Article 6ter (4) of the Paris Convention or any such objection has been withdrawn.

(2) For the purposes of section 63 (emblems, etc., of certain international organizations), the emblems, abbreviations and names of an international intergovernmental organization shall be regarded as protected under the Paris Convention, or as protected under the Paris Convention by virtue of the World Trade Organization Agreement, only if, or to the extent that -

- (a) the organization in question has notified the World Intellectual Property Organization in accordance with Article 6ter (3) of the Paris Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) no objection to the notification has been transmitted to the World Intellectual Property Organization on behalf of Hong Kong in accordance with Article 6ter (4) of the Paris Convention or any such objection has been withdrawn.

(3) Notification in accordance with Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for registration made more than 2 months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection at the Registry by any person, during the normal business hours of the Registry, and free of charge, a list of -

- (a) the state emblems and official signs or hallmarks; and
- (b) the emblems, abbreviations and names of international intergovernmental organizations,

which are for the time being protected under the Paris Convention by virtue of a notification under Article 6ter (3) of the Paris Convention.

PART X

ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

The register of trade marks

65. Register to be kept

(1) The Registrar shall keep at the Registry a register to be known as the register of trade marks.

(2) There shall be entered in the register in accordance with this Ordinance and the rules -

- (a) particulars as to applications for registration of trade marks, including the filing dates and dates of priority;
- (b) the names of owners of registered trade marks;
- (c) particulars as to transactions, instruments or events affecting rights in or under registered trade marks and applications for registration; and
- (d) such other matters as the Registrar may think fit.

(3) The register need not be kept in documentary form.

66. Right to inspect the register

(1) Subject to any rules, the public shall have a right to inspect the register during the normal business hours of the Registry.

(2) In relation to any portion of the register kept otherwise than in documentary form, the right of inspection conferred by subsection (1) is a right to inspect the material on the register.

67. Right to copies of entries

(1) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts.

(2) Any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(3) Applications under this section shall be made in such manner as may be prescribed.

(4) In relation to any portion of the register kept otherwise than in documentary form, the right to a copy or extract conferred by subsection (1) or (2) is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

Powers and duties of Registrar

68. Exercise of Registrar's discretionary powers

Without prejudice to any rule of law, the Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by or under this Ordinance.

69. Registrar's powers in proceedings before the Registrar

(1) The Registrar may, for the purposes of proceedings before him under this Ordinance -

- (a) summon witnesses;
- (b) receive written or oral evidence on oath or affirmation; and
- (c) require the production of documents or articles for inspection and provide for the manner of inspection.

(2) The Registrar may make such orders as he thinks fit as respects any matter mentioned in subsection (1).

(3) Any order made by the Registrar under this section shall, with leave of the court, be enforceable in like manner as an order of the court.

70. Power to give preliminary advice, etc.

(1) The Registrar shall have the power to give to a person who proposes to apply for the registration of a trade mark advice as to whether the trade mark appears to the Registrar prima facie to be capable of distinguishing goods or services of one undertaking from those of other undertakings within the meaning of section 3(1) (meaning of "trade mark").

(2) Any person who wishes to obtain such advice shall apply to the Registrar in the prescribed manner.

(3) If, on an application for the registration of a trade mark as to which the Registrar has given such advice in the affirmative, made within 3 months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not capable of

distinguishing the goods or services of one undertaking from those of another, the applicant shall be entitled, on giving notice of withdrawal of the application under section 43 (withdrawal or restriction of application) within the prescribed period, to have repaid to him any fees paid for the filing of the application.

71. Power to specify official journal, etc.

(1) The Registrar may from time to time, by notice published in the Gazette, specify a publication to be the official journal of record for the purposes of this Ordinance, with effect as of the date specified in the notice.

(2) Where a publication is specified under subsection (1), every notice, request, document or other matter required by this Ordinance or the rules to be published in the official journal shall, from the effective date specified in the notice, be published in the publication so specified, and any reference in this Ordinance or the rules to the official journal shall be construed accordingly.

(3) The Registrar may publish or cause to be published a journal in which there may be published such documents and information relating to trade marks as the Registrar thinks fit.

(4) For the avoidance of doubt, the Registrar may specify the Gazette or the journal referred to in subsection (3) to be the official journal of record.

(5) A publication specified under subsection (1) and the journal referred to in subsection (3) need not be in a documentary form.

(6) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1).

72. Power to require use of forms

(1) The Registrar may require the use of such forms as he may, by notice published in the official journal, specify in connection with the registration of a trade mark or any other proceeding before him under this Ordinance.

(2) A notice under subsection (1) may contain any direction of the Registrar with respect to the use of a form specified in the notice.

(3) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1).

73. Information about applications and registered trade marks

(1) After particulars of an application for the registration of a trade mark are published under section 41 (publication of particulars of application) and upon the filing of a written request by any person in the prescribed manner, the Registrar shall give the person making the request such information, and permit him to inspect such documents, relating to the application or the trade mark concerned as may be specified in the request, subject, however, to any prescribed conditions.

(2) Subject to this section, until particulars of an application for registration of a trade mark are published under section 41 (publication of particulars of application), information or documents constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent the Registrar from publishing or communicating to others any prescribed information or documents relating to an application for registration of a trade mark.

(4) Where a person is notified that an application for registration of a trade mark has been made and that the applicant will, if the trade mark is registered, bring proceedings against that person in the event of his doing an act specified in the notification, that person may make a request under subsection (1), notwithstanding that particulars of the application have not been published, and that subsection shall apply accordingly.

74. Immunity of Registrar as regards official acts

Neither the Registrar nor any public officer -

- (a) shall be taken to warrant the validity of the registration of a trade mark under this Ordinance; or
- (b) shall incur any liability by reason of, or in connection with, any examination required or authorized by this Ordinance, or any report or other proceeding consequent on any such examination.

Legal proceedings, appeals and related matters

75. Language of proceedings before Registrar

(1) Except as otherwise provided in the rules, and notwithstanding section 5 of the Official Languages Ordinance (Cap. 5), the official language in which an application for registration of a trade mark is filed shall be used as the language of the proceedings in all proceedings before the Registrar under this Ordinance.

(2) The rules may -

- (a) require, in respect of any document filed or to be filed with the Registrar in proceedings under this Ordinance, the filing of a translation of the document into the

- language of the proceedings or into one or both official languages;
- (b) provide for the use by any person in oral proceedings before the Registrar, of a language other than the language of the proceedings;
 - (c) In respect of documents to be used for the purpose of evidence in proceedings before the Registrar and which are in a language other than the language of the proceedings, provide for the filing of the document in that other language and the filing of a translation of the document into the language of the proceedings or into one of the official languages;
 - (d) in respect of information provided or to be provided to the Registrar and which is to be entered in the register, require the provision of that information in both official languages; and
 - (e) provide for the issue of and specify the power of the Registrar to issue documents in one or both official languages.
- (3) Rules made for the purposes of subsection (2)(a) or (d) -
- (a) may specify periods within which translations of documents into the language of the proceedings or into the official languages are to be filed or within which information in the official languages is to be provided; and
 - (b) may provide for extensions, upon application by a party to the proceedings, of such periods, and may require that applications for such extension shall be subject to the payment of a prescribed fee.

76. Procedure in case of option to apply to court or Registrar

(1) Where under this Ordinance a person has an option to make an application either to the court or to the Registrar on a question concerning a registered trade mark or an application for registration of a trade mark, then -

- (a) if any proceedings concerning the registered trade mark or application for registration in question is pending before the court, the application must be made to the court; and
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question.

(2) Subsection (1) is without prejudice to the court's powers, apart from this section, to determine any question referred to in that subsection.

77. Application of rules of evidence

Except as otherwise provided in this Ordinance, the Registrar is not bound by the rules of evidence in any proceedings before him under this Ordinance and may inform himself of any matter that is before him in any way that he reasonably believes to be appropriate.

78. Register is prima facie evidence

(1) Subject to subsection (4), the register shall be prima facie evidence of anything required or authorized by this Ordinance or the rules to be registered.

(2) A certificate purporting to be signed by the Registrar and certifying that any entry in the register which he is authorized by this Ordinance or the rules to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be prima facie evidence of the matters so certified.

(3) Each of the following, that is to say -

- (a) a copy of an entry in the register or an extract from the register which is supplied under section 67(1) (right to copies of entries);
- (b) a copy of -
 - (i) any document kept in the Registry;
 - (ii) an extract from any such document; or
 - (iii) any application for registration of a trade mark,

which purports to be a certified copy or a certified extract shall, subject to subsection (4), be admitted in evidence in all courts, and in all proceedings, without further proof and without production of any original.

(4) This section is without prejudice to section 22A or 22B or Part IV of the Evidence Ordinance (Cap. 8) and any provision made by virtue of that section or Part.

(5) In this section, “certified copy” (核證副本) and “certified extract” (核證摘錄) mean a copy and extract certified by the Registrar and sealed with the seal of the Registrar.

79. Registration is prima facie evidence of validity, etc.

In any proceedings relating to a registered trade mark, including proceedings for rectification of the register, the registration of a person as owner of a trade mark shall be prima facie evidence of the

validity of the original registration and of any subsequent assignment or other transmission of it.

80. Certificate of validity of contested registration

(1) If in proceedings before the court the validity of the registration of a trade mark is contested and it is found by the court that the trade mark is validly registered, the court may give a certificate to that effect.

(2) If the court gives such a certificate and in any subsequent proceedings, either before the court or the Registrar -

- (a) the validity of the registration is again questioned on the same or substantially the same grounds; and
- (b) the owner of the registered trade mark obtains a final order, judgment or decision in his favour,

the owner is entitled to his costs on an indemnity basis unless the court or the Registrar, as the case may be, directs otherwise.

(3) Subsection (2) does not extend to the costs of an appeal in any such proceedings.

81. Burden in civil proceedings of proving use of trade mark

If, in any civil proceedings under this Ordinance, a question arises as to the use to which a registered trade mark has been put, it is for the owner of the registered trade mark to show what use has been made of it.

82. Registrar's appearance in proceedings involving the register

- (1) In proceedings before the court involving an application for -
 - (a) the revocation or variation of the registration of a trade mark;
 - (b) a declaration of the invalidity of the registration of a trade mark; or
 - (c) the rectification of the register,

the Registrar is entitled to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar may instead of appearing, submit to the court a statement in writing signed by him, giving particulars of -

- (a) any proceedings before him in relation to the matter in issue;
- (b) the grounds of any decision given by him;
- (c) the practice of the Registrar or the Registry in like cases, if any; and
- (d) such matters relevant to the issues involved in the proceedings and within his knowledge as the Registrar thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings before the court.

83. Appeals from decisions or orders of Registrar

(1) An appeal lies to the court from any decision or order of the Registrar under this Ordinance.

(2) Unless the court otherwise directs, any appeal under this Ordinance which concerns an application for registration of a trade mark shall be heard in public.

(3) In any appeal under this Ordinance -

(a) the Registrar shall be entitled to appear and be represented and be heard in support of his decision or order; and

(b) the Registrar shall appear if so directed by the court.

(4) In this section, “decision” (決定) includes any act of the Registrar made in the exercise of a discretion vested in him by or under this Ordinance.

84. General powers of court

The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Ordinance, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

85. Costs of proceedings before court

(1) In all proceedings before the court under this Ordinance the court may award to any party such costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

(2) If in any such proceedings the court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs shall be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court.

(3) In this section, “any other of the parties” (任何其他一方) includes -

- (a) any party interested;
- (b) any party to the proceedings;
- (c) any person who takes part in the proceedings; and
- (d) any person who appears in the proceedings.

86. Costs of proceedings before Registrar

(1) The Registrar may, in proceedings before him under this Ordinance, by order award to any party such costs as he may consider reasonable and direct how and by what parties they are to be paid.

(2) Any costs awarded under this section shall, if the court so orders, be recoverable by execution issued from the court as if they were payable under an order of that court.

(3) Provision may be made by the rules -

- (a) to empower the Registrar, in such cases as may be prescribed, to require a party to any proceedings before him to give security for costs in relation to those proceedings; and
- (b) as to the consequences if security is not given.

Miscellaneous matters

87. Recognition of agents

(1) Except as otherwise provided by the rules, any act required or authorized by this Ordinance to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a trade mark, may be done by or to an agent authorized by that person orally or in writing.

(2) The rules may in particular authorize the Registrar to refuse to recognize as an agent in respect of any business under this Ordinance any person specified for the purpose in the rules.

(3) The Registrar shall refuse to recognize as an agent a person having neither residence nor a place of business in Hong Kong.

88. Hours of business and business days

(1) The Registrar may give directions specifying the hours of business of the Registry for the purpose of the transaction of business under this Ordinance and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions given by the Registrar under this section may make different provision for different classes of business and shall be published in the prescribed manner.

89. Government's right to sell forfeited articles

Nothing in this Ordinance affects the right of the Government or any person deriving title directly or indirectly from the Government to dispose of or use articles forfeited under the law relating to customs or excise.

PART XI

SUBSIDIARY LEGISLATION

90. Rules

(1) The Registrar may make rules -

- (a) for the purposes of any provision of this Ordinance which contemplates or authorizes the making of rules (other than rules of court) with respect to any matter;
- (b) prescribing anything authorized or required by a provision of this Ordinance to be prescribed; and
- (c) generally for regulating the practice and procedure under this Ordinance.

(2) Without prejudice to the generality of subsection (1), rules made under this section may make provision -

- (a) as to the manner of filing of applications for registration of a trade mark and other documents with the Registrar;
- (b) as to the making of applications for registration of a trade mark by a partnership, association or other unincorporated body and the registration of trade marks in the name of such a body;
- (c) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (d) as to the manner of publication of any notice, request, document or other matter required by this Ordinance or the rules to be published in the official journal;
- (e) specifying the person or class of persons by whom any such notice, request, document or matter shall be published in the official journal and specifying the consequences of a failure to publish;

- (f) as to the time when applications and other documents shall be treated as having been filed with the Registrar for the purposes of this Ordinance or the rules;
- (g) as to the service of documents;
- (h) regulating the procedure to be followed in connection with any proceedings or other matter before the Registrar and authorizing the rectification of irregularities of procedure;
- (i) requiring fees to be paid in connection with any such proceedings or matter or in connection with the provision of any service by the Registry;
- (j) empowering the Registrar to tax costs awarded by him in any proceedings before him;
- (k) regulating the mode of giving evidence in any such proceedings, whether orally or in writing and whether by means of the production of documents or articles or otherwise;
- (l) regulating the inspection of documents or articles;
- (m) prescribing time limits for doing anything required to be done in connection with any proceedings under this Ordinance;
- (n) providing for the extension of any time limit so prescribed, or specified by the Registrar, whether or not it has already expired;
- (o) as to the public inspection of the register and the supply of certified or uncertified copies of entries in, or certified or uncertified copies of extracts from, the register in the event the register is not kept in documentary form; and

(p) providing for the publication and sale of documents and information by the Registry.

(3) Rules made under this section may make different provisions for different cases.

(4) Rules made under this section -

(a) authorizing the rectification of irregularities of procedure; or

(b) providing for the alteration of any period of time, may authorize the extension or further extension of any period of time notwithstanding that the period has already expired.

(5) Rules made under this section prescribing fees shall not be made except with the consent of the Financial Secretary.

(6) Any rules made under subsection (2)(i) may -

(a) prescribe fees fixed at; or

(b) provide for fees to be fixed at,

levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function.

(7) Provision may in particular be made by the rules as to -

(a) the payment of a single fee in respect of 2 or more matters; and

(b) the circumstances, if any, in which a fee may be waived or refunded.

(8) Rules may be made under this section providing for arrangements to be made by the Registrar for the publication of reports of decisions or orders made by the Registrar under this Ordinance or

decisions or orders relating to trade marks made by any court or body (whether in Hong Kong or elsewhere).

91. Regulations

The Chief Executive in Council may by regulation -

- (a) designate, for the purposes of this Ordinance, any country, territory or area as a country, territory or area which has acceded to the Paris Convention or the World Trade Organization Agreement;
- (b) amend Schedule 1 (collective marks); and
- (c) amend Schedule 2 (certification marks).

PART XII

OFFENCES

92. Falsification of the register

(1) Any person who makes or causes to be made a false entry in the register, knowing or having reason to believe that it is false, commits an offence.

(2) Any person who -

- (a) makes or causes to be made anything falsely purporting to be a copy of an entry in the register; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false, commits an offence.

(3) Any person who commits an offence under this section is liable

- (a) on summary conviction, to a fine at level 5 and to imprisonment for 6 months; and

- (b) on conviction on indictment, to a fine at level 5 and to imprisonment for 2 years.

93. Falsely representing trade mark as registered

(1) Any person who -

- (a) falsely represents that a sign is a registered trade mark; or
- (b) makes a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false, commits an offence and is liable on conviction to a fine at level 3.

(2) For the purposes of this section, the use in Hong Kong in relation to a trade mark of -

- (a) the word “registered” or “註冊”; or
- (b) any other word or symbol importing a reference, either express or implied, to registration,

is deemed to be a representation as to registration under this Ordinance unless it is shown that the reference is to registration elsewhere than in Hong Kong and that the trade mark is in fact so registered for the goods or services in question.

94. Misuse of title “Trade Marks Registry”

Any person who uses on his place of business, or on any document issued by him, or otherwise, the words “Trade Marks Registry” or “商標註冊處” or any other words suggesting that his place of business is, or is officially connected with, the Registry, commits an offence and is liable on summary conviction to a fine at level 4.

95. Offences committed by and proceedings relating to corporations

(1) Where an offence under this Ordinance committed by a corporation is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the corporation, or a person purporting to act in any such capacity, he as well as the corporation is guilty of the offence and liable to be proceeded against and punished accordingly.

(2) The following provisions apply for the purposes of proceedings for an offence under this Ordinance alleged to have been committed by a corporation -

- (a) any rules of court relating to the service of documents; and
- (b) section 19A (plea by a corporation before a magistrate) and section 87 (procedure on charge of indictable offence against corporation) of the Magistrates Ordinance (Cap. 227).

(3) In this section, “director” (董事) includes -

- (a) any person who occupies the position of director, by whatever name called; and
- (b) any person in accordance with whose directions or instructions the directors of a corporation are accustomed to act.

(4) A person shall not be deemed to be a person in accordance with whose directions or instructions the directors of a corporation are accustomed to act by reason only that the directors of the corporation act on advice given by him in a professional capacity.

PART XIII

TRANSITIONAL PROVISIONS, CONSEQUENTIAL AND RELATED AMENDMENTS AND REPEALS

96. Transitional matters, etc.

(1) Schedule 3 (transitional matters) has effect as respects transitional matters.

(2) The Chief Executive in Council may make regulations containing provisions of a savings or transitional nature consequent on the enactment of this Ordinance.

(3) Without prejudice to the generality of subsection (2), the regulations may in particular provide for -

- (a) the application of provisions of this Ordinance or the rules made under this Ordinance; or
- (b) the continued application of provisions of the repealed Trade Marks Ordinance (Cap. 43) or the repealed Trade Marks Rules (Cap. 43 sub. leg.),

in connection with any matter specified in the regulations.

(4) Regulations made under this section may, if they so provide, be deemed to have come into operation on a date earlier than the date on which they are published in the Gazette but not earlier than the date on which Schedule 3 (transitional matters) comes into operation.

(5) To the extent that any regulations come into operation on a date earlier than the date on which they are published in the Gazette, those regulations shall be construed so as not to -

- (a) affect, in a manner prejudicial to any person, the rights of that person existing before the date on which the regulations are published in the Gazette; or
- (b) impose liabilities on any person in respect of anything done, or omitted to be done, before that date.

(6) In the event of an inconsistency between any regulations made under this section and the provisions of Schedule 3, the latter shall prevail to the extent of the inconsistency.

97. Consequential and related amendments

The enactments specified in Schedule 4 are amended in accordance with that Schedule.

98. Repeals

- (1) The Trade Marks Ordinance (Cap. 43) is repealed.
- (2) The Trade Marks Rules (Cap. 43 sub. leg.) are repealed.
- (3) The Trade Marks (Emergency) Ordinance (Cap. 263) is repealed.
- (4) The Trade Marks (Emergency) Rules (Cap. 263 sub. leg.) are repealed.

SCHEDULE 1

[ss. 59 & 91]

COLLECTIVE MARKS

General

1. This Ordinance applies to collective marks subject to the provisions of this Schedule.

Signs of which a collective mark may consist

2. In relation to a collective mark, the reference in section 3(1) of this Ordinance (meaning of “trade mark”) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the owner of the collective mark from those of other undertakings.

Indication of geographical origin

3. (1) Notwithstanding section 10(1)(c) of this Ordinance (absolute grounds for refusal of registration), a collective mark which consists of a sign which may serve, in trade or business, to designate the geographical origin of goods or services may be registered.

(2) However, the owner of such a collective mark is not entitled to prohibit the use of the sign in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Mark not to be misleading as to character or significance

4. (1) A collective mark shall not be registered if the public is liable to be misled as regards its character or significance, in particular, if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a sign in respect of which an application is made for registration as a collective mark include some indication that it is a collective mark.

(3) Notwithstanding section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance, an application may be amended so as to comply with any requirement imposed by the Registrar under subsection (2).

Regulations governing use of collective mark

5. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the collective mark.
- (2) The regulations must specify -
- (a) the persons authorized to use the collective mark;
 - (b) the conditions of membership of the association; and
 - (c) where they exist, the conditions of use of the collective mark, including any sanctions against misuse.
- (3) The rules may impose further requirements with which the regulations must comply.

Approval of regulations by Registrar

6. (1) A collective mark shall not be registered unless the regulations governing its use comply with section 5(2) of this Schedule and any further requirements imposed by the rules.
- (2) A collective mark shall not be registered if the regulations governing its use are contrary to accepted principles of morality.
- (3) An applicant for registration of a collective mark must file the regulations and pay the prescribed fee before the end of the prescribed period after the date of the application for registration.
- (4) If an applicant fails to comply with subsection (3), the application shall be deemed to be withdrawn.

7. (1) The Registrar shall consider whether the requirements mentioned in section 6(1) and (2) of this Schedule are met.

(2) If it appears to the Registrar that the requirements mentioned in section 6(1) and (2) of this Schedule are not met, he shall inform the applicant and give him an opportunity to make representations or to file amended regulations within such period as the Registrar may specify.

(3) The Registrar shall refuse the application if the applicant fails to respond before the end of the specified period or fails before the end of that period -

(a) to satisfy the Registrar that the requirements mentioned in section 6(1) and (2) of this Schedule are met; or

(b) to file regulations amended so as to meet those requirements.

(4) If it appears to the Registrar that the requirements mentioned in section 6(1) and (2) of this Schedule, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 41 of this Ordinance (publication of particulars of application).

8. In addition to any other grounds on which the registration may be opposed, notice of opposition may be given relating to any of the matters mentioned in section 6(1) and (2) of this Schedule.

Regulations to be open to inspection

9. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

Amendment of regulations

10. (1) An amendment of the regulations governing the use of a registered collective mark is not effective until the amended regulations are filed and are accepted by the Registrar.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause or require notice of the amendment to be published in the official journal.

(3) If notice of the amendment is published in the official journal, notice of opposition may be given relating to any of the matters mentioned in section 6(1) and (2) of this Schedule.

Infringement: rights of authorized users

11. The following provisions apply in relation to an authorized user of a registered collective mark as in relation to a licensee of a registered trade mark -

- (a) section 17(6) of this Ordinance (infringement of registered trade mark);
- and
- (b) section 23(3) of this Ordinance (order for disposal).

12. (1) The following provisions, which correspond to the provisions of section 33 of this Ordinance (rights of licensees generally), have effect as regards the rights of an authorized user in relation to infringement of a registered collective mark.

(2) An authorized user is entitled, subject to any agreement to the contrary between him and the owner of the registered collective mark, to call on the owner to take infringement proceedings in respect of any matter which affects his interests.

(3) If the owner -

(a) refuses to do so; or

(b) fails to do so within 1 month after being called upon to do so,

the authorized user may bring the proceedings in his own name as if he were the owner.

(4) Where infringement proceedings are brought by virtue of this section, the authorized user may not, without the leave of the court, proceed with the action unless the owner is either joined as a plaintiff or added as a defendant.

(5) Nothing in subsection (4) affects the granting of interlocutory relief on an application by an authorized user alone.

(6) A person who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the owner of a registered collective mark, any loss suffered or likely to be suffered by authorized users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

13. Apart from the grounds of revocation mentioned in section 50 of this Ordinance (revocation of registration), the registration of a collective mark may be revoked on the ground -

(a) that the manner in which the owner uses the collective mark or allows it to be used has caused it to become

liable to mislead the public in the manner referred to in section 4(1) of this Schedule;

- (b) that the owner has failed to observe, or to secure the observance of, the regulations governing the use of the collective mark; or
- (c) that an amendment of the regulations has been made so that the regulations -
 - (i) no longer comply with section 5(2) of this Schedule and any further requirements imposed by the rules; or
 - (ii) are contrary to accepted principles of morality.

Grounds for invalidity of registration

14. Apart from the grounds of invalidity mentioned in section 51 of this Ordinance (declaration of invalidity of registration), the registration of a collective mark may be declared invalid on the ground that the collective mark was registered in breach of section 4(1) or 6(1) or (2) of this Schedule.

SCHEDULE 2

[ss. 60 & 91]

CERTIFICATION MARKS

General

1. This Ordinance applies to certification marks subject to the provisions of this Schedule.

Signs of which a certification mark may consist

2. In relation to a certification mark, the reference in section 3(1) of this Ordinance (meaning of “trade mark”) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

3. (1) Notwithstanding section 10(1)(c) of this Ordinance (absolute grounds for refusal of registration), a certification mark which consists of a sign which may serve, in trade or business, to designate the geographical origin of goods or services may be registered.

(2) However, the owner of such a certification mark is not entitled to prohibit the use of the sign in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Nature of owner’s trade or business

4. A certification mark shall not be registered if the owner carries on a trade or business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5. (1) A certification mark shall not be registered if the public is liable to be misled as regards its character or significance, in

particular, if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a sign in respect of which an application is made for registration as a certification mark include some indication that it is a certification mark.

(3) Notwithstanding section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance, an application may be amended so as to comply with any requirement imposed by the Registrar under subsection (2).

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the certification mark.

(2) The regulations must indicate -

- (a) the persons authorized to use the certification mark;
- (b) the characteristics to be certified by the certification mark;
- (c) how the certifying body is to test those characteristics and to supervise the use of the certification mark;
- (d) the fees, if any, to be paid in connection with the use of the certification mark; and
- (e) the procedures for resolving disputes.

(3) The rules may impose further requirements with which the regulations must comply.

Approval of regulations, etc.

7. (1) A certification mark shall not be registered unless -
- (a) the regulations governing its use comply with section 6(2) of this Schedule and any further requirements imposed by the rules; and
 - (b) the applicant is competent to certify the goods or services for which the certification mark is to be registered.
- (2) A certification mark shall not be registered if the regulations governing its use are contrary to accepted principles of morality.
- (3) An applicant for registration of a certification mark must file the regulations and pay the prescribed fee before the end of the prescribed period after the date of the application for registration.
- (4) If an applicant fails to comply with subsection (3), the application shall be deemed to be withdrawn.
8. (1) The Registrar shall consider whether the requirements mentioned in section 7(1) and (2) of this Schedule are met.
- (2) If it appears to the Registrar that the requirements mentioned in section 7(1) and (2) of this Schedule are not met, he shall inform the applicant and give him an opportunity to make representations or to file amended regulations within such period as the Registrar may specify.
- (3) The Registrar shall refuse the application if the applicant fails to respond before the end of the specified period or fails before the end of that period -

- (a) to satisfy the Registrar that the requirements mentioned in section 7(1) and (2) of this Schedule are met; or
- (b) to file regulations amended so as to meet those requirements.

(4) If it appears to the Registrar that the requirements mentioned in section 7(1) and (2) of this Schedule, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 41 of this Ordinance (publication of particulars of application).

9. In addition to any other grounds on which the registration may be opposed, notice of opposition may be given relating to any of the matters mentioned in section 7(1) and (2) of this Schedule.

Regulations to be open to inspection

10. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

11. (1) An amendment of the regulations governing the use of a registered certification mark is not effective until the amended regulations are filed and are accepted by the Registrar.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause or require notice of the amendment to be published in the official journal.

(3) If notice of the amendment is published in the official journal, notice of opposition may be given relating to the matters mentioned in section 7(1) and (2) of this Schedule.

**Consent to assignment of registered
certification mark**

12. The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

Infringement: rights of authorized users

13. The following provisions apply in relation to an authorized user of a registered certification mark as in relation to a licensee of a registered trade mark -

- (a) section 17(6) of this Ordinance (infringement of registered trade mark);
and
- (b) section 23(3) of this Ordinance (order for disposal).

14. In infringement proceedings brought by the owner of a registered certification mark, any loss suffered or likely to be suffered by authorized users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

15. Apart from the grounds of revocation mentioned in section 50 of this Ordinance (revocation of registration), the registration of a certification mark may be revoked on the ground -

- (a) that the owner has begun to carry on such a trade or business as is mentioned in section 4 of this Schedule;
- (b) that the manner in which the owner uses the certification mark or allows it to be used has caused it to become liable to mislead the public in the manner referred to in section 5(1) of this Schedule;
- (c) that the owner has failed to observe, or to secure the observance of, the regulations governing the use of the certification mark;
- (d) that an amendment of the regulations has been made so that the regulations -
 - (i) no longer comply with section 6(2) of this Schedule and any further requirements imposed by the rules; or
 - (ii) are contrary to accepted principles of morality; or
- (e) that the owner is no longer competent to certify the goods or services for which the certification mark is registered.

Grounds for invalidity of registration

16. Apart from the grounds of invalidity mentioned in section 51 of this Ordinance (declaration of invalidity of registration), the registration of a certification mark may be declared invalid on the ground that the certification mark was registered in breach of section 4, 5(1) or 7(1) or (2) of this Schedule.

SCHEDULE 3

[s. 96]

TRANSITIONAL MATTERS

Preliminary

1. (1) In this Schedule -

“commencement date” (生效日期) means the date on which this Schedule comes into operation;

“existing registered mark” (現有註冊標記) means a mark that, immediately before the commencement date, constituted a registered trade mark, certification trade mark or defensive trade mark under the repealed Ordinance;

“new register” (新註冊紀錄冊) means the register of trade marks kept under section 65 of this Ordinance (register to be kept);

“old law” (舊有法律) means -

- (a) the repealed Ordinance and the repealed Rules; and
- (b) any other enactment or rule of law applying to existing registered marks immediately before the commencement date;

“old register” (舊有註冊紀錄冊) means the register of trade marks kept under the repealed Ordinance;

“the repealed Ordinance” (被廢除條例) means the Trade Marks Ordinance (Cap. 43), as in operation immediately before its repeal by this Ordinance;

“the repealed Rules” (被廢除規則) means the Trade Marks Rules (Cap. 43 sub. leg.), as in operation immediately before their repeal by this Ordinance.

(2) Unless the context otherwise requires, all words and expressions used in this Schedule and defined in section 2(1) of the repealed Ordinance have the same meaning as in the repealed Ordinance.

(3) In the event of an inconsistency between this Schedule and section 92 of the repealed Ordinance (transitional provisions relating to the Intellectual Property (World Trade Organization Amendments) Ordinance 1996), section 92 of the repealed Ordinance shall prevail to the extent of the inconsistency.

(4) For the purposes of this Schedule, a matter shall be treated as pending on the commencement date if -

- (a) the matter was pending before the Registrar under the old law but no written decision on the matter had been issued by the Registrar before the commencement date;
- (b) the matter was the subject of a written decision issued by the Registrar under the old law before the commencement date but the decision was subject to appeal under the old law and the period for commencing the appeal had not yet expired;
- (c) the matter was the subject of proceedings under the old law which were pending before a court immediately before the commencement date; or
- (d) the matter was the subject of an order made by a court before the commencement date but the order was subject to appeal under the old law and the period for commencing the appeal had not yet expired.

(5) For ease of reference, provisions of the repealed Ordinance referred to in this Schedule, and other relevant provisions of the repealed Ordinance, are set out in the Annex to this Schedule.

Existing registered marks

2. (1) Existing registered marks shall be deemed to be transferred on the commencement date to the new register and, subject to this Schedule, shall be deemed to be registered under this Ordinance.

(2) Existing registered marks registered as a series under section 26 of the repealed Ordinance (series of trade marks) shall be deemed to be similarly registered in the new register.

(3) Provision may be made by the rules for putting any entries in the old register of any such series in the same form as is required for new entries made in the new register on or after the commencement date.

(4) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement date.

3. (1) Proceedings brought under section 49 of the repealed Ordinance (power to expunge or vary registration for breach of condition) which are pending on the commencement date shall be dealt with under the old law, and any necessary alterations and entries shall be made in the new register.

(2) Any entry in the old register of a disclaimer, condition or limitation which relates to an existing registered mark shall be deemed to be transferred to the new register and shall have effect as if entered in the new register in accordance with this Ordinance.

Effects of registration - infringement

4. (1) Subject to subsections (2) and (3) -

- (a) sections 13 to 19 of this Ordinance (which relate to registration and infringement) apply in relation to an existing registered mark as from the commencement date; and
 - (b) section 20 of this Ordinance (action for infringement) applies in relation to the infringement of an existing registered mark committed on or after the commencement date.
- (2) The old law applies to infringements committed before the commencement date.
- (3) It is not an infringement of -
- (a) an existing registered mark; or
 - (b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,
- to continue on or after the commencement date any use which did not constitute an infringement of the existing registered mark under the old law.

Infringing goods, material or articles

5. Section 21 (order for delivery up), section 22 (limitation on order for delivery up) and section 23 (order for disposal) of this Ordinance apply to infringing goods, material or articles whether made before, on or after the commencement date.

Rights and remedies of licensee or authorized user

6. (1) Section 33 of this Ordinance (rights of licensees generally) applies to licences granted before the commencement date, but only in relation to infringements committed on or after that date.

(2) Section 14 of Schedule 2 to this Ordinance (court to take into account loss suffered by authorized users, etc.) applies only in relation to infringements committed on or after the commencement date.

Co-ownership of registered mark

7. (1) Subject to subsection (2), section 26 of this Ordinance (co-ownership of registered trade mark) applies as from the commencement date to an existing registered mark of which 2 or more persons were immediately before the commencement date registered as joint owners.

(2) So long as the relations between the joint owners remain such as are described in section 19 or 19A of the repealed Ordinance (jointly owned trade marks relating to goods; and to services), as the case may be, there shall be taken to be an agreement to exclude the operation of section 26 of this Ordinance (co-ownership of registered trade mark).

Assignment, etc. of registered mark

8. (1) Section 25 of this Ordinance (nature of registered trade mark) applies to transactions and events occurring on or after the commencement date in relation to an existing registered mark.

(2) Existing entries under section 43 of the repealed Ordinance (registration of assignments and transmissions) shall be deemed to be

transferred on the commencement date to the new register and shall have effect as if made under section 27 of this Ordinance (registration of transactions affecting registered trade mark).

(3) Provision may be made by the rules for putting such existing entries in the same form as is required for new entries made in the new register on or after the commencement date.

(4) An application for registration under section 43 of the repealed Ordinance (registration of assignments and transmissions) which is pending on the commencement date shall be treated as an application for registration under section 27 of this Ordinance (registration of transactions affecting registered trade mark) and shall proceed accordingly.

(5) The Registrar may require the applicant to amend his application for registration so as to conform with the requirements of this Ordinance.

(6) Where before the commencement date a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration on or after that date shall be made under section 27 of this Ordinance (registration of transactions affecting registered trade mark) and shall proceed accordingly.

(7) Section 43 of the repealed Ordinance (registration of assignments and transmissions) continues to apply to cases to which subsections (4) to (6) apply and, in such cases, section 27(3) and (4) of this Ordinance (registration of transactions affecting registered trade mark) does not apply as regards the consequences of failing to register.

Licensing of registered mark

9. (1) Section 31 (licences may be general or limited) and section 32(2) (exclusive licence may provide same rights as assignment, etc.) of this Ordinance apply only in relation to licences granted on or after the commencement date; and the old law continues to apply in relation to licences granted before that date.

(2) Existing entries under section 58 of the repealed Ordinance (registered users) shall be deemed to be transferred to the new register on the commencement date and shall have effect as if made under section 27 of this Ordinance (registration of transactions affecting registered trade mark).

(3) Provision may be made by the rules for putting such existing entries in the same form as is required for new entries made in the new register on or after the commencement date.

(4) An application made under section 58 of the repealed Ordinance (registered users) for registration as a registered user which is pending on the commencement date shall be treated as an application for registration of a licence under section 27(1) of this Ordinance (registration of transactions affecting registered trade mark) and shall proceed accordingly.

(5) The Registrar may require the applicant to amend his application so as to conform with the requirements of this Ordinance.

(6) Any proceedings pending on the commencement date under section 60 of the repealed Ordinance (variation or cancellation of registration as a registered user) shall be dealt with under the old law, and any necessary alterations and entries shall be made to the new register.

Pending applications for registration

10. (1) Subject to subsection (6), an application for registration of a mark under the repealed Ordinance which is pending on the commencement date shall be dealt with under the old law, and if registered, the mark shall be treated for the purposes of this Schedule as an existing registered mark.

(2) A notice of opposition given under section 15 of the repealed Ordinance (opposition to registration) in relation to an application mentioned in subsection (1) and which is pending on the commencement date shall be dealt with under the old law.

(3) Provision may be made by the rules for regulating the practice and procedure in connection with an application mentioned in subsection (1) or a notice of opposition mentioned in subsection (2).

(4) Without prejudice to the generality of subsection (3), the rules may make provision -

- (a) authorizing the rectification of irregularities of procedure;
- (b) modifying time limits for anything required to be done under the rules;
and
- (c) providing for the extension of any time limit so prescribed whether or not it has already expired.

(5) The power of the Registrar under section 90 of this Ordinance (rules) to make rules regulating the practice and procedure, and as to the matters mentioned in subsection (2) of that section, is exercisable in relation to such applications; and different provision may be made for such applications from that made for other applications.

(6) Sections 24, 25(2), 26(2) and 56 of the repealed Ordinance (provisions as to associated trade marks) shall be disregarded in

dealing, on or after the commencement date, with an application for registration of a mark under the repealed Ordinance.

Conversion of pending application

11. (1) In the case of pending applications for registration referred to in section 10(1) of this Schedule which have not been advertised under section 14 of the repealed Ordinance (advertisement of application) before the commencement date, the applicant may give notice to the Registrar claiming to have the registrability of the mark determined in accordance with this Ordinance.

(2) The notice mentioned in subsection (1) must be in the prescribed form, be accompanied by the prescribed fee and be given no later than 6 months after the commencement date.

(3) A notice duly given under subsection (1) is irrevocable and has the effect that the application for registration is to be treated as if made immediately after the commencement date.

Trade marks registered according to old classification

12. (1) The Registrar may exercise the powers conferred by any rules made for the purposes of section 56 of this Ordinance (adaptation of entries in register to new classification) to secure that any existing registered marks which do not conform to the system of classification prescribed under section 38 of this Ordinance (classification of goods and services) are brought into conformity with that system.

(2) Subsection (1) applies, in particular, to existing registered marks classified according to the classification set out in Schedule 3 to the repealed Rules.

Claim to priority

13. Section 39 of this Ordinance (claim to priority) applies to an application for registration under this Ordinance made on or after the commencement date notwithstanding that the Convention application or WTO application concerned was made before that date.

Duration and renewal of registration

14. (1) Section 47 of this Ordinance (duration of registration) applies in relation to the registration of a trade mark in pursuance of an application made on or after the commencement date; and the old law applies in any other case.

(2) Sections 47(2) and 48 of this Ordinance (which relate to the renewal of registration) apply where the renewal falls due on or after the commencement date; and the old law continues to apply in any other case.

(3) In either case it is immaterial when the fee for renewal, if any, is paid.

Pending application for alteration of registered mark

15. An application under section 51 of the repealed Ordinance (alteration of registered trade mark) which is pending on the commencement date shall be dealt with under the old law, and any necessary alterations and entries shall be made to the new register.

Revocation for non -use

16. (1) An application made under section 37 of the repealed Ordinance (removal from register and imposition of limitations on ground of non -use) which is pending on the commencement date shall be dealt with under the old law, and any necessary alterations and entries shall be made to the new register.

(2) An application for the revocation of an existing registered mark may be made under section 50 of this Ordinance (revocation of registration) at any time on or after the commencement date, but such an application may be made only on the grounds mentioned in section 50(2)(a) or (b) of this Ordinance.

Application for rectification, etc.

17. (1) An application or request made under section 48 or 50 of the repealed Ordinance (rectification or correction of the register) which is pending on the commencement date shall be dealt with under the old law, and any necessary alterations and entries shall be made to the new register.

(2) For the purposes of proceedings under section 51 of this Ordinance (declaration of invalidity of registration), as it applies in relation to an existing registered mark, this Ordinance shall be deemed to have been in force at all material times.

(3) No objection to the validity of the registration of an existing registered mark may be taken on the ground mentioned in section 11(4) of this Ordinance (relative grounds for refusal of registration).

Regulations as to use of certification mark

18. (1) Any regulations governing the use of an existing registered certification trade mark which have been transmitted to or deposited with the Registrar under section 65 of the repealed Ordinance (application for registration as certification trade mark) shall be treated on and after the commencement date as if filed under section 6 of Schedule 2 (certification marks) to this Ordinance.

(2) Any request for amendment of the regulations which was pending on the commencement date shall be dealt with under the old law.

Certificate of validity of contested registration

19. A certificate given under section 75 of the repealed Ordinance (certificate of validity) shall have effect as if given under section 80(1) of this Ordinance (certificate of validity of contested registration).

ANNEX

[s. 1(5) of Sch. 3]

Provisions of the repealed Trade Marks Ordinance (Cap. 43)
referred to in Schedule 3 (transitional matters) and
other relevant provisions of the repealed Ordinance
(as in operation immediately before its repeal
by section 98 of this Ordinance)

2. Interpretation

(1) In this Ordinance, unless the context otherwise requires -

...

“mark” (標記) means any sign that is visually perceptible and capable of being represented graphically and may, in particular, consist of words, personal names, letters, numerals, figurative elements or combination of colours, and includes any combination of such signs;

...

“trade mark” (商標) means (except in the expressions “trade mark relating to goods”, “trade mark relating to services”, “defensive trade mark” and “certification trade mark”) a trade mark relating to goods or a trade mark relating to services;

“trade mark relating to goods” (貨品商標) means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person;

“trade mark relating to services” (服務商標) means a mark used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person;

...

(2) References in this Ordinance to-

- (a) the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;
- (b) the use of a mark in relation to goods shall be construed as references to the use of the mark upon, or in physical or other relation to, goods; and
- (c) the use of a mark in relation to services shall be construed as references to the use of the mark as or as part of any statement about the availability or performance of services or otherwise in relation to services.

(3) For the purposes of this Ordinance, goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and a description of goods and a description of services are associated with each other if it is likely that the description of goods might be sold or otherwise traded in and the description of services might be provided by the same business.

(4) References in this Ordinance to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

(5) For the purposes of this Ordinance, a person who provides services that are ancillary to a trade or business of that person may be regarded as being connected, in the course of business, with the provision of those services.

9. Trade marks registrable in Part A

(1) A trade mark (other than a certification trade mark) to be registrable in Part A of the register shall contain or consist of at least one of the following essential particulars -

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature (in other than Chinese characters) of the applicant for registration or of some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods or services, as the case may be, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, “distinctive” (顯著) means -

- (a) in the case of a trade mark relating to goods, adapted in relation to the goods in respect of which the trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected, in the course of trade, from goods in the case of which no such connection subsists; or
- (b) in the case of a trade mark relating to services, adapted in relation to the services in respect of which the trade mark is registered or proposed to be registered, to distinguish services with the provision of which the proprietor is or may be connected, in the course of business, from services with the provision of which he is not so connected,

either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -
- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10. Trade marks registrable in Part B

(1) A trade mark relating to goods to be registrable in Part B of the register must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connexion subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to the use within the extent of the registration.

(1A) A trade mark relating to services to be registrable in Part B of the register must be capable, in relation to the services in respect of which it is registered or proposed to be registered, of distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

- (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -
- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

14. Advertisement of application

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall require the applicant to advertise it, as accepted, in the prescribed manner. The advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may require an application for registration of a trade mark to be advertised by the applicant before acceptance -

- (a) if it be made under section 9(1)(e); or
- (b) in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do,

and where an application has been so advertised the Registrar may, if he thinks fit, require the applicant to advertise it again when it has been accepted but shall not be bound so to do.

15. Opposition to registration

(1) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(2) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of the notice to the applicant, and, within the prescribed time after the receipt thereof, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(4) If the applicant sends such a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner, and on the appeal the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section any party may, either in the prescribed manner or by special leave of the Court, bring forward further material for the consideration of the Court.

(8) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as hereinbefore provided, except by leave of the Court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) On an appeal under this section the Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of the notice, or an appellant, neither resides nor carries on business in Hong Kong, the tribunal may require him to give security for costs of the proceedings before it relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

16. Registration subject to disclaimer

(1) If a trade mark contains any part not separately registered by the proprietor as a trade mark or if -

- (a) in the case of a trade mark relating to goods it contains matter common to the trade or otherwise of a non-distinctive character; or
- (b) in the case of a trade mark relating to services it contains matter common to the provision of services of that description or otherwise of a non-distinctive character,

the Registrar or the Court, in deciding whether such trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register -

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or of all or any portion of any such matter, to the exclusive use of which the tribunal holds him not to be entitled; or
- (ii) that he shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under such registration.

(2) No disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

19. Jointly owned trade marks relating to goods

Where the relations between 2 or more persons interested in a trade mark relating to goods are such that no one of them is entitled as between himself and the other or others of them to use it except -

- (a) on behalf of both or all of them; or
- (b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Ordinance shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

19A. Jointly owned trade marks relating to services

Where the relations between 2 or more persons interested in a trade mark relating to services are such that no one of them is entitled as between himself and the other or others of them to use it except -

- (a) on behalf of both or all of them; or
- (b) in relation to services with the provision of which both or all of them are connected in the course of business,

those persons may be registered as joint proprietors of the trade mark, and this Ordinance shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

22. Concurrent use

In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or of the Registrar make it proper to do so, the Court or the Registrar may permit the registration by more than one proprietor, in respect of -

- (a) the same goods or services;
- (b) the same description of goods or services; or
- (c) goods and services or descriptions of goods and services which are associated with each other,

of trade marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

24. Associated trade marks

(1) Where a trade mark relating to goods that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of -

- (a) the same goods or description of goods; or
- (b) services that are associated with those goods or goods of that description,

or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(1A) Where a trade mark relating to services that is registered, or is the subject of an application for registration, in respect of any services is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of -

- (a) the same services or description of services; or
- (b) goods that are associated with those services or services of that description,

or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(2) On application made in the prescribed manner by the registered proprietor of 2 or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered, and he may amend the register accordingly.

(3) Any decision of the Registrar under the provisions of subsections (1), (1A) and (2) shall be subject to appeal to the Court.

25. Combined trade marks

(1) If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the whole and any such part as separate trade marks. Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to the provisions of subsection (2) hereof and section 38(2), have all the incidents of an independent trade mark.

(2) Where a trade mark and any part or parts thereof are thus registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

26. Series of trade marks

(1) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or services or the same description of goods or services, seeks to register those trade marks and the trade marks, while resembling each other in the material particulars thereof, differ in respect of -

- (a) statements of the goods or services in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

the trade marks may be registered as a series in one registration.

(2) All trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

37. Removal from register and imposition of limitations on ground of non-use

(1) Subject to the provisions of sections 55(1), 55A(1) and 57(1), a registered trade mark may be taken off the register in respect of any of the goods or services in respect of which it is registered on application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of section 80, to the Registrar, on the ground either -

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, if it was registered under section 18(1), by the corporation or registered user concerned, and that there has in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of 5 years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being.

(1A) Subject to subsection (1C), the tribunal may refuse an application made under subsection (1)(a) or (b) in relation to any goods if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by the proprietor thereof for the time being in relation to -

- (a) goods of the same description; or
- (b) services associated with those goods or goods of that description, being goods or, as the case may be, services in respect of which the trade mark is registered.

(1B) Subject to subsection (1C), the tribunal may refuse an application made under subsection (1)(a) or (b) in relation to any services if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by the proprietor thereof for the time being in relation to -

- (a) services of the same description; or
- (b) goods associated with those services or services of that description,

being services or, as the case may be, goods in respect of which the trade mark is registered.

(1C) Subsections (1A) and (1B) do not apply where the applicant has been permitted under section 22 to register an identical or nearly resembling trade mark in respect of the goods or services in question or where the tribunal is of the opinion that he might properly be permitted so to register such a trade mark.

(2) Where in relation to any goods in respect of which a trade mark is registered -

- (a) the matters referred to in subsection (1)(b) are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in Hong Kong (otherwise than for export from Hong Kong), or in relation to goods to be exported to a particular market outside Hong Kong; and
- (b) a person has been permitted under section 22 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in Hong Kong (otherwise than for export from Hong Kong), or in relation to goods to be exported to that market, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the Court or, at the option of the applicant and subject to the provisions of section 80, to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as the tribunal thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

(2A) Where in relation to any services in respect of which a trade mark is registered -

- (a) the matters referred to in subsection (1)(b) are shown so far as regards non-use of the trade mark in relation to services for use

- or available for acceptance in Hong Kong, or for use in a country or territory outside Hong Kong; and
- (b) a person has been permitted under section 22 to register an identical or nearly resembling trade mark in respect of those services under a registration extending to use in relation to services for use or available for acceptance in Hong Kong or for use in that country or territory, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the Court or, at the option of the applicant and subject to section 80, to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as the tribunal thinks proper for securing that the registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely for the purposes of subsection (1)(b), (2) or (2A) on any non-use of a trade mark -

- (a) in relation to particular goods that is shown to have been due to special circumstances in the trade; or
- (b) in relation to particular services that is shown to have been due to special circumstances affecting the provision of those services,

and not to any intention not to use or to abandon the trade mark in relation to the goods or services to which the application relates.

43. Registration of assignments and transmissions

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(3) Except for the purposes of an appeal under this section or of an application under section 48, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) shall not be admitted in evidence in any Court in proof of the title to a trade mark unless the Court otherwise directs.

48. General power to rectify entries in register

(1) Subject to the provisions of this Ordinance -

- (a) any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of section 80, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think fit;
- (b) the tribunal may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register;
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section;
- (d) any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(2) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

49. Power to expunge or vary registration for breach of condition

On application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of section 80, to the Registrar, or on application by the Registrar to the Court, the tribunal may make such order as the

tribunal may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

50. Correction of register

(1) The Registrar may, on request made in the prescribed manner by the registered proprietor -

- (a) correct any error in the name and address of the registered proprietor of a trade mark; or
- (b) enter any change in the name and address of the person who is registered as proprietor of a trade mark; or
- (c) cancel the entry of a trade mark on the register; or
- (d) strike out any goods or services or classes of goods or services from those in respect of which a trade mark is registered; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

(2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name and address of the registered user.

(3) Any decision of the Registrar under this section shall be subject to appeal to the Court.

51. Alteration of registered trade mark

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse such leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

56. Defensive trade marks to be registered as associated trade marks

A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods or services, be deemed to be, and shall be registered as, associated trade marks.

58. Registration as a registered user.

Meaning of "permitted use"

(1) (a) Subject to the provisions of this section and sections 59 to 63, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

(b) The use of a trade mark by a registered user of the trade mark in relation to -

(i) goods with which he is connected in the course of trade; or

(ii) services with the provision of which he is connected in the course of business,

and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his

registration is subject, is in this Ordinance referred to as the “permitted use” of the trade mark.

- (2) (a) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 37 and for any other purpose for which such use is material under this Ordinance or at common law.
- (b) Where a person is registered as a registered user of a trade mark relating to goods on an application made within one year from the commencement of this Ordinance, this subsection shall have effect in relation to any previous use (whether before or after the commencement of this Ordinance) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

(3) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner, and must furnish him with a statutory declaration made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar -

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods or services in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,

and with such further documents, information or evidence as may be required under the rules or by the Registrar.

(4) When the requirements of subsection (3) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods or services as to which he is so satisfied subject as aforesaid.

(5) The Registrar shall refuse an application under the provisions of subsections (1) to (3) if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(6) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the provisions of subsections (1) to (3) (other than matter entered in the register) is not disclosed -

- (a) in the case of an application for registration in respect of goods, to rivals in the trade; or
- (b) in the case of an application for registration in respect of services, to rivals in the business.

59. Proceedings for infringement

(1) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within 2 months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(2) A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

60. Variation or cancellation of registration as a registered user

(1) Without prejudice to the provisions of section 48, the registration of a person as a registered user -

- (a) may be varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say -
 - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
 - (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration; or
 - (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(2) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered.

62. Registrar's decision subject to appeal to Court

Any decision of the Registrar under sections 58 and 60 shall be subject to appeal to the Court.

63. Right to use not assignable or transmissible

Nothing in sections 58, 59 and 60 shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

64. Marks registrable as certification trade marks

(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(1A) A mark adapted in relation to any services to distinguish in the course of business services certified by any person in respect of quality, accuracy or other characteristic, from services not so certified, shall be registrable as a certification trade mark in Part A of the register in respect of those services in the name, as proprietor of the certification trade mark, of that person:

Provided that a mark shall not be so registrable in the name of a person who is connected in the course of business with the provision of services of the kind certified.

(2) In determining whether a mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which -

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods or services in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods or services in question.

(3) The fact that a mark consists of signs or indications which may serve, in trade, to designate the geographical origin of goods or services shall not preclude

it from being registered as a certification trade mark in Part A of the register in respect of those goods or services.

(4) Nothing in this Ordinance shall entitle the proprietor of a certification trade mark that consists of signs or indications described in subsection (3) to interfere with or restrain the use by any person of any signs or indications the use of which is in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

65. Application for registration as certification trade mark

(1) An application for the registration of a mark under section 64 shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of section 13(2) and of section 13(4) to (7) shall have effect in relation to an application under this section as they have effect in relation to an application under section 13(1).

(3) In dealing under the said provisions with an application under this section the tribunal shall have regard to the like considerations, so far as relevant, as if the application were an application under section 13 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under this section shall transmit to the Registrar draft regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorize the use of the trade mark, and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorize the use of the trade mark in accordance with the regulations). The regulations, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the register.

(5) The Registrar shall consider the application with regard to the following matters -

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
- (b) whether the draft regulations are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either -

- (i) refuse to accept the application; or
- (ii) accept the application, and approve the regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he may think requisite having regard to any of the matters aforesaid;

but, except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard:

Provided that the Registrar may, at the request of the applicant, consider the application with regard to any of the matters aforesaid before the application has been accepted, so however that the Registrar shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft regulations.

(6) Any decision of the Registrar under this section shall be subject to appeal to the Court.

75. Certificate of validity

In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

76. Trade usage, etc., to be considered

(1) In any action or proceeding relating to a trade mark relating to goods or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark relating to goods or trade name or get-up legitimately used by other persons.

(2) In any action relating to a trade mark relating to services or business name, the tribunal shall admit evidence of business usages in the provision of services in question and of any relevant trade mark relating to services or business name or get-up legitimately used by other persons.

92. Transitional provisions relating to the Intellectual Property (World Trade Organization Amendments) Ordinance 1996

(1) In this section -

“existing registered trade mark” (現行註冊商標) means a trade mark, certification trade mark or defensive trade mark that is registered under this Ordinance before the commencement of the new law;

“new law” (新法律) means sections 18 to 25 of the Intellectual Property (World Trade Organization Amendments) Ordinance 1996 (11 of 1996);

“old law” (舊法律) means this Ordinance and any other enactment or rule of law applying to existing registered trade marks immediately before the commencement of the new law.

(2) An application for the registration of a trade mark (including certification trade marks and defensive trade marks), as defined in this Ordinance before the commencement of the new law, shall be treated as pending on the commencement of the new law if the application had been made but had not been finally determined before that commencement.

(3) Sections 27(1), 27A(1) and 67A(1), as amended by the new law, shall apply in relation to an existing registered trade mark as from the commencement of the new law but only in so far as those sections relate to an infringement of an existing registered trade mark that is committed on or after the commencement of the new law; and the old law shall continue to apply in relation to an infringement that is committed before the commencement of the new law.

(4) Despite subsection (3), it is not an infringement of -

(a) an existing registered trade mark; or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered trade mark and which is registered for the same goods or services,

to continue on or after the commencement of the new law any use that did not, under the old law, constitute an infringement of the existing registered trade mark.

(5) Subject to subsection (6), an application for the registration of a trade mark that is pending on the commencement of the new law shall be dealt with under the old law but, if the trade mark is registered, it shall be treated for the purposes of subsections (1) to (4) as an existing registered trade mark.

(6) If an application for the registration of a trade mark that is pending on the commencement of the new law has not been advertised under section 14 before its commencement, the applicant may give notice to the Registrar electing to have the registrability of the mark determined in accordance with this Ordinance, as amended by the new law.

(7) A notice under subsection (6) must be in the prescribed form, be accompanied by the appropriate fee and be given to the Registrar not later than 6 months after the commencement of the new law.

(8) A notice given under subsection (6) is irrevocable and has the effect that the application shall be treated as if it had been made after the commencement of the new law.

(9) An application made under section 48 that is pending on the commencement of the new law shall be dealt with in accordance with the old law.

Specification of Public Offices

1. Schedule amended

The Schedule to the Specification of Public Offices (L.N. 343 of 1998) (Cap. 1 sub. leg.) is amended by repealing -

<p>“Director of Intellectual Property as Registrar of Trade Marks</p>	<p>Trade Marks Ordinance (Chapter 43). Trade Marks Rules (Chapter 43 subsidiary legislation). Trade Marks (Emergency) Ordinance (Chapter 263). Trade Marks (Emergency) Rules (Chapter 263 subsidiary legislation).”</p>
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and substituting -

<p>“Director of Intellectual Property as Registrar of Trade Marks</p>	<p>Trade Marks Ordinance (of 1999). Trade Marks Rules (L.N. of 1999).”.</p>
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The Rules of the High Court

2. Appeals and applications under the Trade Marks Ordinance

Order 100, rule 2 of the Rules of the High Court (Cap. 4 sub. leg.) is amended -

- (a) in paragraph (1), by repealing “the Trade Marks Ordinance (Cap. 43)” and substituting “the Trade Marks Ordinance (of 1999)”;
- (b) by repealing paragraph (6).

Pesticides Ordinance

3. Trade marks, trade descriptions, patents and copyright not affected

Section 20 of the Pesticides Ordinance (Cap. 133) is amended by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”.

Solicitors (Trade Marks and Patents) Costs Rules

4. Interpretation

Rule 2 of the Solicitors (Trade Marks and Patents) Costs Rules (Cap. 159 sub. leg.) is amended -

- (a) in paragraph (1), in the definition of “register”, by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”;
- (b) in paragraph (2), by repealing “Trade Marks Ordinance (Cap. 43) and the Trade Marks Rules (Cap. 43 sub. leg.)” and substituting “Trade Marks Ordinance (of 1999) and the Trade Marks Rules (L.N. of 1999)”.

Federation of Hong Kong Industries Ordinance

5. Powers of Federation

Section 6(ea) of the Federation of Hong Kong Industries Ordinance (Cap. 321) is amended by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”.

Trade Descriptions Ordinance

6. Interpretation

Section 2(1) of the Trade Descriptions Ordinance (Cap. 362) is amended -

(a) by repealing the definition of “Convention country” and substituting -

““Convention country” (公約國家) means a Paris Convention country or WTO member as defined in section 2(1) of the Trade Marks Ordinance (of 1999);”;

(b) by repealing the definition of “trade mark” and substituting -

““trade mark” (商標) means -

(a) a trade mark relating to goods registered or deemed to be registered in Hong Kong under the Trade Marks Ordinance (of 1999);

(b) a certification mark or collective mark relating to goods registered or deemed to be registered in Hong Kong under the Trade Marks Ordinance (of 1999);

(c) a trade mark -

(i) registered in a Convention country; and

(ii) capable of registration in Hong Kong under the Trade Marks Ordinance (of 1999) as a trade mark relating to goods;

(d) a trade mark -

(i) in respect of which an application for registration has been made in a Convention country; and

(ii) capable of registration in Hong Kong under the Trade Marks Ordinance (of 1999) as a trade mark relating to goods; and

(iii) in respect of which a period of 6 months has not expired since the date of the application for the registration thereof in a Convention country.”;

(c) by adding -

““forged trade mark” (偽造商標) has the meaning assigned to it by section 9(3);

“infringing goods” (侵犯權利貨品) means goods to which -

- (a) a forged trade mark is applied; or
- (b) a trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied;

“mark” (標記), when used as a noun, includes a sign capable of distinguishing the goods of one undertaking from those of other undertakings;”.

7. Applying a trade description, trade mark or mark to goods

Section 6(1) (a) and (b) is repealed and the following substituted -

- “(a) weaves it in, impresses it on, works it into, affixes or annexes it to, or in any manner marks it on or incorporates it with -
- (i) the goods themselves; or
 - (ii) anything in, on or with which the goods are supplied;
- (b) places the goods in, on or with anything which the trade description or trade mark or mark has been woven in, impressed on, worked into, affixed or annexed to, marked on or incorporated with, or places any such thing with the goods;”.

8. Sections added

The following are added -

“9A.Offences in respect of certain goods and

articles made outside Hong Kong

(1) Subject to the provisions of this Ordinance, any person who makes outside Hong Kong, for export to Hong Kong, any goods which would, if the goods were made in Hong Kong, constitute infringing goods, commits an offence unless he proves that he acted without intent to defraud the owner of the trade mark or any purchaser of the goods in Hong Kong.

(2) Subject to the provisions of this Ordinance, any person who makes outside Hong Kong any die, block, machine or other instrument for the purpose of -

(a) forging, or being used for forging, a trade mark in Hong Kong;

or

(b) producing infringing goods in Hong Kong, commits an offence unless he proves that he did not know and had no reason to suspect that it would be used or was intended to be used in Hong Kong for that purpose.”.

9. Prohibited import and export of certain goods

Section 12(1) is amended by repealing “,which expression shall be construed in accordance with section 9(3),”.

10. Disclosure of information, etc.

Section 16C(1), (2) and (3) is amended by repealing “proprietor” and substituting “owner”.

11. Penalties

Section 18(1) is amended -

(a) by adding “9A,” before “10,”;

(b) in paragraph (a), by repealing “5 years” and substituting “8 years”.

12. Section substituted

Section 30A is repealed and the following substituted -

“30A.Interpretation

In this Part, “detention order” (扣留令) means an order made under section 30C(1).”.

13. Application for detention order

Section 30B(1), (3) and (4) is amended by repealing “proprietor” wherever it appears and substituting “owner”.

14. Issuance of detention order

Section 30C(1), (2) and (6) is amended by repealing “proprietor” and substituting “owner”.

15. Enforcement of detention order

Section 30D is amended -

- (a) in subsections (2), (3), (4), (5) (a), (6), (7), (8) and (9), by repealing “proprietor” wherever it appears and substituting “owner”;
- (b) in subsection (6), by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”;
- (c) in subsection (9), by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”.

16. Variation or setting aside of detention order

Section 30E(1) and (6) is amended by repealing “proprietor” wherever it appears and substituting “owner”.

17. Disclosure of information

Section 30F(1) and (2) is amended by repealing “proprietor” and substituting “owner”.

18. Inspection of goods, release of samples, etc.

Section 30G is amended -

- (a) in subsection (1) -
 - (i) in paragraph (a), by repealing “proprietor” and substituting “owner”;
 - (ii) in paragraph (b), by repealing “proprietor’s” and substituting “owner’s”;
- (b) in subsections (2) and (4), by repealing “proprietor” wherever it appears and substituting “owner”.

19. Costs payable

Section 30H is amended by repealing “proprietor” where it twice appears and substituting “owner”.

20. Compensation payable to importer, etc.

Section 30J(2) (b) is amended by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”.

21. Trade marks containing trade descriptions

Section 32 is amended -

- (a) by repealing paragraph (b) and substituting -

- “(b) that the trade mark as applied is used to indicate such a connection between the goods and the owner of the trade mark or a person licensed to use the trade mark; and”;
- (b) in paragraph (c), by adding “or owner” after “proprietor” where it twice appears.

Trade Mark (Border Measures) Rules

22. Application for detention order

Rule 6 of the Trade Mark (Border Measures) Rules (Cap. 362 sub. leg.) is amended -

- (a) in subrule (2), by repealing “proprietor” and substituting “owner”;
- (b) in subrule (3), by repealing “proprietor’s” and substituting “owner’s”;
- (c) in subrule (4) -
 - (i) in paragraphs (a) and (b), by repealing “proprietor’s” and substituting “owner’s”;
 - (i) in paragraph (c), by repealing “proprietor” and substituting “owner”;
- (d) in subrule (5), by repealing “A proprietor” and substituting “An owner”.

23. Application for directions

Rule 7(2) is amended by repealing “proprietor” and substituting “owner”.

24. Application to extend period of detention

Rule 8(2) is amended by repealing “A proprietor” and substituting “An owner”.

25. Provision of security, etc.

Rule 12 is amended -

- (a) by repealing “a proprietor” and substituting “an owner”;
- (b) by repealing “the proprietor” and substituting “the owner”.

26. Service of documents on Commissioner

Rule 13(1) is amended by repealing “Trade Marks Ordinance (Cap. 43)” and substituting “Trade Marks Ordinance (of 1999)”.

**27. Service of documents by Commissioner
or authorized officers**

Rule 14(1) (a) is amended by repealing “proprietor” and substituting “owner”.

Smoking (Public Health) Ordinance

28. Interpretation

Section 2 of the Smoking (Public Health) Ordinance (Cap. 371) is amended, in the definition of “trade mark”, by repealing “section 2 of the Trade Marks Ordinance (Cap. 43)” and substituting “section 3 of the Trade Marks Ordinance (of 1999)”.

Explanatory Memorandum

The purpose of this Bill is to modernize Hong Kong’s trade marks law, taking into account recent international developments in the

protection of intellectual property rights. The Bill provides for enhanced protection to trade marks owners and simplifies the application and maintenance procedures for registered trade marks.

Part I - Preliminary

2. Part I deals with preliminary matters.
3. Clause 1 sets out the short title and empowers the Secretary for Trade and Industry to bring the Ordinance into operation on a date or dates to be appointed by him.
4. Clauses 2 to 8 set out the main definitions and interpretative provisions. A “trade mark” is defined in clause 3 to mean any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically. The new definition will permit a wider range of trade marks to be registered than previously.

Part II - Registered trade marks

5. Part II describes the rights conferred by the registration of a trade mark and the grounds on which registration may be refused.
6. Clause 9 is an introductory clause. Among other matters, it provides that a registered trade mark is a property right.
7. Clauses 10 and 11 set out the grounds on which registration may be refused.
8. Clause 12 provides an exception for honest concurrent use.
9. Clause 13 provides that the owner of a registered trade mark has exclusive rights in the trade mark.

10. Clause 14 permits an applicant or the owner of a registered trade mark to disclaim any of those rights.

Part III - Infringement of registered trade marks

11. Part III deals with the infringement of registered trade marks and provides for various remedies.

12. Clauses 15 and 16 are interpretative provisions. Among other matters, they define the meaning of “infringing goods”, “infringing materials” and “infringing articles”.

13. Clause 17 describes the acts which constitute infringing acts and which are thus actionable by the owner of a registered trade mark.

14. Clause 18 sets out a number of exceptions to what otherwise might constitute an infringing act. These include, for example, the use by a person of his own name or address or the use of signs to indicate kind, quality or quantity. Such use must be in accordance with honest practices in industrial or commercial matters. Clause 19 deals with the issue of exhaustion of rights.

15. Clauses 20 to 23 set out the remedies which may be claimed by the registered owner in proceedings for the infringement of a registered trade mark, including damages, injunctions and orders for the delivery up to the registered owner and for the disposal of infringing goods, material and articles.

16. Clause 24 provides a civil remedy to a person who is threatened with infringement proceedings if the threats are not well-grounded.

Part IV - Registered trade marks as objects of property

17. Part IV deals with various aspects of registered trade marks as objects of property.
18. Clause 25 provides that a registered trade mark is personal property and that it is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal property.
19. Clause 26 deals with the co-ownership of registered trade marks.
20. Clause 27 deals with the registration of transactions affecting rights in registered trade marks, the rights of third parties and related matters (for example, the assignments of trade marks and the granting of licences and security interests).

Part V - Licensing of registered trade marks

21. Part V (clauses 30 to 35) deals with the licensing of registered trade marks. Among other matters, it describes the circumstances in which licensees may bring infringement proceedings.

Part VI - Application and registration procedures

22. Part VI sets out the procedures relating to the registration of trade marks.
23. Clause 36 sets out the requirements for an application for registration of a trade mark.
24. Clause 37 sets out a rule for determining the filing date of an application.
25. Clause 38 provides for the classification of goods and services for registration purposes.

26. Clause 39 provides for priority to be given to applications first filed in a Paris Convention country or a World Trade Organization member.
27. Clauses 40 and 41 deal with the examination of applications by the Registrar and the publication of applications.
28. Clauses 42 to 44 deal with opposition proceedings, the withdrawal or restriction of applications and the amendment of applications.
29. Clause 45 deals with the procedure for the registration of trade marks.
30. Clause 46 provides for trade marks to be registered as of the filing date of the application for registration.
31. Clause 47 provides that a trade mark shall be registered for a term of 10 years. A registration may be renewed for further periods of 10 years in accordance with clause 48.
32. Clause 49 authorizes rules to be made in connection with the division of applications for registration, the merging of separate applications and registrations and the registration of series of trade marks.

Part VII - Proceedings affecting registration

33. Part VII deals with various proceedings affecting the registration of a trade mark including proceedings for -
 - (a) the revocation of a registration (clause 50);
 - (b) a declaration of invalidity of a registration (clause 51);
 - (c) the variation of a registration (clause 52);
 - (d) the alteration of registered trade marks (clause 53);
 - (e) the surrender of registered trade marks (clause 54);

- (f) the rectification or correction of the register (clause 55); and
- (g) the adaptation of entries in the register to any new classification (clause 56).

34. Clause 57 deals with the effect of acquiescence to the use of a registered trade mark by the owner of an earlier trade mark.

Part VIII - Defensive trade marks, collective marks and certification marks

35. Part VIII provides for the registration of defensive trade marks, collective marks and certification marks.

36. Clause 58 provides for well-known registered trade marks to be registered as defensive trade marks. A trade mark may be registered as a defensive trade mark in relation to any goods or services, whether or not the trade mark is used in relation to those goods or services.

37. Clause 59 defines the meaning of “collective mark” and provides that the Ordinance shall apply to collective marks in the manner and to the extent provided by Schedule 1 to the Bill.

38. Clause 60 defines the meaning of “certification mark” and provides that the Ordinance shall apply to certification marks in the manner and to the extent provided by Schedule 2 to the Bill.

Part IX - The Paris Convention and the World Trade Organization Agreement: supplementary provisions

39. Part IX (clauses 61 to 64) contains supplementary provisions relating to the Paris Convention for the Protection of Industrial

Property and the World Trade Organization Agreement. Among other matters, Part IX provides for the protection of -

- (a) well-known trade marks (clause 61);
- (b) national flags, armorial bearings and other state emblems (clause 62);
and
- (c) flags, armorial bearings and emblems of international organizations (clause 63).

Part X - Administrative and other supplementary provisions

40. Part X deals with administrative and other supplementary matters, including -

- (a) the keeping of the register of trade marks and the right to inspect the register and make copies of entries (clauses 65 to 67);
- (b) the powers and duties of the Registrar of Trade Marks, including the power to provide preliminary advice and to specify a journal of record (clauses 68 to 74);
- (c) various procedural and legal matters, including the language of proceedings, the application of the rules of evidence and other evidentiary matters, the right of appeal, the powers of the court and the cost of proceedings (clauses 75 to 86); and
- (d) miscellaneous matters, including the recognition of agents, the hours of business of the Trade Marks Registry and the Government's right to sell forfeited articles (clauses 87 to 89).

Part XI - Subsidiary legislation

41. Clause 90 authorizes the Registrar to make rules for the purposes of the Ordinance.
42. Clause 91 authorizes the Chief Executive in Council to make regulations designating Paris Convention countries and World Trade Organization members and to amend Schedules 1 and 2 to the Ordinance (which deal with collective marks and certification marks).

Part XII - Offences

43. Part XII (clauses 92 to 95) sets out the offences, including offences related to -
 - (a) the falsification of the register;
 - (b) the false representation that a trade mark is registered; and
 - (c) the misuse of the title “Trade Marks Registry”.

Part XIII - Transitional provisions, consequential and related amendments and repeals

44. Clause 96 and Schedule 3 to the Bill deal with transitional matters.
45. Clause 97 and Schedule 4 to the Bill make consequential and related amendments to other Ordinances.
46. Clause 98 repeals the Trade Marks Ordinance (Cap. 43), the Trade Marks Rules (Cap. 43 sub. leg.), the Trade Marks (Emergency) Ordinance (Cap. 263) and the Trade Marks (Emergency) Rules (Cap. 263 sub. leg.).