

Bills Committee on Trade Marks Bill

**Comparison between the existing and the proposed time limits and extensions of time for trade mark applications
(as requested by the Bills Committee at its meeting on 26 February 2000)**

Subject Matter	Trade Marks Ordinance (Cap. 43) Trade Marks Rules (Cap. 43 sub. leg. A)			Trade Marks Bill Trade Marks Rules (Draft 2)		
	Section/Rule	Time Limit	Extensible?	Clause/Rule	Time Limit	Extensible?
Claim to priority	S.13A	Any person who has applied for trade mark protection in a Convention country (defined to include Paris Convention country and WTO member) shall be entitled to registration of his trade mark in Hong Kong in priority to other applicants, and the registration shall have same date as the Convention country application, if the Hong Kong application is made within 6 months from the date of first application for protection in a Convention country.	×	Cl.39(1), (2)	A person who has filed an application for registration of a trade mark in or, in respect of, a Paris Convention country or WTO member shall enjoy a right of priority for up to 6 months if the Hong Kong application is made within 6 months from the date of filing of the first of any such applications.	×
	N/A	N/A (no provision for the time limit in filing certificate)	N/A	Rule 9(2)	Applicant shall file a certificate, issued by the competent authority of each country for which a right of priority is claimed, within 3 months after filing application.	√ Rule 65(1)

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Examination of application	Rules 18, 19(1B)	Applicant shall file an application for a hearing or a considered reply to the Registrar's objection to the application within 6 months from date of receipt of the objection; or if the Registrar accepts the applications subject to conditions, amendments, disclaimers, or limitations, the applicant shall file within 6 months a notice of its acceptance or objection.	√ Rule 91	Cl. 36, 40(3), (4), and Rule 10 Cl. 40(3), (4), Rule 11	Applicant shall remedy deficiencies in satisfying the requirements of Cl. 36 of the Bill, Rules 7, 8(1) or (3) within 2 months after Registrar's notice. Applicant shall satisfy the Registrar that the requirements for registration are met or shall amend his application so as to meet the requirements within 6 months after Registrar's notice.	× Rule 65(3)(a) √ Rule 65(1)
Publication of particulars of application	N/A	No statutory time limit to advertise. In practice, Registrar will give notice of non-completion of registration to applicant after 6 months from the date of leave to advertise, and applicant is required to advertise or call for hearing within 1 month from date of receipt of such notice pursuant to section 17(4), Rule 38(1) and Rule 86.	N/A	Rules 12(2), (3)	Where Registrar accepts an application for registration, applicant shall cause particulars to be published. If applicant fails to do so within 3 months, Registrar may give notice of compliance. If applicant fails to comply within 1 month, the application shall be treated as abandoned.	√ Rule 65(1)
Opposition to	Rule 23	Where applicant is required to	√	Rule 20(5)	Where applicant is required to	√

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amendment of application after publication		publish the amendment, procedure and time limits under "Opposition Proceedings" below apply.	Rule 91	Rule 20(6)	publish the amendment, any person may file notice of opposition to the amendment within 1 month after such publication. Thereafter, other time limits in opposition proceedings in Rule 14 to 16 and Rule 52 apply here but no cooling off period ¹ (see below).	Rule 65(1)
Opposition Proceedings	S.15	(time limits stated in rules below)		Cl.42	(time limits stated in rules below)	
(i) Notice of Opposition	Rule 23	Any person may file notice of opposition within 2 months from date of advertisement.	√ Rule 91	Rule 13(1)	Any person may file notice of opposition within 3 months from date of advertisement.	× Rule 65(3)(b)
(ii) Counter-statement	Rule 24	Applicant shall file counter-statement within 2 months from date of receipt of notice of opposition.	√ Rule 91	Rule 14(1)	Subject to cooling-off period if applicable (see below), applicant shall file counter-statement within 3 months from date of receipt of notice of opposition.	× Rule 65(3)(c)
(iii) Cooling off period	N/A	(No cooling off period)	N/A	Rule 14(2)	Registrar may grant "cooling off period" of 3 months with	× Rule

¹ Refined subsequent to Draft 2 of 8.2.2000

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(iv) Evidence	N/A	N/A	N/A	Rule 14(3)	consent of both parties and before expiry of time for filing counter-statement. Registrar may grant an extension of a further 3 months to the cooling off period if both parties consent.	65(3)(d)
	Rule 25	Opponent shall file evidence within 6 months from date of receipt of counter-statement.	√ Rule 91	Rule 15(1)	Applicant shall file counter-statement within 1 month after expiry of cooling off period.	× Rule 65(3)(c)
	Rule 26	Applicant shall file evidence within 6 months from date of receipt of opponent's evidence.	√ Rule 91	Rule 15(3)	Opponent shall file evidence within 6 months from date of receipt of counter-statement.	√ Rule 65(1)
	Rule 27	Opponent may file evidence in reply within 6 months from date of receipt of applicant's evidence.	√ Rule 91	Rule 15(4)	Applicant shall file evidence within 6 months from date of receipt of opponent's evidence.	√ Rule 65(1)
(v) Opposition hearing	Rule 30(2)	The date for hearing argument shall be at least 14 days after the date of receipt of the notice by	N/A	Rule 52(2)	Registrar shall give the party at least 14 days' notice of the time when he may be heard unless he	N/A

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	Rule 30(3)	the parties unless the parties consent to shorter notice. Any party who intends to appear shall give notice within 7 days from date of receipt of Registrar's notice of hearing, failing which he may be treated as not desiring to be heard.	N/A	Rule 16(1)	consents to shorter notice. Any party who intends to appear shall give notice within 14 days after date of receipt of Registrar's notice of hearing, failing which such party may be treated as not desiring to be heard.	N/A
Case management conference	N/A	N/A (no such provision)	N/A	Rule 61	Registrar shall give the parties at least 14 days' notice of the date of case management conference.	N/A
Pre-hearing review	N/A	N/A (no such provision)	N/A	Rule 62	Registrar shall give the parties at least 7 days' notice of the date of pre-hearing review.	N/A
Hearing (other proceedings)						
(i) Application and	Rule 87	A person's request for a hearing	N/A	Rule 52	Registrar shall give the party	N/A

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notice		shall be filed within 1 month from receipt of Registrar's proposal to exercise adversely to that person any discretionary power under the Ordinance and Rules (except hearings for registrability where applicant can reply or call for hearing within 6 months under Rules 18 and 19(1B)).			that may be adversely affected by his decision, an opportunity to be heard.	
(ii) Notice of hearing and intention to attend	Rule 88(1)	Registrar shall give the party not less than 10 days' notice of a hearing.	N/A	Rule 52(2)	Registrar shall give the party at least 14 days' notice of a hearing.	N/A
	Rule 88(2)	A person intends to be heard shall file notice of intention within 5 days from date of receipt of hearing notice, failing which he may be treated as not intending to be heard.	N/A	N/A	Except for opposition hearing (see above), no specified time limit for filing notice of intention to be heard.	N/A
(iii) Language of hearings	N/A	(no such provision)	N/A	Rule 55	Any party who intends to use a language other than the language of proceedings must give at least 10 days' notice to Registrar and the other parties.	N/A
Request for written grounds of Registrar's decision	Rule 20(2)	Applicant may request written grounds for Registrar's decision in a registrability hearing within 3 months from the decision.	√ Rule 91	Rule 63(3)	Where a statement of the reasons is not included in Registrar's written notice of decision, any party may request a statement of	√ Rule 65(1)

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		(For opposition hearings, decision will be issued together with grounds.)			reasons for the decision within 1 month after the notice. (This is not applicable to opposition proceedings where Registrar shall under R18 send the parties written notice of decision with reasons for his decision.)	

Trade and Industry

April 2000

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