



CB(1) 1093/02-03

HONG KONG BAR ASSOCIATION

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5th March 2003

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Legislative Council
Legislative Council Building
8 Jackson Road, Central
Hong Kong

Attn: S.C. Tsang
for Clerk to Subcommittee

Dear Sir,

Subcommittee on Trade Marks Rules and Trade Marks Ordinance (Cap. 559) (Commencement) Notice 2003

I refer to your letter dated 25th February 2003. Please be informed that we have no further comments on the above captioned following our views submitted to the Intellectual Property Department dated 18th October 2002. (enclosed)

Yours sincerely,

Edward Chan, SC
Chairman

/al

香港大律師公會

香港金鐘道三十八號高等法院低層二樓

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19th October 2002

Intellectual Property Department
25/F Wu Chung House
213 Queen's Road East
Hong Kong

Attn: Mr. Stephen Selby
Director of Intellectual Property

Dear Sir,

Consultation on Trade Marks Rules (4th Draft)

Thank you for your letter dated 18th September 2002. I am pleased to enclose herewith the comments of the Taskforce of Intellectual Property on Trade Marks Rules (4th Draft) for your consideration.

Yours faithfully,

Alan Leong, S.C.
Chairman

Encl.

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HONG KONG BAR ASSOCIATION

COMMENTS FROM THE TASKFORCE OF INTELLECTUAL PROPERTY

ON THE TRADE MARKS RULES (4TH DRAFT)

A. Opposition to Registration (Part 3)

1. Rules 16, 17 and 95: Non-extendible 3-month Time Limit for Filing a Notice of Opposition and a Counter Statement in Opposition Proceedings

- We maintain the views given in the Bar's comments on the Trade Mark Rules (3rd Draft) dated 9th July 2001.
- In our view, there should be a 2 month period for filing a notice of opposition and a counter statement respectively, with a discretion to extend such time limit in exceptional circumstances.

2. Rules 18, 19 and 20: Extendible 6-month Time Limit for Filing Evidence in Opposition Proceedings

- The existing proposal allows a total period of 18 months for filing evidence (assuming that there are no time extensions involved). Taking into account the suggested 3 months for filing the notice of opposition and another 3 months for filing the counter statement respectively, it would take more than 2 years before the opposition can be heard.
- Our trade mark registration system should be efficient as well as competitive when compared to those adopted in other countries or territories.
- We believe that it is too generous to allow an extendible period of 6 months for filing evidence under rules 18, 19 and 20 respectively in opposition proceedings. As in England, it should be sufficient to have 3 months for filing evidence in support of an opposition under rule 18, in support of an application under rule 19 and in reply under rule 20 with a discretion to extend the time limit in deserving cases.

B. Withdrawal, Amendment, Division and Merger of Applications for Registration (Part 4)

3. Rules 26 and 95: Non-extendible 3 Months for Filing a Notice of Objection

- In line with our comments on filing of notice of opposition and counter statement in paragraph 1 above, we are of the view that the period in section 26(2) should be 2 months with a discretion to extend the time limit in exceptional circumstances.

**C. Proceedings to Revoke, Invalidate, Vary or Rectify Registration
(Part 6)**

Procedure for Revocation on Grounds of Non-use

4. Rules 37 and 95: Non-extendible 6 Months for Filing a Counter Statement with Evidence of use in Revocation Proceedings for Non-Use

- We do not object to give 6 months to a party to file a counter statement which has to be accompanied by evidence of use of the trade mark concerned or a statement giving reasons for non-use and copies of which have to be sent to the applicant.
- As permissible in opposition proceedings, there should be a discretion to extend the time limit for filing evidence in exceptional circumstances in revocation proceedings.

5. Rules 38 and 39: Extendible 6 Months for Filing Evidence in Revocation Proceedings for Non-Use

- It would take more than 18 months before the revocation proceedings can be heard (taking into account the 6 months for filing the counter statement and evidence under rule 37 and assuming that there are no time extensions involved). We repeat our comments under paragraph 2 above.
- In our view, as in England, it is sufficient to allow 3 months for filing evidence in support of application under rule 38 and in reply under rule 39 in revocation proceedings with a discretion to extend the time limit in deserving cases.

Procedure for Revocation on Grounds Other Than Non-use

6. Rules 42 and 95: Non-extendible 3 Months for Filing a Counter Statement in Revocation Proceedings on Grounds other than Non-Use

- We repeat the views given in the Bar's comments on the Trade Mark Rules (3rd Draft) dated 9th July 2001.
- In our view, there should be a 2 month period for filing the counter statement with a discretion to extend such time limit in exceptional circumstances.

7. Rules 43, 44 and 45: Extendible 6 Months for Filing Evidence in Revocation Proceedings on Grounds other than Non-Use

- We repeat paragraph 2 above.
- In England, the parties only have 6 weeks to file evidence under rules 32(4), (6) and (7) of the Trade Marks Rules 2000 respectively.
- We are of the view that it should be sufficient to have 3 months for filing evidence in support of an application under rule 43, in support of a counter statement under rule 44 and in reply under rule 45 with a discretion to extend the time limit in deserving cases.

Procedure for Declaration of Invalidity

8. Rule 48: Subsequent Procedure in Proceedings for Declaration of Invalidity

- We repeat paragraphs 6 and 7 above.

Procedure for Variation and Rectification

9. Rules 51(3) and (4) and 95: Non-extendible 6 Months for Filing a Counter Statement with Evidence by the Owner where the Application is Made by a Person Other Than the Owner

- We repeat paragraph 4 above.

10. Rules 51(7): Extendible 6 Months for Filing Evidence by the Applicant where the Application is Made by a Person Other Than the Owner

- In line with our comments in paragraph 2 above, we are of the view that the period in rule 51(7) should be 3 months with a discretion to extend the time limit in deserving cases.

D. Other Proceedings Affecting Registration (Part 7)

11. Rules 56 and 95: Non-extendible 3 months for Filing a Notice of Opposition in respect of Proposed Alterations of a Registered Trade Mark

- In line with our comments on filing of notice of opposition and counter statement in paragraph 1 above, we are of the view that the period in rule 56(1) should be 2 months with a discretion to extend the time limit in exceptional circumstances.

12. Rules 62 and 95: Non-extendible 3 Months for Filing a Notice of Opposition to Proposed Amendments to Entries in the Register due to Reclassification

- In line with our comments on filing of notice of opposition and counter statement in paragraph 1 above, we are of the view that the period in section 62(1) should be 2 months with a discretion to extend the time limit in exceptional circumstances.

E. Correction of the Register (Part 9)

13. Rules 68 and 95: Non-extendible 3 Months for Filing a Notice of Opposition to the Proposed Removal of Matter from the Register

- In line with our comments on filing of notice of opposition and counter statement in paragraph 1 above, we are of the view that the period in section 68(2) should be 2 months with a discretion to extend the time limit in exceptional circumstances.

F. Proceedings Before the Registrar (Part 11)

14. Rule 80: Evidence in Proceedings before the Registrar

- The wording of rule 80 is different from rule 55 of the corresponding English Trade Marks Rules 2000. Rule 55(2) of the Trade Marks Rules 2000 provides as follows:-

“The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.” (emphasis supplied)
- Unlike its English counterpart, the words “the Registrar may in any particular case take oral evidence in addition to such evidence [meaning statutory declaration or affidavit evidence]” in rule 80(2) do not provide for the discretion to admit oral evidence in lieu of statutory declaration or affidavit evidence.
- Also, the present wording of rule 80(2) does not provide for the discretion to allow cross examination of the witnesses where there is no oral evidence admitted in addition to statutory declaration or affidavit evidence. The words “any witness” in rule 80(2) are qualified by the first half of the sentence in this sub-rule and they do not refer to someone who has merely given statutory declaration or affidavit evidence under rule 80(1) (as opposed to someone who has given oral evidence in addition to statutory declaration or affidavit evidence under rule 80(2)).
- We are of the view that there must be a right to cross examine witnesses tendering oral evidence whether such oral evidence is admitted in lieu of or in addition to other written evidence already filed in the proceedings.
- We are also of the view that there should be a general discretion to allow cross examination of witness(es) in respect of his/their statutory declaration or affidavit evidence filed in appropriate cases.
- Further, the present rule 80 does not state what will happen if the declarant(s) or deponent(s) ordered to be cross-examined does/do not attend the hearing and whether the Registrar has the discretion not to allow the declaration or affidavit of such witness(es) to be admitted or used at the hearing.
- We are of the view that there should be a provision similar to O38 rule 2 of the Rules of High Court which would give the Registrar the discretion to disallow the use of evidence of those witnesses who do not attend the hearing for cross examination as ordered in our new Trade Marks Rules.

G. Amendment of Documents, Rectification of Irregularities and Extension of Time Limits (Part 12)

15. Rule 95: Non-extendible Time Limits

- It is arguable that the Registrar cannot make rules depriving himself of the power to grant time extensions even in specific circumstances when he is specifically empowered to make rules to grant time extensions under section 91 of the new Trade Marks Ordinance.
- It is one thing for the Registrar not to make rules to grant extensions of time in respect of certain things, it is quite another thing for the Registrar to make rules to

- surrender or positively fetter the scope of his power to grant extensions of time.
- It may give rise to the potential issue of whether rule 95 is ultra vires of the new Trade Marks Ordinance.

H. Series' Trade Marks, Defensive Trade Marks, Collective Marks and Certification Marks (Part 13)

16. Rules 101 and 95: Non-extendible 3 Months for Filing a Notice of Opposition in respect of the Proposed Amendments of Regulations

- In line with our comments on filing of notice of opposition and counter statement in paragraph 1 above, we are of the view that the period in section 101(3) should be 2 months with a discretion to extend the time limit in exceptional circumstances.

I. Miscellaneous (Part 17)

17. Rules 120 and 95: Non-extendible 3 Months for Filing a Notice of Opposition and a Counter-Statement in Pending Applications for Registration

- We repeat paragraph 1 above.

18th October 2002