

香港特別行政區政府
工商及科技局
工商科



香港金鐘道八十八號
太古廣場第一期二十九樓

Our ref. : CIB CR 06/18/12
Your ref. : CB1/SS/3/02

CB(1)1080/02-03(01)
COMMERCE AND INDUSTRY BRANCH
COMMERCE, INDUSTRY AND
TECHNOLOGY BUREAU
GOVERNMENT OF THE HONG KONG
SPECIAL ADMINISTRATIVE REGION

LEVEL 29, ONE PACIFIC PLACE
88 QUEENSWAY
HONG KONG

Tel. no. : 2918 7480
Fax no. : 2869 4420

6 March 2003

Clerk to Subcommittee
Legislative Council Secretariat
Legislative Council Building
8 Jackson Road
Central
Hong Kong

(Attn : Ms Connie Szeto)

Dear Ms SZETO,

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

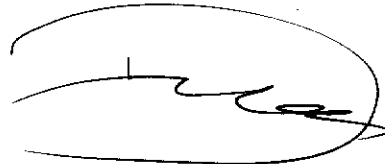
Thank you for your letter of 3 March 2003.

In relation to item (a) of the follow-up action mentioned in your letter concerning the vires issue of rule 95 of the Trade Marks Rules, I attach at Annex A a summary of legal advice from the Department of Justice (DoJ), and at Annex B extract provisions from the UK Trade Marks Act 1994 and Trade Marks Rules 2000 for Members' reference.

With respect to item (c) of your letter concerning the legal effect of deleting rule 95, the Administration's view is that rule 94 provides that subject to rule 95, any period of time prescribed by the Rules or specified by the Registrar for doing any act or taking any proceedings may be extended. If rule 95 is deleted and no amendments are made to rule 94, it would mean that all time limits in the Rules would become extendible.

Responses to items (b) and (d) of your letter will be separately provided.

Yours sincerely,

A handwritten signature in black ink, enclosed within a hand-drawn oval. The signature is stylized and appears to read 'Donald Chen'.

(Donald CHEN)

for Secretary for Commerce, Industry and Technology

c.c.

DIP (Attn : Mr Stephen Selby)

D of J (Attn : Mr Dominic Lai, Mr Jeffrey Gunter, Miss Rayne Chai)

Summary of Legal Advice from Department of Justice

Section 91(1) of the Trade Marks Ordinance (Cap. 559) provides that the Registrar may make rules for certain purposes and further section 91(2) states that rules made by the Registrar may provide for, among other things:

- “(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.

The power under section 91(2)(n) is stated in permissive language rather than obligatory language. This in itself suggests that the Registrar may decide at his discretion whether he should provide for extension of time limits. Moreover, reading section 91(2)(m) and (n) together, it is clear that the legislative intention is that time limits prescribed under section 91(2)(m) may be non-extendible. If time limits were intended to be always extendible, there would have been no need to state that the Registrar may provide for extensions.

In an English Appeal Court case, *Petch v Gurney* [1994] 3 All ER 731, Millett LJ stated the following:

“Where statute requires an act to be done in a particular manner, it may be possible to regard to the requirement that the act be done as mandatory but the requirement that it be done in a particular manner as merely directory. But that is not the case with a stipulation as to time. If the only time limit which is prescribed is not obligatory, there is no time limit at all. Doing an act late is not the equivalent of doing it in time. That is why Grove J said in *Barker v Palmer* (1881) 8 QBD 9 at 10 – ‘provisions with respect to time are always obligatory, unless a power of extending the time is given to the court’. This probably cannot be laid down as a universal rule, but in my judgment it must be the normal one.”

The reasoning in the above quote is contrary to the idea that time limits should usually be extendible.

It cannot be said that to provide for a non-extendible time limit in itself is to fetter the scope of the Registrar's power to grant extensions of time and therefore likely to be ultra vires. If the Rules provide that a time limit is non-extendible but subsequently the Registrar sees good reasons for a change, he can amend the Rules.

UK Trade Marks Act 1994, Section 78

78.—(1) The Secretary of State may make rules—

- (a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter, and
 - (b) for prescribing anything authorised or required by any provision of this Act to be prescribed,
- and generally for regulating practice and procedure under this Act.

(2) Provision may, in particular, be made—

- (a) as to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorising the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
- (f) providing for the extension of any time limit so prescribed, or specified by the registrar, whether or not it has already expired.

(3) Rules under this Act shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

UK Trade Marks Rules 2000, Rule 68(1),(3)

Alteration of time limits

68. - (1) The time or periods-

- (a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or
- (b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).