

Information on time limits for trade mark registration in other jurisdictions

	UK (see Annex A)	Singapore (see Annex B)	Australia (see Annex C)
Time limit for responding to examination report (HK rules 13/14)	No definite period. The applicant is given “such period as the registrar may specify” to make representations or to amend the application (Act, section 37(3)). Such period may be extended (Rule 68(1)(b)).	Applicant has 4 months from the date of the examination report to make representations in writing, apply for a hearing or have his application amended (Rule 24(2)). Such period may be extended (Rule 24(2A)).	An application lapses if it is not accepted within basically a 15-month period from the date of the examination report (Act section 37(1), Regulation 4.12(1)) extendible up to 21 months from the date of the examination report (Regulation 4.12(4)). Correspondence and hearing has to take place within that period. Subject to deferment in certain prescribed circumstances (Act section 36, Regulation 4.13).
Time limit for filing notice of opposition (HK rule 16)	3 months from the date on which the application is published (Rule 13(1)), which period is non-extendible (Rule 68(3)).	2 months from date of publication of the application for registration (Rule 29 (1)), which period is extendible up to 4 months from the date of publication (Rule 29(4)).	3 months from advertisement (extendible on certain grounds) (Regulation 5.1, 5.2).
Time limit for filing counter-statement	Within 3 months of the date on which a copy of the notice of	2 months from the date of receipt by the applicant of the copy of the	No equivalent step in the Australian opposition procedure.

	UK (see Annex A)	Singapore (see Annex B)	Australia (see Annex C)
(HK rule 17)	<p>opposition is sent by the registrar to the applicant, subject to the provisions on “cooling-off period” (Rule 13(3)).</p> <p>Before the expiry of the 3 months for filing counter-statement, applicant may, with the agreement of the opposing party, be granted an extension of 3 months (extendible for a further 3 months) (the “cooling-off period”) (rule 13(4)).</p> <p>Applicant to file counter-statement within 1 month after expiry of cooling-off period (Rule 13(5)).</p> <p>These periods are not extendible (Rule 68(3)).</p>	<p>notice of opposition (Rule 31(1)), which period is extendible up to 4 months from such date of receipt (Rule 31(5)).</p>	<p>The next step after filing notice of opposition is the filing of evidence by the opponent.</p>

Note : while every effort has been made to ensure accuracy in excerpting and explaining the trade marks law in other jurisdictions, please note that the comparison above does not have the approval of the legal and judicial authorities in those jurisdictions.

Annex A

UK Trade Marks Act 1994

37. – (1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules).

...

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

(4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

UK Trade Marks Rules 2000

13. – (1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the

applicant.

...

(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(4) Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the “cooling off period”); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party.

(5) Within one month after the expiry of the cooling off period the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

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 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 ...

Annex B

Singapore Trade Marks Rules 1998 (as amended)

24. – (1) If, in the course of an examination of an application for registration, it appears to the Registrar that the requirements for registration are not met, the Registrar shall give a written notice of this to the applicant.

(2) If, within 4 months from the date of the written notice of the Registrar, the applicant fails to –

- (a) make representations in writing;
- (b) apply to the Registrar for a hearing; or
- (c) apply to have the application amended,

the Registrar shall refuse to accept the application.

(2A) If the applicant wishes to have an extension of time to do any act referred to in paragraph (2)(a), (b) or (c), he shall file with the Registrar a request for extension in Form TM 49 before the expiry of the period of 4 months or any extended period previously allowed by the Registrar.

29. – (1) A person (referred to in this Division as the opponent) may, within 2 months from the date of publication of the application for registration, file with the Registrar a notice opposing the registration in Form TM 11 (referred to in this Division as a notice of opposition).

...

(3) A request for an extension of time to file the notice of opposition shall be made by filing with the Registrar Form TM 48 within 2 months from the date of the publication of the application for registration.

(4) The total extension of time for which the Registrar may allow to file the notice of opposition shall not exceed 4 months from the date of the publication of the application for registration.

31. – (1) Within 2 months from the date of receipt of the copy of the notice of opposition from the opponent, the applicant shall file with the Registrar a counter-statement ...

(4) A request for an extension of time to file the counter-statement shall be made by the applicant to the Registrar in writing within 2 months from the date of receipt of the notice of opposition from the opponent.

(5) The total extension of time for which the Registrar may allow to file the counter-statement shall not exceed 4 months from the date of receipt by the applicant of the notice of opposition.

77. – (1) Any period of time –

(a) prescribed by these Rules; or

(b) specified by the Registrar for doing any act or taking any proceedings,

may, at the request of the person or party concerned, be extended by the Registrar by such period and upon such terms as the Registrar considers fit.

(6) Paragraphs (1) to (5) shall not apply to the following matters:

(a) the doing of any act referred to in rule 24(2)(a), (b) or (c);

(b) the filing of a notice of opposition under rule 29;

(c) the filing of a counter-statement under rule 31; ...

Annex C

Australia Trade Marks Act 1995 (as amended)

33. Application accepted or rejected

(1) The Registrar must, after the examination, accept the application unless he or she is satisfied that:

- (a) the application has not been made in accordance with this Act; or
- (b) there are grounds for rejecting it.

(2) The Registrar may accept the application subject to conditions or limitations.

(3) If the Registrar is satisfied that:

- (a) the application has not been made in accordance with this Act; or
- (b) there are grounds for rejecting it;
the Registrar must reject the application.

(4) The Registrar may not reject an application without giving the applicant an opportunity of being heard.

34. Notice etc. of decision

The Registrar must:

- (a) notify the applicant in writing of his or her decision under section 33; and
- (b) advertise the decision in the *Official Journal*.

35. Appeal

The applicant may appeal to the Federal Court against a decision of the Registrar:

- (a) to accept the application subject to conditions or limitations;
or
- (b) to reject the application.

36. Deferment of acceptance

The Registrar may defer the acceptance of the application in the circumstances, and for the period, provided for in the regulations.

37. Lapsing of application

(1) Subject to subsection (2), an application lapses if it is not accepted within the prescribed period or within that period as extended in accordance with the regulations.

(2) If, after the prescribed period or the prescribed period as extended (as the case may be) has expired, the Registrar extends under section 224 the period within which the application may be accepted, the application:

- (a) is taken not to have lapsed when the prescribed period expired; and
- (b) lapses if it is not accepted within the extended period.

224. Extension of time

(1) If, because of an error or omission by a trade marks officer, a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar must extend the time for doing the act.

- (2) If, because of:
 - (a) an error or omission by the person concerned or by his or her agent; or
 - (b) circumstances beyond the control of the person concerned; a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

- (3) If:
 - (a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and
 - (b) on application made by that person in accordance with the regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time; the Registrar may extend the time for doing the act.

Australia Trade Marks Regulations 1995 (as amended)

4.8 Examination of application - report to applicant

(1) For the purposes of section 31 of the Act (which deals with examination and reporting), if in the course of an examination of an application the Registrar reasonably believes that:

- (a) the application has not been made in accordance with the Act or these regulations; or
- (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it;

the Registrar must report that belief in writing to the applicant.

...

4.9 Examination - applicant's response to report

- (1) An applicant may respond in writing to the Registrar's report

under regulation 4.8.

...

4.10 Examination - further report to applicant

(1) On receipt of a response under regulation 4.9, the Registrar must consider the response.

(2) If the Registrar continues to believe that:

- (a) the application has not been made in accordance with the Act or these regulations; or
- (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it;

the Registrar must report that belief in writing to the applicant.

...

4.12 Periods after which applications lapse

(1) For the purposes of subsection 37(1) of the Act (which deals with lapsing), the prescribed period, for an application in respect of which a report is made under regulation 4.8, is:

- (a) except as provided by paragraph (b) – 15 months from the date of that report (whether or not a further report is made under regulation 4.10); or
- (b) if a further report raises grounds under Division 2 of Part 4 of the Act for rejecting the application that were not raised in the report made under regulation 4.8 – 15 months from the date of the further report.

(2) In determining the period of 15 months for the purposes of paragraph (1)(a) or (b) in relation to an application, no account is to be taken of a period in which acceptance of the application is deferred under regulation 4.13.

(3) An applicant may, before the end of a period prescribed in subregulation (1), or that period as extended under section 224 of the Act or as a result of a previous application of subregulation (4), request the Registrar in writing to extend the period.

(4) The Registrar must, in accordance with a request made under subregulation (3), extend a period, unless:

- (a) the period; or
- (b) that period as extended under section 224 of the Act or as a result of a previous application of this subregulation; would be extended for more than 6 months after the end of the relevant period prescribed in subregulation (1).

4.13 Deferment of acceptance

(1) The Registrar may, at the request of the applicant in writing, defer acceptance of an application for registration of a trade mark, if:

- (a) the request is made within a period prescribed in subregulation 4.12(1); and
- (b) the Registrar reasonably believes that there grounds for rejecting the application under subsection 44(1) or (2) of the Act, or subregulation 4.15A(1) or (2), because of another trade mark;
 - (i) that is registered by another person; or
 - (ii) that is a protected international trade mark; or
 - (iii) in respect of which an application for registration, or an IRDA (International Registration Designating Australia), has been made by another person; and
- (c) the applicant:
 - (i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark or the IRDA; or
 - (ii) is seeking to satisfy the Registrar as to:
 - (A) a matter mentioned in paragraph 44(3)(a) or (b) of the Act or 4.15A(3)(a) or (b) of these Regulations; or
 - (B) the matters mentioned in subsection 44(4) of the Act or subregulation 4.15A(5);in relation to the applicant's trade mark and the other trade mark; or
 - (iii) has filed an application under section 92 of the Act or

regulation 17A.48 in respect of the other trade mark and is awaiting the finalisation of proceedings in respect of that application; or

- (iv) has begun proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark and the proceedings have not been determined or otherwise disposed of; or
- (v) is awaiting renewal of the registration of the other trade mark in the period of 12 months after registration of the other trade mark has expired, or removal of the other trade mark from the Register; or
- (vi) is awaiting renewal of the international registration of the other trade mark in the period of 6 months after the intentional registration has expired, or removal of the other trade mark from the International Register.

(2) The Registrar may, on his or her own initiative, defer acceptance of the application within a period that is prescribed in subregulation 4.12(1) or that is extended under section 224 of the Act or subregulation 4.12(4), if:

- (a) the time within which proceedings mentioned in paragraph (b) may be begun, or an application mentioned in paragraph (c) may be made, has not ended; or
- (b) appeal proceedings under a provision of the Act have begun in a prescribed court in relation to the application; or
- (c) an application has been made to the Administrative Appeals Tribunal for review of a decision of the Registrar in relation to the first-mentioned application; or
- (d) the Registrar is informed in writing that the applicant has died.

(3) The Registrar must defer acceptance of an application for registration of a certification trade mark when a copy of the rules governing the use of the certification trade mark is sent to the Commission in accordance with regulation 16.2.

(4) The Registrar must notify an applicant in writing:

- (a) if the applicant requests the Registrar to defer acceptance of an application – of the Registrar’s decisions to defer, or not

- to defer, acceptance of the application; and
- (b) if the Registrar otherwise defers acceptance of an application – of the provision under which acceptance of the application is deferred.

5.1 Time for filing notice of opposition

For the purposes of subsection 52(2) of the Act (which deals with notice of opposition), the period for filing a notice of opposition is 3 months from the day on which the acceptance of the application is advertised in the *Official Journal*.

5.2 Extension of time for filing - grounds

(1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.

(2) An application for an extension of time may be made within the period for filing a notice of opposition referred to in regulation 5.1 on 1, or more than 1, of the following grounds and on no other ground:

- (a) an error or omission by a trade marks officer;
- (b) an error or omission by the person applying for the extension of time, or by the person's agent;
- (c) circumstances beyond the control of the person applying for the extension of time;
- (d) the conduct of genuine negotiations between that person and the applicant for registration;
- (e) the undertaking of genuine research to decide:
 - (i) whether opposition is justified; or
 - (ii) on the grounds of opposition.