

**Trade Marks Rules**  
**Results of Discussion with the Trade Mark Practitioners**  
**on Time Limits for Application for Registration and for Opposition Proceedings**

**Issue**

In the Sub-committee meeting held on 3 March 2003, representatives of the legal profession repeated their request that the time limits specified under rules 13 and 14 on trade mark application and rules 16 and 17 on opposition proceedings be made extendible so as to allow sufficient time for applicants to complete the requirements. The Administration undertook to discuss further with the practitioners and report back to the Sub-committee.

2. The Intellectual Property Department has held two rounds of discussions with the representatives of the legal profession who attended the meeting on 3 March. The Department has agreed to put forward amendments to those rules (13, 14, 16 and 17) over which such concerns had been expressed. The amendments are summarized below. In short, we propose to make the time limit rules 13 and 14 extendible in specified circumstances. As for rules 16 and 17, we propose to make the time limit extendible by two months with no further extension allowed. Representatives of the legal profession have indicated that they would accept these proposals.

**Agreed Changes**

**Rules 13 & 14**

- 1.1 Registrar issues an opinion to an application
- 1.2 Applicant has 6 months, extendible for one further period of 3 months to respond by making representations or amending application
- 1.3 Registrar issues further opinion
- 1.4 Applicant has 3 months from the further report to:
  - (a) satisfy the requirements for registration; or
  - (b) call for a hearing

which period may be extended for an initial period of 3 months and thereafter for further periods of 3 months each on the following grounds:

- (i) where the application faces an objection under section 12 (relative grounds for refusal of registration) and:
  - (aa) the applicant is obtaining consent of the owner of a relevant earlier trade mark;
  - (bb) a relevant earlier trade mark is the subject of invalidation or revocation proceedings which are pending
  - (cc) the applicant is obtaining an assignment of a relevant earlier trade mark to himself;
- (ii) the applicant is preparing evidence of use to be filed in support of the application;
- (iii) other exceptional circumstances.

## **Rules 16 & 17**

- 2.1 Opponent has 3 months from advertisement of application to file notice of opposition, extendible for 2 months and with no further extensions.
- 2.2 Applicant has 3 months from receipt of copy of notice of opposition to file counter-statement, extendible for 2 months and with no further extensions.
- 2.3 Rule 121 which deals with application for registration of a trade mark under the old law is to be amended in line with Rules 16 & 17, i.e. for both filing of opposition and counter-statement, the time limit will be 3 months, extendible for 2 months and with no further extensions.