

**The Hong Kong
Institute of
Trade Mark
Practitioners**
香港商標師公會

Registered office
Suite D, 16th floor
On Hing Building
1 On Hing Terrace
Central, Hong Kong

	Tel:	Fax:
President Peggy Cheung	2846 1755	2845 0476
Vice President Sandra Gibbons	2840 5028	2537 1907
Treasurer Matthew Laight	2248 6000	2248 6011
Secretary Charmaine Koo	2825 9211	2810 0431
Membership Secretary Steven Birt	2507 9890	2810 1648



11 March 2003

The Honourable Margaret Ng
Chairman of the Subcommittee on
Trade Marks Rules and Trade Marks Ordinance (Cap. 559)

Dear Sirs,

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

Amendments to the Trade Marks Rules

Thank you for your letter of 7 March 2003 updating us on the Subcommittee meeting held on 7 March 2003.

We have also received from the Administration the attached draft resolution to amend Rules 13, 14, 16, 17, 37(4), 41(3), 50(6) and 121 of the Trade Marks Rules as gazetted and laid before LegCo on 12 February 2003.

On behalf of the Law Society of Hong Kong, the Hong Kong Chapter of the Asian Patent Attorneys Association (APAA), the International Trademark Association (INTA) and the Hong Kong Institute of Trade Mark Practitioners (HKITMP), we would like to put forward our comments and response to the draft resolution.

First, we would like to confirm that representatives of the Law Society, APAA, INTA and HKITMP had two rounds of discussions with the Intellectual Property Department and the agreed changes as set out in the attachment to your letter of 7 March 2003 do truly reflect the outcome of our discussions with the Intellectual Property Department.

Following review of the draft resolution, we are now pleased to report that we feel that the proposed amendments to the relevant Rules are in line with the agreed changes.

However, we do have one minor suggestion. For the sake of consistency and clarity, we believe that the words "and substituting" should be added to the end of the first line of Resolution (b) after the words "Rule 14(2) and (3)".

One other comment that we would like to make is that we discussed the wordings of amended Rule 13(6)(c) at length with the Intellectual Property Department during our meetings. We felt that it is difficult to foresee all eventualities and to come up with an exhaustive list of all possible circumstances justifying the grant of an extension of time. It is therefore important

not to exclude any cases whereby it would be unfair to penalize the applicant by refusing to grant an extension of time to comply or resolve all the objections raised against the application. With that in mind the wordings "other exceptional circumstances" were agreed upon.

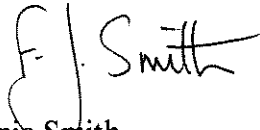
Yours faithfully,



Peggy Cheung
President for and on behalf of
The Hong Kong Institute of Trade Mark Practitioners



Henry Wheare
For and on behalf of the Law Society of Hong Kong



Jeannie Smith
For and on behalf of the International Trademark Association



Henry Wheare
For and on behalf of the Hong Kong Chapter of
The Asian Patent Attorneys Association

cc. Mr. Stephen Selby, Intellectual Property Department

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INTERPRETATION AND GENERAL CLAUSES ORDINANCE

RESOLUTION OF THE LEGISLATIVE COUNCIL

TRADE MARKS RULES

Resolution made and passed by the Legislative Council under section 34(2) of the Interpretation and General Clauses Ordinance (Cap. 1) on

RESOLVED that the Trade Marks Rules, published in the Gazette as Legal Notice No. 30 of 2003 and laid on the table of the Legislative Council on 12 February 2003, be amended –

- (a) in rule 13 –
 - (i) in subrule (2), by deleting “within the period beginning on the date of the notice and ending 6 months after that date” and substituting “at any time during the period beginning on the date of the notice and ending 6 months after that date, do either or both of the following”;
 - (ii) in subrule (3), by deleting “before the expiry of the 6-month period referred to” and substituting “within the period specified”;
 - (iii) by deleting rule 13(4) to (6) and substituting –
 - “(4) If –
 - (a) the applicant files written representations or a request for amendment under subrule (2) within the period specified in that subrule or, where the Registrar has granted an

- extension of time under subrule (3), within the period as so extended; and
- (b) it appears to the Registrar, after considering the representations or request for amendment, that the application, or the application as amended or proposed to be amended, does not meet the requirements for registration,

the Registrar shall inform the applicant of his opinion by notice in writing.

(5) Where a notice is sent to the applicant under subrule (4), the applicant may, at any time during the period beginning on the date of the notice and ending 3 months after that date, do any or all of the following –

- (a) file written representations or further written representations to establish that the requirements for registration are met;
- (b) file a request or a further request under section 46 of the Ordinance to amend his application so as to meet those requirements (see rule 24); or
- (c) file a request for a hearing.

(6) The Registrar may, on a request being filed by the applicant on the specified form within the period specified in subrule (5) or, where the Registrar has previously granted an extension of time under this subrule, within the period as so extended, extend the time for filing written representations or a request under subrule (5) for such period or periods, not exceeding 3 months at any one

time, and on such terms, if any, as he may direct, if he is satisfied that –

- (a) where the notice sent to the applicant under subrule (4) raises an objection to the registration of the trade mark on any of the grounds mentioned in section 12(1), (2) or (3) of the Ordinance (relative grounds for refusal of registration) –
 - (i) the applicant needs additional time to obtain the consent of the owner of a relevant earlier trade mark;
 - (ii) the applicant needs additional time to obtain an assignment of a relevant earlier trade mark; or
 - (iii) proceedings for the invalidation or revocation of a relevant earlier trade mark are pending and time should be extended to allow for the proceedings to be disposed of;
- (b) the applicant needs additional time to prepare evidence of use to be filed in support of the application; or
- (c) other exceptional circumstances exist to justify the granting of an extension of time.”;

(b) by deleting rule 14(2) and (3) –

“(2) Subject to subrule (3), where –

- (a) the Registrar sends a notice to the applicant under rule 13(1);
- (b) the applicant files written representations or a request for amendment under rule 13(2) within the period specified in that rule or as extended under rule 13(3); and
- (c) the Registrar sends a notice to the applicant under rule 13(4),

the prescribed period for the application is the period beginning on the date of the notice sent to the applicant under rule 13(1) and ending 3 months after the date of the notice sent to the applicant under rule 13(4) or, where the Registrar has granted an extension of time under rule 13(6), ending on the last day of the period as so extended.

(3) Where –

- (a) the Registrar sends a notice to the applicant under rule 13(4); and
- (b) the applicant files a request for a hearing within the period specified in rule 13(5) or, where the Registrar has granted an extension of time under rule 13(6), within the period as so extended,

the prescribed period for the application is the period beginning on the date of the notice sent to the applicant under rule 13(1) and ending on the last day of the hearing or at such time as the Registrar may decide the matter without a hearing under rule 75.”;

- (c) in rule 16, by adding –
- “(4) The Registrar may, on a request being filed by any person on the specified form within the period specified in subrule (1), extend the time for filing a notice of opposition or anything referred to in subrule (2) by 2 months, which time may not be further extended.”;
- (d) in rule 17 –
- (i) by adding –
- “(3) The Registrar may, on a request being filed by the applicant on the specified form within the period specified in subrule (1), extend the time for filing a counter-statement by 2 months, which time may not be further extended.”;
- (ii) in subrule (3) –
- (A) by renumbering it as subrule (4);
- (B) by adding “or as extended under subrule (3)” after “subrule (1)”;
- (e) in rule 18(1), by adding “or as extended under rule 17(3)” after “rule 17(1)”;
- (f) in rule 37(4), by deleting “he shall not be permitted to take part in the proceedings” and substituting “the Registrar may treat the application for revocation as being unopposed by the owner”;
- (g) in rule 41(3), by deleting “he shall not be permitted to take part in the proceedings” and substituting “the Registrar may treat the application for revocation as being unopposed by the owner”;
- (h) in rule 47, by adding “with necessary modifications” after “apply”;
- (i) in rule 50(6), by deleting “he shall not be permitted to take part in the proceedings” and substituting “the Registrar may treat the application for variation or rectification as being unopposed by the owner”;

- (j) in rule 74 –
 - (i) in subrule (3), by adding “or on the filing of a request for a hearing in accordance with rule 13(5)” after “subrule (2)”;
 - (i) by deleting subrule (6);
 - (ii) by renumbering subrule (7) as subrule (6);
- (k) in rule 95 –
 - (i) in subrule (1) –
 - (A) in paragraph (b), by deleting “and (3)”;
 - (B) by deleting paragraph (c) and substituting –
 - “(c) rule 13(5) (time for filing representations, a request for amendment or a request for a hearing);”;
 - (C) in paragraph (u), by deleting “rule 121(a)” and substituting “rule 121(1)(a)”;
 - (D) in paragraph (v), by deleting “rule 121(b)” and substituting “rule 121(1)(b)”;
 - (ii) by adding –
 - “(3) No period of time specified in rule 13(3) or (6), 16(4), 17(3) or 121(2) or (3) may be extended under rule 94(1).”;
- (l) in rule 121 –
 - (i) by deleting “Where” and substituting “(1) Where”;
 - (ii) by adding –
 - “(2) The Registrar may, on a request being filed by any person on the specified form within the period specified in subrule (1)(a), extend the time for filing a notice of opposition by 2 months, which time may not be further extended.
 - (3) The Registrar may, on a request being filed by the applicant on the specified form within the period specified in subrule (1)(b), extend the time for filing the

counter-statement by 2 months, which time may not be further extended.”;

- (m) in the Schedule -
- (i) in Fee No. 3, under the column “**Matter or proceeding**”, by deleting “rule 13(3)” and substituting “rule 13(3) or (6)”;
 - (ii) in Fee No. 29, under the column “**Matter or proceeding**”, by deleting “rule 94” and substituting “rule 16(4), 17(3), 94 or 121(2) or (3)”.

Clerk to the Legislative Council

2003