

LEGISLATIVE COUNCIL BRIEF

Trade Marks Ordinance (Chapter 559) Trade Marks (Amendment) Rules 2006

INTRODUCTION

A The Trade Marks (Amendment) Rules 2006 (“the Amendment Rules”) at Annex A have been made by the Director of Intellectual Property in his capacity as the Registrar of Trade Marks under section 91 of the Trade Marks Ordinance. They aim to simplify the signing requirements of applications for registration of two kinds of trade mark transactions, i.e. assignments and assents, in order to facilitate the introduction of enhanced electronic services by the Trade Marks Registry. They also clarify certain provisions in the Trade Marks Rules. This brief explains the Amendment Rules.

THE RULES

Simplified signing requirements

2. The Trade Marks Registry is operated by the Intellectual Property Department (IPD). At present, it provides various electronic services to trade mark applicants, registered trade mark owners and other users. These services include web-based electronic search of the trade marks register; electronic filing, payment and publication of applications for registration; electronic registration of changes in name and address of trade mark owners and agents; as well as electronic renewal of trade marks. Trade mark owners and applicants who choose not to file or manage their marks electronically can still use the paper-based filing options and services.

3. Rules 62(2) and (4) of the Trade Marks Rules require applications and notices to register particulars of assignments and assents to be signed by or on behalf of both parties to the transactions or accompanied by documentary evidence to establish the transaction. This signing requirement is not conducive to introducing enhanced electronic services for registering these transactions.

The Amendment Rules change the above requirements by providing that the form for an application or notice to register an assignment or an assent can be signed respectively by the assignor or the personal representative making the assent. This will also simplify the procedures for registering these transactions and reduce the number of steps and time taken by the parties to register particulars of their transactions. We will also apply the simplified signing requirements to paper-based applications and notices to register these transactions. These simplified signing requirements are in line with those signing requirements for assignments and assents as provided for under section 27(4) of the Trade Marks Ordinance (Cap. 559).

Technical amendments

4. The Amendment Rules also clarify certain provisions of the Trade Marks Rules.

(a) Deficiencies in application

5. Rule 11 of the Trade Marks Rules sets out the procedures to be taken by the Registrar of Trade Marks (“Registrar”) when deficiencies are identified in an application for registration of a trade mark, i.e. the application does not satisfy the requirements of certain rules, including those relating to the specification of goods or services under rule 7(2) in respect of which the trade mark is to be registered. Our intention is that an application should be treated as abandoned only in relation to the objectionable part of the specification of goods or services under rule 7(2) and the Registrar should continue to process the application relating to the rest of the specification. Indeed, the Registry has been adopting the above interpretation when handling deficiencies in applications concerning specifications of goods or services not remedied within the specified period.

6. The existing wording of rule 11(2)(a) may not be clear enough to avoid the interpretation that the “entire” application should be treated as abandoned even if deficiencies only appear in relation to some of the goods or services set out in the specification under rule 7(2), and the deficiencies are not remedied within the specified period. The Amendment Rules amend rule 11(2) so as to remove any doubt.

(b) *Publication of proposals*

7. Rule 58 of the Trade Marks Rules empowers the Registrar to amend entries in the register consequent on changes in the system of classification of goods and services that have been agreed internationally, subject to certain limitations as stipulated in the Trade Marks Ordinance. Rule 59 of the Trade Marks Rules requires the Registrar to give notice to the owner of the registered trade mark in question of his proposals to amend any entry in the register relating to the trade mark and provide that the owner may file objections to the proposed amendments. Our intention is that the Registrar should consider the objections and decide on whether and how the amendments to the entries should be made, including whether his original proposal to amend the entries should be maintained, amended, or abandoned in total. Rule 60(2) provides for procedural matters concerning the publication in the official journal of particulars of the amendments proposed to be made by the Registrar.

8. The existing wording of Rule 60(2) may not be clear enough that the Registrar can amend the entries as he originally proposed after considering the objection filed by the owner of the registered trade mark in question. The Amendment Rules amend rule 60(2) to provide expressly that the Registrar should be empowered to publish his proposal in its original form in the official journal if he is satisfied that the owner's objection does not have any merit. This reflects the current practice of the Registrar.

(c) *Filing of documents with the Registrar*

9. Rule 108(1) of the Trade Marks Rules provides that "Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered to the Registrar at the Registry during the normal business hours of the Registry or sent to the Registrar by post". Our intention is not to allow such filing of documents to be done by facsimile transmission. The existing wording of rule 108(1) may not be clear enough in this respect. The Amendment Rules amend the rule by adding "by hand" after "must be delivered".

B 10. The existing provisions being amended are at Annex B.

LEGISLATIVE TIMETABLE

11. The Amendment Rules will be published in the Gazette on 24 March 2006 and tabled at the Legislative Council on 29 March 2006. Subject to the negative vetting procedure, the amendments will take effect from 26 May 2006.

IMPLICATIONS OF THE PROPOSAL

12. The proposed simplification of the signing requirements for transactions in trade marks can enable expansion of the electronic services to the relevant registration procedure, which is conducive to the efficiency of the entire intellectual property rights system in Hong Kong. This is beneficial to the long-term development of innovative and brand-building activities in our economy.

13. The enhanced electronic services would improve the efficiency of IPD in the handling of concerned applications. The savings in staffing resources from the proposal is however expected to be minimal. The proposal would not have any financial implications. It is in conformity with the Basic Law, including the provisions concerning human rights. It does not affect the current binding effect of the concerned Ordinance. The proposal also has no environmental or sustainability implications.

PUBLIC CONSULTATION

14. We have consulted the relevant legal and intellectual property practitioners' associations, as well as the major chambers of commerce, on the proposed amendments. The Hong Kong Institute of Trade Mark Practitioners, Hong Kong Law Society, Hong Kong Bar Association, Asian Patent Attorneys Association and British Chamber of Commerce in Hong Kong have responded to us indicating no objection to the above proposals.

15. We also consulted the Panel on Commerce and Industry of the Legislative Council on 21 February 2006. Members present indicated support for the proposed amendments.

PUBLICITY

16. A press release will be issued when the Amendment Rules are published in the Gazette on 24 March 2006. A spokesman will be available to handle enquiries.

ENQUIRIES

17. Enquiries on this brief shall be referred to Ms Priscilla To, Principal Assistant Secretary for Commerce, Industry and Technology (Commerce and Industry) at telephone number 2918 7480.

Commerce and Industry Branch
Commerce, Industry and Technology Bureau
March 2006

TRADE MARKS (AMENDMENT) RULES 2006

(Made by the Registrar of Trade Marks under section 91
of the Trade Marks Ordinance (Cap. 559))

1. Commencement

These Rules shall come into operation on 26 May 2006.

2. Deficiencies in application

(1) Rule 11(2)(a) of the Trade Marks Rules (Cap. 559
sub. leg. A) is amended by repealing ", 7(1) or (2)".

(2) Rule 11(2)(a) is amended by repealing "and" at the
end.

(3) Rule 11(2) is amended by adding –

"(aa) where the deficiencies relate to the class or
classes of goods or services in the International
Classification required to be specified under rule
7(1), the part of the application relating to the
goods or services the specification of the class or
classes for which is deficient shall be treated as
abandoned;

(ab) where the deficiencies relate to the description of
goods or services required to be provided under rule

7(2), the part of the application relating to the goods or services the description of which is deficient shall be treated as abandoned; and".

3. Examination of application
(s. 42(1) of the Ordinance)

(1) Rule 12 is amended by renumbering it as rule 12(1).

(2) Rule 12(1) is amended by repealing "The Registrar" and substituting "Subject to subrule (2), the Registrar".

(3) Rule 12 is amended by adding -

"(2) Where rule 11(2)(aa) or (ab) applies, the Registrar shall examine whether the remaining part of the application that is not affected by the deficiencies referred to in that rule satisfies the requirements for registration.".

4. Renewal of registration: special case
(s. 50(1), (3) & (7) of the Ordinance)
(Form T8) (Fee No. 9)

Rule 33(1) is amended by adding "the" before "application for registration".

5. Publication of proposals
(s. 58(3)(b) of the Ordinance)

(1) Rule 60(2) is amended by repealing everything after "consider the objections" and substituting a full stop.

(2)Rule 60 is amended by adding -

"(3)If, having considered the objections, the Registrar is satisfied that the objections (or part of the objections) have merit, he shall -

- (a) abandon the proposals; or
- (b) amend the proposals and publish the proposals as amended in the official journal.

(4)If, having considered the objections, the Registrar is satisfied that the objections are without merit, he shall publish the proposals in the official journal."

6. Application or notice to register registrable transaction

(ss. 29 & 31(3) of the Ordinance)
(Forms T10 & T11)(Fee No. 19)

(1)Rule 62(2) is amended by repealing "signed by or on behalf of the parties to the assignment" and substituting "signed by or on behalf of the assignor".

(2)Rule 62(4) is amended by repealing "signed by or on behalf of both the personal representative and the beneficiary" and substituting "signed by or on behalf of the personal representative".

7. Filing of documents with the Registrar

Rule 108(1) is amended by adding "by hand" after "delivered".

Registrar of Trade Marks

2006

Explanatory Note

These Rules amend the Trade Marks Rules (Cap. 559 sub. leg. A) ("the principal Rules").

2. Rule 1 provides for the commencement of these Rules.

3. Rule 2 amends rule 11(2) of the principal Rules to clarify that if the Registrar of Trade Marks ("the Registrar") considers that part of an application for registration of a trade mark does not comply with the requirements of rule 7(1) or (2) of the principal Rules, and the applicant fails to remedy the deficiencies, only that part of the application (and not the whole application) will be treated as abandoned.

4. Rule 3 amends rule 12 of the principal Rules to clarify

that if only part of an application for registration of a trade mark does not comply with the requirements of rule 7(1) or (2) of the principal Rules, the Registrar shall examine whether the remaining part of the application satisfies the requirements for registration.

5. Rule 4 amends rule 33(1) of the principal Rules to rectify a clerical error.

6. Rule 5 amends rule 60 of the principal Rules to empower the Registrar to proceed with the proposed amendments of the entries in the register of trade marks by publishing the proposal in the official journal if he is satisfied that the objections to the proposed amendments are without merit.

7. Rule 6(1) amends rule 62(2) of the principal Rules to simplify the signing requirement in respect of an application or a notice relating to an assignment by requiring that the application or the notice be signed by or on behalf of the assignor. Under the existing rule 62(2) of the principal Rules, the application or the notice must be signed by or on behalf of the parties to the assignment.

8. Rule 6(2) amends rule 62(4) of the principal Rules to simplify the signing requirement in respect of an application or a notice relating to the making by a personal representative of an assent by requiring that the application or the notice be signed by or on behalf of the personal

representative. Under the existing rule 62(4) of the principal Rules, the application or the notice must be signed by or on behalf of both the personal representative and the beneficiary.

9. Rule 7 amends rule 108(1) of the principal Rules to clarify that the expression "delivered to the Registrar" in that rule 108(1) means "delivered to the Registrar by hand".

Existing provisions being amended

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	7	Heading:	Specification of goods or services (ss. 38(2)(c) & 40 of the Ordinance) (Form T5A) (Fee No. 2)	Version Date:	04/04/2003

- (1) Every application for registration of a trade mark shall specify the class or classes of goods or services in the International Classification to which the application relates.
- (2) The specification shall include for each class of goods or services set out in the specification a clear and concise description, appropriate to that class, of the goods or services in respect of which the trade mark is proposed to be registered.
- (3) If the application relates to more than one class of goods or services in the International Classification, the specification shall set out the classes in consecutive numerical order.
- (4) If the trade mark is proposed to be registered in respect of all the goods or services in a particular class, or in respect of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use the applicant has made of the trade mark or by the use he intends to make of the trade mark if it is registered.
- (5) If the specification lists goods or services by reference to a class or classes in the International Classification under which the goods or services do not fall, the applicant may file a request under section 46 of the Ordinance to amend the application to correct the class or classes accordingly (see rule 24).
- (6) Subject to rule 24, on receipt of a request under subrule (5) and payment of the applicable fee, the Registrar shall amend the application accordingly.
- (7) Subrule (4) does not apply to an application for the registration of a trade mark as a defensive trade mark.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	11	Heading:	Deficiencies in application	Version Date:	04/04/2003

(1) If it appears to the Registrar that an application for registration of a trade mark does not satisfy the requirements of-

- (a) rule 6(1), 7(1) or (2) or 8(1); or
- (b) section 38 of the Ordinance (which sets out requirements relating to applications),

the Registrar shall send a notice to the applicant informing him of the deficiencies and requesting him to remedy those deficiencies.

(2) An applicant to whom a notice is sent under this rule must remedy the deficiencies within 2 months after the date of the notice, and if he fails to do so-

- (a) where the deficiencies relate to rule 6(1), 7(1) or (2) or 8(1) or section 38(1), (2)(e), (3), (4) or (5) of the Ordinance, the application shall be treated as abandoned; and
- (b) where the deficiencies relate to section 38(2)(a), (b), (c) or (d) of the Ordinance, the application shall be deemed never to have been made.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	58	Heading:	Registrar may amend entries in the register (s. 58(1) & (2) of the Ordinance)	Version Date:	04/04/2003

Change of classification of goods or services

Subject to rules 59, 60 and 61 and section 58(5) of the Ordinance (which limits the Registrar's power to amend entries in the register), the Registrar may in order to-

- (a) reclassify the specification of a registered trade mark that is not founded on the classifications of the International Classification to one that is founded on such classifications; or
- (b) implement any amendment to, or substitution for, the classifications of the International Classification,

make such amendments to the entries in the register as he considers necessary for the purposes of reclassifying the specification of any registered trade mark.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	59	Heading:	Notice to owner of trade mark (s. 58(3)(a) & (c) of the Ordinance)	Version Date:	04/04/2003

(1) The Registrar shall, before he amends any entry in the register under rule 58, send to the owner of the registered trade mark in question a notice informing him of the proposals for amendment.

(2) The notice shall include a statement informing the owner that-

(a) he may file written objections to the proposals, within 3 months after the date of the notice, stating the grounds of his objections; and

(b) if no written objections are filed within the period specified in paragraph (a), the Registrar will publish the proposals in the official journal and the owner will not be entitled to make any objections to the proposals upon such publication.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	60	Heading:	Publication of proposals (s. 58(3)(b) of the Ordinance)	Version Date:	04/04/2003

(1) If the owner of a registered trade mark to whom a notice is sent under rule 59 does not file written objections within the period specified in rule 59(2)(a), or at any time before the expiry of that period files written notice of his intention not to make any objections, the Registrar shall as soon as practicable after the expiry of that period or receipt of that notice, as the case may be, publish the proposals for amendment in the official journal.

(2) If the owner files written objections within the period specified in rule 59(2)(a), the Registrar shall consider the objections and shall either abandon the proposals (if he is satisfied that the objections have merit) or, where he has amended the proposals, publish the proposals, as amended, in the official journal.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	62	Heading:	Application or notice to register registrable transaction (ss. 29 & 31(3) of the Ordinance) (Forms T10 & T11) (Fee No. 19)	Version Date:	04/04/2003

PART 8

REGISTRABLE TRANSACTIONS

- (1) An application under section 29 of the Ordinance to register particulars of a registrable transaction relating to a registered trade mark, or a notice under sections 29 and 31(3) of the Ordinance to register particulars of a registrable transaction relating to an application for registration of a trade mark, shall be filed on the specified form.
- (2) Where the registrable transaction is an assignment, the application or notice shall either be signed by or on behalf of the parties to the assignment or be accompanied by such documentary evidence as suffices to establish the assignment.
- (3) Where the registrable transaction relates to the grant of a licence or security interest, the application or notice shall either be signed by or on behalf of the grantor or be accompanied by such documentary evidence as suffices to establish the transaction.
- (4) Where the registrable transaction relates to the making by personal representatives of an assent, the application or notice shall either be signed by or on behalf of both the personal representative and the beneficiary or be accompanied by such documentary evidence as suffices to establish the transaction.
- (5) Where the registrable transaction relates to an order of a court or an authority recognized by the Registrar as a competent authority, the application or notice shall be accompanied by such documentary evidence as suffices to establish the transaction.

Chapter:	559A	Title:	TRADE MARKS RULES	Gazette Number:	L.N. 30 of 2003; L.N. 31 of 2003
Rule:	108	Heading:	Filing of documents with the Registrar	Version Date:	04/04/2003

PART 16

FILING AND SERVICE OF DOCUMENTS

(1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered to the Registrar at the Registry during the normal business hours of the Registry or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the Registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the Registry.

(3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the Registry.