

# TRADEMARK REGISTRATION IN HONG KONG SAR

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## **Legal Basis**

Originally 35 of 2000— L.N. 106 of 2002, L.N. 181 of 2002, 10 of 2005, L.N. 216 of 2005, L.N. 254 of 2009, L.N. 64 of 2013, E.R. 2 of 2014, L.N. 70 of 2014, L.N. 123 of 2015, L.N. 18 of 2017, 2 of 2020, 3 of 2020, E.R. 7 of 2020.

## **Types of Marks**

The applicant can register ordinary trade marks, defensive trade marks, collective marks and certification marks in Hong Kong.

A certification mark is a sign indicating that the goods or services in connection with which it is used are certified by the owner of the sign in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

A collective mark is a sign distinguishing the goods or services of members of the association which is the owner of the sign from those of other undertakings.

Defensive registration is available to protect marks that have become exceptionally well-known in the Hong Kong SAR.

## **Registrable Marks**

A trade mark means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically. A trade mark may consist of words (including personal names), indications, designs, letters, characters, numerals, figurative elements, colours, sounds, smells, the shape of goods or their packaging and any combination of such signs.

## **Well-Known Trademarks**

In determining whether a trade mark is well known in Hong Kong, the Registrar or the court shall take into account any factors from which it may be inferred that the trade mark is well known in Hong Kong, including, but not limited to, information concerning the following:

- (a) the degree of knowledge or recognition of the trade mark in the relevant sectors of the public;
- (b) the duration, extent and geographical area of any use of the trade mark;

- (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the trade mark, to the extent that they reflect use or recognition of the trade mark;
- (e) the record of successful enforcement of rights in the trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by competent authorities in foreign jurisdictions; and
- (f) the value associated with the trade mark.

The factors mentioned above are intended to serve as guidelines to assist the Registrar and the court to determine whether the trade mark is well known in Hong Kong. The determination in each case will depend upon the particular circumstances of that case.

A trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be the trade mark of a person who:

- (a) is a national of, or is domiciled or ordinarily resident in, a Paris Convention country or WTO member;
- (b) has a right of abode in Hong Kong; or
- (c) has a real and effective industrial or commercial establishment in a Paris Convention country, a WTO member or Hong Kong, whether or not that person carries on business in Hong Kong or owns any goodwill in a business in Hong Kong.

### **Signs Unregistrable as Marks**

The following shall not be registered:

- (a) signs which do not satisfy the requirements of meaning of “trade mark”;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs which have become customary in the current language or in the honest and established practices of the trade.

A trade mark shall not be refused registration by virtue of (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

A sign shall not be registered as a trade mark in relation to goods if it consists exclusively of: (a) the shape that results from the nature of the goods themselves; (b) the shape of goods that is necessary to obtain a technical result; or (c) the shape that gives substantial value to the goods.

A trade mark shall not be registered if it is contrary to accepted principles of morality; or likely to deceive the public.

A trade mark shall not be registered if, or to the extent that its use is prohibited in Hong Kong under or by virtue of any law; or the application for registration of the trade mark is made in bad faith.

A trade mark shall not be registered if, or to the extent that, it consists of or contains: (a) the national flag or its design, the national anthem; (b) the national emblem or its design; (c) the regional flag or its design; or (d) the regional emblem or its design.

### **Classification of Goods and Services**

Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification. Any question arising as to the class within which any goods or services fall shall be determined by the Registrar. The applicant shall list the goods and services in the class(es) they fall in according to general classification under the prescribed version of the prescribed edition of the Nice Classification by the World Intellectual Property Organization (WIPO) applied to the Hong Kong Special Administrative Region as effective of the date announced by the Registry.

One application can cover multiple classes of goods/services. The number of goods/services include in 1 class does not affect the filing fees.

An applicant can file a specification for the whole class heading of a particular class of the International Classification of Goods and Services, which becomes a statement of goods/services in that trade mark application. If the class heading is not sufficient to cover the range of goods/services for which the applicant has used or intended to use or licensed the trade mark, the applicant should specifically list out the goods/services in the trade mark application.

Please however note that if the applicant includes a large variety of goods or services in an application, the Registry may invite the applicant to justify his intention to use the mark sought to be registered in respect of such specification.

### **Claim to Priority**

A person who has duly filed an application for the registration of a trade mark in, or in respect of, a Paris Convention country or WTO member, or his successor in title, shall enjoy, for the purpose of registering the same trade mark in Hong Kong in respect of any or all of the same goods or services, a right of priority for a period of 6 months after the date of filing of the first of any such applications, subject to compliance with any prescribed conditions. Priority documents is not required to submit with Registry.

### **First-to-Use Rule**

Hong Kong's trademark law is based on the British trademark law system and belongs to the same common law system as the United Kingdom. The registration of trademarks in Hong Kong is mainly based on the first-to-use principle, supplemented by the first-to-file principle.

### **Documents/information Required for New Filings**

Each application must include the following documents/information:

1. The applicant's name and address;
2. One clear sample of the trademark,

The length of each side of the images should be between 100 pixels and 2,000 pixels. To avoid unclear image, it is recommended that the whole image size should be equal to or greater than 200,000 pixels, e.g. 100 pixels x 2,000 pixels, 400 x 500 pixels. Moreover, to avoid distortion of image, it is recommended that the same dpi to be used for the width and height of the image. The trademark representation has to be of a kind and quality that is suitable for reproduction and registration. Please avoid providing representation(s) without a background or with a transparent background.

3. Priority information, if claimed;
4. Colors of the color mark, if claimed.

### **Examination Process**

There are four stages in the process of examining an application for registration:

1. deficiency checking

2. examination against the requirements of the Trade Marks Ordinance
3. acceptance and publication for opposition
4. registration and issue of certificate of registration.

### **Deficiencies in Application for Registration**

Shortly after an applicant files an application for registration, the Registry will check that the information about the applicant's name, address, the representation of the mark, the goods and services and other information is complete and correct. If the application is not complete and correct, the Registrar will send the applicant a deficiency notice so that the applicant can correct the deficiency within two months. The deficiency notice will tell the applicant whether the deficiency affects the filing date of the application and which Registry form the applicant should use to file his correction.

An applicant must remedy all deficiencies in his application for registration within two months after the date of the Registry's notice to remedy them. The two months cannot be extended. The Registry will accord the application a filing date if it includes a request for registration of the trade mark, the applicant's name and address, a statement of the goods or services and a representation of the trade mark, and the application fee is paid in full. If an application does not include this information or full payment, the Registry will not be able to accord a filing date until it does. If other information in the application is deficient, it will not affect the filing date provided the applicant remedies the deficiencies within the two months.

### **Dividing Applications**

An applicant can file a request to divide his application at any time after it has been given a filing date and before it is registered. The applicant can divide his application for registration of a series of trade marks to overcome an objection that the marks are not a series. The date of application of the divisional application shall be the same as that of the parent application.

### **Renewal and Restoration**

A mark registered shall be registered for a period of 10 years beginning on its date of registration. For example, if the date of registration for your mark is 10 September 2003, it shall be registered for an initial period of 10 years until 9 September 2013. An owner should renew his mark during the six-month period ending on the date of expiry, i.e. latest by 9 September 2013. A request for renewal must be made, and the renewal fee paid, before the expiry of the registration; and failing this, the request may be

made and the renewal fee paid within such further period, of not less than 6 months, as may be prescribed, in which case an additional prescribed fee must also be paid within that period. The registration of the mark may be renewed for further periods of 10 years. In the above example, if the owner renews his mark for a further period, the next expiry date will be 9 September 2023 (assuming all the above dates are business days).

There is a deadline for restoration of a trademark registration. An owner must file a request to restore the trade mark within six months after the date the mark is removed (《Trademark Rules》 rule 35). The six-month period cannot be extended.

### **International Registration of Trade Marks**

The Amendment Ordinance came into operation as of June 19, 2020, except Section 5 and Part 4 of the Amendment Ordinance concerning trade mark rights acquired in Hong Kong under the Madrid Protocol, which shall come into operation on a day to be appointed by the Secretary for Commerce and Economic Development by notice published in the Gazette after completing the relevant preparatory work.

### **Infringement of Registered Trade Mark**

(1) A person infringes a registered trade mark if he uses in the course of trade or business a sign which is identical to the trade mark in relation to goods or services which are identical to those for which it is registered.

(2) A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is identical to the trade mark in relation to goods or services which are similar to those for which it is registered; and

(b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

(3) A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is similar to the trade mark in relation to goods or services which are identical or similar to those for which it is registered; and

(b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

(4) A person infringes a registered trade mark if

(a) he uses in the course of trade or business a sign which is identical or similar to the trade mark in relation to any goods or services;

(b) the trade mark is entitled to protection under the Paris Convention as a well-

known trade mark; and

(c) the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(5) For the purposes of this section a person uses a sign if, in particular, he:

(a) applies it to goods or their packaging;

(b) offers or exposes goods for sale under the sign;

(c) puts goods on the market under the sign;

(d) stocks goods under the sign for the purpose of offering or exposing them for sale or of putting them on the market;

(e) offers or supplies services under the sign;

(f) imports or exports goods under the sign; or

(g) uses the sign on business papers or in advertising.

(6) Notwithstanding subsection (5), a person who applies or causes to be applied a registered trade mark, or a sign similar to a registered trade mark, to material which is intended to be used

(a) for labelling or packaging goods;

(b) as a business paper; or

(c) for advertising goods or services,

shall be treated as a party to any use of the material which infringes the registered trade mark if, at the time the trade mark or sign was applied to the material, he knew or had reason to believe that its application to the material was not authorized by the owner of the registered trade mark or by a licensee.

### **Review of Refusal and Hearing**

The registry may send the applicant an opinion raising objections to a mark, the Registry will explain in the opinion what steps the applicant should consider taking to meet the requirements for registration. The applicant has six months to reply to the opinion. If the applicant does not respond to the letter within the specified six-month period, the registry will send a notice informing the applicant that his application has been refused. If the applicant's written representations cannot establish that the requirements for registration are met, after expiry of the specified six-month period, the Registry will send the applicant a further opinion explaining the objections and giving the applicant three months to resolve them by taking any of steps.

The applicant can file a request for a hearing before the three-month deadline to respond to the Registry's further opinion expires. If a request for hearing is filed duly by the applicant, the Registry will send a notice of hearing to the applicant, setting out the date, time and venue for the hearing. An applicant has 14 days from the date of

the notice of hearing to file notice of his intention to appear at the hearing on Form T12 with the prescribed fee. The fee is non-refundable. A hearing officer will hear the case on the appointed date, and issue a decision.

The applicant may lodge an appeal against the Registrar decision to the High Court. Generally, the appeal must be brought within 28 days after the date of the Registrar decision.

### **Opposition and Hearing**

If a trade mark is accepted for registration by the Trade Marks Registry, it will be published in the Hong Kong Intellectual Property Journal. If anyone wishes to oppose the application for registration, he has to file an opposition notice within 3 months beginning on the publication date. The opposition notice should state the grounds on which he opposes. Within time limits, the applicant will file a counter-statement and both the opponent and the applicant will have an opportunity, within time limits, to file evidence in support of the opposition and application. Upon receipt of all the evidence, the Registry will send a notice of hearing to both parties, setting out the date, time and venue for the hearing. Either the opponent or the applicant has 14 days from the date of the notice of hearing to file notice of his intention to appear at the hearing on Form T12 with the prescribed fee. The fee is non-refundable. A hearing officer will hear the case on the appointed date, and issue a decision. The successful party in opposition proceedings will usually be entitled to an award of costs.

If the applicant does not file a counter-statement within the time allowed, his application for registration shall be treated as withdrawn. If the opponent does not file evidence within the specified period, he shall be deemed to have abandoned his opposition. Any party does not take proper actions to meet the time limit, it will be sentenced to lose in the opposition proceedings,

Either party may lodge an appeal against the Registrar decision to the High Court. Generally, the appeal must be brought within 28 days after the date of the Registrar decision.

### **Declaration of Invalidity of Registration**

(1) An application for a declaration of invalidity of the registration of a trade mark may be made by any person, and may be made either to the Registrar or to the court.

(2) In the case of bad faith in the registration of a trade mark, the Registrar himself

may apply to the court for a declaration of the invalidity of the registration.

(3) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in contravention of Trade Marks Ordinance section 11(absolute grounds for refusal of registration).

(4) Where the trade mark was registered in contravention of Trade Marks Ordinance section 11(1)(b), (c) or (d), it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(5) Subject to subsections (6) and (7), the registration of a trade mark may also be declared invalid on the ground:

(a) that there is an earlier trade mark in relation to which the conditions set out in Trade Marks Ordinance section 12(1), (2) or (3) (relative grounds for refusal of registration) apply; or

(b) that there is an earlier right in relation to which the condition set out in Trade Marks Ordinance section 12(4) or (5) (relative grounds for refusal of registration) is satisfied.

(6) The registration of a trade mark may not be declared invalid under subsection (5) if the owner of the earlier trade mark or other earlier right has consented to the registration.

(7) Where a trade mark has been registered on the ground that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right, as provided for by Trade Marks Ordinance section 13(honest concurrent use, etc.), the registration of a trade mark may not be declared invalid under subsection (5) unless the Registrar or the court is satisfied that in fact there had been no honest concurrent use of the trade mark and the earlier trade mark or other earlier right.

(8) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(9) Without affecting transactions past and closed, where the registration of a trade mark is declared invalid under this section to any extent, the registration shall to that extent be deemed never to have been made.

### **Revocation of Registration**

(1) An application for the revocation of the registration of a trade mark may be made by any person, and may be made either to the Registrar or to the court.

(2) The registration of a trade mark may be revoked on any of the following grounds, namely: (a) that the trade mark has not been genuinely used in Hong Kong by the owner or with his consent, in relation to the goods or services for which it is

registered, for a continuous period of at least 3 years, and there are no valid reasons for non-use (such as import restrictions on, or other governmental requirements for, goods or services protected by the trade mark);

(b) that the trade mark consists of a sign that, in consequence of the acts or the inactivity of the owner:

(i) has become the common name in the trade for goods or services for which the trade mark is registered; or

(ii) has become generally accepted within the trade as the sign that describes goods or services for which the trade mark is registered;

(c) that in consequence of the use made of it by the owner or with his consent, in relation to the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services; or

(d) that there has been a contravention of or a failure to observe any condition entered in the register in relation to its registration.

(3) For the purposes of subsection (2):

(a) use of a trade mark includes use in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered;

(b) use of a trade mark in Hong Kong includes applying the trade mark to goods or to the packaging of goods in Hong Kong solely for export purposes; and

(c) use of a trade mark in Hong Kong includes, where the trade mark is registered in respect of services, use in relation to services provided or to be provided outside Hong Kong.

(4) Subject to subsection (5), the registration of a trade mark shall not be revoked on the ground mentioned in subsection (2)(a) if the use described in that subsection is commenced or resumed after the expiry of the 3-year period and before the application for revocation is made.

(5) Any commencement or resumption of the use described in subsection (2)(a) after the expiry of the 3-year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the owner of the registered trade mark became aware that the application might be made.

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(7) Where the registration of a trade mark is revoked to any extent, the rights of the owner shall be deemed to have ceased to that extent as from:

- (a) the date of the application for revocation; or
  - (b) if the Registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that earlier date.
- (8) For the purposes of subsection(2)(a), the 3-year period may begin at any time on or after the actual date on which particulars of the trade mark were entered in the register under Trade Marks Ordinance section 47(1)(registration).

### **Registration of a Registrable Transaction**

A registrable transaction is a transaction that affects any right in either a trade mark registered in the Hong Kong SAR or an application for registration of a trade mark filed in the Hong Kong SAR (collectively “TM right”).The following are registrable transactions:

- a. an assignment of any TM right;
- b. licensing of any TM right;
- c. the grant of any security interest over any TM right;
- d. the making by a personal representative of an assent in relation to any TM right;
- e. an order of a court transferring any TM right.

Registration of a registrable transaction is optional but strongly encouraged to safeguard the rights of the relevant party/parties to the transaction. More specifically, while registration is not a pre-requisite to the validity of the underlying transaction, non-registration may lead to certain adverse consequences, namely:

- a. the transaction is ineffective as against a person acquiring a conflicting interest in the relevant TM right(s) without knowledge of the transaction;
- b. (where the registrable transaction is licensing of any TM right) the licensee does not enjoy various statutory protection, including its rights in relation to infringement of the trade mark; and/or
- c. the person who becomes the owner or a licensee of a trade mark by virtue of the transaction will not be entitled to damages or an account of profits for any infringement of the trade mark occurring after the date of the transaction.

It is advisable to apply for registration of a registrable transaction as soon as practicable after the date of the transaction. Where there is a change of ownership in or a licensing of the trade mark concerned by virtue of a registrable transaction, an application for registration of the registrable transaction should be filed within 6 months from the date of the transaction, or else the new owner or the licensee will be deprived of damages or an account of profits as aforesaid.

An application for registration of a registrable transaction has to be filed with the Registrar of Trade Marks. There is no need to produce documentary evidence for filing with the Registrar of Trade Marks in support of an application for registration of a registrable transaction, provided that the relevant official form is signed by or on behalf of the assignor, the grantor of the licence/security interest, or the personal representative making the assent, as the case may be.

Otherwise, the documentary evidence of the registrable transaction required to be produced for filing will also be open to public inspection.

### **Marking**

The owner can only use the ® with his trade mark if he has registered the mark in the Hong Kong SAR, or if it is shown that the mark is in fact registered elsewhere, for his goods or services. If the owner has not registered his mark in the Hong Kong SAR or elsewhere, it is an offence to use the ® and he may be liable on conviction to a fine.

### **Trade Mark Agent**

Any person, partnership or company can act as a trade mark agent in any proceedings in the Trade Marks Registry. An agent must have a residence or a place of business in Hong Kong. An agent can act and sign for an applicant, a registered owner or other person in connection with any proceedings under the Trade Marks Ordinance. However, an agent cannot make a statutory declaration or affidavit (unless he has first hand knowledge of the facts) or give or revoke a power of attorney on behalf of an applicant or other person for whom he acts.

CLT Patent & Trademark (H.K.) Limited (“CLT”), also working as Hong Kong representative office of CCPIT PATENT & TRADEMARK LAW OFFICE, founded in Hong Kong, on the date of June 19, 1998, is a local professional IP agency operating under the laws of Hong Kong SAR. With its root in Hong Kong SAR, CLT provides both local and global clients with a wide range of IP services relating to patent, design, and trademark, as well as IP strategy consultation. Should there be any questions regarding IP related matters in Hong Kong SAR, please kindly feel free to contact [mail@ccpit-patent.com.cn](mailto:mail@ccpit-patent.com.cn) or [hongkong@ccpit-patent.com.cn](mailto:hongkong@ccpit-patent.com.cn).