

Address for service and change of name, address or address for service

Address for service

An address for service of a person or a party is important for the purpose of communication between that person or party on the one hand and the Registrar and other parties on the other.

Any document or other thing required or authorized by the Ordinance or the Rules to be sent to any person will be considered properly sent if it is left at, or sent to him by post, at his address for service (rule 112).

An address for service in Hong Kong must be filed by every person who files :

- an application for registration of a trade mark;
- a notice of opposition/objection, an application for revocation, declaration of invalidity, variation or rectification or a counter-statement;
- application for leave to intervene or to be substituted for another party;
- application or notice to register particulars of a registrable transaction, or an amendment/removal of such particulars; and
- other documents listed in rule 105(1) and any other document where the specified form requires an “address for service”.

An address for service must be a residential or business address in Hong Kong (rule 105(2)). It cannot be a P.O. Box or e-mail address.

An address for service filed with an application for registration of a trade mark shall, subject to any filing to the contrary, be treated as the address of service of the owner of the trade mark upon registration (rule 105(7)).

An applicant for registration of a trade mark or an owner of a registered mark can only use one address for service for the purposes of all proceedings before the Registrar in relation that mark (rules 105(5) and 105(6)). For example, an applicant for registration of a mark cannot use one address for service for processing his application for registration of the mark, and another address for service for processing his application to record a licence of the same mark. If he owns more than one mark, he can have a different address for service for each of his marks.

Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings (rule 105(8)). Take an example of an opponent who has filed a notice of opposition on Form T6 with a particular address for service, and who later files a request on Form T13 for an extension of time to file evidence in respect of that opposition, with another address for service. The address for service of the opponent for the purposes of that opposition will be changed from that given in the Form T6 to that given in the Form T13.

Since an owner of a registered mark can only use one address for service for that mark, whenever he files a form and gives an address for service different from the one already on the register, the new address for service will automatically replace the previous one for the purposes of that registered mark.

An exception is in the case of renewal. The person filing a request for renewal (or

restoration and renewal) is required only to provide a “contact address for person filing this (renewal) request” in Box 7 of Form T8. This is not an address for service for any purpose other than the subject renewal (and restoration, if applicable) of the mark, and it will not replace the address for service on record for that mark. (The next renewal reminder will still be sent to the address for service on record for that mark.)

Co-owners

Only one address for service may be filed in relation to any application, notice, request or other document that is filed in the name of 2 or more persons. This address shall be treated as the address for service of each of these persons (rule 105(4)).

Agents

Where a person who has become a party to proceedings before the Registrar appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent has to file:

- an address for service in Hong Kong (rules 105(2) and 105(9)) and;
- the address in Hong Kong where he resides or carries on his business activities (rules 103(3)).

No act required or authorised by the Ordinance or the Rules to be done by or to a person, can be done by or to the newly appointed agent before he files an address for service in Hong Kong and the address in Hong Kong where he resides or carries on his business activities (rules 103(5) and 105(10)). See chapter on Agents.

Filing of address for service

An address for service can be filed either by providing an address for service on any specified form that requires an address for service or by notice in writing to the Registrar (rule 105(3)).

Change or withdrawal of address for service

Any person can change his address for service by filing Form T5 or by notifying the Registrar in writing (rule 106(1)). An applicant can also withdraw his address for service by notifying the Registrar in writing (rule 106(3)).

Failure to file an address for service

If an address for service is not filed in accordance with rule 105, or where we are satisfied that an address for service is no longer valid, we may send a notice requesting the filing of an address for service to the person concerned at one of the following addresses (rules 107(1) and 107(2)) :

- any previously filed address for service of that person;
- any address of that person in Hong Kong that is shown in the register;
- any residential or business address of that person in Hong Kong; and
- any other address of that person that is known to the Registrar.

If a person to whom such a notice is sent fails to file an address for service within 2 months after the date of the notice:

- any application, notice, or request filed by that person shall be treated as abandoned or withdrawn; and

- the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party

(rule 107(3)).

Whenever a Form T6 is filed by a party without giving an address for service and he also has not given one previously in respect of the relevant proceedings, a notice requesting the filing of an address for service should be sent to him as soon as possible.

Change of name or address in the register

A change in the name or address of a trade mark owner, licensee, or person having a registered interest in or charge on a registered trade mark can be effected by filing Form T5 (rule 65). No fee is payable. A request for change of name or address can relate to more than one registered mark or application for registration.

By contrast, a change in the identity of a trade mark owner, for example in a corporate merger, is an assignment/transfer of the trade mark and is a transaction registrable under section 29 and rules 62 and 63.

Where a request is made to record a change in the name of the owner, licensee, or person having a registered interest in or charge on a registered trade mark, we usually rely on a signed Form T5 which includes a confirmation that there is no change in the identity of such person, i.e. it is the same legal person before and after the change. If there is any doubt (an obvious example being a change from a natural person to a company), we may ask the person filing the request for change to clarify the

circumstances leading to the “change in name” and to provide evidence in support of the change as appropriate (rule 65(2)).

* * *