

Hearings

Opposition/revocation etc hearings

Once the evidence rounds have been completed, the matter is considered “ready” for hearing and shall be entered on the “pending hearing” list. Hearings will, in normal circumstances, be fixed in the order that they are entered onto the pending hearing list. Where possible, the parties will be advised that their matter is likely to be reached within the next 3 to 6 months. If a hearing is no longer required, this is an opportunity to advise the Registrar so that hearing time is not unduly wasted.

The Registrar will, on his own initiative (rule 74(4) and (7)) fix the date, time and place for the hearing and send a notice of this to the parties. The Registrar will endeavour to give the parties 2 months’ notice of a formal fixture.

Any party who intends to appear at the hearing shall file notice of his intention to appear on Form T12 together with the specified fee within 14 days after the date of the notice sent pursuant to rule 74(3) or (4). This period is extendible (rule 94). Any party seeking an extension must however send a copy of the request to every other party to the proceedings (rule 94(2)). If Form T12 and the accompanying fee is not received at the Registry within the 14 days specified or any agreed period of extension, that party may be treated as not desiring to appear at the hearing.

The Registrar may direct the parties who have filed Form T12 and paid the specified fee, to attend a pre-hearing review pursuant to rule 87. No less than 7 days notice will be given of the date, place and time of the pre-hearing review in accordance with rule 87(2).

If neither party files Form T12 the provisions of rule 75 will come into play and the matter decided on the evidence filed, and on consideration of the written submissions filed (if any) but without a hearing.

Who may attend

Any party who has complied with rule 74(5) or his representative may attend the hearing in person or by such other means as the Registrar allows (rule 76(1)). The Registrar will generally permit representation by counsel, an agent currently on the record for the matter; a duly authorised officer where the party is a company, or a partner where the party is a partnership. The hearing is open to the public (rule 77).

Order of addresses

Under Cap. 43, the ultimate burden of proving that the mark applied for should be accepted lay with the applicant for registration, and accordingly he had the opening and closing speech. Under Cap. 559 there is no such presumption, in fact, the opposite may be the case.

“The burden of proof in an opposition such as this lies on the opponent. It is for the opponent to show that the relevant likelihood of confusion exists” – *REACT Trade Mark* [2000] RPC 285 at 287.

In *AUDI-MED Trade Mark* [1998] RPC 863 at 868 the Registrar had this to say :

“In the *EUROLAMB Trade Mark* [1997] RPC 279 Geoffrey Hobbs QC, sitting as the Appointed Person on appeal from the registrar, decided that section [40] of the [Ordinance] was neutral as concerns the relationship between the registrar and an applicant. If that is right it is difficult to see why there should be a greater onus on an applicant if there is a subsequent opposition... It is therefore difficult to identify any specific provision in the [Ordinance] which could have the effect of placing an overall onus on an applicant in an opposition... I conclude that the onus under section [12(4)] of the [Ordinance] is on an opponent to show that the use of the mark applied for will take unfair advantage of and/or be detrimental to

the opponent's earlier mark or its reputation. If he succeeds in doing so the applicant must, in order to avoid the refusal of his application, show that he nevertheless has "due cause" to use the mark applied for."

The order of addresses for an opposition, following the ultimate burden of proof, shall accordingly be: opponent – applicant – opponent.

The order of addresses for revocation on grounds other than non-use, invalidity and variation by someone other than the registered owner shall be: applicant – owner – applicant.

The order of addresses for revocation on the ground of non-use shall be: owner – applicant – owner.

For inter partes interlocutory applications, the applicant for extension of time or the applicant for leave to amend pleadings, to file further evidence, etc., has the burden of proof. The order of addresses shall accordingly be: applicant for extension/leave – the other side – applicant for extension/leave.

In cross-applications when it is not obvious which party should have the right to open and reply, the matter will be settled, either by agreement, or by the Registrar.

Language of the hearing

Where a party in a hearing before the Registrar or any witness called to give evidence by such party, wishes to give evidence in a language other than the language of the proceedings, the Registrar and the other party must be given at least 10 days prior written notice of his intention. The power to allow this course of action is discretionary. The Registrar, if he allows it, may require the party giving such notice to make provision for interpretation into the language of the proceedings and may give directions as to who should bear these costs (rule 78).

Oral evidence and cross-examination

See discussion in the *Evidence* section.

Decisions

When the Registrar has made his decision, he shall send a notice to all parties informing them of the decision (rule 91(1)).

Where a statement of the reasons for the decision is not included in the notice, any party wishing to have a statement of the reasons for the decision must file a request on Form T12 together with the specified fee. This must be received at the Registry within one month after the date of the notice. This period is extendible (rule 94). At the same time as filing a request for a statement of the reasons for the decision the party so requesting, shall send a copy to each other party to the proceedings (rule 91(3)). Once prepared, the statement of reasons for decision will be sent to each party to the proceedings (rule 91(2)).

Uploading of decisions

Statement of reasons of decision issued after a hearing should be uploaded onto our website. Where a matter proceeds by way of a hearing on the papers, statement of reasons issued should also be uploaded onto our website.

Appeal

For the purposes of an appeal against the Registrar's decision, time runs from the date when the "letter" decision is sent out, unless a request is filed for a statement of reasons

for decision, in which latter case, time will run from the date on which the statement is sent (rule 91(4)). Although the effect of section 85 is that an appeal is a hearing *de novo*, it would assist the appellant court to have full reasons for the Registrar's decision available to it, and accordingly the existing practice to call for written reasons when an appeal is being considered should continue.

Ex-parte hearings – registrability

The statutory frame work for the examination of an application to register a trade mark is set out in section 42 and rules 13 – 14. See chapter on Examination of applications.

Provision is made in rule 13(5) for an applicant whose application does not, in the opinion of the Registrar, meet the requirements for registration, to file a request for a hearing. Pursuant to rule 13(5), the time limit for doing so is within 3 months after the date of the report under rule 13(4). This period is not extendible (rule 95(1)(c)) except in accordance with rule 13(6).

There is no specified form to be used for requesting a hearing and no fee payable.

Processing a request for a hearing

Upon receipt of the request for a hearing check the following :

- If it relates to a trade mark application, that it was received within 3 months after the date of the notice given under rule 13(4);
- The request should immediately be drawn to the attention of AD(H) and the colleague currently in charge of the preparation of the registrability hearing list notified;

- When so advised, write to the applicant advising him of the date, time and place fixed for the hearing (rule 74(3)). The applicant must be given not less than 14 days notice of the hearing date (section 70(2)). In practice, the period will be longer to give the applicant time to comply with rule 74(5);
- The hearing date is entered into the computer system; and
- The hearing room is booked in the computer system if this has not already been done.

Options available to the applicant

If the applicant intends to appear at the hearing, he must, within 14 days after the date of the notice advising the date, time and place fixed for the hearing, file notice of his intention to appear on Form T12 together with the specified fee (rule 74(5)).

Form T12 is the form for notifying the Registrar of a party's intention to appear at a hearing or for requesting statement of reasons. It is not for adjourning a hearing. If a party has no intention to appear at a hearing or to request statement of reasons, Form T12 should not be filed. If extension of time is required, request should be made on Form T13 and in accordance with rule 13(6).

Although the applicant can apply for an extension of time for filing notice of his intention to appear at the hearing under rule 94, an applicant must give good reasons for an extension request. Reasons like 'The applicant is considering how to proceed', 'We are considering whether to file evidence', 'We are considering to file further evidence' or 'We are awaiting instructions from the applicant' are not reasons for allowing an extension of time. Additionally, as rule 74(5) states that the applicant should file notice of his intention within 14 days, any extension that the Registrar allows is likely to be short.

On filing notice of his intention to appear, an applicant may ask for the hearing to be postponed if he, or counsel cannot attend on the appointed hearing date, or for other good reason. If the Registrar considers the request to be reasonable, he would appoint a new date for the hearing and give notice to the applicant. The Registrar will not normally postpone a hearing for more than once. Where the application is faced with relative grounds objections, and proceedings for the invalidation or revocation of a relevant earlier trade mark have been instituted and are pending, the Registrar may postpone the hearing. The applicant would have to keep the Registrar informed of developments.

If the applicant fails to file notice of his intention to appear at the hearing, or is content to file written submissions (which must be received on or before the day appointed for the hearing), the Registrar shall treat the applicant as not wishing to appear and shall reach a determination on the materials available to him.

The file is brought up 14 days after the date of the notice advising the applicant of the fixture to check whether Form T12 or an application to extend time pursuant to rule 94 has been received. The assigned Hearing Officer is to be advised of the position. Any time extension application is to be referred to the assigned Hearing Officer.

If the applicant does not intend to appear, the booking of the hearing room is cancelled.

Any material which the applicant wishes to place before the Registrar for consideration must be exhibited to a statutory declaration or affidavit (rule 79).

Written submissions without exhibits may take any form. If reference is made to any case law, a copy of the decision is to be supplied to the Registrar.

Who may attend

See corresponding section in *Opposition/revocation etc hearings*.

Procedure after a determination is made

The Registrar shall, pursuant to section 42(6) and rule 91(1), notify the applicant in writing whether the mark is accepted for registration pursuant to section 42(5) (at which point the hearing process ceases) or refused pursuant to section 42(4).

Where a statement of reasons for the decision is not included in the notice, the applicant may make a request for a statement of the reasons for the decision by filing Form T12 with the specified fee. This must be received at the Registry within one month after the date on which the notice of the decision was sent to him. This period is extendible (rule 94).

If no notice of appeal is received within 28 days from the date of decision (calculated in accordance with rule 91(4) and O.55, r.4(2)), the application to register the trade mark can be considered as abandoned.

Uploading of decisions

Where a statement of reasons is requested and issued, it should be uploaded onto our website. Whenever a Form T12 is filed indicating intention to appear at a hearing, any statement of reasons issued should be uploaded onto our website. This includes cases where no oral hearing took place and the matter proceeded by way of a hearing on the papers.

Appeal

See the corresponding section in *Opposition/revocation etc hearings*.

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