

Renewal and restoration

Application of the new law

Registration dates from the filing date of an application for registration, not from the priority date (sections 39 and 48).

Registration is for a period of 10 years beginning on the date of registration (section 49(1)). Renewal is for a further period of 10 years (section 49(2)). A renewal fee (including a class fee for each class in a multi-class registration) is payable (section 50(1); rules 32(1) and 33(2)). Renewal takes effect from the expiry date (section 50(4)).

For example:

Date of registration:	10 June 2003
Expiry date:	9 June 2013
If renewed for another 10 years, next expiry date:	9 June 2023

(assuming all the above dates are business days)

Late renewal within 6 months after expiry is still possible on the payment of a late renewal fee (section 50(3) and rule 32(3)).

Failure to renew within 6 months after expiry results in the mark being removed from the register (section 50(5) and rule 34). A request for restoration and renewal must be made and the applicable fee for restoration and renewal paid within 6 months after the date of removal (section 50(6) and rule 35(1)). The time limit cannot be extended (rule 95(1)(j)).

Before expiry, the Registrar sends the owner a reminder of renewal (rule 31). After expiry, the Registrar publishes a list of registrations that have not been renewed (rule 32(2)). Similarly, after the Registrar removes a trade mark from the register for failure to

renew, he publishes a notice of the removal (rule 34(3)), and where the Registrar restores a registration, he publishes a notice of the restoration in the Hong Kong Intellectual Property Journal (rule 35(2)).

Reminder of a renewal of registration

No earlier than 6 months and no later than 1 month before expiry, the Registrar will send a notice of approaching expiry to the registered owner (section 50(2) and rule 31(1)). The notice includes Form T8 on which the request for renewal should be made. A notice does not need to be sent if renewal has already been effected (rule 31).

An exception is where an application for registration has been long running, and on the date which is 6 months before the date when renewal would have been due (by reason of the date of application), the mark is not yet registered. In this situation, a reminder of renewal can be sent within 1 month after the mark is actually registered (rule 31(2)).

Example

Actual date of registration :	15 July 2010
Expiry date :	1 August 2010
Renewal reminder to be sent :	at the latest by 15 August 2010
Renewal fees payable :	at the latest by 15 January 2011 (6 months after the actual date of registration)

Examining a renewal request

Factors to be considered when examining renewal requests are :

- Is the request made on the specified form, Form T8 (section 50(1); rules 32(1) and 33(2))?

- Was the request made within 6 months before expiry (rule 32(1))? A request made earlier should be refused. If the request was made within 6 months before expiry, has the renewal fee been paid (section 50(1) and rule 32(1))?

- Was the request made and the renewal fee paid before expiry (section 50(3) and rule 32(1))? If not, has the request been made, and the renewal fee and the late renewal fee been paid, within 6 months after expiry (section 50(3) and rule 32(3))? The time limit cannot be extended (rule 95(1)(h)).

- Exceptionally, where an application for registration has been long running and is not registered by the date which is 6 months before the date on which renewal would have been due, has the request been made and the renewal fee been paid within six months after the date of actual registration (rules 33(1) and 33(2))? The time limit cannot be extended (rule 95(1)(i)).

Renewal

Steps to be taken on the renewal of registrations :

- Renew the registration with effect from the expiry of the previous registration (section 50(4)).

- Publish notice of the renewal in the Hong Kong Intellectual Property Journal (section 50(7); rules 32 (4) and 33(3)).

Publishing the fact of expiry and removing the registration

Steps to be taken on the expiry of registrations :

- On expiry of the registration, if the request for renewal has not been filed or the

renewal fee has not been paid, publish the fact of expiry in the Hong Kong Intellectual Property Journal (rule 32(2)).

- 6 months after expiry, if a request for renewal has not been made or the renewal fee and late renewal fee have not been paid, remove the trade mark from the register (rule 34(1)). The time limit cannot be extended (rule 95(1)(h)).

- Publish notice of the removal in the Hong Kong Intellectual Property Journal (rule 34(3)). An expired mark is still cited against later applications for registration for 1 year after expiry, even if the mark is removed from the register (section 5(3)).

- Where an application for registration has been long running and is not registered by the date which is 6 months before the date when renewal would have been due, remove the trade mark from the register if the request for renewal has not been made and the renewal fee has not been paid within 6 months after the date of actual registration (rule 34(2)). The time limit cannot be extended (rule 95(1)(i)). Publish notice of the removal and the date of removal in the Hong Kong Intellectual Property Journal (rule 34(3)).

Examining a request for restoration and renewal

Factors to be considered when examining requests for restoration :

- Is the request made on the appropriate Form T8 (section 50(6) and rule 35(1))?

- Has the applicable fee for restoration and renewal been paid (rule 35(1))?

- Was the request for restoration and renewal filed within 6 months after the date of removal (rule 35(1))? The time limit cannot be extended (rule 95(1)(j)).

- Does the request for restoration give reasons for the failure to renew? In view of the failure to renew, is it just to restore the trade mark to the register (section 50(6) and rule 35(1))? An owner should give reasons for the failure to renew. If there have been changes in the ownership of the mark, he must explain his claim to ownership and file any necessary forms to register particulars of assignments or other registrable transactions. In considering whether it is just to restore the trade mark to the register, we should consider all the circumstances of the failure to renew. Generally, it would be just to restore the mark where the owner had in place a proper system for renewing the registration and an application to restore was filed as soon as practicable after the omission became apparent.

Restoring the mark to the register

Steps to be taken in restoring the trade mark to the register :

- Restore the mark to the register and renew the registration with effect from the expiry of the previous registration (sections 50(4), and 50(6); rule 35(1)).
- Publish a notice of the restoration of the registration and the date of restoration in the Hong Kong Intellectual Property Journal (section 50(7) and rule 35(2)).

Transitional provisions

The new law applies to applications for registration filed on or after the commencement date, or filed before and converted, and to renewals of registered marks falling due on or after the commencement date (section 97; sections 11 and 14 of Schedule 5). The applications are registered for an initial term of 10 years and registrations can be renewed for consecutive terms of 10 years.

The old law applies to applications for registration filed before the commencement date and not converted (section 97; sections 10(1) and 14 of Schedule 5). These applications

are registered for an initial term of 7 years.

* * *