

Surrender of registered trade marks

Application of the new law

An owner can surrender his registration in respect of some or all of the goods or services (section 56).

An owner must notify every person having a registered interest or any other right in the mark before he files a notice of surrender (rule 56(2)(c) and (d)).

Surrender takes effect on the filing of a notice that complies with the rules (rule 57(2)). Third parties and persons having a registered interest in the mark do not have rights under the rules to object to or to oppose a notice of surrender that complies with the Rules.

Examining a notice of surrender

Factors to be considered when examining notices to surrender the registration of trade marks :

- Is the notice of surrender made on the specified form, Form T9 (rule 56(1))?
- Is the notice given by, and signed by or on behalf of, the owner (section 56(1))?
- Does the notice :

- state the registration is to be surrendered in respect of all of the goods or services of the registration (rule 56(2)(a)), or in respect of the goods or services specified in the notice (rule 56(2)(a) and (b))?
- state the name and address of any other person having a registered interest or any other right in the trade mark (rule 56(2)(c))?
- certify that every person named as having a registered interest or any other right in the mark has been sent not less than 3 months' notice of the owner's intention to surrender the registration (rule 56(2)(d)(i)), or is not affected or, if affected, consents to the surrender (rule 56(2)(d)(ii)) (Box 5 of Form T9)?

Effecting the surrender

If the surrender is effective :

- enter the surrender in the register (rule 57(3)); and
- publish notice of the surrender in the Hong Kong Intellectual Property Journal (rule 57(3)).

Transitional provisions

The new law applies to notices of surrender filed on or after the commencement date.

The old law applies to requests to cancel the entry of a trade mark on the register (section 50(1)(c) of Cap. 43) or to strike out any goods or services from a registration (section

50(1)(d) of Cap. 43) filed before the commencement date under the old law and which are pending on the commencement date (section 97; section 17(1) of Schedule 5).

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