

Transitional arrangements

Introduction

Section 99 of the new Trade Marks Ordinance (Cap. 559) repeals the Trade Marks Ordinance (Cap. 43) and the Trade Marks Rules (Cap. 43 sub. leg.) as from the commencement date.

Schedule 5 of Cap. 559 deals with transitional matters where Cap. 43 will continue to apply in certain circumstances.

Existing registered marks

Existing registered marks (whether registered in Part A or B under Cap. 43) are transferred on the commencement date to the new register (Cap. 559, Schedule 5 section 2(1)).

Existing registered marks registered as a series under section 26 of Cap. 43 (series of trade marks) shall be deemed to be registered as a series in the new register (Cap. 559, Schedule 5 section 2(2)).

Any disclaimers, conditions or limitations entered on the former register which related to an existing registered mark shall be deemed to be transferred to the new register (Cap. 559, Schedule 5 section 3(2)).

Pending applications

An application for registration of a mark under Cap. 43 which is pending on the

commencement date shall be dealt with under the old law, and, if registered, the mark shall be treated as an existing registered mark (Cap. 559, Schedule 5 section 10(1)).

The “old law” is defined to mean, amongst other things, the repealed Trade Marks Ordinance (Cap. 43) and Trade Marks Rules (Cap. 43 sub. leg.) (Cap. 559, Schedule 5 section 1(1)).

Where the old law applies, the old forms and fees and provisions in Cap. 43, including provisions relating to advertisements in the Gazette (section 14; rule 22), continue to apply.

A matter is treated as pending on the commencement date if :

- the matter was pending before the Registrar under the old law but no written decision on the matter had been issued by the Registrar before the commencement date;
- the matter was the subject of a written decision issued by the Registrar under the old law before the commencement date but the decision was subject to appeal under the old law and the period for commencing the appeal has not yet expired;
- the matter was the subject of proceedings under the old law which were pending before a court immediately before the commencement date; or
- the matter was the subject of an order made by a court before the commencement date but the order was subject to appeal under the old law and the period for commencing the appeal had not yet expired.

(Cap. 559, Schedule 5 section 1(4))

Thus, if no written decision pursuant to rule 20(1) of the old Rules has been issued as at the commencement date, or where a decision has been issued but the appeal period has not yet expired, the application to register is considered as “pending”.

The time limit for responding to an examination report under rule 18/19 (Cap. 43 sub. leg.) will continue to apply in respect of pending applications examined under the old law.

Opposition

Section 15 of Cap. 43 (Opposition to registration) and any other provisions of the old law relating to opposition to registration continue to apply to these pending applications (Cap. 559, Schedule 5 section 10(2)). These can be divided into two categories :

- applications pending on commencement, and advertised before commencement – the old law including the old forms and fees apply;

- applications pending on commencement, but advertised after commencement – the old law, old forms (including Form TM-No. 6 and Form TM-No. 7) and old fees apply, except that the period within which notice of opposition and counter-statement may be filed in respect of such applications are prescribed in rule 121 (Cap. 559 sub. leg.).

(See chapter on Transitional provisions for proceedings before the Registrar).

Conversion of pending applications

Applications pending on commencement of the new law, which have not been advertised before commencement, can be converted for examination under the new law (Cap. 559, Schedule 5 section 11(1)).

Notice to convert must be filed no later than 6 months after the commencement date (Cap. 559, Schedule 5 section 11(2)). This six-month period cannot be extended.

Notice to convert is irrevocable (Cap. 559, Schedule 5 section 11(3)).

Notice to convert has the effect that the application for registration is treated as if made on the commencement date (Cap. 559, Schedule 5 section 11(3)).

Notice to convert will result in a loss of priority in applications which claim priority from a Convention or WTO application made more than 6 months before the commencement date (Cap. 559, Schedule 5 sections 11(3) and 13).

When examining a notice to convert :

- Has the notice to convert been filed on the prescribed form, Form T15 (Cap. 559, Schedule 5 section 11(2); rule 122)?
- Was the prescribed fee (Fee No. 34: HK\$900 per application) paid on filing?
- Was the notice filed no later than 6 months after the commencement date (Cap. 559, Schedule 5 section 11(2))? **The six-month period cannot be extended.** Rule 94 (extension of time limits) is not applicable here as it does not apply to time limits stated in the Ordinance (Cap. 559).
- Was the application advertised before the commencement date (Cap. 559, Schedule 5 section 11(1))? If the application was advertised before the commencement date, the notice to convert must be refused.
- Was a written decision on the application issued before the commencement date and had the appeal period expired (Cap. 559, Schedule 5 section 1(4)(a), (b))?

Was a court order in respect of the application made before the commencement date and had the appeal period expired (Cap. 559, Schedule 5 section 1(4)(c), (d))? In these circumstances, the notice to convert must be refused.

- Does the application claim priority from a Convention or WTO application made more than 6 months before the commencement date (Cap. 559, Schedule 5 sections 11(3) and 13)? If so, the claim to priority is lost.
- Treat the application for registration as if it had been made on the commencement date and examine the application accordingly (Cap. 559, Schedule 5 section 11(3)). This means citing applications (for identical or similar marks and the same or similar goods or services) which have an earlier filing date or an earlier priority date (see chapter on Relative grounds for refusal).
- All converted applications are treated as having the same filing date. Applications for the same date are not cited against each other unless priority is claimed (see definition of “earlier trade mark” in section 5(1)).
- In examining the notice to convert, we review the status of citations raised in the original search and we search from the date of the original search to the commencement date. Our examination report should reconsider citations shown in the original search and raise citations shown in the conversion search.
- A notice to convert can be filed up to 6 months after the commencement date but the application is treated as if filed on the commencement date. It is possible that a notice to convert an application claiming priority from a date not more than 6 months before the commencement date, could be filed after the date of the conversion search and could give rise to a late citation and withdrawal of acceptance under section 42(5) of Cap. 559. This is no different from the situation that can arise where priority is claimed in an application not subject to conversion.

On conversion, the application is treated as if filed under the new law and is subject to the new law's provisions. For example, the application can be amended only as provided in section 46 and rule 23.

A converted application will be given a new filing date, but will retain its original application number. On registration, the mark will be given a new number.

Any application for registering a mark under Cap. 43 may have been accompanied by an application to register a person as a registered user under section 18(1)(b) of Cap. 43. This application to register a registered user will be treated as an application for registering a license under section 9(4) of Schedule 5 to Cap. 559 whether or not the application for registering the mark is converted under the new Ordinance.

Associated marks

The concept of associated marks no longer exists as a result of the new Ordinance. No reference to association will be made in the case of marks registered on or after the commencement date.

Notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement date (Cap. 559, Schedule 5 section 2(4)).

For transitional arrangements in relation to:

- registered users and licences – see chapter on Licences in respect of registered trade marks and applications.
- assignments – see chapter on Assignments of registered trade marks and applications.

- renewal – see chapter on Renewal and restoration.

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