

# **Transitional provisions for proceedings before the Registrar**

## **Registrability**

If no written “decision” pursuant to rule 20(1) of the old Rules has been issued at the date that Schedule 5 to the Ordinance came into operation, or where a decision has been issued but the appeal period has not yet expired, the application to register is considered as “pending” (Schedule 5 section 1(4)) and will be dealt with under the old law (Schedule 5 section 10(1)).

This means that a formal registrability hearing, sought in the case of a decision issued after consideration of a considered reply and issued after the commencement of Schedule 5, will be governed by the old law.

An appeal lodged after a formal registrability hearing, where the decision was issued not earlier than 3 months before the commencement date of Schedule 5 (i.e. the appeal period had not expired on the commencement date), would be decided under the old law.

The “old law” includes the old Rules (Schedule 5 section 1(1)), so for these hearings the old Rules still apply.

## **Opposition**

An application advertised on or before the commencement of Schedule 5 cannot be converted to the new law (Schedule 5 section 11(1)) and accordingly any opposition to it will be governed by the old law and old Rules. For applications under the old law which are advertised on or after the commencement date, rule 121 provides that the

period for filing of the notice of opposition and counter-statement shall be 3 months beginning on the date of the advertisement/filing of the notice of opposition respectively.

Any opposition proceedings commenced under the old law continue to be governed by the old law and Rules.

It should be noted that applications pending on commencement but advertised after commencement are dealt with under the old law (including advertisements in the Gazette, old forms (including Form TM-No. 6 and Form TM-No. 7) and old fees), subject only to time limits for notice of opposition and counter-statement in rule 121 and a request for extension of such time limits under rule 121 has to be filed on the new Form T13 with the new prescribed fee. Extension of time for filing evidence will continue to be governed by the old law (rule 91 of Cap. 43 sub. leg.), and the old law Form S. 75 with prescribed fee is applicable.

### ***Opposition to alteration of registered trade mark (section 51 Cap. 43)***

Where an application for alteration is made under section 51 of Cap. 43 before the commencement date and is pending on commencement, any opposition to it after it has been advertised (whether the advertisement takes place before or after commencement) is governed by the old law and Rules (Schedule 5 section 15). Rule 121 has no application in this scenario.

Existing oppositions continue under the old law, old Rules.

### **Other proceedings**

Any application in which a decision has yet to be issued or where a decision was issued not earlier than 3 months before the commencement date of Schedule 5 (i.e. the appeal period has not expired on the commencement date) shall be dealt with under the old law,

old Rules (Schedule 5 sections 3(1), 9(6), 16(1) and 17(1)). This applies to the following applications :

- Applications under section 37 of Cap. 43;
- Applications under section 48 of Cap. 43;
- Applications under section 50 of Cap. 43;
- Applications to expunge or vary registration for breach of conditions (section 49 of Cap. 43); and
- Proceedings under section 60 of Cap. 43.

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