

Consultation Paper on Scale of Costs in Opposition Proceedings under the Trade Marks Ordinance Cap.559

Background

1. Trade mark practitioners expressed their concern on costs awarded in Trade Marks Registry's proceedings and suggested that awards should be made by reference to a scale which would standardize costs for perusal, preparation and filing of certain documents in opposition proceedings under Cap.559 and also the preparation for and attendance of extension of time hearings in relation to the proceedings.

Issues for Consultation

2. After several discussions, a scale in relation to 3 items of costs had been proposed by professional bodies. Details of the scale are set out in the following table:-

(a)	Opposition proceedings commenced on or after (date) Preparing and filing Notice of Opposition or Counter-Statement Perusal of Notice of Opposition or Counter-Statement	Scale party and party costs allowed Up to HK\$8,000 plus official fees plus translation costs (where required for details of foreign trade marks). Up to HK\$6,000
(b)	Extension of time hearings taken place on or after (date) Preparation for and attendance	Scale party and party costs allowed Up to HK\$8,000

3. The Scale of Costs is applicable when the party awarded costs was legally represented in relation to the 3 items only.

4. The Scale of Costs is subject to review from time to time to take better account of the real costs involved in litigation before the Registrar of Trade Marks.

5. The proposed effective date of the Scale of Costs is 1 August 2008. It is proposed to be applicable to opposition proceedings commenced on or after 1 August 2008 and extension of time hearings taken place on or after 1 August 2008.

Considerations

6. The purpose of this Scale of Costs is to establish a scale on the amount of costs that would normally be awarded in relation to the 3 items set out in paragraph 2. The Registrar's discretion under the Trade Marks Ordinance, Cap. 559 to award costs to any party as he may consider reasonable is not affected by the Scale of Costs, as the circumstances in any given case may justify a deviation from it.

7. In practice, the Trade Marks Registry rarely, if ever, makes an award of costs which is above the maximum amount proposed by professional bodies.

How to Respond

8. We welcome views by 30 June 2008 by email at conniefu@ipd.gov.hk, by fax at 2574 9102 or by post to 24th Floor, Wu Chung House, 213 Queen's Road East, Hong Kong to the attention of the Trade Marks Registry, Intellectual Property Department. We shall consider your views carefully.

Registrar of Trade Marks
30 May 2008