

Intellectual Property Dept.,
Trade Marks Registry,
15/F., Ocean Centre,
Curved Block,
5 Canton Road,
Kowloon.

204/TMR/87
165/TMR/88(Part II)

1st August 1991

Circular No. 10 of 1991

**Filing of evidence of use
in support of trade mark applications**

This Circular supersedes Circular No. 5 of 1988 with immediate effect.

PAST PRACTICE

2. In the past, evidence of use under Sections 9(1)(e), 22 and 10(2)(b) of the Trade Marks Ordinance have usually been submitted in the form of one principal statutory declaration and two local statutory declarations.

ONE PRINCIPAL STATUTORY DECLARATION ONLY

3. The Registrar of Trade Marks takes the view that the nature and extent of evidence presented to overcome prima facie objections to a mark under **Sections 9 and 10 of the Trade Marks Ordinance (and in respect of Section 22 thereof) is a matter for the applicant.**

4. **In the future**, the Trade Marks Registry is prepared to entertain the submission of evidence by way of **one principal statutory declaration only sworn by the applicant** where the applicant feels that all the relevant evidence can be contained within the said statutory declaration. The Registrar will consider the evidence presented to determine whether this shows that an applied mark has become in fact adapted to distinguish (for the purposes of a Part A registration) or capable of distinguishing (for the purposes of a Part B registration) or whether the provisions of Section 22 of the Trade Marks Ordinance have been complied with. The applied mark will be accepted or rejected on the basis of the evidence filed with the Registrar and it will be up to an applicant to decide whether further evidence should be filed if the application is to proceed any further. The Registrar will not in future be making any requests for further evidence **but reserves the right to do so in any appropriate case.**

APPLICANT REPRESENTED BY SOLE AGENT IN HONG KONG

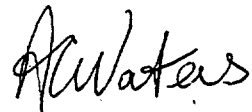
5. Where the applicant is a corporation domiciled abroad, a declaration made by a sole agent of the corporation resident in Hong Kong may be accepted, but it will be necessary for the applicant to provide a declaration adopting the evidence given by the sole agent on its behalf. **The Registrar of Trade Marks will not consider any evidence submitted by a sole agent for this purpose unless it is supported by the declaration of the overseas corporation adopting the evidence supplied by the sole agent.** It would assist the Registry if both these Declarations could be submitted at the same time.

NOTES

6. Attached at Annex "A" are notes prepared for the filing of evidence of use in trade mark applications which are intended to assist generally and to operate as non-binding guidelines only. They do not have and are not intended to have any force of law.

SPECIMEN STATUTORY DECLARATIONS

7. Specimen statutory declarations are attached at Annex "B", "C" and "D". If evidence is presented in that format it will normally satisfy the requirements of the Registry. Agents and applicants are requested to use this format where possible.



(Miss A. C. Waters)
p. Registrar of Trade Marks

Encls.

NOTES ON THE FILING OF EVIDENCE OF USE IN TRADE MARK APPLICATIONS
AND THE COMPLETION OF THE STATUTORY DECLARATIONS

- 1 The nature and extent of evidence presented to overcome prima facie objections to a mark under Sections 9, 10 and 12(1) of the Trade Marks Ordinance Hong Kong is a matter for the applicant.
- 2 The mode of giving evidence in all trade mark proceedings before the Registrar is governed by Section 83 of the Trade Marks Ordinance which states that, in the absence of directions to the contrary, it should be given by Statutory Declaration. The way in which such declarations may be declared is governed by Rule 96 of the Trade Marks Rules.
- 3 It is not the Registrar's function to demand evidence in a particular format, but, if evidence is presented in the style of the attached proforma Statutory Declarations (Annexes "B", "C" and "D"), it will satisfy his requirements in the great majority of cases. If possible, a separate declaration should be filed in respect of separate applications in different classes. Where this is not possible a breakdown of turnover and advertising figures etc should be given for each class.
- 4 The applicant or his agent may wish to file evidence beyond that required in the proforma, and equally, the Registrar may in special circumstances require the filing of additional evidence to satisfy him on a particular point, e.g. whether or not other traders in the goods use the mark or something closely resembling the mark in a descriptive manner.
- 5 Detailed notes on the preparation of statutory declarations are given at Part II. The following points of general guidance may be helpful :-

SECTIONS 9 and 10

It is not possible to quantify the amount of use which must be demonstrated to overcome prima facie objections to descriptive marks, common surname marks, letter marks etc. Generally, however, the more descriptive the mark, the more use is required to show that it is factually distinctive in relation to the goods in question. The same principle applies to surnames in that, if a surname is relatively rare a few years user may suffice, whereas, if it is very common e.g. Smith or Chan then long and substantial, user will almost certainly be required. It should be borne in mind that some marks are unregistrable eg laudatory terms such as "Good" and "Best" and the names of geographical cities such as "York", "Beijing", and that, in such instances, the filing of evidence of use may not assist the application.

SECTION 22

Any mark applied for may conflict with a mark already on the register, but, under Section 22 of the Ordinance, the Registrar may allow such a mark to be registered provided it can be established by evidence that the two marks have been in honest concurrent use for a significant period of time.

Where the marks are not identical, or the goods are not identical, or the mark has been used in different markets, applicant(s) may submit evidence of use to show that there has been sufficient honest concurrent use alongside the other mark to accustom the public to distinguish between the two marks. If the Registrar is so convinced, the application may be allowed to proceed under the provisions of Section 22 of the Ordinance.

NOTES ON THE COMPLETION OF STATUTORY DECLARATIONS (ANNEXES "B" & "C")

(The Paragraph Nos. refer to those used in ANNEX B and apply, mutatis mutandis, to ANNEX C)

HEADINGS

The document must be headed with the words STATUTORY DECLARATION. Beneath, on the right hand side, should be an explanatory heading which adequately describes the mark(s) and application(s) to which the evidence applies.

The name of the applicant company should conform with that given on the application Form TM 3.

PARAGRAPHS (1) & (2)

INTRODUCTION

- (a) The NAME of the declarant.
- (b) The ADDRESS of the declarant - this may be his private address but more usually the official address of his/her company, firm, partnership, etc.
- (c) The position, rank or status the declarant holds within the said company.
- (d) The source of the evidence given may be (i) personal knowledge, (ii) company records, (iii) any other source.

PARAGRAPH (3)

DATE OF USE

- (a) The mark should be exhibited in the exact manner used. If variations have existed, this should be explained in the blank space provided.
- (b) The date that the mark was first used in HK (i.e. the month and the year where possible).
- (c) If an applicant is claiming use of the mark from a date before which he actually owned it, i.e. through a predecessor in title, he must indicate when the mark was acquired by the applicant and from whom. If there have been multiple previous owners this should also be explained. The importance of this is to demonstrate that the mark has been assigned to the new owner(s) TOGETHER WITH THE GOODWILL at each stage.

SPECIFICATION

The goods upon which the mark has been used should be individually listed with the year of first use in respect of individual items or activities. If it is not possible to give an exact date, the term “not later than” should be given. Any exhibits which illustrate use of the mark should be cross referred (eg exhibit 1, exhibit 2, etc) but such evidence (e.g. illustrated literature), should predate the date of application.

PARAGRAPH (4)

THE EXTENT OF TURNOVER

The volume of sales values etc for at least the last 5 years prior to the date of application should be given for Section 9(1)(e) and Section 22 cases and for at least 2 years for Part B cases under Section 10(2)(b). It may be necessary, if a wide range of goods is claimed, to break these down into closely related groups and to give separate figures for each group. In the case of goods it should be clearly stated whether this is the wholesale, retail or ex-factory figure.

Goods for Export/Services provided outside Hong Kong Kingdom

Under Section 39 of the Ordinance use of the mark upon goods for export from Hong Kong is admissible in evidence but a breakdown of the turnover figures into use in the home market and overseas should, if possible, be given.

PARAGRAPH (5)

EXHIBITS

Exhibits demonstrating use of the mark EXACTLY AS APPLIED FOR plus any other supporting material should be attached to this Statutory Declaration.

PARAGRAPH (6)

ADVERTISING EXPENDITURE

The extent of advertising expenditure incurred to establish and increase the reputation of the mark for at least 3-5 years prior to the date of application should be given under e.g. the following headings:

TV, NEWSPAPERS (TITLES), MAGAZINES (TITLES), HOARDINGS (AREAS) etc.

Also, where possible, samples illustrating the type of advertising may be given e.g. scripts for commercial films, press cuttings etc; or invoices relating to advertising expenditure.

PARAGRAPH (7)

NAME OF AGENT/RETAILERS

The name of agent and leading local retailers are to be provided.

PARAGRAPH (8)

ADDITIONAL EVIDENCE

Applicants are encouraged to provide any additional evidence which they consider would assist the application.

PARAGRAPH (9)

DECLARATION

The Statutory Declaration is to be concluded in the terms set out in the proforma. (Annex "B" or "C" and "D")

Insert if appropriate

If the declarant makes the declaration in his own language i.e. other than English a certified translation into the English language will have to be provided. This certificate may be in the following form:

"I ... NAME OF TRANSLATOR of ... ADDRESS ... being conversant and capable in both the English and ...(COUNTRY) languages hereby confirm that I have duly translated the declaration of ... NAME OF DECLARANT ... DATED ... and hereby certify that this is a true translation of the original declaration SIGNED ... WITNESSED...".

STATUTORY DECLARATION BY APPLICANT

IN THE MATTER of Application Number
19 by

for the registration in Hong Kong
of the Trade Mark
in Class
and

IN THE MATTER of the [Oaths and *
Declarations Ordinance 1972 (Cap.)]

PRINCIPAL STATUTORY DECLARATION in PART A

I, [Full name of Declarant] of [Full address of Declarant] do solemnly and sincerely declare as follows:-

1. I am the [Official Capacity of Declarant] of the said [Full name and address of Applicant], the Applicant herein.
2. I have been associated with the Applicant for _____ years and have occupied my present position since 19 _____. I have free access to the records of the Applicant relating to its trade marks and the user thereof, and I am duly authorized by the Applicant to make this declaration.
3. The Applicant [the predecessors in title to the Applicant] first used [description of trade mark] hereinafter referred to as the Trade Mark the subject of this application continuously since [date of earliest use] in “ _____ ” in respect of [goods] manufactured and sold by them.

Note
[for use to
be of any
assistance it
must occur
prior to the
date of
application]

* if
applicable

4. The Applicant has used the Trade Mark continuously since [date of 1st use] in Hong Kong in respect of [goods]. (hereinafter referred to as "the said goods.") Sales of the said goods by the Applicant under the Trade Mark in Hong Kong [and/or for export from Hong Kong] or 5 years before the date of the application are as follows:-

<u>YEAR</u>	<u>VALUE</u>
19	\$
19	\$
19	\$
19	\$
19	\$

5. The Trade Mark is and has been applied to the said goods by _____ and by means of labels attached to the said goods and the Trade Mark appears on packages in which the said goods are wrapped for sale [export]. Exhibits demonstrating use of the mark EXACTLY as applied for are attached to this Declaration.

Note
(i)-(v) delete
if inapplicable
(vi) to be
expanded as
necessary]

6. The Applicant has during the period that the Trade Mark has been used in Hong Kong advertised the said goods by means of (i) Press, (ii) T.V., (iii) Circulars to the trade, (iv) Exhibition, (v) display of posters, (vi) others and the amount expended in making the said goods known in this manner since the year is as follows:-

<u>YEAR</u>	<u>AMOUNT</u>
19	
19	
19	
19	
19	

Samples of the advertisements and circulars are annexed hereto and marked “ ”.

7. The Applicant has appointed Messrs. [full name of agent] of [full address of agent] Hong Kong as their agents to sell the said goods in Hong Kong. The leading local retailers of the said goods include . . .

8. [Any evidence which may be relevant.]

9. The said trade mark has by reason of the facts herein set out come to signify to the trade [and to the general public] goods manufactured and [exported] sold by the applicant company.

AND I make this solemn declaration conscientiously believing the same to be true and by virtue of [the Oaths and Declarations Ordinance 1972.] *

DECLARED at)
)
this day of 19 .) By:

Before me,

[Solicitor, Hong Kong.]
[Notary Public]

* if applicable

STATUTORY DECLARATION BY AGENT

IN THE MATTER of an Application Number
19 by

for the registration in Hong Kong
of the Trade Mark
in Class
and

IN THE MATTER OF the [Oaths and
Declarations Ordinance 1972 (Cap.)]

PRINCIPAL STATUTORY DECLARATION

I, [Full name of Declarant] of [Full address of Declarant] Hong Kong do solemnly and sincerely declare as follows:-

1. I am [Capacity of Declarant] of [Full name and address of Declarant's firm/company etc.]
2. My company is the sole distributor/sole agent of the applicant, _____ [and not connected financially or in any other way with the] Applicant for Trade Mark of Pending Application No. 19 herein. I am fully familiar with the trade mark as per the specimen annexed hereto marked "Exhibit A" (hereinafter referred to as "the Trade Mark") for which registration as a trade mark is being sought by _____, of (hereinafter referred to as "the Applicant").
3. My company has been appointed the agents for the applicants' goods [identify types of goods] bearing the Trade Mark for over years in Hong Kong.

4. As the agents of the applicants' goods in Hong Kong since _____, I am aware that the Applicant has used the Trade Mark continuously since [date of 1st use] in Hong Kong in respect of [goods]. (hereinafter referred to as "the said goods.") Sales of the said goods under the Trade Mark in Hong Kong [and/or for export from Hong Kong] for 5 years before the date of the application are as follows:-

<u>YEAR</u>	<u>VALUE</u>
19	\$
19	\$
19	\$
19	\$
19	\$

5. The Trade Mark is and has been applied to the said goods by _____ and by means of labels attached to the said goods and the Trade Mark appears on packages in which the said goods are wrapped for sale [export]. Exhibits demonstrating use of the mark EXACTLY as applied for are attached to this Declaration.

Note [(i)-(v) delete if inapplicable (vi) to be expanded as necessary]

6. I also declare that the Applicant has during the period that the Trade Mark has been used in Hong Kong advertised the said goods by means of (i) Press, (ii) T.V., (iii) Circulars to the trade, (iv) Exhibition, (v) display of posters, (vi) others and the amount expended in making the said goods known in this manner since the year _____ is as follows:-

<u>YEAR</u>	<u>AMOUNT</u>
19	
19	
19	
19	
19	

Samples of the advertisements and circulars are annexed hereto and marked “ ”.

STATUTORY DECLARATION

by ADOPTING STATUTORY
DECLARATION OF
SOLE AGENT

IN THE MATTER OF Application Number
19 by
for the registration in Hong Kong
of the Trade Mark
in Class
and
IN THE MATTER of the
[state legislation under which
Declaration is sworn

I, [Full name of Declarant] of [Full address of Declarant] do solemnly and sincerely declare as follows:-

1. I am the [official capacity of Declarant] of the said [Full name and address of Applicant], the Applicant herein.

2. I refer to the attached Statutory Declaration dated [insert particulars] made by [insert particulars] on behalf of [insert particulars], the sole agent of the Applicant in Hong Kong, and hereby declare that the contents of the said Statutory Declaration are true and are hereby adopted and confirmed by the Applicant.

AND I make the solemn declaration conscientiously believing the same to be true and by virtue of the [state legislation under which declaration is sworn]

Declared at)
)
) By
)
this day of 19)

Before me