

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

28th August 1991

Circular No. 11 of 1991

Applications made co-pending under
Section 21 of the Trade Marks Ordinance
in respect of Trade Marks for goods

1. Introduction

Circular No. 2 of 1985

1.1 Practitioners will be familiar with Circular No. 2 of 1985 which applies to applications first examined on/or after 15th April 1985.

Revised-Policy

1.2 This Circular No. 11 of 1991 sets out the Registry's revised co-pending policy which will apply to all applications first examined, or where a first report has been issued, on/or after 1st August 1991. Applications examined before this date will continue to be dealt with in accordance with Circular No. 2 of 1985 unless all parties agree that co-pending situations should be resolved in accordance with the provisions of this Circular No. 11 of 1991.

No Radical Change

1.3 This Circular No. 11 of 1991 does not radically alter the co-pending practice which has been in place up till now, although the attention of practitioners is drawn to para 4.c below of this Circular which reflects a change in practice.

2. Where No Leave to Advertise Issued

2.1 The normal co-pending procedure set out below applies to trade mark applications where no leave to advertise has been issued.

2.2 Where the Registry decides that separate applications for trade marks made by different persons are identical or nearly resemble each other within Section 21 of the Trade Marks Ordinance, the following procedure, which reflects the current practice of the Registry, will apply :-

First Filed

- (a) The first filed application for goods will be regarded as having, prima facie, the prior right and the processing of this mark will continue uninterrupted.

Later Applications

- (b) Later applications will have the first filed application cited against them. However, the owner of the first filed application will not be advised of the existence of later applications.

Onus on Later Applicants

- (c) The onus will lie upon later applicants to advise the Registrar of any claim they may have to the sole ownership of the mark or to the prior right and to establish this claim through evidence. If they cannot make such a claim then the applicants will need to find some other means of avoiding the conflict (e.g. limitation of specification, modification of the mark, or an agreement with the first applicant which will be acceptable to the Registrar).

Challenge

- (d) Any challenge by the later applicants should be supported by the relevant information and/or by evidence. If the challenge has merit, the marks are made co-pending and priority will be determined as set out in paras. 3 to 5 below.

Priority

3. Where a particular applicant wishes to establish priority after marks have been made co-pending pursuant to paras. 2.2(d) (i.e. where marks have been made co-pending in the normal way) the following will apply :-

- (a) It is up to a later applicant to submit evidence as to his claim.
- (b) The later applicant may be invited to support his challenge by way of statutory declaration in which case the earlier applicant (or other applicants) will be invited to respond to the challenge by producing evidence, by way of a statutory declaration if required, in support.

Assessment of S/D evidence

4. Once the evidence is available the case will be dealt with in accordance with the following principles, although each case must be decided upon its own facts :-

No user in Hong Kong

- (a) If it appears that neither party's claim supports user in Hong Kong the first filed application will be accepted by virtue of priority of application.

First user

- (b) Where one applicant can establish first user in Hong Kong and the other applicants cannot prove such user then the applicant with first user will be accepted as having priority.

Both parties have substantial user

- (c) If all parties claim Hong Kong user, the Registrar will treat the applicant with the first user as having priority even if the user in all cases is substantial. There may be instances where either or both applications could only be allowed to proceed on the basis of Section 22 of the Ordinance.

Equities in Doubt/Settlement

5. The following should also be noted :-

- (a) In cases where there is a dispute between the parties or the equities of the parties may be in doubt the Registrar may and often will exercise his discretion to refuse to proceed with the application until the rights of the applicants have been determined by the Court or by Agreement between the parties in a manner approved by the Registrar.

- (b) In the case of any applications dealt with under Section 21 the parties may at any time come to an agreement and this may be submitted to the Registrar for approval. The Registrar may also consider whether in the cases where both parties have user, the provisions of Section 22 could be considered.

Earlier application advertised

6. In the event that an earlier filed application has been advertised but not registered :-
- (i) the later applicants will have recourse to opposition in the normal way and, if necessary, the opposition period may be extended.
 - (ii) the advertised applicants will be informed that later applicants' letters claiming priority over the first mark will be treated as a request for an extension of time for entering opposition and that an extension of time would usually be granted subject to the right of the owner of the advertised mark to ask for an interlocutory hearing. The later applicants will, however, be expected to specify the grounds on which they base a claim to priority over the first mark.



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