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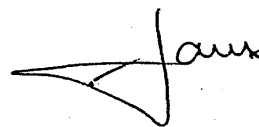
11th June 1992

Circular No. 9 of 1992

Filing of Evidence of Use
in support of Trade Marks Applications

The Trade Mark (Amended) Ordinance provides for the expansion of the system of the registration of trade marks for registration of marks for services. It follows that there is a need to review Circular No. 10 of 1991 on the captioned subject to take account of the case of service marks.

2. The said Circular was previously issued on 1.8.91. The method and practice as set out in this Circular will remain in force. However, Annexes A (Parts I & II), B, C and D have been amended to also provide for the nature of services.
3. The new Annexes A - D are issued herewith and shall supersede the one's annexed to Circular 10 of 1991.
4. To reiterate, these notes and specimen statutory declarations are intended to assist generally to operate as non-binding guidelines only and not have any force in law.



(H. R. Faux)
P. Registrar of Trade Marks

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/ broker 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/services 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/services 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/services 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/services upon/in relation to 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 (e.g. exhibit 1, exhibit 2, etc.) and such evidence (e.g. illustrated literature) should predate the date of application.

PARAGRAPH (4)

THE EXTENT OF TURNOVER

The volume of sales values/business turnovers etc. for at least 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/services 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.

In the case of services, where actual monetary income received from the services provided is not directly applicable or easily identified, the extent of the use may also be reflected by giving information such as :-

- (a) The number of clients/objects/accounts serviced e.g. the no. of patients treated in the case of hospital/clinic services; the no. of cars serviced under warranty period of purchase .In the case of automobile maintenance and repair.
- (b) The number of deposit accounts or the total deposit amount in the case of banking services.
- (c) The number of policy holders (with types of insurance indicated) in the case of insurance services.
- (d) The size of the applicant's organisation e.g. the no. of branches, no of members/students enrolled etc.
- (e) The number of rooms and associated facilities in the case of hotel services.
- (f) The number of visitors in the case of museum or art gallery services.
- (g) The quantity of materials treated e.g. the tonnage of paper recycled in the case of material treatment services.

Many services do not issue any invoices either because it is not their trading practice to do so or because they are operating on a small family scale e.g. taxi services, medical services (provided by individual practitioner), operating of tunnel services, Chinese bone setting services, geomancy (fung shui), fast food services, hair dressing services, shoe repairs etc. In such cases, the followings may be submitted to substantiate their claim in place of sales invoices

- statements of accounts
- company annual reports
- balance sheets
- company returns
- tax returns etc.

Goods for Export/Services provided outside Hong Kong

Under Section 39 of the Ordinance, use of the mark upon goods for export from Hong Kong or in relation to services for use outside Hong Kong which, if done in relation to services provided within Hong Kong for use there, 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. Unlike a mark for goods that has to be used upon or in physical or other relation to goods, a mark in relation to services can be used as or as part of any statement about the availability or performance of services or otherwise in relation to services. The exhibits demonstrating use of the mark in relation to services therefore can take many forms such as entrance signs, staff business cards to headed stationery, brochures and catalogues etc. bearing the mark applied for. The form in which a mark is used will depend greatly on the nature and category of the services being provided and the manner and style in which they are operated or promoted. A list of examples of the evidence that may be admitted is attached as Appendix 1 to this Annex. This list is not an exhaustive or exclusive one.

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, listing in trade guides, seminars, trade shows or exhibitions organised (no. of these shows held, date of such shows and no. of attendees), listing in yellow pages (under what headings) etc.

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

PARAGRAPH (7)

NAME OF AGENT/BROKER/RETAILERS

The name of agent, broker, 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 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...".

**Examples of possible exhibits
demonstrating use of trade marks
in relation to services**

Brochures, leaflets describing the services

Catalogues

Statements of accounts

Balance sheets

Company annual reports

House newsletter, magazines, information bulletin

Headed stationery, envelopes

Invoices and receipts

Sales advices

Tickets

Compliment slips

Staff business cards

Mail shots

Delivery van

Entrance signs

Advertising in news media or TV advertising script

Liability proposal forms and insurance policies for insurance services

Posters

Menus, bar list,, wine list etc. for restaurants

Room folders, guest information cards for hotel services

Timetable for travel services

(Actual samples of the aforesaid or where necessary photographs thereof showing use of the mark can be submitted)

This list is not an exhaustive list and is not exclusive of other materials

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.

Note

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

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 class [_____] in respect of [goods/services] manufactured/sold/provided by them.

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

YEAR SALE VALUE/BUSINESS TURNOVERS ETC.

19
19
19
19
19

5. The Trade Mark is and has been applied to the said goods/used in relation to the said services 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

Wordings here are to be varied for services depending on the circumstances of each case. (See Notes on “Exhibits” on page 3 of Annex A (Part II))

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/promoted the said goods/services by means of (i) Press, (ii) T.V., (iii) Circulars to the trade, (iv) Exhibition, (v) display of posters, (vi) other and the amount Expended in making the said goods/services 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/broker) of [full address of agent/broker] Hong Kong as their agents/broker to sell/provide the said goods/services in Hong Kong. The leading local retailers retail broker of the said goods/services 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/services manufactured/exported/sold/provided by the applicant company.

STATUTORY DECLARATION BY AGENT/BROKER

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/sole broker of the applicant, [full name of 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/exhibits annexed hereto marked "Exhibit A" (hereinafter referred to as "the Trade Mark) for which registration as a trade mark is being sought by [name of applicant], of [address] (hereinafter referred to as "the Applicant").

3. My company has been appointed the agents/broker for the applicants' goods/services [identify types of goods/services] bearing/under the Trade Mark for over _____ years in Hong Kong.

4. As the agents/broker of the applicants' goods/services 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/services]. (hereinafter referred to as "the said goods/services".) Sales of the said goods/business turnover of the said services under the Trade Mark in Hong Kong [and/or for export from Hong Kong/for use outside Hong Kong] for 5 years before the date of the application are as follows:-

<u>YEAR</u>	<u>SALE VALUE/BUSINESS TURNOVERS ETC.</u>
19	
19	
19	
19	
19	

Note

Wordings here are to be varied for services depending on the circumstances of each case. (See Notes on "Exhibits" on page 3 of Annex A (Part II)).

5. The Trade Mark is and has been applied to the said goods/used in relation to the services 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]

the Trade Mark has been used in Hong Kong advertised / promoted the said goods / services by means of (I) Press, (ii) T.V., (iii) Circulars to the trade, (iv) Exhibition, (v) display of posters, (vi) other and the amount expended in making the said goods / services 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. [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/ services manufactured / exported / sold / provided by the applicant company / marketed, distributed / provided by me as the agents / broker.

6. I also declare that the Applicant has during the period that

STATUTORY DECLARATION

by

ADOPTING STATUTORY DECLARATION OF
SOLE AGENT/BROKER

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 _____ made by [insert particulars] on behalf of [insert particulars], the sole agent/broker 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)
)
this day of 19 .) By:

.....
.....

Before me