

## Company and trademark registration

Intellectual Property Workshop  
by  
Intellectual Property Department

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## Background

### Survey on Business Attitudes to Intellectual Property 2005

- 53.1% of companies surveyed believe if they have obtained the business registration or company registration, no one else can use their company names as trade marks in Hong Kong

## Background

### Survey on Business Attitudes to Intellectual Property 2005

- 44.8% of companies surveyed believe if they have obtained trade mark, patent or design registration in Mainland China, they will gain automatic protection in Hong Kong

## Background

- Briefly compare company name and trade mark registration systems in Hong Kong
- Suggest some strategies to protect your clients' rights

## Separate Laws and Systems

- Company registration: Companies Registry  
<http://www.info.gov.hk/cr>  
Companies Ordinance (Cap. 32)
- Trade mark registration: Trade Marks Registry,  
Intellectual Property Department  
<http://www.ipd.gov.hk>  
Trade Marks Ordinance (Cap. 559)

## Separate Laws and Systems

- IP rights that require registration (e.g. trade marks, patents & designs) need to be registered separately in Hong Kong and in the Mainland before they can be protected effectively in both places

# Company registration

- Choice of new company name
- Names not the same as a name appearing in the company names index are registrable

# Objection to company name

- Any person can make an objection to the Registrar of Companies, if a name is “too like” a name appearing in the index of company names
- Company Names Guidelines 1998

## Change of company name

- The Registrar's power to direct a company to change its name can be exercised within 12 months of its registration
- A company that fails to comply with the Registrar's direction to change its name and every officer of the company who is in default is liable to a fine

## Trade Mark

What is a trade mark? (Section 3, Cap. 559)

- Badge of trade origin
- Capable of distinguishing the goods / services of one undertaking from those of others
- Sign: distinctive words, figurative elements, colours, sound, shapes

## Registration requirements (Section 11, Cap. 559)

- Is the mark distinctive, or just a description (e.g. quality, intended purpose, geographical origin) of the goods/services?

## Registration requirements (Section 12, Cap. 559)

- Has someone else already registered or applied to register the same or similar mark for the same or similar goods and services?
- Only Trade Marks Register is searched, not Company Names Index

## Registration requirements (Section 44, Cap. 559)

- Publication of applications in Hong Kong Intellectual Property Journal  
[http://www.ipd.gov.hk/eng/ip\\_journal.htm](http://www.ipd.gov.hk/eng/ip_journal.htm)
- Any person may oppose an application within 3 months from the date of publication

## Trade mark protection

- The owner can take infringement proceedings against another person who uses, without authorisation, in the course of trade/business, a sign identical / confusingly similar to the registered trade mark for identical / similar goods or services

## Company vs Trade Mark Registration

- The owner of a registered trade mark has exclusive rights in the trade mark
- Registering a company name in Hong Kong does not give the owner the right to use the name for activities that infringe someone else's trade mark.

## Some strategies

- Adopt a mark that is clearly different from other owners' marks
- Search the Trade Marks Register, the Companies Register (<http://www.icris.cr.gov.hk/csci/>), trade directories, business telephone directory and the Internet, before adopting a company name or trademark.

## Some strategies

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- Separately register a trade mark in Hong Kong and in the Mainland to gain protection in both jurisdictions.

## Some strategies

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- Register a trade mark as soon as possible to ensure it is available for business use and you can take immediate action against infringement

## Some strategies

- Consider registering a mark in both English and Chinese (translation and/or transliteration) to give it broader appeal and protection
- e.g. Great Wall / 長城 / Changcheng

## Some strategies

- Monitor the on-line Hong Kong Intellectual Property Journal ([www.ipd.gov.hk/eng/ip\\_journal.htm](http://www.ipd.gov.hk/eng/ip_journal.htm)) for applications to register marks likely to cause confusion with your mark and take action to oppose them

## Some strategies

- Report infringement immediately to Customs and Excise Department, Intellectual Property Investigation Bureau, if infringing activity takes place in Hong Kong.
- Evidence of ownership of trade mark and proof of alleged infringement necessary
- [http://www.customs.gov.hk/eng/major IPR protection e.html](http://www.customs.gov.hk/eng/major_IPR_protection_e.html)

## Some strategies

- Register trade mark and company name as domain names to protect them on the Internet.
- Hong Kong Domain Name Registration Company Limited (<http://www.hkdnr.net.hk/hkdnr/index.jsp>) is a non-profit company that administers the registration of Internet domain names under “.hk”.

# Company vs Trademark Registration

## Q & A

# Thank you