Amendment of applications

Shortly after an application for registration is received, a representation of the mark and particulars of the application are entered into our database which is searchable online. It is crucial that what is being applied for is accurately set out in the application form, so that the data can then be accurately entered into the database. Under Cap. 559 and the Rules, there are only very limited circumstances under which amendment of an application can be allowed. The philosophy under the new law is that application details should be correct as from the time of filing of the application. It is not in the interest of the public at large that an applicant be allowed to subsequently change what he has applied for. It is always open to him to make a fresh application of a slightly different mark.

The types of amendment of an application which may be allowed are:

- Adding a representation of a registered trade mark to the representation of the applied-for mark, but only if all of the following conditions are met:
  - at the time the request for amendment is made, the registered trade mark is registered in the name of the applicant;
  - the goods or services for which the registered trade mark is registered are identical or similar to the goods or services covered by the application; and
  - the date of registration of the registered trade mark is earlier than the date of application for registration of the trade mark in question (section 46(2)).

- Restricting the goods or services covered by the application (section 46(3)(a)).
If the specification lists goods or services by reference to a class or classes under which the goods or services do not fall, the applicant may file a request to amend the application to correct the class or classes accordingly (rules 7(5) and 23(a)).

Example: The applicant applies to register a mark for “clothing, handbags” in class 25. Since “handbags” do not fall within class 25 and should be in class 18, it is possible to amend the application, subject to payment of an additional class fee, as follows:

“Handbags” in class 18; and
“Clothing” in class 25

Transfer of goods/services from one class to another is possible only where the originally applied-for goods/services in question do not fall within the particular class. For example, transfer of “Clothing in class 25” to “Protective clothing in class 9” would not be acceptable, since “Clothing” does fall within class 25.

- Adding a disclaimer, limitation or condition under section 15 (rule 23(b)).

- Withdrawing a claim to a right to priority (rule 23(c)).

- Amendment for the purpose of correcting:
  - the name or address of the applicant;
  - errors of wording or of copying; or
  - obvious mistakes,

but only where the correction does not substantially affect the identity of the
trade mark or extend the goods or services covered by the application (section 46(4)).

As it is not uncommon for marks to consist of or contain misspelt words, changing a misspelt word in a mark into a correctly spelt word is likely to substantially affect the identity of the mark which cannot be allowed.

Correcting an error of wording, e.g. wording in a specification of goods or services, cannot be allowed if it would thereby include in the specification some goods/service not included in the original application.

Examples of amendments that cannot be accepted:

- adding/withdrawing a colour claim;
- adding a priority claim;
- replacing the representation of a mark with a clearer version such that some features become apparent or recognisable for the first time;
- amending a three-dimensional shape with words and/or figurative elements appearing on it, into an application to register the shape alone; or
- amending the specification of goods or services which would widen its scope.

There is no provision in the Ordinance or the Rules for deferring the filing date of an application once it has been accorded. A new application would have to be filed.

**Procedure**

A request to amend an application for registration of a trade mark must be filed (Forms T5, T5A, T5B & T5S, as appropriate) (rule 24(1)).
The Registrar may in limited circumstances require the applicant to file reasons for and evidence in support of the request (rule 24(2)). For example, where an applicant applies to change his name, the Registrar will generally rely on the applicant’s confirmation in Form T5 (Box 3(a)) that there has been no change in his identity, i.e. it is the same legal entity before and after the change. However, if we are in doubt (an obvious example being change from a natural person to a company), we can ask the applicant to clarify the circumstances leading to the change in name and to provide documents in support of the request.

Where a request to amend an application for registration of a trade mark is made after particulars of that application have been published, the Registrar shall, if the amendment affects the representation of the trade mark or the goods or services covered by the application, publish particulars of the proposed amendment in the Hong Kong Intellectual Property Journal (rule 25).

Where particulars of an amendment are published, any person claiming to be affected by the proposed amendment may file a notice of objection (rule 26). See chapter on Objections to amendment of applications for trade marks.

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