

**FAQs for
Trade Marks (Amendment) Ordinance 2020 (“2020 Amendment Ordinance”)
Effective 19 June 2020**

Before filing a trade mark application

1. Is there any change of the nature and scope of the preliminary advice given by the Registrar of Trade Marks pursuant to a request in the form of the revised Form T1 under the Trade Marks Ordinance as amended by the 2020 Amendment Ordinance?

No. The relevant legislative amendments only seek to set out the applicable law on provision of preliminary advice by the Registrar of Trade Marks more precisely in accordance with the usual practice that has been adopted by the Registrar of Trade Marks, namely the nature and scope of preliminary advice relate to whether a trade mark is likely to be refused registration on a ground mentioned in section 11 and/or section 12(1) to (3) of the Trade Marks Ordinance (as the case may be). On this premise, textual refinements have also been introduced into Form T1 for promoting its clarity and consistency.

In addition, the conditions for refund of the fees paid for filing a trade mark application concerning withdrawal of such application following the Registrar of Trade Marks’ objection to such application in direct contradiction to his preliminary advice on the same mark, also remain unchanged.

(See the amended section 72 of the Trade Marks Ordinance and the new rule 73A of the Trade Marks Rules)

Filing a trade mark application

2. Under the Trade Marks Ordinance as amended by the 2020 Amendment Ordinance, it is a filing requirement under the new section 38(2)(a)(iii) of the Trade Marks Ordinance for a trade mark applicant who is a corporation to indicate its place of incorporation. In this regard, what matters should I pay attention to when completing Form T2 to apply for registration of a trade mark for a corporation?

A trade mark applicant has to complete the field “Applicant type” in Part 01(c) of Form T2. If the applicant is a corporation (i.e. a company incorporated in Hong Kong, or any other body corporate incorporated or established in or outside Hong Kong), please mark the box “Incorporated” and fill in the country/territory/area of incorporation in Part 01(d) of the form. Furthermore, if the corporation was incorporated in the United States, please also fill in the state in which it was incorporated in Part 01(e) of the form.

Please note that it is mandatory for a corporation to indicate its place of incorporation. Failure to do so is a deficiency under rule 11(1)(b) of the Trade Marks Rules. If you fail to provide this information within two months after the date of the Registry’s notice requesting you to do so, your application shall be treated as abandoned.

(See also the amended rule 11(2)(a) and new rule 29(da) of the Trade Marks Rules)

3. Will the Registrar of Trade Marks verify the information about the applicant type and the place of incorporation of a corporation filed by a trade mark applicant?

The filing particulars of a trade mark application may be entered in the register of trade marks to enhance its transparency, which help the Registrar of Trade Marks and third parties better identify the applicant/owner of a trade mark. However, the Registrar of Trade Marks will not verify any information provided by an applicant regarding applicant type or place of incorporation before entering it in the register of trade marks. Persons who wish to ascertain the veracity of such information should carry out independent inquiries and searches.

4. How would my trade mark application be affected if I do not pay the application fee at the time of submitting the application?

A trade mark application will not be given a filing date until the application fee is paid in full (*see the amended section 39(1) of the Trade Marks Ordinance*). For calculation of the sum of your application fee, please refer to https://www.ipd.gov.hk/eng/forms_fees/trademarks_559.htm.

Furthermore, a failure to pay the specified application fee remains a deficiency under rule 11(1)(b) of the Trade Marks Rules. If you fail to pay the application fee within two months after the date of the Registry's notice requesting you to do so, your application shall be deemed never to have been made.

5. Has the 2020 Amendment Ordinance taken away the option to amend a trade mark application?

No, it has not. It remains that a trade mark application may only be amended in a limited number of ways as specified under the law. The 2020 Amendment Ordinance only introduces the following changes regarding the amendment of a trade mark application:

First, it clarifies the circumstances in which an amendment to a trade mark application by adding thereto the representation of the applicant's own registered trade mark may be made. It is now expressly set out that the specification of goods and/or services of the registered trade mark which representation is to be added must be identical to or wide enough to cover the specification of goods and/or services of the trade mark being applied for. In fact, this is the position as always adopted by the Registrar of Trade Marks. The other conditions for this type of amendment (namely, the registered trade mark must be registered in the applicant's name at the time the request for amendment is made, and the date of registration of the registered trade mark must be earlier than the date of the trade mark application sought to be amended) remain unchanged.

Second, where a trade mark application is amended by the addition of the representation of a registered trade mark, certain registered particulars of the registered trade mark (e.g. a statement claiming a colour or 3-dimensional shape as an element of the trade mark, and any other disclaimer, limitation, condition, etc.) would also be added to the amended application. This is intended to better reflect the scope of protection to be conferred by the registration of the amended mark. These registered particulars continue to apply to the part of the amended application consisting of a representation of the registered trade mark.

(See the amended section 46 of the Trade Marks Ordinance, particularly its new subsections (2), (2A), (2B) and (6))

- 6. My company has recently become the new applicant for a trade mark or acquired a right in a trade mark application by way of assignment/transmission, and would like to register the particulars of the transaction with the Trade Marks Registry. Do I also need to provide information on its place of incorporation?**

If the new trade mark applicant is a corporation and applies for the registration of the particulars of an assignment or transmission of a trade mark application or any right therein, the applicant has to complete the fields “Owner type”, “Country/Territory/Area of incorporation” and (if applicable) “State of incorporation” in Parts 03(c), (d) and (e) of Form T10. In this regard, please note that the guidelines provided for a corporate trade mark applicant in relation to equivalent fields on Form T2 (see FAQs 2 and 3) likewise apply to the new corporate trade mark applicant.

(See the amended rule 63 of the Trade Marks Rules, particularly its subrules (1)(a)(ia) and (1)(b)(ia))

Post trade mark registration matters

- 7. My company has recently become the new owner of a registered trade mark or acquired a right in a registered trade mark by way of assignment/transmission, and would like to register the particulars of the transaction with the Trade Marks Registry. Do I also need to provide information on its place of incorporation?**

The guidelines under FAQs 2, 3 and 6 above are likewise applicable.

- 8. Does the 2020 Amendment Ordinance affect the way of how an error or omission in the register of trade marks that is attributable to an error or omission on the part of the Registrar of Trade Marks can be corrected?**

No. The relevant legislative amendments only seek to codify the existing practice concerning correction of an error or omission in the register of trade marks that is attributable to an error or omission on the part of the Registrar of Trade Marks, under which—

- (a) the Registrar of Trade Marks may initiate the correction; and
- (b) a trade mark owner or any other person having sufficient interest may apply to the Registrar of Trade Marks for such correction.

(See the amended section 57 of the Trade Marks Ordinance, particularly its new subsections (6), (6A), (6B) and (6C), and the amended rule 66 of the Trade Marks Rules; and also the chapter “Correction of errors or omissions attributable to the Registrar” of the Trade Marks Registry Work Manual)

Application of Madrid Protocol to Hong Kong SAR

- 9. The 2020 Amendment Ordinance seeks to enable the making of rules for implementation of an international registration system of trade marks under the Madrid Protocol (“the international registration system”) in Hong Kong SAR. Has the system already been launched for use?**

The 2020 Amendment Ordinance marks a legislative milestone by empowering the Registrar of Trade Marks to make rules for the purpose of implementing the international

registration system in Hong Kong SAR. Further preparatory work to implement the system is being carried out. This includes formulating and enacting the detailed procedural rules for such implementation and setting up the necessary information technology system, and drawing up detailed workflows for processing various cases under the international registration system. We plan to implement the international registration system in Hong Kong SAR in 2022-23 the earliest.

Intellectual Property Department
The Government of the Hong Kong Special Administrative Region
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