

# 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 the Trade Marks Ordinance (Cap. 559) and the Trade Marks Rules, there are only very limited circumstances under which amendment of an application can be allowed. The philosophy under Cap. 559 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.

## Types of amendment

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

- Adding a representation together with the registered particulars of a registered trade mark (section 46(2)), but only if all of the conditions set out in section 46(2A) are met (see below).
- 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 and rule 23(b) – see below.
- 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 (save where a colour claim is added together with a representation of a registered trade mark under section 46(2));
- 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.

## **Amendment under section 46(2)**

The Registrar may amend an application for registration to add a representation of a registered trade mark together with the registered particulars of that trade mark as he considers appropriate if all of the following conditions (set out in section 46(2A)) are satisfied:

- at the time the request for amendment is made, the registered trade mark is registered in the name of the applicant;
- the application is made in respect of any or all of the goods or services for which the registered trade mark is registered; 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.

The registered particulars to be added to the application include colour claims, three-dimensional shape claims, disclaimers, limitations, conditions, etc. as the Registrar considers appropriate. The Registrar may modify the wording of such registered particulars to reflect that they have effect only in relation to the part of the amended applied-for mark that is the registered trade mark (section 46(2B)).

The registered trade mark which is sought to be added needs to be specified by reference to its registration number. It would not be sufficient for the applicant to simply state that he wishes to “add the housemark” to the applied-for mark. Representations of the amended applied-for mark must also be filed.

Although a registered trade mark may be added to the representation of the applied-for mark under section 46(2), the amended mark as a whole must be distinctive for it to overcome absolute grounds objection under section 11. The following factors will be taken into account in the Registrar’s assessment of the amended mark as a whole:

- the prominence of the registered trade mark relative to other elements in the amended mark; and
- whether the distinctive character of the registered trade mark is retained and not diminished by the presence of other elements in the amended mark.

If the registered trade mark was itself accepted on the basis of acquired distinctive character, it is less likely that the amended mark will be distinctive without evidence of use in support of it. However, if the amended mark would constitute “a series” of the registered trade mark and is for identical goods/services, the amended mark will be considered distinctive and can be accepted for registration with an endorsement referring to the registered trade mark that was accepted on use, i.e.

“Proceeding because of Trade Mark No. [#]”.

See also chapter on Absolute grounds for refusal, in particular “Section 11(2) – acquired distinctiveness through use”.

If the registered trade mark was itself accepted by virtue of consent from the owner of another trade mark, the consent would not be treated as consent to the registration of

the amended mark. The Registrar will raise relative grounds objection under section 12(1), (2) or (3) against the amended mark in appropriate cases.

## **Amendment under section 15 and rule 23(b)**

An applicant for registration may disclaim any right to the exclusive use of any specified element of the trade mark, or agree that the rights conferred by the registration shall be subject to a limitation or condition. The Registrar will take the following decided cases into consideration when assessing amendment applications filed under section 15 and rule 23(b):

- *Swizzels Matlow Ltd's Trade Mark* [1999] RPC 879 – dimensions of depth and diameter of a mark are not limitations and cannot be added by amendment.
- *Societe des Produits Nestle SA v Mars UK Ltd* [2004] EWCA Civ 1008 – elements of colour and size of a mark are not limitations and cannot be added by way of an amendment.

## **Procedure**

A request to amend an application for registration of a trade mark must be filed (Forms T5, T5A and T5B, 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 by way of Form T5, he confirms that he remains the same legal entity before and after the change by signing the form (see the notes in Part 03(a) thereof). The Registrar will generally rely on the applicant's confirmation that there has been no change in his identity. 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.

## **Transitional provisions**

The current version of this Chapter applies to requests to amend applications for registration of trade marks filed on or after 19 June 2020 (i.e. the commencement date of the Trade Marks (Amendment) Ordinance 2020). For requests filed before 19 June 2020, the version of this Chapter as in force immediately before that date will apply.

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