

Declaration of invalidity of registration of trade mark, collective or certification mark

An application to have a registration declared invalid is a claim that the mark did not qualify for registration in the first place and should have been refused on either “absolute grounds” (section 11) or “relative grounds” (section 12), or both. The grounds for seeking a declaration of invalidity of a trade mark are to be found in section 53. An application may not be made on the ground contained in section 12(4) in respect of a trade mark registered before the commencement date of Schedule 5 Cap. 559 section 17(3) of Schedule 5. The additional grounds for a declaration of invalidity of a collective mark are to be found in section 14 of Schedule 3 to the Ordinance, and of a certification mark, in section 16 of Schedule 4 to the Ordinance.

Grounds affecting only some of the goods or services

The grounds for invalidity may apply to only some of the goods or services covered by the registration. If such an application is successful, the trade mark shall be declared invalid only in respect of the goods or services where the grounds are made out (section 53(8)).

Who may apply?

Section 53(1) provides that “any” person may apply for a declaration of invalidity of the registration of a trade mark. There is no test to determine whether or not the applicant is a “person aggrieved” (as under Cap. 43) or whether the applicant has any interest in the registration or its removal from the register. As the grounds for declaration of invalidity of collective and certification marks are expressed as being

additional to those in section 53, it follows that “any” person may also apply for a declaration of invalidity of these special marks.

Where is the application to be made?

See chapter on Where the application is to be made.

Applying for a declaration of invalidity

The application must be made on the specified form and filed with a statement of the grounds on which the application is made – rule 46(1) and (2).

The “specified form” is Form T6, which includes a filing fee (currently \$800). An address for service must be filed – rule 105(1)(i) either on Form T6 or by written notification.

At the same time, the applicant must send a copy of the application and statement of grounds to the owner – rule 46(3).

The statement of grounds is not evidence and therefore should not stray into the area of evidence. Evidence such as foreign trade mark registration certificates, magazines, newspaper, photographs, promotional materials, invoices and other commercial agreements should not be included in any way in the statement of grounds, but instead they should be filed by way of statutory declaration or affidavit at the evidence stage. Any evidence included in the pleadings, as an attachment or otherwise, would not be uploaded to IPD website for online inspection.

See also the chapter on Evidence.

Outline of procedure

The steps to be taken by applicants and owners (if the latter intend to contest the application) are set out in rules 41 to 45 with necessary modifications – also chapter

on Revocation of registration (including defensive, collective and certification marks)
on grounds other than non-use.

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