

Examination of applications

Once the applicant has been notified of any deficiencies under rule 11 and the deficiencies have been remedied, we will examine to see whether it satisfies the necessary requirements for registration.

In particular, the following will be considered :

- whether the applied-for mark falls within the meaning of “trade mark” in section 3, i.e.
 - is the sign capable of distinguishing the goods or services of one undertaking from those of other undertakings; and
 - is it capable of being represented graphically (section 3(1))(section 3(2) includes a non-exhaustive list of what a trade mark can consist of);
- whether any of the absolute grounds for refusal (section 11) apply; and
- whether the mark offends any of the relative grounds for refusal (section 12).

Other requirements under the Rules will also be checked, e.g. :

- priority claims (see chapter on Claim to priority); and
- colour claims (see chapter on Colour marks).

A notice of the Registrar’s opinion will then be prepared.

If an application meets all the requirements for registration, the notice will indicate that the Registrar is prepared to accept the application for registration.

If it appears that the requirements for registration are not met, the Registrar will inform the applicant of the objections as well as the matters referred to in section 42(3)(b) and (4) by sending to the applicant a notice of the Registrar's opinion under rule 13(1).

The applicant has until 6 months after the date of the notice to do either or both of the following :

- file written representations to establish that the requirements for registration are met; or

- file a request to amend the application to meet these requirements.

If the applicant needs more time, e.g. to gather evidence of use or to obtain the consent of the owner of a conflicting mark, he may request an extension of 3 months under rule 13(3) by filing Form T13 before the expiry of the six-month period. No further extension can be granted under rule 13(3) (rule 95(3)).

If the applicant fails to respond to the notice under rule 13(1) within 6 months (or in the further 3 months, if extension is granted), the application will be refused and the Registrar will send a refusal letter to the applicant (section 42(4)(a)).

If the requirements for registration are met, the Registrar will inform the applicant accordingly.

If after considering the applicant's representations or any filed request for amendment,

the Registrar finds that the application still does not satisfy the requirements for registration, he will send the applicant a notice of his further opinion under rule 13(4). The applicant then has until 3 months after the date of that notice to do any or all of the following :

- file further written representations to establish that the requirements for registration are met;
- file a request or further request to amend his application so as to meet those requirements; or
- file a request for a hearing

(rule 13(5)).

The three-month period to respond to the notice under rule 13(4) may be extended for a further period or periods of not more than 3 months each, but only if :

- a request on Form T13 for extending the period is filed before the end of the period for which extension is sought (i.e. before the current deadline); and
- the applicant satisfies the Registrar that any of the circumstances listed in rule 13(6) exist to justify the granting of the extension.

Those circumstances are :

- an objection is raised against the mark on the ground that it conflicts with an earlier trade mark (section 12(1), (2) or (3)) and :
 - the applicant needs additional time to obtain the consent of the owner of such earlier trade mark;
 - the applicant needs additional time to obtain an assignment of such earlier trade mark; or

- proceedings for invalidation or revocation of such earlier trade mark are pending and time should be extended to allow for the proceedings to be disposed of;
- the applicant needs additional time to prepare evidence of use to be filed in support of the application; or
- other exceptional circumstances exist to justify the granting of an extension of time.

If the applicant :

- fails to respond; or
- responds but fails to satisfy the registration requirements, and does not call for a hearing,

within the period ending 3 months after the date of the notice under rule 13(4), or within such period as extended under rule 13(6), we will send a letter to the applicant refusing the application (section 42(4)(a); rule 14(3)).

It is important to note that if an applicant only files representations in response to a rule 13(4) notice without an extension of time request and without a request for a hearing, and if after considering the representations, we maintain that the registration requirements are not met, and the prescribed period (calculated in accordance with rule 14) has expired, we will have to refuse the application.

If an application was accepted in error, we may withdraw the acceptance, but only if particulars of the application have not yet been published under section 43 in our official journal, namely the Hong Kong Intellectual Property Journal (section 42(5)).

Where the applicant calls for a hearing, see the procedure set out under the heading *Processing a request for a hearing* in the chapter on Hearings.

Conflict with pending marks

Where an applied-for mark is in conflict with another mark which is the subject of another pending application, it would face a relative ground objection only if the latter mark is registered (see definition of “earlier trade mark” in section 5(2), and chapter on Relative grounds for refusal).

Where a mark otherwise fulfils all requirements for registration, and the only potential obstacle is the conflict with one or more pending applications (“the earlier application”), notice of the Registrar’s opinion under rule 13(1) should not be issued until the fate of the earlier application is clear. The applicant may be notified that there is potentially such a problem. An appropriate bring-up date should be set (say, 3 months), and the matter looked at again then. If by then the earlier application has matured to registration, a notice under rule 13(1) for the later application can then be issued, raising the relative ground objection as appropriate. If the earlier application has since been withdrawn, the later application may proceed, subject to the other requirements for registration being met. If the earlier application is still pending, another bring-up date should be set and the matter looked at again then.

Where an application is faced with both a potential conflict with an earlier pending application as well as other objections (e.g. an absolute ground objection, or a relative ground objection based on a registered conflicting mark), a notice under rule 13(1) can be issued raising those other grounds only. The applicant should also be advised, although not as part of the rule 13(1) notice, that there is the potential conflict with the pending mark, and that his mark may face a relative ground objection in respect of that mark should that mark become registered.

Late objections

Where, after a rule 13(1) notice of the Registrar's opinion in relation to an application is issued, it becomes necessary to raise a completely new ground of objection (e.g. a section 12 objection in addition to a section 11 objection, or another conflicting mark which has been overlooked), a fresh notice under rule 13(1) should be issued to supersede the earlier notice. The time limits flowing from the issue of a rule 13(1) notice would therefore run afresh.

Care should be taken to minimize the instances of raising late objections.

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