

## **Time limits in the examination process**

### **Prescribed period for applicants to satisfy requirements for registration**

After deficiencies (if any) in an application for registration of a trade mark have been remedied by the applicant under rule 11, the Registrar will proceed to examine whether the application satisfies the requirements for registration under rule 12.

If it appears to the Registrar that the requirements for registration are not met, the Registrar shall inform the applicant of his opinion by notice in writing (section 42(3) and rule 13). The applicant will be given a prescribed period to satisfy the Registrar that the requirements for registration are met.

The prescribed periods applicable to different stages of the examination process are set out in rule 14. When issuing a notice of his opinion under section 42(3), the Registrar will remind the applicant of the relevant prescribed period and the options available to him if he wishes to proceed with the application.

The Registrar is obliged under section 42(4) to refuse an application at the expiry of the prescribed period if:

- the applicant fails to respond to the Registrar's opinion before the end of the prescribed period; or
- fails to satisfy the Registrar that the requirements for registration are met before the expiry of such period.

### **Registrar's opinion under rule 13(1)**

If, on the basis of an examination under rule 12, it appears to the Registrar that the requirements for registration are not met, he will inform the applicant of his opinion by notice in writing under rule 13(1). This opinion is called a "rule 13(1) opinion".

In response to the rule 13(1) opinion, the applicant may:

- file written representations to establish that the requirements for registration are met; or
  
- file a request to amend his application under section 46.

#### *Prescribed period after issue of rule 13(1) opinion*

The prescribed period for taking the above action commences on the date of issue of the rule 13(1) opinion and expires 6 months thereafter (“prescribed 6-month period”). Upon receipt of a request on the specified form with the prescribed fee filed by the applicant within the prescribed 6-month period, the Registrar will grant under rule 13(3) an extension of time of 3 months for the applicant to respond to the rule 13(1) opinion. It should however be noted that this time period cannot be further extended (rules 95(1)(b), 95(3)).

#### *Issue of reply by the Registrar*

Upon receipt of the applicant’s submissions, the Registrar will issue a reply after expiry of the prescribed 6-month period. The Registrar will issue a notice of acceptance if he is satisfied that the requirements for registration are met. Otherwise, he will inform the applicant of his opinion by notice in writing (rule 13(4)). This opinion is called a “rule 13(4) opinion”.

#### *Issue of observation letters*

The Registrar may give certain comments to the applicant prior to expiry of the prescribed 6-month period. This could happen if the Registrar considers that the requirements for registration would be satisfied provided that minor adjustments are made to the application (e.g. minor changes to a letter of consent filed by the applicant to overcome a relative ground objection). A reply of this nature is not a rule 13(4) opinion since the prescribed 6-month period has not expired. It is often referred to as an “observation letter”. By issuing an observation letter, the Registrar hopes to facilitate the applicant in meeting the requirements for registration within the prescribed 6-month period.

Observation letters are issued only in certain circumstances. The Registrar does not generally comment on an applicant’s submissions prior to issuing a rule 13(4) opinion.

## **Registrar’s opinion under rule 13(4)**

Where the Registrar issues a rule 13(4) opinion, the applicant may take the following course of action:

- file written representations to establish that the requirements for registration are met;
- file a request to amend his application under section 46; or
- file a request for a hearing.

*Prescribed period after issue of rule 13(4) opinion*

The prescribed period for taking the above action expires 3 months after the issue of the Registrar's rule 13(4) opinion ("3-month period"). The period may be extended under rule 13(6) for further period(s) not exceeding 3 months at any one time. No period of time specified in rule 13(6) may be extended under rule 94(1) – see rule 95(3).

A request for extension of time under rule 13(6) must be filed on the specified form with the prescribed fee within the 3-month period, or where the Registrar has previously granted an extension of time under this rule, within the period so extended.

It is important to note that the Registrar only has the discretion to extend time in the limited circumstances set out in rule 13(6).

*Extension of time granted in limited circumstances*

In brief, the Registrar has discretion to grant extensions of time if he is satisfied that the applicant needs further time for the following purposes:

- obtaining the consent of the owner of an earlier trade mark;
- obtaining an assignment of a relevant earlier trade mark;
- disposing of invalidation or revocation proceedings which have been issued against an earlier trade mark; or
- preparation of evidence of use.

In addition to the above, the Registrar may grant an extension of time where there are exceptional circumstances that justify the granting of such extension. It would not be appropriate to prescribe the circumstances under which the Registrar would exercise his discretion. Each case has to be decided on its merits. However, reasons like

“awaiting overseas client’s instructions”, “considering the appropriate course of action to take”, “awaiting Registrar’s reply”, “considering whether or not to file evidence”, “change of agent” (especially where this occurs weeks or more before the relevant deadline) or “the personnel handling the application is on holiday” would not, in our view, constitute “exceptional circumstances”<sup>1</sup>.

#### *Issue of reply by Registrar*

The Registrar will respond to the submissions filed by the applicant after expiry of the 3-month period, or if extension of time is granted under rule 13(6), the period so extended. The Registrar does not generally give comments on the applicant’s submissions in the interim.

If the Registrar, having considered the submissions made by the applicant, is satisfied that the requirements for registration are met, he will issue a notice of acceptance. On the contrary, if the Registrar maintains that the requirements are still not met, and the applicant has not filed a request for hearing within the 3-month period (or the period as extended under rule 13(6)), he will refuse the application and issue a notice of refusal (section 42(4), rule 91(1)).

#### *Request for hearing*

Applicants should note that any request for hearing should be made within the 3-month period (or such longer period as may be extended under rule 13(6)) after the Registrar issues a rule 13(4) opinion. If the applicant intends to file written representations to establish that the requirements for registration are met or a request to amend his application, he should, at same time, consider whether he wishes to call a hearing if his submissions are not accepted. As the Registrar will generally issue a reply after expiry of the 3-month period, the applicant may need to request a hearing at the time of filing the written submissions if he intends to resolve any outstanding issues by way of a hearing.

The date of the hearing will be fixed according to the Registry’s list of applications for hearings. Further submissions (whether in the form of written representations, evidence of use or letters of consent) filed after a request for hearing has been made would be considered by the relevant hearing officer in conjunction with other submissions made by the applicant during the hearing. The Registrar would not in the meantime give comments on such submissions.

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<sup>1</sup> Where the applicant or agent has filed written representations or evidence of acquired distinctiveness or of honest concurrent use and indicates in the request for extension of time that the applicant needs time to prepare evidence or further evidence if necessary, depending on Registrar’s reply, it is no different from giving the reason for the request for extension as “awaiting Registrar’s reply” or “considering whether or not to file evidence”.

## **Obtaining letters of consent or evidence of use**

We are aware that obtaining letters of consent from the owners of earlier trade marks or compiling evidence of use often takes time. If an applicant intends to take such action to overcome the objection raised in the Registrar's first opinion under rule 13(1), he should notify the Registrar of the proposed course of action in writing.

Notifications of this nature will be regarded as written representations under rule 13(2)(a). Applications for extension of time are generally not necessary at this stage. If the proposed letter of consent or evidence is not forthcoming by the end of the prescribed 6-month period, the Registrar will issue a further opinion under rule 13(4) and the applicant will be given further time to give a reply.

Where further time is required by the applicant to pursue any of the above action, the applicant should, within the 3-month period, inform the Registrar in writing of the progress of the matter and apply for an extension of time under rule 13(6).

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