

Trademark Protection in Hong Kong

Territorial protection of registered trademarks

The trademark registration system of Hong Kong provides territorial protection. Hence, trademarks registered with the Trademark Office under the State Administration for Industry and Commerce of the People's Republic of China or trademarks registries of other countries or regions do not automatically receive protection in Hong Kong. In order to obtain protection as registered trademarks in Hong Kong, trademarks must be registered under the Trade Marks Ordinance (Chapter 559) and the Trade Marks Rules (Chapter 559A).

Why register a trademark?

Registering your trademark means that you have the exclusive right to use the trademark in relation to the goods and services for which the mark is registered. If other people use it in the course of trade or business in Hong Kong in relation to the same or similar goods or services without your consent, they may be liable for infringement of your mark and you may take legal action against them. Unregistered trademarks may be protected by the common law action of passing off. You must prove reputation in the unregistered mark and must prove that the other person's use of the mark will cause you damage. Passing off is usually a more difficult action to bring than an action for infringement of a registered trademark.

Filing your trademark application

You should complete the appropriate application form and fill in an address for service in Hong Kong and send it to the Trade Marks Registry (the "Registry") of the Intellectual Property Department (IPD) of the Government of the Hong Kong Special Administrative Region (HKSAR). The application fee for the registration of a trademark is HK\$2,000 plus

HK\$1,000 per each additional class of goods or services, if any. For details on application forms and fees, please refer to the website of the IPD http://www.ipd.gov.hk/eng/forms_fees/trademarks_559.htm.

How to classify the goods and services?

You must list out in your application form all the goods and/or services you want to register your trademark with, and state the number of class(es) they fall in. The goods and services must be classified according to the NICE Classification. Please refer to the IPD's website at http://www.ipd.gov.hk/eng/intellectual_property/trademarks/how_to_classify.htm to find out the classes which your goods and/or services fall into.

What happens to an application for registration of a trademark after it is filed with the Registry?

There are four stages in the process of examining an application for registration:

- deficiency checking
- examination against the requirements of the Trade Marks Ordinance and Trade Marks Rules
- acceptance of application and publication for opposition
- registration and issue of certificate of registration.

If there is no deficiency in the application and all requirements for registration are met, the application will be accepted for registration. If there is no opposition to the trademark application by a third party within the three-month opposition period from the publication

date, the whole registration process may take as short as six months from the date of receipt of application by the Registry.

The first stage - Deficiency Checking

After receiving the application, the Registry will check whether the information provided (including the name and address of applicant, the representation of the mark and the goods and/or services) is complete and correct. If such information is not complete and correct, the Registry will send the applicant a deficiency notice, asking him/her to correct the deficiency within two months.

If everything is in order, the application will proceed to the next stage (examination of application).

The second stage – Examination of Application

- Search and examination

After the deficiency checking has been completed and everything is found to be in order, the Registry will conduct a search of the trademarks records to see if the same or similar trademark has already been registered or applied for registration by another person in respect of the same or similar goods or services.

The Registry will also see if the trademark satisfies the registration requirements laid down in the Trade Marks Ordinance and Trade Marks Rules, including:

- ◇ Is it distinctive?

Does the trademark stand out from the others? Does the trademark, be it a logo, word, picture, etc. clearly distinguish the applicant's goods and services

from those of other traders? For instance, “FOR YOU” is devoid of any distinctive character for banking services because it does not give any idea as to who provides the services. The Registry will consider invented words or everyday words that are in no way associated with the applicant’s line of business as distinctive. It will raise an objection if it thinks the mark lacks distinctive character.

✧ Is it a description of the applicant’s goods and services?

If the trademark describes the goods and services or designates the quality, purpose, quantity or value of them, then the Registry is likely to raise objection. Similarly the Registry is likely to object to the use of geographical name in a mark. Examples include “QUALITY HANDBAGS”, “FRESH AND NEW” and “NEW YORK FASHION”.

✧ Is it a well-known term in the applicant’s line of business?

If the trademark is a well-known term or representation in the applicant’s line of business, the Registry will object to it. “TELECOM” or “NETWORK” are examples of words which have become customary in the current language of the trade.

After examining the trademark application, the Registry will send the applicant a notice, setting out the grounds for refusal of registration or confirming that the mark is acceptable for registration.

- Refusal of registration

If the requirements for registration are not met, the Registry will inform the applicant of the objection by sending him/her a notice. In such case, the applicant has to meet the requirements in 6 months, though a further 3-month extension may be granted.

- How to overcome the refusal

The Registry will indicate in the notice to the applicant why the mark does not meet the requirements for registration. If it considers that the requirements for registration can be met by amending the application or by other means, it may suggest ways to do so in the notice.

- If the application still does not satisfy the requirements for registration

Although the applicant has tried to overcome the objection stated in the notice issued by the Registry, the application may still be found not meeting the requirements for registration. In such case, the Registry will issue a further notice informing the applicant of its opinion. If the applicant wishes to pursue his/her trademark application, he/she will have 3 months from the date of the further notice issued by the Registry to satisfy the registration requirements, or he/she may call for a hearing. The applicant may ask for an extension of this period only in certain circumstances specified in the Trade Marks Rules (for example, where the applicant needs additional time to obtain the consent of the owner of an earlier trademark.)

If the applicant calls for a hearing, all the evidence for and against the trademark application will be considered at the hearing, after which a decision will be issued by the hearing officer.

The third stage – Publication of Trademark Application and Opposition to Registration

- Publication of trademark application

Once a trademark application has been accepted for registration, particulars of the application will be published in the Hong Kong Intellectual Property Journal at http://www.ipd.gov.hk/eng/ip_journal.htm.

- Opposition by a third party

Anyone can view particulars of the trademark applications published in the Hong Kong Intellectual Property Journal and raise an opposition to them. He/She has to file an opposition notice within a 3-month period from the publication date. The applicant may respond to the opposition by filing a counter-statement. Both parties are given the opportunity, within certain time limits, to file evidence in support of the application and opposition. Upon receipt of all the evidence by the Registry, a hearing will take place before a hearing officer who then makes a decision.

The fourth stage – Registration

After the application has proceeded to the registration stage, the Registry will register the trademark by entering particulars in relation to the trademark in the register of trade marks and the applicant will be issued with a certificate of registration. The relevant notice of registration will be published in the Hong Kong Intellectual Property Journal and the trademark will be registered as of the filing date of application.

Difference among company registration, business registration and trademark registration

Company registration, business registration and trademark registration in Hong Kong serve different purposes. They are regulated by different laws and registration systems administered by different government departments.

Business Registration Office

The Business Registration Office under the Inland Revenue Department administers the Business Registration Ordinance (Chapter 310, Laws of Hong Kong). The Business Registration Office is responsible for registering businesses carried on by **an individual, a partnership, a local limited company or a non-Hong Kong company**.

Companies Registry

The Companies Registry administers and enforces the Companies Ordinance (Chapter 32, Laws of Hong Kong). The Companies Registry is responsible for providing services for the incorporation of **local limited companies** and the registration of **companies incorporated outside Hong Kong which have established a place of business in Hong Kong**.

Trade Marks Registry

The Trade Marks Registry under the Intellectual Property Department is responsible for providing **trademark registration** services to members of the public under the Trade Marks Ordinance (Chapter 559, Laws of Hong Kong) and the Trade Marks Rules (Chapter 559A, Laws of Hong Kong).

A company name registration at the Companies Registry or a business name registered with the Business Registration Office is not an indication of trademark rights or the rights to use the name as a trademark in promoting or dealing in goods or services.

(To be updated by Veness)

Well-known Trademarks

A well-known trademark can be protected by registration in the same way as other marks. There is no separate category of “well-known mark registration”.

A trademark that is well known in Mainland China does not necessarily mean that it is well known in Hong Kong. Schedule 2 of the Trade Marks Ordinance sets out the factors for determining whether a trademark is well known in Hong Kong. Factors for consideration include the degree of knowledge or recognition of the trademark in the relevant sectors of the public, the duration and extent or geographical area of any use of the trademark.

The owner of a well-known trademark may restrain by injunction the use in Hong Kong of a trademark:

- (a) which, or the essential part of which, is identical or similar to his trademark;
- (b) in relation to identical or similar goods or services; and
- (c) where such use is likely to cause confusion on the part of the public.

Recommendation – What strategies should be adopted to protect your trademark in Hong Kong and separately, in Mainland China?

You may consider adopting the following strategies to protect your trademark:

- Adopt a mark that is clearly different from the others and will not infringe other owners’ rights.

- Register your trademark both in Hong Kong and in the Mainland where there are separate systems of registration and protection. Registering your mark in the Mainland does not automatically give you protection in Hong Kong.
- Register your trademark in English (translation or transliteration) for use in Hong Kong to give it broader appeal and protection.
- Register your trademark as soon as possible to ensure that it is available for use in your business and that you can take immediate action against any infringement.
- Put in place a structured licensing scheme, if you intend to sign a license contract permitting the use of your trademark by the others.
- Browse from time to time the online Hong Kong Intellectual Property Journal to check if there is any application of trademark registration in Hong Kong which is likely to cause confusion with your mark, and take action to oppose them.
- Consider taking action under the Trade Marks Ordinance of Hong Kong in case of any infringement of your trademark taking place in Hong Kong.
- Consider taking action for passing off against damage to your business goodwill and reputation in Hong Kong for your goods or services.
- Consider reporting to the Intellectual Property Investigation Bureau of the Customs and Excise Department in case of any criminal infringement taking place in Hong Kong. You will need to provide the Customs and Excise Department with evidence to prove your ownership of the trademark and evidence

to prove the alleged infringement. For details, please refer to the following website: http://www.customs.gov.hk/eng/major_IPR_protection_e.html

- Consider taking administrative or legal action under the law of Mainland China if the infringing activity takes place in the Mainland. If a Hong Kong company uses your trademark in its name as a front for infringing activities in the Mainland, you may consider taking legal actions under Mainland law against the company's infringing activities.
- Most importantly, seek professional advice from an intellectual property lawyer or agent with regard to all aspects of your intellectual property rights including trademark, copyright or registered design, which helps protecting your products or services in other ways.
- Seek professional advice on other business safeguards, including registering your trademark, trade name and company name as domain names to protect them on the Internet. Hong Kong Domain Name Registration Company Limited (<http://www.hkdnr.net.hk/hkdnr/index.jsp>) is a non-profit making company that administers the registration of Internet domain names under “.hk” country-code top-level domain.

Online Search

The IPD provides a free online search service at: <http://ipsearch.ipd.gov.hk>, through which you may check the registered trademarks or trademark applications, trademark registered owners or applicants and persons or companies licensed to use the trademarks in Hong Kong.

E-filing Services

To file trademark forms via the IPD's E-filing System, you need to register as a user of electronic services with the IPD first. Every user of electronic services must provide an address for service in Hong Kong and possess an electronic certificate issued by a recognized certificate authority. For information on e-filing services, please refer to the IPD's website at <https://iponline.ipd.gov.hk>.

Further Information

If you require help or more information, please contact the Trade Marks Registry at:

Intellectual Property Department

24/F, Wu Chung House

213 Queen's Road East

Wanchai

Hong Kong

Telephone No.: (852) 2961 6901

Alternatively you may wish to email to enquiry@ipd.gov.hk

or visit the IPD's website at <http://www.ipd.gov.hk/>

Intellectual Property Department

Government of the Hong Kong Special Administrative Region

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Important Notice

This publication only gives a brief introduction to trademark protection in Hong Kong. It does not seek to be exhaustive and is not meant to give legal advice. For legal advice on trademark protection, please seek professional opinions from an intellectual property lawyer or agent.

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