

Alteration of registered trade marks

Application of the new law

Only a registered trade mark that includes the owner's or any previous owner's name or address can be altered (section 55(2)). An alteration can be made to the name or address only and the alteration must not substantially affect the identity of the trade mark (section 55(2)).

In certain circumstances, an owner may need to file reasons for and evidence in support of his request for alteration (rule 54(2)).

Proposed alterations are published in the Hong Kong Intellectual Property Journal (rule 54(3)). Any person claiming to be affected by a proposed alteration can object to it by filing a notice of objection within 3 months after the publication (rule 55(1)) (see below).

Examining a request for alteration of a registered trade mark

Factors to be considered when examining requests for the alteration of registered trade marks:

- Is the request for alteration made on the specified form T5B (rule 54(1))?
- Is the request made by and signed by or on behalf of the owner (section 55(2))?
- Does the registered mark include the owner's or any previous owner's name or address, and does the alteration relate to the name or address (section 55(2))?

- Does the alteration leave the identity of the trade mark substantially unaffected? The alteration must not substantially affect the identity of the trade mark (section 55(2)). Factors to be considered in deciding whether an alteration substantially affects the identity of a registered trade mark are summarised below.
- Are the circumstances under which the request for alteration is being made apparent? For example, a request to alter the address shown in the mark to the owner's new address, for which he also files a request for change of address in the register, does not need to be explained and supported by evidence. However, where the circumstances under which the request for alteration is made are not apparent, we can require the owner to file reasons for and evidence in support of the request (rule 54(2)).

Alteration must not substantially affect a mark's identity

The alteration must not substantially affect the identity of the trade mark (section 55(2)). What is meant by the identity of the mark are those features by which the mark is recognised, either by its meaning, phonetically or visually, and which distinguish the goods or services of the owner of the mark from the similar goods or services of other traders (*Seaforth Maritime Ltd's Trade Mark* [1993] RPC 72 at 74).

Factors to be considered in deciding whether an alteration substantially affects the identity of a registered trade mark include:

- Is an essential element of the mark altered substantially?
- Does the altered mark create a substantially different impression?

Publishing the proposed alteration

If we propose to allow the alteration, notice of the alteration will be published in the Hong Kong Intellectual Property Journal (rule 54(3)). The published notice must include a representation of the trade mark as altered (rule 54(3)).

Objection to the proposed alteration

Any person claiming to be affected by a proposed alteration can object to it by filing a notice of objection (rule 55(1)). The notice of objection must include a statement of the grounds of objection which explains how the objector would be affected by the alteration if it was made, and why in his opinion it would be contrary to section 55 to allow the alteration (rule 55(2)). The notice of objection must be filed within 3 months after the date of publication (rule 55(1)), and this time limit cannot be extended (rule 95(1)(n)).

The grounds for objecting to a proposed alteration include: the mark does not contain or consist of the owner's or any previous owner's name or address; or the alteration is not merely to the name or address; or the alteration substantially affects the identity of the mark (section 55(2)).

Registering the alteration

If the proposed alteration is not objected to, or the objection is determined in the applicant's favour, ~~alter~~ the mark will be altered in the register.

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Transitional provisions

~~The new law applies to requests for alteration of a registered trade mark filed on or after the commencement date.~~

~~The old law continues to applyies to applications for alteration of a registered trade mark (section 51 of Cap. 43) filed before the commencement date under the old law and remainwhich are pending as at on the commencement date (section 97; section 15 of Schedule 5).~~

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