

Objections and opposition to change of classification of goods or services

Provision is made for both the owner of a registered trade mark to object to a reclassification of his goods or services and for any other person claiming to be affected by such reclassification to oppose the proposed reclassification after its publication in the Hong Kong Intellectual Property Journal.

Objections by owner

The Registrar is obliged, before he makes any amendment to the register for the purposes of reclassifying the goods or services of a registered trade mark, to give the owner of the trade mark notice of his proposals for amendment (rule 59(1)).

The notice will include a statement informing the owner that he may, within three months after the date of the notice, file written objections to the proposal and the consequences of not doing so. There is no specified form nor fee payable, however the written objection must state the owner's grounds for his objection.

The time limit is ~~extendible~~ extendable but the owner risks publication of the proposals and the forfeiture of the right to object if the application to extend the time period is made after the expiration of the time limit (rule 59(2)(b)).

After considering the written objections, and after hearing the party, if requested, the Registrar will abandon the proposals if he considers the objections have merit, or publish the proposals or amended proposals as the case may be.

Irrespective of whether the owner has filed a written objection or not, the owner is

precluded from further opposition. This is the effect of section 58(3)(d) and rule 59(2)(b) read together.

Opposition by any other persons claiming to be affected

Following publication of the proposals in the Hong Kong Intellectual Property Journal, any person (other than the owner) claiming to be affected by the reclassification may file notice of opposition.

The notice of opposition is to be filed on Form T6 together with the prescribed fee (currently \$800) within 3 months after the date of publication of the proposals for reclassification in the Hong Kong Intellectual Property Journal (rule 61(1)). This time limit is ~~non-extendible~~non-extendable (rule 95(1)(o)). The opponent should, at the same time, file an address for service (rule 105(n)).

The notice of opposition shall include a statement of the grounds of opposition and in particular it must explain how the opponent would be affected by the proposed amendments and why the proposed amendments would be contrary to section 58(5) (rule 61(2)).

Although rule 61 uses the terminology “notice of opposition” this is not an “opposition” in the sense of rules 16 – 21. The opposition is confined to challenging the proposed reclassification on the grounds that it would substantially extend the rights conferred by the registration or adversely affect the rights of any person.

The Registrar has the power to require or to admit evidence directed to the questions in issue (rule 61(4)).

The provisions of rule 74 apply, see chapter on Hearings, for any hearing requested by the opponent.

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