

Orders of court transferring registered trade marks and applications

Orders transferring registrations and applications

A court in the Hong Kong SAR can make an order transferring a registered trade mark, an application for registration of a trade mark, or any right in or under it, in proceedings relating to the ownership of the registration or application, or any right in or under it (see sections 29(2)(e) and 31(1)).

Because a trade mark registered in the Hong Kong SAR is a piece of personal property situated in the Hong Kong SAR, there is no authority other than the court in the Hong Kong SAR that is competent under section 29(2)(e) to order the transfer of a registered trade mark or any right in or under it.

Application of the new-law Trade Marks Ordinance (Cap. 559)

An order transferring a registered trade mark or application for registration of a trade mark is a registrable transaction (sections 29(2)(e) and 31(3)). Unless particulars of the order are filed for registration, the order is ineffective as against a person acquiring a conflicting interest without knowledge of it (sections 29(3)(a) and 31(3)). Unless particulars of the order are filed for registration, a person claiming to be a licensee by virtue of the order does not have the rights of a licensee under the Ordinance (sections 29(3)(b) and 31(3)).

Additionally, unless particulars of the order are filed before the end of the period of 6 months beginning on its date, the person who becomes the trade mark owner or licensee by virtue of the order will not be entitled to damages or an account of profits for infringements for the period before particulars of the order are registered (sections

29(4)(a) and 31(3)).

It is necessary to produce the order when applying to register particulars (of a transfer of a registered mark) or when giving notice to register particulars (of a transfer of an application for registration) (rule 62(5)).

Examining applications/notices to register particulars

Factors to be considered in examining applications/notices to register particulars of court orders are listed below:

- Is the application to register particulars (relating to registered mark(s)) or notice to register particulars (relating to application(s) for registration) made on the specified form, Form T10 (rule 62(1))?

- Was the specified fee (Fee No.19) paid on filing? An application/notice to register particulars of one registrable transaction can relate to more than one registered mark or application for registration.

- Is the application/notice made by, and signed by or on behalf of, the person who becomes the owner or licensee by virtue of the order (section 29(1)(a)) or any other person claiming to be affected (section 29(1)(b))?

- Is the application/notice accompanied by documentary evidence (rule 62(5))? The application/notice must be accompanied by a certified copy of the order (rules 62(5) and 117(1)), and the order will be open to public inspection (rule 69(1)(r)).

- Does the application/notice state:
 - the transferee's name and address (rule 63(1)(f)(i));
 - if the transferee is a corporation, the place under the law of which the corporation was formed and registered, incorporated or established (rule 63(1)(f)(ia)) (if the transferee was incorporated in the United States, the state under the law of which it was incorporated should be stated);
 - the name of the court or other competent authority (rule 63(1)(f)(ii));
 - the date of the order (rule 63(1)(f)(iii)); and
 - the trade mark, application or right transferred (section 29(2)(e) and rule 63(1)(f)(iv))?

Registering particulars of an order

The following matters are entered in the register:

- the transferee's name and address (rule 63(1)(f)(i));
- in case the transferee is a corporation, the place under the law of which the corporation was formed and registered, incorporated or established (rule 63(1)(f)(ia));
- the name of the court or other competent authority (rule 63(1)(f)(ii));
- the date of the order (rule 63(1)(f) (iii));
- in case of a transfer of any right in or under the trade mark or application, a

description of the right transferred (rule 63(1)(f)(iv));

- the date of application or notice to register particulars of the order (sections 29(3), 29(4)(a) and 31); and

- the date on which the entry in the register is made (rule 63(2)).

Transitional provisions

~~The new law applies to applications to register particulars of orders (relating to a registered mark or marks) filed on or after the commencement date (section 97; sections 8(1) and 8(6) of Schedule 5).~~

~~Applications filed before the commencement date under the old law and pending on the commencement date, to register a subsequent proprietor or other right holder as the result of a court order, are treated as applications to register particulars under the new law (section 97; section 8(4) of Schedule 5). We may require the applicant to amend his application to register particulars to conform with the requirements of the new law (section 97; section 8(5) of Schedule 5).~~

* * *