

Transitional provisions for proceedings before the Registrar

Registrability

If no written “decision” pursuant to rule 20(1) of the ~~old-repealed Trade Marks~~ Rules (Cap. 43 sub. leg.) has been issued ~~at the date that Schedule 5 to the Ordinance came into operation~~ as at 4 April 2003, or where a decision has been issued but the appeal period has not yet expired, the application to register is considered as “pending” (Trade Marks Ordinance, Cap. 559, Schedule 5 section 1(4)) and will be dealt with under the old law (as defined in Cap. 559, Schedule 5 section 1(1)) (Cap. 559, Schedule 5 section 10(1)).

This means that a formal registrability hearing, sought in the case of a decision issued after consideration of a considered reply and issued after ~~the commencement of Schedule 5~~ 4 April 2003, will be governed by the old law (as defined in Cap. 559, Schedule 5 section 1(1)).

An appeal lodged after a formal registrability hearing, where the decision was issued not earlier than 3 months before ~~the commencement date of Schedule 5~~ 4 April 2003 (i.e. the appeal period had not expired on ~~the commencement date~~ 4 April 2003), would be decided under the old law (as defined in Cap. 559, Schedule 5 section 1(1)).

The “old law” (as defined in Cap. 559, Schedule 5 section 1(1)) –includes the ~~old-repealed Trade Marks~~ Rules (Cap. 43 sub. leg.) (Schedule 5 section 1(1)), so for these hearings the ~~old-repealed Trade Marks~~ Rules still apply.

Opposition

An application advertised on or before ~~the commencement of Schedule 5~~ 4 April 2003 cannot be converted to ~~the new law~~ Cap. 559 (Schedule 5 section 11(1)) and accordingly any opposition to it will be governed by the old law (as defined in Cap. 559, Schedule 5 section 1(1))~~and old Rules~~. For applications made under the ~~old law~~ repealed Cap. 43 which are advertised on or after ~~the commencement date~~ 4 April 2003, rule 121 provides that the period for filing of the notice of opposition and counter-statement shall be 3 months beginning on the date of the advertisement/filing of the notice of opposition respectively.

Any opposition proceedings commenced under the ~~old law~~repealed Cap. 43 continue to be governed by the old law (as defined in Cap. 559, Schedule 5 section 1(1))~~and Rules~~.

It should be noted that applications pending on ~~commencement~~ 4 April 2003 but advertised after ~~commencement~~ 4 April 2003 are dealt with under the old law (as defined in Cap. 559, Schedule 5 section 1(1)) (including advertisements in the Gazette, old forms (including Form TM-No. 6 and Form TM-No. 7) and old fees), subject only to time limits for notice of opposition and counter-statement in rule 121 and a request for extension of such time limits under rule 121 has to be filed on the new Form T13 with the new prescribed fee. Extension of time for filing evidence will continue to be governed by the old law (rule 91 of Cap. 43 sub. leg.), and the old law Form S. 75 with prescribed fee is applicable.

Opposition to alteration of registered trade mark (section 51 Cap. 43)

Where an application for alteration is made under section 51 of ~~the repealed~~ Cap. 43 before ~~the commencement date~~ 4 April 2003 and is pending on ~~commencement~~ 4 April 2003, any opposition to it after it has been advertised (whether the advertisement takes place before or after ~~commencement~~ 4 April 2003) is governed by the old law (as defined in Cap. 559, Schedule 5, section 1(1))~~and Rules~~ (Schedule 5 section 15). Rule 121 has no application in this scenario.

Existing oppositions continue under the old law (as defined in Cap. 559, Schedule 5 section 1(1)), ~~old Rules~~.

Other proceedings

Any application in which a decision has yet to be issued or where a decision was issued not earlier than 3 months before ~~the commencement date of Schedule 5~~ 4 April 2003 (i.e. the appeal period has not expired on ~~the commencement date~~ 4 April 2003) shall be dealt with under the old law (as defined in Cap. 559, Schedule 5, section 1(1)), ~~old Rules~~ (Schedule 5 sections 3(1), 9(6), 16(1) and 17(1)). This applies to the following applications:

- Applications under section 37 of the repealed Cap. 43;
- Applications under section 48 of the repealed Cap. 43;
- Applications under section 50 of the repealed Cap. 43;
- Applications to expunge or vary registration for breach of conditions (section 49 of the repealed Cap. 43); and
- Proceedings under section 60 of the repealed Cap. 43.

* * *