

Agents

Who can act as agentsRecognition

In general, Any person, whether an individual, a partnership or a company, can act as a trade mark agent in any proceedings in the Trade Marks Registry.

Agent's address in Hong Kong

An agent must have a residence or a place of business in Hong Kong (section 88(3)).

Agent can act in all proceedings

An agent can act and sign for an applicant, a registered owner or other person in connection with any proceedings under the Ordinance (section 88(1)).

However, an agent cannot make a statutory declaration or affidavit (unless he has first-hand knowledge of the facts to be deposed) or give or revoke a power of attorney on behalf of an applicant or other person for whom he acts.

Agent must have residence or place of business in Hong Kong

An agent must have a residence or a place of business in Hong Kong, failing which the Registrar would refuse to recognize a person as an agent (section 88(3)).

Accordingly, an agent must provide the Registry with an address in Hong Kong where the agent resides or has a place of business. A place of business of an agent typically refers to an office or any premises used, whether exclusively or not, for carrying on the

business activities of the agent.

Any premises, notably an office providing secretarial services and a business centre, that is solely used by an agent either for forwarding mails or as a “care of” address does not satisfy the requirement under section 88(3). A P.O. box, virtual office, or any office/place outside Hong Kong is equally not acceptable to the Registry.

Notifying the Registrar of Filing agent’s address in Hong Kong

An agent must file-notify the Registrar in the specified form or in writing of the address in Hong Kong where he resides or carries on his business activities before he acts or signs on behalf of an applicant, a registered owner or other person in connection with proceedings under the Ordinance or the Rules (rules 103(3) and 103(5)).

The notice must contain a declaration by the agent that he resides or carries on business activities on the local premises as specified in the notice.

~~If we receive a complaint with evidence or have other reasons to believe that the address filed is neither a residence nor a place of business of the agent in Hong Kong, we will send a notice to the agent concerned:~~

- ~~▪ requesting him to file supporting document (e.g. a copy of business registration certificate or utility bill in the name of the agent) to show that he resides or carries on his business activities at the address given within 1 month after the date of the notice; and~~
- ~~▪ informing him that the Registrar is unable to recognize as an agent a person having neither a residence nor a place of business in Hong Kong (section 88(3)).~~

~~If the agent fails to provide any supporting document within the specified period, the Registrar will refuse to recognize him as an agent. All future correspondence will be sent directly to the person instructing the agent and we will request him to file a new~~

address for service in Hong Kong under rule 107(1) (see chapter on Address for service and change of name, address or address for service).

Failure to notify the Registrar of agent's address in Hong Kong

If no notification of an agent's address in Hong Kong is given to the Registrar in accordance with rule 103(3), the Registrar will send a notice to the person instructing the agent:

- requesting him to file his agent's address in Hong Kong within 2 months after the date of the notice; and
- informing him that the Registrar will refuse to recognize a person having neither a residence nor a place of business in Hong Kong as his agent (section 88(3)).

New agent

An agent appointed by a person who is already a party to proceedings before the Registrar, or appointed to replace another agent, must file an address for service in Hong Kong at the time, or before, he acts or signs on behalf of the person in connection with the proceedings (rules 105(2), 105(9) and 105(10)). A new agent can register an address for service in Hong Kong by filing Form T5 (rule 106(1)(a)) or any other specified form that he files in connection with proceedings under the ~~Trade Marks~~ Ordinance (rule 105(1)(v)). Keep in mind that a person can have only one address for service for a particular application for registration of a trade mark or a registered mark (rules 105(5) and (6)) (see chapter on Address for service and change of name, address or address for service).

It is for the new agent appointed to replace another agent to inform the latter of the new appointment in question~~former agent~~.

If ~~there is any we have reason to~~ doubt about an agent's authority, the Registrar ~~we~~ can require the person instructing the agent to sign personally (rule 103(1)), or ~~:-~~ Alternatively, we can require the an agent to produce evidence of his authority (rule 103(2)).

Change of agent's address

An agent should notify the Registrar of any can change of his address in Hong Kong by filing Form T5 or by notifying the Registrar otherwise in writing (rule 103(4)).

The notice to the Registrar must contain a declaration by the agent to the effect that his new address in Hong Kong as specified in the notice is where he resides or carries on business activities.

~~Failure to file agent's address in Hong Kong~~

~~If an agent's address in Hong Kong is not filed in accordance with rule 103(3), we will send a notice to the person instructing the agent:~~

- ~~▪ requesting him to file his agent's address in Hong Kong within 2 months after the date of the notice; and~~
- ~~▪ informing him that the Registrar is unable to recognize as an agent a person having neither a residence nor a place of business in Hong Kong (section 88(3)).~~

Circumstances requiring additional proof of agent's residence or place of business in Hong Kong

Where the Registrar receives a complaint/report supported by evidence, or has any other reason to believe that the local address of an agent filed with the Registrar is neither a residence nor a place of business of the agent, the Registrar will send a notice to the agent concerned:

- requesting him to file within 1 month after the date of the notice with the Registrar written proof of his residence or his business activities at the local address in question; and
- informing him that in the absence of written proof to the satisfaction of the Registrar as aforesaid, the Registrar will refuse to recognize him as an agent (section 88(3)).

Whether an agent has a residence or place of business in Hong Kong is a question of facts to be established by the agent and determined by the Registrar based on the particular facts in each individual case.

Valid written proof of local residence or place of business should bear the full name and address of the agent in question, and should generally be issued within the last three months before the date of the Registrar's notice. Depending on the individual circumstances, copies of the following supporting documents would generally suffice:

- utility bills (e.g. water, electricity, town gas);
- stamped lease agreement for residential property/office premises.

If a person acting as agent fails to, at the request of the Registrar, furnish with the Registrar within the specified period valid and sufficient proof of the person's local residence or place of business, the Registrar will refuse to recognize such person to act as an agent. Accordingly, the person will no longer have any entitlement in the capacity of an agent to receive any further correspondence from the Registrar in relation to proceedings before the Registrar. The person's principal, being the affected party, is then subject to the Registrar's request to file a new address for service in Hong Kong under rule 107(1) (see chapter on Address for service and change of name, address or address for service).

Other circumstances under which the Registrar may refuse to

recognize person acting as agent

The Registrar is also empowered to refuse to recognize a person acting as an agent in respect of any business under the local trade mark legislation in several specified circumstances. These include where the person has been convicted of a criminal offence or has been suspended from acting as a barrister or solicitor; a specified statutory order has been made against the person, e.g. under the Securities and Futures Ordinance (Cap. 571) (see rule 104 for more details).

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