Appeals against decisions of the Registrar

What may be appealed against

Any decision or order of the Registrar made under the Ordinance is subject to appeal to the Court of First Instance ("Court") (section 84). Unlike under Cap. 43, "decisions" are specifically defined to include any act of the Registrar made in the exercise of a discretion vested in him by or under the Ordinance. This effectively means that any challenge to the Registrar's decisions or orders whether made pursuant to statutory provisions or in the exercise of a discretion will be by way of an appeal.

An appeal therefore lies against any decision of the Registrar, such as his refusal to register a trade mark, his decision in an opposition matter and other *inter partes* proceedings, and any other decision by the Registrar in the exercise of his discretion, including any interlocutory decision.

Appeals to the Court are governed by O.55 of the Rules of the High Court. They should be instituted by originating motion (O.55, r.3(1)).

Decisions of the Registrar

When the Registrar has made a decision in any proceedings before him, a notice will be sent to each party to the proceedings communicating the decision. If a statement of the reasons for the decision is not included in the notice, any party to the proceedings can file a request on Trade Mark Form T12 for a statement of the reasons for the decision, within one month after the date on which the notice is sent to him. The party making the request should, at the same time, send a copy of his request to all other parties to the proceedings.

Computation of time for appeal

The notice of originating motion ("notice of motion") by which an appeal is brought and the grounds of the appeal must be served and the appeal entered within 28 days after the date of the decision or order against which the appeal is brought (O.55, r.4(2)).

For the purpose of any appeal against the Registrar's decision, the decision is deemed to have been made on the date on which the notice of decision is sent, or, where a statement of reason has been requested within the stipulated period, the date on which the statement of reason is sent (rule 91 of the Trade Marks Rules).

An application to extend the prescribed period for bringing an appeal may only be made to the Court (O.3, r.5).

The Court's powers

The Court's powers under O.55 and section 85 of the Ordinance are much wider than those in relation to a judicial review (O.53). The Court not only exercises a supervisory role over the Registrar's decisions, it also has powers concurrent with those of the Registrar, for the purpose of determining any question in its original jurisdiction under the Ordinance, to make any order or exercise any other power which the Registrar could have made or exercised (section 85). In particular, O.55, r.3(1) provides that an appeal shall be by way of a rehearing; O.55, r.7(2) provides for the reception of further evidence and for directions as to how it should be received; and O.55, r.7(5) for any order to be made by the Court which should have been made by the Registrar.

The general principles on the Court's approach in dealing with an appeal from a decision of the Registrar can be found in *Monster Energy Company v 洪嘉珮* [2020] HKCFI 561, at §§10-14, and *Re NAKED* [2010] 1 HKLRD 382, at §22.

The legal principles to be applied when the Court is determining whether to admit further evidence in an appeal against a decision of the Registrar can be found in *樂氏同仁藥業科技集團有限公司 v 中國北京同仁堂(集團)有限責任公司* [2021] HKCFI 1025, at §§5-10.

The Registrar's right of appearance in appeals

The Registrar must be served with the notice of motion and grounds of appeal, whether he is named as a party to the appeal or not (O.55, r.4(1)). In any appeal under the Ordinance, the Registrar is entitled to appear and be heard in the proceedings in support of his decision or order, either of his own motion or if so directed by the Court (section 84(3)).

Parties to an appeal

Where a party appeals to the Court against a decision of the Registrar in an *ex parte* matter, the Registrar may be named as the respondent to the appeal. However, where the Registrar's decision is in relation to an *inter partes* matter, the Registrar should not be named as the respondent. The parties to an appeal are the same parties to the proceedings from which the appeal is brought (see *East Touch Publisher Ltd. v. The Television and Entertainment Licensing Authority* [1996] 3 HKC 195).

Appeal not a stay of proceedings

The bringing of the appeal does not of itself have the effect of staying the proceedings in the Registry unless the Court hearing the appeal, or the Registrar who gave the decision so orders. If the Registrar who made the decision has not ordered a stay of proceedings, an application for a stay under O.55, r.3(3) may be made by motion or summons to the Court hearing the appeal. In addition, the appellant may appeal to the Court if the Registrar has refused the stay.

Appeal from the Registrar's decision in an *inter partes* matter

The Registrar normally does not take part in the appeal where no issues of principle or public importance seem to be involved.

If the Registrar decides to appear and be represented in the appeal, Instructions to Counsel (Department of Justice) will be prepared as soon as possible, giving the Registrar's opinion on the points at issue.

If the Registrar decides he will not be represented at the hearing, the Registrar will notify the Court and the legal representatives of each of the parties to the appeal.

On occasion, on an appeal, the Court may direct the Registrar to give an opinion or answer questions of procedure. The Registrar will appear as directed to provide his assistance either through an authorised representative or by Counsel (Department of Justice). He may, for example, give particulars of :

- any proceedings before the Registrar in relation to the matters in issue;
- the grounds of any decision given by him;
- the practice of the Registry in similar cases; and
- such matters as are relevant to the issues and within his knowledge as the Registrar thinks fit to provide.

The parties should observe the requirements set out in the Judiciary's Practice Direction 22.1 concerning appeals against decisions of the Registrar.

Appeal from Registrar's decision in an *ex parte* matter

Where an applicant appeals against the Registrar's refusal to register his application, the Registrar appears by Counsel (Department of Justice). The Instructions to Counsel should include details of any relevant Registry practice and applicable case law. A folder containing a copy of the Registrar's decision and a copy of the trade mark application should be supplied to Counsel. Conference with Counsel should be arranged.

Costs

Unlike under section 81 of Cap. 43, the Registrar accepts that in an *ex parte* matter he is in the position of any other litigant before the Court, and that the Court may award to any party such costs as it may consider reasonable, usually following the event.

Decisions of the Court

The Court will make an order on the appeal, but no action should be taken by the Registry until after the appeal period (see O.59, r.4) has expired, and a sealed copy of the order is filed with the Registry by the person in whose favour the order is made. A copy of the Court's judgment should be circulated in-house as with other decisions issued by the Registrar.

Appeal dismissed

If the appeal fails and the Registrar's decision is upheld, the Registrar's original decision should be actioned unless the appellant appeals further.

Appeal allowed

In an *ex parte* matter, if the appeal is allowed and the Registrar's decision reversed, a decision will be made whether the Registrar should make a further appeal. A conference with the Department of Justice/Counsel may be appropriate. The Registrar will only

lodge a further appeal if some important general principle is involved. The Court's judgment should be actioned if the Registrar decides not to further appeal.

In respect of a registrability matter, this will mean that the application will proceed to publication, but the Registrar should note any conditions or amendments subject to which the Court may have allowed the appeal.

In an *inter partes* matter, if the appeal is allowed and the Registrar's decision reversed, the Court's judgment should be actioned unless the respondent appeals further.

Further appeal

Appeals to the Court of Appeal are governed by O.59.

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