

Consolidation of proceedings

Consolidation is an administrative procedure to reduce costs and the work involved in dealing with several sets of similar proceedings.

When should consolidation be requested?

There is no fixed period for this but clearly there will be substantial benefits for both parties if they agree to an early consolidation, as thereafter only one set of evidence needs to be filed, headed in respect of the consolidated proceedings.

In opposition proceedings consolidation will not be allowed until after Form T7 (counter-statement) has been filed.

In revocation proceedings based upon non-use under section 52(2)(a), and in variation or rectification proceedings, consolidation may be allowed before Forms T7 are filed if the parties agree and the Registrar is satisfied that the issues are identical in all the proceedings. The reason for this difference is that evidence must be provided at an earlier stage than in opposition proceedings (rule 36(2) and rule 48(2)(b) respectively). However, even when consolidation is agreed prior to filing Form T7, separate T7 Forms and counter-statements must be filed for each set of proceedings as consequences flow against either party failing to file Form T7, i.e. in revocation proceedings (rule 37(4)) and in variation or rectification proceedings (rule 50(6)).

With multiple applications or cross-applications, consolidation will not be possible until all the evidence is filed as the sequence for filing evidence may be different.

The Registrar may not agree to consolidation if the two sets of proceedings are at very different stages, as otherwise one set would have to be suspended while the other catches up.

Who may request consolidation?

Any party in proceedings may request consolidation. In appropriate circumstances the Registrar may invite the parties to consider consolidation. The party seeking consolidation should make a written request to the Registrar, copying the request to the other party. Where the parties agree to consolidate, the Registrar will usually direct the consolidation.

The Registrar will, as far as practicable, allow the other party an opportunity to comment on the request. The comments must be copied to the party seeking consolidation.

In the event that the other party does not consent, or the Registrar declines the application, the procedure set out in rule 88 will apply.

When would consolidation be appropriate?

Cross-oppositions, e.g. where the applicant in one case is the opponent in another and the marks are similar, consolidation may be appropriate. This is not applicable when one set of proceedings is under Cap. 43 and the other under Cap. 559.

Cross-opposition/Revocation, e.g. where the proprietor of a registered mark opposes an application and the applicant for the mark has applied to revoke/invalidate the registered mark, consolidation may be appropriate.

Opposition by the same opponent to two similar marks by different applicants will rarely be allowed even if both applicants consent. Insurmountable difficulties and complexity would arise if an appeal were lodged against only one of the marks.

Opposition by different opponents to the same mark is not a consolidation situation.

Revising time limits

If consolidation is agreed and/or allowed, the files concerned have to be checked for applicable time limits and the parties notified of any such revisions. The new time limit for outstanding action is to be revised to the due date for the action to be taken furthest away in point of time from the date of the consolidation order. The computer system database must also be updated with the revised due dates.

If consolidation is refused, particularly where the parties are the same and the reason for refusal is technical (applications under different Ordinances) or as a result of disparity in the stage of proceedings, the Hearing Officer should nevertheless attempt to hear the cases one after the other, even though this may accelerate the later case up the pending hearing list.

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