

Transitional arrangements for the repealed Trade Marks Ordinance (Cap. 43)

Introduction

Section 99 of the Trade Marks Ordinance (Cap. 559) repeals the Trade Marks Ordinance (Cap. 43) and the Trade Marks Rules (Cap. 43 sub. leg.) as from 4 April 2003.

Schedule 5 of Cap. 559 deals with transitional matters where Cap. 43 will continue to apply in certain circumstances.

Existing registered marks

Existing registered marks (whether registered in Part A or B under Cap. 43) are transferred on 4 April 2003 to the new register (Cap. 559, Schedule 5 section 2(1)).

Existing registered marks registered as a series under section 26 of Cap. 43 (series of trade marks) shall be deemed to be registered as a series in the new register (Cap. 559, Schedule 5 section 2(2)).

Any disclaimers, conditions or limitations entered on the former register which related to an existing registered mark shall be deemed to be transferred to the new register (Cap. 559, Schedule 5 section 3(2)).

Pending applications

The “old law” is defined to mean, amongst other things, the repealed Trade Marks

Ordinance (Cap. 43) and Trade Marks Rules (Cap. 43 sub. leg.) (Cap. 559, Schedule 5 section 1(1)).

An application for registration of a mark under the repealed Cap. 43 which is pending as at 4 April 2003 shall be dealt with under the old law, and, if registered, the mark shall be treated as an existing registered mark (Cap. 559, Schedule 5 section 10(1)).

Where the old law applies, the old forms and fees and provisions in the repealed Cap. 43, including provisions relating to advertisements in the Gazette (section 14; rule 22), continue to apply.

A matter is treated as pending on 4 April 2003 if:

- the matter was pending before the Registrar under the old law but no written decision on the matter had been issued by the Registrar before 4 April 2003;
- the matter was the subject of a written decision issued by the Registrar under the old law before 4 April 2003 but the decision was subject to appeal under the old law and the period for commencing the appeal has not yet expired;
- the matter was the subject of proceedings under the old law which were pending before a court immediately before 4 April 2003; or
- the matter was the subject of an order made by a court before 4 April 2003 but the order was subject to appeal under the old law and the period for commencing the appeal had not yet expired.

(Cap. 559, Schedule 5 section 1(4))

Thus, if no written decision pursuant to rule 20(1) of the repealed Trade Marks Rules (Cap. 43 sub. leg.) has been issued 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”.

The time limit for responding to an examination report under rule 18/19 (Cap. 43 sub. leg.) will continue to apply in respect of pending applications examined under the old law.

Opposition

Section 15 of the repealed Cap. 43 (Opposition to registration) and any other provisions of the old law relating to opposition to registration continue to apply to these pending applications (Cap. 559, Schedule 5 section 10(2)). These can be divided into two categories:

- applications pending on 4 April 2003, and advertised before 4 April 2003 – the old law including the old forms and fees apply;
- applications pending on 4 April 2003, but advertised after 4 April 2003 – the old law, old forms (including Form TM-No. 6 and Form TM-No. 7) and old fees apply, except that the period within which notice of opposition and counter-statement may be filed in respect of such applications are prescribed in rule 121 (Cap. 559 sub. leg.).

(See chapter on Transitional provisions for proceedings before the Registrar).

Associated marks

The concept of associated marks does not exist under the Trade Marks Ordinance (Cap. 559). No reference to association will be made in the case of marks registered on or

after 4 April 2003.

Notes indicating that existing registered marks are associated with other marks have ceased to have effect on 4 April 2003 (Cap. 559, Schedule 5 section 2(4)).

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