

Certification and collective marks

The Trade Marks Ordinance (Cap. 559) provides for the registration of certification and collective marks. Certification marks were registrable under the repealed Trade Marks Ordinance (Cap. 43), but collective marks are a new type of registrable marks introduced by Cap. 559.

Unlike an ordinary trade mark, a certification mark does not indicate origin by identifying the manufacturer, producer or provider of the goods or services. Instead it conveys the message that the goods or services have been examined, tested or in some way certified by an independent organisation who does not trade in those goods or provide the services, by methods determined by the owner of the certification mark to indicate or guarantee certain specific characteristics or quality.

A collective mark indicates commercial origin of goods or services in members of an association rather than origin in one particular manufacturer or service provider.

Certification marks

Definition of a certification mark

Section 62 and Schedule 4 of the Trade Marks Ordinance (Cap. 559) set out the relevant provisions on certification marks. Section 62(1) provides that a certification mark:

“is a sign indicating that the goods or services in connection with which it is used are certified by the owner of the sign in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.”

There are important differences between a certification mark and an ordinary trade mark, and applicants should note the following:

- The Ordinance applies to certification marks subject to the provisions of Schedule 4.
- Section 3(1) of Schedule 4 permits the registration of a certification mark indicating geographical origin.
- The owner of a certification mark must not carry on a trade or business involving the supply of goods or services of the kind certified (section 4 of Schedule 4). However, the owner may authorise others to use the certification mark.
- The application for registration of a certification mark will be refused if the public is liable to be misled as regards the mark's character or significance, in particular, if it is likely to be taken to be something other than a certification mark. The Registrar may require the mark to include some indication that it is a certification mark (section 5 of Schedule 4).
- The applicant must file with the Registrar regulations governing the use of the certification mark (section 6(1) of Schedule 4) (see "Regulations governing use of certification marks" below for further details). A certification mark cannot be registered unless:
 - (a) the regulations governing its use comply with section 6(2) of Schedule 4 and any further requirements imposed by the Trade Marks Rules; and
 - (b) the applicant is competent to certify the goods or services for which the certification mark is to be registered (section 7(1)(b) of Schedule 4).

A number of registered certification marks are shown in Appendix 1 as an illustration of the kind of marks which are registrable as certification marks.

The examination process

An application for a certification mark should be made on Form T2. The applicant has to indicate on the application form that the application is for registration of a certification mark. The application will be examined in the same way as an application for an ordinary trade mark except as otherwise indicated in this chapter (see chapter on Examination of applications).

The applicant must file a copy of the regulations governing use of the certification mark with the Registrar within nine months after the date of application for registration (section 7(3) of Schedule 4 and rule 101(1)). Otherwise, the application is deemed to be withdrawn (section 7(4) of Schedule 4).

The regulations must be accompanied by evidence of the applicant's competence to certify the goods or services for which the certification mark is to be registered. Such evidence is to be in the form of a statutory declaration or affidavit ("Declaration of Competency"; rule 101(2)).

We may, even before an opinion under rule 13(1) is issued, send to the applicant our observations on the application, the suitability of the regulations and the sufficiency of the Declaration of Competency. We may specify a period of time during which the applicant may respond to any of the observations, which period is extendable under rule 94(1)(b). The applicant may respond by modifying the regulations, filing a new or supplementary Declaration of Competency or amending the application under section 46 of the Ordinance as appropriate (rule 101(3)).

We will examine the application, the regulations and Declaration of Competency filed, and consider whether the requirements for registering the mark as a certification mark are met. We will then issue an opinion under rule 13(1) if there are objections, for example, under the absolute or relative grounds, as well as under Schedule 4. We will give the applicant an opportunity to make representations, make a request to amend the

application under section 46, or to file amended regulations within 6 months (section 8(2) of Schedule 4; rules 13(2) and 101(4)). The Registrar, on the request of the applicant before the expiry of the six-month period, may extend the six-month period for one further period of 3 months (rules 13(3) and 101(4)). No further extension can be granted under rule 13(3).

The rest of the examination procedure is similar to that applicable to ordinary trade marks – see chapter on Examination of applications for details.

Regulations governing use of certification mark

The regulations need not take any particular form but they must deal with the issues set out in section 6(2) of Schedule 4. A certification mark cannot be registered unless the regulations comply with this section. The regulations governing the use of the mark must not be contrary to accepted principles of morality (section 7(2) of Schedule 4).

The regulations should at least deal with the following:

- Persons authorised to use the certification mark and the criteria (which must not be discriminatory) for the acceptance or rejection of applications to use the certification mark. The conditions of issue of licence or certificate to authorised users should be clearly stated. There should also be a formal agreement between the owner and each authorised user of the certification mark under which the owner agrees not to cancel the licence or certificate except in accordance with the regulations. The owner must maintain a register of all the authorised users which should be made available at the owner's registered office for inspection. The Regulations should also state what information is to be entered in the register and indicate that the register is open to inspection by the public on reasonable terms.

- The characteristics to be certified by the certification mark. The characteristics of the goods or services must be defined as precisely as possible, e.g. services

“of a good standard” are not acceptable. Such characteristics should be capable of objective testing.

- How the certifying body is to test the characteristics and to supervise the use of the mark. The regulations must provide for the inspection of goods in the course of their manufacture or for the inspection of samples, or other methods which will ensure that the goods or services have those characteristics. Details of the tests applied to the goods or services and the assessment of the results of those tests should be explained clearly in the regulations.
- Any fees payable in connection with the use of the certification mark need to be clearly described. The Registry will not require the actual amount of fees to be laid down, otherwise any subsequent revision of fees would necessitate an amendment of the Regulations, which would require the Registrar’s consent. It would be sufficient for the regulations to refer to, e.g. a schedule of fees contained in an identifiable document. The certification scheme should be operated by the owner on a not-for-profit basis.
- The regulations (including any schedules attached thereto) cannot be altered without the consent of the Registrar.
- The procedures for resolving any dispute between the certification mark owner and authorised users. There must be a right of appeal to an independent arbiter against any refusal on the part of the owner to certify or to authorise the use of the mark in accordance with the regulations. **It should be noted that the Registrar will not act as an independent arbitrator in this regard.** Referring disputes to the Hong Kong International Arbitration Centre (www.hkiac.org) would be acceptable. In the case of marks indicating overseas origin, appeals heard by a suitable independent arbiter within the overseas country concerned would also be acceptable.

The regulations must be filed in English or Chinese. If they are not in either one of these languages, a verified translation into the language of proceedings will be required (see chapter on Language).

The regulations are open to public inspection in the same way as the trade marks register (section 10 of Schedule 4).

Competence of the applicant

The applicant of a certification mark must prove that he is competent to certify the goods or services for which the mark is to be registered. Competence to certify is usually a question of the applicant's ability to monitor and control its licensees, or authorised users.

At the time of filing the regulations, the applicant must also provide evidence of his competence to certify the relevant goods or services (rule 101(2)). Such evidence is to be in the form of a statutory declaration or affidavit ("Declaration of Competency"). The Declaration of Competency should deal with the following:

Description of the applicant

An application must be made in the name of a legal person, ie, one who can sue or be sued. Applications can be made in the names of limited companies. In the case of an unregistered association, the applicant will need to satisfy the Registry that such an association has a legal personality; otherwise the application will need to be made in the name of someone who has legal personality, e.g. the secretary of the unregistered association. If the applicant is an incorporated entity, a copy of the memorandum and articles of association/constitution should be provided.

Nature of business

It is a fundamental requirement that the applicant does not trade in the relevant goods or services themselves. If the applicant carries on a trade or business involving the supply of some other goods or services, then the nature of such trading or business activities should be clearly stated. For incorporated applicants, it may be necessary for them to submit copies of the memorandum and articles of association/constitution for examination.

Competence

The Registrar must be satisfied as to the competence of the applicant to operate and supervise the scheme contemplated in respect of the certification mark. Generally the applicant must be of a sufficient size, have a well-known status in the relevant trade, and have sufficient skills and resources to ensure that the certification is authoritative.

Non-discrimination

An applicant must undertake that there would be no discrimination as to who can use the certification mark. Anyone meeting the conditions and standards in the regulations should be permitted to use the mark.

Adequate supervision

The applicant has an obligation to maintain the reputation of the certification mark and prevent its misuse. There must be satisfactory explanation as to how the use of the mark will be monitored to ensure that the relevant goods or services have the required characteristics. This may be supported in greater detail by the regulations.

Opposition to registration

The opposition procedure for ordinary trade marks also applies to certification marks (see chapter on Opposition to registration).

Assignments

Section 12 of Schedule 4 provides that “the assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar”. Such consent is likely to be given where, for example, the new owner of the certification mark has the competence to supervise the mark and where the mark in the new ownership will continue to have the same significance it had before the transfer. The Registrar will also consider whether the new owner carries on a trade or business involving the supply of goods or services of the kind certified.

Amendment of regulations

Section 11(1) of Schedule 4 to the Ordinance stipulates that an amendment of the regulations requires the consent of the Registrar before it is effective. The amended regulations will be examined on the same basis as the original regulations filed with the Registrar.

Before accepting any amended regulations, the Registrar may require a notice of the amendment to be published in the Hong Kong Intellectual Property Journal (section 11 of Schedule 4; rule 102(2)). Where such a notice is published, any person claiming to be affected by the amendment may within three months after the date of publication file a notice of opposition on Form T6 (rule 102(3)). This three-month period is non-extendable (rule 95(1)(s)). The notice must include a statement of grounds of opposition. The statement must explain how the opponent would be affected by the amendment and why the amendment would be contrary to section 7(1) or (2) of

Schedule 4. The opponent is required to send a copy of the notice of opposition to the owner of the certification mark at the time the notice is filed with the Registrar. If the Registrar is satisfied that the opposition has merit, he may refuse to accept the amendment. But if he is satisfied that the opposition is without merit, and that the amendment should be accepted, he may accept the amendment.

If no notice of amendment is filed within the three-month period, and the Registrar is satisfied that the amendment should be accepted, he will accept the amendment as proposed (rule 102(7)).

Merging of certification marks

Certification marks can be merged in the same way as ordinary trade marks (section 51 and rule 28). However, any proposed merger will need to take into account the possibility of having to amend each set of regulations.

Grounds for revocation/declaration of invalidity of a certification mark

Similar to an ordinary trade mark, a certification mark may be revoked on any of the grounds in section 52(2). In addition, a certification mark may be revoked on any of the grounds set out in section 15 of Schedule 4 :

- The owner has begun to carry on such a trade or business involving the supply of goods or services of the kind certified;

- The manner in which the owner uses the certification mark or allows it to be used has caused it to become liable to mislead the public in the manner referred to in section 5(1) of Schedule 4;

- The owner has failed to observe, or to secure the observance of, the regulations;
- Amendment to the regulations so that they no longer comply with section 6(2) of Schedule 4, or that they are contrary to accepted principles of morality;
- The owner is no longer competent to certify the goods or services for which the certification mark is registered.

Further details and the procedures for revoking a trade mark are set out in the chapters on Revocation of registration on the grounds of non-use and Revocation of registration (including defensive, collective and certification marks) on grounds other than non-use.

Similar to an ordinary trade mark, a certification mark may be declared invalid under section 53. In addition, a certification mark may be declared invalid on the ground that the certification mark was registered in breach of sections 4, 5(1), 7(1) or 7(2) of Schedule 4 (section 16 of Schedule 4). See chapter on Declaration of invalidity of registration of trade mark, collective or certification mark for further details.

Collective marks

The collective mark is a new class of trade marks under Cap. 559. It was not available previously under the repealed Cap. 43.

Section 61 of defines a collective mark as “a sign distinguishing the goods or services of members of the association which is the owner of the sign from those of other undertakings”. More detailed provisions relating to collective marks are set out in Schedule 3 to the Ordinance.

The purpose of a collective mark is to indicate the commercial origin of goods or services in members of an association, as opposed to a certification mark which is to certify certain characteristics of the goods or services. The collective mark is used by members of the association, and the proprietor (i.e. the association) holds the mark for the benefit of all members of the association. An example of use of a collective mark is an association of vegetarian restaurants which allows its members to display a collective mark showing that they belong to the same association.

The term “association” has its origin in Article 7*bis* of the Paris Convention for the Protection of Industrial Property (1967), which sets out the obligation for member states to provide for collective marks. “Association” is not defined in either the Paris Convention or the Ordinance. However it is generally understood to mean traders’ and manufacturers’ associations and not government departments.

An applicant should note the following provisions:

- A collective mark which consists of a sign which may serve to designate the geographical origin of goods or services may be registered (section 3(1) of Schedule 3).

- A collective mark shall not be registered if the public is liable to be misled as regards its character or significance, in particular, if it is likely to be taken to be something other than a collective mark. The Registrar may require that such a mark includes some indication that it is a collective mark (section 4(1) & (2) of Schedule 3).

As an illustration, the Chartered Institute of Patent Agents, the European Hydraulic Tool Manufacturers Association, and Amateur Swimming Association have registered “CHARTERED PATENT AGENT” (registration no. 2029488), “EHTMA Collective Mark” (registration no. 2109408), and “Amateur Swimming Association & device” (registration no. 2047450) respectively as collective marks at the UK Patent Office.

The examination process

An application for a collective mark should be made on Form T2. The applicant must indicate on the application form that the application is for registration of a collective mark. The application will be examined in the same way as an application for an ordinary trade mark except as otherwise indicated in this chapter (see chapter on Examination of applications).

The applicant must file a copy of the regulations governing use of the collective mark with the Registrar within nine months after the date of application for registration (section 6(3) of Schedule 3 and rule 100(1)). Otherwise, the application is deemed to be withdrawn (section 6(4) of Schedule 3). Unlike an application for registration of a certification mark, it is not necessary to file a Declaration of Competency.

We may, even before an opinion under rule 13(1) is issued, send to the applicant our observations on the application and the suitability of the regulations. We may specify a period of time during which the applicant may respond to any of the observations, which period is extendable under rule 94(1)(b). The applicant may respond by modifying the Regulations or amending the application under section 46 of the Ordinance as appropriate (rule 100(2)).

We will examine the application and the regulations filed, and consider whether the requirements for registering the mark as a collective mark are met. We will then issue an opinion under rule 13(1) if there are objections, for example, under the absolute or relative grounds, as well as under Schedule 3. We will give the applicant an opportunity to make representations, make a request to amend the application under section 46, or to file amended regulations within 6 months (section 7(2) of Schedule 3; rules 13(2) and 100(3)). The Registrar, on the request of the applicant before the expiry of the six-month period, may extend the six-month period for one further period of 3 months (rules 13(3) and 100(3)). No further extension can be granted under rule 13(3).

The rest of the examination procedure is similar to that applicable to ordinary trade marks – see chapter on Examination of applications for details.

Regulations governing use of collective mark

The regulations need not take any particular form but they must specify the matters set out in section 5(2) of Schedule 3:

- The persons authorised to use the collective mark.

- The applicant should, as part of the Regulations, include a list of names of the members who are authorised to use the mark. Alternatively, the Regulations may refer to an identifiable document which contains such information, e.g. a register of authorised users, and provide details of how it may be inspected.

- The conditions of membership of the association.

- Where they exist, the conditions of use of the collective mark, including any sanctions against misuse.

A copy of the memorandum and articles of association/constitution of the applicant should be provided. It may be attached as a schedule to the regulations if it contains information which is referred to in the regulations.

A collective mark will not be registered unless the regulations comply with section 5(2) of Schedule 3 and they are not contrary to accepted principles of morality (section 6 of Schedule 3).

The applicant should note the language requirements. Regulations have to be filed in English or Chinese. Otherwise a verified translation into the language of the proceedings is required (see rule 120 of the Trade Marks Rules and chapter on Language).

The regulations governing the use of a registered collective mark “shall be open to public inspection in the same way as the register” (section 9 of Schedule 3).

Opposition to registration

The opposition procedure for ordinary trade marks also applies to collective marks (see chapter on Opposition to registration).

Assignments

Unlike a certification mark, an assignment of a collective mark does not require the consent of the Registrar.

Amendment of regulations

Section 10(1) of Schedule 3 stipulates that an amendment of the regulations requires the consent of the Registrar before it is effective. The amended regulations will be examined on the same basis as the original regulations filed with the Registrar.

Before accepting any amended regulations, the Registrar may require a notice of the amendment to be published in the Hong Kong Intellectual Property Journal (section 10(2) of Schedule 3; rule 102). Where such a notice is published, any person claiming to be affected by the amendment may within three months after the date of publication file a notice of opposition on Form T6. This three-month period is non-extendable (rule 95(1)(s)). The notice must include a statement of grounds of opposition. The statement must explain how the opponent would be affected by the amendment and why the amendment would be contrary to section 6(1) or (2) of Schedule 3. The opponent is required to send a copy of the notice of opposition to the owner of the collective mark

at the time the notice is filed with the Registrar. If the Registrar is satisfied that the opposition has merit, he may refuse to accept the amendment. But if he is satisfied that the opposition is without merit, and that the amendment should be accepted, he may accept the amendment.

If no notice of opposition is filed within the three-month period, and the Registrar is satisfied that the amendment should be accepted, we will accept the amendment as proposed (rule 102(7)).

Grounds for the revocation/declaration of invalidity of a collective mark

Similar to an ordinary trade mark, a collective mark may be revoked on any of the grounds in section 52(2). In addition, a collective mark may be revoked on the grounds set out in section 13 of Schedule 3:

- The manner in which the owner uses the collective mark or allows it to be used has caused it to become liable to mislead the public in the manner referred to in section 4(1) of Schedule 3;
- The owner has failed to observe, or to secure the observance of, the regulations;
- Amendment to the regulations so that they no longer comply with section 5(2) of Schedule 3, or that they are contrary to the accepted principles of morality.

Further details and the procedures for revoking a trade mark are set out in the chapters on Revocation of registration on the grounds of non-use and Revocation of registration (including defensive, collective and certification marks) on grounds other than non-use.

Similar to an ordinary trade mark, a collective mark may be declared invalid under section 53. In addition, a collective mark may be declared invalid on the ground that the collective mark was registered in breach of sections 4(1), 6(1), or 6(2) of Schedule 3 (section 14 of Schedule 3). See chapter on Declaration of invalidity of registration of trade mark, collective or certification mark for further details.

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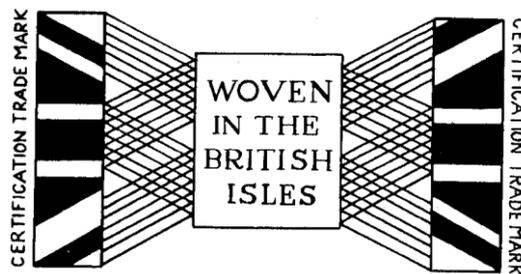
Appendix 1



Registration Nos. 1989C1898 – 1900, 1989C2607



Registration No. 1987C3330



Registration No. 1975C1077