

Processing of pleadings and evidence

Notice of opposition/Application for revocation

Upon receipt of Form T6, a sub-file will be opened bearing the trade mark application/registration number. This number must be quoted in all correspondence with the Registry. Where Form T6 relates to an opposition, a copy of the application particulars published in the Hong Kong Intellectual Property Journal should be placed in the file.

Upon receipt of Form T6 it will be examined to ensure that:

- The notice of opposition relates to only one trade mark application. If more than one application number is quoted it shall be treated as filed in respect of the first mentioned application only.
- Where the application is a “multi-class” application that the opponent has indicated whether the opposition is taken against all or just some of the classes in the application and the classes are marked on Form T6.
- Where Form T6 is filed by more than one party that it is expressed to be made “jointly”.
- The appropriate fee has been paid. If the form is lodged without the appropriate fee it cannot be accepted as having been properly filed (rule 4(3)). Where the form is lodged without the fee, the filing date of the form will be the date of receipt of the fee (rule 4(4)).

- Where it is an opposition, it has been filed within 3 months beginning on the date on which particulars of the application are published in the Hong Kong Intellectual Property Journal save where an application to extend time is filed within the prescribed period and granted, then within the extended period. See chapter on Computation of time for filing at the Registry.
- The form is accompanied by a statement of grounds of opposition.
- Where the opposition is based upon an earlier mark, that the statement of grounds includes the matters referred to in rule 16(2). See chapter on Opposition to registration.
- Where Form T6 is an application for revocation on the grounds of non-use, variation or rectification, it is accompanied by evidence.
- Where Form T6 is an objection to a proposed amendment to a trade mark application (rule 26) or opposition by someone other than the owner to a proposal for change of classification, that the statement of grounds covers the matter referred to in rules 26(3) and 61(2) respectively.
- Where Form T6 is filed by an intervener, that the intervener has stated the nature of his interest.
- Every section of Form T6 has been completed, and the form is signed and dated. If the section which provides the address for service in Hong Kong has not been completed, check whether a written notification of the address for service has been filed pursuant to rule 105(3)(b). The documents cannot be accepted as having been properly filed until an address for service is filed.
- Particulars of the opposition are entered into the computer system and all relevant fields completed.

Form T6 can be accepted and be deemed to be filed within time despite an irregularity in the form or the accompanying documents, other than non-payment of fee. However see the provisions of rule 95(2). In such a case the irregularity should be brought to the attention of the filer with a suggestion that leave be sought to file and serve an amended notice of opposition, application for revocation, or as is appropriate.

Counter-statement

Upon receipt of Form T7 it will be examined to ensure that:

- The application/registration number is correct.

- In the case of a counter-statement in opposition proceedings, the applicant's name is the same as on Form T2 (Application for registration of a trade mark).

- In revocation proceedings check that the owner's name is the same as that recorded on the register. If not, check whether a request to change name or to register the particulars of an assignment has been filed or application made for substitution of a party.

- If it has been filed more than three months after the date of the filing of the notice of opposition and not within an agreed extension period it may be necessary to ask the applicant for proof of the date of his receipt of the copy of the notice of opposition so that the exact deadline can be calculated. Rule 112(2) contains a deeming provision which can be overturned by evidence of the date of actual receipt.

- Form T7 is accompanied by a counter-statement complying with rule 17(1)(a) – (d), 37(1)(a) – (d), 41(1)(a) – (d) or 50(3)(a) – (d) as is appropriate.

- Where Form T7 is a counter-statement to an application for variation or rectification filed by someone other than the owner, that it is accompanied by evidence or a statement that the owner does not intend to file evidence.
- Where Form T7 is a counter-statement to an application for revocation for non-use, that it is accompanied by evidence of use or a statement giving reasons for non-use.
- Every section of the form has been completed and the form is signed and dated.
- If the address for service filed with the application for registration of a trade mark has meanwhile been withdrawn by notification in writing to the Registrar, the counter-statement can only be accepted as having been properly filed if an address for service in place thereof is provided in Form T7 or notified in writing at the same time (rule 105(3)).
- Particulars of the receipt and service are entered into the computer system.

Form T7 can be accepted and be deemed to be filed within time despite an irregularity in the form or the accompanying documents, other than a failure to file within the specified time. However see the provisions of rule 95(2). In such a case, the irregularity should be brought to the attention of the filer with a suggestion that leave be sought to file and serve an amended counter-statement.

Additional information

To avoid unnecessary applications being made for security for costs, it is good practice for parties to proceedings to state their place of residence or place of incorporation in their pleadings. (See chapter on Security for costs)

Evidence

Upon receipt of evidence it will be checked to ensure that:

- It has been filed within the relevant time frame or any extension period granted. If filed after 6 months from the date of his receipt of the counter-statement/earlier round of evidence it may be necessary to ascertain, subject to the discretion to extend time, the actual date of receipt of the counter-statement/earlier round of evidence.
- The exception is evidence filed pursuant to rules 38(1)(b) or 42(1)(b).
- The proceedings and the parties are correctly identified.
- It is made in the first person. If it is made on behalf of a partnership, body corporate or unincorporated body or association of persons within the meaning of rule 118, the capacity in which the declaration (or affidavit) is made must be stated (rule 80(2)).
- All the exhibits referred to in the statutory declaration or affidavit have been filed and are properly identified and dated. Any discrepancy will be taken up with the filer as soon as practicable.
- The proceedings relate to only one opposition matter (unless there has been a previous order consolidating proceedings).
- It has been properly signed and properly attested in accordance with rule 80.
- Particulars of the receipt and service of the evidence is entered into the computer system.

If irregularities are found, these will be raised with the filer as soon as practicable and the filer offered the opportunity to put matters in order (rule 92). The other party must be kept informed and he may challenge the Registrar's discretion in allowing any amendments to be made by making written submissions and/or requesting an interlocutory hearing (rule 74).

Where the evidence is evidence in reply, in addition to the above, the evidence will be checked to ensure that :

- It is strictly in reply to the applicant's evidence. If new matters are raised, this fact should be brought to the attention of the Hearing Officer by a minute.

If the applicant claims that the evidence in reply does not restrict itself to answering the points in his evidence, it cannot be admitted until the matter has been resolved. The applicant should be asked to identify what parts of the evidence go beyond being in reply, and the opponent is to be given an opportunity to respond. Unless the objection is withdrawn or the matter is otherwise resolved, the matter will require an interlocutory hearing. Remedies available at such a hearing would be :

- If the objection is upheld, then the objectionable parts shall be excised.
- If the objection is found to be unfounded, the evidence shall remain as filed.

The matter should not be left until the substantive hearing to avoid adjournments and uncertainty as to the evidence.

The status of the case is changed to "HEARING" in the computer system.

* * *