

Appeals against decisions of the Registrar

What may be appealed against

Any decision or order of the Registrar made under the Trade Marks Ordinance (Cap. 559) is subject to appeal to the 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 O100 r2 and O55 of the Rules of the High Court. They should be instituted by originating motion (O55 r3(1)). O55 r1(4) provides that the rules of O55 shall, in relation to an appeal to which it applies, have effect subject to any provision made in relation to that appeal by any other provision of these rules or by or under any enactment, in this case, O100.

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 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 (O55 r4(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).

The Court’s powers

The Court’s powers under O55 and section 85 of the Ordinance are much wider than in relation to a judicial review (O53). 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, O55 r3(1) provides that an appeal shall be by way of a rehearing; O55 r7(2) provides for the reception of further evidence and for directions as to how it should be received; and O55 r7(5) for any order to be made by the Court which should have been made by the Registrar.

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 (O55 r4(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 O55 r3(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.

Registry procedure

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

When a copy of the notice of motion is received, the responsible clerical officer should immediately:

- input data, for example the court proceedings number and the trade mark

number, in the computer maintenance screen;

- print the register image and up to date registration details; and
- retrieve all relevant trade mark and proceedings files for the responsible examiner.

The notice of motion should be checked for the following details :

- the names of the parties involved;
- the date on which the matter is to be heard by the Court; and
- the firm(s) of solicitors representing the party or parties.

A new Court case sub-file, is to be opened i.e. prepare a file cover, mark enclosures, check the particulars of the registration involved, etc.

On being served with the notice of motion, the Registrar will as a matter of practice provide the Court with the Registry's pleadings and evidence filed. The files, should be in the same manner and format as for the preparation of cases for the original hearing in the Registry. The files should then be hand delivered to the Court in good time before the hearing.

Minutes should be prepared for the hearing officer's attention highlighting any hearing date fixed. His views must also be sought on whether the Registrar should appear before the Court.

The Registrar normally does not take part in the appeal unless there are special allegations in the case, such as administrative error on the part of the Registry, perpetration of fraud, etc. If so, 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 proforma letters are prepared, for consideration and signature, and sent to the legal representatives of each of the parties to the appeal, seeking their undertakings, inter alia, that they will not agree to any relief not asked for in the notice of motion without first giving the Registrar an opportunity to consider the matter; and that they will keep the Registrar informed of the status of the proceedings. On receipt of the required undertakings, a letter to inform the Court of the receipt of the undertakings is prepared, for consideration and signature.

The progress and status of the appeal should be checked on at least a half yearly basis, and the hearing officer informed of developments.

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.

Appeal from Registrar's decision in an ex parte matter

Where an applicant appeals against the refusal of the Registrar 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.

Where evidence of use has been submitted, the document should be numbered in sequence and indexed to allow easy identification of statutory declarations and exhibits. The front cover of each folder should be annotated with the subject matter in the file and a list of the content.

For other details relating to appeal procedure and registry procedure, see *Appeal from the Registrar's decision in an inter partes matter* above.

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.

New evidence on appeal

On appeal before the Court, new evidence may be admitted with the leave of the Court. The Court will decide whether such evidence should be admitted based on established principles and case law (see *Hunt-Wesson Inc.'s Trade Mark Application* (1996) RPC 233 and *TM applications by Club Europe Holidays Ltd* (2000) RPC 329).

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 O59 r4) has expired, and a certified 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. If no further appeal is lodged within the appeal period, the file should be updated with the date of the decision and the date of dismissal of the appeal. The file is then sent back to the examiner-in-charge for the record.

If a further appeal is lodged, the Department of Justice will notify the Hearings Team. A copy of the proceedings file is sent to the Court when the date of the further appeal is known.

Appeal allowed

If an 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.

Further appeal

If a further appeal is to be made, the Hearings Team should seek endorsement from the Department of Justice.

Appeals to the Court of Appeal are governed by O59.

No further appeal

If the appeal is allowed, and the Registrar's decision reversed, the decision can be actioned if the Registrar decides not to further appeal. The file should record the date of the decision.

In respect of a registrability matter, the file is then sent back to the examiner-in-charge. This will mean that the application will proceed to registration, but the examiner should note any conditions or amendments subject to which the Court may have allowed the appeal.

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