

## Assignments of registered trade marks and applications

### What is an assignment?

A registered trade mark, or an application for registration of a trade mark, can be transferred from one person to another (see sections 27(2) and 31(1)). “An assignment” can be the document that gives legal effect to the transfer. An assignment of a registered trade mark, or of an application for registration of a trade mark, must be in writing and signed by the assignor (sections 27(4) and 31(1)).

An assignment may be limited, for example to some but not all of the goods or services of the registration or application (sections 27(3) and 31(1)). A partial assignment of an application effectively operates as a division of the application.

The sale of a registered trade mark or an application for registration of a trade mark by personal representatives, in the administration of a deceased person’s estate, is made by assignment. The assignment must be in writing and signed by the personal representatives (sections 27(4) and 31(1)). By contrast, the transfer of a registered trade mark or an application for registration of a trade mark by personal representatives to a person (or other entity) entitled under the deceased person’s will or intestacy is made by assent (see chapter on Assents by personal representatives).

A registered trade mark, or an application for registration of a trade mark, is also assigned as the result of a corporate merger. The applicable law may provide that the transfer of the merging company’s assets, including any trade marks, to the new corporate entity is effective on registration of the merger by the appropriate companies’ registering authority in the company’s country or state of incorporation. The assignment is usually evidenced by a certificate of merger or a certified extract from the companies’ or commercial register, as

appropriate in such cases.

## **Application of the new law**

An assignment of a registered trade mark or an application for registration of a trade mark is a registrable transaction (sections 29(2)(a) and 31). Until particulars of an assignment are filed for registration, the assignment is ineffective as against a person acquiring a conflicting interest without knowledge of it (sections 29(3)(a) and 31(3)).

Unless particulars of the assignment are filed before the end of the period of 6 months beginning on the date of the assignment, the assignee will not be entitled to damages or an account of profits for infringements for the period before particulars of the assignment are registered (sections 29(4)(a) and 31(3)).

It is no longer necessary to produce the assignment when applying to register particulars (of an assignment of a registered mark) or when giving notice to register particulars (of an assignment of an application for registration) if the application, or notice, is signed by or on behalf of the assignor (rule 62(2)). If the application, or notice, is not signed by or on behalf of the assignor, a copy of the assignment has to be filed and will be open to public inspection (rule 69(1)(r)). Where a copy of the assignment is not filed, other documentary evidence will be accepted if it is sufficient to establish the assignment (rule 62(2)).

The transmission of a registered trade mark or an application for registration of a trade mark is dealt with in the same way as an assignment. Documentary evidence has to be submitted if the application, or notice, is not signed by or on behalf of the transferor.

## Examining applications/notices to register particulars

Factors to be considered in examining applications to register particulars or notices to register particulars of assignments are listed below :

- Is the application to register particulars (relating to registered mark(s)) or notice to register particulars (relating to application(s) for registration) made on the specified form, Form T10 (rule 62(1))?
- Was the specified fee (Fee No. 19) paid on filing? An application/notice to register particulars of one registrable transaction can relate to more than one registered mark or application for registration.
- Is the application made by, and signed by or on behalf of, the assignor (section 29(1)(b)) or the assignee (section 29(1)(a))? If the application is signed by or on behalf of the assignor it does not need to be accompanied by documentary evidence of the transaction (rule 62(2)). If the application is not signed by or on behalf of the assignor, it must be accompanied by documentary evidence of the transaction, for example, a copy of the assignment (rule 62(2)). This document will be open to public inspection (rule 69(1)(r)). (See *Co-ownerships* below.)
- Does the application/notice state :
  - the assignee's name and address (rule 63(1)(a)(i) and (b)(i));
  - the date of the assignment (rule 63(1)(a)(ii) and (b)(ii)); and
  - in an assignment of any right, the right assigned (sections 27(3) and 29(2)(a); rule 63(1)(b)(iii)).
- In the case of assignment of certification marks, has the requirement for the

Registrar's consent been complied with? (section 12 of Schedule 4)

(See *Assignments* and *Certification marks* in the chapter on Certification and collective marks.)

## Registering particulars of an assignment

The following matters are entered in the register :

- the assignee's name and address (rule 63(1)(a)(i) and 63(1)(b)(i));
- the date of the assignment (rule 63(1)(a)(ii) and (b)(ii));
- in an assignment of any right, description of the right assigned (rule 63(1)(b)(iii));
- the date on which the entry in the register is made (rule 63(2)); and
- the date of application of registration of particulars or giving of notice (sections 29(3)(a), 29(4)(a) and 31).

## Co-ownerships

One co-owner cannot assign without the consent of each other co-owner (section 28(4)(b) and section 31(1)). An agent authorised to act for the co-owners can sign an application to register particulars of an assignment on their behalf.

## **Sole proprietorships and partnerships**

Applicants should ensure that the entity named as the applicant or the owner of a trade mark has the capacity of owning property and is recorded in an appropriate manner to safeguard the rights in the registration. The Registrar is not able to advise on the legal status of applicants.

In the case of a firm owned by one or more persons, the application or registration may be made in the name(s) of the sole proprietor/the partners or the name of the firm depending on the relevant law of the place where the firm is established.

In the case of a sole proprietorship established in Hong Kong, an application is usually filed and registered in the name of the sole proprietor trading in the name of the firm (e.g. Chan Siu-ling trading as Chan & Co.).

In the case of a partnership established in Hong Kong, it is common for an application or registration to list the names of the partners (or at least two of them) followed by the name of the firm (e.g. Chan Siu-ling and Lam Mei-mei trading as Chan & Lam).

An agent authorised to act for the firm can sign an application to register particulars of assignment on its behalf.

## **Unincorporated associations**

An unincorporated association is not a legal person. It does not have a corporate or separate legal existence from its members. Because an unincorporated association is not a legal person, it has no capacity to hold property (including a trade mark registration or application) in its name.

To resolve this difficulty, a trade mark registration or application can be held, subject to what is stated in the constitution of the unincorporated association by :

- named trustees; or
- named members.

An agent authorised to act for the trustees or members of an unincorporated association can sign an application or a notice to register particulars of an assignment on their behalf.

## **Trusts**

Particulars of an assignment can be registered in the personal name of a trustee but no notice of any trust shall be entered in the register (section 30).

## **Transitional provisions**

The new law applies to applications to register particulars of assignments (relating to a registered mark or marks) filed on or after the commencement date (sections 97; sections 8(1) and 8(6) of Schedule 5).

Applications filed before the commencement date under the old law, to register a subsequent proprietor as the result of an assignment or a transmission, that are pending on the commencement date, are treated as applications to register particulars under the new law (section 97; section 8(4) of Schedule 5). We may require the applicant to amend his application to register a subsequent proprietor to conform with the requirements of the new law (section 97; section 8(5) of Schedule 5).

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Previous Version