

Claim to priority

Application of the new law

International convention and agreement require Hong Kong to recognise an applicant's right of priority (Article 4, Paris Convention and Article 2, TRIPS Agreement).

Hong Kong's obligation is given effect in section 41 of the Trade Marks Ordinance. An applicant who has filed an application to register a trade mark in a Paris Convention country or a WTO member country, territory or area can enjoy a right of priority for 6 months for the purpose of registering the same mark for any or all of the same goods or services in Hong Kong (section 41(1)).

If an applicant files an application for registration in Hong Kong during the six-month period, he can claim the date on which he filed the Convention application or WTO application as his priority date. The priority date is the date for establishing which rights take precedence (section 41(2)(a)) and a third party cannot acquire rights in the mark by use between the priority date and the date of application in Hong Kong (section 41(2)(b)). Rights acquired before the priority date are not affected.

Unlike the position under the old law, the priority date no longer determines the date of registration of a trade mark. A trade mark applied for under the new Ordinance is registered as of the filing date of the application for registration. Registration under the new Ordinance does not date back to the date of the Convention application or WTO application (sections 39 and 48).

The right of priority derives from the first Convention application or WTO application and the six-month period is from the date of filing of the first application (section 41(1), (2), (5), and (6)).

Exercising priority right

An applicant must make his claim to priority in his application for registration (rule 9(1)). It is not possible to amend an application for registration after the filing of the application to include a priority claim (section 46; rule 23).

An applicant will not usually be required to file a priority certificate (rule 9(3)) unless he faces a potential citation of an earlier trade mark (see chapter on Relative grounds for refusal).

If an applicant claims priority, we will potentially cite his mark against an earlier filed competing application that does not have priority, or that has a later priority date. However, if particulars of the earlier filed competing application have already been published, the later applicant claiming priority will need to exercise his priority right by opposing the earlier filed application (section 42(5)).

If an applicant claims priority over an earlier filed mark that has already been registered, subject to priority documents being found to be in order, the registered mark will not be cited against his application (see definition of “earlier trade mark” in section 5(1)(a)).

Examining priority claims in applications

Factors to be considered in examining claims to priority in applications for the registration of trade marks are listed below :

- Was the application for registration filed in Hong Kong within 6 months of the filing date of the Convention application or WTO application (section 41(1))?
- Does the application include:
 - the name of the country, territory or area for which a right to priority is

claimed;

- the date of filing of the Convention application or WTO application; and
- the application number assigned to that application? (rule 9(1)) If an applicant does not include the priority application number in his application we will give him notice to do so : see *Notice to file a priority application number*, below.

There can be more than one priority date claimed in a multiclass application where priority is claimed on the basis of more than one Convention or WTO application covering different goods and services.

Similarly, there can be more than one priority date claimed in a series application from separate applications for marks in the series.

- Is the claim to priority based on an application in a Convention country or WTO member listed in Schedule 1 to the Ordinance? Is the claim to priority based on an application equivalent to a regular national filing in a Convention country or WTO member, for example a Community Trade Mark application (section 41(3))?

Notice to file a priority application number

If an applicant does not include the priority application number in his application for registration, we will give him notice in writing to file it (rule 9(2)). An applicant must file the application number within 3 months after the date of the notice (rule 9(4)). If he does not file the application number within 3 months, the right to priority is lost (rule 9(4)).

Notice to file a priority certificate

If an applicant faces a potential citation of an earlier trade mark, we will give him notice in writing to file a certificate by the registering, or other competent authority certifying or establishing, the particulars of the Convention application or WTO application (rule 9(3)). This notice can be given at the time when a notice of the Registrar's opinion is issued under rule 13(1), or when the potential conflict is known.

An applicant must file the priority certificate within 3 months after the date of the notice (rule 9(3)). If the certificate is not in Chinese or English, the applicant must also file a translation of it (rule 120). If he does not file the certificate within 3 months the right to priority is lost (rule 9(4)).

Examining a priority certificate

Factors to be considered when examining priority documents in applications for registration of trade marks are listed below :

- Does the certificate issued by the registering or other competent authority certify or establish :
 - the name of the registering authority;
 - the filing date of the application;
 - the application number;
 - the representation of the mark; and
 - the goods or services covered by the application (rule 9(2))?

- If the certificate is not in Chinese or English, has the applicant filed a translation of it (rule 120)?

- Is the application for registration made by the applicant of the Convention application or WTO application, or a successor in title (section 41(8))? The right to claim priority can be transferred independently of the Convention application or WTO application (section 41(8)). An applicant needs to file an assignment of the right to priority, or a certified copy of the assignment, only where he exerts his claim to priority over a competing application or registration.

- Is the application for registration for the same trade mark as the Convention application or WTO application (section 41(1))?

If the mark in the Convention/WTO application is in colour but the application in Hong Kong is for the mark in black and white, the priority claim cannot be accepted. The same applies in the reverse situation if the application in Hong Kong includes a colour claim.

- Is the application for registration for the same goods or services as the Convention application or WTO application (section 41(1))?

If some of the goods/services covered by the Hong Kong application are not covered by the Convention/WTO application, the applicant will have to cut out the additional goods/services. Alternatively the applicant will have to divide the application, and he will be able to claim priority only for the divisional application where the goods/services are fully covered by the Convention/WTO application.

Registration

The date of priority claimed is entered in the register on registration of the trade mark (rule 29(1)(c)).

Transitional provisions

- An application for registration filed under the old Ordinance and which is converted under the new Ordinance is treated as if made on the commencement date of the new Ordinance (section 11(3) of Schedule 5).
- A converted application retains its priority date, if it claims priority from a Convention application or WTO application made no more than 6 months before the commencement date of the new Ordinance.
- But conversion will result in a loss of priority for applications which claim priority from a Convention application or WTO application made more than 6 months before the commencement date (section 11(3) and 13 of Schedule 5).

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