

Defensive trade marks

Defensive trade marks have been retained under the Cap. 559. It was also possible under Cap. 43 (see sections 55 to 57) to register defensive trade marks.

Section 60 of the Ordinance sets out the conditions for registration of a defensive trade mark. Where:

- the applicant has registered the same mark as a trade mark for certain goods or services;
- that mark has been used so much in relation to all or any of the goods or services for which it is registered that it has become exceptionally well-known in Hong Kong; and
- use of the registered mark by someone other than the trade mark owner on other goods or services would be likely to detract from its distinctive character in relation to the goods or services for which it has been so used;

then the mark may be registered as a defensive trade mark in respect of any or all of those other goods or services, even if there is no intention to use the mark for those goods or services.

There has been a relaxation in the kinds of marks that can be registered as defensive trade marks. Under section 55 of Cap. 43, only invented words or devices, or a combination of them, could be registered as defensive trade marks. This limitation no longer exists under the Ordinance.

What is meant by “exceptionally well known in Hong Kong” has to be determined on a case by case basis. Very substantial evidence of use is usually required to establish that

a mark is “exceptionally well known in Hong Kong”. Each of the three conditions above would have to be established.

As an illustration, the following marks have been registered as defensive trade marks:

- “Shell device” in Classes 6, 8, 10, 12, 13, 14, 15, 18, 21, 22, 23, 24, 26, 27, 29, 31, 32, 33 and 34



- “SONY” in Classes 2, 3, 4, 5, 6, 7, 8, 10, 11, 12, 13, 15, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29 and 30

SONY

The Ordinance contains a list of factors for determining what is a well-known trade mark (Schedule 2). The test in section 60 of the Ordinance for a defensive trade mark is a higher test in that the mark must be “**exceptionally** well known in Hong Kong” before it can be registered as a defensive trade mark.

Applicants wishing to register a defensive trade mark will need to submit evidence by way of statutory declaration or affidavit in order to establish the claim that a mark has become exceptionally well known in Hong Kong.

Application requirements

The application requirements referred to in rule 99 and Part 2 of the Trade Marks Rules (as applicable) are set out below:

- An application for the registration of a defensive trade mark must be filed on the specified form (Forms T2 and T2A). The applicant must indicate in the application form that the application is for registration of a defensive trade mark.
- The applicant must file the following within 9 months after the date of application:
 - (a) a statement of case setting forth full particulars of the facts on which the applicant relies in support of his application, verified by a statutory declaration or an affidavit made by the applicant or some other person approved for the purpose by the Registrar; and
 - (b) such evidence, if any, as the applicant may desire to adduce in support of the application.
- If no statutory declaration or affidavit is filed within the time specified, the Registrar will treat the application as abandoned.
- The applicant may, within such time as the Registrar may allow, whether after a request made by the Registrar or otherwise, file such other evidence as he may desire to adduce in support of the application.

Examination of a defensive trade mark

An application for registration of a defensive trade mark goes through the same examination process as an application for an ordinary trade mark (see chapter on

Examination of applications). However, the Registrar will only issue an opinion under rule 13 after the statutory declaration or affidavit has been filed by the applicant.

If the evidence submitted by the applicant is not sufficient, we may, even before an opinion under rule 13(1) is issued, request the applicant to file further evidence pursuant to rule 99(4). We may specify a period of time during which the applicant may file such evidence, which period is extendible under rule 94(1)(b).

Under section 60(5) of the Ordinance, an applicant for a defensive trade mark must have a prior registration of the same mark in Hong Kong. The defensive trade mark application will be refused unless there is such a prior registration.

A trade mark that is registered as a defensive trade mark in respect of particular goods or services may be subsequently registered (otherwise than as a defensive trade mark) in the name of the owner of the registered trade mark in respect of the same goods or services.

A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if it is already registered (otherwise than as a defensive trade mark) in the name of the applicant in respect of those goods or services.

Opposition to registration

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

Revocation of a defensive trade mark

Section 60(6) of the Ordinance stipulates the only grounds for which a registered

defensive trade mark may be revoked.

Since a registered defensive trade mark does not have to be used by the owner, section 38(3), section 52(2)(a), (b) and (c), and any other provisions of the Ordinance which may be inconsistent with section 60 do not apply to defensive trade marks.

* * *

Previous Version