

## Opposition to registration

### Who may oppose

Section 44 of the Trade Marks Ordinance provides that “any” person may give notice to the Registrar of opposition to the registration of a trade mark. The only qualification to this broad statement is that the notice must be given in writing within the prescribed period, in the prescribed manner, and shall contain a statement of the grounds of opposition. The opponent must also file an address for service in Hong Kong in accordance with rule 105(1)(b).

The “prescribed period” is within the three-month period beginning on the date on which particulars of the application for registration are published in the Hong Kong Intellectual Property Journal (rule 16(1)). See Chapter on Computation of time for filing at the Registry for illustrations of computation of the deadline for filing a notice of opposition with the Registry. This period is extendible once only by 2 months, provided the request is filed on the specified form T13 within the aforesaid “prescribed period” (rule 16(4)). See Chapter on Applications for extension of time – Deadline for lodging of pleadings.

The “prescribed manner” requires that :

- the notice of opposition is filed on Form T6;
- it is accompanied by the appropriate fee (currently \$800); and
- when the opposition is based on an earlier mark, the provisions of rule 16(2)(a) – (d) have to be observed.

## Outline of procedure

The main steps to be taken by opponents and applicants (if the latter intend to contest the opposition) are set out in rules 16 to 21. These are broadly :

- Rule 16 (1) The opponent gives notice of opposition by filing Form T6 with a  
(2) statement of the grounds of opposition and the prescribed fee. This must be received at the Registry within the prescribed period unless time is extended.
- Rule 16 (3) The opponent, at the same time as he files the notice of opposition, shall send a copy of it to the applicant.
- Rule 17 (1) The applicant may file a counter-statement on Form T7, which, unless time is extended, must be received at the Registry within 3  
(3) months after the date on which he receives the copy of the notice of opposition. There is no fee payable on filing a counter-statement. This time period is extendible once only by 2 months provided the request is filed on the specified form T13 within the aforesaid three-month period. If the applicant does not file a  
(4) counter-statement within the time allowed, his application for registration shall be treated as withdrawn.
- Rule 17 (2) The applicant shall, at the same time as he files the counter-statement, send a copy of it to the opponent.
- Rule 86 (1) The Registrar may direct the parties, at their own cost, to attend a  
(2) case management conference to focus the issues before evidence is filed. At least 14 days notice of the time, date and place of the case management conference will be given.

Rule 18 (1) The opponent may file evidence by way of statutory declaration or an affidavit in support of his opposition (rule 79(1)). This must be received at the Registry within 6 months (or any agreed extended date) after the date on which he receives the copy of the counter-statement. The opponent must, at the same time as he files evidence, also send a copy of that evidence to the applicant. If the opponent does not file evidence within the specified period, he shall be deemed to have abandoned his opposition.

Rule 19 (1) The applicant may file evidence (by way of statutory declaration or an affidavit) in support of his application, or a statement to the effect that he does not intend to file evidence. This must be received at the Registry within 6 months (or any agreed extended time) after the date on which he receives a copy of the opponent's evidence. The applicant must, at the same time as he files his evidence or statement, send a copy of it to the opponent.

Rule 20 (1) If, and only if, the applicant files evidence, the opponent may file (by way of statutory declaration or an affidavit) evidence, which must be strictly in reply to that filed by the applicant under rule 19(1). Such evidence must be received at the Registry within 6 months (or any agreed extended period) after the date on which he receives a copy of the applicant's evidence. The opponent must, at the same time as he files such evidence, send a copy of it to the applicant.

Rule 20 (3)  
Rule 82 Either party may apply at any time for leave of the Registrar to file further evidence. If leave is granted it is normal for the other side to be allowed to file further evidence strictly in reply. The opponent has the right to be the last to file evidence.

Rule 86 (1) The Registrar may, if the evidence does not support the pleadings or some of them, direct the parties to attend a case management conference. The Registrar may order costs in accordance with Section 87

section 87. At least 14 days notice of the date time and place of the case management conference will be given.

- Rule 21  
Rule 74 (4)
- After the evidence rounds have been completed, the Registrar shall, on his own initiative fix a time, date and place for the hearing and shall notify each party to the proceedings of these particulars.

### **Procedure common to all applications resulting in a hearing**

- Rule 74 (5)
- Any party who intends to appear at the hearing shall, within 14 days after the date of the notice referred to in rule 74(4), file notice of his intention on Form T12 together with the specified fee (currently \$1,700). Any party failing to do so may be treated as not intending to appear at the hearing.

- Rule 87 (1)
- Following the filing by the parties of their notices of intention to appear, the Registrar may direct that the parties attend a pre-hearing review at which the Registrar may give such directions as to the conduct of the hearing as he may think fit. The parties shall be given a minimum of 7 days' notice of the date of the review.
- (2)

- Rule 76
- Any party who has complied with rule 74(5) can attend the formal hearing in person and/or be represented there. The Registrar will generally permit representation by counsel, an agent currently on the record for that matter, a duly authorised officer where the party is a company, or a partner where the party is a partnership. The hearing is open to the public (rule 77).

- Rule 91 (1)
- (2)
- After the Registrar has reached his decision, he will send a notice to each party informing them of his decision. Where a statement of the

- reasons for the decision is not included, any party may, upon the filing of Form T12 and payment of the specified fee (currently \$1,500), request the Registrar to send him a statement of the reasons for the decision. This request must be received at the Registry within one month after the date of the notice. That party must, at the same time as the request form is filed, also send a copy to all other parties to the proceedings. The appeal period shall run from the date when the notice of decision is sent, or, where a statement of the reasons for the decision is sought, the date on which the statement of reasons is sent out.
- (3)
- (4)

Section 87 (1) An award of costs will generally be made in favour of the successful party.

Section 84 Either party can appeal to the Court of First Instance against the decision, which may in turn be appealed to the Court of Appeal, and, subject to the leave of the Court of Final Appeal, be further appealed. The time limit for lodging an appeal is specified in the Rules of the High Court.

The periods for filing evidence specified above are subject to rule 94(3) which provides:

- (3) Where —
- (a) the period within which any party to any proceedings before the Registrar may file evidence under these Rules is to begin on the expiry of any period during which any other party may file evidence; and
- (b) the other party notifies the Registrar that he does not intend to file any evidence or any further evidence,

the Registrar may direct that the period within which the party, mentioned in paragraph

(a) may file evidence shall begin on the date as specified in the direction, and if he issues such a direction, he shall notify all parties to the proceedings of the relevant date.

## **Transitional procedure**

Rule 121 provides that where the advertisement of an application filed under the old law occurs on or after the commencement date, the period within which a notice of opposition may be filed is the three-month period beginning on the date of the advertisement. The time is extendible once only by 2 months provided a request is filed on the specified form T13 within the aforesaid period of 3 months (rule 121(2)). The counter-statement may be filed within 3 months after the date of receipt by the applicant of a copy of the notice of opposition. The time is extendible once only by 2 months provided a request is filed on the specified form T13 within the aforesaid period of three months (rule 121(3)). See Chapter on Applications for extension of time – Deadline for lodging of pleadings.

## **More than one opponent shown on Form T6**

Each opponent to a trade mark application must file a separate Form T6 and each opponent must pay the specified fee and observe the time limits. If there is more than one opponent, who intend to “jointly” oppose the application, Form T6 should state this fact. In such situations, the grounds of opposition must be common to all opponents and there can only be one address for service.

## **Pleadings**

It is the function of pleadings to define the issues between the parties. They also form the basis to which evidence will be directed. Interest of justice, fairness, efficiency and economy combined to make it necessary for pleadings to provide a focused statement of the case of the party. Failure by a party to comply with the requirements in Cap. 559A relating to the contents of pleadings may be a factor to be taken into account by the Registrar when considering an award of costs.

## Content of the statement of grounds of opposition

Subject to rule 16(2), there is no prescribed form that the statement of grounds must take. It can be in the form of a declaration, notice or letter.

It should set out the primary facts upon which the opposition is based, and if based upon an earlier mark, must comply with rule 16(2)(a) – (d). The following particulars are required under rule 16(2):

- a representation of that earlier trade mark (rule 16(2)(a)).
- if it is registered, a statement of the goods or services in respect of which it is registered (rule 16(2)(b)).
- if it is not registered, a statement of the goods or services in respect of which it is used (rule 16(2)(c)).
- a statement indicating the registration or application number(s) of the earlier trade mark(s) where there are registration(s) or pending applications in Hong Kong (rule 16(2)(d)).

“Registered” in rules 16(2)(b) and (c) means registered in Hong Kong.

If the earlier trade mark is registered in Hong Kong (or an application for registration has been made), the opponent is required to provide the details required by rule 16(2)(b) and (d).

If the earlier trade mark is not registered in Hong Kong, the opponent is required to comply with rule 16(2)(c).

Since pleadings should be filed in the language of proceedings, particulars of earlier trade marks included in notices of opposition must be filed in the language of proceedings.

In addition, the statement of grounds must identify precisely the section and subsection upon which each objection is taken. Ultimately it will be necessary to test each objection separately by measuring the evidence offered against the requirements of the Ordinance. “Rolled-up” objections are therefore defective pleadings. See the comments of the Appointed Person in *CORGI Trade Mark* [1999] RPC 549.

If opposition is taken only in respect of some of the goods in the specification, this should be stated and in the absence of such a statement, may have costs implications. See *Naturelle Trade Mark* [1999] RPC 326 at 332. Form T6 provides for the election.

The statement of grounds is not evidence and therefore should not stray into the area of evidence. Evidence such as foreign trade mark registration certificates, magazines, newspaper, photographs, promotional materials, invoices and other commercial agreements should be filed by way of statutory declaration or affidavit at the evidence stage. Any evidence attached to the pleadings would not be uploaded to IPD website for online inspection.

### **Service of Form T6 and the statement of grounds**

Rule 16(3) is a departure from the old procedure. The opponent is now required, at the same time as he files the notice of opposition, to send a copy of it to the applicant. Also see chapters on Service of pleadings and evidence and Computation of time for service of documents.



## Examining the notice of opposition

See chapter on Processing of pleadings and evidence.

## Requests to amend the notice of opposition

See chapter on Amendment of pleadings.

## Options available to the applicant for registration

Upon receipt of a copy of the notice of opposition, the applicant for registration may either :

- withdraw his application (section 45; rule 22);
- divide the application where the opposition is made only in respect of some of the goods or services – see chapter on Division of applications; or
- file a counter-statement.

## Filing of a counter-statement

If the applicant for registration wishes to defend his application, he must file Form T7 with a counter-statement. There is no fee for filing Form T7 and the counter-statement. The documents must be received at the Registry within 3 months after the applicant for registration receives a copy of the notice of opposition from the opponent (rule 17(1)). This period may be extended once only by 2 months provided the request is made on the specified form within the three-month period allowed for filing the counter-statement. See Chapter on Applications for extension of time – Deadline for lodging of pleadings.

If the documents are received at the Registry after the period allowed as above has expired, they cannot be accepted.

Also see chapter on Computation of time for filing at the Registry.

If Form T7 and the counter-statement are not received at the Registry before the expiration of the period allowed, the application for registration will be treated as withdrawn (rule 17(4)).

### **Content of the counter-statement**

There is no prescribed form that the statement of grounds of the counter-statement must take. It can be in the form of a declaration, notice or letter.

The counter-statement must however set out:

- the grounds on which the applicant for registration relies in support of his application;
- the facts, if any, alleged in the notice of opposition which he admits;
- the facts alleged in the notice of opposition that he denies and his reasons for the denial. If he intends to put forward an alternative version of events, he must set out his version of those events; and
- the facts alleged in the notice of opposition that he is unable to admit or deny.

Subject to what is said above, the counter-statement is not evidence and it should not stray into the area of evidence. Evidence such as foreign trade mark registration certificates, magazines, newspaper, photographs, promotional materials, invoices and other commercial agreements should be filed by way of statutory declaration or affidavit at the evidence stage. Any evidence attached to the pleadings would not be uploaded to IPD website for online inspection.

## **Service of Form T7 and the counter-statement**

Rule 17(2) is a departure from the old procedure. The applicant is now required, at the same time as he files the counter-statement, to send a copy of it to the opponent. See also chapters on Service of pleadings and evidence and Computation of time for service of documents.

## **Request to amend counter-statement**

See chapter on Amendment of pleadings.

## **Filing of evidence**

Where evidence is to be provided to the Registrar, it must be in the form of a statutory declaration or affidavit (rule 79(1)). The Registrar also has the power to allow oral evidence to be given in addition and for a deponent to be cross-examined on his statutory declaration or affidavit. Guidance on the formalities of evidence is given in the chapter on Evidence.

## **Opponent's evidence-in-chief**

The opponent may file evidence in support of his opposition. The complete evidence-in-chief must be received at the Registry within 6 months after the date on

which he receives a copy of the counter-statement (rule 18(1)). This period can be extended at the Registrar's discretion (rule 94). For the procedure for extending time, see chapter on Applications for extension of time.

The opponent must, at the same time as he files the evidence, send a copy of it to the applicant (rule 18(2)).

### **Procedure when evidence is not filed**

If the opponent does not file evidence by the due date and no extension of time is requested, the opponent is deemed to have abandoned his opposition (rule 18(3)).

### **Service of evidence**

See chapters on Service of pleadings and evidence and Computation of time for service of documents.

### **Applicant's evidence**

The applicant may file evidence by way of statutory declaration or affidavit in support of the application to register. If the applicant does not intend to file evidence, he must file a statement to this effect (rule 19(1)(b)). If the applicant wishes to file evidence, it must be received at the Registry within 6 months after the date he received the opponent's evidence-in-chief. This period can be extended at the Registrar's discretion (rule 94). For the procedure to extend the time period see chapter on Applications for extension of time. He must, at the same time as he files his evidence, or statement to the effect that he does not intend to file evidence, send a copy of it to the opponent (rule 19(2)).

## **Procedure where evidence is filed by the applicant**

See chapter on Processing of pleadings and evidence.

## **Procedure where the applicant does not file evidence**

If the applicant has filed a statement that he does not wish to file evidence or has not filed evidence in the time allowed (or any agreed extended period) the opposition is regarded as ready for the fixing of a date, time and place for the hearing under rule 21.

The Registrar shall inform the opponent that no evidence has been filed by the applicant.

The computer system is updated to the “HEARING” status.

## **Opponent’s evidence in reply**

If the applicant files evidence, the opponent has the right to file further evidence by way of statutory declaration or affidavit. Such further evidence is confined to matters strictly in reply to the applicant’s evidence. The further evidence must be received at the Registry within 6 months after the applicant has served his evidence upon the opponent (rule 20(1)). The period can be extended at the Registrar’s discretion (rule 94). For the procedure for extending time, see chapter on Applications for extension of time.

The opponent is required, at the same time as he files his evidence in reply, to send a copy of it to the applicant (rule 20(2)).

## **Procedure when evidence in reply is filed**

See chapter on Processing of pleadings and evidence.

## **Further evidence**

The filing of the opponent's evidence-in-reply will usually complete the evidence rounds. Also see chapter on Procedure where leave is sought to file further evidence.

## **Fixing hearing**

The procedures for the fixing of a hearing can be found in the chapter on Hearings.

\* \* \*