Revocation of registration (including defensive, collective and certification marks) on grounds other than non-use

Revocation is a request to have a registered trade mark removed from the register either in whole or in part. The grounds for removal other than for non-use are to be found in section 52(2)(b), (c) and (d). The grounds for revocation of a trade mark as a defensive mark are to be found in section 60(6). The additional grounds for revocation of the registration of a collective mark are to be found in section 13 of Schedule 3 to the Trade Marks Ordinance. The additional grounds for revocation of a certification mark can be found in section 15 of Schedule 4 to the Ordinance.

Grounds affecting only some of the goods or services

The grounds for revocation of a trade mark or defensive mark may apply to only some classes or to only some of the goods or services covered by the registration. In the case where some classes are not affected Form T6 should reflect this. If such an application is successful, the decision will order the registration to be revoked only in respect of the goods or services where the grounds are made out (section 52(6) (revocation), section 60(6) (defensive mark)).

Effective date of revocation

Section 52(7) provides that where the registration of a trade mark is revoked to any extent, the rights of the owner shall be deemed to have ceased to that extent as from either the date of the application for revocation, or if the grounds for revocation existed

at an earlier date, that earlier date. The applicant should specify on Form T6 the date from which the revocation is to take effect.

Since the rights of the owner of a revoked trade mark only cease to have effect as from the date of revocation, it is vital for an applicant seeking to overcome a citation of an earlier trade mark to make a request in its application for revocation of the earlier trade mark that the revocation is to take effect from a date on or before the date of its own application for registration and to demonstrate that the ground of revocation existed on such date. See Riveria Trade Mark [2003] RPC 50.

In other words, a citation of an earlier trade mark which had been revoked may still be raised in an application for registration if the application for registration has an accorded filing date which is earlier than the effective date of revocation of the earlier trade mark.

Who may apply?

Sections 52(1) (revocation) and 60(6) (defensive mark) provide that "any" person may apply for the revocation of the registration of a trade mark. There is no test to determine whether or not the applicant is a "person aggrieved" (as under Cap. 43) or whether the applicant has any interest in the registration or its removal from the register. As the grounds for revocation of collective and certification marks are expressed as being additional to those in section 52, it follows that "any" person may also apply for revocation of these special marks.

Applying for revocation on grounds other than non-use

The application must be made on the specified form and filed with a statement of the grounds on which the application is made.

The "specified form" is Form T6, which also includes a filing fee (currently $800).

The applicant should also, at the same time, file an address for service in Hong Kong (rule 105(1)(g)) which can either be on Form T6 or alternatively by notifying the Registrar of the address for service in writing.

Outline of procedure

The main steps to be taken by applicants and owner's (if the latter intend to contest the application) are set out in rules 40 to 45. These are broadly :

Rule 40 (1) (2) The applicant makes his application by filing Form T6 with a statement of the grounds on which the application is made, together with the prescribed fee.

Rule 40(3) The applicant must, at the same time as he files the application, send a copy of it and the statement of grounds to the owner of the trade mark.

The following outline of procedure also applies to applications for declarations of invalidity.

Rule 41(1) The owner may file a counter-statement on Form T7 setting out the matters contained in rule 41(1)(a) – (d). This must be received at the Registry within 3 months after the date on which he receives a copy of the application and statement of grounds. This period cannot be extended (rule 95(1)(l)). If the owner does not file a counter-statement within that time, the Registrar may treat the application for revocation as unopposed by the owner. The owner must, at the same time as he files his counter-statement, send a copy of it to the applicant.

Rule 41(3)

Rule 41(2)

Rule 42(1)(a)
Rule 42(2)
Rule 42(3)

The applicant may file evidence by way of statutory declaration or affidavit in support of the grounds stated in his application. Where the owner has filed a counter-statement, the evidence must be received at the Registry within 6 months (or any agreed extended date) after the date on which he receives a copy of the counter-statement. The applicant, at the same time, must also send a copy of that evidence to the owner. If the applicant does not file evidence within the specified period, he shall be deemed to have withdrawn his application.

Rule 42(1)(b)

If the owner does not file a counter-statement, then the applicant shall file evidence in support within 9 months after the date of the filing of the application.

Rule 43 (1) (a)
(b)
(2)

If the applicant has filed evidence, an owner who has filed a counter-statement may file evidence by way of statutory declaration or affidavit 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 applicant's evidence. The owner must, at the same time, send a copy of that evidence or statement that he does not intend to file evidence to the applicant.

Rule 44 (1)
(2)

If the owner files evidence, the applicant may file, by way of statutory declaration or affidavit, further evidence which must be strictly in reply to that filed by the owner under rule 43(1). Any evidence filed 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 owner's evidence. The applicant must, at the same time as he files his evidence send a copy of it to the owner.

Rule 44(3) Rule 82	Either party may apply at any time for leave from the Registrar to file further evidence. If leave is granted, it is normal for the other party to be allowed to file further evidence strictly in reply. The applicant has the right to be the last to file evidence.

For procedures thereafter, see *Procedure common to all applications resulting in a hearing* and in the chapter on Opposition to registration.

More than one applicant shown on Form T6

It would be rare to have more than one applicant for revocation, however should it occur, each applicant must file a separate Form T6 and each applicant must pay the specified fee. Where more than one applicant intends to "jointly" apply, Form T6 should state this fact. In such a situation the grounds on which the application is made must be common to all applicants.

Content of the statement of grounds on which the application is made

There is no prescribed form that the statement of grounds on which the application is made must take. It can be in the form of a declaration, notice or letter.

It should set out the primary facts upon which the application is based. If revocation is to take effect from a date earlier than the date of application, the applicant for revocation should specifically allege that the grounds existed at an earlier date and state the actual date from which the revocation is to be effective.

The statement of grounds must precisely identify the section and subsection upon which the application is made. Ultimately, it will be necessary to test each ground separately by measuring the evidence offered against the requirements of the Ordinance.

"Rolled-up" grounds are therefore defective pleadings. See the comments of the Appointed Person in *CORGI Trade Mark* [1999] RPC 549.

The statement of grounds is not evidence and therefore should not stray into the area of evidence.

Multiple actions

Where multiple actions are taken (i.e. revocation on the grounds of non-use and either revocation on any other ground and/or invalidity) the applications must be made on separate forms and separate fees paid. The reason for this is because the order of filing evidence is different, as is the time scale. This applies equally in cross-applications for revocation and/or declaration of invalidity when an opponent files opposition proceedings. The appropriate time to make an application for consolidation or applications that the matters be heard together is at the conclusion of the evidence rounds.

Service of Form T6 and the statement of grounds

The applicant must, at the same time as he files the application, send a copy of it and the statement of the grounds on which the application is made to the owner of the trade mark.

Also see chapters on Service of pleadings and evidence, and Computation of time for service of documents between parties.

Requests to amend the application or statement of grounds

See chapter on Amendment of pleadings.

Options available to the owner

Upon receipt of a copy of the application and statement of grounds, the owner may either :

- file a counter-statement — see below; or

- do nothing if he does not want to defend his registration.

Section 2(1) defines "owner" as the person whose name is for the time being entered in the register as the owner of the trade mark, or if there are two or more such persons, each of those persons.

Filing and service of counter-statement

If the owner wishes to defend his registration, he must file Form T7 and a counter-statement. There is no fee payable on filing Form T7. The documents must be received at the Registry within 3 months after the owner receives a copy of the application and the statement of grounds (rule 41(1)). This period cannot be extended (rule 95(1)(l)).

See also chapter on Computation of time for filing at the Registry.

The owner must, at the same time, send a copy of all the documents filed to the applicant.

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

If the owner does not currently have an address for service recorded in the register he should also at the same time file an address for service in Hong Kong, either on Form T7 or separately notifying the Registrar of his address for service in writing.

Content of the counter-statement

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

Rule 41(1)(a) – (d) however provides that it must set out :

- the grounds on which he relies to support his registration;
- the facts alleged in the application that he admits;
- the facts alleged in the application that he denies and his reasons. If he intends to put forward an alternative version of event, his version of those events; and
- the facts alleged in the application that he is unable to admit or deny.

The counter-statement is not evidence and it should not stray into the area of evidence.

Procedure when Form T7 and counter-statement is not filed

If the owner does not file Form T7 and a counter-statement by the due date, the Registrar may treat the application for revocation as being unopposed by the owner. The Registrar will then invite the applicant to file his evidence pursuant to rule 42(1).

Applicant's evidence

Upon receipt of the counter-statement, an applicant wishing to continue must file evidence by way of statutory declaration or affidavit in support of the grounds stated in his application. Such evidence must be received at the Registry within 6 months after the date he received the owner's counter-statement. The period can be extended at the Registrar's discretion (rule 94). For the procedure to extend time, see chapter on Applications for extension of time.

The applicant must, at the same time as he files his evidence in support, serve a copy of his evidence upon the owner (rule 42(2)).

Procedure when the applicant does not file evidence

If the applicant does not file evidence by the due date and no extension of time is requested, he shall be deemed to have withdrawn his application (rule 42(3)).

Owner's evidence

If the applicant files evidence under rule 42**,** an owner who has filed a counter-statement may file, either evidence by way of statutory declaration or affidavit in support of the counter-statement or a statement to the effect that he does not intend to file evidence. The evidence or statement must be received at the Registry within 6 months after the applicant has served his evidence upon the owner (rule 43(1)). The period can be extended at the Registrar's discretion (rule 94). For the procedure to extend time, see chapter on Applications for extension of time.

The owner must, at the same time as he files his evidence or statement, send a copy of the evidence or statement to the applicant (rule 43(2)).

Procedure when the owner files no evidence

If the owner does not file evidence within the specified time or any agreed extension of time for doing so, the evidence rounds are considered completed, and the matter will be considered "ready" for the fixing of a date, time and place for hearing argument. To avoid any doubt, an owner who does not file evidence, even if he does not file a statement that he does not intend to file evidence, will not be permitted to make an application pursuant to rule 44(3).

The computer system is updated to "HEARING".

Procedure when the owner files a statement that no further evidence will be filed

If the owner files a statement pursuant to rule 43(1)(b), the evidence rounds are considered completed, and the matter shall be considered "ready" for the fixing of a date, time and place for hearing argument.

The computer system is updated to "HEARING".

Procedure when the applicant files evidence in reply

If the owner files evidence, the applicant 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 owner's evidence. This further evidence must be received at the Registry within 6 months after the owner has served his evidence upon the applicant (rule 44(1)). The 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.

The applicant must, at the same time as he files his evidence in reply, send a copy of it to the owner (rule 44(2)).

Further evidence

The filing of the applicant's evidence in reply will usually complete the evidence rounds.

See also chapter on Procedure where leave is sought to file further evidence.

Fixing a hearing

See chapter on Hearings.

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