

Revocation of registration on grounds of non-use

Revocation is a request to have a registered trade mark removed from the register either in whole or in part. This ground is available irrespective of whether the application relates to a trade mark registered before the commencement date of Schedule 5 Cap. 559 or after. The ground for revocation for non-use is to be found in section 52(2)(a) :

- That the trade mark has not been genuinely used in Hong Kong by the owner or with his consent, in relation to the goods or services for which it is registered, for a continuous period of at least three years, and there are no valid reasons for non-use (such as import restrictions on, or other governmental requirements for, goods or services protected by the trade mark).

Note that section 52(2)(a) has no application where the mark has been registered as a defensive trade mark (section 60(7)).

Section 52(2)(a) refers to **use in Hong Kong**. For the purpose of section 52(2)(a), use of a trade mark in Hong Kong includes (section 52(3)(b) and (c)) :

- (a) applying the trade mark to goods or to the packaging of goods in Hong Kong solely for export purposes; and
- (b) where the trade mark is registered in respect of services, use in relation to services provided or to be provided outside Hong Kong (e.g. advertising use in Hong Kong of a mark for hotel services, where the hotel services is provided outside Hong Kong).

Grounds affecting only some of the goods or services

The grounds for revocation may apply to only some classes or to only some of the goods or services within a class 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)).

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.

Section 52(8) provides that for the purposes of subsection (2)(a), the 3-year period may begin at any time on or after the actual date on which particulars of the trade mark were entered in the register under section 47(1) (registration). Therefore, an application for revocation on the grounds of non-use may be made, and the revocation may take effect, at the earliest, on a date not less than three years from the actual date of registration. See Philosophy di Alberta Ferretti Trade Mark [2003] RPC 15 and WISI Trade Mark [2006] RPC 22.

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?

Section 52(1) provides 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.

Where is the application to be made?

See chapter on Where the application is to be made.

Applying for revocation on the grounds of non-use

Rule 36(2) contains a departure from the old procedure. The application must be made on Form T6 accompanied by a statement of the grounds on which the application is made, evidence in support of the application, and the fee (currently \$800). The applicant must, at the same time as he files the application, send a copy of it, the statement of grounds and the evidence to the owner of the registered trade mark.

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

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 36 – 39. Broadly, these are :

- Rule 36(1)(2) The applicant makes his application by filing Form T6 with a statement of the grounds on which the application is made, evidence in support, together with the prescribed fee and an address for service.
- Rule 105(1)(e)
- Rule 36(3) The applicant shall at the same time as the application is filed, send a copy of the application, statement of grounds and evidence to the owner of the trade mark.
- Rule 37 (1) The owner may file a counter-statement on Form T7 setting out the matters contained in rule 37(1)(a) – (d) together with either, evidence of the use made of the trade mark, or, a statement giving reasons for non-use. These documents must be received at the Registry within 6 months after the date on which he receives a copy of the application, statement of grounds and applicant's evidence. The owner must, at the same time as he files the counter-statement, send a copy of the counter-statement and a copy of the evidence of use or statement giving reasons for non-use to the applicant. If the owner does not file a counter-statement and evidence of use or a statement giving reasons for non-use within that period, the Registrar may treat the application for revocation as being unopposed by the owner. The 6 month period is not extendable (rule 95(1)(k)).
- (2)
- (3)
- (4)
- Rule 38 (1)(a) Whether the owner has taken steps or not, the applicant may file further evidence by way of statutory declaration or an affidavit in support of his application. This 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 and evidence of use or statement giving reasons for non-use as the case may be.
- (1)(b) Where the owner has not taken steps, the applicant may still file additional evidence. This must be received at the Registry within 9 months after the date of filing the application. The applicant must
- (3)

also, at the same time as he files his additional evidence in support of the application, send a copy of that evidence to the owner.

Rule 38(4)
Rule 82

Except with the leave of the Registrar no further evidence may be filed by either party. If leave is granted, it is normal for the other side to be allowed to file further evidence strictly in reply. The applicant has the right to be the last to file evidence.

Rule 86 (1)
(2)

The Registrar may, if the evidence does not support the pleadings or some of them, direct the parties to attend a case management conference. At least 14 days notice of the date, time and place of the case management conference will be given.

Rule 39
Rule 74(4)

When the evidence rounds are complete, the Registrar shall, on his own initiative, fix a date, time and place for the hearing and give notice of the hearing to the parties.

After this, please refer to the outline procedure common to all applications resulting in a hearing in the chapter on Opposition to registration.

More than one applicant shown on Form T6

Although it will be rare that there would be more than one applicant for revocation under this section, should it occur, each applicant for revocation must file a separate Form T6 and each applicant must pay the specified fee.

If more than one applicant intends to apply “jointly”, 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 the 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 revocation is to be effective. See the decision of Jacob J in Omega SA v Omega Engineering Inc. [2003] EWHC 133 (Ch) at para. 11.

The statement of grounds is not evidence and therefore should not stray into the area of evidence. Evidence such as investigation reports, 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. Any evidence filed would not be uploaded to IPD website for online inspection.

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 that the order of filing evidence is different, as is the time scale. This applies equally to cross-applications for revocation on the grounds of non-use when an opponent files opposition proceedings. The appropriate time to make an application for consolidation, or applications that the matters be heard together, are at the conclusion of the evidence rounds.

A separate statement of grounds for each action in a multiple action application must be filed. Each statement of grounds must identify precisely the section and subsection

upon which each 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.

Evidence in support of the application

The applicant will not know whether the owner intends to defend his registration. The purpose underlying the new requirement to file evidence of non-use with the application is to enable the revocation to take place earlier if the owner does not resist. Revocation can be ordered (providing the evidence filed under rule 36(2) is adequate) as soon as the six-month period under rule 37(1) has expired without steps being taken by the owner. The evidence would comprise the normal investigator’s statutory declaration or affidavit outlying the enquiries undertaken to ascertain there had been no use discovered of the mark in the relevant period. If this evidence does not amount to *prima facie* evidence of non-use, the Registrar will invite the applicant to file additional evidence under rule 38(1)(b).

Service of Form T6, the statement of grounds and evidence

Rule 36(3) is a departure from the old procedure. The applicant is required, at the same time as he files the application, to send a copy of it, the statement of grounds and the evidence in support to the owner of the trade mark.

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

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 and evidence of the use made of the trade mark or a statement giving reasons for non-use – 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 2 or more of such persons, each of those persons.

Filing of counter-statement and evidence of use or statement giving reasons for non-use

If the owner wishes to defend his registration, he must file Form T7 and a counter-statement and either a copy of evidence of use made of the trade mark or a copy of a statement giving reasons for non-use. There is no fee for filing Form T7. The documents must be received at the Registry within 6 months after the owner receives a copy of the application and statement of grounds. This period is not extendible (rule 95(1)(k)).

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

If Form T7, the counter-statement, evidence of use or statement of reasons for non-use are not received at the Registry before the expiration of the said period, the Registrar may treat the application for revocation as being unopposed by the owner. As the burden of proving use lies with the owner (section 82(1)), the Registrar shall then

determine whether an order revoking the mark can be made without the filing of further evidence by the applicant.

Content of the counter-statement

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

Rule 37(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. Evidence such as investigation reports, 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. Any evidence filed would not be uploaded to IPD website for online inspection.

Filing of evidence of use/burden of proving use of a trade mark

Where evidence is to be provided to the Registrar, it must be in the form of a statutory declaration or affidavit (rule 79(1)).

Section 82(1) provides that if, in any civil proceedings under the Ordinance in which the owner of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use lies with the owner.

Owners should bear that provision in mind when preparing their evidence. A mere assertion of use is not sufficient – see *ACADEMY Trade Mark* (unreported, UK Registry, 27 November 1998). The standard of proof is the civil standard, i.e. on the balance of probability.

Statement giving reasons for the non-use of the trade mark

There is no specified form in which the statement has to be made. It may be by statutory declaration, affidavit, notice or letter. It should however be confined to valid reasons for non-use, which, from the examples given in section 52(2)(a), would be confined to factors beyond the control of the owner and of a governmental nature. It is unlikely that commercial disruptions would amount to valid reasons.

Service of counter-statement and evidence of use etc

The owner must, at the same time as he files the counter-statement and evidence or statement, send a copy of all the documents filed to the applicant.

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

Applicant's further evidence where owner has taken steps

Upon receipt of the counter-statement and evidence of use, or statement of the reasons for non-use, the applicant may file further evidence, by a statutory declaration or

affidavit, in support of the grounds stated in his application. Such evidence is not restricted to evidence strictly in reply to the owner's evidence. Such evidence must be received at the Registry within 6 months after the date he received the owner's documents under rule 37(3). 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, send a copy of it to the owner (rule 38(3)).

Applicant's further evidence when owner has taken no steps

If the owner does not file a counter-statement and evidence of use or a statement giving reasons for non-use within the time specified in rule 37(1), the applicant may file further evidence. This is likely to arise only if the Registrar is not satisfied that the evidence filed under rule 36(2) establishes non-use to his satisfaction. He will then invite the filing of further evidence. Where further evidence is to be filed by the applicant, it should be received by the Registry within 9 months of the date of filing the application. This period may however be extended – rule 94.

If the applicant does not intend to file further evidence he must file a statement to that effect within the periods specified in rule 38(1)(a) or (b) as appropriate.

The further evidence or statement pursuant to rule 38(2) must, at the same time as it is filed, be served on the owner. This is so even when the owner has taken no steps.

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

If the applicant files a statement pursuant to rule 38(2) the evidence rounds are

considered completed, subject to any subsequent application under rule 38(4) for leave to file further evidence, 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”.

Further evidence

The filing of the applicant’s further evidence will usually complete the evidence rounds. Where the owner has filed a counter-statement and evidence of use or a statement giving reasons for non-use and further evidence is filed by the applicant, the owner may seek leave to file further evidence. Whether leave will be granted is a matter for the Registrar’s discretion.

For further procedures see chapter on Procedure where leave is sought to file further evidence.

* * *