

Variation and rectification of registration

Variation is a limited remedy. The transitional provision of the Trade Marks Ordinance provides that any entry in the old register of a disclaimer, condition or limitation which relates to an existing registered mark shall be deemed to be transferred to the new register (section 3(2) of Schedule 5). Many of the conditions that were imposed, especially upon older marks, may now have become obsolete. Section 54 provides a vehicle to vary a condition, but only in the limited circumstances where there has been a contravention of, or a failure to, observe any condition (note not disclaimer or limitation) entered in the register in relation to its registration (section 54(2)). It could be used, for example, to vary a blank space condition which arguably serves no useful purpose. It cannot, however be a vehicle to vary a condition, for example, that the registration shall give no exclusive right to the use of the numeral “2”, which is in effect a disclaimer.

Rectification is the power to rectify an error or omission in the register, save in respect of a matter affecting the validity of the registration of a trade mark (section 57(2)). If the rectification is allowed, except where the Registrar or the court otherwise directs, the error or omission is treated as never to have been made (section 57(4)).

For correction by the Registrar of errors or omissions in the register pursuant to section 57(6) and opposition or objection to removal of matter from the register pursuant to section 57 (7), see the relevant chapters bearing these names.

A request to change a name or address recorded in the register is covered by section 57(5) and rule 65. There is no provision for opposition to such a change.

Who may apply?

Section 54(1) provides that “any” person may apply for the variation 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 variation. The applicant may, and in all probability will, be the owner of the mark himself.

For rectification pursuant to section 57(1), any person having a “sufficient interest” may apply. What amounts to a sufficient interest will need to be determined on a case by case basis.

Where is the application to be made?

See chapter on Where the application is to be made.

Applying for variation or rectification

There are two distinct procedures provided by the Rules depending on whether the application for variation or rectification is made by –

- the owner of the registered mark; or
- someone other than the owner of the registered mark.

In both situations the application must be made on the specified form and filed with a statement of the grounds on which the application is made, together with evidence to support the grounds.

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

Outline of procedure when the owner applies to vary or to rectify a registered trade mark

Rule 48(1) & (2) The owner makes his application by filing Form T6 with a statement of the grounds on which the application is made together with the prescribed fee. He must also file such evidence in the form of a statutory declaration or affidavit as he wishes to adduce.

Rule 105(1)(v) If the applicant does not have a current address for service recorded in the register he must at the same time file an address for service in Hong Kong.

Rule 49(2) The Registrar, if he allows the variation or rectification, will publish a notice containing the particulars specified in rule 49(2)(a) or (b) as appropriate, in the Hong Kong Intellectual Property Journal. If the Registrar does not allow the variation or rectification, the applicant will have the right to be heard pursuant to section 70 and rule 74.

Rule 49 (3) Any person may file a notice of objection on Form T6 together with the specified fee accompanied with a statement of the grounds of objection. This must be received at the Registry within 3 months beginning on the date of publication of the notice referred to in rule 49(2).

Rule 105(1)(b) The opponent must at the same time file an address for service in Hong Kong.

Rule 16(3) The opponent must, at the same time send a copy of the notice of objection and grounds to the owner of the registered trade mark.

The provisions of Part 3 of the Rules apply to any opposition under this provision. See chapter on Opposition to registration for detailed procedures.

Outline of procedure where the application is made by someone who is not the owner

The main steps to be taken by applicant and owner (if the latter intend to contest the application) are set out in rule 50. These are broadly:

Rule 48 (1) 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. He must also file such evidence in the form of a statutory declaration or affidavit as he wishes to adduce.

48 (2)

Rule 105(1)(j) The applicant must at the same time file an address for service in Hong Kong.

Rule 50(2) The applicant must at the same time send a copy of the application, statement of grounds and evidence to the owner of the trade mark.

Rule 50(3) & (4) The owner may file, a counter-statement on Form T7 together with such evidence as he wishes to adduce, or a statement to the effect that he does not intend to file evidence. This must be received at the Registry within 6 months after the date on which he receives the copy of the application,

- 50(6) statement of grounds and the applicant's evidence. This period is not extendible (rule 95(1)(m)). If the owner does not file a counter-statement within the prescribed period the Registrar may treat the application as being unopposed by the owner.
- Rule 105(1)(k) If the owner does not have a current address for service recorded on the register he must at the same time file an address for service in Hong Kong.
- Rule 50(5) The owner must at the same time serve a copy of the counter-statement and evidence (or statement) on the applicant.
- Rule 50(7) Where the owner has filed a counter-statement and evidence or a statement, 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 50(4). Any further 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 send a copy of that evidence to the owner.
- 50(8)
- Rule 50(9)
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.
- Rule 50(10)
Rule 74(4) When the evidence rounds are complete, the Registrar will fix a date, time and place for the hearing and give notice of this to the parties concerned. The Registrar will endeavour to give the parties 2 months

notice of the hearing date.

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

If the Registrar allows the variation or rectification he shall publish a notice in the Hong Kong Intellectual Property Journal containing the particulars specified in rule 50(11)(a) or (b).

Obvious clerical error or omission in the register

Where the written request for correction sought is of an obvious error or omission committed by the registered owner or the agent, such as a typographical error evident on the face of the register, the correction will usually be allowed upon written request and on reason(s) being given, without the need for supporting evidence or publication in the Hong Kong Intellectual Property Journal. An error or omission is obvious if nothing else would have been intended than what is offered as the correction. Some examples include:

- a typographical error in the word “Limtied” (for “Limited”) in the name of the registered owner
- a misspelling of the word “Strasser” (for “Strasse” meaning street in German), or “New Jeresy” (for “New Jersey”) in the address of the registered owner

* * *