

TRADE MARKS (EMERGENCY) ORDINANCE

(Chapter 263)

Long title

To make such special provision with respect to trade marks as is expedient to meet any emergency which may arise as a result of war.

[3 September 1939]

1. Short title

This Ordinance may be cited as the Trade Marks (Emergency) Ordinance.

2. Interpretation

- (1) In this Ordinance, unless the context otherwise requires—“*enemy*” (敵、敵人) and “*enemy subject*” (敵人子民) have the meanings respectively assigned to them by the Trading with the Enemy Ordinance 1914*; “*Registrar*” (處長) means the Registrar within the meaning of the Trade Marks Ordinance (Cap. 43).
- (2) References in this Ordinance to any enactment shall be construed as references to that enactment as amended by any subsequent enactment, including, except where the context otherwise requires, this Ordinance.

[*cf.* 1939 c. 107 s. 10(1) U.K.]

* See 25 of 1914 and 12 of 1957.

3. Power of Registrar to suspend trade mark rights of an enemy or an enemy subject

- (1) where it is made to appear to the Registrar that it is difficult or impracticable to describe or refer to an article, substance or activity without the use of a trade mark registered in respect of that article, substance or activity, being a trade mark which is, or has at any time since the beginning of 3 September 1939 been registered in the name of an enemy or an enemy subject, whether alone or jointly with another, or which is, or has at any such time as aforesaid been, in the proprietorship of an enemy or an enemy subject, whether alone or jointly with another, the following provisions of this section shall have effect. (*Amended 44 of 1991 s. 55*)
- (2) On the application of any person who proposes to deal in the course of trade in Hong Kong with an article or substance which is or is intended to be the same as, or equivalent to or a substitute for, the article or substance in respect of which the trade mark is registered, the Registrar may order that the right to the use of the trade mark given by the registration thereof shall be suspended—
 - (a) so far as regards use thereof by the applicant and any such use thereof by any other person in relation to goods connected in the course of trade with the applicant as would not be an infringement of the said right if the applicant were the proprietor of the trade mark; (*Amended 44 of 1991 s. 55*)
 - (b) to such extent and for such period as the Registrar may consider necessary for enabling the applicant to render well-known and established some description of, or means of reference to, the article or substance with which he proposes to deal in the course of trade, being a description or means of reference which does not involve the use of the trade mark.

- (2A) On the application of any person who proposes to provide in the course of business in Hong Kong services including an activity which is or is intended to be the same as, or equivalent to or a substitute for, the activity in respect of which the trade mark is registered, the Registrar may order that the right to the use of the trade mark given by the registration thereof shall be suspended—
- (a) so far as regards use thereof by the applicant and any such use thereof by any other person in relation to services connected in the course of business with the applicant as would not be an infringement of the said right if the applicant were the proprietor of the trade mark;
 - (b) to such extent and for such period as the Registrar may consider necessary for enabling the applicant to render well-known and established some description of, or means of reference to, the activity which he proposes to carry on in the course of business, being a description or means of reference which does not involve the use of the trade mark. (*Added 44 of 1991 s. 55*)
- (3) Where an order has been made under subsection (2) or (2A), no action for passing off shall lie on the part of any person interested in the trade mark in respect of any use thereof which, by virtue of the order, is not an infringement of the right to the use thereof given by the registration thereof. (*Amended 44 of 1991 s. 55*)
- (4) An order under this section may be varied or revoked by a subsequent order made by the Registrar. [*cf. 1939 c. 107 s. 3 U.K.*]

4. Effect of war on registration of trade marks

- (1) Notwithstanding the provisions of section 5 of the Trading with the Enemy Ordinance 1914*, or any rule of law relating to intercourse or dealings with or for the benefit of enemies, it shall be lawful, subject to the provisions of this Ordinance, for a trade mark to be registered under the Trade Marks Ordinance (Cap. 43) on the application of an enemy:
Provided that, where such a registration as aforesaid is effected on the application of an enemy—
- (a) the person registered shall not be entitled to require the issue of the certificate of registration; and
 - (b) the rights conferred by the registration shall be subject to any relevant provisions of any enactment for the time being in force relating to the property of an enemy.
- (2) The Registrar may, in any case in which in his opinion it is desirable in the public interest so to do, refuse to take, or suspend the taking of, any proceedings on or in relation to an application of an enemy for the registration of a trade mark.
- (3) No act requisite for enabling such a registration as aforesaid to be effected, in so far as it is done for that purpose and for that purpose only, shall, whether the registration is effected or not, be treated as a contravention of any of the provisions of section 5 of the Trading with the Enemy Ordinance 1914 (*See 25 of 1914 and 12 of 1957*), or of any rule of law relating to intercourse or dealings with or for the benefit of enemies.
- (4) References in this section to an application of an enemy shall be construed as including references to an application of an enemy jointly with any other person, whether an enemy or not. [*cf. 1939 c. 107 s. 4 U.K.*]

* See 25 of 1914 and 12 of 1957.

5. Power of Registrar to extend time limits having regard to war circumstances

- (1) The Registrar may, subject to such conditions, if any, as he thinks fit to impose, extend the time limited by or under the Trade Marks Ordinance (Cap. 43), or this Ordinance, for doing any act, where he is satisfied—
 - (a) that the doing of the act within the time so limited was prevented by a person's being on active service or by any other circumstances arising from the existence of a state of war which, in the opinion of the Registrar, justify an extension of the time so limited; or
 - (b) that, by reason of circumstances arising from the existence of a state of war, the doing of the act within the time so limited would have been or would be injurious to the rights or interests of the person by or on whose behalf the act is or was to be done or to the public interest.
- (2) An extension under this section of the time for doing any act—
 - (a) may be for any period that the Registrar thinks fit, notwithstanding that by or under any Ordinance power is conferred to extend the time for doing that act for a specified period only; and
 - (b) may be granted notwithstanding that that time expired before any application or request for extension was made, or that, by reason of that act not having been done within that time, the relevant application, registration or proceeding has ceased or expired, or become void or invalid, or been treated as abandoned.
- (3) The powers conferred by this section may be exercised notwithstanding that the exercise thereof benefits, whether directly or indirectly, an enemy or an enemy subject.

[cf. 1939 c. 107 s. 6 U.K.]

6. Evidence relating to nationality and place of residence, and decisions relating to enemy character

- (1) For the purposes of this Ordinance—
 - (a) the fact that the address of any person registered in the register of trade marks kept under the Trade Marks Ordinance (Cap. 43) is an address in enemy territory within the meaning of the Trading with the Enemy Ordinance 1914*, shall be prima facie evidence that that person is resident in that territory; and
 - (b) the fact that in any such register a person is stated to be of a particular nationality shall be prima facie evidence that he is of that nationality.
- (2) No order made by the Registrar under this Ordinance shall be held to be invalid by reason only that any decision made for the purposes of the order that a particular person is an enemy or an enemy subject is wrong.

[cf. 1939 c. 107 s. 7 U.K.]

* See 25 of 1914 and 12 of 1957.

7. Persons to be heard before making of orders

Before deciding as to the making of any order under this Ordinance, the Registrar shall, unless having regard to the circumstances he considers it inexpedient or impossible so to do, give to any person who appears to the Registrar to be interested such opportunity of being heard as appears to him to be just.

[cf. 1939 c. 107 s. 8 U.K.]

8. Rules and fees

- (1) The Chief Justice with the approval of the Legislative council may make rules for regulating the practice under this Ordinance, including rules providing for oppositions and rules regulating the service of documents and the time within which any act authorized or required by this Ordinance or the rules may or must be done.
- (2) There shall be paid in respect of applications and other matter under this Ordinance such fees as may be prescribed by the Chief Justice with the concurrence of the Legislative Council.

[cf. 1939 c. 107 s. 9 U.K.]