

TRADE MARKS ORDINANCE

Chapter 43

Long title

To amend and consolidate the law relating to the registration of trade marks.

[1 January 1955] G.N.A. 143 of 1954

(Originally 47 of 1954)

Section 1

Short title

This Ordinance may be cited as the Trade Marks Ordinance.

[cf. 1938 c. 22 s. 71 U.K.]

Section 2

Interpretation

Remarks:

Adaptation amendments retroactively made—see 22 of 1999 s. 3

(1) In this Ordinance, unless the context otherwise requires-

“assignment” means assignment by act of the parties concerned;

“certification trade mark” means a mark registered or deemed to have been registered under [section 64](#); (Added 44 of 1991 s. 2)

“defensive trade mark” means a mark registered under [section 55](#) or [55A](#); (Added 44 of 1991 s. 2)

“limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor of the trade mark, including limitations of that right as to mode of use or as to use,-

(a) in the case of a trade mark relating to goods, in relation to-

(i) goods to be sold, or otherwise traded in, within Hong Kong; or

(ii) goods to be exported to any market outside Hong Kong; and

(b) in the case of a trade mark relating to services, in relation to-

(i) services for use or available for acceptance within Hong Kong; or

(ii) services for use in any place outside Hong Kong; (Replaced 44 of 1991 s. 2)

“mark” means any sign that is visually perceptible and capable of being represented graphically and may, in particular, consist of words, personal names, letters, numerals, figurative

elements or combination of colours, and includes any combination of such signs; (Replaced 11 of 1996 s. 18)

“permitted use” has the meaning assigned to it by [section 58\(1\)](#);

“prescribed” means, in relation to proceedings before the Court or preliminary thereto or connected therewith, prescribed by this Ordinance or by the rules made thereunder or by rules of court and, in other cases, prescribed by this Ordinance or by the rules made thereunder;

“provision”, in relation to services, means their provision, whether or not for money or money’s worth; (Added 44 of 1991 s. 2)

“register” means the register of trade marks kept under this Ordinance;

“registered trade mark” means a trade mark which is actually on the register;

“registered user” means a person who is for the time being registered as such under [section 58](#);

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Ordinance;

“Registrar” means the Registrar of Trade Marks appointed by the Chief Executive; (Replaced 35 of 1990 s. 10. Amended 22 of 1999 s. 3)

“seal” means the seal of the Registrar kept in the Trade Marks Registry Hong Kong; (Amended 22 of 1999 s. 3)

“trade mark” means (except in the expressions “trade mark relating to goods”, “trade mark relating to services”, “defensive trade mark” and “certification trade mark”) a trade mark relating to goods or a trade mark relating to services; (Replaced 44 of 1991 s. 2)

“trade mark relating to goods” means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person; (Added 44 of 1991 s. 2)

“trade mark relating to services” means a mark used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person; (Added 44 of 1991 s. 2)

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment;

“tribunal” means the Court or the Registrar.

(2) References in this Ordinance to-

- (a) the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;
- (b) the use of a mark in relation to goods shall be construed as references to the use of the mark upon, or in physical or other relation to, goods; and
- (c) the use of a mark in relation to services shall be construed as references to the use of the mark as or as part of any statement about the availability or performance of services or otherwise in relation to services. (Replaced 44 of 1991 s. 2)

(3) For the purposes of this Ordinance, goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and a description of goods and a description of services are associated with each other if it is likely that the description of goods might be sold or otherwise traded in and the description of services might be provided by the same business. (Added 44 of 1991 s. 2)

(4) References in this Ordinance to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion. (Added 44 of 1991 s. 2)

(5) For the purposes of this Ordinance, a person who provides services that are ancillary to a trade or business of that person may be regarded as being connected, in the course of business, with the provision of those services. (Added 44 of 1991 s. 2)

[cf. 1938 c. 22 s. 68 U.K.]

Section 3 Register of trade marks

REGISTER OF TRADE MARKS

(1) The Registrar shall for the purposes of this Ordinance keep a record called the register of trade marks, wherein shall be entered all registered trade marks, with the dates of their registration, the names and addresses of their proprietors, notifications of assignments and transmissions, the names and addresses of all registered users, disclaimers, conditions, limitations, and such other matters relating to such registered trade marks as may be prescribed. (Amended 44 of 1991 s. 3) [cf. 1938 c. 22 s. 1(1) & (4) U.K.]

(2) The Registrar need not keep the register in documentary form. (Added 44 of 1991 s. 3)

Section 4 Division of register into 2 parts

(1) The register shall be divided into 2 parts, called **Part A** and **Part B**. [cf. 1938 c. 22 s. 1(2) U.K.]

(2) **Part A** of the register shall comprise all trade marks entered in the register of trade marks at the commencement of this Ordinance and all trade marks which after the commencement of this Ordinance shall be registered in that Part under the provisions of this Ordinance.

(3) **Part B** shall comprise all trade marks registered in that Part under the provisions of this Ordinance.

[cf. 1919 c. 79 s. 1 U.K.]

Section 5 Trust not to be entered in register

There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

[cf. 1938 c. 22 s. 64(1) U.K.]

Section 6 Inspection of register

(1) The register shall at all convenient times be open to the inspection of the public, subject to such rules as may be prescribed. (Amended 44 of 1991 s. 4) [cf. 1938 c. 22 s. 1(3) U.K.]

(2) In relation to any portion of the register kept otherwise than in documentary form, the right of inspection conferred by [subsection \(1\)](#) is a right to inspect the material on the register.

(Added 44 of 1991 s. 4)

Section 7 Copies and extracts from register

(1) Any person who applied for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of the prescribed fee; and rules under [section 90](#) may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of the prescribed fee.

(2) In relation to any portion of the register kept otherwise than in documentary form, the right to a copy or extract conferred by [subsection \(1\)](#) or rules under [section 90](#) is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

(3) In this section, “certified copy” and “certified extract” mean a copy and extract certified by the Registrar and sealed with the seal of the Registrar.

(Replaced 44 of 1991 s. 5)

[cf. 1938 c. 22 s. 1(5), (7) & (11) U.K.]

Section 8 Trade mark must be for particular goods

REGISTRABLE TRADE MARKS

(1) A trade mark relating to goods must be registered in respect of particular goods or classes of goods. (Amended 44 of 1991 s. 53)

(1A) A trade mark relating to services must be registered in respect of particular services or classes of services. (Amended 44 of 1991 s. 6)

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final. (Amended 44 of 1991 s. 52)

[cf. 1938 c. 22 s. 3 U.K.]

Section 9 Trade marks registrable in Part A

(1) A trade mark (other than a certification trade mark) to be registrable in **Part A** of the register shall contain or consist of at least one of the following essential particulars-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
 - (b) the signature (in other than Chinese characters) of the applicant for registration or of some predecessor in his business;
 - (c) an invented word or invented words;
 - (d) a word or words having no direct reference to the character or quality of the goods or services, as the case may be, and not being according to its ordinary signification a geographical name or a surname; (Amended 44 of 1991 s. 7)
 - (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in [paragraphs \(a\), \(b\), \(c\) and \(d\)](#), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.
- (2) For the purposes of this section, “distinctive” means-
- (a) in the case of a trade mark relating to goods, adapted in relation to the goods in respect of which the trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected, in the course of trade, from goods in the case of which no such connection subsists; or
 - (b) in the case of a trade mark relating to services, adapted in relation to the services in respect of which the trade mark is registered or proposed to be registered, to distinguish services with the provision of which the proprietor is or may be connected, in the course of business, from services with the provision of which he is not so connected,

either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration. (Replaced 44 of 1991 s. 7)

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

[cf. 1938 c. 22 s. 9 U.K.]

Section 10 Trade marks registrable in Part B

(1) A trade mark relating to goods to be registrable in **Part B** of the register must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to the use within the extent of the registration. (Amended 44 of 1991 s. 53)

(1A) A trade mark relating to services to be registrable in **Part B** of the register must be capable, in relation to the services in respect of which it is registered or proposed to be registered, of distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration. (Added 44 of 1991 s. 8)

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and (Amended 44 of 1991 s. 8)
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in **Part B** notwithstanding any registration in **Part A** in the name of the same proprietor of the same trade mark or any part or parts thereof.

(Replaced 3 of 1985 s. 2)

[cf. 1938 c. 22 s. 10 U.K.]

Section 11 Coloured trade marks

(1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

[cf. 1938 c. 22 s. 16 U.K.]

Section 12 Restriction on registration

(1) It shall not be lawful to register as a trademark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design. [cf. 1938 c. 22 s. 15(3) U.K.]

(2) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark relating to goods in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Ordinance or thereafter shall, notwithstanding anything in [section 30](#), be deemed for the purposes of [section 48](#) to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that the foregoing provisions of this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use. (Amended 44 of 1991 s. 53) [cf. 1938 c. 22 s. 11 U.K.]

(3) A sign shall not be registered as a trade mark relating to goods if it consists exclusively of-

- (a) the shape that results from the nature of the goods themselves;
- (b) the shape of goods that is necessary to obtain a technical result; or
- (c) the shape that gives substantial value to the goods. (Added 11 of 1996 s. 19)

Section 13 Application for registration

REGISTRATION OF TRADE MARKS

(1) Any person claiming to be entitled to be registered as the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in **Part A** or **Part B** of the register.

(2) Subject to the provisions of this Ordinance, the Registrar may refuse the application, or accept it absolutely or subject to such conditions, amendments, modifications, or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in **Part A** of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in **Part B** and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the Court.

(5) An appeal under this section shall be made in the prescribed manner, and on such appeal the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated as aforesaid by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated as aforesaid by him, except by leave of the Court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(7) The Registrar or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the Court may think fit.

[cf. 1938 c. 22 s. 17 U.K.]

Section 13A Priority for application made in Convention country

Remarks:

Adaptation amendments retroactively made—see 22 of 1999 s. 3

(1) Subject to [subsection \(2\)](#), any person who has applied for protection for any trade mark in a Convention country, or his legal representative or assignee, shall be entitled to registration of his trade mark under this Ordinance in priority to other applicants and, subject to [subsection \(2A\)](#), the registration shall have the same date as the date of the application in the Convention country. (Amended 44 of 1991 s. 9)

(2) For the purposes of obtaining priority under [subsection \(1\)](#), the application for registration of the trade mark under this Ordinance must be made within 6 months from-

- (a) the date of application for protection in the Convention country; or
- (b) where more than one such application for protection has been made, from the date of the first application.

(2A) Where an application for protection for a trade mark relating to services was made in a Convention country before the date on which the Trade Marks (Amendment) Ordinance 1991 (44 of 1991) came into force, a trade mark relating to services registered on an application under this section made within the period specified in [subsection \(2\)](#) shall be registered as of that date. (Added 44 of 1991 s. 9)

(3) Nothing in [subsection \(1\)](#) shall entitle the proprietor of a trade mark to recover damages for any infringement happening prior to the actual date on which his trade mark is registered under this Ordinance.

(4) An application for the registration of a trade mark under this section shall, subject to such further requirements as may be prescribed-

- (a) be made in the same manner as an ordinary application under this Ordinance; and
- (b) specify-
 - (i) the Convention country in which the application for protection, or the first such application, was made; and
 - (ii) the date on which such application for protection was made.

(5) Where a person has applied for protection for any trade mark by an application which-

- (a) in accordance with the terms of a treaty subsisting between any 2 or more Convention countries, is equivalent to an application duly made in any one of those Convention countries; or
- (b) in accordance with the law of any Convention country, is equivalent to an application duly made in that Convention country,

he shall be deemed for the purposes of this section to have applied in that Convention country.

(6) In this section “Convention country” means-

- (a) the China; (Amended 22 of 1999 s. 3)
- (b) any country for the time being specified in the Schedule; (Replaced 11 of 1996 s. 20)
- (c) any colony, protectorate or territory subject to the authority or under the suzerainty of another country, or territory administered by another country, for the time being specified in the Schedule; (Added 11 of 1996 s. 20)
- (d) any other territory, or any area, for the time being specified in the Schedule. (Added 11 of 1996 s. 20)

(7) The Chief Executive may by order published in the Gazette- (Amended 22 of 1999 s. 3)

- (a) add to the Schedule-
 - (i) the name of any country which has acceded to the Paris Convention for the Protection of Industrial Property 1883, as revised at Brussels in 1900, at Washington in 1911, at the Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and as the same may be revised from time to time;

- (ii) the name of any colony, protectorate or territory subject to the authority or under the suzerainty of another country, or territory administered by another country, on behalf of which such other country has acceded to the said Convention; (Amended 22 of 1999 s. 3)
- (iii) the name of any country, territory or area which has acceded to the World Trade Organization Agreement done at Marrakesh in 1994, and as the same may be revised from time to time; (Added 11 of 1996 s. 20)
- (b) delete from the Schedule the name of-
 - (i) any country which has denounced the said Convention;
 - (ii) any colony, protectorate or territory on behalf of which the said Convention has been denounced;
 - (iii) any country, territory or area which has denounced the said Agreement; (Replaced 11 of 1996 s. 20)
- (c) otherwise amend the Schedule.

(Added 55 of 1977 s. 2)

[cf. 1907 c. 29 s. 91 U.K.]

Section 14 Advertisement of application

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall require the applicant to advertise it, as accepted, in the prescribed manner. The advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may require an application for registration of a trade mark to be advertised by the applicant before acceptance-

- (a) if it be made under [section 9\(1\)\(e\)](#); or
- (b) in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do,

and where an application has been so advertised the Registrar may, if he thinks fit, require the applicant to advertise it again when it has been accepted but shall not be bound so to do.

[cf. 1938 c. 22 s. 18(1) U.K.]

Section 15 Opposition to registration

(1) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(2) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of the notice to the applicant, and, within the prescribed time after the receipt thereof, the applicant shall send to the Registrar, in the prescribed manner, a

counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(4) If the applicant sends such a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner, and on the appeal the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section any party may, either in the prescribed manner or by special leave of the Court, bring forward further material for the consideration of the Court.

(8) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as hereinbefore provided, except by leave of the Court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) On an appeal under this section the Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of the notice, or an appellant, neither resides nor carries on business in Hong Kong, the tribunal may require him to give security for costs of the proceedings before it relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned. (Amended 44 of 1991 s. 54)

[cf. 1938 c. 22 s. 18(2) to (11) U.K.]

Section 16

Registration subject to disclaimer

(1) If a trade mark contains any part not separately registered by the proprietor as a trade mark or if-

- (a) in the case of a trade mark relating to goods it contains matter common to the trade or otherwise of a non-distinctive character; or
- (b) in the case of a trade mark relating to services it contains matter common to the provision of services of that description or otherwise of a non-distinctive character,

the Registrar or the Court, in deciding whether such trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register-

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or of all or any portion of any such matter, to the exclusive use of which the tribunal holds him not to be entitled; or

(ii) that he shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under such registration.

(2) No disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

(Replaced 44 of 1991 s. 10)

Section 17

Registration, and failure to complete

Remarks:

Adaptation amendments retroactively made—see 22 of 1999 s. 3

(1) When an application for registration of a trade mark in **Part A** or in **Part B** of the register has been accepted and has not been opposed and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the application has been accepted in error or unless the Chief Executive otherwise directs, register the trade mark in **Part A** or **Part B**, as the case may be, and the trade mark when registered shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Ordinance to be the date of registration: (Amended 55 of 1977 s. 3; 22 of 1999 s. 3)

Provided that, in relation to the date as of which a trade mark shall be registered and to the date to be deemed the date of registration, this subsection shall, as respects an application to which [section 13A](#) applies, have effect subject to that section. (Added 55 of 1977 s. 3) [cf. 1938 c. 22 s. 19(1) U.K.]

(2) The registration of a trade mark shall be for a period of 7 years, but may be renewed according to the provisions of [section 45](#):

Provided that, in relation to a registration as of a date before the commencement of this Ordinance, this subsection shall have effect with the substitution of a period of 14 years for the said period of 7 years. [cf. 1938 c. 22 s. 20(1) U.K.]

(3) On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof under the hand and seal of the Registrar. [cf. 1938 c. 22 s. 19(2) U.K.]

(4) When the registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice. [cf. 1938 c. 22 s. 19(3) U.K.]

Section 18

Application for registration of mark not to be used by applicant but to be assigned to corporation to be constituted or to be used by registered user

(1) An application for the registration of a trade mark in respect of any goods or services shall not be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark-

- (a) if the Registrar is satisfied that a body corporate is about to be constituted, and that applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods or services by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services and the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The Registrar may, as a condition of the exercise of the power conferred by [subsection \(1\)](#) in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings relative to any opposition, and in default of such security being duly given may treat the application as abandoned.

(3) Where a trade mark is registered in respect of any goods or services under the power conferred by [subsection \(1\)](#) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding 6 months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods or services, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

(Amended 44 of 1991 s. 52)

[cf. 1938 c. 22 s. 29 U.K.]

Section 19

Jointly owned trade marks

Where the relations between 2 or more persons interested in a trade mark relating to goods are such that no one of them is entitled as between himself and the other or others of them to use it except-

- (a) on behalf of both or all of them, or
- (b) in relation to an article with which both or all of them are connected in the course of trade, those persons may be registered as joint proprietors of the trade mark, and this Ordinance shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(Amended 44 of 1991 ss. 11 & 53)

[cf. 1938 c. 22 s. 63 U.K.]

Section 19A

Jointly owned trade marks relating to services

Where the relations between 2 or more persons interested in a trade mark relating to services are such that no one of them is entitled as between himself and the other or others of them to use it except-

- (a) on behalf of both or all of them; or
- (b) in relation to services with the provision of which both or all of them are connected in the course of business,

those persons may be registered as joint proprietors of the trade marks, and this Ordinance shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(Added 44 of 1991 s. 12)

Section 19B

Registration of joint proprietors

Subject to [sections 19](#) and [19A](#), nothing in this Ordinance shall authorize the registration of 2 or more persons who use a trade mark independently, or propose so to use it, as joint proprietors of the trade mark.

(Added 44 of 1991 s. 12)

Section 20

Prohibition of registration of identical and resembling trade marks

(1) Except as provided by [section 22](#), no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of-

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those good or goods of that description.

(2) Except as provided by [section 22](#), no trade mark relating to services shall be registered in respect of any services or description of services that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of-

- (a) the same services;
- (b) the same description of services; or
- (c) goods or a description of goods which are associated with those services or services of the description.

(Replaced 44 of 1991 s. 13)

Section 21

Applications for registration of identical or resembling trade marks

Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of-

- (a) the same goods or services;
- (b) the same description of goods or services; or
- (c) goods and services or descriptions of goods and services which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or, on an appeal, by the Court.

(Replaced 44 of 1991 s. 13)

Section 22 Concurrent use

In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or of the Registrar make it proper to do so, the Court or the Registrar may permit the registration by more than one proprietor, in respect of-

- (a) the same goods or services;
- (b) the same description of goods or services; or
- (c) goods and services or descriptions of goods and services which are associated with each other,

of trade marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

(Replaced 44 of 1991 s. 13)

Section 23 Protection of marks registered in country of origin

(1) Subject to [subsection \(3\)](#), the Registrar may refuse to register any trade mark relating to goods in respect of any goods or description of goods if it is proved to his satisfaction by the person opposing the application for registration that such mark is identical with or nearly resembles a trade mark which is already registered in respect of-

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description,

in a country or place from which such goods originate.

(2) Subject to [subsection \(3\)](#), the Registrar may refuse to register any trade mark relating to services in respect of any services or description of services if it is proved to his satisfaction by the person opposing the application for registration that such mark is identical with or nearly resembles a trade mark which is already registered in respect of-

- (a) the same services;
- (b) the same description of services; or

- (c) goods or a description of goods which are associated with those services or services of that description,

in a country or place from which such services originate.

(3) No application to register shall be refused under this section-

- (a) if the applicant proves that he or his predecessors in business have in Hong Kong, in relation to such goods or services, continuously used the trade mark for the registration of which he has made application from a date anterior to the date of the registration of the other mark in such country or place or origin; or
- (b) if the opponent does not give an undertaking to the satisfaction of the Registrar that he will, within 3 months from the giving of the notice of opposition, apply for registration in Hong Kong of the trade mark so registered in the country or place of origin, and will take all necessary steps to complete such registration.

(Replaced 44 of 1991 s. 14)

Section 24 Associated trade marks

ASSOCIATED TRADE MARKS

(1) Where a trade mark relating to goods that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of-

- (a) the same goods or description of goods; or
- (b) services that are associated with those goods or goods of that description,

or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(1A) Where a trade mark relating to services that is registered, or is the subject of an application for registration, in respect of any services is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of-

- (a) the same services or description of services; or
- (b) goods that are associated with those services or services of that description,

or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(2) On application made in the prescribed manner by the registered proprietor of 2 or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered, and he may amend the register accordingly. (Amended 44 of 1991 s. 52) [cf. 1938 c. 22 s. 23(5) U.K.]

(3) Any decision of the Registrar under the provisions of [subsections \(1\), \(1A\)](#) and [\(2\)](#) shall be subject to appeal to the Court.

(Amended 44 of 1991 s. 15)

Section 25 Combined trade marks

(1) If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the whole and any such part as separate trade marks. Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to the provisions of [subsection \(2\)](#) hereof and [section 38\(2\)](#), have all the incidents of an independent trade mark. [cf. 1938 c. 22 s. 2(1) U.K.]

(2) Where a trade mark and any part or parts thereof are thus registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks. [cf. 1938 c. 22 s. 23(3) U.K.]

Section 26 Series of trade marks

(1) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or services or the same description of goods or services, seeks to register those trade marks and the trade marks, while resembling each other in the material particulars thereof, differ in respect of-

- (a) statements of the goods or services in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

the trade marks may be registered as a series in one registration. (Replaced 44 of 1991 s. 16)

(2) All trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks. [cf. 1938 c. 22 s. 23(4) U.K.]

Section 27 Right given by registration in Part A in respect of goods, and infringement thereof

EFFECT OF REGISTRATION AND THE ACTION FOR INFRINGEMENT

(1) Subject to the provisions of [subsections \(2\) to \(4\)](#) hereof, and of [sections 33](#) and [34](#), the registration (whether before or after the commencement of this Ordinance) of a person in **Part A** of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the

trade mark or a registered user thereof using by way of the permitted use, uses in the course of trade a mark identical with or nearly resembling it, in relation to any goods in respect of which it is registered, or in relation to goods of the same description where such use would result in a likelihood of confusion, and in such manner as to render the use of the mark likely to be taken either- (Amended 44 of 1991 s. 17; 11 of 1996 s. 21)

- (a) as being use as a trade mark relating to goods; or (Amended 44 of 1991 s. 53)
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person-

- (a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark relating to goods, being one of 2 or more registered trade marks relating to goods which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks. Each registered proprietor of such a trade mark shall otherwise have the same rights as if he were the sole registered proprietor thereof. (Amended 44 of 1991 ss. 17 & 53)

[cf. 1938 c. 22 s. 4 U.K.]

Section 27A

Right given by registration in Part A in respect of services, and infringement thereof

(1) Subject to the provisions of [subsections \(2\) to \(4\)](#), and of [sections 33](#) and [34](#), the registration, after the commencement of the Trade Marks (Amendment) Ordinance 1991 (44 of 1991), of a person in **Part A** of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any services shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those services and, without prejudice to the generality of the

foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses in connection with the provision of any services a mark identical with or nearly resembling it in relation to any services in respect of which it is registered, or in relation to services of the same description where such use would result in a likelihood of confusion, and in such manner as to render the use of the mark likely to be taken either- (Amended 11 of 1996 s. 22)

- (a) as being use as a trade mark relating to services; or
- (b) in a case in which the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the mark or to services with the provision of which such a person as aforesaid is connected in the course of business.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to services for use or available for acceptance in any place, country or territory, or in any other circumstances, to which having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person-

- (a) in relation to services to which the proprietor of the mark or a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark; or
- (b) in relation to services the provision of which is connected in the course of business with the proprietor or a registered user of the mark, where the proprietor or registered user has at any time expressly or impliedly consented to the use of the mark; or
- (c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if-
 - (i) the use of the mark is reasonably necessary in order to indicate that the services are available for such use; and
 - (ii) neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of business between any person and the provision of those services.

(4) The use of a registered trade mark relating to services, being one of two or more registered trade marks relation to services that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks. Each registered proprietor of such a trade mark shall otherwise have the same rights as if he were the sole registered proprietor of that trade mark.

(Added 44 of 1991 s. 18)

Section 28

Right given by registration in Part B, and infringement thereof

(1) Except as provided by [subsection \(2\)](#), the registration of a person in **Part B** of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in **Part A** of the register, and the provisions of [section 27](#) shall have effect in like manner in relation to a trade mark registered in respect of any goods in **Part B** of the register as they have effect in relation to a trade mark registered in **Part A** of the register. (Amended 44 of 1991 s. 19)

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in **Part B** of the register, otherwise than by an act that is deemed to be an infringement by virtue of [section 32](#), no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

[cf. 1938 c. 22 s. 5 U.K.]

Section 28A

Right given by registration in Part B in respect of services, and infringement thereof

(1) Except as provided by [subsection \(2\)](#), the registration after the commencement of the Trade Marks (Amendment) Ordinance 1991 (44 of 1991) of a person in **Part B** of the register as proprietor of a trade mark in respect of any services shall, if valid, give to that person the like right in relation to those services as if the registration had been in **Part A** of the register, and the provisions of [section 27A](#) shall have effect in like manner in relation to a trade mark registered in respect of services in **Part B** of the register as they have effect in relation to a trade mark registered in **Part A** of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in **Part B** of the register, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating that a person having the right either as proprietor or as registered user to use the mark is connected in the course of business with the provision of the services.

(Added 44 of 1991 s. 20)

Section 29

Registration to be prima facie evidence of validity

In all legal proceedings relating to a registered trade mark (including applications under [section 48](#)) the fact that a person is registered as proprietor of such trade mark shall be prima facie evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions thereof.

[cf. 1938 c. 22 s. 46 U.K.]

Section 30

Registration in Part A to be conclusive as to validity after 7 years

(1) In all legal proceedings relating to a trade mark registered in **Part A** of the register (including applications under [section 48](#)) the original registration of the trade mark in **Part A** of the register shall, after the expiration of 7 years from the date of that registration, be taken to be valid in all respects, unless-

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against the provisions of [section 12\(1\)](#).

(2) Nothing in [section 28\(1\)](#) or [28A\(1\)](#) shall be construed as making applicable to a trade mark registered in **Part B** of the register the provisions of [subsection \(1\)](#) relating to a trade mark registered in **Part A** of the register. (Amended 44 of 1991 s. 21)

[cf. 1938 c. 22 s. 13 U.K.]

Section 31

Equities in respect of trade marks

Subject to the provisions of this Ordinance, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

[cf. 1938 c. 22 s. 64(2) U.K.]

Section 32

Infringement by breach of certain restrictions

(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark relating to goods, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorizes it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof. (Amended 44 of 1991 s. 53)

- (2) The acts to which this section applies are-
- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
 - (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
 - (c) in a case in which the trade mark is upon the goods, and there is also there on other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
 - (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;

- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

[cf. 1938 c. 22 s. 6 U.K.]

Section 33 Saving for vested rights

(1) Nothing in this Ordinance shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior-

- (a) to the use of the first mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title or his, or
- (b) to the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods or services under [section 22](#).

(2) The references in [subsection \(1\)](#) to the use of a trade mark by a person’s predecessor in title shall, as respects use in relation to services before the commencement of the Trade Marks (Amendment) Ordinance 1991 (44 of 1991), be construed as references to use by any predecessor of his in business.

(Amended 44 of 1991 ss. 22 & 52)

[cf. 1938 c. 22 s. 7 U.K.]

Section 34 Saving for use of name, address or description of goods

No registration of a trade mark shall interfere with-

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business;
- (b) the use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in [section 27\(1\)\(b\)](#) or in [section 67\(1\)\(b\)](#); or
- (c) the use by any person of any bona fide description of the character or quality of his services, not being a description that would be likely to be taken as importing any such reference as is mentioned in [section 27A\(1\)\(b\)](#) or in [section 67A\(1\)\(b\)](#).

(Amended 44 of 1991 s. 23)

[cf. 1938 c. 22 s. 8 U.K.]

Section 35

No action for infringement of unregistered trade mark

No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.

[cf. 1938 c. 22 s. 2 U.K.]

Section 36

“Passing off” action

Nothing in this Ordinance contained shall be deemed to affect rights of action against any person for passing off or the remedies in respect thereof.

(Amended 44 of 1991 s. 24)

[cf. 1938 c. 22 s. 2 U.K.]

Section 37

Removal from register and imposition of limitations on ground of non-use

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

USE AND NON-USE OF TRADE MARKS

(1) Subject to the provisions of [sections 55\(1\)](#), [55A\(1\)](#) and [57\(1\)](#), a registered trade mark may be taken off the register in respect of any of the goods or services in respect of which it is registered on application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of [section 80](#), to the Registrar, on the ground either-

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, if it was registered under [section 18\(1\)](#), by the corporation or registered user concerned, and that there has in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of 5 years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being. (Amended 44 of 1991 s. 52)

(IA) Subject to [subsection \(1C\)](#), the tribunal may refuse an application made under [subsection \(1\)\(a\)](#) or [\(b\)](#) in relation to any goods if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by the proprietor thereof for the time being in relation to-

- (a) goods of the same description; or
- (b) services associated with those goods or goods of that description, being goods or, as the case may be, services in respect of which the trade mark is registered.

(1B) Subject to [subsection \(1C\)](#), the tribunal may refuse an application made under [subsection \(1\)\(a\)](#) or [\(b\)](#) in relation to any services if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by the proprietor thereof for the time being in relation to-

- (a) services of the same description; or
- (b) goods associated with those services or services of that description, being services or, as the case may be, goods in respect of which the trade mark is registered.

(1C) [Subsections \(1A\)](#) and [\(1B\)](#) do not apply where the applicant has been permitted under [section 22](#) to register an identical or nearly resembling trade mark in respect of the goods or services in question or where the tribunal is of the opinion that he might properly be permitted so to register such a trade mark.

(2) Where in relation to any goods in respect of which a trade mark is registered-

- (a) the matters referred to in [subsection \(1\)\(b\)](#) are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in Hong Kong (otherwise than for export from Hong Kong), or in relation to goods to be exported to a particular market outside Hong Kong; and
- (b) a person has been permitted under [section 22](#) to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in Hong Kong (otherwise than for export from Hong Kong), or in relation to goods to be exported to that market, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the Court or, at the option of the applicant and subject to the provisions of [section 80](#), to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as the tribunal thinks proper for securing that that registration shall cease to extend to such use as last aforesaid. (Amended 44 of 1991 s. 54)

(2A) Where in relation to any services in respect of which a trade mark is registered-

- (a) the matters referred to in [subsection \(1\)\(b\)](#) are shown so far as regards non-use of the trademark in relation to services for use or available for acceptance in Hong Kong, or for use in a country, territory or place outside Hong Kong; and
- (b) a person has been permitted under [section 22](#) to register an identical or nearly resembling trade mark in respect of those services under a registration extending to use in relation to services for use or available for acceptance in Hong Kong or for use in that country, territory or place, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the Court or, at the option of the applicant and subject to [section 80](#), to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as the tribunal thinks proper for securing that the registration shall cease to extend to such use as last aforesaid. (Added 44 of 1991 s. 25. Amended 22 of 1999 s. 3)

(3) An applicant shall not be entitled to rely for the purposes of [subsection \(1\)\(b\)](#), [\(2\)](#) or [\(2A\)](#) on any non-use of a trade mark-

- (a) in relation to particular goods that is shown to have been due to special circumstances in the trade; or
- (b) in relation to particular services that is shown to have been due to special circumstances affecting the provision of those services, and not to any intention not to use or to abandon the trade mark in relation to the goods or services to which the application relates. (Replaced 44 of 1991 s. 25)

[cf. 1938 c. 22 s. 26 U.K.]

Section 38

Use of one of associated trade marks equivalent to use of another

(1) Where under the provisions of this Ordinance use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as the tribunal thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Ordinance be deemed to be also use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of [section 25\(1\)](#).

[cf. 1938 c. 22 s. 30 U.K.]

Section 39

Use of trade mark for export trade constitutes use of the trade mark

(1) The application in Hong Kong of a trade mark to goods to be exported from Hong Kong, and any other act done in Hong Kong in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Hong Kong, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Ordinance or at common law. (Amended 44 of 1991 s. 54) [cf. 1938 c. 22 s. 31 U.K.]

(1 A) Any act done in Hong Kong in relation to services for use outside Hong Kong which, if done in relation to services provided within Hong Kong for use there, would constitute use of a trade mark in Hong Kong, shall be deemed to constitute use of the trade mark in relation to those services for any purpose for which such use is material under this Ordinance or at common law. (Added 44 of 1991 s. 26)

(2) [Subsection \(1\)](#) shall be deemed to have effect in relation to an act done before, as it has effect in relation to an act done after, the commencement of this Ordinance. [cf. 1938 c. 22 THIRD SCHEDULE Para. 6 U.K.]

Section 40

Use of trade mark after change in form of trade connection

(1) The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of

connection in the the course of trade subsisted or subsists. (Amended 44 of 1991 s. 27) [cf. 1938 c. 22 s. 62 U.K.]

(2) The use of a registered trade mark in relation to services between the provision of which and the person using it any form of connection in the course of business subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to services between the provision of which and that person or a predecessor in title of his a different form of connection in the course of business subsisted or subsists. (Amended 44 of 1991 s. 27)

Section 41

Powers of, and restrictions on, assignment and transmission of trade marks

ASSIGNMENT AND TRANSMISSION

(1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark relating to goods shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not. (Amended 44 of 1991 s. 53)

(2) A registered trade mark relating to goods shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods or services in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods. (Amended 44 of 1991 s. 53)

(3) The provisions of [subsections \(1\)](#) and [\(2\)](#) shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in [subsections \(1\)](#), [\(2\)](#) and [\(3\)](#), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to-

- (a) the same goods;
- (b) the same description of goods; or
- (c) goods and services or descriptions of goods and services which are associated with each other, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods or the association of the goods and services or descriptions of goods and services, and to the similarity of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be

exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within Hong Kong (otherwise than for export therefrom), or in relation to goods to be exported to the same market outside Hong Kong. (Amended 44 of 1991 ss. 28 & 54)

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods or the association of the goods and services or descriptions of goods and services and to the similarity of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under [subsection \(4\)](#), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under [subsection \(4\)](#) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under [section 43](#) of the title of the person becoming entitled is made within 6 months from the date on which the certificate is issued. (Amended 44 of 1991 s. 28)

(6) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made on or after the commencement of this Ordinance otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of 6 months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

(7) Any decision of the Registrar under this section shall be subject to appeal to the Court.

[cf. 1938 c. 22 s. 22 U.K.]

Section 41A

Assignment and transmission of trade marks relating to services

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

(1) A registered trade mark relating to services shall be assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark relating to services shall be assignable and transmissible in respect either of all the services in respect of which it is registered, or of some (but not all) of those services.

(3) The provisions of [subsections \(1\)](#) and [\(2\)](#) shall have effect in the case of an unregistered trade mark used in relation to any services as they have effect in the case of a registered trade mark registered in respect of any services, if at the time of the assignment or transmission of the unregistered trade mark it is used in the same business as a registered trade mark, and if it is assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of services all of which are services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in [subsections \(1\), \(2\) and \(3\)](#), a trade mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to-

- (a) the same services;
- (b) the same description of services; or
- (c) services and goods or descriptions of services and goods which are associated with each other,

of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the services or the association of the goods and services or descriptions of goods and services, and to the similarity of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion:

Provided that, where a trade mark is assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed on them, such as not to be exercisable by two or more of those persons in relation to services for use in Hong Kong, in relation to services for use in the same country, territory or place outside Hong Kong or in relation to services available for acceptance in Hong Kong (wherever they are to be used). (Amended 22 of 1999 s. 3)

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any of the services in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the services or the association of the services and goods or descriptions of services and goods and to the similarity of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under [subsection \(4\)](#), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under [subsection \(4\)](#) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under [section 43](#) of the title of the person becoming entitled is made within 6 months from the date on which the certificate is issued.

(6) Where an assignment in respect of any services of a trade mark that is at the time of the assignment used in a business of providing those services is made otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of 6 months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

(7) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(Added 44 of 1991 s. 29)

Section 42

Power of registered proprietor to assign, and give receipts

Subject to the provisions of this Ordinance, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment.

[cf. 1938 c. 22 s. 24 U.K.]

Section 43

Registration of assignments and transmissions

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register. (Amended 44 of 1991 s. 52)

(2) Any decision of the Registrar under this section shall be subject to appeal to the Court. (Amended L.N. 294 of 1988)

(3) Except for the purposes of an appeal under this section or of an application under [section 48](#), a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of [subsection \(1\)](#) shall not be admitted in evidence in any Court in proof of the title to a trade mark unless the Court otherwise directs.

[cf. 1938 c. 22 s. 25 U.K.]

Section 44

Assignments and transmissions of associated trade marks

Trade marks that are registered as, or that are deemed by virtue of this Ordinance to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

[cf. 1938 c. 22 s. 23(1) U.K.]

Section 45

Renewal of registration

RENEWAL OF REGISTRATION

The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of 14 years from the date of expiration of the original registration as stated in [section 17\(2\)](#) or of the last renewal of registration, as the case may be, which date is hereinafter referred to as "the expiration of the last registration".

[cf. 1938 c. 22 s. 20(2) U.K.]

Section 46

Procedure on expiry of period of registration

At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

[cf. 1938 c. 22 s. 20(3) U.K.]

Section 47 **Status of unrenewed trade mark**

Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for registration of a trade mark during one year next after the date of such removal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this section shall not have effect when the Registrar is satisfied either-

- (a) that, in the case of a trade mark that was before removal registered in respect of goods, there has been no bona fide trade use of the trade mark during the 2 years immediately preceding its removal; or (Amended 44 of 1991 s. 30)
- (b) that, in the case of a trade mark that was before removal registered in respect of services, there has been no bona fide business use of the trade mark during the 2 years immediately preceding its removal; or (Amended 44 of 1991 s. 30)
- (c) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed. (Amended 44 of 1991 s. 30)

[cf. 1938 c. 22 s. 20(4) U.K.]

Section 48 **General power to rectify entries in register**

RECTIFICATION AND CORRECTION OF REGISTER

(1) Subject to the provisions of this Ordinance-

- (a) any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of [section 80](#), to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think fit;
- (b) the tribunal may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register;
- (c) in case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section;

- (d) any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(2) The power to rectify the register conferred by this section shall include power to remove a registration in **Part A** of the register to **Part B**.

[cf. 1938 c. 22 s. 32 U.K.]

Section 49

Power to expunge or vary registration for breach of condition

On application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of [section 80](#), to the Registrar, or on application by the Registrar to the Court, the tribunal may make such order as the tribunal may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

[cf. 1938 c. 22 s. 33 U.K.]

Section 50

Correction of register

- (1) The Registrar may, on request made in the prescribed manner by the registered proprietor-
- (a) correct any error in the name and address of the registered proprietor of a trade mark; or
 - (b) enter any change in the name and address of the person who is registered as proprietor of a trade mark; or
 - (c) cancel the entry of a trade mark on the register; or
 - (d) strike out any goods or services or classes of goods or services from those in respect of which a trade mark is registered; or (Amended 44 of 1991 s. 52)
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

(2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name and address of the registered user.

(3) Any decision of the Registrar under this section shall be subject to appeal to the Court. (Amended 44 of 1991 s. 31)

[cf. 1938 c. 22 s. 34 U.K.]

Section 51

Alteration of registered trade mark

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse such leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under [subsection \(2\)](#).

[cf. 1938 c. 22 s. 35 U.K.]

Section 52

Words used as name or description of an article or substance

(1) The registration of a trade mark relating to goods shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance: (Amended 44 of 1991 s. 53)

Provided that, if it is proved either-

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent, that a period of 2 years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance, the provisions of [subsection \(2\)](#) shall have effect.

(2) Where the facts mentioned in [paragraph \(a\)](#) or [\(b\)](#) of the proviso to [subsection \(1\)](#) are proved with respect to any word or words, then-

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of [section 48](#) to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark-

- (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or (Amended 44 of 1991 s. 32)
- (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in [paragraph \(a\)](#) of the proviso to [subsection \(1\)](#) first became well-known and established, or at the expiration of 2 years mentioned in [paragraph \(b\)](#) of that proviso.

[cf. 1938 c. 22 s. 15(1) & (2) U.K.]

Section 52A

Words used as name or description of an activity

(1) The registration of a trade mark relating to services shall not be deemed to have become invalid by reason only of any use, after the date of registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of some activity:

Provided that, if it is proved that there is a well-known and established use of the word or words as the name or description of some activity by a person or persons providing services which include that activity, not being use in relation to services with the provision of which the proprietor or a registered user of the trade mark is connected in the course of business, the provisions of [subsection \(2\)](#) shall have effect.

(2) Where the facts mentioned in the proviso to [subsection \(1\)](#) are proved with respect to any word or words, then-

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the activity in question, shall be deemed for the purposes of [section 48](#) to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the activity in question, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that activity of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark-
 - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the activity in question; or
 - (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in the proviso to [subsection \(1\)](#) first became well-known and established.

(Added 44 of 1991 s. 33)

Section 53

Removal of trade mark from register on proof of prior registration in country of origin

(1) Subject to [subsection \(3\)](#), the Court may, on application in writing within 7 years from the registration in Hong Kong of a trade mark relating to goods by any person aggrieved by such registration, remove such trade mark from the register if it is proved to the satisfaction of the Court that such trade mark is identical with or nearly resembles a trade mark which was, prior to the registration in Hong Kong of the first-mentioned trade mark, registered in respect of-

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description,

in a country or place from which such goods originate.

(2) Subject to [subsection \(3\)](#), the Court may, on application in writing made within 7 years from the registration in Hong Kong of a trade mark relating to services by any person aggrieved by such registration, remove such trade mark from the register if it is proved to the satisfaction of the Court that such trade mark is identical with or nearly resembles a trade mark which was, prior to the registration in Hong Kong of the first-mentioned trade mark, registered in respect of-

- (a) the same services;
- (b) the same description of services; or
- (c) goods or a description of goods which are associated with those services or services of that description,

in a country or place from which such services originate.

(3) No trade mark shall be removed from the register under this section in the following cases-

- (a) if the proprietor of the other trade mark consented to the registration in Hong Kong of the first-mentioned trade mark; or
- (b) if the proprietor of the trade mark registered in Hong Kong proves that he or his predecessors in business have continuously used such trade mark in Hong Kong in connection with such goods or services (as the case may be) from a date anterior to the date of the registration of the other trade mark in the country or place of origin; or
- (c) if the applicant does not prove-
 - (i) that within the 5 years immediately preceding the making of the application under this section there has been bona fide user in connection with such goods or services (as the case may be) in Hong Kong of the trade mark registered in the country or place of origin; or

- (ii) that the special circumstances of the trade or affecting the provision of such services (as the case may be) account for the non-user of such trade mark in Hong Kong within the same period; or
- (iii) that the trade mark so registered in the country or place of origin was first registered there within the like period of 5 years,

and does not give an undertaking to the satisfaction of the Registrar that he will within 3 months from the making of the application under this section apply for registration in Hong Kong of the trade mark so registered in the country or place of origin, and will take all necessary steps to complete the registration.

(Replaced 44 of 1991 s. 34)

Section 54

Adaptation of entries in register to amended or substituted classification of goods

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

(1) The Chief Executive in Council may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or services or classes of goods or services in respect of which trade marks are registered to any amended or substituted classification that may be prescribed. (Amended 44 of 1991 s. 52; 22 of 1999 s. 3)

(2) The Registrar shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or services or classes of goods or services to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods or services:

Provided that this subsection shall not have effect in relation to goods or services as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods or services and would not substantially prejudice the rights of any person. (Amended 44 of 1991 s. 52)

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the Court, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of [subsection \(2\)](#). The decision of the Registrar on any such opposition shall be subject to appeal to the Court.

[cf. 1938 c. 22 s. 36 U.K.]

Section 55

Defensive registration of trade marks

DEFENSIVE TRADE MARKS

(1) Where a trade mark relating to goods and consisting of an invented word or invented words, or a device or devices, or a combination of them, has become so exceptionally well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods or to services, or both, would be likely to detract from its distinctive character in respect of the first-mentioned goods, then, notwithstanding-

- (a) that such use would not be likely to be taken as indicating a connection in the course of trade between those other goods or those services, or both, as the case may be, and a person entitled to use the trade mark in relation to the first-mentioned goods; and
- (b) that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods or those services, or both, as the case may be,

and notwithstanding anything in [section 37](#), the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods or those services, or both, as the case may be, as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those other goods or those services, or both, as the case may be, under [section 37](#). (Amended 44 of 1991 s. 35)

(1A) In determining whether a trade mark relating to goods is exceptionally well known and whether its use in relation to other goods or to services, or both, would be likely to detract from its distinctive character in respect of the goods for which it is registered, the tribunal shall have regard to all related circumstances, including the length of time the trade mark has been in use, the extent to which it has become well known in relation to the goods in respect of which it is registered, the nature of those goods, and whether the notoriety of the mark is limited because of its use on goods that are not of wide distribution. (Amended 44 of 1991 s. 35)

(2) The registered proprietor of a trade mark relating to goods may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration. (Amended 44 of 1991 s. 53)

(3) Except as otherwise expressly provided in this section and in [sections 56](#) and [57](#), the provisions of this Ordinance shall apply in respect of the registration of trade marks relating to goods as defensive trade marks and of trade marks so registered as they apply in other cases. (Amended 44 of 1991 s. 35)

[cf. 1938 c. 22 s. 27(1), (2) & (6) U.K.]

Section 55A

Defensive registration of trade marks relating to services

(1) Where a trade mark relating to services and consisting of an invented word or invented words, or a device or devices, or a combination of them, has become so exceptionally well known as respects any services in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other services or to goods, or both, would be likely to detract from its distinctive character in respect of the first-mentioned services, then, notwithstanding-

- (a) that such use would not be likely to be taken as indicating a connection in the course of business between the provision of those other services or those goods, or both, as the case may be, and a person entitled to use the trade mark in relation to the first-mentioned services; and
- (b) that the proprietor registered in respect of the first-mentioned services does not use or propose to use the trade mark in relation to those other services or those goods, or both, as the case may be, and notwithstanding anything in [section 37](#), the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned services, be registered in his name in respect of those other services or those goods, or both, as the case may be, as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those other services or those goods, or both, as the case may be, under [section 37](#).

(2) In determining whether a trade mark relating to services is exceptionally well known and whether its use in relation to other services or to goods, or both, would be likely to detract from its distinctive character in respect of the services for which it is registered, the tribunal shall have regard to all related circumstances, including the length of time the trade mark has been in use, the extent to which it has become well known in relation to the services in respect of which it is registered, the nature of those services, and whether the notoriety of the mark is limited because of its use in relation to services that are not widely available.

(3) The registered proprietor of a trade mark relating to services may apply for the registration thereof in respect of any services as a defensive trade mark notwithstanding that it is already registered in his name in respect of those services otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any services otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those services as a defensive trade mark, in lieu in each case of the existing registration.

(4) Except as otherwise expressly provided in this section and [sections 56](#) and [57](#), this Ordinance applies in respect of the registration of trade marks relating to services as defensive trade marks and of trade marks so registered as they apply in other cases.

(Added 44 of 1991 s. 36)

Section 56

Defensive trade marks to be registered as associated trade marks

A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods or services, be deemed to be, and shall be registered as, associated trade marks. (Amended 44 of 1991 s. 52)

[cf. 1938 c. 22 s. 27(3) U.K.]

Section 57

Removal of defensive trade marks from the register

(1) On application by any person aggrieved to the Court or, at the option of the applicant and subject to [section 80](#), to the Registrar,-

- (a) the registration under [section 55\(1\)](#) of a trade mark as a defensive trade mark may be cancelled-

- (i) on the ground that the requirements of [section 55\(1\)](#) are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark; or
- (ii) as respects any goods or services in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods or services would detract from its distinctive character in respect of the goods first-mentioned in [section 55\(1\)](#);
- (b) the registration under [section 55A\(1\)](#) of a trade mark as a defensive trade mark may be cancelled-
 - (i) on the ground that the requirements of [section 55A\(1\)](#) are no longer satisfied in respect of any services in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark; or
 - (ii) as respects any services or goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those services or goods would detract from its distinctive character in respect of the services first-mentioned in [section 55A\(1\)](#).

(2) The Registrar may at any time cancel the registration as a defensive trade mark in respect of goods or services, or both, of a trade mark of which there is no longer any registration either in respect of goods or services in the name of the same proprietor otherwise than as a defensive trade mark.

(Replaced 44 of 1991 s. 37)

Section 58

Registration as a registered user. Meaning of "permitted use"

Expanded Cross Reference:

[59](#), [60](#), [61](#), [62](#), [63](#)

REGISTERED USERS

- (1)
 - (a) Subject to the provisions of this section and [sections 59 to 63](#), a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions. (Amended 44 of 1991 s. 52)
 - (b) The use of a trade mark by a registered user of the trade mark in relation to-
 - (i) goods with which he is connected in the course of trade; or
 - (ii) services with the provision of which he is connected in the course of business, and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Ordinance referred to as the "permitted use" of the trade mark. (Replaced 44 of 1991 s. 38)
- (2)

- (a) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of [section 37](#) and for any other purpose for which such use is material under this Ordinance or at common law.
- (b) Where a person is registered as a registered user of a trade mark relating to goods on an application made within one year from the commencement of this Ordinance, this subsection shall have effect in relation to any previous use (whether before or after the commencement of this Ordinance) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use. (Amended 44 of 1991 s. 53)

(3) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner, and must furnish him with a statutory declaration made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar-

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods or services in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,

and with such further documents, information or evidence as may be required under the rules or by the Registrar. (Amended 44 of 1991 s. 52)

(4) When the requirements of [subsection \(3\)](#) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods or services as to which he is so satisfied subject as aforesaid. (Amended 44 of 1991 s.52)

(5) The Registrar shall refuse an application under the provisions of [subsections \(1\) to \(3\)](#) if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(6) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the provisions of [subsections \(1\) to \(3\)](#) (other than matter entered in the register) is not disclosed-

- (a) in the case of an application for registration in respect of goods, to rivals in the trade; or
- (b) in the case of an application for registration in respect of services, to rivals in the business. (Amended 44 of 1991 s. 38)

[cf. 1938 c. 22 s. 28(1) , (2) ,(4) to (7) U.K.]

Section 59 Proceedings for infringement

(1) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within 2 months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(2) A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

[cf. 1938 c. 22 s. 28(3) U.K.]

Section 60 Variation or cancellation of registration as a registered user

(1) Without prejudice to the provisions of [section 48](#), the registration of a person as a registered user-

- (a) may be varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates; (Amended 44 of 1991 s. 52)
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say-
 - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
 - (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration; or
 - (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(2) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered. (Amended 44 of 1991 s. 52)

[cf. 1938 c. 22 s. 28(8) & (10) U.K.]

Section 61 Notification of registration as registered user and of application for variation or cancellation of such registration

Provision shall be made by the rules for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under [section 60](#) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

[cf. 1938 c. 22 s. 28(9) U.K.]

Section 62

Registrar's decision subject to appeal to Court

Any decision of the Registrar under [sections 58](#) and [60](#) shall be subject to appeal to the Court.

[cf. 1938 c. 22 s. 28(11) U.K.]

Section 63

Right to use not assignable or transmissible

Nothing in [sections 58](#), [59](#) and [60](#) shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

[cf. 1938 c. 22 s. 28(12) U.K.]

Section 64

Marks registrable as certification trade marks

CERTIFICATION TRADE MARKS

(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in **Part A** of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(IA) A mark adapted in relation to any services to distinguish in the course of business services certified by any person in respect of quality, accuracy or other characteristic, from services not so certified, shall be registrable as a certification trade mark in Part A of the register in respect of those services in the name, as proprietor of the certification trade mark, of that person:

Provided that a mark shall not be so registrable in the name of a person who is connected in the course of business with the provision of services of the kind certified. (Added 44 of 1991 s. 39)

(2) In determining whether a mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which-

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods or services in question; and

(b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods or services in question. (Amended 44 of 1991 s. 52)

(3) The fact that a mark consists of signs or indications which may serve, in trade, to designate the geographical origin of goods or services shall not preclude it from being registered as a certification trade mark in **Part A** of the register in respect of those goods or services. (Added 11 of 1996 s. 23)

(4) Nothing in this Ordinance shall entitle the proprietor of a certification trade mark that consists of signs or indications described in [subsection \(3\)](#) to interfere with or restrain the use by any person of any signs or indications the use of which is in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name). (Added 11 of 1996 s. 23)

[cf. 1938 c. 22 s. 37(1) & (2) U.K.]

Section 65

Application for registration as certification trade mark.

Expanded Cross Reference:

[13\(4\)](#), [\(5\)](#), [\(6\)](#), [\(7\)](#)

(1) An application for the registration of a mark under [section 64](#) shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of [section 13\(2\)](#) and of [section 13\(4\) to \(7\)](#) shall have effect in relation to an application under this section as they have effect in relation to an application under [section 13\(1\)](#).

(3) In dealing under the said provisions with an application under this section the tribunal shall have regard to the like considerations, so far as relevant, as if the application were an application under [section 13](#) and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under this section shall transmit to the Registrar draft regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorize the the use of the trade mark, and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorize the use of the trade mark in accordance with the regulations). The regulations, if approved, shall be deposited with the Registrar and shall be open to inspection in like manner as the register. (Amended 44 of 1991 ss. 40 & 52) [cf. 1938 c. 22 s. 37(7) U.K.]

(5) The Registrar shall consider the application with regard to the following matters-

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered; (Amended 44 of 1991 s. 52)
- (b) whether the draft regulations are satisfactory; and

- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either-

- (i) refuse to accept the application; or
- (ii) accept the application, and approve the regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he may think requisite having regard to any of the matters aforesaid;

but, except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard:

Provided that the Registrar may, at the request of the applicant, consider the application with regard to any of the matters aforesaid before the application has been accepted, so however that the Registrar shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment modification is thereafter made in the application or in the draft regulations.

- (6) Any decision of the Registrar under this section shall be subject to appeal to the Court.

[cf. 1938 c. 22 FIRST SCHEDULE Para 1 U.K.:]

Section 66

Advertisement of application. Opposition to registration

(1) When an application for the registration of a certification trade mark has been accepted, whether absolutely or subject to conditions and limitations, the Registrar shall require the applicant to advertise it, as accepted, in the prescribed manner, and the provisions of [section 15](#) shall have effect in relation to the registration of the mark as if the application had been an application under [section 13](#):

Provided that, in deciding under the said provisions, the Registrar shall have regard only to the considerations referred to in [section 65\(3\)](#), and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Registrar under [subsection \(2\)](#) of any opposition relating to any of the matters referred to in [section 65\(5\)](#).

(2) When notice of opposition is given relating to any of the matters referred to in [section 65\(5\)](#), the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions and limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

[cf. 1938 c. 22 FIRST SCHEDULE Para. 2 U.K.]

Section: 67

Heading: Right given by registration in respect of goods, and infringement thereof

(1) Subject to the provisions of [subsections \(2\) to \(4\)](#) hereof, and of [sections 33](#) and [34](#), the registration of a person as proprietor of a certification trade mark in respect of any goods, shall, if

valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations in that behalf using it in accordance therewith, uses in the course of trade, a mark identical with it or nearly resembling it, in relation to any goods in respect of which it is registered, or in relation to goods of the same description where such use would result in a likelihood of confusion, and in such manner as to render the use of the mark likely to be taken either- (Amended 44 of 1991 s. 41; 11 of 1996 s. 24)

- (a) as being use as a trade mark relating to goods; or (Amended 44 of 1991 s. 53)
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorization under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(2) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person-

- a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorization under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that [paragraph \(a\)](#) hereof shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(4) Where a certification trade mark relating to goods is one of 2 or more registered trade marks relating to goods which are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks. (Amended 44 of 1991 ss. 41 & 53)

[cf. 1938 c. 22 s. 37(3) to (6) U.K.]

Section 67A

Right given by registration in respect of services, and infringement thereof

(1) Subject to the provisions of [subsections \(2\) to \(4\)](#) and of [sections 33](#) and [34](#), the registration of a person as proprietor of a certification trade mark in respect of any services, shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those services, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations in that behalf using it in accordance therewith, uses in connection with the provision of any services a mark identical with or nearly resembling it, in relation to any services in respect of which it is registered, or in relation to services of the same description where such use would result in a likelihood of confusion, and in such manner as to render the use of the mark likely to be taken either- (Amended I 1 of 1996 s. 25)

- (a) as being use as a trade mark relating to services; or
- (b) in a case in which the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having a right either as proprietor or by his authorization under the relevant regulations to use the mark or to services certified by the proprietor.

(2) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to services for use or available for acceptance in any place, country or territory, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person-

- a) in relation to services to which the proprietor of the mark or another in accordance with his authorization under the relevant regulations has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been certified by the proprietor; or
- (b) in relation to services certified by the proprietor of the mark where the proprietor has at any time expressly or impliedly consented to the use of the mark; or (c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if-
 - (i) the use of the mark is reasonably necessary in order to indicate that the services are available for such use; and
 - (ii) neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the services are certified by the proprietor:

Provided that [paragraph \(a\)](#) hereof shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any services, notwithstanding that they are such services as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(4) Where a certification trade mark relating to services is one of 2 or more registered trade marks relating to services which are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks. (Added 44 of 1991 s. 42)

Section 68

Alteration of deposited regulations, or expunging or varying of entry in register relating to certification trade mark

- (1)
 - (a) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.
 - (b) The Registrar may, before granting an application, cause it to be advertised in any case where it appears to him that it is expedient so to do, and, where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.
- (2)
 - (a) On application by any person aggrieved to the Court, or at the option of the applicant and in the prescribed manner and subject to the provisions of [section 80](#), to the Registrar, or on application by the Registrar to the Court, the tribunal may make such order as the tribunal thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground-
 - (i) that the proprietor is no longer competent, in the case of any of the goods or services in respect of which the trade mark is registered, to certify those goods or services;
 - (ii) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
 - (iii) that it is no longer to the public advantage that the trade mark should be registered; or
 - (iv) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied. (Amended 44 of 1991 s. 52)
 - (b) The Registrar shall rectify the register or the deposited regulations in such manner as may be requisite for giving effect to an order made under [paragraph \(a\)](#) hereof.

[cf. 1938 c. 22 FIRST SCHEDULE Para. 3 & 4 U.K.]

Section 69

Certification trade mark assignable or transmissible only with Registrar's consent

- (1) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Registrar, who before giving his decision shall consider-
 - (a) in the case of a mark registered in respect of goods, whether the person to whom it is proposed to assign or transmit the mark is competent to certify the goods in respect of which the mark is registered; and

- (aa) in the case of a mark registered in respect of services, whether the person to whom it is proposed to assign or transmit the mark is competent to certify the services in respect of which the mark is registered; and (Added 44 of 1991 s. 43)
- (b) whether in all the circumstances the proposed assignment or transmission would be to the public advantage.
- (2) A certification trade mark registered in respect of goods shall not be assignable or transmissible to a person who carries on a trade in goods of the kind certified.
- (2A) A certification trade mark registered in respect of services shall not be assignable or transmissible to a person who is connected in the course of business with the provision of services of the kind certified. (Added 44 of 1991 s. 43)
- (3) Any decision of the Registrar under this section shall be subject to appeal to the Court. (Amended 44 of 1991 s. 43)

[cf. 1938 c. 22 s. 37(8) U.K.]

Section 70

Registrar not empowered to award costs on appeals to him

Notwithstanding anything in [section 82](#), the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or services or to authorize the use of the trade mark. (Amended 44 of 1991 s. 52)

[cf. 1938 c. 22 FIRST SCHEDULE Para. 5 U.K.]

Section 71

Provisions not applicable to certification trade marks

Expanded Cross Reference:

[13](#), [14](#), [15](#), [41\(4\)](#), [41\(5\)](#), [41\(6\)](#), [41\(7\)](#), [41A\(4\)](#), [41A\(5\)](#), [41A\(6\)](#), [55](#), [56](#), [57](#), [58](#), [59](#), [60](#), [61](#), [62](#), [63](#)

The following provisions of this Ordinance shall not have effect in relation to a certification trade mark, that is to say, [section 9](#), [sections 13 to 15](#) (except as expressly applied by [sections 65](#) and [66](#)), [sections 19](#), [27](#), [27A](#), [32](#), [37](#), [40](#), [41\(4\) to \(7\)](#), [41A\(4\) to \(6\)](#), [55](#), [55A](#), and [56 to 63](#), and any provisions the operation of which is limited by the terms thereof to registration in **Part B** of the register.

(Amended 44 of 1991 s. 44)

[cf. 1938 c. 22 FIRST SCHEDULE Para. 6 U.K.]

Section 72

Trade mark registered under section 59 of Trade Marks Ordinance 1909 (40 of 1909 See 43 1950 Ed.), to be deemed registered as a certification trade mark under this Ordinance

Expanded Cross Reference:

[64](#), [65](#), [66](#), [67](#), [68](#), [69](#), [70](#), [71](#)

[Sections 64 to 71](#) shall have effect, in relation to a trade mark that immediately before the commencement of this Ordinance was on the register by virtue of [section 59](#) of the Trade Marks Ordinance 1909 (40 of 1909 See Cap 43 1950 Ed.), as if the sections had been in force at the date of the registration of the trade mark and it had been registered under those sections, subject however to the following modifications, that is to say-

- (a) that the proviso to [section 64\(1\)](#) shall not apply;
- (b) that [sections 64 to 71](#) shall have effect as if references therein to the regulations governing the use of certification trade marks had been omitted; and
- (c) that the proprietor shall be at liberty, or may be required by the Registrar as a condition of the continuance of the registration, to deposit at any time after the commencement of this Ordinance such regulations as the Registrar may permit or require.

[cf 1938 c. 22 THIRD SCHEDULE Para. 7 U.K.]

Section 73

Preliminary advice by Registrar as to distinctiveness

POWERS AND DUTIES OF REGISTRAR

(1) The power to give to a person who proposes to apply for the registration of a trade mark in [Part A](#) or [Part B](#) of the register advice as to whether the trade mark appears to the Registrar prima facie to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Ordinance.

(2) Any person who is desirous of obtaining advice as aforesaid shall make application to the Registrar in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within 3 months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid for the filing of the application.

[cf. 1938 c. 22 s. 42 U.K.]

Section 74

Hearing before exercise of discretionary power of Registrar

Where any discretionary or other power is given to the Registrar by this Ordinance or by the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

[cf. 1938 c. 22 s. 43 U.K.]

Section 75

Certificate of validity Version

LEGAL PROCEEDINGS AND APPEALS

In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

[cf. 1938 c. 22 s. 47 U.K.]

Section 76 **Trade usage, etc., to be considered**

(1) In any action or proceeding relating to a trade mark relating to goods or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark relating to goods or trade name or get-up legitimately used by other persons. (Amended 44 of 1991 s. 45) [cf. 1938 c. 22 s. 49 U.K.]

(2) In any action relating to a trade mark relating to services or business name, the tribunal shall admit evidence of business usages in the provision of services in question and of any relevant trade mark relating to services or business name or get-up legitimately used by other persons. (Amended 44 of 1991 s. 45)

Section 77 **Registrar's appearance in proceedings involving rectification**

(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of his office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

[cf. 1938 c. 22 s. 50 U.K.]

Section 78 **Appeal from Registrar**

Except when expressly given by the provisions of this Ordinance or the rules there shall be no appeal from a decision of the Registrar, but the Court in dealing with any question of the rectification of the register (including all applications under the provisions of [section 48](#)) shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

[cf. 1938 c. 22 s. 51 U.K.]

Section 79

Appeal to Court of Appeal. Discretion of Court in appeals

(1) Every order of the Court shall be subject to appeal to the Court of Appeal. The appeal shall be commenced within 21 days from the time when the decision appealed against is pronounced or made. (Amended 92 of 1975 s.59)

(2) In any appeal from a decision of the Registrar to the Court under this Ordinance, the Court shall have and exercise the same discretionary powers as under this Ordinance are conferred upon the Registrar.

[cf. 1938 c. 22 s. 52 U.K.]

Section 80

Procedure in case of option to apply to Court or Registrar

Where under any of the provisions of this Ordinance an applicant has an option to make an application either to the Court or to the Registrar-

- (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

[cf. 1938 c. 22 s. 54 U.K.]

Section 81

Cost of proceedings before the Court

COSTS

In all proceedings before the Court under this Ordinance the Court may award to any party such costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

[cf. 1938 c. 22 s. 48 U.K.]

Section 82

Cost of proceedings before the Registrar

Save as otherwise provided in this Ordinance, in all proceedings before the Registrar, he shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.

[cf. 1938 c. 22 s. 44 U.K.]

Section 83

Mode of giving evidence

EVIDENCE

(1) In any proceeding under this Ordinance before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which he shall think it right to do so, he may take evidence viva voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a special referee appointed by the Court.

[cf. 1938 c. 22 s. 55 U.K.]

Section 84 Evidence of entries in Hong Kong

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

A printed or written copy of any entry in or extract from the register, purporting to be certified by the Registrar and sealed with his seal, shall be admitted in evidence in all Courts, and in all proceedings, without further proof or production of the original.

(Amended 44 of 1991 s. 46; 22 of 1999 s. 3)

[cf. 1938 c. 22 s. 57 U.K.]

Section 85 Evidence of entries made or of things done by Registrar

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

A certificate purporting to be under the hand of the Registrar, as to any entry, matter or thing which he is authorized to make or do, shall be prima facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

(Amended 22 of 1999 s. 3)

[cf. 1938 c. 22 s. 58 U.K.]

Section 86 Falsification of entries in register

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

OFFENCES

(Amended 22 of 1999 s. 3)

If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he commits an offence and is liable on conviction upon indictment to a fine of \$50000 and to imprisonment for 7 years.

(Amended 44 of 1991 s. 47)

[cf. 1938 c. 22 s. 59 U.K.]

Section 87

Falsely representing a trade mark as registered, etc.

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

(1) Any person who makes a representation-

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not registered; or (Amended 44 of 1991 s. 52)
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

shall be liable to a fine of \$500.

(2) For the purposes of this section, the use in Hong Kong in relation to a trade mark of the word "registered", or of any word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except-

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country or place outside Hong Kong, being a country or place under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word "registered") is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country or place outside Hong Kong and in relation to goods to be exported to that country or place or to services for use in that country or place. (Amended 44 of 1991 ss. 48 & 54; 22 of 1999 s. 3)

[cf. 1938 c. 22 s. 60 U.K.]

Section 88 (Repealed 22 of 1999 s. 3)

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

Section 89 Recognition of agents

AGENTS

Where by this Ordinance any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may, under and in accordance with the rules, or in particular cases by special leave of the Registrar, be done by or to an agent of that person duly authorized in the prescribed manner.

[cf. 1938 c. 22 s. 65 U.K.]

Section 90 Power of Chief Executive in Council to make rules

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

RULES

(1) The Chief Executive in Council may by rules prescribe or provide for- (Ameded 44 of 1991 s.50; 22 of 1999 s. 3)

- (a) regulating the practice under this Ordinance, including the service of documents;
- (b) classifying goods or services for the purposes of registration of trade marks; (Amended 44 of 1991 s. 52)
- (c) making or requiring duplicates of trade marks and other documents;
- (d) securing and regulating the publishing and selling or distributing, in such manner as the Chief Executive in Council may think fit, of copies of trade marks and other documents; (Ameded 22 of 1999 s. 3)
- (e) forms which shall be used for carrying out the provisions of this Ordinance;
- (f) fees which shall be paid in respect of applications and registrations and other matters under this Ordinance;
- (g) regulating the business of the registry in relation to trade marks and all things by this Ordinance placed under the direction or control of the Registrar;
- (h) generally, carrying into effect the provisions of this Ordinance. [cf. 1938 c. 22 s. 40 U.K.]

(2) Any rules made under [subsection \(1\)\(f\)](#) may-

- (a) prescribe fees fixed at; or

(b) provide for fees to be fixed at,

levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function. (Added 44 of 1991 s. 50)

Section 90A

Hours of business and excluded days

(1) Rules under [section 90](#) may specify the hour at which the registry shall be deemed to be closed on any day for the purposes of the transaction by the public of business under this Ordinance or of any class of such business, and may specify days as excluded days for any such purposes.

(2) Any business done under this Ordinance on any day after the hour so specified in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Ordinance expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

(Added 44 of 1991 s. 51)

[cf. 1938 c. 22 s. 40A U.K.]

Section 91

Validity of registrations under previous enactments

TRANSITIONAL PROVISIONS

(1) Nothing in this Ordinance shall be taken to invalidate the original registration of a trade mark that immediately before the commencement of this Ordinance was validly on the register.

(2) No trade mark which was on the register at the commencement of this Ordinance and which under this Ordinance is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Ordinance in force at the date of its registration.

(3) Nothing in this section shall be construed as having subjected any person to any liability in respect of any act or thing done before the commencement of this Ordinance to which he would not have been subject under the Ordinance then in force. (Amended L.N. 294 of 1988)

[cf. 1938 c. 22 s. 69 U.K.]

Section 92

Transitional provisions relating to the Intellectual Property (World Trade Organization Amendments) Ordinance 1996

(1) In this section-

"existing registered trade mark" means a trade mark, certification trade mark or defensive trade mark that is registered under this Ordinance before the commencement of the new law;

"new law" means [sections 18 to 25](#) of the Intellectual Property (World Trade Organization Amendments) Ordinance 1996 (11 of 1996);

"old law" means this Ordinance and any other enactment or rule of law applying to existing registered trade marks immediately before the commencement of the new law.

(2) An application for the registration of a trade mark (including certification trade marks and defensive trade marks), as defined in this Ordinance before the commencement of the new law, shall be treated as pending on the commencement of the new law if the application had been made but had not been finally determined before that commencement.

(3) [Sections 27\(1\)](#), [27A\(1\)](#), [67\(1\)](#) and [67A\(1\)](#), as amended by the new law, shall apply in relation to an existing registered trade mark as from the commencement of the new law but only in so far as those sections relate to an infringement of an existing registered trade mark that is committed on or after the commencement of the new law; and the old law shall continue to apply in relation to an infringement that is committed before the commencement of the new law.

(4) Despite [subsection \(3\)](#), it is not an infringement of-

- (a) an existing registered trade mark; or
- (b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered trade mark and which is registered for the same goods or services, to continue on or after the commencement of the new law any use that did not, under the old law, constitute an infringement of the existing registered trade mark.

(5) Subject to [subsection \(6\)](#), an application for the registration of a trade mark that is pending on the commencement of the new law shall be dealt with under the old law but, if the trade mark is registered, it shall be treated for the purposes of [subsections \(1\) to \(4\)](#) as an existing registered trade mark.

(6) If an application for the registration of a trade mark that is pending on the commencement of the new law has not been advertised under [section 14](#) before its commencement, the applicant may give notice to the Registrar electing to have the registrability of the mark determined in accordance with this Ordinance, as amended by the new law.

(7) A notice under [subsection \(6\)](#) must be in the prescribed form, be accompanied by the appropriate fee and be given to the Registrar not later than 6 months after the commencement of the new law.

(8) A notice given under [subsection \(6\)](#) is irrevocable and has the effect that the application shall be treated as if it had been made after the commencement of the new law.

(9) An application made under [section 48](#) that is pending on the commencement of the new law shall be dealt with in accordance with the old law.

(Added 1 I of 1996 s. 26)

Section 93 Savings

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

The amendments made to this Ordinance by the Adaptation of Laws (No. 8) Ordinance 1999 (22 of 1999) shall not affect the validity of, or the admissibility in evidence or evidentiary value of-

- (a) any printed or written copy of an entry in or extract from the register, purporting to be certified by the Registrar and sealed with the seal used by the Registrar before 1 July 1997;
- (b) any certificate purporting to be under the hand of the Registrar as to any entry, matter or thing which he is authorized to make or do, issued by the Registrar before 1 July 1997;
- (c) any other document sealed with the seal used by the Registrar before 1 July 1997;
- (d) any printed or written copy of an entry in or extract from the United Kingdom Register of Trade Marks, purporting to be certified by the Comptroller-General of the United Kingdom Patent Office and sealed with the seal of the United Kingdom Patent Office before 1 July 1997; or
- (e) any certificate purporting to be under the hand of the Comptroller-General of the United Kingdom Patent Office, as to any entry, matter or thing which he is authorized to make or do, issued by the Comptroller-General before 1 July 1997.

(Added 22 of 1999 s. 3)

Schedule 1 CONVENTION COUNTRIES

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

[section 13A]

Countries which have acceded to the Paris Convention
and countries, territories
and areas which have acceded to the
World Trade Organization Agreement
(excluding China)

(Amended 22 of 1999 s. 3)

Albania

Algeria

Angola (Added L.N. 342 of 1998)

Antigua and Barbuda

Argentina

Armenia

Australia

Austria

Azerbaijan

Bahamas

Bahrain

Bangladesh



Barbados
Belarus
Belgium
Belize
Benin
Bolivia
Bosnia and Herzegovina
Botswana
Brazil
Brunei Darussalam
Bulgaria
Burkina Faso
Burundi
Cambodia (Added L.N. 342 of 1998)
Cameroon
Canada
Central African Republic
Chad
Chile
Colombia
Congo
Costa Rica
Cote d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's Republic of Korea
Democratic Republic of Sao Tome and Principe (Added L.N. 342 of 1998)
Democratic Republic of the Congo (Added L.N. 342 of 1998)
Denmark
Djibouti
Dominica
Dominican Republic
Ecuador



Egypt
El Salvador
Estonia
European Community (Added L.N. 342 of 1998)
Fiji
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea
Guinea Bissau
Guyana
Haiti
Holy See
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Iraq
Ireland
Israel
Italy
Jamaica
Japan
Jordan
Kazakhstan (Added L.N. 342 of 1998)
Kenya



Kuwait
Kyrgyzstan
Latvia
Lebanon
Lesotho
Liberia
Libya
Liechtenstein
Lithuania
Luxembourg
Macau
Madagascar
Malawi
Malaysia
Maldives
Mali
Malta
Mauritania
Mauritius
Mexico
Monaco
Mongolia
Morocco
Myanmar
Namibia
Netherlands-For the Kingdom in Europe and for the Netherlands Antilles
New Zealand
Nicaragua
Niger
Nigeria
Norway
Pakistan
Panama (Added L.N. 342 of 1998)
Papua New Guinea (Added L.N. 342 of 1998)
Paraguay



Peru
Philippines
Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Republic of Mozambique (Added L.N. 342 of 1998)
Romania
Russian Federation
Rwanda
Saint Kitts and Nevis
Saint Lucia
Saint Vincent and the Grenadines
San Marino
Senegal
Sierra Leone
Singapore
Slovak Republic
Slovenia
Solomon Islands (Added L.N. 342 of 1998)
South Africa
Spain
Sri Lanka
Sudan
Suriname
Swaziland
Sweden
Switzerland
Syria
Tajikistan
Thailand
The former Yugoslav Republic of Macedonia
Togo
Trinidad and Tobago



Tunisia

Turkey

Turkmenistan

Uganda

Ukraine

United Arab Emirates

United Kingdom (Added 22 of 1999 s. 3)

United Republic of Tanzania (Added L.N. 342 of 1998)

United States of America

Uruguay

Uzbekistan

Venezuela

Viet Nam

Yugoslavia

Zambia

Zimbabwe

(Replaced L.N. 314 of 1996. Amended L.N. 342 of 1998; 22 of 1999 s. 3)