



Hong Kong

Trademark Application

**Hong Kong Trademark & Design
Protection Agency Ltd.**

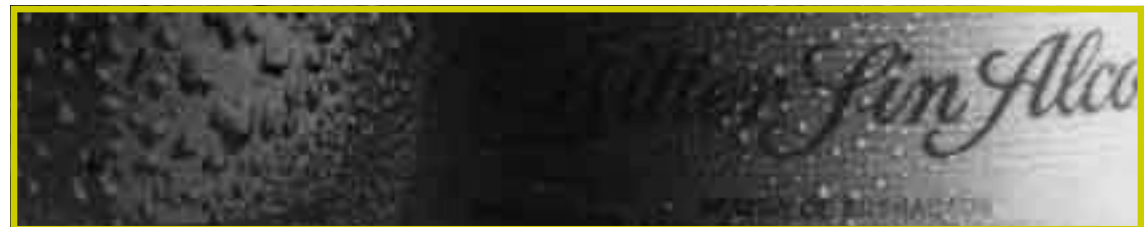
Introduction

Trademarks are protected in Hong Kong by the Trade Marks Ordinance and by the Common law doctrine of passing off.

The protection by passing off alone is the last resort. Enforcement by way of passing off entails copious proof of establishment of goodwill. Unregistered mark also leaves the trademark register wide open for third party to register an identical or similar mark to it.

Trademark application in Hong Kong can be based on an intention to use basis. No proof of use is required for the issuance of the trademark certificate or for renewal. Nevertheless, if a registered trademark is not used in Hong Kong for any continuous period of 3 years, any interested person may apply for its removal on the ground of non-use.

What counts as use include use in Hong Kong by the owner, its licensee or any person with the owner's consent. Registration of license is not mandatory but is advisable from the point of view of the licensee.





Benefits of Registered Trademark

- Registration ensures that you can safely use your trademark without worrying about any unintentional infringement on third party's trademark.
- Trademark certificate is the best proof of your claim on the mark.
- Registration enables lawful use of ® next to your trademark.
- Registration blocks other people from registering an identical mark on your specified goods.
- Registration gives you a good ground to oppose any attempt by your competitors to register a confusingly similar mark.
- Registration empowers you to take legal action against counterfeiters.
- Registered trademark is a corporate asset which is useful when making valuation of your company in M&A or IPO situations.
- Registration in an important city and trading centre like Hong Kong is essential for export or global marketing plans.

Fees

Our fee is **HK\$5,600** for 1 product category. The product categories are defined by the classes in the *Nice Classification of Goods and Services*.

The fee is **all-inclusive**. Neither the Registry nor us charge any fee on publication, registration and issuance of the trademark certificate. Nor do we charge any miscellaneous disbursement.

If additional product category is needed, each is only HK\$2,800 all-inclusive.

In the minority event of any serious objection by the examiner during substantive examination, or in the rare event of any opposition by third party after publication, the complicated application will be abandoned, and the client will be given another chance to apply using a new mark at official fee only.



Search

We usually conduct a free-of-charge search before filing. The purpose is to rule out any rejection due to presence of prior identical mark or obvious similar mark.

If such free search reveals any similar mark that cannot be obviously ruled out, the client has a choice of instructing us to obtain an official search by the Trade Marks Registry as to whether in its opinion there is any conflicting prior mark. The fee for official search is HK\$1,500 per mark for the first class and HK\$500 for each subsequent class included in the same request. The time needed is 1 to 3 weeks. The opinion will be given by an examiner on the official letterhead of the Intellectual Property Department of the Hong Kong Government.

If the result of the official search is positive and the follow-on application is rejected by the examiner contrary to the official search opinion, the official fee and the application fee will all be refunded.





Timeframe

Hong Kong trademark application usually takes 5 to 10 months to complete :-

Filing receipt and Application number	1 day
Application searchable in official website	2 days
Formality examination	within 6 months
Substantive examination	within 3 months
Opposition period after publication	3 months
Issuance of trademark certificate	3 weeks

When application details have been verified and fee received, we will digitally sign and file the application, and followed with our e-mail Filing Report enclosing a copy of the official filing receipt.

Two days after filing, the application will be updated into the Registry's database and anyone can independently check the received application free-of-charge at the Registry 's internet search website <http://ipsearch.ipd.gov.hk>.

Upon registration, a registered trademark is first valid for **10 years** and is renewable indefinitely for further periods of 10 years each by paying the renewal fee.

Classification of Goods & Services

Hong Kong adopts the Nice Classification of Goods and Services.

Multiple classes or product categories of the same mark can be included in one application. Existing marks registered under the old per mark per class system can also be merged into a single registration so as to save on renewal fee.

Specification (ie. description of goods and services) can either base on actual use or an honest intention to use the mark in Hong Kong. Unlike countries such as the USA or Canada, commencement of use is not a pre-condition for the issuance of trademark certificate.

All types of goods and services on which the mark is currently used or honestly intended to be used should be listed as broadly as possible in the specification to cover the class or category applying for in one exercise, since the specification can only be narrowed and not extended after filing. Upon registration, the scope of the exclusive right granted by the registration is limited by the ambit of the specified goods and services.



Series Marks

If coloured mark is used, both the colour mark and its black and white version can be filed as a series of marks in the same application at no extra-cost. The colour can be specifically claimed in words to improve the distinctiveness of the mark.

The traditional and simplified versions of Chinese characters, or the closely similar fonts or type faces of English words can usually be filed as a series of marks in the same application at no extra-cost.

One application can have maximum of 4 series marks.





Details Required

1. Applicant's full name and address.
2. Description of goods and services.
3. Logo or stylized mark in *.jpg* format.

No power of attorney is needed from the Applicant



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