



Hong Kong

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Trademark Application

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

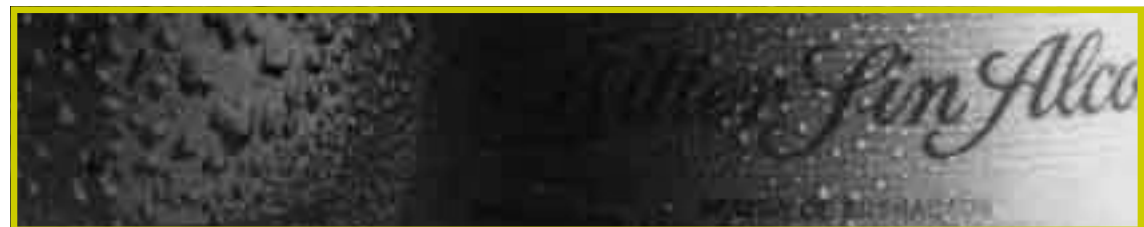
## *Introduction*

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\$4,500** for the first product category, and half price for each subsequent product category of the same mark. The product categories are defined in terms of the classes in the Nice Classification of Goods and Services.

The fee is inclusive of both the government fee and our professional fee. There is no separate fee for the publication, registration and issuance of the trademark certificate.

Unless the application encounters objection or opposition, there will not be any extra-charge. The chance of objection or opposition can be reduced by choosing an invented word as the mark, or adding a distinctive logo to the mark.

In the event of any objection or suggested amendment by the examiner, the client has the choice of (1) continue to pursue for registration at additional fee according to the complication, or (2) abandon the pending application at no extra-cost.

In the event of any opposition by third party, apart from the respective agent's additional fees, the applicant or the opponent who abandons or loses will be liable to pay the reasonable fees of the other side.



## 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 the 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\$1,200 per mark for any of the product categories specified. 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 application fee of HK\$4,500 will 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 3 months
Substantive examination	within 3 months
Opposition period	3 months
Issuance of trademark certificate	3 weeks

When fees have been received and application details have been verified, we will digitally sign and file the application, and followed with our 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.



## *Convention Priority*

If the client has filed an application in another WTO or Paris Convention country within the last half year, then there is a choice of treating the effective filing date in Hong Kong to be the same as the date of the earlier application.

Priority claim is usually made when the Hong Kong application is part of a coordinated world-wide filing exercise, or when a search reveals that a recent application of a third party may be surpassed by the priority claim, or if the client is concerned about possible competing third party application in Hong Kong at around the same time.

## *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 need to be specifically claimed in words. 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.



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