Absolute grounds for refusal

General principles

Section 11 of the Ordinance sets out the "absolute grounds for refusal" of a trade mark. The "absolute" grounds are mainly concerned with the nature of the mark itself, as opposed to the "relative" grounds of refusal contained in section 12 which deal with conflicts of an applied-for mark with earlier trade marks and earlier rights.

Each of the grounds for refusal under section 11 operates independently of the others and calls for separate examination, and the applicability of any one of the specified grounds is sufficient to prevent registration of the trade mark. A trade mark application may be objectionable under more than one ground for refusal.

Under each ground for refusal, the same test must be applied whether the sign consists of words, letters, numerals or other types of signs (other than section 11(3) which applies to shapes only, see chapter on Shape marks). Where the grounds for refusal exist in respect of only some of the goods or services for which registration is sought, the refusal shall apply to those goods or services only (section 11(8)).

Section 11(1)(a) and its interplay with sections 11(1)(b), (c) and (d)

Section 11(1)(a) prohibits registration of signs which do not satisfy the requirements of section 3(1) (meaning of "trade mark") of the Ordinance. According to section 3(1), a "trade mark" means any sign which is capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of other undertakings.

As only "trade marks" can be registered under the Ordinance, it is a first and fundamental requirement that the "sign" submitted for registration qualifies as a "trade mark". By contrast, the prohibitions in paragraphs (b), (c) and (d) of section 11(1) are applicable to "trade marks" (i.e. signs which have fulfilled the requirement of being a trade mark).

Since the sign's capacity to be represented graphically should have been considered at the deficiency checking stage (see chapter on Deficiencies checking), the question to be decided during the examination stage under section 11(1)(a) is whether the sign is capable of distinguishing the goods or services of the applicant from those of other traders. The test to be applied has a very low threshold. The requirement is satisfied even if a sign is only "capable" to the limited extent of being "not incapable" of distinguishing goods or services of one undertaking from those of other undertakings (*AD2000 Trade Mark* [1997] RPC 168).

Under this test, signs that are most likely to be excluded under section 11(1)(a) would be the ordinary name for the goods or services such as "Soap" for soap, and highly descriptive or laudatory words such as "Purewool".

Sections 11(1)(b), 11(1)(c) and 11(1)(d) are concerned with aspects of distinctiveness, with section 11(1)(b) being of the broadest scope and is the sweeping up provision. If any of these grounds is established, the objection may be overcome under section 11(2) by showing that the mark has, through use, become distinctive. However, a sign which fails to satisfy the requirement of section 11(1)(a) could not be registered no matter how much "use" has been made of it.

Accordingly, the Registrar is not precluded from finding a mark to be "devoid of any distinctive character" under section 11(1)(b) even where the mark has been accepted as a sign "capable of distinguishing" the goods or services of one undertaking from those of other undertakings for the purpose of section 11(1)(a). Signs which are not objectionable under section 11(1)(a) may be objectionable under the provisions of sections 11(1)(b), 11(1)(c) and /or 11(1)(d).

Section 11(1)(b) – not distinctive

The operative words in section 11(1)(b) are "distinctive character". "Distinctive" has a technical meaning in trade mark law. It means the mark must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish such goods or services from those of other undertakings. A mark can be striking, unusual, memorable or different, which can contribute to it being distinctive, but if it does not serve as a guarantee of origin, it is not distinctive in law.

"Devoid" simply means lacking.

The use of the word "any" could imply a low threshold but in practice this is misleading. If a mark cannot do the job of distinguishing goods or services of one undertaking from those of other undertakings without first educating the public that it is a trade mark, it has no distinctive character – or put in the statutory language – it is devoid of any distinctive character. Its character is something other than "distinctive".

Objections taken under other paragraphs of section 11(1) do not stop objections from also being taken under paragraph (b). FRESHBANKING is objectionable under paragraph (c) – FRESH (quality) BANKING (kind of service). The conjoining of FRESHBANKING does not, without evidence of acquired distinctiveness, change the primary meaning of the words, i.e. a new style of banking. It tells us what the service is and a characteristic of it but not whose service – so it is also devoid of any distinctive character.

Section 11(1)(c) – descriptive trade marks

Section 11(1)(c) is applicable only when the sign consists *exclusively* of the descriptive element or word(s). If there is another element in the sign which is not descriptive (except an element which is insignificant, e.g. a simple border), the sign would not be objectionable under section 11(1)(c) but may remain objectionable under section 11(1)(b).

The second point to note is that, a "trade mark" may consist of personal names (section 3(2)) and a mark comprising exclusively of a personal name is not among the prohibited signs in this subsection as it does not refer to a characteristic of the goods or services. See chapter on Names, signatures and images of individuals; fictitious character, titles of books, films and songs for more detailed guidance.

The third point to note is that the words "… which *may* serve, in trade or business, to designate …" suggests that a mark which is reasonably likely to be used by honest traders to designate characteristics of their goods or services ought to be refused without it being necessary to show that the sign is actually used or needed by the trade in question.

The words "may serve … to designate" allow for a degree of foreseeability (absent from section 11(1)(d)) that the mark may be perceived by the relevant class of persons as a new form of descriptive expression. There is no reason why the assessment to consider raising objection under section 11(1)(c) should not take into account the advent of new forms of descriptive expressions, e.g. "cloud computer", "e-cinema".

The fifth point is that section 11(1)(c) makes no distinction between signs which would be absolutely descriptive regardless of the goods or services to which they are applied (i.e. quality, quantity, value, geographical origin (though to a lesser degree), time of production of goods or rendering of services) from those which are dependent on the goods or services concerned (i.e. kind, intended purpose or other characteristics). This is an important consideration as a sign suggestive of an intended purpose may not be suggestive of the intended purpose for every item in the specification. Section 11(8) provides that where the ground for refusal exists in respect of only some of the goods or services for which the application for registration is made, the refusal will apply to those goods or services only.

Any trade mark which is the commonly used and accepted name of any single chemical element or compound, will fall within the provisions of section 11(1)(c) if registration is sought for goods being a chemical substance or preparation.

A useful question to ask is how would a reasonably well-informed, reasonably observant and circumspect consumer view the sign? As an origin neutral reference to the goods or services on which it is to be applied, or as an identifier of origin? If the former, an objection should be taken; if the latter, the sign performs the essential function of distinguishing as to origin.

Section 11(1)(d) – generic trade marks

The first thing to note about section 11(1)(d) is that it only applies to trade marks which consist *exclusively* of the prohibited matter.

A spanner device for car servicing, a chef's hat for restaurant services, a bunch of grapes for wine, stars for hotel services or brandy are examples of devices which are customary in the established practices of the trade concerned. However, five stars on a Martell brandy label would not fall within the provision because of the distinctive word Martell.

NETWORK, NET, WEB, CYBER, LINK, TELECOM are examples of words which have become customary in the current language of the relevant trade.

The second point to note is that the tense used in the sub-section is the perfect tense – "… which *have* become …". Also note the use of the word "current" in the phrase "… customary in the *current* language …". This wording combines to exclude speculation on whether use of the mark may become customary in the *future*. The mark must have an *established* meaning.

It is necessary to keep in mind that some signs would only be in customary use in a particular field. NETWORK would be unregistrable for computer software but it may not be objectionable for clothing.

Section 11(2) – acquired distinctiveness through use

Trade marks refused registration under sections 11(1)(b) (devoid of any distinctive character), 11(1)(c) (trade marks which are descriptive) or 11(1)(d) (trade marks which are generic) may nevertheless be accepted if the applicant establishes, to the satisfaction of the Registrar, that, **before the date of the application for registration**, the trade mark has in fact acquired a distinctive character as a result of the use made of it. The distinctiveness acquired by the use of the mark must exist before the date of the application to register. No consideration will be given to any likelihood that the mark will become distinctive in the future, due to any advertising or promotion by the mark's owners.

Section 11(2) does not extend to signs precluded from registration by section 11(1)(a), i.e. those incapable of distinguishing as to origin. Section 11(2) also does not extend to signs which are refused under section 11(3), nor to trade marks refused under sections 11(4), 11(5), 11(6) or 11(7).

The purpose of the evidence is to demonstrate that, despite the objectionable nature of the trade mark, it has in fact, prior to the application for registration, become identified, in the minds of the public, with a particular trader's goods or services. That is what is meant by "distinctive character".

"Premier" applied to luggage would be objectionable under sections 11(1)(c) (solely designating quality) and 11(1)(b) (devoid of any distinctive character) but on evidence from the trade, may be shown to identify the luggage manufactured by a particular manufacturer.

Some trade marks may not, on their face, appear to designate origin at all. Examples of these are container shapes; slogans ("the real thing" for the brand name "Coca Cola"); or laudatory words ("Treat" for the brand name "Silver Spoon"). Evidence filed to overcome objection to these marks must be directed at showing that the public, upon seeing or hearing such marks, identify them with the goods or services of a particular undertaking. Evidence showing how the undertaking has endeavoured to educate the public that the sign is as much an indication of origin as the brand name would be highly

relevant.

Proof of extensive use or extensive promotion alone may not satisfy the requirement for establishing "distinctive character" on a highly descriptive or commonplace mark. Additional evidence of public or trade recognition may assist.

The evidence should answer the following questions in the affirmative:

- Has the mark been used as a trade mark?
- Has the applicant promoted the mark as a trade mark?
- Does the evidence show, as a matter of fact, that the trade mark is operating in the market place as an indicator of origin?
- Has the primary meaning of the trade mark been displaced to the extent that, in relation to the goods or services, it has come to denote those of the applicant?
- Does the evidence overall show that the trade mark does, in fact, distinguish the applicant's goods or services?

If the evidence that would be required to establish the factual distinctiveness of a descriptive or commonplace trade mark would need to come from a market survey or trade evidence, consideration should be given to obtaining that evidence **before** applying for registration. Any market survey evidence obtained after objection is raised must satisfy the requirement that the trade mark was so recognised as an indicator of origin **before** the application date.

The following categories of marks, likely to have been refused registration under section 11(1)(b), (c) or (d), can be considered with evidence of acquired distinctiveness:

- Common surnames and personal names

- Descriptive letters and numerals

- Descriptive words

- Misspellings of descriptive words

- Geographical names

- Descriptive foreign words

- Descriptive devices (not common to the trade)

- 3D shapes representing the shape of the goods, or packaging or containers for the goods

- Colour combinations

- Sounds and smells

Whether the mark has acquired a distinctive character is a matter of degree. The onus rests on the applicant to prove the case. Extensive use alone may not be sufficient. "TREAT" for example, was not saved by evidence of its substantial sales. [1]

Evidence of the expenditure or efforts spent on advertising the mark may not be conclusive. Some of the most memorable television advertisements, for example, are remembered for their entertainment values leaving no recollection of the advertiser.

[1] *British Sugar v Robertson* [1996] RPC 281

There is no fixed period of use, although five years is a useful benchmark. Extensive use over a shorter period may well be sufficient, although use for less than two years prior to the date of application would very unlikely be regarded as sufficient. Use should be continuous, though strong sales after a break may well establish that the distinctiveness acquired before the break has not been lost.

An application for registering a mark in a different typeface to that actually used needs to be considered carefully. Would the variant qualify as a series? If not, the use would not qualify as establishing factual distinctiveness.

The use must also relate to the goods or services sought to be protected. If it only supports some categories, the applicant must seek an amendment to delete those goods or services where the mark has not been shown to have acquired a distinctive character. Some flexibility is possible if the evidence shows use for a range of goods within a general term, e.g. stationery.

Prior registration of a variant of the trade mark sought to be registered (which would not qualify as a series) or a prior registration of the trade mark in respect of different goods or services will not assist.

Established use must be by the applicant, and if not, the link to the applicant, for example, use by a distributor, must be explained.

In assessing the acquired distinctive character of a mark the following can be taken into account:

- the market share held by the mark;

- how intensive, geographically widespread and long-standing use of the mark has been;

- the amount invested by the owner in promoting the mark;

- the proportion of the relevant class of persons who, because of the mark, identify the goods or services as originating from the particular owner; and

- statements from chambers of commerce and industry or other trade and professional associations.

We will also take account of the inherent characteristics of the mark, including whether it does or does not contain an element descriptive of the relevant goods or services. The more descriptive the mark, the more likely it is to be equally applied to the goods or services of others.

The use must be in respect of the mark applied-for, although it may be used together with background or decorative elements or with another distinctive mark.

Where the mark is used together with another trade mark, we also need to consider whether it would be recognised as a trade mark on its own, i.e. as a secondary trade mark. The following can be taken into account:

- the strength of the objection to the mark

- any evidence of use of the mark on its own even if it is normally used as part of, or in conjunction with, the other trade mark?

- is the other trade mark so highly distinctive that it is likely to overwhelm the mark?

- has the mark been used distinctively to educate the public that it is a trade mark, albeit in combination with a house mark or another established mark of the same proprietor? (e.g. is the trade mark highlighted or emphasized in some way)?

If the mark is always seen with another distinctive sign it is doubtful that the mark will be distinctive when presented on its own, e.g. “TREAT” was always accompanied by

the established mark "SILVER SPOON"[2]; or "POUR N'WHIP" was always used in conjunction with the distinctive signs "AVOSET" and "Sims"[3]. For this reason, where a mark is used alongside another distinctive sign, the burden on the applicant to show that it has come to be seen as a secondary trade mark will be greater.[4]

The assessment of distinctive character must also refer to the particular goods or services to be protected and examined from the point of view of a reasonably well-informed, reasonably observant and circumspect consumer of those goods or services. The average consumer normally sees a mark as a whole and does not proceed to analyse its various details. The consumer's level of attention is also likely to vary according to the category of goods or services in question. Finally, where the application for registration contains no limitations as to how the mark is to be used, we should pay attention to the various marketing methods and practices that the average user of the relevant goods or services is likely to meet under normal and fair trading conditions.

If, on the basis of these factors, we conclude that the relevant class of persons, or at least a significant proportion of them, come to identify the goods or services as originating from a particular undertaking because of the use made of the trade mark before the date of the application, we will rule that the requirement as laid down in section 11(2) has been satisfied.

The concept of "extension of equity" under Cap. 43 is not carried over to Cap. 559. Section 11(2) refers to an acquired distinctive character as a result of the use made of "it", i.e. the mark applied-for. A degree of latitude is permissible if the use proved is of a mark that would be regarded as "a series" mark e.g. use is made of the mark in capitals when the applied-for mark is in lower case. However, where the use proved is of a variant which would not qualify as "a series", the fact that the variant is registered is irrelevant. Similarly neither use of "a series" mark nor the registration of a variant mark in respect of different goods or services will establish acquired distinctiveness.

The mode of giving evidence in all trade mark proceedings before the Registrar is governed by rule 79 of the Rules, which states that the evidence be filed by way of a

[2] *British Sugar v Robertson* (supra)
[3] Decision of the Trade Marks Registry, Hong Kong SAR, 31 May 2007
[4] *HAVE A BREAK* Case C-353/03 [2006] FSR 2; *British Sugar v Robertson* (supra).

statutory declaration or affidavit. Rule 80 governs how such documents are to be made and signed.

The proforma and the checklist shown at the end of this chapter are for the assistance of those applicants with no or little knowledge of the formalities of a statutory declaration or affidavit and/or the evidence that may be considered relevant for establishing acquired distinctiveness. The proforma will need to be expanded with further evidence particular to the application in question. The checklist is prepared based on common deficiencies identified in evidence of use filed with the Registrar. The applicant should check the evidence it intends to file against this list to ensure the evidence supports a claim under section 11(2). Note however that filing evidence comprising **only** the clauses in the proforma and meeting the requirements of the checklist is no guarantee that the mark will be accepted on acquired distinctiveness.

If a mark is accepted on evidence of use, the publication of particulars of the application in the Hong Kong Intellectual Property Journal under section 43 will include the words "This trade mark has been accepted because of distinctiveness acquired through use.".

If a mark is accepted on evidence of use, which includes trade or survey evidence, the publication of particulars of the application in the Hong Kong Intellectual Property Journal under section 43 will include the words "This trade mark has been accepted because of distinctiveness acquired through use and trade (or survey) evidence.".

Where an applied-for mark is identical to, or would be considered "a series" of, a trade mark registered in the name of the applicant which was accepted on the basis of acquired distinctive character through use, the Registrar may take that fact into account in considering an objection on absolute grounds. In determining whether an objection should be raised the Registrar will also consider whether the applied-for goods or services are identical to those of the registered trade mark.

If an application is accepted because the applied-for mark is identical to or would be considered "a series" of the registered trade mark which was itself accepted on the basis of acquired distinctive character through use, the following endorsement will be placed

on the register: "Proceeding because of Trade Mark No. #".

Section 11(3) – see chapter on Shape marks

Section 11(4)(a) – marks contrary to accepted principles of morality

Section 11(4)(a), which differs from the Trade Marks Act 1994 (UK) in that it omits "contrary to public policy", is concerned with principles of morality rather than political correctness. As with all the subsections of section 11, the Registrar's decision rests on the exercise of judgment, not the exercise of discretion – see *Ghazilian's Trade Mark Appln ("TINY PENIS")* [2001] RPC 654.

Each case must be decided on its own facts. The dividing line will be drawn between offence which amounts only to distaste, against offence which would justifiably cause outrage, or would be the subject of justifiable censure as being likely to significantly undermine current religious, family or social values. The outrage or censure must be within an identifiable section of the public, and a higher degree of outrage or censure amongst a small section of the community will be sufficient just as lesser outrage or censure amongst a more widespread section of the public will also suffice.

Our approach would be to invoke the concept of right-thinking members of the public. A right-thinking member may personally not be outraged, but will be able to objectively assess whether or not the mark in question is calculated to cause "outrage" or "censure" amongst a relevant section of the public. The matter must be approached objectively. It does not matter whether the examiner finds the mark personally unacceptable. ~~Section 11(4)(a) is also not concerned with political correctness, rather it is concerned with principles of morality.~~

Marks that are regarded as contrary to accepted principles of morality include marks containing, in whole or in part, any sign that —

- may be contrary to the interests of national security, sovereignty, unity, reputation or territorial integrity; public security or order; and personal safety, notably through transmitting, inciting or trivializing an illegal activity;

- is, either explicitly or by insinuation, associated or connected with an offensive, indecent or outrageous meaning, conduct or activity, e.g. a sign that incites hatred or otherwise transmits an insulting/degrading/disparaging message towards a particular race, group, gender, religion, institution or belief;

- is, without authorization, identical to or resemble individual names/emblems/landmarks of government leadership, authorities or agencies (including those of the Central People's Government); or

- contains references to or is associated/connected with any well-known tragedy or otherwise shocking/disturbing event, as likely to be considered amongst a section of the public as offensive through commercialization.

Marks contrary to accepted principles of morality would likely be refused registration regardless of their applied for goods or services.

Section 11(4)(b) – marks that are likely to deceive

Section 11(4)(b), unlike section 12(1) of Cap. 43, is not concerned with likely deception as the result of an earlier unregistered mark or passing-off. Remedies for this type of deception are covered under section 12(5)(a) which can only be raised in opposition proceedings.

The potential for deception may in certain circumstances be removed by the applicant's acceptance of an appropriate limitation. Despite rule 10 of the Trade Marks Rules, which provides that any limitation must be included in the application, rule 23(b) allows the amendment of an application by adding a limitation. Another removal method of any potential for deception can be the amendment of the application to restrict the goods or services covered by the application under section 46(3)(a).

The types of deception that could lead to an objection under this subsection are not defined. Clearly they would include marks which give rise to an expectation which will not be fulfilled (given the content of the specification). If by the words or graphic devices used the mark suggests its manufacture is in an area that is famous for the quality of the specified goods, and the goods are made elsewhere, objections will be raised. The composition of the goods, if the materials used make a significant contribution to the purchase decision, suggestions of patronage, or approvals, suggestions of environmental friendliness, provided that this quality is relevant to the goods or services concerned, are other examples. Further, if the mark includes words or characters like "made/made in/imported from/exported from" together with the geographical name (for example, Swiss made/made in Hong Kong/imported from Japan/exported from Thailand), it is likely that the average consumer will expect the specified goods are made in or imported/exported from the geographical place even though the area is not famous for the quality of the specified goods. If the goods are imported/exported from or made elsewhere, the mark would be deceptive. Another example of a deceptive mark is a mark which implies official approbation but in fact, there is none.

The use of the words "likely to deceive" means that there must be a real rather than an imagined possibility of deception occurring. The use of the words "the public" means that particular consideration must be given to the nature of the trade and its customers. "Youth Glow" for cosmetics for example, would not lead to any real expectations that its use by elderly customers would restore a youthful skin tone. However if a mark appears to be the name of a university, and yet the institution does not award any recognised qualification, it may be deceptive, since a "university" is an institution of higher education having authority to award bachelors' and higher degrees (Collins English Dictionary).

Special consideration should be applied in relation to applications for trademarks for tobacco products under Class 34. Marks may be refused on the grounds that they are false, misleading, deceptive or likely to create an erroneous impression about the product's characteristics, health effects, hazards or emissions, including any term, descriptor, figurative or any other sign that directly or indirectly creates the false impression that a particular tobacco product is less harmful than other tobacco products.

These may include terms such as “low tar”, “light”, “ultra-light”, or “mild”.

Section 11(5)(a) – use prohibited in Hong Kong by virtue of any law

As with section 11(4)(b) this subsection is not intended to cover passing-off or conflict with an earlier right under registered designs or copyright as section 12(5) specifically protects these rights. If use of the proposed trade mark would amount to an offence under an Ordinance that prohibits the use of a sign, this subsection will be invoked.

Examples include:

- a mark the use of which constitutes an offence under The Law of the People’s Republic of China on Safeguarding National Security in the Hong Kong Special Administrative Region and/or the Safeguarding National Security Ordinance (Instrument A305);

- the unauthorized use of the words “Heung Yee Kuk (鄉議局)” as prohibited by the Heung Yee Kuk Ordinance (Cap. 1097);

- the unauthorized use of the words “Red Cross” or “紅十字會” , other badge, token or emblem specifically adopted by the Hong Kong Red Cross or the emblem of the Geneva Convention as prohibited by the Hong Kong Red Cross Ordinance (Cap. 1129);

- the unauthorized use of any title which so closely resembles “Hong Kong Sheng Kung Hui”, “Sheng Kung Hui”, “香港聖公會” or “聖公會” as prohibited by the Hong Kong Sheng Kung Hui Ordinance (Cap. 1157);

- the use of the national flag, emblem or anthem (or its lyrics or score); or the HKSAR regional flag or emblem, in a trade mark as prohibited by the National Flag and National Emblem Ordinance (Instrument A401), the National Anthem Ordinance (Instrument A405) or the Regional Flag and Regional Emblem Ordinance (Instrument A602), as the case may be (cf. section 11(6)).

"Any law" extends the scope beyond statutory law though no aspect of the common law readily comes to mind which would be affected by this prohibition.

Section 11(5)(b) – bad faith

Applying for a mark knowing it belongs to someone else could amount to bad faith.

Objections based on bad faith are more likely to be raised by a third party in opposition or invalidation proceedings than at the examination stage.

However, it is appropriate for the Registry to raise an objection if the circumstances of the application give rise to a reasonable suspicion of the applicant's entitlement to the mark or the honesty of his intention. For example, if:

- the mark is generally known to be the trade mark of a particular company, entity or individual, and the applicant has not submitted information to show a relationship between the applicant and the generally known owner of the trade mark;

- the applicant has simultaneously filed a number of applications for registration of different trade marks, one or more of which is generally known to be the trade mark of a particular company, entity or individual, and there is no information in the applications showing the relationship between the applicant and the generally known owner of the trade mark; or

- the mark incorporates the name or image of a well-known person without his or her agreement,

we may raise an objection on the ground that the application is made in bad faith. The applicant may overcome the objection by providing material to show that he is entitled to apply for registration, such as a written endorsement of the owner of the trade mark

in question.

Section 11(6) – national flag, emblem and anthem, and regional flag and emblem

This subsection prohibits the registration of signs consisting of or containing the national flag, emblem or anthem; or the HKSAR regional flag or emblem.

This section must be read with section 11(9) together with the National Flag and National Emblem Ordinance (Instrument A401), the National Anthem Ordinance (Instrument A405) and the Regional Flag and Regional Emblem Ordinance (Instrument A602).

Section 11(7) – signs protected under Article 6*ter* of the Paris Convention

~~This subsection prohibits the registration of the national emblems of WTO members or international organisations.~~

This subsection prohibits unauthorized registration of a trade mark which consists of or contains —

- the flag, armorial bearings or any other state emblem, official sign or hallmark of a Paris Convention country or WTO member, which is protected under Article 6*ter* of the Paris Convention; or

- the armorial bearings, flag or any other emblem, abbreviation or name of an international intergovernmental organization of which one or more Paris Convention countries or WTO members are members, which is protected under Article 6*ter* of the Paris Convention.

This must be read together with sections 64 and 65.

* * *

SAMPLE FORMAT OF A STATUTORY DECLARATION

IN THE MATTER OF the Trade Marks Ordinance (Cap. 559)
Trade mark application no. [#]
in the name of [*the applicant*]
for the registration of [*trade mark*]
in Class(es) [#] in the Hong Kong Special Administrative Region

AND

IN THE MATTER OF the Oaths and Declarations Ordinance (Cap. 11)

STATUTORY DECLARATION

I, [*declarant*] of [*address*], solemnly and sincerely declare as follows:

1. I am [*capacity or position*] of [*the applicant*] of [*address*], the applicant herein.

2. I have been associated with the applicant for [#] years and have occupied my present position since [*year*].

3. I have free access to the records of the applicant relating to its trade marks and the user thereof. The facts set forth in this declaration are within my personal knowledge or are derived from the records of the applicant and I am duly authorised by the applicant to make this declaration on its behalf.

4. The applicant first used the trade mark [*trade mark*] in Hong Kong in [*month & year*]. [*State whether it has since been used by the applicant continuously in Hong Kong.*]

5. The goods/services on which the trade mark has been used in Hong Kong, and the date of first use, are as follows:

Class [#]: [*description of goods/services*] first used in the year [*year*]

Class [#]: [*description of goods/services*] first used in the year [*year*]

6. There is now produced and shown to me marked "Exhibit ###" [*description*].

[*exhibits of samples, catalogues and other printed materials demonstrating use of the mark exactly as applied for in relation to each of the classes of goods and services applied for*]

7. Sales of the goods/services by the applicant in Hong Kong within 5 years before the date of application were as follows:

Class [#]

19… $…
19… $…
20… $…
20… $…
20… $…

Class [#]

19… $…
19… $…
20… $…
20… $…
20… $…

8. There is now produced and shown to me marked "Exhibit ###" [*description*]. [*exhibits of invoices*]

9. Amounts spent on promoting the goods/services in Hong Kong within 5 years before the date of application were as follows:

19..	$…
19..	$…
20..	$…
20..	$…
20..	$…

Promotion of the goods/services was conducted by means of advertisements in [*description of media*]. [*Any other means of promotion*]

10. There is now produced and shown to me marked "Exhibit ###" [*description*]. [*exhibits of sample advertisements illustrating the way in which the mark is used to promote the goods/services*]

11. [*Any other relevant information*]

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the Oaths and Declarations Ordinance.

[*Signature and name of declarant*]

Declared at [...] this [...] day of [...]

Before me,

[*Signature and designation, i.e. Justice of the Peace/Notary Public/Commissioner for Oaths*]

EXAMPLE OF A COMPLETED STATUTORY DECLARATION

IN THE MATTER OF the Trade Marks Ordinance (Cap. 559)
Trade mark application no. 987654321
in the name of ABC LIMITED
for the registration of "FASMOW"
in Classes 7 and 8 in the Hong Kong Special Administrative Region

AND

IN THE MATTER OF the Oaths and Declarations Ordinance (Cap. 11)

STATUTORY DECLARATION

I, Thomas Mow of 5th Floor, 99 Duddell Street, Central, Hong Kong, solemnly and sincerely declare as follows:

1. I am the Managing Director and Chief Executive Officer of ABC LIMITED of 5th Floor, 99 Duddell Street, Central, Hong Kong, the applicant herein.

2. I have been associated with the applicant for 20 years and have occupied my present position since 1996.

3. I have free access to the records of the applicant relating to its trade marks and the user thereof. The facts set forth in this declaration are within my personal knowledge or are derived from the records of the applicant and I am duly authorised by the applicant to make this declaration on its behalf.

4. The trade mark "FASMOW" (the "Trade Mark") was first devised by the

applicant independently in April 1995, by combining the letters "FAS" with the letters "MOW". Those letters were derived from the names of the Product Design Manager of the applicant, Mr. F. A. So and myself, who were the designers of a new line of lawnmowers developed in 1995 by the applicant. There is now produced and shown to me marked "Exhibit A" an extract of an Employer's Return filed by the applicant in 1996 which included the names of Mr, So and myself.

The Trade Mark was devised honestly by the applicant without knowledge of the cited earlier mark no. 403922333.

5. The applicant first used the Trade Mark in Hong Kong in July 1995. It has since been used by the applicant continuously in Hong Kong.

6. The goods on which the Trade Mark has been used in Hong Kong, and the date of first use, are as follows:-

Class 7: Lawnmowers and parts and fittings for lawnmowers.
First used in the year 1995

Class 8: Hand tools and implements (hand operated) for cutting grass
First used in the year 1996.

7. There is now produced and shown to me marked "Exhibit B" catalogues dated 1998, 1999, 2000, 2001 and 2002 showing lawnmowers bearing the Trade Mark.

8. There is now produced and shown to me marked "Exhibit C" catalogues dated 1998, 1999, 2000, 2001 and 2002 showing hand operated tools for cutting grass bearing the Trade Mark.

9. Sales of the goods by the applicant in Hong Kong under the trade mark within 5 years before the date of application were as follows:

	Class 7 goods (HK$)	Class 8 goods (HK$)
1998	$7,467,200	$1,825,600
1999	$9,355,400	$1,701,570
2000	$12,305,600	$2,350,850
2001	$11,467,200	$2,762,300
2002	$13,255,700	$3,854,250

10. There is now produced and shown to me marked "Exhibit D" copies of invoices in relation to sales of lawnmowers under the Trade Mark from 1998 to 2002.

11. There is now produced and shown to me marked "Exhibit E" copies of invoices in relation to sales of hand operated tools for cutting grass under the Trade Mark from 1998 to 2002.

12. Amounts spent on promoting the goods in Hong Kong within 5 years before the date of application were as follows:

1998	$515,600
1999	$521,870
2000	$801,420
2001	$1,100,250
2002	$1,501,300

Promotion of the goods was conducted by means of advertisements in magazines ("Lawnmowers Monthly" and "Hong Kong Gardening News"), television advertisements on DTV, and distributing printed materials to retailers and potential customers.

13. There is now produced and shown to me marked "Exhibit F" copies of advertisements for the Class 7 goods which appeared in the "Lawnmowers

Monthly" and "Hong Kong Gardening News" in June 1998, June 1999, August 2000, July 2001 and August 2002.

14. There is now produced and shown to me marked "Exhibit G" copies of advertisements for the Class 8 goods which appeared in the "Lawnmowers Monthly" and "Hong Kong Gardening News" in August 1998, July 1999, August 2000, September 2001 and August 2002.

15. I truly believe that as a result of the use made of the trade mark by the applicant, the trade mark "FASMOW" is well known to the general public and to buyers and users in Hong Kong of lawnmowers and hand operated tools for cutting grass, that it is uniquely associated with ABC Limited, and that it distinguishes the lawnmowers and hand operated tools for cutting grass sold by ABC Limited from those of others.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the Oaths and Declarations Ordinance.

(Signed) THOMAS MOW

Declared at Central, Hong Kong this 30th day of April 2003

Before me,

(Signed) WONG MEI MEI LILY

Solicitor of the Hong Kong Special Administrative Region

EXAMPLE OF A COMPLETED EXHIBIT SHEET TO ACCOMPANY A STATUTORY DECLARATION

IN THE MATTER OF the Trade Marks Ordinance (Cap. 559)
Trade mark application no. 987654321
in the name of ABC LIMITED
for the registration of "FASMOW"
in Classes 7 and 8 in the Hong Kong Special Adminstrative Region

AND

IN THE MATTER OF the Oaths and Declarations Ordinance (Cap. 11)

This is the exhibit marked "Exhibit A" referred to in the Statutory Declaration of Thomas Mow dated this 30th day of April 2003.

Before me,

(Signed) WONG MEI MEI LILY

Solicitor of the Hong Kong Special Administrative Region

CHECKLIST FOR PREPARING EVIDENCE OF USE

Representation of the subject mark

- ☐ Is the mark shown to be used the same as that applied for? If not, is there any basis for regarding such use as use of the subject mark?
- ☐ If the subject mark is used together with another trade mark, consider whether the subject mark would be recognised as a trade mark on its own.

Specification of the goods or services

- ☐ Does the evidence show that there has been use of the subject mark in respect of all of the applied for goods or services? If not, consider filing Form T5A to restrict the applied-for goods or services to those for which the subject mark has been used as shown in the evidence.
- ☐ Has the subject mark been used on goods sold or services provided in Hong Kong?

Information showing the extent of the use of the subject mark

- ☐ Is the currency unit (e.g. HKD) for the sales or turnover and the promotional expenses in respect of the subject mark specified?
- ☐ For multi-class application, is there any breakdown for the sales or turnover and the promotional expenses of the respective class of goods or services?
- ☐ If the sales or turnover and the promotional expenses include those outside Hong Kong, is there any separate figure for the sales or turnover and the promotional expenses in Hong Kong?
- ☐ Do the materials in the Exhibits to the Statutory Declaration (e.g. packaging, catalogues, advertisements) show the use of the subject mark?
- ☐ Are the materials in the Exhibits to the Statutory Declaration (e.g. packaging, catalogues, advertisements) dated ~~on or~~ before the date of application?
- ☐ Where the materials show use by a party other than the applicant, the basis for regarding such use as the applicant's has to be explained. For example, the user is a wholly owned subsidiary of the applicant.

Others

- ☐ Has the evidence been prepared in the form of a statutory declaration or affidavit?
- ☐ Is the declaration/affidavit declared by the applicant? If not, the applicant needs to make a declaration/affidavit to adopt the former declaration/affidavit.