
20. Solicitors (Trade Marks and Patents) Costs Rules

ARRANGEMENT OF RULES

Rule

1. Citation
2. Interpretation
3. Scale of costs in certain non-contentious matters
4. Costs in other non-contentious business
5. Application

Schedule

1. Citation

These rules may be cited as the Solicitors (Trade Marks and Patents) Costs Rules.

2. Interpretation

(1) In these rules, unless the context otherwise requires -

“non-contentious business” means any trade mark or patent business done by and as a solicitor which is not contentious trade mark or patent business;

“Registrar” means -

- (a) in Part I of the Schedule, the Registrar of Trade Marks appointed by the Governor; and
- (b) in Part II of the Schedule, the Registrar of Patents appointed by the Governor;

“register” means -

- (a) in Part I of the Schedule, the register of trade marks kept under the Trade Marks Ordinance (Cap. 43); and
- (b) in Part II of the Schedule, the register of patents kept under the Registration of Patents Ordinance (Cap. 42).

(2) In Part I of the Schedule, the references by numbers to sections and to rules are references to sections and rules of the Trade Marks Ordinance (Cap. 43) and the Trade Marks Rules (Cap. 43 sub. leg.), respectively.

(3) In Part II of the Schedule -

- (a) the references by numbers to sections and to rules are references to sections and rules of the Registration of Patents Ordinance (Cap. 42) and the Registration of Patents Rules (Cap. 42 sub. leg.), respectively; and
- (b) “Schedule to (Fees) Rules” means the Schedule to the Registration of Patents (Fees) Rules (Cap. 42 sub. leg.).

3. Scale of costs in certain non-contentious matters

The scale of costs contained in the Schedule shall be the scale of costs for solicitors in relation to the non-contentious business specified therein.

4. Costs in other non-contentious business

Subject to rule 3, a solicitor's costs in relation to non-contentious business shall be such sum as may be fair and reasonable, having regard to all the circumstances of the case and, in particular, to -

- (a) the complexity of the matter or the difficulty or novelty of the questions raised;
- (b) the skill, labour, specialized knowledge and responsibility involved on the part of the solicitor;

- (c) the number and importance of the documents prepared or perused without regard to length;
- (d) the place where and circumstances in which the business or any part thereof is transacted;
- (e) the time expended by the solicitor;
- (f) where money or property is involved, its amount or value; and
- (g) the importance of the matter to the client.

5. Application

- (1) Non-contentious trade mark and patent business for which instructions were accepted before 27 July 1984 shall continue to be governed by these rules as they stood before they were amended by the Solicitors (Trade Marks and Patents) Costs (Amendment) Rules 1984 (L.N. 246 of 1984).
- (2) Non-contentious trade mark and patent business for which instructions were accepted on or after 27 July 1984 but before the date of coming into operation of the Solicitors (Trade Marks and Patents) Costs (Amendment) Rules 1989 (L.N. 344 of 1989) shall continue to be governed by these rules as they stood before the date the Solicitors (Trade Marks and Patents) Costs (Amendment) Rules 1989 (L.N. 344 of 1989) come into operation.
- (3) These rules as amended by the Solicitors (Trade Marks and Patents) Costs (Amendment) Rules 1989 (L.N. 344 of 1989) ("the amending rules") shall apply to all non-contentious trade mark and patent business for which instructions are accepted on or after the date of coming into operation of the amending rules.

SCHEDULE

[rules 2 & 3]

PART I

SCALE OF COSTS IN NON-CONTENTIOUS TRADE MARK BUSINESS

Item	Section and Rule	Subject Matter	Costs \$
1.	Section 7, rules 103–105	Application to Registrar for a sealed, certified copy of any entry in the register	500
2.	Sections 9, 10 and 13, rules 9 and 11	Application for registration of trade mark in Part A or Part B of the register	2,500
3.	Section 9	Preparation and filing of each declaration of distinctiveness	4,000
4.	Section 13A, rule 9(2)	Convention priority	600
5.	Sections 14 and 17, rules 22 and 37	Obtaining certificates of registration, including receiving notice to advertise, attending to such advertisement and applying for certificate	1,200
6.	Sections 41, 41A and 42, rules 40-43	Assignment of a trade mark with goodwill	\$2,500 and if assignment is in respect of more than one mark, \$300 for each additional mark covered by the same assignment.
7.	Sections 41, 41A and 42, rules 40–43 and 45	Assignment of a trade mark without goodwill	\$3,000 and if the assignment is in respect of more than one mark, \$300 for each additional mark covered by the same assignment.
8.	Section 45, rules 58 & 58A	Renewal of registration of a trade mark	2,000
9.	Section 50, rule 66	(a) Request to Registrar to correct any error in name, address, etc	1,000

		(b) Additional mark	300
10.	Section 51, rules 70-73	Application to Registrar for leave to amend a trade mark, attending advertising and correspondence with Registrar and Government Printer concerning advertisement	\$2,500 and if application is in respect of more than one class, \$500 for each additional class.
11.	Section 58, rule 79	Application for registration as a registered user, including preparation of registered user agreement	\$3,500 and if the application is in respect of more than one mark, \$300 for each additional mark covered by the same application.
12.	Rule 91	Application to Registrar for uncontested extension of time	400
13.	Section 73, rule 108(1)	Official search	600
14.	Rule 108(2)	Unofficial search to determine whether a particular trade mark is registered or has been applied for	600

PART II

SCALE OF COSTS IN NON-CONTENTIOUS PATENT BUSINESS

Item	Section and Rule	Subject Matter	Costs \$
15.	Section 3, rule 2	Application for registration of a United Kingdom patent	3,000
16.	Schedule to (Fees) Rules (items 4 and 5)	Application to Registrar for a sealed, certified copy of any entry in the register	500
17.	Section 10, rule 4	Assignment	\$2,500 and if the assignment is in respect of more than one patent, \$300 for each additional patent covered by the same assignment.
18.	Schedule to (Fees) Rules (items 6, 7 and 8)	(a) Request to Registrar to make any changes in name, address, description, etc	1,000
		(b) For each additional simultaneous request to make the same change	300
19.	Schedule to (Fees) Rules (item 3)	Search to determine whether a particular patent is registered	600