

## Application for International Registration in Hong Kong SAR, China

### (Trade Marks Registry (“TMR”) as Office of Origin)

#### International Application (“IA”)

(\*) requires provision of an address for service in Hong Kong SAR

- Entitlement to file<sup>[1]</sup>
- Applied-for trade mark must have a —
  - (a) basic application (“BA”) or
  - (b) basic registration (“BR”)
 in Hong Kong SAR
- Applicant to fill in WIPO online form (in English) (\*)
- (where BA or BR is in Chinese) Applicant to provide verified English translation of BA or BR
- Online payment to WIPO (in Swiss Franc), inclusive of TMR’s handling fee

#### TMR: certification of IA

- (where there is no irregularity in IA, or upon applicant’s correction of any irregularity in IA) TMR to certify and present IA to WIPO

#### WIPO: formality examination of IA

- WIPO to check TMR’s certification, applicant’s payment of fees, classification on goods / services in IA, etc.
- IB to notify applicant and/or TMR of any irregularity in IA
- Applicant and/or TMR to respond to IB directly to remedy any irregularity

#### During the 5-year dependency period (from the date of IR)<sup>[3]</sup>

- TMR to notify IB of any total / partial failure of BA<sup>[4]</sup> or BR ceasing to be in force totally / partially<sup>[5]</sup>
- WIPO to cancel IR totally / partially (to the extent applicable), and inform IR’s holder and each DO of cancellation
- IR’s holder may file transformation application(s) separately and directly with each relevant DO within 3 months from date of cancellation of IR so as to transform IR into individual domestic trade mark application(s) or registrations(s) in each relevant jurisdiction

#### International registration (“IR”)

- WIPO to register applied-for trade mark in International Register as an IR, and publish IR in WIPO Gazette
- Date of IR is date of filing IA online, if IA (containing all the essential elements<sup>[2]</sup>) can reach WIPO within 2 months from that date, or else date on which missing element is last received by WIPO
- WIPO to forward IR to each designated office (“DO”)
- DO to conduct substantive examination according to its own domestic trade mark legislation and determine whether to grant protection on trade mark in its jurisdiction

[1] (a) Applicant must be—  
 (i) a Chinese national;  
 (ii) a person domiciled in Hong Kong SAR;  
 (iii) a company under section 2(1) of the Companies Ordinance (Cap.622), or a body corporate that is incorporated or established in Hong Kong SAR; or  
 (iv) a person or entity who has a real and effective industrial or commercial establishment in Hong Kong SAR.  
 (b) TMR may request the applicant to provide evidence that is necessary to satisfy TMR that the applicant is eligible to make an international application.

[2] The essential elements are—  
 (a) indications establishing applicant’s identity are sufficient to contact applicant or its representative, if any;  
 (b) contracting parties which are designated;  
 (c) reproduction of applied-for mark; and  
 (d) indication of goods and services for which IR is sought.

[3] An IR remains dependent on its BA filed with or BR with TMR as the Office of Origin for the 5-year dependency period from the date of IR. If there is any total / partial failure of the BA or BR (see footnotes [4] and [5] below) within the five-year dependency period, the IR will be cancelled totally / partially, to the extent applicable.

[4] Examples of failure of BA in Hong Kong SAR are voluntary withdrawal of BA, BA being treated as abandoned or withdrawn totally / partially due to failure to remedy deficiencies raised in respect of BA or to file address for service for BA, total / partial refusal of BA following TMR’s substantive examination thereof or a third party’s successful opposition thereto, etc.

[5] Examples of BR ceasing to be in force in Hong Kong SAR are BR being expired and not restored, total / partial success in application for revocation or declaration of invalidity of BR, total / partial surrender of BR, etc.