



## APPLICATION FOR INTERNATIONAL REGISTRATION UNDER MADRID PROTOCOL IN HONG KONG

The Trade Marks (Amendment) Ordinance (the “Amendment Ordinance”) provides a basis for the application of the Protocol Relating to the Madrid Agreement Concerning the International Registrations of Marks (Madrid Protocol) in Hong Kong. Nonetheless, those provisions concerning trade mark rights acquired in Hong Kong under the Madrid Protocol are yet to be implemented. It is believed that the international registration system would be implemented in 2022-23 as said by the Trade Marks Registry of Hong Kong.

### **To file an application for international registration in Hong Kong, the 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, 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.

That applicant must own a basis trade mark application or registration in Hong Kong. He can file an international application by filling in WIPO online form (in English) with payment of the prescribed fees. The Trade Marks Registry of Hong Kong will certify and present the international application to WIPO.

Upon compliance with the certification made by the Trade Marks Registry, payment of the fees by the applicant and remedy of any irregularities in the international application, WIPO will register the mark in International Register as an International Registration (“IR”), and publish IR in WIPO Gazette. WIPO will also forward the IR to each designated office for substantive examination according to its own domestic trade mark law.

An IR will remain dependent on the validity of its Hong Kong basic application or registration for the 5-year dependency period from the filing date of the IR. If there is any total or partial failure of the Hong Kong basic application or registration within the 5-year dependency period, the IR will be cancelled totally or partially where appropriate.



For filing of an application by an applicant through the Madrid system, the Trade Marks Registry (“TMR”) will notify the International Bureau of Intellectual Property (“IB”) about the filing of an international registration (“IR”) designating Hong Kong SAR, China (“IDHK”). Substantive examination on absolute and relative grounds for refusal of the IDHK will be conducted by the TMR as same as a domestic application. Should IDHK go through the substantive examination, it will be published in the Official Journal for the 3-month opposition period. TMR will issue a statement of grant of protection to WIPO should no opposition be filed within the three month period or the extended two month period.

application overseas via route, WIPO will Registry of Hong Kong

There are some other provisions for post registration of IR and IDHK in Hong Kong. For instance, recordal of assignment should be made at WIPO directly whereas grant of license be made at TMR. Application for transformation of IR and IDHK to a HK trade mark application/registration can be made at TMR within 3 months from the date on which the underlying international registration was cancelled by Office of Origin. And request for replacement of earlier HK registered trade mark by IR and IDHK can also be made at TMR.

It is believed that the Madrid Protocol system will offer an efficient and cost-effective way for domestic and overseas trade mark owners to obtain and maintain trade mark protection across Hong Kong and many other jurisdictions.