

CERTIFICATION TRADEMARK FILING IN HONG KONG

Certification marks are signs indicating that the goods or services in connection with which it is used are certified by an independent organization (ie owner of the sign) who does not trade in those goods or provide those services, by methods determined by the independent organization to indicate or guarantee certain specific characteristics or quality.

A. Information & Documents Required

- (1) Full name and address of the applicant in English with proof of ID / Certificate of Incorporation.
- (2) Clear specimen of the mark (".jpg" format preferred).
- (3) Goods and / or services to be applied for and, if known, the International Class(es).
- (4) If an application has been first filed in another country (which is party to the Paris Convention or WTO), priority can be claimed within 6 months beginning on the date of the first filing. For claiming priority, please provide the filing date, country and application number of the priority application.
- (5) [Regulations](#) governing use of the certification mark (**detailed in Part D below*)
- (6) A [Declaration of Competency](#) to prove that the applicant is competent to certify the goods for which the mark is to be registered (**detailed in Part E below*)

B. Time Frame

It would depend on when the Registrar of Trademarks examines the filing documents and whether we need to deal with any objection raised by the Registrar. As a rough guide, for a straightforward application, it usually takes around 12 – 18 months for a certification trademark to become approved and registered. If, however, the Registrar queries / objects the filing documents, it may then take several years, say 2 - 4 years or even longer for the registration to complete and mature to registration.

C. Costs

Should you be interested in obtaining a fee estimate of filing and completing a certification trademark application in Hong Kong, please contact us at law@chloelee.hk

D. Regulations

The applicant must file a copy of the [Regulations](#) governing use of the certification mark with the Registrar within nine months after the date of application for registration. The [Regulations](#) must be accompanied by evidence of the applicant's competence ie the [Declaration of Competence](#) (*details stated in Part E below*) to certify the goods or services for which the certification mark is to be registered.

The [Regulations](#) should cover the following basic requirements: -

1. [Persons authorized](#) to use the certification mark should be stated in the [Regulations](#);
2. [Criteria](#) (which must not be discriminatory) for acceptance or rejection of applications to use the certification mark should be set out in the [Regulations](#);
3. [Conditions of issue of the licence or certificate](#) to the authorized user to use the certification mark should be clearly stated;
4. A [formal agreement](#) between the owner and each authorized user of the certification mark under which the owner agrees not to cancel the licence or certificate except in accordance with the [Regulations](#) should be stipulated;
5. The owner must maintain and keep at its registered office for inspection by the public on reasonable terms a [register of all the authorized users and information](#) to be entered in the register should be stated in the [Regulations](#);
6. The [characteristics to be certified by the certification mark](#) - the characteristics of the goods or services must be non-discriminatory, defined as precisely as possible and capable of objective testing. Services of "a good standard" are unacceptable criteria because the description is not precise and not capable of objective testing;
7. [How the certifying body is to test those characteristics and to supervise the use of the certification mark](#) - The [Regulations](#) must provide for the inspection of goods in the course of their manufacture or for the inspection of samples or other methods which will ensure that the goods or services have those characteristics. Details of the tests applied to the goods or services and the assessment of the results of those tests should be explained clearly in the [Regulations](#);
8. The [fees, if any, to be paid in connection with the use of the certification mark](#) - The Registry will not require the actual amount of fees to be laid down. It would be sufficient for the [Regulations](#) to refer to a schedule of fees contained in an identifiable document. The certification scheme should be operated by the owner on a not-for-profit basis;
9. The [procedures for resolving disputes](#) - There must be a right of appeal to an independent arbiter against any refusal on the part of the owner to certify or to authorize the use of the mark in accordance with the [Regulations](#). It should be noted that the Registrar of Trade Marks, Hong Kong will not act as an independent arbiter in this regard.

* The [Regulations](#) (including any schedules attached thereto) cannot be altered without the consent of the Registrar.

E. Declaration of Competency

The [Declaration of Competency](#) should cover the following basic requirements: -

- (1) [Description of the Applicant](#) - An application must be made in the name of a legal person, ie one who can sue or be sued. Applications can be made in the names of limited companies. In the case of an unregistered association, the applicant will need to satisfy the Registry that such an association has a legal personality. If the applicant is an incorporated entity, a copy of the memorandum and articles of association / constitution should be provided.
- (2) [Nature of Business](#) - It is a fundamental requirement that the applicant does not trade in the relevant goods or services themselves. If the applicant carries on a trade or business involving the supply of some other goods or services, then the nature of such trading or business activities should be clearly stated. For incorporated applicants, it may be necessary for them to submit copies of the memorandum and articles of association / constitution for examination.
- (3) [Competence](#) - The Registrar must be satisfied as to the competence of the applicant to operate and supervise the scheme contemplated in respect of the certification mark. Generally, the applicant must be of a sufficient size, have a well-known status in the relevant trade, and have sufficient skills and resources to ensure that the certification is authoritative.
- (4) [Non-Discrimination](#) - An applicant must undertake that there would be no discrimination as to who can use the certification mark. Anyone meeting the conditions and standards in the [Regulations](#) should be permitted to use the mark.
- (5) [Adequate Supervision](#) - The applicant has an obligation to maintain the reputation of the certification mark and prevent its misuse. There must be satisfactory explanation as to how the use of the mark will be monitored to ensure that the relevant goods or services have the required characteristics. This may be supported in greater detail by the [Regulations](#).

*The [Declaration of Competency](#) should be in the form of a statutory declaration / affidavit / affirmation; and it should be signed before any court, judge, justice of the peace, notary, notary public, consul or other person authorized by law to administer an oath or to exercise notarial functions in that place for the purpose of any legal proceeding. The person signing the [Declaration of Competency](#) should state the capacity in which he / she makes the [Declaration of Competency](#).

F. Remarks

- (1) A certified copy of the priority application (if any) is generally not required but the Registrar retains the right to request for it.

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Photo by Mr Addie Lin, a good friend

If you would like to know more about what we do, please visit us at www.chloelee.hk or contact us at law@chloelee.hk

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Hong Kong Certification Trademark Registration Procedure

