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Does the Law Matter? Part IV

Own Your Trade Mark

Your Most Valuable Commercial Asset

February 2016



LETTERS & THOO

PATENT AND TRADE MARK ATTORNEYS

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Own Your Trade Mark: Your Most Valuable Commercial Asset

Dragon Law

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Introduction



Understand why the law matters.

This eBook is part of the series Does the Law Matter which provides essential tips and advice every startup or small business should consider.

Intellectual property is associated with several legal protections such as:

- trade marks;
- copyright;
- patents; and
- trade secrets.

This eBook focuses on trade marks.

Read on.

Trade marks: an introductory guide



When managed properly, a trade mark has the potential to become one of the most valuable commercial assets of your business.

This introductory guide is intended to provide a practical understanding of key issues involved in establishing, registering, and maintaining your trade mark rights so that the value to your business is maximised.

What is a trade mark?

A trade mark is a sign that is used in the course of trade that is capable of distinguishing the goods and services of one trader from those of another and that is able to be graphically represented. The owner of a trade mark has an exclusive right to prevent others from using the trade mark without authorisation in relation to the goods or services that are covered by the trade mark.

There are few limitations upon what types of signs may constitute a trade mark and may include for example: words, slogans, logos, names, Chinese characters, and features of colour, as well as shape aspects of packaging, scents, sounds, or any combination of these things, provided that the sign satisfies requirements for registration.

Examples of trade marks



JUST DO IT.



How to register a trade mark

Before investing considerable time and money in launching your new brand, it is sensible to spend some time assessing whether the trade mark is marketable, whether it is safe to use the trade mark without infringing upon anyone else's trade mark rights, and whether there are reasonable prospects for you to register your own trade mark. If these issues are not properly dealt with at an early stage and problems later arise, it may be necessary to rebrand the business which can be an extremely expensive and inconvenient exercise.

Know your audience

In terms of the marketability of the trade mark, some of the factors that should be considered and thoroughly tested beforehand are whether the trade mark is an attractive and appealing brand to your target market, whether it is simple and easily remembered by consumers, whether it is easy to pronounce, whether it appropriately represents the image and ethos of your business, and whether it potentially conveys any negative meanings or connotations in other cultures and languages where the trade mark will be used. Also, the availability of a domain name corresponding to the trade mark is likely to be an important consideration for many businesses looking to secure a strong online presence.

Remember to check:



**the meaning of your
trade mark in other
cultures**



**domain name
availability**

Do you have freedom-to-use the trade mark?

Whilst it is advantageous to be able to register your own trade mark wherever possible, it is more important that you have “freedom to use” your own trade mark in view of any pre-existing trade mark rights of others. In order to make such a determination, it is strongly advisable to engage a qualified and experienced trade mark professional to conduct a search of both registered and unregistered trade mark rights (if applicable) in each country where you intend to use your trade mark and to provide you with an opinion as to your level of risk.

If you have contracted a graphic designer to design the artwork for your trade mark, it is important that all intellectual property rights (e.g. copyright, design rights, and the right to use the trade mark in future) that may be owned by the graphic designer are assigned to you.

This important step is often overlooked and if not properly dealt with from the start may, in a worst case scenario, preclude you from legally using the trade mark in future without authorisation from the graphic designer.



Distinctiveness

In order for your trade mark to be registrable, it must be considered distinctive. It will not be considered distinctive and will be refused registration if it consists solely of descriptive or laudatory words (or slight variations of such words) ordinarily used in the trade to describe the goods or services (e.g. a quality or geographic origin of the goods or services) or if it consists of terms that may ordinarily be used in the trade in connection with the goods or services. For example, it would not be possible to register the words “organic tomatoes” as a trade mark in respect of organic tomatoes. Generally speaking, if the trade mark comprises an invented word or a logo having little or no obvious connection with the goods or services, then there will generally be a stronger prospect of the trade mark being considered distinctive. In certain circumstances, a trade mark which is not inherently distinctive in its own right may still be capable of registration if it has been used over an extensive period of time so as to have acquired the ability to distinguish the goods or services from those of other traders.

Conflicting marks

Your trade mark will also be refused registration if it is considered to be identical or similar (either visually or phonetically) to an existing trade mark registration covering similar goods or services.

The Trade Marks Registry will be able to provide a preliminary search and non-binding opinion regarding whether it believes there may be any prior conflicting trade marks that may pose an obstacle to registration of your own trade mark. Even if a prior conflicting trade mark registration is identified in the course of the search, it may still be possible to address this obstacle, for instance by purchasing the earlier trade mark from its owner if it is no longer of commercial relevance to them, by negotiating a co-existence agreement with the owner of the earlier trade mark or by applying to remove the earlier trade mark registration on grounds of non-use (if applicable) so that there may no longer be an obstacle to you registering your own trade mark. If none of these options are viable, it may then be safer and expedient to consider an alternative trade mark for your business.

“ **... engage a qualified and experienced trade mark professional to conduct a search of both registered and unregistered trade mark rights (if applicable) in each country where you intend to use your trade mark...** ”

If your business is planning to employ an independent consultant, contractor, or freelancer, set out the details of that arrangement in a Consultancy Agreement.

[> Learn more and create your own](#)

[> Hiring? Read about employment and IP protection in the eBook “The New Hire”](#)

Do I need a Chinese language trade mark?

In markets with large ethnic Chinese populations, the public will often prefer to use a Chinese language version of the trade mark rather than the actual English language trade mark because it is easier to pronounce.

Be proactive

If you have not established your own Chinese language version of your trade mark, Chinese consumers will tend to adopt their own informal version of your English-language trade mark which may ultimately become the more valuable trade mark

right in the market (which you will not own or have control over). This can be dangerous as the informal Chinese version of the trade mark that is adopted in the market may potentially convey a negative meaning or connotation which can adversely impact upon the value of your business.

Your trade mark should be:

- ✓ attractive
- ✓ appealing
- ✓ memorable
- ✓ easy to pronounce
- ✓ reflective of business's beliefs

With this in mind, it is advantageous to proactively select and register a Chinese version of your trade mark in order to more effectively market to ethnic Chinese consumers, and, in order to control the meaning and perception of the Chinese version of the trade mark that is conveyed to the public.

Tips on selecting a Chinese version of your trade mark

When selecting Chinese characters for your Chinese version of your trade mark, ideally they should combine both a positive meaning and phonetic similarity (in major dialects including Cantonese and Mandarin) to the English language trade mark. Also, depending upon the particular market in which you will be using the trade mark, either traditional Chinese or simplified characters may be more appropriate. However, if possible, protection of a Chinese version of the trade mark in both traditional Chinese and simplified Chinese characters is advisable.



What is a trade mark?

Graphically distinguishes the goods and services of one trader from those of another.



How to select a trade mark?

Consider distinctive, unique qualities. Consider your audience; is your trade mark memorable, simple, easy to pronounce?



Do I need a Chinese language trade mark?

A proactive move to control the meaning and perception.

Where you should register a trade mark



Where should I pursue trade mark protection?

There is no “one size fits all” approach as to how, where, and when a business should protect its trade mark.

In an ideal world, trade mark protection should be sought as soon as possible in all countries where the trade mark will be used. However, this is not always the most practical and cost-effective course of action and adopting a more pragmatic and strategically targeted filing and protection strategy may be the best way to proceed.

Trade marks are limited by territory and therefore it is necessary to register your trade mark in each country in which protection is required.



Tier 1 countries

Generally it is a good idea to register your trade mark in at least the “tier 1” countries in which you primarily intend to manufacture or sell your goods or services. There may be other “tier 2” countries where your trade mark is being used to a lesser extent and further protection may potentially be an option. However, you will need to weigh up whether the size and importance of your commercial operations in these secondary markets justifies the additional time and costs involved in pursuing local trade mark protection.

Look to the future

It is also important to consider pursuing trade mark protection in countries not only where you are currently operating, but also where you intend to expand your commercial operations in future or where a potential investor or licensee may expect the trade mark to be appropriately protected.

Costs involved

The costs involved in filing and maintaining registration of trade marks from one country to another may vary considerably. It is advisable to have preliminary availability searches conducted in countries where you are intending to use your trade mark before actually filing trade mark application in such countries. This will allow you to identify any potential obstacles to registration of your trade mark in such countries to assess your chances of registering the trade mark there before actually incurring the more substantial trade mark filing fees.

Defensive purposes

Sometimes, it is important to protect your trade mark in certain countries, not necessarily because you want to enforce your trade mark rights against others there but primarily for defensive purposes to ensure that others do not register your trade mark there first and then use the registration to disrupt your commercial operations.

The costs incurred in securing a defensive trade mark registration will invariably be much cheaper than the costs involved in trying to challenge a trade mark registration that has been filed by others in bad faith in order for you to safely continue operating there.

Dragon Law can help you secure trade mark registrations around the world.

[> Find out more.](#)

How do I protect my trade mark internationally?



There are different strategies for pursuing trade mark protection internationally. Trade mark applications may be filed directly into each country of commercial relevance to your business where they must each be independently examined by the relevant examining authority to meet the criteria for registrability in each country. The degree of difficulty in obtaining registration in each country may vary considerably depending upon many factors including the strictness of the relevant examining authority and the nature and complexity of objections that are raised during examination in each country. Ultimately, it is possible that your

trade mark may be registrable in certain countries but not in others, or in some cases, may not be registrable in any country.

Multi-country protection

Alternatively, a single international “Madrid Protocol” trade mark registration covering more than 90 different member countries may be obtained based upon an existing trade mark application or registration in a country that is a member of the Madrid Protocol.

In addition to the Madrid Protocol system of international trade mark protection, certain regions of the world such as Europe allow for regional trade mark protection to also be obtained by way of securing a European Community Trade mark which covers 28 different member countries.

Is it necessary to register a trade mark?

It is not compulsory to register a trade mark in certain countries because trade mark rights may be either registered or unregistered.

If a trade mark is unregistered but has been used to such an extent that it has acquired a reputation amongst consumers in relation to certain goods or services, it may be possible to take action against unauthorised use of the unregistered trade mark under the common law action of “passing off”. However, in practical terms this can be more difficult and costly than enforcing a registered trade mark.

Although registration of a trade mark is not compulsory, there are several important advantages in doing so:

- registration serves as a public notice to others that you own the trade mark and provides a deterrent against unauthorised use of your trade mark;
- registration assists in blocking competitors from trying to register the same or a similar trade mark in relation to similar goods or services;
- registration simplifies the procedural requirements for enforcement of trade mark rights compared to the enforcement of unregistered trade mark rights;
- registration makes it easier for customs to seize imported goods that infringe the registered trade mark; and
- registration makes it easier to assign and license the trade mark rights to others.



Where should I pursue trade mark protection?

Generally, “tier 1” countries in which you primarily intend to manufacture or sell your goods or services.



How do I protect my trade mark internationally?

Some options outside Hong Kong exist for widespread protection.



Is it necessary to register a trade mark?

Advantages: deters others from registering the same trade mark, helps you license the product to others, eases the seizure of infringing goods.

How to register a trade mark



Defining the goods or services to be covered

Before filing an application to register the trade mark that you have selected, it is necessary to select the relevant class(es) and define the scope of goods or services in each class that you want the trade mark to cover.

Classification

Most types of goods and services are classified amongst 45 different standard classes in accordance with the Nice International System of Classification and the classes that are relevant to your trade mark should be selected based on this system. For example, “clothing” is generally covered under class 25 and “software” is generally covered under class 9 whilst “financing services” is covered under class 36.



Describing the goods or services

The standardised terminology used to describe each of the goods or services within each class should also be utilised wherever possible. However, if no suitable standardised terminology exists to describe your goods or services, for instance where they relate to an entirely new technology, it may be appropriate to define the goods or services using appropriate bespoke language.

Consider future uses

It is very important that the description of goods or services is carefully considered before filing your application so that it accurately and thoroughly defines the relevant scope of goods or services that you wish the trade mark to cover as it will not be possible to expand the scope of the description in the application after it has been filed. It is also important to consider not only what goods or services you are currently using the trade mark in relation to, but also, what goods or services you intend to use the trade mark in relation to in future, or, what potential investors and/or licensees may require the trade mark to cover.

Extra classes, costs, and non-use

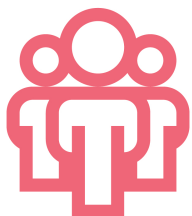
Although having broad coverage of goods or services under a trade mark may be advantageous, as the number of classes of goods or services covered by the trade mark increases, the costs of securing and maintaining the trade mark registration will also increase. Furthermore, even if the trade mark is ultimately registered in relation to a broad range of goods or services, unless the trade mark is actually used in relation to all of the goods or services, the trade mark may be subject to removal for non-use in relation to some or all of the goods or services covered.

The Dragon Law app makes selecting classes simple. Just type in keywords and the app does the rest.

> [Read how to submit a trade mark online.](#)

Who will own the trade mark?

A trade mark may be registered in the name of either a natural person, or, an incorporated entity.



Ultimately, the choice of trade mark and who will own the trade mark will have implications upon how the trade mark rights may later be enforced in infringement proceedings, and, how the trade mark should be used to avoid losing the rights.

Notably, only the owner or a licensee of the trade mark may initiate court proceedings for trade mark infringement, and, the owner or licensee should use the trade mark to ensure that the trade mark registration does not become subject to a removal by others on grounds of “non-use.”

Should a word and logo be registered together or separately as a trademark?

If your trade mark consists of a word and a logo in combination, it is generally advisable to try and register these elements as separate trade marks if each may satisfy the criteria for registration in their own right as this will provide for broader scope of protection and make it easier to enforce your trade mark rights against others. However, by splitting up a trade mark into individual word and logo elements for registration, it may be more difficult to argue the distinctiveness of each individual element, and this may increase the chances of rejection of both elements from registration as trade marks.

Where it is not possible to protect the individual elements of the trade mark separately, it may be possible to register the combined word and logo together as the overall complexity of the trade mark may render it distinctive.

Examination, allowance, and opposition

Before your trade mark application is accepted for registration, it must first be examined by the Trade Marks Registry to determine whether all statutory requirements for registration have been satisfied. During the examination process, the application will be assessed as to whether it complies with all requirements (e.g. whether the correct classes of goods or services have been selected or whether the terminology used to describe the goods or services is clear), as well as substantive requirements (e.g. whether the trade mark is distinctive and whether it may conflict with someone else’s earlier trade mark registration).



Objection notice

If there are any deficiencies in the trade mark application, the Trade Marks Registry will issue an official notice outlining the nature of the objections raised and the deadline by which it will be necessary to address the deficiencies. Opportunity will be provided to try and address the deficiencies, for instance by filing arguments in response to the objections or by suitably amending the application. It is important to file the response by the statutory deadlines provided otherwise the application will lapse.

Allowance, publication, and opposition

If there are no deficiencies found in the application or if the Trade Marks Registry is satisfied that all deficiencies in the application have been suitably addressed, an official notice will be issued advising of allowance of the application.



After allowance of the application but before registration, the details of your allowed application will be advertised in the Official Journal of the Trade Marks Registry, and third parties will then have the opportunity to oppose your application if they wish to do so.

Opposition

If an opposition is initiated against your application, it will be necessary to file a defence against the opposition within the statutory deadline for doing so, otherwise the application will be deemed to have lapsed.

If no opposition is initiated against your allowed application (which is the case with the vast majority of applications), the trade mark will proceed to registration and a certificate of registration will be issued evidencing registration of the trade mark.

How long does it take to register a trade mark?

The time taken for your trade mark to progress to registration will vary from case to case depending upon how busy the Trade Marks Registry is at any given time, and based upon the nature and complexity of any deficiencies in your trade mark that need to be addressed.

In a best case scenario where no objections are raised during examination, the application may take less than half a year to progress to registration.. In a worst case scenario it may take two years or more years to complete, for instance where the application encounters substantial objections during examination and/or is opposed by a third party.

Remember these key take aways when preparing your trade mark application:

> [Apply for a trade mark online with Dragon Law.](#)



Defining the goods or services to be covered

Consider the present and the future.



Who will own the trade mark?

Commercial decision of either a natural person or an incorporated entity.



Together or separate?

Words and logos registered separately receive a broader scope of protection.



Examination, allowance, & opposition

Time for addressing any deficiencies in an application.



Allowance, publication, & opposition

Opportunity for third parties to oppose application, if none, registration is issued.



How long does it take?

In the best case scenario, an application typically takes 5-6 months to progress to registration.

How to maintain and manage your trade mark after registration



After your trade mark has been registered, it is necessary to periodically pay a renewal fee to the respective jurisdiction's registry to keep the registration alive.

In addition to paying the renewal fees when they fall due, it is also important to regularly monitor and properly manage the way in which your trade mark is used on an ongoing basis to ensure that the value of your trade mark is maximised and to alleviate risk of your trade mark becoming invalid or subject to removal.

Registered and pending trademark status

Although not compulsory to do so, it is advisable to clearly display the ® symbol next to your registered trade mark, and the "TM" symbol next to your trade mark whilst it is still a pending application. This will serve as notice to others that your trade mark is actually being used as a trade mark and it will make it easier procedurally to enforce your trade mark rights against others if required.

List the registration number

If possible and practical to do so, the trade mark application or registration numbers should also be clearly indicated in relation to the relevant goods or services (for instance on the actual goods, packaging, brochures and marketing material, and on your website) so as to alleviate any potential confusion as to the existence and identify of your trade mark rights when enforcing such rights. It is very important that the correct trade mark markings be applied as statutory penalties may be applicable for "false marking."

Use it or lose it

If your trade mark is not being used in relation to all goods or services that are covered by your trade mark registration, it may become vulnerable to removal by others over time. Therefore, it is important to actually use your trade mark in relation to all relevant goods or services that you want to remain covered by the trade mark in order to defend against a possible removal action in future and to keep detailed records of this useage. Conversely, if over time you decide to no longer use the trade mark in relation to certain classes of goods or services, you may elect not to renew the registration in relation to those specific classes of goods or services that are no longer of commercial interest. This will reduce your costs for maintaining the registration.

Conduct regular consistency checks

Be sure to regularly check that the way in which you are using your trade mark is consistent with the trade mark that is actually registered. If there is any discrepancy between the use of your trade mark and the actual scope of the trade mark as registered, this may also expose your trade mark to a removal action in future on ground of non-use. Also, if you change the appearance of your trade mark or expand the scope of goods or services that your trade mark is used in relation to, it may be the case that your existing trade mark registration may no longer offer adequate protection. If this is the case, it would be necessary to file a new trade mark application covering the updated trade mark appearance and the expanded scope of goods or services.



Adoption as a generic name

If a trade mark becomes known by consumers as a generic name for the actual goods or services covered, it will lose its legal protection as a trade mark. To avoid this from happening, and in addition to using the “®” or “TM” symbols with your trade mark, you should always use your trade mark as an adjective (e.g. a Kleenex tissue) and avoid using your trade mark as a noun (e.g. a Kleenex) or as a verb (e.g. do not say “you will Xerox a document”, but instead say “you will make a copy using a Xerox copier”).

Communicate “proper usage”

Do also ensure that all members of your business, your licensees, distributors, and your consumers are regularly reminded and encouraged as to the proper usage of your trade mark, and if you become aware of any incorrect usage of your trade mark, you should take steps bring this to the attention of the appropriate parties as soon as possible.

Enforcing your trade mark rights

The Trade Marks Registry will not monitor any infringements or take action to enforce your trade mark rights on your behalf. Therefore, if you believe that others are using an identical or similar trade mark to yours in relation to similar goods or services covered by your trade mark without your authorisation, you should seek professional advice as soon as possible in order to assess the options available to you for enforcing your rights afforded under the trade mark.

Groundless threats

It is important that you do not prematurely accuse another party of infringing your trade mark rights or threaten to take action against them until you have first obtained professional advice confirming that you have legal basis for making such an allegation. In certain countries, you may be liable for making a “groundless threat” if it is the case that your trade mark rights have not actually been infringed.

Enforcement

If legal action is to be taken against an infringer, this should generally be commenced as soon as possible so that the infringer knows that you are serious about protecting your trade mark rights. Also, any undue delay in taking action against an infringer may potentially prejudice your ability to successfully enforce your rights in future.

Enforcement of your trade mark rights does not always mean resorting to litigation at first instance, which can be an expensive and complex process. There are various legal and non-legal options available before taking legal action before the courts to enforce your rights, although this may ultimately be the most appropriate course of action. By seeking the advice of a qualified and experienced trade mark professional, this will provide you with a better understanding of what options (both legal and non-legal) are available to you so that you may make an informed decision how best to proceed in enforcing your trade mark rights.



Renewal

A renewal fee is paid every 10 years in Hong Kong.



Maintenance

Alleviate risk of invalidation or removal by monitoring and managing the use of your trade mark.



Record use

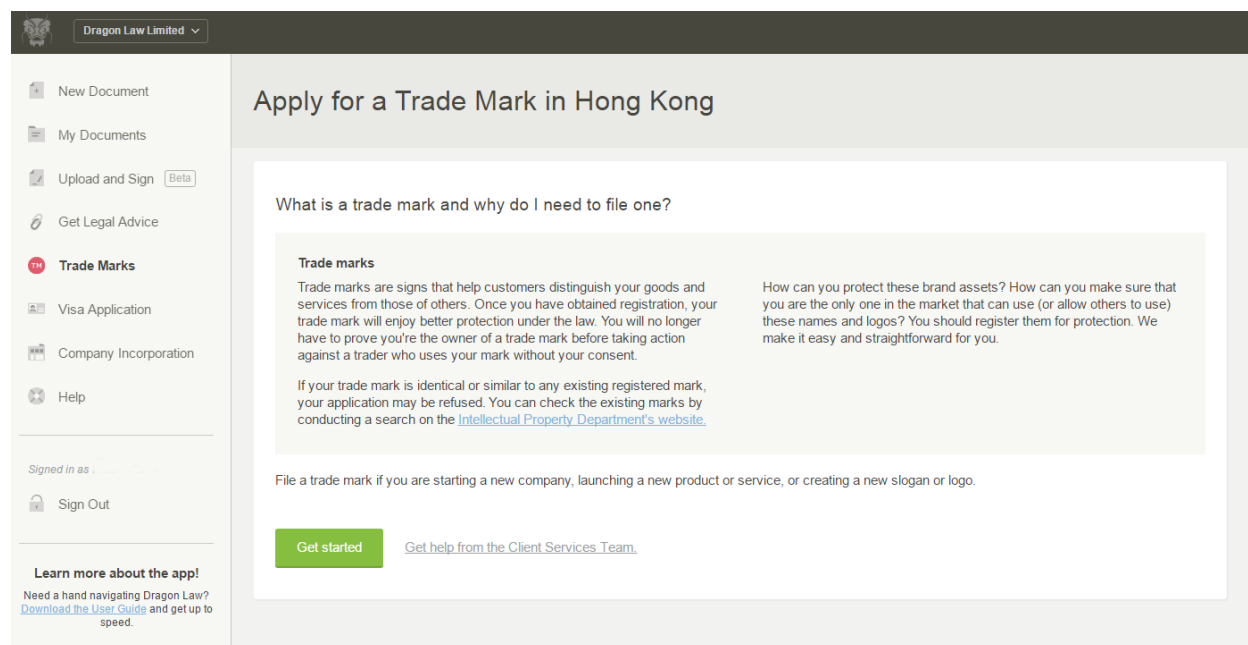
Helpful when defending from possible removal.

Register your trade mark online with Dragon Law

Securing intellectual property (IP) has never been easier.

It only takes a few minutes to submit a trade mark application or to draft a Copyright Assignment on the Dragon Law app.

Use this guide to help you prepare the needed answers to questions in a trade mark application.



Submit a trade mark application online with Dragon Law

Create an account with [Dragon Law](#) and sign in.

In the [Dragon Law app](#), click on *Trade Marks* from the menu on the left and then click on *Get Started*.

The workspace will guide you through several questions. Use the *Back* and *Next* buttons to navigate.

Question 1. Indicate who owns the trade mark. If the trade mark is a company logo, then the owner is likely your company.

Question 2. Specify the address of the trade mark owner. If the owner is your company, enter your company's registered office address.

Question 3. Specify the item you wish to register. If it is a logo, select *Brand Logo* and upload a high resolution image.

Question 4. Select the classes of goods and services the trade mark will be used for.



Note

Select goods and services that you do not want anyone to use your trade mark for, whether for promotion, sale, or other commercial purposes.

To select a good or service, type a keyword in the box.

You will see instant results of the standard terms used for trade mark applications worldwide. For example, if you sell bicycles, then you should type bicycles and select "bicycles/cycles" from Class 12.

Question 5. Indicate if you have used or will use the trade mark for the goods and services selected. If you have registered the same trade mark in another country, provide the details.

Question 6. If you answer no to Question 5, confirm that you will use the trade mark for the goods and services selected.

Question 7. Confirm if you have or have not filed the trade mark in any other country in the last six months. Provide the countries and the respective dates of filing if necessary.

Confirm the information and proceed to the next page for payment. If you have a promo code, you can enter it on this page.

Upon submission, you will receive an email confirming the receipt of your application. A report will be sent to you after the trade mark is filed.

Upon submission, you will receive an email confirming the receipt of your application. A report will be sent to you after the trade mark is filed.

Documents you will need

Intellectual property-related documents on the Dragon Law app:

Confidentiality Agreement (also known as a Non-disclosure Agreement)

A legal contract, also known as a non-disclosure agreement (NDA), that creates a relationship between parties to protect any type of confidential business information.

Trade Mark Licence Agreement

A legally binding document to allow one party to use (but not own) the trade marks of another party for the purpose of trade during a particular period.

Trade Mark Assignment

A contract that transfers the ownership of a trade mark, the goodwill of a business, and the rights to a trade name.

Copyright Assignment (Photo)

A contract to assign your rights over certain photos to another individual or business.

Copyright Assignment

A contract to buy or sell the copyright in a piece of literary work.

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About Letters & Thoo



Letters & Thoo is a specialist intellectual property practice based in Hong Kong with internationally recognised expertise in the procurement, management and protection of trade mark, patent, and industrial design rights both domestically and internationally.

The firm was established in 2013 by Dr. Timothy Letters and Mr. Laurence Thoo, both professionally qualified and registered patent and trade mark attorneys, after many years of practising at leading intellectual property firms in Hong Kong and Australia.

The firm's patent attorneys have established a proud track record of excellence in the field of intellectual property which has been consistently recognised by peer review in industry benchmark publications including International Asset Management (IAM) magazine's The World's Leading Patent Practitioners (2012, 2013, 2014, 2015 and 2016) and Asia IP Experts (2013).

Over the years our clients have come to know us not only for the uncompromising quality of our professional services but also for our commitment to providing friendly and responsive client care. Letters & Thoo strives to maintain these high standards by providing a unique range of client-focused intellectual property services for clients of all sizes and sectors which meet their commercial objectives cost-effectively.

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About Dragon Law

By leveraging **technology** and working hand in hand with several of the most **reputable local and international law firms**, Dragon Law provides an **end-to-end solution** to clients' legal needs.

Services include:

- Identify, create, sign, and store **legal documents**.
- Choose from a wide selection of customisable documents, compliant with either Singapore or Hong Kong law.
- Get **legal advice**. Request specialist legal advice and assistance through our network of law firms across Asia.
- Submit a **trade mark** application for immediate filing.
- Get **incorporated** in any country.
- Apply for **visas**.

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The Team 20+ years of experience in leading law firms, tech companies, and consulting firms across Asia, Europe, and the USA.

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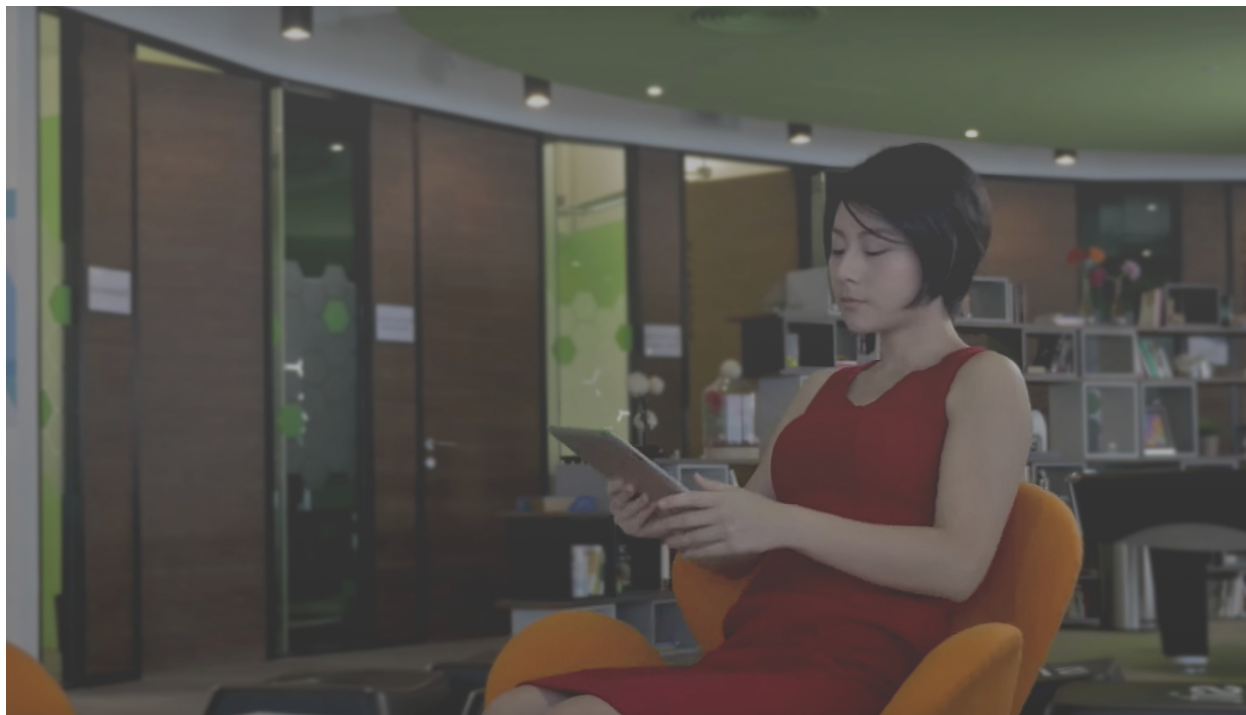
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