

The Hong Kong Institute of Trade Mark Practitioners Limited



🎄 THE JOURNAL 🎄

*Vol. 10 No. 1
December 2015*

Message from the President

Dear Members,

As 2015 comes to a close, I would like to thank our immediate past President Justin Davidson for his leadership and hard work over the past two years and to our council members for their invaluable support and contribution to the work of the Institute. Under Justin's leadership, the Institute has continued to be an important voice for Hong Kong's intellectual property practitioners, communicating members' views to the legislature and the Intellectual Property Department on legislative change and trade mark practice.

For 2016 we are looking forward to the launch of our new website, thanks to the efforts of Jeffrey Mclean and Barry Yen, and to further opportunities for members to meet and socialise with fellow members at our very popular lunchtime seminars and social gatherings. In addition to our regular newsletters, I would also like to invite members to make use of resources such as the Institute's LinkedIn page as a way of keeping in touch and sharing news and information.

Finally, we are always open to hearing from members on any suggestions for the Institute, for example, seminar speakers or any other ideas that can help further the Institute's aims.

Merry Christmas and best wishes for 2016.

Davina Lee
HKITMP President





EVENTS AND ACTIVITIES

Past Events

1. 2015 Lunchtime Seminars

The Institute continued to run the popular lunch time seminar series. In 2015 we organized four seminars:

- **Douglas Clark** on New Developments in IP Litigation in China on 30 January 2015.
- **Jong Lee** on Tangible and Intangible Markets: Monetizing Ideas in Asia on 31 March 2015.
- **Winnie Tam SC** on Recent jurisprudence on confusion and deception in trade mark infringement and passing-off on 17 June 2015.
- **Philips Wong** on Practice in Trade Marks Registry (Contentious Proceedings) on 24 November 2015.

2. Visit from the Commissioner KIPO



Kim Youngmin, Gregory So and Ada Leung

The Institute hosted a meeting with the Commissioner of the Korean Intellectual Property Office on his visit to Hong Kong and HKITMP President, Justin Davidson, also witnessed the signing of a Memorandum of Understanding between KIPO and IPD on 29 January 2015.

3. HKITMP Graffiti Nite



Justin Davidson and HKITMP artwork

This year's summer social event was a lesson on graffiti art spray painting held on the Kowloon rooftop of the Pantone Graffiti Workshop on 7 July 2015 and was well attended by members.

Please pass any requests for future social event activities to the HKITMP President.



4. HKITMP AGM

The 2015 HKITMP AGM and Dinner was held at the Forum Restaurant, Causeway Bay, on 29 October 2015. We were entertained after dinner by this year's speaker, Clifford Borg-Marks, former Maltese Ambassador to China and long time IP practitioner in Hong Kong (with Baker McKenzie, Bird & Bird, Hogan Lovells and now consulting with SIPS). Clifford gave a very interesting and entertaining talk on life as a diplomat for Malta.



From left to right: Davina Lee (President), Clifford Borg-Marks and Justin Davidson (immediate Past President)

This year, Davina Lee, Benjamin Choi, Charmaine Koo, Ruby Chan, Theresa Mak, Serena Lim, Andrea Fong and Winnie Yue were obliged to step down from Council, though happily all eight re-stood and were re-elected for another term. Following the AGM, a short Council meeting was held and the Institute's appointed Officers and Council Members for 2015-2016 are now:

President:	Lee, Davina	Marks & Clerk
Vice President:	Choi, Benjamin	Mayer Brown JSM
Secretary:	Lim, Serena	Hogan Lovells
Membership Secretary:	Mak, Theresa	Yu & Partners
Treasurer:	Houng, Cynthia	Marks & Clerk
Council Members:	Birt, Steven	Reed Smith Richards Butler
	Bodnar-Horvath, Nicholas	Bodnar Horvath Solicitors & Notaries
	Cheung, Peggy Po Yee	Jones Day
	Chan, Ruby Yu-Ting	Baker & McKenzie
	Davidson, Justin C.	Norton Rose Fulbright
	Fong, Andrea	Wilkinson & Grist
	Gibbons, Sandra	Marks & Clerk
	Koo, Charmaine	Deacons
	Lau, Patsy	Deacons
	Mclean, Jeff (Co-opted)	Deacons
	Tang, Helen	Simone IP Services
	Yen, Barry	So Keung Yip & Sin
	Yue, Winnie	Deacons



5. HKITMP IP Prize



The recipient of the Institute Prize for Intellectual Property in the Principles of Intellectual Property Course for the academic year 2014-2015 is Lydia Leung of the Chinese University of Hong Kong. Lydia was able to join us at our Annual General Meeting dinner.

6. Panel Session at Business of IP Asia Forum 2015



Mr CY Leung, opening BIP Asia

The Institute participated again in the Business of IP Asia Forum co-organised by the Intellectual Property Department and the Hong Kong Trade and Development Council on 3 & 4 December 2015.

The Institute co-organized one of the panel sessions on "Innovation and New Licensing Models in Asia: Lessons learned from the Hi-Tech industry". The panel session was moderated by the Institute's immediate Past President, Justin Davidson and panellists included Keith Bergelt of Open Invention Network, Pindar Wong of Verifi and Nicholas Mak of Microsoft.



Mr Francis Gurry, Director General of WIPO

Future Events

Lunch time seminar in January 2016

Martin Howe QC, visiting from London, will speak to the Institute on celebrity image rights and the Rihanna case (on which he was the lead counsel) on **14 January 2016**. Details of the seminar will be circulated shortly. Our seminars are free for Members (plus HKD100 if collecting CPD) and HKD200 for non-members, space permitting.



Dates for your diary

INTA – Orlando, Florida – 21-25 May 2016

LEGAL UPDATES

IPD Biannual Meetings

1. Updates On Issues Raised By HKITMP Members At Previous Meetings

a) Proposed provision of company description of trade mark applicants

The consensus of the HKITMP, the IP Committee of the Law Society, APAA and the Licensing Executive Society was that IPD should and could require additional details in Form T2 regarding country of incorporation of trade mark applicants, and the requirement of such details was in line with international norm and practice. As practitioners were obliged to know what clients they were dealing with and for proper due diligence, we considered that it was within IPD's power to ask for details on country of incorporation from applicants. As a pragmatic way forward, the Institute suggested that a box could be included in Form T2; it could be optional and IPD did not have to refuse the form if the relevant information was not provided. We pointed out that it was a mandatory requirement in the UK and Singapore for applicants to provide the relevant information in the form.

IPD responded that the Department of Justice had previously advised that the Registrar could only require such information from applicant as was relevant to the Registrar's duty in conducting examination. At present, the Registrar would distinguish between different entities that bear the same name by looking at their addresses. In view of the latest views from HKITMP and the three other bodies, IPD would re-consider the matter again and seek advice from the Department of Justice as appropriate.

b) The issue of engaging law costs draftsman by a non-law firm to prepare a bill of costs for taxation

IPD informed the meeting that the Trade Marks Registry Work Manual Chapter on "Taxation of Costs" had been revised to provide details on who may prepare a bill of costs, including law costs draftsmen instructed by a party or his agent. We indicated that some law costs draftsmen felt that they were bound by the Court's Practice Direction as they could not prepare a bill of costs in the absence of the instruction from a solicitor. We said that it would be contrary to the spirit of the Trade Marks Ordinance if a lay person could apply for and attend hearing on a trade mark application but could not engage experts to help prepare the bill of costs.



IPD suggested that if there were any problems concerning the matter, law costs draftsmen should enquire directly with IPD.

c) Proposed application of Madrid Protocol to HKSAR

IPD informed the meeting that the three-month consultation period had ended on 11 February 2015 and 21 submissions, including one from HKITMP, were received. IPD was now considering all the submissions and would get back to HKITMP in due course.

We asked if IPD had any timetable in place. IPD responded that there was no definitive timetable, but IPD anticipated that once a decision was made, it would take 3 to 4 years for implementation. IPD had invited experts from the World Intellectual Property Organization to visit IPD to provide technical advice and would arrange visits to the International Bureau in due course. The Government therefore would not be able to make a decision within a short period of time. It would however keep the matter in view as some Legislative Council members asked IPD to proceed as soon as it could.

d) Official Fees review exercise conducted by IPD

IPD reported that new Registry fees came into effect on 30 March 2015. Given that fee revision was meant to be an annual exercise, IPD would consider reviewing the fees by smaller amounts annually in future.

The Institute requested that HKITMP be involved in the earlier stage of discussion rather than at the biannual meetings in the future fee revision exercises and meeting could be set up for the purpose. IPD explained that it would not be able to disclose relevant details of fee revision proposals before internal clearance, but agreed with HKITMP that an informal meeting could be arranged to discuss possible scenarios rather than the exact details.

IPD said that the comments received from the Law Society of Hong Kong and others had been seriously considered by both the Government and the Legislative Council in the fee revision exercise, and a LegCo sub-committee meeting was held in February 2015 to examine IPD's fee revision proposals. The LegCo sub-committee recognised that the main principle for the fee review exercise was to achieve full cost recovery and did not propose any amendments to IPD's proposal. IPD estimated that after the new fees took effect, it would be achieving 100% full cost recovery for each Registry. Some LegCo sub-committee members considered that the reduction in renewal fees may lead to retention of disused trade marks and possible abuse. IPD undertook to keep track of grounds of objection on relative grounds in future trade mark applications and signs of possible abuse.

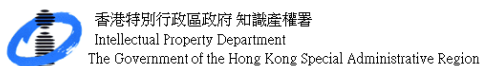


2. Bi-Annual Meetings

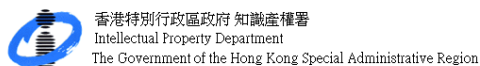
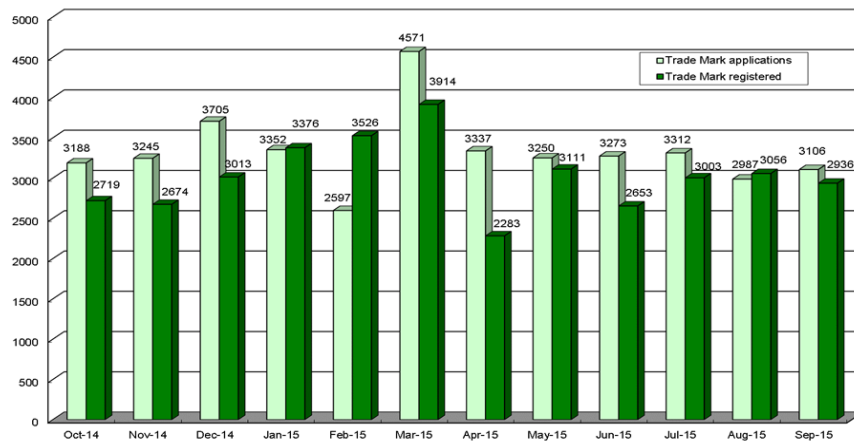
Bi-Annual meetings with the IPD took place on 22 April and 26 October 2015.

A. Summary of Statistics from IPD

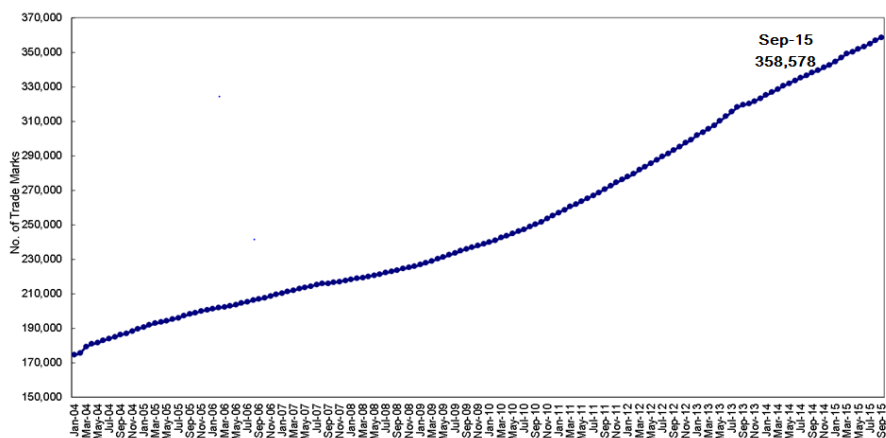
The IPD provided the following statistics:



Trade Marks Registry
Number of trade mark applications received and trade mark registered
(October 2014 – September 2015)



Trade Marks Registry
Number of trade marks in force
(January 2004 – September 2015)





IPD informed the meeting that the number of trade mark applications received during the period from April 2014 to March 2015 (“that period”) kept rising. There was an increase of 4.34% during that period based on the average month-on-month comparison, with a sharp increase in applications in March 2015 possibly due to the influx of applications prior to the fee increase. The total number of trade mark applications received during that period was 41,523 (covering 79,195 classes) with an average of 3,460 applications received per month. The number of outstanding trade mark applications as at March 2015 was 12,755.

IPD informed the meeting that there were 287 registered e-filers as at September 2015, compared with 252 registered e-filers as at September 2014.

There was an increase in the number of standard patent ‘request to record’ applications based on average month-on-month comparison for the period Oct 2014 to Sep 2015 (i.e. 1.84%). For short-term patent applications, there was an increase in the number of applications received based on average month-on-month comparison for the period Oct 2014 to Sep 2015 (i.e. 4.68%). For design applications, there was an increase in the number of designs applied for registration based on average month-on-month comparison for the period Oct 2014 to Sep 2015 (i.e. 4.44%).

B. Issues Raised By HKITMP Members

a) Registry’s changing positions on citations – multiple Rule 13(1) opinions issued

We said that there was a case where three Rule 13(1) opinions were issued by the Trade Marks Registry. IPD responded that, having looked into the matter, it considered that that was an isolated case. IPD expressed its regrets and had reminded the examiner to be mindful in future. It would also ask all examiners to be more careful as re-issuance of Rule 13(1) opinion was rare and should be avoided.

b) Deficiencies – whether objection raised by examiner is justified

We expressed concern over the handling of a deficiency checking case by an examiner. Having looked into the matter, IPD confirmed that it was an isolated case. IPD considered that there was no need to qualify the items mentioned in the specification of an application if such item fell within that class. The examiner concerned had been reminded to be more careful in the future.

c) Delay of up to six months in recording assignments at the Patent Registry

IPD explained that due to constraints in human resources and the deployment of examiners to provide guidance to the new office operation service contractor and to monitor its performance, there was delay in handling patent assignment applications. IPD considered that the performance



of that contractor was now more or less back to normal and the Registry was looking into measures to catch up on the backlog and to streamline the processing of applications.

d) Inclusion of agent reference in notifications of non-payment of patent renewal fee

We asked if agent references could be included in the notifications of non-payment of patent renewal fee so that it would be easier for practitioners to keep track of their cases.

IPD reported that it would seek to enhance the computer system to provide for the inclusion of agent references in such notifications.

e) Applicant's evidence in non-use revocation proceedings

We expressed concern that an applicant in non-use revocation proceedings had to file extensive evidence when the onus was on the owner to prove use. HKITMP came across a case where the applicant was asked to file additional evidence, which contrasted the UK situation where a registration would be revoked if the owner did not file a counter-statement. On some occasions, applicants had difficulties in collating evidence, and applicants had to incur costs in order to obtain investigation reports as evidence.

IPD replied that the Trade Marks Ordinance required an applicant to put in some evidence to initiate the revocation proceedings. If no counter-statement was filed by the owner and the application was treated as unopposed, the Registrar may proceed to issue a revocation order without an oral hearing. In some cases, the Registrar would ask the applicant to consider filing additional evidence if the evidence already filed was inadequate, for instance, it was not directed at the relevant period. The Registry did not require applicants to file specific evidence such as an investigation report. The Registry would keep in view the comments of the representative in considering evidence filed by the applicants.

The UK legislation on revocation was different from that of Hong Kong. IPD confirmed that although the applicant was required to file prima facie evidence of non-use, the onus was on the owner to prove use.

f) Delay in posting documents re inter-partes matters in online register

We expressed concern that pleadings including the notice of opposition and the counter-statement were not made available online for a long time on many occasions. IPD explained that it would take some time to perform checking and redacting personal data from the documents, scanning etc., before the documents could be uploaded online, and with tight manpower resources, this task had been given a low priority. IPD however acknowledged that it should update information on the



website as soon as possible, and it was considering measures to shorten the processing time. It would also accord priority to certain cases.

We also enquired whether online renewal could accommodate three joint owners or such renewal should be performed manually. IPD explained that the online system was designed to cater for multiple owners and therefore could handle such request.

g) Online status of trade mark applications

We enquired about a trade mark application that was published since June 2013 but the application status had not been updated and remained “Application Published”, which meant that the application had been published for opposition purpose. IPD considered that that could be due to other pending matters, for instance the filing of Form T5A after publication.

C. Other Business

Provision of lists for “Commonly used descriptions of goods or services and their class numbers”

IPD reported that to facilitate applicants or agents to complete the specification of goods or services when filing Forms T1 and T2, the Registry had prepared lists setting out the commonly used descriptions of goods and services in some classes which were now available at the Public Service Counter of IPD. The lists would also be posted onto the IPD website (http://www.ipd.gov.hk/eng/forms_fees/trademarks_559/Common_spec.htm). The lists would be subject to review and IPD would appreciate feedback on the lists. IPD said that if applicants found the lists useful, IPD would prepare the lists for all other classes.

MEMBERSHIP

Please contact our Membership Secretary, Theresa Mak, at membership@hkitmp.org if there are any changes in your contact details.

2015 Moves

Name	From	To
Michelle Yee	Norton Rose Fulbright	Mayer Brown JSM



New Members

We were pleased to welcome seven new members of the Institute in 2015:

1. Katherine Lai of Marks & Clerk
2. Yannie Chan of inCompass IP International
3. Alan Chiu of Hogan Lovells
4. Eugene Low of Hogan Lovells
5. Amy Chung of Deacons
6. Marcia Lee of Baker & McKenzie
7. Rhonda Tin of AWA Asia Limited

QUIZ

Last Issue's Question: Guess the number of trade mark applications which will be filed in Hong Kong in January 2015?

A: 3,352 trade mark applications were filed in Hong Kong in January 2015.

This Issue's Question:

Q: Who is the only US president to have a patent in his name?



*Merry Christmas
and
Happy New Year!*

© Hong Kong Institute of Trade Mark Practitioners Ltd
December 2015