

## The Hong Kong Institute of Trade Mark Practitioners

### President's Report 2005/2006

1. The AGM sees the end of my first year of a two-year term and I think it is fair to say that it has been a fairly busy year which has produced some results, with hopefully more results to be achieved from the efforts that have been made to date.

2. I have done my best to keep members informed of developments and activities of the Council throughout the year, and I trust that this greater communication has been well received. I have had a number of useful comments from the membership on the various issues that have been circulated to members, which has also facilitated the Council's work.

#### Proposal for amendment of Section 22 of the Companies Ordinance

3. Members would have seen the various correspondences that I had with Mr. Gordon Jones of the Companies Registry concerning the ever-increasing problem of companies being registered in Hong Kong with company names that incorporate well-known registered trade marks or company names; and, perhaps most importantly, the apparent inability of the Companies Registry to either strike off the company or change its name where a trade mark owner has even gone to the trouble of issuing proceedings, obtaining a Court Order requiring the company to change its name and then seeking to enforce that Order. This is clearly an unsatisfactory state of affairs and a hole in the law which needs to be rectified.

4. Our correspondences with the Companies Registry resulted in a meeting with Mr. Gordon Jones and four other senior officers at the Companies Registry on both legal and administrative sides, which was attended by myself and Barry Yen (Vice President). At this meeting we put forward the prospect of a very simple amendment to Section 22 of the Companies Ordinance. This has been incorporated into a formal proposal for such amendment, to be possibly taken forward in the form of a Private Members Bill. Unfortunately, as the Government has already announced its plans to undertake a complete review of the Companies Ordinance, there is no prospect of the Government itself implementing the changes, notwithstanding its simplicity.

5. The Companies Registry has informed us that the proposal is currently being considered by it and the relevant Government departments and we will be pushing it forward in the next few months.

#### Register of Trade Mark Agents

6. Members would also have seen the proposal for a Register of a Trade Mark Agents that, with the Institute's initiative, has been submitted to the Intellectual Property Department with the endorsement of the Asian Patent Attorneys Association ("APAA") and the Law Society. The aim of the proposal for a register is to ensure the maintenance of high standards in the trade mark profession in Hong Kong, and to provide a register which should be of great benefit to trade mark owners to identify experienced and qualified practitioners. An initial response has been

received (back) from the Intellectual Property Department which the Council has not yet had the opportunity to consider, but which will be addressed in the next few months.

7. I wish to thank Henry Wheare who is retiring from the Council as of the AGM on 27<sup>th</sup> September 2006, for his great contribution to the preparation of the proposal and his coordination with the relevant committees at APAA and the Law Society.

#### Copyright

8. Members will recall that in February 2005 the Institute filed a comprehensive submission in response to the Government's discussion papers titled "Review of Certain Provisions of the Copyright Ordinance". Earlier this year the Government published its Copyright (Amendment) Bill 2006 which incorporated many of the intended provisions referred to in the consultation paper.

9. The Institute's Copyright Committee, consisting of myself, Barry Yen and Charmaine Koo, prepared a formal response to the Commerce, Industry and Technology Bureau on certain of the provisions referred to in the Bill. Further developments on the Copyright Bill are awaited.

#### Interactive Services and Amendments to the Trade Mark Rules

10. In November 2005 the Intellectual Property Department proposed certain amendments to the Trade Mark Rules to facilitate the roll-out of electronic services relating to renewal of trade marks and to record certain changes to registered particulars (such as assignment and security interests). The Council considered the proposed amendments and whilst we generally agreed with them and approved the Intellectual Property Department's proposal, the Council strongly objected to the proposed amendments for the alteration of the terms of a licence or security interest by the grantee of the licence or security interest. The Council considered that it should be a matter to be addressed by both grantor and grantee.

11. The Intellectual Property Department accepted our concerns and the Trade Mark Rules were amended in respect of the remaining items.

#### Awarding costs in Trade Marks Registry proceedings

12. In October 2005, the Intellectual Property Department put forward a proposal for a scale of costs in respect of the various procedures in opposition, revocation, invalidity and rectification proceedings, seeking to adopt a scale for similar items that are adopted in the United Kingdom. The Intellectual Property Department's proposal was circulated to the Institute, APAA, Law Society and the Bar Association. The Council proposed to members that there should only be a scale for limited items, namely filing notice of opposition or counter statements, perusal of the same and preparation for attendance at an extension of time hearing, with the proviso that the Registrar's discretion should not ultimately be affected. The proposal secured the support from APAA, the Law Society and Bar Association and appears to have found favour with the Intellectual Property Department also.

## CEPA

13. The Institute has been in liaison with the Intellectual Property Department concerning the accessibility of Hong Kong practitioners to practise in the Mainland. Our correspondence arose as a result of certain difficulties encountered by some members and we are endeavouring to get to the bottom of the situation. Further news on this will be available shortly.

## IPD meetings

14. On 23<sup>rd</sup> May 2006 myself and other council members attended the biannual meeting with the IPD at which various matters were discussed concerning the Registry's practice and procedures, namely, awarding costs in Trade Marks Registry proceedings, taxation of costs, amendment of Trade Mark Rules, company name problems regarding registered trade marks, the IPD's five-day week, continuing roll-out of interactive services, and mainland/Hong Kong cooperation. We will continue to have close relations with the IPD and keep you informed.

## New members

15. I am pleased to report that the Institute has taken numerous new members during the year, namely Zhang Hailing of China Patent Agent, Angela Chu of Baker & McKenzie, Maggie Chong of DLA Piper, Gloria Chow of Deacons, Winnie Lai of Johnson Stokes & Master, Jeannie Lam of Deacons, Ted Marr of Allens Arthur Robinson, John Slater of Simmons & Simmons, Cynthia Houg of Yu & Partners, Andrea Fong of Wilkinson & Grist and Vera Sung of Oldham, Li & Nie. Georgia Chiu and Kim Nicholson ceased to be members.

16. Members should note that whilst we do have requirements for membership in the articles which the Council needs to uphold (and which has resulted in a number of applicants being rejected from membership), the Institute is also keen to encourage new members. To this end, the Council has put forward an amendment to Affiliate member status which is to be dealt with at the EGM/AGM on 27<sup>th</sup> September 2006, with the aim of extending eligibility for membership.

## Council Members

17. For the past 12 months, members serving on Council have been

Steven Birt	-	President
Barry Yen	-	Vice President
Davina Lee	-	Treasurer
Kim Nicholson / Helen Tang	-	Secretary
Justin Davidson	-	Membership Secretary
Peggy Cheung / Anne Choi / Lindsay Esler / Graeme Hall / Nicholas Horvath / Patsy Lau / Sandra Gibbons / Charmaine Koo / Henry Wheare / Barry Yen / Winnie Yue / Judith Eeles		

18. At the AGM, Charmaine Koo, Helen Tang, Graeme Hall, Henry Wheare, Sandra Gibbons, Winnie Yue and Nicholas Horvath will stand down from Council. They may stand for re-election. In addition, Davina Lee and Kim Nicholson have left Hong Kong.

19. Henry Wheare and Graeme Hall have both decided not to stand for re-election. Both Henry and Graeme (a past President) have contributed much time and effort in their work on Council, and I extend the Institute's thanks to them for that. Unfortunately, neither can attend the AGM tonight.

20. In addition, Davina Lee and Kim Nicholson were on the Council for several years and have both decided to leave Hong Kong, at least for the time being, to pursue their careers overseas. We wish them well in their endeavours.

#### Social events

21. As it has been such a busy year we have unfortunately only had time to arrange one social event, namely the Spring Dinner on 1<sup>st</sup> March 2006 at Kee Club. This was a very enjoyable evening with 56 attendees, which is just about half of the membership. Members enjoyed the evening with fine food and wine completed with a presentation by Mike McKevith, Head of Regional Counterfeiting of Philip Morris.

#### Member invitations

22. In the course of the year there have been a number of general invitations that have been circulated to members including the following:

- IPD lecture on marketing dietary supplements/traditional medicines globally-legal aspects - 21<sup>st</sup> October 2005;
- Meeting with delegation from the State Intellectual Property Office of China - 5<sup>th</sup> November 2005;
- Mainland, Hong Kong and Macau Intellectual Property's emporium 2005 - 24<sup>th</sup> & 25<sup>th</sup> November 2005;
- IPD lecture - Friend or Foe: Section 337 IP Infringement Investigations of United States International Trade Commission - 18<sup>th</sup> January 2006;
- IPD lecture on an Update on the Development of EC and UK case law on trade mark protection - 24<sup>th</sup> February 2006;
- Seminar organized by the Guangdong/Hong Kong experts group on the protection of intellectual property rights in Zhanjiang - 5<sup>th</sup> March 2006;
- IPD lecture on making the IP system meet users' needs - 16<sup>th</sup> March 2006;
- IPD seminar with the American Intellectual Property Law Association Far East Committee Delegation - 12<sup>th</sup> May 2006;
- Call for paper (in Chinese) for the Pan-Pearl River Delta Intellectual Property Forum - June 2006;
- IPD lecture on some recent developments in EU and UK trade mark law - 23<sup>rd</sup> June 2006;
- Invitation to attend APEC IPR public education and awareness platform 2006 - workshop on effective strategies for IP public education - 8<sup>th</sup>-10<sup>th</sup> November 2006.

## Newsletter

23. Just one newsletter was sent to members in April 2006 which members hopefully found informative. The past Presidents have aimed to issue more than one newsletter in each year, but it has not been possible this year due to the number of activities that were ongoing throughout the year. However, as members have been kept informed throughout, I hope that the lack of more newsletters has been compensated with my regular updates on our activities.

I am looking forward to my second year which I am sure will prove to be equally challenging as the year just gone.

Steven Birt  
President  
27<sup>th</sup> September 2006