



## The Hong Kong Institute of Trade Mark Practitioners

### President's Report 2006/2007

1. The AGM sees the end of my two-year term and I think it is fair to say that it has been a fairly busy two years which has produced some results, with hopefully more results to be achieved from the efforts that have been made to date.
2. As in my first year, 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. However, feedback could have been greater and I would encourage members to be more forthcoming for the new President, as your input really is needed and valued.

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

3. Members will recall 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.
4. I have previously reported that 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. Unfortunately, there is no prospect of the Government itself implementing the changes, notwithstanding its simplicity.
5. In the absence of Government support, the Council decided that the only way to move forward with our proposal was in the form of a Private Members Bill. A revised form of our proposal was prepared following discussion with Ms. Margaret Ng, and a proposal was obtained from a well-known lobbying firm in Hong Kong, with a view to their assisting in lobbying members of LEGCO for the Bill. Due to the costs involved, the Institute is not in a position to drive this forward itself. Support has been sought from the Japanese government (with whom myself and Barry Yen have met), the United States Trade Department, Am Cham, INTA and the Quality



Brands Protection Committee (China) for financial support. Responses we have had back indicated those parties are considering the proposal and funding. We remain hopeful that funding will be made available, but in the event it is not, we believe we have done a very good job in bringing this issue to the Government's attention.

6. Indeed, the Companies Registry has set up a liaison group, of which myself, Barry Yen, Charmaine Koo and Justin Davidson are participants, and through that group the Companies Registry has proposed amendments to Certificates of Incorporation to incorporate a notice that registration of a company name with the Companies Registry does not confer intellectual property rights over the company name. The Companies Registry is also willing to issue an appropriate letter, upon request, to confirm this. We believe this step by the Companies Registry, although not an answer to the problem, is a positive move which may assist addressing counterfeiting activities in the Mainland.

#### Register of Trade Mark Agents

7. Members will also recall the proposal for a Register of a Trade Mark Agents that, with the Institute's initiative, had 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.

8. After discussing the matter with the IPD, further internal discussions among the Council, and due to logistical difficulties in the establishment of a formal register, the Institute has filed trade mark applications in Hong Kong for collective trade marks, which in due course it is hoped will result in greater recognition of Institute membership.

#### Scale Costs of Trade Mark Cases

9. Earlier this year the Law Society issued revised scale of costs for trade mark cases, in which the major changes were in the scale costs for searches, applications, renewals, amendment of entries of the Register and division of applications. Such revised fees were encouraged by the Institute as such fees had not been changed in many years, I believe over 15 years, and we believe the fees are more reflective of the work and investment of practitioners in providing such services. At the same time the increased fees are not too high, which also ensures that Hong Kong remains a competitive country/territory in which to register trade marks, from a pricing perspective.

10. I also take this opportunity to remind members that membership of the Institute includes an obligation incorporated in the Articles of Association that members will follow the scale of costs recommended by the Law Society from time to time. Two members were expelled from the



Institute for offering their firm's services at a very substantial discount to the scale of costs. Whilst we are keen to encourage new members to the Institute, we also wish to maintain standards across the profession. The maintenance of a level playing field on pricing at a cost that is reasonable to our clients and enables proper resources to be made available, is the primary objective of the scale fee aspect of membership, and I hope that members recognize the benefit of this approach.

11. The Law Society also introduced recommended scales of costs for patent and design cases (which are not required to be followed by members of the Institute). If members have any comments on those, we remain open to receiving comments from you.

### Copyright

12. The Government issued a Consultation Paper on Copyright and Internet Matters, seeking views on whether and how the Copyright Ordinance should be amended to ensure that it is effective in protecting copyright in the face of rapid technological developments.

13. The Institute copyright committee, consisting of myself, Barry Yen, Winnie Yue and Charmaine Koo, prepared a formal response to the Commerce and Industry branch of the Commerce, Industry and Technology Bureau on each of the issues referred to in the consultation paper. Further developments are awaited in due course.

### Patents

14. The Government had proposed to amend the Patents Ordinance to implement the Protocol for Amendment of the TRIPS Agreement, in order (among other things) to enable the Government to itself take advantage of patent rights in the event of extreme emergency. The proposed amendments in Hong Kong appear to be consistent with the Protocol. Mark Irons reviewed the proposed amendments and his comments were incorporated in a submission that was made to the IPD. A Patent Amendment Bill 2007 has since been published with these changes.

### IPD meetings

15. On 27<sup>th</sup> October 2006, myself and other Council members attended a meeting with the IPD at which various matters were discussed concerning the Registry practice and procedures, including:-

- (a) we raised issues with the IPD concerning difficulties in device code searches, following which the IPD has stated it is going use sub-categories for device coding of individual letters and has started to revise the codes assigned to stylised letter marks;



- (b) the use of Ming Font in Registry letters and certificates, online search and e-filing website interface. We identified that this sometimes result in breaks in the applicant's name which are not actually there. The IPD has since justified its use of Ming Font on its website as being the most adaptable font for various international characters such as simplified and traditional Chinese, Japanese and certain European and Latin characters. The Institute's comments will hopefully ensure closer scrutiny of how the IPD documents appear.
16. We also met with the IPD again on 21<sup>st</sup> May 2007 at which other issues were discussed including:-
- (a) Institute views on the disclosure of personal data and business information on the IPD website;
- (b) the role of Hong Kong Productivity Council and its continued representation on behalf of foreign applicants, in respect of which the IPD has passed on the Institute's concern that a Government department should not be providing such services to foreign companies in competition with our members. The Institute's pressure has resulted in an unofficial undertaking from the HKPC to not participate in such activities. This is a matter of continued observation by the Institute;
- (c) the IPD undertook to notify us of changes in the Registry Work Manual including specific notification of what changes have been made. This has already been implemented and hopefully members are benefiting from this additional information made available by the IPD.

#### Social events

17. Although it has been such a busy year we have had time to arrange two social events, namely the Spring Dinner on 14<sup>th</sup> March 2007 at Kee Club. This was a very enjoyable evening with the usual strong attendance. Members enjoyed the evening with fine food and wine completed with a presentation by Bernie Hung, Legal Counsel, Asia Pacific, for Gucci Group.

18. On 15<sup>th</sup> August 2007 we held a 10-pin bowling evening at the Hong Kong Club. This was great fun with bottles of champagne represented as prizes for the best male and best female performance.

#### Member invitations

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



- IPD joint seminar with the Guangdong Province Intellectual Property Office on 3<sup>rd</sup> April 2007.
- IPD public lecture on IPR Enforcement and Global Village, 20<sup>th</sup> March 2007;
- IPD lecture on 2007-a year of change and update on procedures and practices in the UK, 30<sup>th</sup> March 2007;
- IPD invitation for submission on Bills Committee on Patents (Amendment) Bill 2007;
- IPD invitation to seminar on exploring marketing opportunities in supporting the Olympic Games, 22<sup>nd</sup> May 2007;
- High level seminar on IP Laws in Qingdao, 26 - 30<sup>th</sup> May 2007;
- Preparatory the course for 2007 National Qualification Examination for Patent Agency;
- Invitation for submission on the Paris Convention on choice of Court Agreements Constitution Paper;
- Linkage to Pan-PRD Patent agency search database seminar;
- Invitation to join Igors Group Privilege Card;
- IPD invitation to the HK and Macau Intellectual Property Symposium 2007, 24<sup>th</sup> October 2007;
- IPD invitation to high level seminar on IP Laws in Guangzhou, 20<sup>th</sup> - 23<sup>rd</sup> October 2007

#### New members

20. I am pleased to report that the Institute has accepted 5 new ordinary members, 2 affiliate members and 3 student members during the year, namely Emmy Chow Lai-On of Deacons, Tim Hancock of Haldanes, Melvin Li of Lloyd Wise & Co., Allan Woodley of Lovells, Kristy Lau Sin-Fan of Marks & Clerk, Edward Alder of Prince's Chambers, Andrew Chan Ka Pong of Richards Butler, Shirley Chan Yu Ting of Johnson Stokes & Master, Shirley Kwok of Bird & Bird and Connie Mak Suk Han of Baker & Mckenzie.

#### Council Members

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

Steven Birt	-	President
Barry Yen	-	Vice President
Andrea Fong	-	Treasurer
Helen Tang	-	Secretary
Justin Davidson	-	Membership Secretary
Peggy Cheung / Anne Choi / Lindsay Esler / Nicholas Horvath / Patsy Lau / Sandra Gibbons / Charmaine Koo / Barry Yen / Winnie Yue / Judith Eeles / Mark Irons		



22. At the AGM, Anne Choi, Judith Eeles, Peggy Cheung, Helen Tang, Justin Davidson, Pasty Lau and Lindsay Esler will stand down from Council. They may stand for re-election.

23. Lindsay Esler, Anne Choi and Judith Eeles have decided not to stand for re-election. All three have contributed much time and effort in their work on Council, and I extend the Institute's thanks to them for that.

24. In addition to thanking those Council members who have stood down and decided not to apply for re-election, I also wish to thank those Council members that have supported me during my 2 years as President. The communications you received from me are the result of the efforts of all Council members who are involved, and achieved through our regular monthly meetings, and the additional meetings we have on the specific committees and issues arising. The work undertaken is not rewarded other than potentially seeing laws changed for the better of the profession. I wish to thank each of my fellow Council members for their support during these 2 years.

I am looking forward to supporting the new President to ensure the profession and the Institute continue to prosper.

Steven Birt  
President  
9<sup>th</sup> October 2007