

The Hong Kong Institute of Trade Mark Practitioners

President's report

2007/2008

It is vital to the health and growth of HKITMP that members are kept informed of developments, that members participate and that members are included in the activities of our organization. I believe that council has been active in furthering the aims of HKITMP and to this end I outline developments in the progress of our organization over the last year.

Committees

HKITMP has active committees focusing on the following key areas:

1. Copyright – (Steven Birt, Charmaine Koo, Winnie Yue, Barry Yen);
2. Trade Marks – (Peggy Cheung);
3. Patents and Designs – (Mark Irons); and

Council also recently appointed a new "Functions Committee" – (Nick Horvath, Deanna Wong and Ruby Chan) to help organize social events so you can meet other members. I believe that the personal relationships that you build through such interactions will enhance your enjoyment of our unique practice area and also improve your ability to resolve issues between clients.

Bi-annual Meetings with Intellectual Property Department

- A. First bi-annual meeting held on 30 October 2007. Representatives from HKITMP met with members of the Intellectual Property Department ("IPD") to discuss developments. During that meeting the IPD provided updates on the statistics relating to registration; the e-commerce services they provide; and information on their publicity and public education programs. The IPD also informed us that

they were arranging a meeting between intellectual property practitioners in Hong Kong, Macau and Mainland China. The meeting was held in Shenzhen on 26 June 2008.

- B. Second bi-annual Meeting with the IPD was held on 29 April 2008. IPD provided updated statistics on registrations; developments on e-commerce services; and on their publicity and education campaigns. Practitioners raised a number of issues with the IPD. Since it was clear that there were numerous issues relating to points of practice and interpretation the IPD kindly arranged a separate "Working Group" meeting to discuss those points.

Patsy Lau led the HKITMP team (Sandra Gibbons, Deanna Wong, and Ruby Chan) at the "special" additional meeting on 15 July 2008. We are indebted to Patsy Lau for preparing a detailed list of discussions points. I believe this practical discussion is beneficial to all members.

- C. The IPD also held a working group meeting on "Award of Costs in certain Trade Marks Registry proceedings" on 29 May 2008. HKITMP participated with representatives of APAA, The Bar Association and The Law Society. The parties reviewed the draft scale of costs that had been prepared, following input from various parties. The participants endorsed the scale of costs and discussed how best to implement the scale. This scale provides guidance on appropriate costs for preparing and filing notices of opposition or counter-statement; perusing and advising on notices of opposition or counter-statement; and for attending extensions of time hearings. We are glad that this has been finalized in a collegiate manner.

Consultation papers

The HKITMP reviewed several consultation papers over the last year including:

- a. "Consultation paper on the provision of additional exemptions on circumvention of technological measures". The copyright committee discussed this complex issue and prepared draft views. The draft was circulated to members before finalizing and submission.
- b. Trade Description (Amendment) Bill 2007. Unfortunately we were not invited to

consult on this. Nonetheless, we became aware that the Commerce and Economic Development Bureau was considering this issue so contacted them on 18 January 2008 and requested that we be given advance notification of all possible changes to policy and law that would affect intellectual property matters in future and requested a commitment to set reasonable consultation periods not interrupted by extended public holidays. Following discussion we prepared and filed a submission on 6 February 2008.

HKITMP was also invited to attend a Bills Committee meeting in the Legislative Council ("LegCo") chambers on 18 February 2008. Barry Yen and Sandra Gibbons represented HKITMP. During LegCo meeting we raised several points including the issue of "mens rea" as a pre-condition to prosecution under the Trade Descriptions Ordinance ("TDO") and also the benefits of extending the TDO to services. We were glad to see active participation in the lively discussion from Legislative Councilor Audrey Eu.

- c. The Companies Bill team of the Financial Services and Treasury Bureau wrote to HKITMP on 2 April 2008 inviting comment on the "Public Consultation on Company Names, Director's duties, Corporate Directorship and Registration of Charges". Steven Birt provided substantial assistance in preparing a strong submission for the HKITMP. The HKITMP views in relation to the re-write of the Companies Ordinances were submitted on 30 June 2008.
- d. Following the consultation on December 26, 2006 the Commerce and Economic Development Bureau published "Preliminary Proposals for Strengthening Copyright Protection in the Digital Environment".

On 18 April 2008, Steven Birt, Winnie Yue and Barry Yen considered the issue of what possible additional exemptions on circumvention of technological measures would be appropriate. A draft paper was circulated to members before finalizing. HKITMP views were submitted to the Commerce and Economic Development Bureau on 2 September 2008.

Function

The HKITMP enjoyed a special wine tasting and dinner on 23 July 2008 at the China Tea Club. I believe this function was well received. We welcome suggestions for future social activities.

Council Meetings

Council meetings were held on the following dates:

1st – 10 October 2007

2nd - 12 December 2007

3rd – 23 January 2008

4th – 12 March 2008

5th – 23 April 2008

6th – 11 June 2008

7th – 13 August 2008

I thank all the participating firms for generously offering their board rooms for council meetings.

I appreciate that council members are very busy and it is a reflection of their commitment that they make an effort to attend at a very busy time of day.

Election of Council Members

Half of the council is required to retire at each annual general meeting. This year Andrea Fong, Nick Horvath, Sandra Gibbons, Steven Birt, Winnie Yue, John Slater, and Mark Irons needed to retire. A ballot was held for the additional member to make up the eight required to seek re-election from those elected last year. Loke Khoon Tan's name was drawn from the ballot. Loke Khoon Tan and Mark Irons have decided not to put their name forward for re-election to council.

Philip Tsang and Benjamin Choi have indicated that they would serve on council. All the other members who retired automatically (Andrea Fong, Nick Horvath, Sandra Gibbons, Steven Birt, Winnie Yue and John Slater) have indicated that they will

re-stand to serve on your council. Since the number of vacancies match the number of people standing for council all those individuals standing are automatically elected to council.

I welcome the new council members and look forward to their participation and that of all council members throughout the year.

Membership

Several people ceased as members but these were outweighed by the introduction of new members.

We welcome and appreciate participation and input from all members. This would typically be in relation to draft responses to consultation exercises, providing your views on issues of practice and also participation in our functions.



Barry Yen
President
HKITMP