

The Hong Kong Institute of Trade Mark Practitioners

President's report

2008/2009

Businesses faced severe tests throughout the year. This also adversely impacted the volume of intellectual property work, the attitude of clients to costs and the ability of members to recover fees in a timely manner.

Throughout your council has kept focus on advancing the interests of intellectual property practitioners.

Committees and officers

Our committees have focused on the following areas:

1. Copyright – (Steven Birt, Charmaine Koo, Winnie Yue, Barry Yen);
2. Trade Marks – (Peggy Cheung, Twiggy Liu, Benjamin Choi, Sandra Gibbons);
3. Patents and Designs – (Deanna Wong, Graeme Hall, Jeffrey McLean); and
4. Functions – (Nick Horvath, Deanna Wong and Ruby Chan)

I am very grateful for the support of all the dedicated volunteers on those committees.

It is also very important to recognize the commitment and exemplary contributions of our Secretary (Helen Tang), Membership Secretary (Justin Davidson) and Treasurer (Andrea Fong).

These councilors form the reliable backbone of our organization. Without all these voluntary contributions our Institute would not be able to operate effectively.

Bi-annual Meetings with Intellectual Property Department

Your representatives attended bi-annual meetings with the Intellectual Property Department ("IPD").

A. The first bi-annual meeting was held on 19 November 2008. Our representatives met senior IPD staff to discuss developments. During the meeting the IPD provided updates on:

- i. Statistics relating to filings. An average of over 2,000 trade mark applications were filed each month. When considering the number of classes this increases to over 3,500 applications per month. There are currently over 220,000 trade mark registrations. Interestingly, if you can say that about statistics, about half the applicants are not represented by professional agents. This suggests that there is scope for members to increase their clientele and improve the quality of what is being claimed under applications and registrations;
- ii. The e-commerce services provided. In October 2008 there were about 15,260 visits to the Trade Mark search database and 6,580 visits to the Patent search database;
- iii. Publicity and public education programs undertaken. It is important that the IPD strive to increase public awareness of intellectual property issues.

The HKITMP raised queries relating to various practice matters (including amending typographical errors, searching for Japanese characters and the perceived more rigorous examination standard for sound marks).

The Trade Marks Committee also met separately with IPD staff to discuss several other detailed practice issues. This included discussion on defensive marks, three dimensional marks and smell marks; as well as discussion on how information can or should be presented on the public on-line database.

B. The second bi-annual meeting with the IPD was held on 20 April 2009. IPD provided updated statistics on applications and registrations; developments on e-commerce services; and on their publicity and education campaigns. Practitioners raised a number of issues with the IPD. This included an enquiry on

what impact the Civil Justice Reforms may have on the IPD's practice. The IPD responded that there was already provision for case management under the TM Rules. Further, the IPD informed us that they appointed a consultant to assist formulate Copyright Tribunal Rules.

The IPD sends regular email alerts when there are changes to practice and when there is other news impacting on intellectual property matters. If members are not receiving those alerts from the IPD and would like to receive them please let us know. We are grateful that the IPD updates us promptly on these matters.

Mainland, Hong Kong and Macau IP Symposium

The IPD arranged a symposium on 25 November 2008.

Intellectual Property Forum

A representative of the HKITMP attended the Business of IP Forum on 11 December 2008 at the Convention Centre, Wanchai. This Forum was part of the annual Business of Design Week event. We were honoured to have Mr. Tian Lipu, the PRC Commissioner of the State Intellectual Property Office, attend to discuss the Outline of the National Intellectual Property Strategy. Members are no doubt hopeful that these principles can be implemented to improve the understanding of intellectual property at the consumer, judicial and the administrative levels in China. I understand there is another very interesting program and speakers arranged for this year. See the website: www.bodw.com.hk.

Guangdong / Hong Kong IP Seminar

Helen Tang kindly represented HKITMP as a speaker at the Guangdong / Hong Kong Seminar on Intellectual Property and Development of Small & Medium Enterprises in Zhongshan, China on 7 April 2009.

Consultations

The HKITMP reviewed and considered invitations to consult on the following issues relating to intellectual property matters:

- a. March 2009 – IPD enquired whether it would be beneficial to automatically send

reminder notices if no response is given two weeks prior to the expiry of a specified time period allowed in relation to trade mark, patent and design matters. HKITMP indicated that this would be helpful.

- b. You may recall that representatives attended the Legislative Council ("LegCo") chambers on 18 February 2008 to discuss possible changes to the Trade Descriptions Ordinance ("TDO"). Unfortunately the HKITMP's suggestions (e.g. extending the TDO to services) were not implemented.
- c. The Companies Bill Team of the Financial Services Branch thanked HKITMP for its comments on the "Public Consultation on Company Names, Director's duties, Corporate Directorship and Registration of Charges". The conclusion of the consultation may be found at www.fstb.gov.hk/fsb (under "CO Rewrite").
- d. HKITMP filed a submission on the proposed administrative measures for Short-term Patents. This issue was raised because of concerns expressed about short-term patent owner being able to initiate infringement actions even though the patent had not been substantively examined. We agreed that there should be a notice warning about the limitations of short-term patent registrations.

Other

Arbitration

A delegation (Christopher Britton, Henry Wheare, and Barry Yen) met with the Hong Kong International Arbitration Centre (Gary Soo, Dennis Cai) in early April 2009 to explore the possibility of including interested members on a list of arbitrators or panelists for assisting with IP related disputes. Members are more likely to be able to qualify for the panel considering domain name disputes.

Prizes for best Intellectual Property students

Noting that HKITMP enjoys a healthy financial balance Council resolved to award two cash prizes to students who excel in the study of intellectual property. We hope this will provide a material incentive to students and raise awareness about HKITMP amongst future lawyers.

HKITMP approached The University of Hong Kong (HKU) and The Chinese University (CU) with the proposal to offer an Institute prize for their top student of intellectual property. Both institutions were very grateful for our offer. HKU have indicated that they will likely award the \$5,000.00 cash prize to the graduate student who achieves the highest mark in the post graduate course "Hong Kong Intellectual Property Law". We are waiting for an indication from CU as to who they intend to award the Institute prize to.

Functions

Members were invited to two special social functions during the year:

- # 18 February 2009 – a special hot-pot night at the Dynasty Club to celebrate Chinese New Year.

- # 17 June 2009 – an exciting bowling competition and curry night was held at the Hong Kong Club.

Council Meetings

Council meetings were held on the following dates:

- # 2 October 2008
- # 14 October 2008
- # 9 December 2008
- # 14 January 2009
- # 18 February 2009
- # 25 March 2009
- # 6 May 2009
- # 8 July 2009
- # 26 August 2009

I thank all the participating firms for generously hosting us in the council in their board rooms.

I appreciate that all council members are very busy and it is a reflection of their commitment that they made time to attend the nine meetings after office hours.

Election of Council Members

Half of the council is required to retire at each annual general meeting. This year it is the turn of Ruby Chan, Peggy Cheung, Justin Davidson, Lindsay Esler, Charmaine Koo, Helen Tang and Deanna Wong. A ballot was held for the additional member to make up the eight required to seek re-election from those elected last year. Andrea Fong's name was drawn from the ballot.

I am glad that all retiring council members have indicated that they are standing for re-election.

Membership

Seven new members joined. This was comprised of five Ordinary members, one Student member and one affiliate member. I warmly welcome all the new members to the HKITMP.

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Many economic commentators assess that the worst of the downturn is past. I hope that optimism proves correct and that it is reflected in your practices.

I also hope the new executive team enjoys the support that I have been very encouraged to receive over the past two years.

I trust that you will all enjoy a stimulating and productive year ahead; and that you will participate in the Institute's social functions and occasional requests for comments on practice issues.


Barry Yen
President
HKITMP