

**The Hong Kong Institute of Trade Mark Practitioners
Annual General Meeting
Monday, 24 September 2012**

President's Report 2011 / 2012

In the past 12 months, we have witnessed the most dramatic electoral year we ever had, followed by more dramas after our Chief Executive assumed duty, including illegal structures, the new ministers' family businesses, national education. More recently, we are faced with strong nationalistic sentiments over the dispute of ownership of the Diaoyu Islands.

All these events bring home two messages: the transition of Hong Kong into a more politically sensitive society; and the heightened public awareness of their rights and higher expectation of those in public office.

For us, individually as professionals, this translates into higher expectation of us from clients.

As Council Members of the Institute, we aim to provide a forum to keep the legislature, the Hong Kong Intellectual Property Department ("IPD") and other bodies in Hong Kong, informed of the views of trade mark practitioners. We also aim to originate and promote improvements in trade mark law and practice and be a conduit between the government and other bodies to its members.

With the above mission in mind, Council Members have been kept busy in the past 12 months advancing the interests of the IP community.

Committees

The following are special Committees set up to address specific areas of the IP practice:

1. **Copyright** – Steven Birt, Charmaine Koo, Barry Yen
2. **Trade Marks** – Peggy Cheung, Sandra Gibbons, Theresa Mak
3. **Patents and Designs** – Barry Yen, Steve Birt, Jeffrey McLean
4. **Seminar Committee** – Winnie Yue, Charmaine Koo
5. **Newsletter Committee** – Davina Lee, Theresa Mak

6. **Social Functions** – Ruby Chan, Nick Horvath, Andrea Fong

I wish to thank all Council Members and Co-Op Member for all their hard work and contributions, with special thanks to our office bearers, our Vice President, Justin Davidson, our Secretary Benjamin Choi, Membership Secretary Winnie Yu and Treasurer Cynthia Houg.

The Institute would not have been able to subsist and undertake all its tasks without everyone's effort and support.

I would also wish to express our sincere appreciation to:

- the Patent Committee Members and our Co-Op Member Jeffrey McLean for their contribution in the preparation of the submissions made to IPD on Patent Reform in December 2011;
- the Seminar Committee for their efforts in organizing our lunch time seminars;
- the Newsletter Committee to have helped to revive our newsletter.

I encourage all members to continue to support the HKITMP by voicing any issues and concerns to Council to enable us to serve you more effectively.

I also encourage those who wish to make contribution to the IP community to volunteer to be part of Council.

Bi-Annual Meetings with the IPD

As in past years, the Council Members met with the IPD twice a year.

Two Bi-Annual Meetings were held, 17 November 2011 and 17 April 2012, to discuss policies and working issues.

Some notable issues raised include:

1. IPD agreeing to remind all hearing officers that unrepresented litigant should not have an advantage over a legally represented litigant.
2. IPD agreeing not to require a return of the original certificate when conditions of registration have changed as a result of a division, and that the Trade Marks Register will simply be endorsed with the new changes.

Details of the issues have been reported to members through our recent Newsletter released in August 2012.

Other Working Meetings with IPD

Having voiced complaints over delays at various stages of trade mark application, the Registrar issued a request for Expression of Interest ("EOI") in June 2012 to outsource Deficiency Checking and the Issuance of First Opinion to an outside consultant ("Consultant"). This has raised concerns amongst trade mark practitioners on the following issues:

- (a) Conflict of Interest;
- (b) Consistency and quality of work;
- (c) Risk of breach of confidentiality;
- (d) Possible compounded delay in responding to submissions.

We wrote to the Registry to express our views and we also met with IPD on 26 July 2012. We were informed that the EOI request partly stemmed from the restrictions and difficulties they have in recruiting more examiners to tackle the increased number of filings resulting in backlog.

We understand that the Law Society and the Asia Patent Attorneys Association also met with the IPD expressing similar concerns.

As a result of these meetings, it seems that the IPD has a better understanding of the practitioners' view point and the outsourcing exercise is now indefinitely suspended.

Patent Committee

The Institute was invited to make submissions in response to IPD's "Review on the Patent System in Hong Kong". Our Patent Committee Members prepared and filed submissions with IPD in December 2011. A copy of the submissions is posted on our website.

Prizes

The HKITMP continues to sponsor an IP Prize scholarship for the respective graduate program at the Chinese University and the Hong Kong University.

The Chinese University Faculty of Law nominated Ms. Haruna Yamakawa for Intellectual Property in the academic year 2011/12.

The University of Hong Kong Faculty of Law nominated three recipients of our prize for the highest mark in the "Hong Kong Intellectual Property Law" course, and they are (1) Miss Elizabeth Anne Herbert-Murphy; (2) Miss Hui Ka Wai and (3) Miss Zhang Yi.

We have the pleasure of having the company of Miss Zhang tonight and there will be an award presentation after our AGM.

Education

As part of our on-going effort to improve trade mark practice, we are considering resuming the intellectual property course through HKU SPACE. It is still at a very preliminary stage of discussion and will provide more information in due course.

Reports & Communications

We have revived publication of our Newsletter to keep our members informed of the latest IP issues and events through emails. We welcome your feedback and suggestions.

Please notify our membership secretary Winnie Yue of any changes of your email address or other contact information.

Seminar Invitations

Members were invited to a number of events and seminars organized by various IP bodies during the past year. Below are some of the events and outside seminars attended by representatives of the HKITMP:

1. Catherine Zhang of Deacons attended an IP Forum in Wuhan on 18 November 2011.
2. Theresa Mak of Rouse Legal, in association with Yu & Partners, attended a seminar on IP Protection conducted by the Baptist University on 29 November 2011.
3. Peggy Cheung of Jones Day is now on the Steering Committee of Business of IP Asia Forum.

ITMP Lunch Seminars

We continued to run our lunch time seminars. Since our first seminar held in June 2011, we organized our second seminar given by Mr. Stuart Witchell of FTI Consulting who spoke on "Strategic Brand Integrity Programs - a new approach in dealing with Intellectual Property Issues" on 18 May 2012.

These seminars are free for Institute members and we try to choose topics that are relevant to our practice. Members are encouraged to join if possible.

Social Events

We had two very enjoyable social events for members during the past 12 months.

We had our usual 2012 Spring Dinner at the Dynasty Club in March 2012 to celebrate the Chinese New Year when individual hot pots were back by popular demand.

We also had our Horse Racing Night at the Happy Valley on 4 July 2012.

Special thanks to all who supported these events.

This year, we have further subsidized the costs of social events to encourage members' participation, and to encourage more to join us as members. These are casual and friendly opportunities to acquaint ourselves with other IP practitioners.

Suggestions for future social events are very much welcomed.

Membership

We have four new members in the past 12 months:

Name	Firm	Type of Membership	Joined Date
Gee, Owen	Marks & Clerk	Ordinary	11.01.2012
Chu, Jacqueline	Mayer Brown JSM	Ordinary	21.03.2012
Cobden, Andrew	Hogan Lovells	Ordinary	21.03.2012
Allison, David	Laracy & Co	Ordinary	22.08.2012

Council Meetings

Council Members usually meet once a month, unless that month clashes with major holidays, or conferences. In the past year, we had nine meetings on the following Wednesdays:-

1st – 24 November 2011

2nd – 7 December 2011

3rd – 11 January 2012

4th – 23 February 2012

5th – 21 March 2012

6th – 18 April 2012

7th – 23 May 2012

8th – 4 July 2012

9th – 22 August 2012

I wish to thank all the participating firms for generously hosting these Council Meetings.

Council Members

We have 16 members serving on Council during the past 12 months:

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| 1. Helen Tang | - | President |
| 2. Justin Davidson | - | Vice President |
| 3. Cynthia Houg | - | Treasurer |
| 4. Benjamin Choi | - | Secretary |
| 5. Winnie Yue | - | Membership Secretary |
| 6. Patsy Lau | | |
| 7. Barry Yen | | |
| 8. Steven Birt | | |
| 9. Sandra Gibbons | | |
| 10. Peggy Cheung | | |
| 11. Nicolas Bodnar-Horvath | | |
| 12. Charmaine Koo | | |
| 13. John Slater | | |
| 14. Davina Lee | | |
| 15. Theresa Mak | | |

We also have the pleasure to have Jeffrey McLean as our Co-Op Member.

Each year, half of the Council Members will retire for re-election. This year, the Council Members who retired are:

1. Nicolas Bodnar-Horvath
2. Steven Birt
3. Sandra Gibbons
4. Patsy Lau

5. John Slater
6. Barry Yen
7. Winnie Yue
8. Cynthia Houg

All of them except John Slater stood for re-election and they will serve on Council for another 2 years. John has decided not to re-stand due to work commitments. On behalf of the Institute, I extend our sincere gratitude to John for his contribution.

There will be a vacancy on Council which will be open for nomination from the floor. Members who are interested in working on Council are invited to volunteer for election.

Conclusion

I would like to thank everyone for their support to the Institute. I look forward to another productive year.

Helen Tang
President
24 September 2012