

The Hong Kong Institute of Trade Mark Practitioners Limited



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Message from the President

Dear Members,

Since our last newsletter, we made submissions to the Hong Kong Intellectual Property Department ("IPD") on 31 May 2013 on the Consultation on Regulation of Patent Agency Services. A copy of the submissions has been uploaded on our website.

We have also been invited to provide Public Consultation on Treatment of Parody under the Copyright Regime. We look forward to receiving your comments if you have already not done so.

Best regards,

Helen Tang
President

Membership

Please contact Winnie Yue if there are any changes in your contact details.

New Members

We are pleased to welcome Timothy Letters and Laurence Thoo as Affiliate Members of the Institute.



Events and Activities

Future Events

AGM

The Institute's annual general meeting will be held on 25 September 2013 at the American Club Hong Kong. As usual, the meeting will be followed by dinner and we look forward to seeing you.

Business of Intellectual Property (BIP) Asia Forum 2013

The Institute will once again be supporting the Business of Intellectual Property (BIP) Asia Forum 2013 organised by the Hong Kong Trade Development Council and the Hong Kong Design Centre. The Forum will be held on 5- 6 December 2013. Further details will be announced in the autumn.

Past Events

25th Anniversary

The Institute celebrated its 25th anniversary at another Hong Kong institution, the Foreign Correspondents' Club on 10 June 2013. With over sixty members attending together with invited guests from the Intellectual Property Department, prominent members of the bar, the Law Society IP Committee and the APAA, and last but not least, founder members of the Institute, the evening provided a great opportunity to renew old acquaintances. Members audience were entertained with speeches from our President Helen Tang, founder member, past president and council member Nick Horvath on the early history of the Institute, Director of the IPD, Peter Cheung, and former director Stephen Selby and messages from overseas past president Jeannie Smith and ex-council member Lindsay Esler. To top off a memorable evening, members and guests were offered gifts of thermal mugs or travel adaptors as souvenirs.



Welcoming speech by President Helen Tang



Left to right: Justin Davidson, Stephen Selby, Helen Tang, Andrew Liao, Barry Yen, C.K. Kwong, Steven Birt, Dennis Kwok, Peggy Cheung, Peter Cheung, Nick Horvath, Anthony Evans, Patsy Lau.



Legal Updates

Consultation Paper on Treatment of Parody under the Copyright Regime

The Intellectual Property Department issued a Consultation Paper on Treatment of Parody under the Copyright Regime on 11 July 2013.

The document sets out, amongst others, three options for changes:

- Option 1: clarification of existing general provisions for criminal sanction;
- Option 2: introduction of a specific criminal exemption for parody; and
- Option 3: introduction of a fair dealing exception for parody.

Please visit IPD's website or click on the link below for further details: -

http://www.ipd.gov.hk/eng/intellectual_property/copyright/consultation_on_parody.htm

We have issued an email invitation on views on 24 July 2013. Please let us hear from you before 30 September 2013 so that we may respond to the Commerce and Economic Development Bureau by **15 October 2013**.

IPD Biannual Meetings

The first Bi-Annual meeting with the IPD for 2013 was held on 15 May 2013. A summary of the issues raised at the meeting follows below:-

Statistics and Performance of Registration

The IPD announced the statistics regarding applications of trade marks, patents and designs based on the average month-on-month comparison for the period from May 2012 to April 2013. The number of T2 trade mark applications received kept increasing at a rate of 1.25%. There was also an increase in the number of standard patent 'request to record' applications by 2.97%. Regarding design applications, there was an increase in the number of designs applied for registration by 1.49%.

IP Trading



The Director of the IPD, Mr. Peter Cheung, spoke about the update on IP trading in Hong Kong during the Biannual Meeting. Hong Kong, being a bilingual city and the window of China, with a well-developed law system, low tax rates and no control on foreign exchanges, is well positioned to become the centre for IP trading.

Items Raised by HKITMP

Deficiencies

Some examiners, but not all, would mark up the specification of goods/services requiring amendments. However, usually only additions and amendments were shown and deleted wordings were simply omitted and not struck out, which was misleading and confusing. It was suggested that added wordings could be marked in bold and underlined and deleted wordings could be indicated as strike throughs. The IPD reminded the examiners that amended wordings should be underlined and deletions should be indicated by strikethroughs.

Amending Inconsistencies in Registrants' Name

In the past, IP practitioners were advised to simply write a letter explaining the inconsistency and request to adopt one consistent format, for example, to add the Japanese "Kabushiki Kaisha" transliteration name, or streamline a French company name from "CLARINS" to "CLARINS S.A.". Nevertheless, a number of examiners requested a formal change of name recordal form to be filed even though it was not an official change of name.

The IPD replied that examiners might ask for rectification for changes of names. IP practitioners can write to the IPD to clarify or explain the changes by way of 'data cleansing'. The IPD will look at the substance of the cases after receiving the mentioned documents. For trade mark applications of the same owners with the same specifications but different deficiency requests, the IPD suggested that IP practitioners write to them by letter, so that the IPD could adopt the same approach to those applications.

Possibility of Linking Status Check Page to Search Site

At the last bi-annual meeting, the IPD was asked if they could provide a link to a glossary of status descriptions (for trade marks on the register) on the Registry's search facility. The IPD replied that due to economic implications, they can only provide an icon on the left. The IPD will review this in due course.



Transliteration and Translation of Non-Roman and Non-Chinese Characters

The IPD was requested to clarify how the Registrar compared marks containing words/letters/characters not in Roman letters or Chinese characters. If the Registrar engaged in oral and conceptual comparison of the marks, in addition to a visual comparison, then it would be necessary to enter the transliteration or translation for all marks containing foreign characters, so that practitioners could accurately conduct searches and advise on availability of foreign character mark.

The IPD responded that whilst applicants are still required to include the transliteration/translation of these words in the application and the language to which those words or characters belong in the marks under Rule 120(4) of the Trade Marks Rules, when performing searches, although conceptually similar, word marks in different language are unlikely to be regarded as similar as the overall impression of the marks is likely to be different, for example, “馬”, “cheval” and “horse” would not be considered as similar. Transliteration/translation of non-Roman letters or non-Chinese characters forming the marks would not be used for searches as they were no longer required to be entered in the Trade Marks Register.

Possibility of Highlighting Words being Searched for Goods and Services

It was suggested that words of goods and services or key words searched could be highlighted in the results, which would make the searches easier. The IPD replied that it could be performed with the “Search” function of Internet browsers. As the suggestion would entail a system enhancement with significant cost implications, the IPD cannot provide the above service at the moment. The IPD will conduct feasibility study for the mentioned service in the future.

Clarification of Opposition Deadline in a Short Month

The IPD was asked whether the opposition deadline was 27th or 28th February 2013 if a trade mark application had been published on 30th November 2012. They replied that according to Rule 16(1) of the Trade Marks Rules, the deadline should be 28th February 2013. Since the application was published on 30th November, the opposition deadline should be three months later, i.e. 30th February. However, as there is no 30th February, the deadline would be moved to the end of the month, i.e. 29th February in leap years or 28th February in common years.

The Registrar referred to the “corresponding date rule” as explained in paragraph 3/1/1 of the Hong Kong Civil Procedure 2013, “...if it is to be done within “one month” after January 31, the last day is



February 28(or 29 in a leap year)". Therefore, if an application is published on 30 November 2012, 28th February 2013 would be the opposition deadline and not 27th February 2013.

Others

The IPD sought views of members of ITMP about the Madrid System. The ITMP's view is that members are concerned about the effect on the business, but realised this is the trend.

The next biannual meeting will be held in October 2013.

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