

The Hong Kong Institute of Trade Mark Practitioners Limited



THE JOURNAL

*Vol. 9 No. 2
Dec 2014*

Message from the President

Dear Members,

Warm greetings to all for the festive season and health and happiness for 2015.

2014 has been a busy year with our first INTA meeting held in Hong Kong and despite the dismal weather, most overseas visitors seem to have enjoyed the trip to our home city. Another event of note this year was Peter Cheung's retirement as Director of Intellectual Property after many years with the IPD – we wish him a long and happy retirement. Ada Leung has taken up the reins as Director of Intellectual Property and there was an enjoyable welcome dinner for her and some of the existing and new senior members of her IPD management team, hosted as a combined event by the Councils of HKITMP, APAA and the Law Society IP Committee.

2015 promises to be similarly busy with a number of events on the horizon. There are already a number of Government Consultations announced, including most importantly in relation to a possible HK adoption of the Madrid Protocol, with all the challenges and opportunities that may mean for the HK IP profession. HKITMP will continue to support the newly established Focus Group meetings with the IPD on the reform of the Patent Law in Hong Kong as well as holding our regular biannual meetings with the Registry to improve practice and procedures. We are also aware that IPD has submitted proposals for a change next year to the Registry fee levels (some increases and some decreases) on which HKITMP will likely wish to make some formal observations to LegCo. as they proceed for statutory approval – please let the Council know your thoughts.

We have instituted a series of lunchtime seminars through the year that have continued to prove a popular format and we shall continue them in 2015, with the first event planned for 30 January so please mark your diaries.

As always, please remember this is your Institute and so as members, I encourage you all to get involved, attend our events and contribute your views and opinions on all matters that effect our profession. I look forward to seeing you in 2015.

Merry Christmas.

Justin Davidson
HKITMP President



EVENTS AND ACTIVITIES

Past Events

1. Lunchtime Seminars

The Institute organized several lunchtime seminars in the second half of 2014. The first was held on 3 June when Dr Gino Yu spoke on "**New Opportunities for Intellectual Property in a Digital Hong Kong**". Dr Yu spoke on how digital technology has revolutionised the entertainment industry and raises questions as to the application of the traditional system of intellectual property rights to the digital environment.

Following a thought provoking seminar provided by Dr Yu, the Institute organized a second seminar revolving around intellectual property issues and digital technology. On 14 October, we had the pleasure of having Dr Po Chi Wu to present on "**The Complexity of IP in the high-tech world**". In this seminar, Dr Wu discussed the various market trends, strategies and conflicts amongst well-known high-tech companies, and also spoke on the value of intellectual property in the future.

2. HKITMP Bowling Event

This year's bowling event was held at the Ladies' Recreation Club and was well attended by members. Steven Birt and Serena Lim emerged as the top men and ladies scorers with a score of 159 and 130 respectively.

3. HKITMP AGM

The 2014 HKITMP AGM and Dinner was held at the Kee Club, on 29 October 2014. The after dinner speaker was Jasmine Karimi, President of the Corporate Counsel's Association in Hong Kong, who gave a very interesting presentation on the significant disruptive influences we should start preparing for as IP professionals with the increasing advances in 3D printing technology.

This year, Barry Yen, Nick Horvarth, Winnie Yue, Cynthia Houng, Steve Birt, Patsy Lau, Sandra Gibbons, and Helen Tang were obliged to step down from Council, though happily all seven re-stood and were re-elected for another term. Following the AGM, a short Council meeting was held and the appointed Officers and Council Members for 2013-2014 are now:



President:	Davidson, Justin C.	Norton Rose Fulbright
Vice President:	Lee, Davina	Marks & Clerk
Secretary:	Lim, Serena	Hogan Lovells
Membership Secretary:	Choi, Benjamin	Mayer Brown JSM
Treasurer:	Houng, Cynthia	Marks & Clerk
Council Members:	Birt, Steven	Reed Smith Richards Butler
	Bodnar-Horvath, Nicholas	Bodnar Horvath Solicitors & Notaries
	Cheung, Peggy Po Yee	Jones Day
	Chan, Ruby Yu-Ting	Baker & McKenzie
	Fong, Andrea	Wilkinson & Grist
	Gibbons, Sandra	Marks & Clerk
	Koo, Charmaine	Deacons
	Lau, Patsy	Deacons
	Mak, Teresa	Yu & Partners
	Tang, Helen	Simone IP Services
	Yen, Barry	So Keung Yip & Sin
	Yue, Winnie	Deacons

4. HKITMP IP Prize



The recipient of the Institute Prize for Intellectual Property in the Principles of Intellectual Property Course for the academic year 2013-2014 is Mr Yuen Ming Kin Matthew of the Chinese University of Hong Kong. Matthew was present at our Annual General Meeting to receive his prize.

5. Panel Session at Business of IP Asia Forum

The Institute participated in the Business of IP Asia Forum co-organised by the Intellectual Property Department and the Hong Kong Trade and Development Council on 4 & 5 December 2014.



Ms Wang Binying, Deputy Director
General of WIPO opening BIP Asia

The Institute co-organized one of the panel sessions on "Exploitation of IP Rights in Business - Technology Transfer and Licensing". The panel session was moderated by the Institute's President, Justin Davidson and panellists included Institute members, Peggy Cheung, Jeff McLean. We were pleased to have David Ai, Director of Knowledge Transfer at City University Hong Kong to join us as one of the panellists.



From left to right: David Ai, Jeff McLean, Peggy Cheung and Justin Davidson.

Future Events

1. Lunch time seminar in January 2015

Douglas Clark of Gilt Chambers will speak on "New Developments in IP Litigation in China". The seminar will be held on 30 January 2015 at 12:30pm. Details of the seminar will be circulated shortly.

LEGAL UPDATES

IPD Biannual Meetings

1. Updates On Issues Raised By Members At Previous Meetings

a) Greater transparency on opposition and cancellation matters

Following suggestions made by members to the IPD, the IPD has now made available the schedule of upcoming inter partes hearings online. The schedules can now be downloaded from http://www.ipd.gov.hk/eng/trademarks/Upcoming_Hearings/schedule_of_upcoming_inter_partes_hearings.htm.

b) Joint Oppositions

At the previous meeting, the IPD was requested to consider updating the Oppositions chapter in the Work Manual to provide guidance on filing joint applications, namely oppositions filed by



related companies against the same applicant, using the same grounds of opposition. The chapter on Oppositions was revised on 11 July 2014.

2. Bi-Annual Meeting on 27 October 2014

The last Bi-Annual meeting with the IPD took place on 27 October 2014. A summary of the issues raised at the meeting is as follows:-

A. Summary of Statistics of the Registries

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 October 2013 to September 2014. There was an increase by 1.72% in the number of T2 applications received by the Registry during this period.

There was also an increase in the number of standard patent '*request to record*' applications by 0.144%. For short-term patent applications, there was an increase by 6.37% in the number of applications received.

For design applications, there was an increase by 0.98% in the number of designs applied for registration.

B. Issues Raised by IPD

a) Deficiencies Report

IPD commented that more than 50% of IPD examiners' time is spent on reviewing specifications. To avoid the need for urgent work, the IPD has indicated a preference that responses to deficiencies report be sent 7 days prior to the deadline. This is to allow the IPD sufficient time to review submissions and revert well before the non-extendible deadline to remedy deficiencies.

Further, IPD is considering the introduction of a "pick list" from which descriptions of goods and services can be chosen from when filing applications. IPD indicated that the "pick-list" will not be a mandatory list but the use of standardized items from this list will be encouraged, with a view to reducing the time spent on checking specifications.

b) Revision of official fees

The IPD reported that they have proposed revisions to official fees for trade marks, patents and designs in Hong Kong and the revised official fees is currently pending approval from the Financial



Services Bureau. Once FSB's approval is obtained, the revised fees will then be presented to the Legislative Council.

IPD indicated that there will be some increase and some decrease in fees. Some of the proposed increase in fees is quite substantial.

C. Issues Raised By Members

a) Inconsistent image and description of mark

A member notified the IPD that the image and description of a mark on the register is inconsistent and remained inconsistent despite enquiries made with the IPD. It is proposed that there needs to be a mechanism to expedite the correction of the IPD's records. Members also queried whether the IPD is aware of this problem and if yes, how widespread is it.

IPD responded that the inconsistencies are not wide spread (there were less than 10 cases in the last 10 years). The IPD will amend their records using the statutory procedures under Rule 66 of the Trade Marks Rules as and when they come across discrepancies.

b) Costs in non-use cancellation filed against expired registration

Members queried the Registry's practice for a non-use revocation action filed against a registration which has expired but not yet removed from the Register, and the possible liability for costs. Pursuant to a telephone enquiry, an officer of the IPD advised that the registrant could only renew the registration (out of time) before it can surrender it, but even by surrendering the registration the registrant would still be liable for the other side's costs as the effective date of the surrender would be after the non-use revocation filing date. The officer further advised that the only option would be to provide a written consent to the other side and reach an agreement in order to avoid cost liability.

At the bi-annual meeting, the IPD advised that they will not process the application for revocation until the registration is renewed or restored, and if the registration is not renewed, the revocation action will not be processed. As to the issue of costs, the IPD replied that this is a matter of the Registrar's discretion and may grant costs against the registrant.

Council members who attended the meeting with IPD expressed views against the Registry's current practice, as the current practice means that a registrant who no longer has interest in maintaining a registration would have to renew and surrender its registration in order to avoid liability on costs in an undefended revocation action.



The IPD indicated that they will take our views in consideration.

- c) Old cases dating back to pre-Cap. 559 days being allowed to remain dormant whilst the opponent and applicant supposedly “negotiate for a settlement”.

Members enquired whether the IPD proactively monitors progression of opposition cases. There had always been a policy not to allow the register to become clogged with “deadwood” because this reduces the availability of marks for third parties. One member is aware of cases pending for over a dozen years (still under Cap. 43).

The IPD responded that they will not impose obligations on parties to settle the matter. As of September 2014, there were 73 applications filed under the old Cap. 43 Ordinance which are still pending. These include applications which are kept in abeyance pursuant to extensions of time or stayed pending Court judgment, pending settlement negotiations or by consent of parties.

- d) Query / concern about the capacity of the Registry server

A member noted that on 14 October 2014 at around 3:00pm-4:30pm, access to the search database was severely curtailed.

The IPD responded that this should be a one-off incident, due to the way in which the servers handling search requests are programmed. Since being notified of this issue, the IPD has looked into ways to re-program the servers to avoid overloads.

- e) The issue of engaging law costs draftsman by non-law firm to prepare bill of cost for taxation

Members enquired whether the IPD would accept bill of costs for taxation purposes prepared by law costs draftsman engaged by non-law firms as the current practice requires a law costs draftsman's work to be supervised by a solicitor.

The IPD replied that they would accept and consider bill of costs prepared by a law costs draftsman which is engaged by non-law firms.

- f) Cross search list

Members enquired whether the IPD regularly update the cross search list, and on what basis any revision is made.



IPD replied that they regularly update the list to take into account yearly changes in the NICE classification. As to the cross-search criteria, the IPD indicated that they do take into account the practice in other comparable jurisdictions.

g) Routine maintenance of Online Search System

Currently, the Online Search System of the IPD's records will not be available from midnight till 1am daily to allow for routine updates and maintenance of the system. Members enquired if the IPD would delay the time for maintenance as some members will still require access to the Online Search System at the current routine maintenance time.

The IPD responded that they will look into delaying the routine maintenance time.

MEMBERSHIP

Please contact our Membership Secretary, Benjamin Choi, at membership@hkitmp.org if there are any changes in your contact details.

Recent Moves

Name	From	To
Helen Tang	Wilkinson & Grist	Simone IP Services

New Members

We are pleased to welcome new members of the Institute:

1. Dong Hao of Baker & McKenzie (student member)
2. Deland Ji of Baker & McKenzie (student member)
3. Katherine Lai of Marks & Clerk (ordinary member)

QUIZ

Last Issue's Question: Which was the first sound mark registered in Hong Kong?

A: Yahoo! Inc's *sound of a human voice yodeling the word "YAHOO"* (Registration No. 300014787).



This Issue's Question:

Q: Guess the number of trade mark applications which will be filed in Hong Kong January 2015.

A prize will be awarded to the person who responds with the closest guess.

Correction



The answer to the quiz question in the last issue should be in 1876.

registered in the United Kingdom



*Merry Christmas
and
Happy New Year!*

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December 2014