

The Hong Kong Institute of Trade Mark Practitioners Limited



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Message from the President

Dear Members,

This is our first newsletter for quite a while. We have decided that it is high time to revive our newsletter as this is the easiest and most direct way of communicating with you. Whilst we see each other during our social functions, seminars etc., we can do with some short news reporting in between. Since we all suffer from varying degree of information overload, we have decided that the newsletter will be brief and should only contain information that is not available elsewhere, such as what we discuss with the Intellectual Property Department (“IPD”) during our Bi-Annual Meetings, which will impact on our practice. We hope to report to you every six months, and we trust that you will find this useful. We would like to hear your view and suggestions, however, and we look forward to receiving your comments and feedback.

Best regards,

Helen Tang
President

Membership

Renewals

Thank you to all the members who have renewed their membership. Members who have not yet renewed their membership are reminded to renew their membership soon.

It should be noted that early-bird membership rates are only applicable if the application for renewal is received during the early-bird period.

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



New Members

We are pleased to welcome Andrew Cobden of Hogan Lovells, Jacqueline Chu of Mayer Brown JSM and Owen Gee of Incompass IP Limited as new members of the Institute.

Events and Activities

Future Events

The next **AGM** will be held on 24th September 2012 at the Bankers Club and we are pleased to introduce former Council member Philip Tsang as our guest speaker for the evening.

Philip is an international award-winning photographer based in Hong Kong, who has been named as one of the Top 30 wedding photographers in Asia. He was the First Place and Second Place winner of WPPI International Photography Competition 2010. He is the only photographer from Hong Kong who is listed on the world renowned Best of Wedding Photographers, a premier by-invitation-only association for the world's top wedding photographers.



Philip started shooting when he was in college. He obtained his LLB and LLM at the University of Hong Kong, and was admitted as a solicitor of HKSAR. His practice was mainly in trade marks, and he served as a Council Member of the HKITMP. Later, he went back to photography, an art he fell in love with during his early years. It was a love for capturing touching emotional moments in an artistic manner that steers him as one of the most sought-after photographers in Hong Kong.

Details for the AGM will be announced shortly.

Past Events

Talk on IP Rights at the Hong Kong Baptist University

At the invitation of the IPD, Council Member Theresa Mak gave a talk on behalf of the Institute in November 2011 at the Hong Kong Baptist University in an event organized by the IPD, the University and Sing Tao Daily and JobsDB. The event was aimed at students and concerned the protection of IP rights. There were discussions on the experience of the speakers, who included designer Alice Chan, an artwork designer and Mr. Chiu Sung Kei, Hong Kong film director on protecting their work.

Lunch Time Seminar 18 May 2012

Our second Lunch Time Seminar took place on 18th May 2012 with Stuart Witchell, the senior Managing Director of FTI Consulting as speaker. Stuart spoke on a new approach in dealing with intellectual property issues - "Strategic Brand Integrity Programs" involving a long term strategic approach and innovative practical investigation tools.



Summer Horse Racing Event

The Summer Horse Racing event was held on 4th July 2012. It was a wonderful evening. We had a splendid view of the race track and great food. Special thanks to Benjamin Choi and Ruby Chan for organizing!



Pictures taken at the Summer Horse Racing event

Legal Updates

Nice Classification, 10th Edition

The 10th Edition of the Nice Classification was adopted and came into force in Hong Kong on 1st January 2012.

Patent Reform Consultation

The Institute was invited to make submissions in response to IPD's "Review on the Patent System in Hong Kong", including:

- (a) Standard Patent System and Original Patent Grant ("OPG");
- (b) Short Term Patent System; and
- (c) Regulation of Patent Agency Services.

A copy of the Institute's submissions will be available shortly on our website.

IPD Biannual Meetings

The Biannual Meetings with the IPD provide a good and useful opportunity for practitioners to raise any issues regarding trade mark prosecution directly with senior members of the IPD in an informal setting. Taking place every six months, the meetings encourage a productive and informative



dialogue. A précis of matters addressed in meetings held in November 2011 and April 2012 is set out below. Members are encouraged to communicate with Council on any issues that they may have so that the same can be raised on their behalf.

Delays

Addressing the noticeable delays in relation to the matters below, the IPD explained that its resources had been employed in correcting errors in registration certificates and that it would re-channel its resources into expediting these matters. The delays have been compounded by a vast increase in the number of applications received (6,000 new applications in March 2012 alone). The IPD is in the process of trying to recruit additional examiners.

- organisation of hearings;
- clearance of deficiencies;
- recordal of assignments/mergers;
- issuance of second opinions;
- issuance of patent notices of publication;
- examination of "problematic" applications;
- examination of assignment with documentary evidence;
- issuance of deficiency notifications affecting filing date (see below).

Submission of Copyright Materials

The IPD was asked to state its position in relation to the submission of copyright material and whether it would consider making proceedings held before the IPD subject to judicial exemption. The response from the IPD was that materials submitted to the IPD should either be original copyright material or have been copied with the permission of the copyright owner and that there was no intention of moving from this position at present.

Enquiry on Proposed Specification

The IPD has stopped reviewing proposed specifications submitted in requests for preliminary opinions. However, the current guidelines for specifications of goods and services do not necessarily cover the situation where the applicant's products are unfamiliar or are innovative products. The IPD reiterated that it would no longer provide reviews of specifications submitted for preliminary opinion.

Internal Communications between the IPD's Hearings Team and Examination Team

Where citations of conflicting marks are successfully revoked subsequent to a hearing, the applicant will still be required to notify the examiner of the decision so that the citations can be waived. The IPD was asked whether the citations could be waived without the need to notify the examiner. In



response, the IPD cited Rule.13 of the Trade Marks Rules which requires written submissions to be made in order for an application to proceed.

Errors in Certificates of Registration

The IPD has been notifying trade mark owners regarding errors discovered in filing dates, Convention priority claims and series marks in the IPD's own records. The IPD confirmed that new certificates of registration would be issued with correct details.

Issuance of Observation Letters Shortly Before Deadline of First Opinion

The IPD was asked to account for the issuing of observation letters shortly before the expiry of the deadline of the first opinion. The practice was justified according to the IPD if, by making a minor amendment to the application, the requirements for registration would be satisfied.

Objections Against Wide Specifications

In response to the observation that the IPD has been raising objections under Rule 7(4) of the Trade Marks Rules against trade mark applications covering as few as six to seven classes, requiring the applicant to submit documents or evidence to show that the goods and services claimed in the specification of goods and services are justified, the IPD stated that such evidence would not be examined to the same standard as evidence of use. In making the decision to issue such letters, the IPD would consider applicants on a case by case basis before deciding when Rule 7(4) should come into play.

IPD Overhelping Litigant In Person

In a contested time extension hearing where the applicant was represented by its in-house counsel, the Hearing Officer was observed intervening in the applicant's request for costs after it had already made submissions as to costs. In response, the IPD said that it would consider the matter further.

Rectification or Correction of the Register

The IPD sought to correct an error in the Register where applications were incorrectly identified as a series of marks. No objection was raised to the proposed amendment. The IPD required the registered owner to return the original certificates of registration before issuing new corrected certificates. However the original certificates were lost, and the applicant was requested to provide a statutory declaration to explain. The IPD will now reissue a certificate without a statutory declaration.

Work Manual – Hearings

The IPD's attention was drawn to an error in the "Hearings" chapter of the Work Manual in paragraph 2 of page 1:-

The Registrar will, on his own initiative (rule 74(4) and (7)) fix the date, time and place for the hearing and send a notice of this to the parties.



The IPD confirmed that the reference to Rule 74 (7) is an error as there is no such rule and will amend and reissue the chapter.

Deficiency Affecting the Filing Date – Legibility of Representation of the Mark

IPD took over 3 months to notify a deficiency affecting the filing date, resulting in the trade mark application being assigned a filing date three months after the application was lodged. The deficiency in this case rested on the word elements in the mark which had been compressed in size to comply with the IPD's application formalities being unreadable. The IPD recommended that enlarged representations of the mark may be submitted by hand, or applications should be filed on paper if the electronic version of the mark is not clear.

Extension Request for an Application for a Certification Mark

In an application for a certification mark, the applicant needs to submit the regulations and a statutory declaration within 9 months after the filing date of the application. This deadline is extendible. If the Registry issues an "Observation" (as opposed to an Opinion or Further Opinion) and specifies a deadline for the applicant to respond, it is possible to apply for an extension of time under Rule 94(1)(b).

Form T13(i) is only applicable for extensions under Rule 13(3) and Rule 13(6). An extension under Rule 94 may only be filed in a paper form of Form T13.

It is suggested that the Trade Marks Work Manual be updated to remind practitioners of the requirement of using a paper form for an extension request under Rule 94.

Re-Classification Notices

A request was made to issue re-classification notices with the proposed changes highlighted in bold or in a different colour so that it is easier for practitioners to spot the proposed changes, particularly when the registrations have very extensive specifications of goods and services.