

# The Hong Kong Institute of Trade Mark Practitioners Limited



## **THE JOURNAL**

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### **Message from the President**

Dear Members,

Festive greetings to everyone as we enter the Christmas and New Year season!

First of all, may I thank my predecessor Helen Tang for all her hard work holding the reins during her previous two year term as President. Secondly, may I reach out to all of you as stakeholders in this Institute to encourage you to participate to further the goals of the Institute. An organisation like ours relies on all its members to be involved, not just its office holders and other Council members who already put in a lot of effort and support to make it all work, long after the day job is over. Whether it be providing feedback to the Council on issues affecting you as practitioners, lobbying for points that matter for your clients or simply attending and participating when we run Institute events, this body is for you. Having a friendly and professional forum to meet and exchange ideas and views with your fellow practitioners, and hopefully make some good friends along the way, is something that we should all cherish and value, and should never be taken for granted. It has never ceased to amaze me in my time in practice, how many other jurisdictions lack such a friendly environment to engage together and I do believe that it is part of what makes Hong Kong such a strong and attractive place to work as an IP practitioner and to do IP business as a client.

I will therefore strive during my term to encourage greater participation at the grass roots level within the Institute. As one plank of that we have set up a Linked-In Group for the Institute and I would encourage people to join that as an additional online meeting place at everyone's finger tips, to interact with your fellow members.

One recent event that is worth highlighting is the Business of IP Asia Forum co-organised by the IPD and the HKTDC on 5 & 6 December 2013. This event is now in its third year and has grown to be a great showcase of Hong Kong's place as a convenient and trusted IP trading hub and marketplace. I was invited to moderate a panel session on 'Exploitation of IP Rights in Business - Technology Transfer and Licensing' and panellists included Institute members, Peggy Cheung and Jeff McLean, and Winnie Yeung of Microsoft Hong Kong Limited. The conference was opened by the Hon. CY Leung and attended by nearly 2,000 registered delegates from 25 countries - see article later with some photos from the event. In parallel with the conference, I also attended on behalf of the Institute a signing ceremony between SIPO and the IPD on cooperation arrangements in the area of patents.

There have been a couple of recent government consultations, on which the Institute has made submissions, discussed in this newsletter (copies of which are available on our website [www.hkitmp.org](http://www.hkitmp.org)) and we also report on points raised at the Institute's recent bi-annual meeting with the IPD.

Justin Davidson  
HKITMP President



## EVENTS AND ACTIVITIES

### Past Events

#### 1. HKITMP AGM

The 2013 HKITMP AGM was held at the America Club, Exchange Square on Wednesday 25 September 2013. This year, Ruby Chan, Benjamin Choi, Andrea Fong, Peggy Cheung, Charmaine Koo, Davina Lee, Theresa Mak were obliged to step down from Council, though happily all seven re-stood and were re-elected for another term. The Institute also received a further nomination from the floor, for the last remaining Council member position, for Serena Lim, who was also duly elected. Following the AGM, a short Council meeting was held and the appointed Officers and Council Members for 2013-2014 are now:



2013 HKITMP AGM

<b>President:</b>	Davidson, Justin C.	Norton Rose Fulbright
<b>Vice President:</b>	Lee, Davina	Marks & Clerk
<b>Secretary:</b>	Gibbons, Sandra	Marks & Clerk
<b>Membership Secretary:</b>	Choi, Benjamin	Mayer Brown JSM
<b>Treasurer:</b>	Houng, Cynthia	Marks & Clerk
<b>Council Members:</b>	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
	Koo, Charmaine	Deacons
	Lim, Serena	Hogan Lovells
	Lau, Patsy	Deacons
	Mak, Teresa	Yu & Partners
	Tang, Helen	Wilkinson & Grist
	Yen, Barry	So Keung Yip & Sin
	Yue, Winnie	Deacons



Group photo of newly elected Council Members  
Standing (from left to right): Nick Horvarth, Serena Lim, Davina Lee, Ruby Chan, Sandra Gibbons,  
Jeff McLean, Barry Yen, Charmaine Koo, Andrea Fong and Benjamin Choi  
Sitting (from left to right): Justin Davidson, Helen Tang, Cynthia Houg and Theresa Mak

## **2. HKITMP IP Prize**

The recipient of the Institute Prize for Intellectual Property in the Principles of Intellectual Property Course for the academic year 2012-2013 is Chung Ming Yan Cecilia of the Chinese University of Hong Kong. Cecilia was present at our Annual General Meeting to receive her prize.

## **3. 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 5 & 6 December 2013. As mentioned in the President's Message, the conference was opened by the Hon. C Y Leung, The Chief Executive, Hong Kong SAR, and attended by nearly 2,000 registered delegates from 25 countries.

The Asia IP Exchange (AsiaIPEX) [<http://www.asiaipex.com>] was officially launched shortly after the opening remarks by The Hon C Y Leung, Mr. Tian Lipu, Commissioner, State Intellectual Property Department of the People's Republic of China and Ms. Wang Binying, Deputy Director General, World Intellectual Property Organization. AsiaIPEX is a free online platform and database of IP rights developed and managed by Hong Kong Trade Development Council, with a view to facilitating trading of IP rights. There was also signing ceremony between SIPO and the IPD on cooperation arrangements in the area of patents.



The Hon. C Y Leung delivering his opening remarks.



Peter Cheung, Director of Intellectual Property Department of Hong Kong (left) and Tian Lipu, Commissioner, State Intellectual Property Department of the People's Republic of China (right) at the signing ceremony between SIPO and the IPD on cooperation arrangements in the area of patents.

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, and Winnie Yeung, Director, Legal & Corporate Affairs, Microsoft Hong Kong Limited.



From left to right: Peggy Cheung, Winnie Yeung, Jeff McLean and Justin Davidson.

#### **4. HKITMP Linked-In Group**

The Institute has set up a Linked-In Group with a view to encourage interaction amongst fellow members and greater participation at the grass roots level within the Institute. The Linked-In Group serves as an additional online meeting place for members.



## **Future Events**

### **1. Lunch time seminar in January 2014**

We are inviting some speakers to speak on topical issues and will confirm the topic and seminar details once the speakers confirm their availability. At the time of publication, the next lunch time seminar is scheduled to take place in January 2014.

### **2. The Institute's Spring Dinner**

The Institute's annual Spring Dinner is scheduled to take place on 27 February 2014. Further details will be circulated once the venue is confirmed.

## **Dates for Upcoming IP Related Events**

<b>Event</b>	<b>Date</b>
INTA Annual General Meeting, Hong Kong	10-14 May 2014
ECTA Annual Conference, Alicante, Spain	18-21 June 2014
MARQUES Annual Conference, Copenhagen, Denmark	23-26 September 2014

## **LEGAL UPDATES**

### **IPD Biannual Meetings**

#### **1. Updates On Issues Raised By Members At Previous Meetings**

##### **a) Possibility Of Linking Status Check Page To Search Site**

At previous bi-annual meetings, members enquired whether the IPD could provide a link to a glossary of status descriptions for trade marks on the register on the Registry's search facility. The IPD had considered members' requests and have now provided a link to "Status Description" displayed at the left-hand column in the screen of the Registry's search facility.

##### **b) Transliteration and Translation of Non-Roman and Non-Chinese Characters**

At the previous meeting, the IPD was requested to clarify the examination standards with regards to marks containing words/characters not in Roman letters or Chinese characters. The IPD responded that transliterations / translations provided by applicants for marks containing words/characters not in Roman letters or Chinese characters, word marks in different language are





unlikely to be regarded as similar. In the IPD's post meeting notes, the IPD further clarified that although the transliterations and translations of the foreign characters forming the marks are not entered in the Register, such transliterations and translations will be used by the Examiner in considering whether to raise absolute grounds objections against a mark of foreign language for which the meaning may not be easily checked.

c) Clarification of Opposition Deadline in a Short Month

In response to a query from members, the IPD clarified that the opposition deadline for an application published on 30 November should be 29 February in leap years, and 28 February in common years. Since the last meeting, the IPD is considering providing examples in the Trade Marks Registry Work Manual Chapters on "Opposition" and "Computation of time for filing at the Registry".

## 2. Bi-Annual Meeting on 31 October 2013

The last Bi-Annual meeting with the IPD took place on 31 October 2013. 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 2012 to September 2013. There was an increase by 1.28% 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 0.17%. However, for short-term patent applications, there was a decrease by 0.20% in the number of applications received.

For design applications, there was an increase by 1.99% in the number of designs applied for registration.

### B. Issues Raised By Members

a) Roman Numerals

Clarification is sought on whether Roman numerals, such as "I" (one), "V" (five), "X" (ten) and "L" (fifty) will be treated as numbers or as letters if they are incorporated in a trade mark for which application is sought. In response, the IPD confirmed that it will consider the mark as a whole and cannot say whether, in general, numerals will be interpreted as a letter or a numeral. It will depend



on context and on whether the public perceives the mark as a numeral.

b) Rules on Preparation for Bundles for Inter-Parte Hearings

Clarification is sought on the rules on preparing evidence bundles at inter-parte hearings. Particularly, in the absence of provision / guidance in the Trade Marks Registry Manual, whether we may refer to the rules applicable to High Court for reference. In response, the IPD clarified that it generally follows the Rules of the High Court. Whilst the Trade Marks Work Manual states that hearing bundles needs to be paginated, the IPD notes that various practice directions are difficult to enforce, particularly where a party is not represented.

c) Timely Issue of Letters Confirming Filing Date

Certain members raised the issue of delays in receiving confirmation of filing dates from the Registry. In an example, three applications for three different marks in the name of the same applicant were filed on the same day. Two have been published for opposition, however, in relation to the third, an official letter has yet to be received confirming the filing date. Whilst the oversight and inconsistency may be inadvertent, we stressed the importance of having a confirmed filing date issued as early as possible. The IPD replied that it is actively trying to clear the backlog and reduce delays. New examiners have been recruited and they are undergoing training. Hence, it may be some time till the backlog is cleared.

d) Post-Grant Amendment of a Hong Kong Standard Patent Registered on the Basis of a European Patent

Under s. 43(1) of the Hong Kong Patents Ordinance:

*If the specification of the corresponding designated patent in respect of a standard patent granted ... has ... been amended in the designated patent office following prescribed opposition or revocation proceedings, the proprietor of the standard patent shall file with the Registrar ... within the prescribed period a verified copy of the amended specification or the amending order or other prescribed documents.*

Under s. 36 of the Patents (General) Rules under the Patents Ordinance:

*The following opposition or revocation proceedings are prescribed for the purposes of sections 43 ... of the Ordinance –*

...

*(b) in European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.*



The European Patent Convention has recently been revised, allowing a proprietor of a European patent to limit (under Articles 105a to 105c) a granted European patent by an amendment of the claims, which, if allowed, will be effective in all the Contracting States in which it has been validated.

However, as limitation is not an opposition or revocation proceedings prescribed under s. 36 of the Patents (General) Rules, the Registrar of Patents has refused to amend a Hong Kong standard patent registered on the basis of a European patent which has subsequently been limited. This means that the proprietor of a Hong Kong patent has to consider petitioning to the Court for a post grant limitation of the Hong Kong patent, which is significantly more expensive than a simple amendment application before the Registrar. The IPD replied that it will consider this matter further.

e) Other Matters

- i. The IPD informed us that its IT infrastructure is currently being replaced and therefore the frequency at which the IPD's website is not available will increase. The process will last until next year. There will however be no difference to the public interface after the new infrastructure is in place.
- ii. The current waiting time for inter parties substantive hearings is 20-22 months.
- iii. The IPD is conducting an internal costing exercise and will review the official fees for trade marks, patents and designs. There may be a revision of the official fees upwards or downwards depending on the outcome of the costing exercise. The revision is scheduled to take place in the second half of 2014.
- iv. The IPD is considering the implementation of the Madrid Protocol and Hague Agreement Concerning the International Registration of Industrial Designs to Hong Kong.
- v. The IPD is also considering requiring the stating of a company's description on Form T2 where applicant is a company. This is so that the owner of a trade mark can be easily identified with information such as the type of incorporation and place of incorporation recorded on the register.





## MEMBERSHIP

Please contact our Membership Secretary, Benjamin Choi, at [membership@hkitmp.org](mailto:membership@hkitmp.org) if there are any changes in your contact details.

### Recent Moves

Name	From	To
Gabriela Kennedy	Hogan Lovells	Mayer Brown JSM
Davina Lee	Hogan Lovells	Marks & Clerk
Timothy Letters	Deacons	Letters & Thoo Patent and Trade Mark Attorneys
Serena Lim	So Keung Yip & Sin	Hogan Lovells
Lawrence Thoo	Deacons	Letters & Thoo Patent and Trade Mark Attorneys

### New Members

We are pleased to welcome Douglas Clark of Gilt Chambers, Lau Siu Fan, Kristy of Marks & Clerk and Amy Yuanyuan Zhang of Hogan Lovells as new members of the Institute.

## QUIZ

Q: What was the first trade mark ever registered and where?

The answer will be revealed in the next HKITMP Newsletter.



*Merry Christmas  
and  
Happy New Year!*