

The Hong Kong Institute of Trade Mark Practitioners Limited



THE JOURNAL

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Message from the President

Dear Members,

I wanted to get this newsletter out to you in advance of the INTA Annual Meeting that is now almost upon us. No doubt all members are, like me, frantically busy clearing their desks and filling their schedules for this global giant of an IP event. As I am sure you all know, this is the first time the Annual Meeting has been held in Asia, let alone Hong Kong, and only the third time outside North America in over 130 years. It is therefore perhaps unlikely the Annual Meeting will be back any time soon, so please do welcome our guests and all make the most of it so as to do the Hong Kong IP profession proud, for it is certainly our hour in the global IP limelight.

The main report in this issue is the feedback from our recent biannual meeting with the IPD, about which I will let you read a summary later. We do try to bring current and practical issues to these meetings with the Registry on behalf of all our members, so if you have a practice matter you would like addressed, without recourse to you or your client's specific case, please do get in touch with myself or a Council member so that it may have the chance to be raised.

Last but not least, please do send any comments about this edition of the Journal, and any letters, articles or other contributions for future issues to the Editor, Serena Lim (serena.lim@hoganlovells.com). If any members are not receiving the Journal properly, please advise the Membership Secretary in case your contact details are not properly recorded.

Regards

Justin Davidson
HKITMP President



EVENTS AND ACTIVITIES

Past Events

1. Lunch Time Seminar in January 2014

The Institute had the pleasure of having Stella Law from CBRE Hong Kong to talk about IP Valuation on 21 January 2014. The seminar was well attended. The topics covered by the speaker include the various methods commonly used to value IP rights with examples of how those are applied.

2. The Institute's Spring Dinner

Following popular demand, the Institute once again held a hot pot dinner to welcome Spring. This year, the Spring Dinner was held at San Xi Lou.

Future Events

1. INTA Annual General Meeting

IP practitioners in Hong Kong will be looking forward to welcoming fellow practitioners from around the world to Hong Kong for the upcoming 135th INTA Annual General Meeting, which will take place between 10-14 May 2014.

2. Lunch Time Seminar

Please save the date for our next lunch time seminar, which is set to take place on Monday 2 June 2014. Further details will be sent out to members shortly.

3. HKITMP Bowling Event

We care about work-life-balance. Please stay tuned and join us for the next Summer Bowling Event which will take place on Wednesday 11 June 2014 at the Ladies Recreation Club.



LEGAL UPDATES

IPD Biannual Meetings

Bi-Annual Meeting on 11 April 2014

The last Bi-Annual meeting with the IPD took place on 11 April 2014. A summary of some of the issues raised at the meeting follows:-

A. Issues Raised By Members

1. Greater transparency on opposition and cancellation matters

Some members noted that there is presently no easily accessible list of pending oppositions and cancellations, and that there is also no public notification of hearings. The Registry is suggested to consider something similar to the Courts' daily cause list. (http://www.judiciary.gov.hk/en/crt_lists/daily_caulist.htm). In response, the IPD commented that Registry hearings are already public and a printed list of daily hearings is posted on the 25th floor outside the hearing room. However, there are practical issues with accommodating very much public attendance at hearings. The usual IPD Hearing room itself is very small and at present can only accommodate the parties directly involved in the proceedings. The IPD currently does not have the space capacity to accommodate larger numbers. The IPD drew attention to the fact that Copyright Tribunal hearings are listed online, but they are held in the (larger) IPD Function Room. Unfortunately it is not possible to reserve the Function Room exclusively for trade mark hearings, to accommodate greater public attendance, given the number of trade mark hearings.

2. Online database record of corporate owners' country of incorporation

When implementing the online system, IPD did consult with the Institute and the other professional bodies on the removal of this information and at the time, most practitioners were content with less information on the application form, so it was not incorporated as a data field in the online system. However, it has become apparent over time that, for example on an assignment, this information can be crucial for correctly identifying the current corporate owner (with multiple jurisdictions using the same corporate naming conventions). Members suggested that the IPD revisit this issue, perhaps on renewals. In response, the IPD mentioned that this issue has been raised by other stakeholders. The IPD has consulted the Department of Justice ("DOJ") about this. The DOJ has confirmed that the IPD has no power to make it mandatory to provide the country of incorporation and in order to do so, a change in the law would be required. It is unlikely that this would be given priority given the current legislative backlogs.



The Institute raised the possibility of making the provision of country of incorporation data voluntary as an interim measure, pending a change in the law. The IPD has been informed by other stakeholders that they intend to make written representations for consideration by the DOJ. The IPD asked if the Institute would liaise with other stakeholders to obtain their views as they have in the past, so as to combine to push for a change in legislation as opposed to any interim proposal.

3. IPD's examination standard on relative registrability

Members have noted that in some recent trade mark applications, the IPD appears to have departed from its past standard of examination on relative registrability. Some examples of such apparent departure were discussed at the meeting. The Institute queried whether there had been a positive change of policy approach on relative registrability. In response, the IPD confirmed that the examples provided by the Institute are isolated incidents and there has been no formal or informal change in examination standards.

4. Staying Taxation requests

Members queried whether it is possible to seek the Registrar's direction on staying a taxation request, if the Registrar's decision is pending on appeal to Court. The IPD confirmed that it is possible to seek leave either from the Registry or from the Court to stay taxation proceedings.

5. Companies (Disclosure of Company Name and Liability Status) Regulation (Cap. 622B)

From 3 March 2014 onwards, under the above new regulation, companies with both Chinese and English names recorded with Companies Registry must state both names in certain documents and official publications. Failure to do so will constitute an offence. Members asked whether the IPD has considered this issue (for example, in relation to publication of a company's trade mark applications in the 'official' Government Gazette) and whether the system will cater for this change so that applicant can readily record both English and Chinese names at the time of filing and/or when processing any post registration changes that will be officially published.

The IPD's position is that there has not been a significant change in the obligations required from the IPD. The IPD's interpretation of the legislation is that a company must state its registered name on business letters and communications generated by the company itself. The IPD is not bound by this obligation. In any event, it is possible to insert both the English and Chinese company name on form T2 should an applicant wish to do so.

6. Cross-checking with post-registration team (e.g. in relation to assigned citations)

Due to delays in handling some post-registration matters (e.g. assignments), members noted that citations are sometimes received (when the cited mark has in fact already been assigned to the applicant but is waiting completion of the recordal) and applicants have to file extensions of time pending the recordal of the assignment just to maintain the application. This causes unnecessary delay



and costs to applicants when it can be internally verified by the Registry. The IPD is requested to consider whether anything can be done to improve the situation. For example, can the examiner cross-check with the post-registration team before issuing the first opinion.

Members also noted that sometimes the applicants use different agents to handle the recordal of assignment and the new filing, and the Registry normally does not provide the agent handling the application with information/status of the recordal as they are not the agent handling the recordal. Members asked if the Registry could be more flexible in sharing information with agents handling the application if the prior mark pending an assignment is raised as a citation.

The IPD confirmed that there is already some cross-department consultation. However, practitioners can write to or call the Registry if necessary to draw these circumstances to the examiner's attention and such assignment recordal cases can then be given priority.

7. Burden to prove proper service of pleadings / documents in contentious proceedings.

The TM Ordinance / Rules require that documents be left at or sent by post to the address for service on the Register, or if there is no address for service, then if sent by post to the last known address. The Ordinance / Rules / Work Manual is silent on whether the party effecting service has the burden of proving service, or whether it is up to the recipient to challenge service after receipt of the Registry's letter informing the recipient that proceedings / evidence have been filed (where the recipient will also be requested to confirm the date it received the documents). The Registry is requested to clarify whether in absence of a response to the letter from the Registry, the Registry will assume that documents are properly served.

The IPD responded that the Forms T6 and T7 require the applicant to indicate whether the papers have been served on the other party and the date of such service. In practice, the T6 and T7 are often accompanied by copies of the covering letters to the other party. The IPD will write to the other party for confirmation of the date of receipt of the documents. If the IPD does not receive a response, it will proceed on the basis that the documents have been received.

8. Joint Oppositions

The IPD is 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. In particular it would be helpful if the Work Manual could state that in these circumstances, the proceedings can be consolidated into a single set of proceedings, rather than needing to file two separate sets. The Registry responded that the Work Manual will be amended to clarify the current wording.



9. Update on possible future introduction of the Madrid Protocol to Hong Kong

Members requested an update on the possible introduction of the Madrid Protocol to Hong Kong.

In response, the IPD informed the members that in view of the fact that brand owners are in favour and that many other jurisdictions have committed to the Madrid system there is a fair chance that it will be implemented in Hong Kong at some point, particularly considering Hong Kong's long term strategic position. The IPD indicated that there would be assistance from WIPO with clarification of the system and that IPD would do its best to minimise any impact on stakeholders. The introduction of the Madrid system would be a government-wide initiative and not solely pushed forward by the IPD. The first step will be considering Hong Kong's policy approach to the issue and the process of developing such a policy has begun, but it will be quite a few years before such a Madrid system might be in place.

10. Scope of Specifications

Members asked what the IPD's position is on the *IP Translator* case. Without having the opportunity to review the case in any detail, the IPD's preliminary response is that it will assess a specification to see if the claim is reasonable.

B. Other matters raised by the IPD

i. Deficiency Notices

The IPD asked for cooperation from members to provide their responses to deficiency notices at least 7 working days before the expiry of the deadline, if possible, as this would greatly assist with the processing of the responses.

ii. Amending an application by adding a "house" mark

The IPD reiterated that the proposed amended mark should be the same colour as the house mark.

iii. Fee Review

The IPD has undertaken a fee review exercise, given that the current level of fees has been in place for 10 years. As a result, it is possible that there will be a substantial fee adjustment, but the IPD would not indicate whether there would be rise or reduction in the level of fees. The time line for the introduction of revised fees will likely be during the 2014-2015 legislative year, so to take effect in 2015.



OTHER ISSUES

Asia IP Exchange

As members may be aware, the Hong Kong Government is very keen in promoting Hong Kong as an IP trading hub. The Asia IP Exchange IP trading platform was launched by the Hong Kong Trade Development Council recently and its website is at http://www.asiaipex.com/Home/Index_EN. This will be a platform for IP right owners to offer IPs which they are no longer interested in maintaining for sale. IPD is keen that the Institute's members should promote its existence to and encourage its use by their clients.

IP Clinic

To achieve the target of making Hong Kong an IP trading hub, the Hong Kong Government is considering to set up IP Clinics which are specialized in provision of free but limited (initial and preliminary) legal consultation / advisory services on IP issues to individuals or SMEs with a view to facilitating the targeted parties entering into IP transactions. The Government recognizes that such services should be provided by legal practitioners with specialized IP knowledge and experience, such as the members of the Institute.

The IPD is seeking the views of members on the feasibility of such proposed IP Clinics and very much welcomes any suggestions members may have to achieve the Government's objectives.

Members are invited to submit their views and/or indicate their willingness to participate in the intended IP Clinics by way of an email to the Institute President at Justin.Davidson@nortonrosefulbright.com.

MEMBERSHIP


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

We are pleased to welcome Michelle Yee of Norton Rose Fulbright as a new member of the Institute.

QUIZ

Last Issue's Question: What was the first trade mark ever registered and where?



A: , registered in the United Kingdom in 1875.

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

The answer will be revealed in the next issue.