

The Hong Kong Institute of Trade Mark Practitioners Limited



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Celebrating World IP Day on 26 April Innovate for a Green Future

Message from the President

Dear Members,

Many of you would be travelling to Singapore this week if not for the travel restrictions and cancellation of the INTA Annual Meeting. I hope everyone is keeping well during these interesting times.

The Covid-19 outbreak caused many businesses to review their operations and adapt to the interruptions caused by social distancing measures. We in the IP profession have not been spared. Many law firms and IP agencies including the IPD have allowed employees to work from home where situation permits. Instead of in person meetings, many discussions are now held over the phone or via video conference.

In Hong Kong, we have been fortunate that new IP filings can still be made through the IPD's e-filing system so right owners can still file applications and obtain confirmed filing dates almost instantaneously. We are able to file documents with the IPD through the e-filing system and the Registries' front desk remain open to allow filing of physical documents, so that contentious matters can still progress. The IPD is also considering the possibility of holding hearings via video conferencing, so that business can be as "usual" as possible while taking precautionary measures to ensure the health and safety of all concerned. At the Courts, all civil and criminal proceedings will resume on 4 May albeit with reduced capacity.

At the Institute, we have held our Council Meetings regularly, with the use of video conferencing facilities, and have been working closely with the IPD on the legislative amendments planned for this year. We have not been able to organize our usual Spring Dinner and Summer Event yet, and the lunch-time seminar originally scheduled for earlier this year has been postponed. However, we are looking at running webinars in place of our usual in-person seminars, so watch this space for further updates!

We must count our blessings and be grateful that Hong Kong is not subject to a strict lockdown. And I look forward to seeing all of you at our events once we are able to organize one.

Serena Lim
HKITMP President





EVENTS AND ACTIVITIES

2020 Events

1. 2020 Lunchtime Seminars

The Institute's first 2020 seminar, "The legal principles in relation to the cause of action in breach of confidence in Hong Kong" by Martin Kok of Des Voeux Chambers, originally scheduled for 18 February, and postponed to 12 May 2020, will now be further postponed to the Autumn.

In light of continued social distancing rules, there are plans to hold a webinar lunchtime seminar in May instead. We shall circulate further details as soon as confirmed.

2. Spring Dinner

This year's Spring Dinner unfortunately had to be cancelled due to the Covid-19 lockdown. The Institute hopes to host a larger Summer Event if Covid-19 circumstances permit by then.

Future Events

We welcome ideas and suggestions from our members for future Institute events (even virtual events!).

Dates for your diary

INTA - venue changed from Singapore to Houston, Texas, USA - postponed to 16-20 Nov 2020

LESI - cancelled (original schedule: Berlin, Germany - 17 - 19 May 2020)

MARQUES - Stockholm, Sweden - 22 - 25 September 2020

APAA - Gold Coast, Australia - 13 - 17 November 2020



LAW/PRACTICE UPDATES

IPD Bi-Annual Meetings

Please feel free to raise any IP law or practice issues with any member of Council, so that we may discuss these on your behalf at our regular liaison meetings with IPD.

The Institute's last regular meeting with the IPD took place on 27 November, 2019. A summary of the issues raised at that meeting is as follows:-

1. Updates on Matters Arising from Previous Bi-Annual Meeting

a. Implementation of the new patent system

The IPD informed the Institute that the new patent system was ready and would be launched as scheduled on 19 December 2019. IPD was in the final stage of drawing up the examination guidelines and would re-run a briefing session about the examination procedures under the new patent system on 2 December 2019.

[Post-meeting Note: The new HK patent system was launched on 19 December 2019 in tandem with the rollout of the new purpose-built IT system (OGPIS), and the full set of examination guidelines was issued before the launch of the new patent system.]

b. Proposed application of Madrid Protocol to HKSAR

The IPD informed the Institute that it had been awaiting the resumption of the second reading of the *Trade Marks (Amendment) Bill 2019*. Meanwhile, IPD had begun work on drafting instructions on legislative amendments to the Trade Marks Rules.

Two focus group meetings would be arranged on 9 and 18 December 2019 to consider a list of items concerning rules to implement the Madrid Protocol. Two further meetings relating to hearing issues would be scheduled in early 2020.

c. Proposed amendments to the Rules of the High Court (Cap. 4A), Trade Marks Rules (Cap. 559A), Patents (General) Rules (Cap. 514C) and Registered Designs Rules (Cap. 522A)

The IPD informed the Institute that it had submitted legislative proposals to the Judiciary in August 2019 seeking 'in-principle' approval from the High Court Rules Committee. After obtaining such approval, IPD and Commerce, Industry and Tourism Branch of Commerce and Economic Development Bureau would brief the LegCo panel about the proposals and seek its support before initiating the negative vetting exercise in LegCo.



d. Review of copyright exceptions for persons with a print disability

The IPD reported that the *Copyright (Amendment) Bill 2019* (the “2019 Bill”) was gazetted on 1 November 2019. The first and second readings of the 2019 Bill were completed at LegCo’s meeting on 27 November 2019. Debate on the Bill was adjourned.

e. Regulation of titles of Trade Mark agents or practitioners

A joint meeting was held between IPD and representatives of the Institute and two other IP practitioners’ bodies on 20 November 2019, during which the regulation of titles was discussed.

As the matter concerned the whole trade mark practitioners’ sector, IPD considered it would be more appropriate to follow up the discussions at such joint meetings in future, which would be held on an annual basis.

2. Items raised by IPD

a. IPD Statistics and performance

The number of trade mark applications received during the period from November 2018 to October 2019 (the “Update period”) decreased by 4.61%, as compared to the same period from 2017 to 2018. For standard patent “request to record” applications, short-term patent applications, and design applications received during the Update period, there was an increase of 1.7%, 14.4% and 10.8% respectively on a year-on-year basis.

b. Update on the New Integrated IT System (“NIS”)

IPD reported that the final phase of the NIS was scheduled to launch on 19 December 2019. The launch would be of a much smaller scale, including provision of new web-forms relating to inter-partes proceedings, hearings and certified true copies. The data fields for requesting extension of time in web-form T13 would also be enabled for e-filing.

With the provision of web-forms for matters relating to inter-partes proceedings and hearings, documents such as pleadings and correspondences can be filed electronically with the Registrar. However, paper filing would still be required for certain documents.

3. Issues Raised by Institute Members

a. Trade Marks Registry’s Work Manual chapter on consent letters

IPD confirmed that original/ certified copy of consent letters issued by proprietors of cited marks is no longer required under the new practice which came into effect on the launch of NIS in February 2019. Furthermore, a consent letter can be printed on plain paper instead of the cited owner’s letterhead, but the capacity of the signatory of the consent letter should be clearly stated.



b. Chinese character searches for owner's name and searches in general

IPD reported that the new Public Online Search ("POS") system is able to retrieve results that match with the traditional or simplified Chinese characters of the search input. However, if the owner's name contained (i) variant Chinese characters or (ii) Chinese characters which could be used as traditional or simplified versions, the search could only retrieve results that matched the exact character(s) input by the user.

c. Comma function in Advanced Search

IPD provided a wildcard search function (*) in the Advanced Search of POS, in response to certain feedback on the comma (,) function.

d. Imprecise specification of goods/ services

The Institute commented that the items "computer software" in Class 9 and "online retail services; retail store services; retail department store services; etc." in Class 35 (the "relevant goods/ services") were not clear and concise.

IPD referred to biannual meeting discussions in 2012/2013 where mixed views were expressed on the item "computer software" in Class 9 and where IPD decided to maintain the practice of not requiring applicants to provide detailed particulars of the "computer software" in the specification.

Upon receiving comments from the Institute, IPD conducted a further review and maintains the view that the relevant goods/ services should be sufficiently clear *per se*. IPD also noted the following examination practices which were highlighted at the meeting:-

(i) Deficiency checking stage - it might not be feasible to provide further details of or particularise the subject matter of the computer software and/or the goods involved in online retail services within the non-extendable two-month period for responding to a notice of deficiency.

(ii) First examination stage - citation could be raised if the applied-for mark was identical/ similar to a prior mark and the specifications of both marks contained the relevant goods/ services without any qualification.

(iii) Subsequent examination stage - restriction of specifications, e.g. by particularising the subject matter of the software or the goods to be sold through the retail services, might assist to overcome the citation.

IPD also noted the items "computer software", "online retail services" and "department store retailing" without particularization are accepted in a number of other jurisdictions.

The Institute also inquired whether bad faith on the part of a registrant could be implied in invalidation proceedings where the registrant had applied for a broad range of goods. IPD replied that bad faith



had always been considered as a serious allegation, which had to be determined on a case-by-case basis.

e. Case Management Conferences (“CMC”)

IPD explained that the Registrar may (i) direct the parties to attend a CMC; or (ii) give directions in relation to procedure or filing of documents/ information/ evidence irrespective of whether a CMC had been held. The Work Manual sets out some non-exhaustive scenarios under which a CMC would be considered suitable to facilitate resolution of procedural issues.

To minimize occasions where parties fail to provide particularized pleadings, IPD will propose amendments to the Trade Marks Rules. Hearing issues will be discussed in focus group meetings with the Institute in January 2020.

MEMBERSHIP

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

Linked-In – please note that any Institute member is free to join our HKITMP group on *Linked-In*.

2020 Moves

Name	From	To
Jonathan CHU	Stephenson Harwood	CMS Cameron McKenna Nabarro Olswang LLP
Rebecca LO	Rebecca Lo & Co	Gallant

2020 New Members

A warm welcome to the following new member of the Institute:

Name	From
Lilian Xiaoli SHI	Dorsey & Whitney



QUIZ

Last Issue's Question:

Q: When is the first copyright for Walt Disney's Mickey Mouse due to expire?

A: 1st Jan 2024.

This Issue's Question:

Q: Who will be WIPO's upcoming Director General and from which country is he/she?

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