

The Hong Kong Institute of Trade Mark Practitioners Limited



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Goodbye 2020, Hello 2021!

Message from the President

Dear Members,

The pandemic has brought about many changes in the intellectual property industry. Many of us, including the Intellectual Property Department have implemented measures for remote working. Some hearings before the Registry as well as the Courts have been disposed of on paper or via video conference. Most face-to-face meetings were replaced by telephone or video conferences. We also saw the usual IP conferences (BIP Asia and INTA Annual Meeting) taking place virtually.

Despite these changes, it is also business as usual in many aspects. It was the first year of launch of the new Original Grant Patent System and the IPD's New Integrated IT System. We also saw the passing of the Trade Marks (Amendment) Ordinance 2020 and Copyright (Amendment) Ordinance 2020. Work on preparation or amendment of the rules for implementation of the Madrid Protocol in Hong Kong and on other IP or trade mark related matters (such as those for hearings before IPD and the Courts) have also been ongoing.

At our bi-annual meeting with the IPD, the Institute continues to further the interest of trade mark practitioners. Members will see clarification from the IPD regarding treatment of applications for marks in monochrome and in colour in a series in this Newsletter. We have also proposed a review of the Scale of Costs for proceedings before the Registry. I would like to take this opportunity to encourage members to voice out views for further development of the IP practice. Your continued support is crucial for the Institute to remain relevant.

Year 2020 is unprecedented in many ways. As we bid goodbye to year 2020, I hope that we all enter year 2021 with a positive note. As the saying goes, when you hit rock bottom, the only way to go is up! Here's wishing everyone a Happy New Year, and to a better, greater year ahead!

Serena Lim
HKITMP President



EVENTS AND ACTIVITIES

2020 Events

1. 2020 Lunchtime Seminars

While we were not able to conduct any seminars in person this year due to social distancing restrictions, we were able to conduct two webinars with the kind support of our speakers. The Institute is grateful to both of them, and also to members who have taken the effort to remotely participate in these webinars:

- Mr Doug Clark who spoke on 27 May 2020 on the topic of “IP and Freedom of Expression”; and
- Mr Martin Kok who spoke on 8 September 2020 on the topic of “Legal Principles in relation to the Cause of Action for Breach of Confidence in Hong Kong”.

2. BIP Asia Forum

The Institute continues to support the Business of IP Asia Forum jointly organised by the Government of the HKSAR, the Hong Kong Trade Development Council and the Hong Kong Design Centre. This year’s event was conducted virtually on 3 and 4 December 2020, and the opening remarks were delivered by the HKSAR Chief Executive, the Hon. Mrs Carrie Lam, the Commissioner of the China National Intellectual Property Administration, Dr Shen Changyu, and the Director General of the World Intellectual Property Organization, Mr Daren Tang. For further details, please refer to <http://www.bipasiaforum.com>.



3. Annual General Meeting and Extraordinary General Meeting

This year’s Annual General Meeting took place at Deacons’ office on 17 November 2020. A short Extraordinary General Meeting also took place beforehand and resolutions were passed to amend the Articles of the Institute to create new classes of membership for In-House Members and Honorary Members, and also to entitle Student Members, Overseas Members, and Affiliate Members to receive



notices and attend meetings. Members were given the option to attend the AGM and EGM virtually via video-conferencing.

4. Social Events

Public health issues prevented the Institute from organizing large group social gatherings this year. We will organize one as soon as circumstances permit.

Future Events

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

Dates for your diary

INTA – San Diego, USA - 1 - 5 May 2021 (to be confirmed)

LESI – Virtual Meeting - 27 - 28 May 2021

MARQUES – The Hague, The Netherlands – 14 - 17 September 2021

APAA – Gold Coast, Australia – 29 October - 2 November 2021

LAW/PRACTICE UPDATES

(A) Legislative Updates

1. The Trade Marks (Amendment) Ordinance 2020

The Trade Marks (Amendment) Bill 2019 was passed and enacted as the Trade Marks (Amendment) Ordinance 2020. The Ordinance was gazetted on 19 June 2020, with the majority of its provisions taking effect on the same day. These provisions mainly cover:

- (i) Empowering the Registrar of Trade Marks to make rules to implement the international registration system under the Madrid Protocol;
- (ii) Conferring powers on the Customs and Excise Department to enforce the criminal provisions related to trade mark registration under the Trade Marks Ordinance (the “TMO”); and
- (iii) Making miscellaneous and technical amendments to various existing provisions of the TMO to enhance the relevant trade mark application and registration system.

2. The Copyright (Amendment) Ordinance 2020

The Copyright (Amendment) Ordinance 2020 was enacted and came into effect on 26 June 2020. It aims to enhance the copyright exceptions in the Copyright Ordinance relating to persons with a print disability, and introduce new permitted acts allowing cross-border exchange of accessible copies by specified bodies with authorised entities in other jurisdictions, in order to bring the existing relevant copyright exceptions into line with the standards under the Marrakesh Treaty to Facilitate Access to Published Works for



Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled.

(B) IPD Bi-Annual Meeting

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 4 September 2020. A summary of the issues discussed at that meeting is set out below:

1. Special Work Arrangements of the Registries

In line with the steer from the Government and to reduce the risk of spread of COVID-19 in the community, the IPD implemented special work arrangements since the end of January 2020. Under the arrangements, IPD staff discharged their duties through a flexible mix of office operations and home office operations. Extended staggered working hours were introduced.

The public was notified of the special arrangements concerning the IPD's public service through weekly notices posted on the IPD's website. The IPD also maintained regular contacts with IP practitioner bodies and members of the Institute were notified of the latest IPD working arrangements via email.

Registries' services

Subject to a few exceptions, the following registries services were maintained throughout:

- (i) E-filing;
- (ii) Public online search;
- (iii) Publication of trade mark, design and patent cases in the Official Journal as scheduled;
- (iv) Public Service Counter operated on a reduced scale; and
- (v) Drop box service was introduced since 27 July on days where the counter was closed.

If practitioners were not able to reach IPD staff by telephone, they could leave a voice message and the relevant officer would respond to them as soon as practicable.

Notwithstanding the disruptions caused by the pandemic, the overall performance of the registries was satisfactory during the affected period.

Hearings

For hearings which had been fixed to take place during the affected period, parties were invited to resolve the issues in dispute by paper submissions or by oral hearing via telephone conferencing as far as possible. Where parties were unable to reach consensus on an alternative mode of hearing, it would be adjourned to a date to be fixed. Physical hearings had been held on certain occasions where circumstances allowed. To summarise, the latest position on hearings since 29 January 2020 (up till 4 September 2020) was as follows:

- 34 cases were disposed by paper submissions;



- 7 hearings were conducted by telephone conferencing; and
- 4 physical hearings were held in the IPD.

Looking ahead, the IPD would continue to encourage parties to dispose of the cases by paper submission or conduct their hearings by telephone conferencing. In line with the practice of the Judiciary and other IP offices, the IPD also planned to conduct hearings using video conferencing facilities more readily in the long run, possibly starting as a standing option. The next step will be to identify appropriate cases for pilot run and the IPD would consult the parties to the proceedings in advance.

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

a. Implementation of the new patent system

The new patent system comprising the original grant patent (OGP) system together with the OGPIS, its supporting IT system, were launched on 19 December 2019. The Patent Examination Guidelines are available for viewing on the IPD's website.

The IPD intends to hold practice group meeting(s) with stakeholders in Q1 2021 to hear their views and suggestions on the operations of the OGP system.

b. Proposed application of Madrid Protocol to HKSAR

The IPD informed the Institute that it has been engaging in, amongst others, the legislative exercise with a view to implementing the Madrid Protocol in 2022-23 the earliest.

(i) Principal legislation - Trade Marks (Amendment) Ordinance 2020

As reported above, the Trade Marks (Amendment) Ordinance 2020 was enacted on 19 June 2020 and most of the provisions were brought into force on the same date. To reflect and explain the latest legislative amendments concerning certain practice and procedure of the Trade Marks Registry, the IPD has updated the relevant chapters of the Trade Marks Registry Work Manual, and also published a new set of Q&As online for general reference.

(ii) Drawing up new subsidiary rules

New rules for implementing Madrid Protocol and refining existing provisions of Trade Marks Rules

By virtue of the enabling provisions in the Trade Marks Ordinance (as expanded by the Trade Marks (Amendment) Ordinance 2020), the IPD was working with the Law Draftsman to draw up a set of new subsidiary legislation so as to provide for the necessary procedures for implementing the Madrid Protocol in Hong Kong, and also introduce several miscellaneous/technical amendments for refining certain existing provisions of the Trade Marks Rules.

Hearing-related matters

The IPD held two Focus Group Meetings with the IP practitioners' bodies and Hong Kong Bar Association on 13 January and 7 May 2020 respectively to discuss proposed amendments to the Trade



Marks Rules, with a view to streamline hearing procedures, compress the time limits for parties to file documents in proceedings, e-filing and e-servicing of documents of proceedings. The IPD would consider and take into account the views received in the meetings when formulating proposed amendments to Trade Marks Rules.

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 had submitted the legislative proposals on amending the Rules of the High Court to the High Court Rules Committee in August 2019 for its consideration. The IPD would keep the matter in view and follow up with the Judiciary.

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

The Copyright (Amendment) Ordinance 2020 was enacted and came into effect on 26 June 2020. It aims to enhance the copyright exceptions in the Copyright Ordinance relating to persons with a print disability, and introduce new permitted acts allowing cross-border exchange of accessible copies by specified bodies with authorised entities in other jurisdictions, in order to bring the existing relevant copyright exceptions into line with the standards under the Marrakesh Treaty.

3. Items raised by the IPD

a. IPD Statistics and performance

The IPD highlighted that statistics (except for standard patents “request to record”) showed a decreasing trend comparing the period from August 2019 to July 2020 with the corresponding 12-month period from 2018 to 2019. The number of trade mark applications received decreased by 14.3% (from 39,340 to 33,731). There was a substantial drop of 23.5% in the number of request for search of records/preliminary advice on registrability (Form T1). For short-term patent applications and design applications received, there was a decrease of 10.6% and 13.1% respectively. For standard patent “request to record”, there was an increase of 14%.

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

The final phase of the NIS was successfully launched on 19 December 2019, allowing the electronic filing of trade marks forms relating to inter-partes proceedings, hearings, certified true copies and request for extension of time for opposition and other proceedings. For the documents that can be submitted electronically, please refer to the NIS’ Terms of Use – Electronic Filing and Communication for details.

To further facilitate the conduct of hearings, parties to proceedings would soon be able to file skeleton submissions and authorities for use at the hearings via NIS.



4. Issues Raised by Institute Members

a. Series of trade marks consisting of colour marks with colour claim

Referring to the Court of Final Appeal's judgment in *TWG Tea Co Pte Ltd v Tsit Wing (Hong Kong) Co Ltd and others*, FACV 15 of 2015 ("TWG case"), the Institute considered the position on registration of a series of trade marks comprising (i) a monochrome version and (ii) a coloured version ("M&C marks in series") with a colour claim unclear.

The Institute was concerned that the Registrar's acceptance of registration of a set of M&C marks in series with a colour claim (being a statement filed by the trade mark applicant claiming the colour scheme adopted in the coloured version of the M&C marks in series as element(s) of the marks) might not be in line with the CFA's judgment.

The validity of registration of M&C marks in series and the enforcement of such marks (*i.e.* their scope of protection) were also uncertain.

Having considered and discussed the subject matter at the meeting followed by tele-conferences with the Institute, the IPD noted the following fundamental principles and practice:

Registration of a series of trade marks

- (i) Registration of a series of trade marks would give rise to a series of different trade marks, each of which is registered, albeit under a single registration number, but not as a single registered trade mark nor a new and sui generis kind of trade mark.
- (ii) To qualify as a series of trade marks, the marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question.

Colour claims

- (iii) An application for registration of a colour either as a trade mark or as an element of a trade mark will only be so treated by the Registrar if the application, amongst others, contains a statement claiming the colour as the trade mark, or as an element of the mark, as the case may be (known as "colour claim"). A colour claim is treated to confirm that "a specified colour or colour scheme forms part of the trade mark to which the claim relates; or more restrictively" per case authority.
- (iv) Where a trade mark in an application for registration is represented to contain any colour as the trade mark or as an element of the mark, but does not contain any colour claim, the Registrar would not take into account the colour(s) in assessing distinctiveness of the mark.



Examination of application for registration of M&C marks in series with colour claim

- (v) Based on points (ii) and (iii) above, the Trade Marks Registry (“Registry”), when examining an application for registration of M&C marks in series with a colour claim, would accept the marks for registration in series, provided that the Registry, having regard to the colour claim, considers that the difference between the monochrome version and the coloured version of the marks (notably in terms of their colour variation) is only of a non-distinctive character without substantially affecting the identity of the marks. In this connection, the colour claim is taken into account by the Registry in assessing whether there is any material difference between/amongst the applied-for series marks so as to determine whether the marks qualify for registration as series marks.
- (vi) It follows that the Registry’s acceptance of M&C marks with a colour claim for registration in series does not amount to any determination of the Registry as to whether or not the colour of the marks to which the colour claim relates is distinctive vis-à-vis any trade mark of a third party. Whether the colour of the marks is so distinctive may still be open to argument by parties to proceedings on a case by case basis.

Prudent practice of seeking registration of trade mark in colour

- (vii) If the colour scheme adopted in a trade mark is meant/considered by the mark owner to be an essential/dominating/distinguishing feature/element of the mark, it would be prudent for the mark owner to seriously consider filing a separate application for registration of the mark in colour with an appropriate colour claim.

The Registry is reviewing the relevant chapters of the Trade Marks Registry Work Manual, and may, if required, introduce appropriate revisions so as to make the aforesaid key examination principles and practice sufficiently clear.

b. Scale of costs in opposition proceedings (“Scale”)

The existing Scale was formulated in 2008. The Institute proposed that the Scale should be revised given that the costs of proceedings have increased over the years (as reflected by the Consumer Price Index). The Institute submitted a proposed revised Scale for the IPD’s review.

The IPD confirmed that the purpose of the Scale was to provide some guidance on the amount of costs that the Registrar would normally award in relation to the items specified. However, the Registrar’s discretion to award costs under the Trade Marks Ordinance would not be bound by the Scale. The IPD had kept the matter in view all along.

The Scale would be reviewed from time to time to take into the account the amount of costs actually awarded. The IPD noted the Institute’s proposal and would need time to review the matter especially the circumstances which led to the current Scale and the taxed amount that the Registrar had in practice awarded in recent years.



c. Extensions of time for inter-partes proceedings

The Institute would like the IPD to clarify the guidelines on granting extensions of time ("ET").

The IPD explained that generally speaking, whether an ET would be granted depends on the circumstances of each case. It was also stated in the Trade Marks Work Manual chapter on "*Applications for extension of time*" that the Registrar was bound by case law to consider each application for ET having regard to the circumstances of the particular case. It would not be appropriate for the Registrar to lay down a mechanical practice that x number of terms of ET could be granted, or a warning would be given after y number of terms, without regard to the particular circumstances of a case.

d. Issue of first opinion and further opinion by an examiner

The Institute noted that the first opinion and the further opinion might be issued by the same examiner. If the second round submissions were being reviewed by the same examiner, the applicant would be denied an opportunity of having their applications being re-considered by another examiner who might have different views. The Institute would like IPD to understand better how the further opinion was being handled in the Registry internally, *e.g.* whether and when the second round submissions would be reviewed by another or a senior examiner.

The IPD confirmed that every case would be examined afresh upon receipt of second round submissions from applicants/agents. If objections were to be maintained and where applicable, the way forward of overcoming the objections such as restriction of specification would be proposed in the Registry's replies.

The Registry has put in place a mechanism with different levels of internal review to reconsider the objections. Depending on the complexity of the cases, case examiners would either discuss the matters afresh with their team heads who were senior examiners or seek advice through case discussion sessions regularly held by chief examiners with support from legal officers. The further opinion might be issued by the same case examiner or another examiner depending on the circumstances. In any event, all the cases had been reviewed with fresh inputs before a further response was issued.

e. Notification of down time of IPD electronic services

Some users of the IPD's online search system reported slow performance and display of strange number of hits on 24 August 2020. The problems were referred to the contractor and they were finally resolved in the evening on the same day.

During the affected period, the maintenance notice was automatically posted to the online search website intermittently when the system was not accessible. The IPD is working with the contractor on how to improve the notification mechanism to alert users of any system issues in a more timely manner in the future.



MEMBERSHIP

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

LinkedIn – please note that all Members are free to join our HKITMP group on *LinkedIn*.

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 members of the Institute:

Name	From
Allen CHAN (Affiliate Member)	Deacons
Lilian Xiaoli SHI	Dorsey & Whitney
Tanya PREW (In-House Member)	Shangri-La Hotel Group

QUIZ

Last Issue's Question:

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

A: Daren Tang from Singapore.

This Issue's Question:

Q: What was the first statute in the United Kingdom that provided for trade mark registration?