

Hong Kong Institute of Trade Mark Practitioners
Annual General Meeting
9 November 2022

President's Report 2021/22

I am pleased to deliver my first President's Report. I am grateful to all members of the Council for their unreserved contribution and support to the Institute over the past year. For tonight's AGM and Dinner, special thanks to Nick Horvath and Valerie Suen for preparing the meeting agenda and papers, Cynthia Houg for preparing the Institute's accounts, and Steven Birt for organizing the dinner.

On behalf of the Council, we thank all members for attending this meeting and those who have sent their apologies.

Committees

We have seven committees responsible for various tasks and functions throughout the year. Membership of these committees are:-

1. Trade Marks Committee: Jacqueline Chu, Patsy Lau, Serena Lim, Theresa Mak, Helen Tang, David Wu
2. Patents and Designs Committee: Peggy Cheung, Justin Davidson, Jeffrey McLean
3. Copyright Committee: Steven Birt, Benjamin Choi, Peggy Cheung, Valerie Suen
4. Seminar Committee: Benjamin Choi, Justin Davidson, Jacqueline Chu, Theresa Mak
5. Social Events Committee: Andrea Fong, Nick Horvath, Barry Yen, Peggy Cheung
6. Website Committee: Jeffrey McLean, Katherine Lai
7. Newsletter Committee: Helen Tang, David Wu, Valerie Suen

I would like to thank all Committee members and our Co-Op Affiliate Member for all their time and hard work.

Meetings with the Intellectual Property Department ("IPD")

We had several meetings with the IPD in the year 2021/22:-

1. Joint Meeting between HKITMP, APAA, Law Society IP Committee ("IPLS") and IPD (20 January 2022).
2. Joint Meeting between HKITMP, APAA, IPLS and IPD (17 February 2022).
3. Patent Practice Group Meeting (17 February 2022).
4. Joint Meeting between HKITMP, APAA, IPLS and IPD (12 May 2022).
5. Joint Meeting between HKITMP, APAA, IPLS and IPD (31 August 2022).
6. Trade Mark Practice Group Meeting with IPD (31 August 2022).
7. HKITMP and IPD Annual Meeting (4 November 2022).

Amendments of Trade Marks Rules

IPD is working on amending the Trade Marks Rules to include provisions on the implementation of the Madrid Protocol as well as amending the rules regarding hearing procedures. IPD is working

towards the target of submitting the amendment bills to LegCo for negative vetting during the 2023 legislative year.

Proposal for verification of Hong Kong based "Agents" under the Trade Marks Ordinance

In recent years, it has been discovered that overseas-based businesses and individuals have purported to be and acted as local "Hong Kong agents" through a "company secretarial service provider" or similar with no real physical presence in Hong Kong. It appears that the IPD is not enforcing section 88 (3) of the Trade Marks Ordinance which provides that "The Registrar shall refuse to recognise as an agent a person having neither residence nor a place of business in Hong Kong".

Together with APAA and IPLS, the Institute worked together on a written submission to the Commerce and Economic Development Bureau ("CEDB") and IPD on 14 February 2022 to express practitioners' concerns regarding service providers that handled trade mark matters without a place of business in Hong Kong.

Representatives of the three professional members met with IPD on 12 May 2022 to discuss the matter. Prior to the meeting the three professional bodies compiled a list of 16 agents which appeared not to have a place of business in Hong Kong. At the meeting, IPD claimed that section 88 and Rule 103 are sufficient and do not see a need to amend the existing provisions. They claim that they will take more 'robust' measures such as amending the Work Manual and specify the requirements for physical presence of local agents. IPD claimed that they will also look into the list of e-filers with no real Hong Kong presence that we provided.

At the meeting, IPD mentioned a complaint about an agent with no physical presence in Hong Kong that they received in February 2022. IPD made some inquiries with the agent. Eventually, the agent had to transfer 5000 plus trade marks and designs records to another agent. IPD urged practitioners to inform them if they are aware of any agents that do not have any physical presence in Hong Kong. IPD affirmed that simply having a Business Registration certificate and virtual offices are not acceptable.

On 29 June 2022, the three professional bodies worked together and produced a supplemental submission to CEDB and IPD with further examples of 35 additional questionable agents and requested another meeting with IPD.

Another meeting was held with IPD on 31 August. IPD reported that out of the 51 agents drawn to their attention, IPD was carrying out investigations into 32 cases; and out of the 19 companies that were investigated, no action was taken against 10 agents while 9 agents were considered as not having a principal place of business in Hong Kong. IPD also reported that enhanced measures to strengthen enforcement of section 88 (3) of the TMO were in progress:

- conducting robust investigations and enforcement under s.88(3) of TMO
- conducting proactive enquiries about agents opening e-filing accounts
- to update TM Registry Work Manual to reflect the enhanced practice of TM Registry
- to update the current e-filers list for identifying which ones are legally qualified
- to set up dedicated webpage about agents
- to highlight the statutory requirement on agents via appropriate means (e.g. IPD & WIPO's websites, correspondences on office actions, promotional materials) of preparing the implementation of Madrid Protocol
- to collaborate with IP bodies in:

- promoting HK quality professional services
- organizing possible training courses
- Updating of trade mark forms with inclusions of statutory requirements, declaration and warning:
 - (i) Applicable to e-filers and paper filers alike
 - (ii) Highlighting statutory requirements for agent to provide its residential/business address in Hong Kong
 - (iii) Agent is required to declare that the address so provided is where agent resides or carries on its business activities in Hong Kong, and that such declaration is true and accurate
 - (iv) Inclusion of a specific warning to the effect that making a false declaration is an offence which is liable to criminal prosecution

In addition, IPD is considering the following enhanced measures:

- a. to introduce an express statutory requirement for an agent, when notifying the Registrar of its address under r.103(3)/(4) of TMR, to declare that such address is a place where it resides or carries on his business activities in Hong Kong, and that such declaration is true and accurate.
- b. to highlight the Registrar's power to direct filing of documents, information or evidence as proof of an address provided under r.103(3)/(4) of TMR if he thinks fit.
- c. discussing with DOJ about possible amendments to highlight the key pointer which the Registrar, when considering any document, information or evidence filed by an agent pursuant to the Registrar's direction, may take into account whether the documents indicate that "the agent has a physical residence or place of business in Hong Kong.

Submissions to Consultations

- (i) Submissions to Copyright (Amendment) Bill 2022
- (ii) Submissions to CEDB and IPD on amendment of Trade Marks Rules – see above

Invitations

Collaboration with IPD on IP Training Programme for trade marks agents – in January 2023.

Events and invitations

Members of the Council were invited to and/or participated in a number of other meetings, discussion sessions and events including:-

1. BIP Asia Forum (2-3 December 2021). The Institute was also a supporting organization for the Business of IP Asia Forum.
2. IEEM IP Programme 2022 is organised by the Institute of European Studies of Macau (IEEM) and co-organised by the IPD
3. Online seminar "2022 Guangdong/Hong Kong Seminar on Intellectual Property and Development of Small and Medium Enterprises" to be held on 12 August 2022

This year's BIP Asia Forum will take place on 1 and 2 December 2022 in person and on-line, and the Institute will once again be a supporting organization of the forum.

Webinar

Since last year, the Institute has organized online webinars in place of in-person lunchtime seminars. This year, we had the pleasure of having Mr Kenneth Lee and Mr William Tse to present an online seminar on the topic of "METAVERSE, TRADE MARKS & ANTITRUST".

In October this year, Sebastian Hughes presented a seminar on the topic of "The Exhaustion of Rights Defence – Recent Case Law" that included analysis of similar statutory provisions in Singapore (upon which the Hong Kong provision is based) and the United Kingdom, and relevant case law – including the Singapore Samsonite decision; and the decision of Laddie J in *Zino Davidoff SA v A&G Imports Ltd*.

The Institute have not applied for CPD accreditation for our webinars. Members are however reminded of the Law Society's guidelines in respect of a deemed accreditation system. Specifically, a solicitor or trainee solicitor subject to the CPD Rules Cap. 159W may, out of the annual CPD requirement of 15 CPD points, claim a maximum of 3 CPD points per CPD practice year by attending courses which fulfil the accreditation criteria prescribed under the deemed accreditation system stated in the CPD Information Package.

Members are encouraged to get in touch with the Institute on topics that you would be interested to hear about in future seminars.

Social Event

Following the relaxation of the social distancing rules, the Institute organized a cocktail workshop on 31 August 2022 where members and guests mixed their own cocktails followed by a sumptuous dinner.

Newsletter

Our last newsletter was issued in February 2022 and the next edition is expected at the end of the year. Many thanks to David Wu for his time and effort in producing the newsletter.

Membership

Our membership currently stands at 83 (of which 80 are Ordinary Full Members, 3 are Student Members).

New Members who joined the Institute this year include:

1. Anny Wing Yu WONG (Student member) of Baker & McKenzie
2. Tiffany CONLEY (Ordinary member) of Baker & McKenzie
3. Monique WOO (Ordinary member) of Douglas Clark LLP

Council Meetings

For the year 2021/22, we had 10 Council meetings on the following dates:-

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|---------------------|---------------------|
| 1. 1 December 2021 | 6. 29 June 2022 |
| 2. 12 January 2022 | 7. 20 July 2022 |
| 3. 23 February 2022 | 8. 7 September 2022 |
| 4. 20 April 2022 | 9. 5 October 2022 |
| 5. 25 May 2022 | 10. 19 October 2022 |

Council Members

For the year 2021/22 the following members have served on Council:-

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|---|-------------------------|
| 1. Theresa Mak – President | 10. Justin Davidson |
| 2. Jacqueline Chu – Vice President | 11. Andrea Fong |
| 3. Cynthia Houg – Treasurer | 12. Patsy Lau |
| 4. Valerie Suen – Secretary | 13. Davina Lee |
| 5. Katherine Lai – Membership Secretary | 14. Serena Lim |
| 6. Steven Birt | 15. Helen Tang |
| 7. Nick Bodnar-Horvath | 16. David Wu |
| 8. Peggy Cheung | 17. Barry Yen |
| 9. Benjamin Choi | 18. Jeffrey Ross Mclean |

Jeffrey McLean has been our long standing Co-Op Affiliate Member providing support to the Council on all patent related matters.

Each year, one-half of Council Members excluding the President and Vice President having served longest in office will need to retire. Council Members retiring this year are:-

1. Steven Birt
2. Benjamin Choi
3. Justin Davidson
4. Cynthia Houg
5. Katherine Lai
6. Patsy Lau
7. Barry Yen
8. Serena Lim

I would like to thank all Council Members, Co-Opt Affiliate Member and office bearers for all their contributions and services on Council and each Committee throughout the year. In particular, on behalf of all members, I would like to express our thanks to Cynthia Houg, who has been our Treasurer for more than 8 years. I am sad to inform you all that Cynthia will be stepping down as Treasurer to move to the U.K. next year. We wish her all the best in her new journey. Benjamin Choi, has kindly agreed to take up the role of Treasurer, thank you Ben!

Awards

Each year, the Institute grants award(s) to recognize academic achievements in the Intellectual Property Law subject. The Institute received 2 nominations from Hong Kong University and Chinese University of Hong Kong this year.

The IP Prize winners for our financial year ending 2021/22 were as follows:

- HKU: Mr. Tang, King Sang
- CUHK: Mr. Chan, Foon Lok

This concludes my President's report.

Theresa Mak
President
The Hong Kong Institute of Trade Mark Practitioners
9 November 2022