

Hong Kong Institute of Trade Mark Practitioners
Annual General Meeting
18 October 2023

President's Report 2022/2023

I have the honour of presenting the President's Report on this joyous occasion of the 35th anniversary of the Institute. I would like to express my appreciation to all members of the Council for their valuable input and support to the Institute throughout the year. I also wish to acknowledge the efforts of Nick Horvath, Valerie Suen for organizing the agenda and documents for tonight's AGM and Dinner, Benjamin Choi for preparing the Institute's accounts and Jacqueline Chu for her support.

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

I would like to express my gratitude to the dedication and efforts of all the Committee members and our Co-Op Affiliate Member for their valuable contributions.

Meetings with the Intellectual Property Department ("IPD")

We had several meetings with the IPD in the year 2022/2023:-

- A. Joint Meeting between HKITMP, APAA, Law Society IP Committee ("IPLS") and IPD (23 March 2023)
- B. Patent Practice Group Meeting (27 March 2023)
- C. Briefing on the proposed amendments to the Rules of the High Court concerning IP Proceedings before the Court of First Instance and proposed additional complementary and incidental amendments to TMR, PGR & RDR (16 June 2023)
- D. Trade Mark Practice Group Meeting (31 August 2023)
- E. Briefing session on registered design fees (31 August 2023)

A. Joint Meeting between HKITMP, APAA, Law Society IP Committee (“IPLS”) and IPD

In the Joint Meeting, IPD provided updates on the following issues:

- a) There has been a decrease in the number of filings for trade marks and patents with a slight increase in short term patents.
- b) The IPD will be adjusting the official fees for patents and registered designs with preferential rates for e-filings.
- c) The IPD will be updating the official forms to encourage applicants to provide the place of incorporation.
- d) To cater for the implementation of the Madrid Protocol, IPD will be updating the official forms.
- e) IPD had investigated 59 agents suspected of not having an actual place of business in Hong Kong and 19 agents were refused recognition.

B. Patent Practice Group Meeting (27 March 2023)

IPD invited the Institute together with 5 other organizations namely, APAA-HK, LawSoc-IP, Hong Kong Institute of Patent Attorneys Limited (“HKIPA”), Hong Kong Institute of Patent Practitioners Limited (“HKIPP”) and the Hong Kong Chinese Patent Attorneys Association (HKCPAA”) to this meeting.

I attended the meeting with Valerie Suen and Jeffrery McLean. At the meeting, IPD sought practitioners’ views on adding a “List of Persons in HK with Patent Agent Qualification” on its website. The list will contain persons residing in Hong Kong and qualified to lawfully provide patent agency services in jurisdictions outside Hong Kong.

Practitioners commented that the public may mis-interpret the list as having been endorsed by IPD and urged the IPD to consider setting up a register of qualified persons to regulate patent agents. The HKIPA, the HIPP and the HKCPAA have prepared a discussion paper covering a grandfathering scheme for “registered patent agents” and a new qualifying scheme for “registered patent attorneys”. However, the paper was only made available to attendees of the meeting.

C. Briefing on the proposed amendments to the Rules of the High Court concerning IP Proceedings before the Court of First Instance and proposed additional complementary and incidental amendments to Trade Marks Rules, Patents (General) & Registered Designs Rules (16 June 2023)

The IPD held a briefing on the legislative exercise for introducing three new Orders into the Rules of the High Court (“RHC”) and the amendments to the Trade Marks Rules, Patents (General) Rules and Registered Designs Rules.

IPD provided drafts of the above-mentioned proposed amendments, on a “restricted” basis, to the Institute and other professional bodies to solicit the professional bodies’ views. Valerie Suen, Benjamin Choi, Helen Tang, Loretta Lau, Jacqueline Chu and I worked together and put forward comments on the proposed amendments on behalf of the Institute.

Submissions to IPD

- (i) Submissions on the TM(IR)R and Trade Marks (Amendment) Rules
- (ii) Comments on the proposed amendments to the Rules of the High Court concerning IP Proceedings before the Court of First Instance and proposed additional complementary and incidental amendments to Trade Marks Rules, Patents (General) & Registered Designs Rules
- (iii) Letter to IPD requesting IPD to amend official forms to require place of incorporation
- (iv) Letter to IPD regarding two agents which do not appear to have a real place of business in Hong Kong

Events and invitations

Members of the Council were invited to and/or participated in the following meetings and events:

1. BIP Asia Forum (1-2 December 2022). The Institute was also a supporting organization for the Business of IP Asia Forum.
2. World IP Day Reception hosted by IPD (25 April 2023)
3. CITMA Reception in Singapore
4. Mainland and Hong Kong SAR, Macao SAR Intellectual Property Symposium 2023 – June 2023
5. CITMA Reception in Singapore
6. 2023 Policy Address Consultation Session – Enhancing competitiveness (Regional Intellectual Property Trading Centre) (15 August 2023)
7. IPD's IP Training Program

This year's BIP Asia Forum will take place on 7-8 December 2023 and the Institute will once again be a supporting organization of the forum.

Seminars

We will host a lunch seminar at Deacons on 31 October 2023. We have invited Ms. Stephanie Wong, barrister at Des Voeux Chambers, to be the speaker. Stephanie will talk about various topics of current interest including on e-commerce platforms and joint liability issues, the jurisdictional issues arising out of online sales of infringing materials available to buyers in Hong Kong but which are hosted by platforms owned by entities overseas (e.g. China or elsewhere), and the Mary Kay/Taobao and Tmall case.

The Institute has 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.

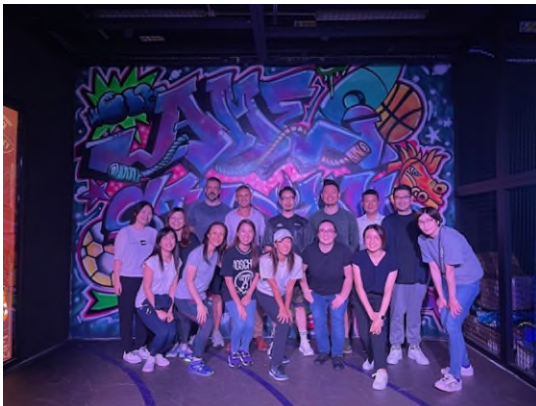
Members are encouraged to get in touch with the Institute on topics that you would be interested in future seminars.

Social Events

Spring Dinner on 29 March 2023 at Forum – Every spring, the Institute will gather for a spring dinner to celebrate the Chinese New Year. This year we had a sumptuous dinner at Forum Restaurant where we got a chance to meet with many guests and members after the uplifting of the social restrictions since the pandemic.



Summer event - Despite the scorching heat of the summer, we had an exciting and competitive e-sports evening at AME Stadium where everyone had a go at indoor rock climbing, horse racing, kayaking, basketball, football and cycling.



Newsletter

Our latest newsletter was issued in April 2023 and the next edition will be issued 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 77 (of which 70 are Ordinary Full Members, 4 Affiliate Members, 3 Student Members).

Names of new members since the last AGM include:

- (a) Janice Yip of ELLALAN joined as of March 2023
- (b) Mina Li of ROUSE joined as of July 2023
- (c) Winnie Ho of ELLALAN joined as of September 2023

Council Meetings

For the year 2022/2023, we had 7 Council meetings on the following dates:-

1. 1 December 2022
2. 22 February 2023
3. 29 March 2023
4. 7 June 2023
5. 12 July 2023
6. 16 August 2023
7. 13 September 2023

Council Members

For the year 2022/2023, 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. Benjamin Choi – 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. Loretta Lau | 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. Many thanks to Jeff for his support.

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

1. Andrea Fong
2. Nick Bodnar-Horvath
3. Davina Lee
4. David Wu
5. Helen Tang
6. Peggy Cheung
7. Valerie Suen
8. Serena Lim

I would like to thank all Council Members, Co-Op Affiliate Member and office bearers for all their contributions and services on Council and each Committee throughout the year.

Ms. Davinia Lee will be stepping down from Council. We would like to express our gratitude to Davinia for her participation and contribution as ex-President and Council member all these years, thank you Davinia! It has been a great pleasure having you.

The Scrutineer have received the following nominations:

1. Andrea Fong
2. Nick Bodnar-Horvath
3. Helen Tang
4. Peggy Cheung
5. Valerie Suen
6. Janette Sham
7. Serena Lim
8. David Wu

Awards

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

The IP Prize winners for our financial year ending 2022/2023 were as follows:

- HKU: Mr. Gu Shaoyu
- CUHK: Mr. Kevin Tsai

This concludes my last President's Report.

Theresa Mak
President
The Hong Kong Institute of Trade Mark Practitioners
18 October 2023