

Legislative Council Panel on Commerce and Industry

Amendments to Trade Marks Ordinance

Purpose

This paper seeks Members' views on our proposal to introduce technical amendments to clarify two provisions in the Trade Marks Ordinance (Cap. 559) (the TMO).

The Proposed Amendments

Claim to priority

2. The Convention for the Protection of Industrial Property (the Paris Convention), which is fundamental to international protection of intellectual property including patents, trademarks and industrial designs, has been extended to the Hong Kong Special Administrative Region by the Central People's Government. Article 4C (read with Article 4A) of the Paris Convention stipulates that any person who has duly filed an application for the registration of a trade mark in a Paris Convention country shall have a right of priority for a period of 6 months for the purpose of filing applications in other Paris Convention countries. This means that if a person applies for registration of a trade mark in a Paris Convention country and within the next six months applies for registration of the same mark in Hong Kong, he can claim the date on which he filed the application in the Paris Convention country as the priority date of his Hong Kong application. The priority system aims at resolving conflicting claims between two or more applications filed for the same or similar mark in the same Convention territory.

3. Section 41(1) of the TMO is intended to give effect to the requirement under Article 4C of the Paris Convention. It provides that "A person who has duly filed an application for the registration of a trade mark in a Paris Convention country..... shall enjoy..... a right of priority for a period of 6 months beginning on the date of filing of the first of any such applications.....". It is unclear from the present wording of the section if the day of filing should be included in the calculation of the 6-month period. However, Article 4C(2) of the Paris Convention expressly provides that the day of filing shall not be included in counting the 6-month period.

4. To clarify the intent of the provision, we propose to amend section 41(1) of the TMO to put it beyond doubt that the day of filing should not be included in calculating the 6-month period.

Alteration of registered trade mark

5. Section 55(2) of the TMO provides that “The Registrar may, at the request of any owner of a registered trade mark which contains or consists of the owner’s name or address, allow the alteration of that name or address but only to the extent that the alteration does not substantially affect the identity of the trade mark.” Section 2(1) of the TMO provides that “..... “owner”, in relation to a registered trade mark, means “the person whose name is for the time being entered in the register as the owner of the trade mark”.....”.

6. According to the current wording, a subsequent owner of a trade mark (e.g. the person who obtains a trade mark ownership through an assignment) who has registered his name as the new owner of the mark, may not be eligible to apply for an alteration of the previous owner’s name or address in the trade mark, because the name or address in the mark is not the name or address of the new owner as entered in the register. This is not the original intention of section 55(2). We therefore propose amendments to this section to make it clear that alterations by subsequent owners are permitted.

The Statute Law (Miscellaneous Provisions) Bill

7. The above proposed amendments will be included in a Statute Law (Miscellaneous Provisions) Bill which is an omnibus bill to be put forward by the Secretary for Justice for introducing simple and non-controversial amendments to any ordinance of Hong Kong. Details of the proposed amendments are at Annex. The omnibus bill will be submitted to the Legislative Council within this legislative session.

Annex

Consultation

8. We have consulted the relevant legal and intellectual property associations on the proposed amendments to the TMO. Intellectual property practitioners of the Law Society have welcomed the proposed

amendments.

Advice sought

9. Members are invited to give their views on the proposed amendments.

**Commerce & Industry Branch
Commerce, Industry and Technology Bureau
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Proposed Amendments to Trade Marks Ordinance

- (a) To amend section 41(1) of the Trade Marks Ordinance (Cap. 559) by repealing “beginning on” and substituting “after”.

Existing text of section 41(1) of the Trade Marks Ordinance

41. Claim to priority

(1) A person who has duly filed an application for the registration of a trade mark in, or in respect of, a Paris Convention country or WTO member, or his successor in title, shall enjoy, for the purpose of registering the same trade mark under this Ordinance in respect of any or all of the same goods or services, a right of priority for a period of 6 months beginning on the date of filing of the first of any such applications, subject to compliance with any prescribed conditions.

- (b) To amend section 55(2) of the Trade Marks Ordinance (Cap. 559) by repealing “owner’s name or address” and substituting “name or address of the owner or any previous owner”.

Existing text of section 55(2) of the Trade Marks Ordinance

55. Alteration of registered trade mark

(2) The Registrar may, at the request of any owner of a registered trade mark which contains or consists of the owner’s name or address, allow the alteration of that name or address but only to the extent that the alteration does not substantially affect the identity of the trade mark.