

**For information
on 17 April 2007**

Legislative Council Panel on Commerce and Industry

**Issues relating to online data leakage by
the Intellectual Property Department**

Purpose

This paper sets out the current system through which information relating to oppositions to applications for trade mark registration is uploaded onto the Internet. It also briefs Members on the measures that are being taken to prevent publication of unsolicited personal data and sensitive business information onto the Internet.

Background

2. In a report on 1 April, the Sunday Morning Post reported that some personal data, including a photocopy of a passport, as well as what might be 'sensitive business information' was uploaded through the Intellectual Property Department (IPD)'s system to the Internet where the public can read it.

3. Members of the public or their legal representatives/agents supply information to the Registrar of Trade Marks in the context of complying with statutory procedures under the Trade Marks Ordinance (Cap. 559) ("TMO"). The Director of Intellectual Property runs Hong Kong's Trade Marks Register. The Register is entirely in digital form, operating on the Internet. All information on the Register can be viewed online via the Internet.

4. Two particular processes under the TMO are relevant. The first is the filing of opposition to an application for registration of a trade mark (pursuant to s.44 of the TMO). The second is the filing of a counter-statement (i.e. the original applicant's first response to the opponent). These procedures are done using statutory forms 'T6' and 'T7' respectively (copies attached at Annexes A and B).

5. The intention behind the filing of opposition is that an opponent should give notification of his opposition and state his grounds. The statement of grounds is intended to be set out in simple terms which, at the very minimum, could consist of: ‘the mark applied for is confusingly similar to my registered trade mark, number 1234567’. In practice, the Registry encourages maximum transparency in pleadings, so that all parties concerned can clearly assess their position as soon as possible.

6. The Trade Marks Registry does **not** require the submission of ID card or other national identification document details. The personal data normally required consists of names and correspondence addresses.

7. The forms prescribed by the Registrar in relation to the various functions carry the following statement:

“Use of personal data

Personal data provided in this form will be used by the Intellectual Property Department and can be disclosed for purposes relating to the administration of the Trade Marks Ordinance and its subsidiary legislation. Registration will protect your intellectual property rights and information in this form is used to process your application. You can obtain information regarding access to and alteration of your personal data in accordance with the Trade Marks Ordinance and its subsidiary legislation by contacting the Registrar of Trade Marks.”

8. The notice of opposition (form T6) and the counter-statement (form T7) are documents that can be viewed by the public under Rule 69 of the Trade Mark Rules (Cap. 559A)¹. IPD’s approach had been that, in the general context of running a transparent Internet-based online search system, such a requirement should be fulfilled by allowing the public to request to see the information in a traditional Internet manner i.e. clicking on a link.

Note ¹ Rule 69(2) of the Trade Marks Rules states:
“(2) The Registrar shall, on the request of any person, permit that person to inspect any document to which this rule applies and in respect of which no particulars have been recorded in the register...”

9. In practice, when a member of the public searches for a trade mark, the display relating to a mark which has been opposed will include an option to click on a link to 'View document available for inspection'. A click on the link takes the person to scanned copies of the documents themselves. The information is published in the form of graphic files. It cannot be indexed or searched using a search engine.

10. The trade marks opposition process is recognized in law as a quasi-judicial process. The grounds submitted under form T6 and the counter-statement under form T7 as well as all documents submitted together with these forms form part of the pleadings and may be called up by the High Court should cases go to appeal. All these documents are now available for inspection.

Immediate actions taken

11. IPD blocked the access to all documents available for inspection including opposition and counter-statement documents on Sunday morning 1 April 2007.

12. The Director of Intellectual Property (DIP) issued the following statement via the media the same day:

"I am deeply concerned about the situation, and I apologize that we had not done more to avoid unsolicited personal or business information submitted by the public being published on the Internet without their full knowledge.

I have blocked Internet access to such information and we are urgently assessing the extent of the problem.

In addition to the data protection notice currently provided in the specified forms, we are urgently considering what can be done to ensure that the public would better understand that the information they provide may be published on the Internet. We shall also consider how to strengthen our internal procedures to avoid unsolicited personal or business information submitted by the public being published on the Internet without their full knowledge.

We shall be contacting the Privacy Commissioner to obtain advice on how best to balance the need to protect personal data with the legal obligation to make the relevant information available to the public in trademark proceedings.”

The extent of the problem

13. Following a study of 11,592 documents filed under the Trade Marks Ordinance and its subsidiary legislation that can be viewed by the public under Rule 69, we found that 45 documents included HKID card / passport numbers affecting 49 individuals, and 18 documents included foreign ID card / passport numbers affecting 29 individuals. Business information was also supplied as documentary evidence. In addition, 178 cases were found of mobile phone numbers or email addresses, one cheque and one complaint to the Hong Kong Police Force.

14. While the information contained in personal identity documents is clearly personal data, it is difficult for the Department to categorize certain business data as sensitive as it varies from case to case, and ultimately it is up to the data provider to decide. Following our first round of assessment, we found 173 cases of sales figures and invoices and 125 cases of other business information. These figures exclude business information which is available publicly through the Companies Register or registers open to the public overseas.

The Department's assessment

15. IPD has in the past been too focused on ensuring that the Department does not actively require the public to submit personal data, and not paid enough attention to unsolicited personal data.

16. The “Use of Personal Data” notices placed on the relevant forms (please see paragraph 7 above) were prominent; but they were too general. They did not make it clear that the information supplied would be visible on the Internet. There was no notice specifically referring to making any business data available on the Internet.

Added measures to protect personal data and sensitive business data

17. To forestall inadvertent publication of unsolicited personal data on the Internet in future, we propose to take the following measures:

- (i) we shall not publish on the Internet any personal data enumerated under Rule 69 of the Trade Marks Rules without the prescribed consent of the data subject concerned;
- (ii) we shall include a privacy policy statement in IPD's webpage setting out the specified purposes of the information published by us in the website and the limitation on subsequent usage of such information;
- (iii) we shall formulate a comprehensive guideline for our staff on the collection, holding, processing and use of personal data for the administration of the Trade Marks Ordinance and its subsidiary legislation and provide the Privacy Commissioner with a copy of such guideline; and
- (iv) we shall identify all individuals whose personal data have been published on the Internet pursuant to Rule 69 of the Trade Marks Rules and take all practical steps to inform such individuals in writing of the following:
 - the kinds of personal data that have been published on the Internet;
 - the kinds of action that have been taken to remedy the situation (e.g. removal of the personal data from the website);
 - the affected individuals' rights to give consent to the disclosure of their personal data;
 - the affected individuals' rights to refuse to give consent and to seek civil remedy from the Government; and
 - the name and address of the person to be contacted in the department, if required.

In formulating the above added measures, we have taken into account the advice of the Privacy Commissioner.

Screening

18. We shall screen all in-coming information, whether or not it is solicited. Any identity card or passport numbers found will be partially blocked out.

Business data

19. We shall amend our forms and messages on the Internet to require that those submitting information sign a declaration that they understand that the information will be made available on the Internet for inspection by any person. We shall make it clear that some information can be supplied at a later stage as evidence, which will not be uploaded to the Internet, but will still be available to the other party in opposition proceedings.

20. We intend to implement the measures before the end of May 2007.

Other operations run by IPD

21. We have already instituted a system to review our data protection procedures on a six-monthly basis, including issuing reminders to staff and holding a review meeting. We are arranging for third-party digital security evaluation of all the operations run by IPD, and we shall include personal data security in the assessments.

22. The measures set out in paragraphs 17 to 19 will also be implemented for the other registry operations run by the Director of Intellectual Property.

Presentation

23. Members are invited to note the content of this paper.

Note 2 Notice of opposition must be filed within the 3-month period beginning on the date of publication in the Hong Kong Intellectual Property Journal.

Note 3 Any person claiming to be affected by a proposed amendment to an application for registration of a trade mark (rule 26(2) of the Trade Marks Rules) or a proposed alteration of a registered trade mark (rule 55(1) of the Trade Marks Rules) may, within 3 months after the date of publication in the Hong Kong Intellectual Property Journal, file a notice of objection. Under rule 95(1) of the Trade Marks Rules, the time limit as stated is not extendible. The Trade Marks Rules can be viewed at www.ipd.gov.hk/.

Note 4 See rules 48 and 49 of the Trade Marks Rules.

Note 5 See rules 48 and 50 of the Trade Marks Rules.

02 This notice/application relates to *(Please mark one box only)*

(a) Opposition (**Note 2**)

(b) Objection. (**Note 3**) Please specify the relevant rule no.

(c) Revocation on grounds of non-use. Please specify the date from which you wish the revocation to take effect:
(DD-MM-YYYY)

(d) Revocation on grounds other than non-use. Please specify the date from which you wish the revocation to take effect:
(DD-MM-YYYY)

(e) Declaration of Invalidity

(f) Variation By owner (**Note 4**) By person other than the owner (**Note 5**)

(g) Rectification By owner (**Note 4**) By person other than the owner (**Note 5**)

(h) Intervention in proceedings. Please identify the proceedings:

Note 6 If the name of the opponent/objector/applicant is not in Roman letters or in Chinese, a transliteration of the name in Roman letters must be provided.

03 Name of **opponent** **objector**
applicant for **revocation** **invalidation** **variation** **rectification**
 applicant for intervention (Note 6)

Address

04 Statement of grounds of **opposition** **objection** **revocation** **invalidation** **variation**
 rectification
 Statement of nature of interest by applicant for intervention

Note : If this application relates to revocation on grounds of non-use under rule 36 of the Trade Marks Rules or variation or rectification under rule 48 of the Trade Marks Rules, it must be accompanied by evidence. The Trade Marks Rules can be viewed at www.ipd.gov.hk/.

Note 7 The opponent/objector/applicant shall, at the same time as he files the notice/application, serve a copy of it to the applicant for registration/owner of registered mark at its address for service.

05 Copy of this **notice of opposition** **notice of objection** **application**

served on the party named in Part 01 at its address for service (Note 7) on

(DD-MM-YYYY)

Note 8 The fee for filing notice / application is HK\$800. Payment can be made in person by cash, or by sending a cheque made payable to THE GOVERNMENT OF THE HONG KONG SPECIAL ADMINISTRATIVE REGION.

06 Payment of fee for filing this notice/application (Note 8)

Amount of fee payable HK\$ 800

Note 9 An address for service in Hong Kong, China must be supplied.

Note 10 If you are a newly appointed agent, an address in Hong Kong, China where you reside or carries on your business activities must be supplied.

07 Signature

Signature

Name and Official
Capacity of SignatoryDate
(DD-MM-YYYY)**08 Address for service in Hong Kong, China (Note 9)****Name****Address****Your reference****Telephone no.****Facsimile no.****E-mail address****09 Agent's address (Note 10)****10 State the number of additional sheet(s) attached to this form**



Trade Mark Form T7

Counter-statement

Trade Marks Ordinance (Cap. 559)

Trade Marks Rules (Cap. 559A)

General notes

- a. This form
- is used to defend an application or registration against a third party who has filed an opposition (rule 16 of the Trade Marks Rules) or an application to revoke (rules 36 and 40 of the Trade Marks Rules), invalidate (rule 46 of the Trade Marks Rules), vary or rectify (rule 50 of the Trade Marks Rules) a trade mark registration. The Trade Marks Rules can be viewed at www.info.gov.hk/ipd.
 - must be signed and dated.
- b. Please complete this form in English unless otherwise stated.
- c. If there is not enough space for any part on this form, please continue on an additional sheet. Number each additional sheet and state the number of additional sheets.
- d. Please enquire through the following means:
- E-mail: enquiry@ipd.gov.hk
 - Internet homepage address: www.info.gov.hk/ipd

Submission of application/request

In person or by mail with the appropriate fee to the Registrar of Trade Marks, 24/F, Wu Chung House, No. 213 Queen's Road East, Wanchai, Hong Kong, China.

Use of personal data

Personal data provided in this form will be used by the Intellectual Property Department and can be disclosed for purposes relating to the administration of the Trade Marks Ordinance and its subsidiary legislation. Registration will protect your intellectual property rights and information in this form is used to process your application. You can obtain information regarding access to and alteration of your personal data in accordance with the Trade Marks Ordinance and its subsidiary legislation by contacting the Registrar of Trade Marks.

Note 1 Separate forms have to be filed if the counter-statement relates to more than one trade mark application or registration.

01 Application no. Registration no. (Note 1)

02 Name of applicant for registration owner of registered mark intervenor filing this form

03 Name of opponent
 applicant for revocation invalidation variation rectification

Note 2 This form must be accompanied by details of the grounds for counter-statement to be set out on additional sheet(s) of paper. It must be filed within three months after the date of receipt of the notice of opposition or of the application for revocation on grounds other than non-use or declaration of invalidity, or within six months after the date of receipt of the application for revocation on grounds of non-use, variation or rectification.

04 Please provide the following information on additional sheet(s): *(Note 2)*

- (a) The grounds on which you rely in support of your application / registration;
- (b) The facts alleged in the notice of opposition / application for revocation / declaration of invalidity / variation / rectification that you
- i) admit,
 - ii) deny, with reasons, (and if you intend to put forward an alternative version of events, that version) and
 - iii) are unable to admit or deny.

Note 3 For application for revocation on grounds of non-use, under rule 37(2) of the Trade Marks Rules, the counter-statement must be accompanied by **either** evidence of the use made of the trade mark **or** a statement giving reasons for non-use. The Trade Marks Rules can be viewed at www.info.gov.hk/ipd.

Note 4 For application for variation or rectification, under rule 50(4) of the Trade Marks Rules, the counter statement must be accompanied by **either** evidence in support of the counter-statement **or** a statement of no intention to file evidence.

05 For counter-statement filed under rule 37(2) of the Trade Marks Rules, the item marked below is attached:
(Note 3)

evidence of the use made of the trade mark; or

statement giving reasons for non-use

For counter-statement filed under rule 50(4) of the Trade Marks Rules, the item ticked below is attached: *(Note 4)*

evidence in support; or

statement of no intention to file evidence

Note 5 The applicant for registration/owner of registered mark/intervenor shall, at the same time as he files the counter-statement, serve a copy of it (with copy of evidence/statement, if applicable) to the address of service of the opponent/applicant for revocation, invalidation, variation or rectification address for service.

06 Copy of this counter-statement (and evidence or statement, if applicable) served on the address of service of the party named in Part 03. (Note 5)

on
(DD-MM-YYYY)

Note 6 An address for service in Hong Kong, China must be supplied. If you are a newly appointed agent, you have to notify the Registrar of Trade Marks of the address in Hong Kong, China where you reside or carry on your business activities by filing Form T5 or by notice in writing.

07 Signature

Signature	Name and Official Capacity of Signatory	Date (DD-MM-YYYY)

08 Address for service in Hong Kong, China (Note 6)

Name

Address

Your reference

Telephone no.

Facsimile no.

E-mail address

09 State the number of additional sheet(s) attached to this form