

Legislative Council Panel on Commerce and Industry

**Proposed Amendments to the Schedules to the
Patents Ordinance (Cap. 514),
Registered Designs Ordinance (Cap. 522),
Trade Marks Ordinance (Cap. 559) and
Layout-design (Topography) of Integrated Circuits (Designation
of Qualifying Countries, Territories or Areas) Regulation (Cap. 445B)**

Introduction

This paper informs Members of certain proposed technical amendments to the Schedules to the Patents Ordinance (“PO”), the Registered Designs Ordinance (“RDO”), the Trade Marks Ordinance (“TMO”) and the Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation. The proposed amendments seek to update the Schedules setting out the membership of the Paris Convention for the Protection of Industrial Property (“Paris Convention”) and the World Trade Organization (“WTO”).

Background

2. China is a party to the Paris Convention. The Central People's Government (“CPG”) applied the Convention to the Hong Kong Special Administrative Region (“HKSAR”) with effect from 1 July 1997. Under Article 4 of the Paris Convention, the HKSAR is obliged to grant to a person who has filed an application for registration of a patent, industrial design or trade mark in a Paris Convention country a right of priority during a prescribed period for the purpose of filing the same application in the HKSAR. Separately, the HKSAR is a WTO member in its own right. Under Article 2.1 in Part I of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), the HKSAR is obliged to do the same in respect of an application filed in a WTO member country, territory or area.

3. We have met the above international obligations by making specific provisions in the PO, the RDO and the TMO to the effect that a person who has filed an application in a Paris Convention country or WTO member country, territory or area will enjoy a right of priority. We have also set out in a Schedule to each of the afore-mentioned Ordinances the list of Paris Convention countries and WTO member countries, territories or areas. The Chief Executive (“CE”) in Council is empowered to amend the relevant Schedule to the PO by an Order published in the Gazette. In the case of the RDO and the TMO, the CE in Council may amend the relevant Schedules by Regulation.

4. Separately, Article 35 in Part II of the TRIPS Agreement requires HKSAR to grant the same level of intellectual property protection for layout-design (topography) of integrated circuits to citizens of other WTO member countries, territories or areas, as to HKSAR citizens. To meet this requirement, we have provided in the Layout-design (Topography) of Integrated Circuits Ordinance that such protection will be given to citizens of such qualifying countries, territories or areas as are designated by Regulation by the CE. The Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation, with a Schedule setting out those countries, territories or areas that have acceded to the WTO Agreement, has been made for this purpose.

Proposed Amendments to the Schedules

5. The above Schedules were last amended in February 2006. Since then, three more countries (i.e. the Republic of Angola; the Kingdom of Thailand; and the Republic of Yemen) have become members of the Paris Convention and five more countries (i.e. the Republic of Cape Verde; the Kingdom of Saudi Arabia; the Kingdom of Tonga; Ukraine; and the Socialist Republic of Viet Nam) have acceded to the WTO Agreement. Separately, one existing Paris Convention country (namely, Serbia and Montenegro) has become two countries (i.e. the Republic of Serbia; and Montenegro). To reflect these changes, we need to update the Schedules to the Ordinances/Regulation. We will also take the opportunity to revise the English name and/or Chinese translation of some countries in the various Schedules to reflect their latest names as appeared in the relevant member lists. Details of the proposed amendments are at Annex.

Legislative Timetable

6. We are now drafting the necessary amendment Order and Regulations and intend to table these pieces of subsidiary legislation at the Legislative Council for negative vetting by the end of this year.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
October 2009

Proposed Amendments

Patents Ordinance (Cap. 514)

I(a) For the list of “Paris Convention countries” in Schedule 1 -

- (i) To add :
- “The Republic of Angola” (安哥拉共和國)
 - “The Kingdom of Thailand” (泰國(泰國))
 - “The Republic of Yemen” (也門共和國)
- (ii) To replace :
- “Serbia and Montenegro” (塞爾維亞和黑山) by “The Republic of Serbia” (塞爾維亞共和國) and “Montenegro” (黑山)
- (iii) To replace :
- “The State of Bahrain” (巴林國) by “The Kingdom of Bahrain” (巴林王國)
 - “利比里亞” by “利比里亞共和國”
 - “The Republic of Malta” by “Malta”
 - “The Kingdom of Nepal” (尼泊爾王國) by “The Federal Democratic Republic of Nepal” (尼泊爾聯邦民主共和國)
 - “Spain” (西班牙) by “The Kingdom of Spain” (西班牙王國)
 - “The Republic of Syprus (Cyprus)” (塞浦路斯共和國(塞浦路斯)) by “The Republic of Cyprus” (塞浦路斯共和國)
 - “The Bolivar Republic of Venezuela” by “The Bolivarian Republic of Venezuela”

I(b) For the list of “WTO member countries, territories and areas (not including Paris Convention countries)” in Schedule 1 -

- (i) To delete :
- “The Republic of Angola” (安哥拉共和國)
 - “Royal Thai (Thailand)” (泰國(泰國))
- (ii) To add :
- “The Republic of Cape Verde” (佛得角共和國)

Registered Designs Ordinance (Cap. 522)

II(a) The amendments in paragraph I(a) above for the Patents Ordinance apply to the list of “Countries which have acceded to the Paris Convention” in the Schedule.

II(b) The amendments in paragraph I(b) above for the Patents Ordinance apply to the list of “Countries, territories and areas which have acceded to the World Trade Organization Agreement (not including countries which have acceded to the Paris Convention)” in the Schedule.

Trade Marks Ordinance (Cap. 559)

III(a) The amendments in paragraph I(a) above for the Patents Ordinance apply to the list of “Countries which have acceded to the Paris Convention” in Schedule 1.

III(b) For the list of “Countries, territories and areas which have acceded to the World Trade Organization Agreement” in Schedule 1 -

(i) To add :

- “The Republic of Cape Verde” (佛得角共和國)
- “The Kingdom of Saudi Arabia” (沙特阿拉伯王國)
- “The Kingdom of Tonga” (湯加王國)
- “Ukraine” (烏克蘭)
- “The Socialist Republic of Viet Nam” (越南社會主義共和國)

(ii) To replace :

- “The State of Bahrain” (巴林國) by “The Kingdom of Bahrain”(巴林王國)
- “The Republic of Malta” by “Malta”
- “The Kingdom of Nepal” (尼泊爾王國) by “The Federal Democratic Republic of Nepal” (尼泊爾聯邦民主共和國)
- “Spain” (西班牙) by “The Kingdom of Spain” (西班牙王國)
- “The Republic of Syprus (Cyprus)” (塞浦路斯共和國(塞浦路斯)) by “The Republic of Cyprus” (塞浦路斯共和國)
- “Royal Thai (Thailand)” by “The Kingdom of Thailand”
- “The Bolivar Republic of Venezuela” by “The Bolivarian Republic of Venezuela”

Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation (Cap. 445B)

The amendments in paragraph III(b) above for the Trade Marks Ordinance apply to the list of “Qualifying countries, territories or areas” in the Schedule.