

For Information

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 respective 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 (“Integrated Circuits Regulation”). The proposed amendments seek to update these schedules setting out the list of contracting parties to the Paris Convention for the Protection of Industrial Property (“Paris Convention”) and the membership list of the World Trade Organization (“WTO”).

Background

2. China is a party to the Paris Convention. The Central People's Government (“CPG”) applied the Paris Convention to the Hong Kong Special Administrative Region (“HKSAR”) with effect from 1 July 1997. Besides, the HKSAR (in the name of Hong Kong, China) is a member of the WTO in its own right.

3. Under Article 4 of the Paris Convention, the HKSAR is obliged to grant to a person who has filed an application for a patent or for registration of a 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, Article 2.1 in Part I of the Agreement on Trade-Related Aspects of Intellectual Property Rights

(“TRIPS Agreement”) under the WTO regime obliges the HKSAR to do the same in respect of an application filed in a WTO member country, territory or area.

4. 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 lists of Paris Convention countries and WTO member countries, territories or areas. The Chief Executive 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 Chief Executive in Council may amend the relevant schedules by regulation.

5. Separately, Article 35 in Part II of the TRIPS Agreement requires the HKSAR to grant the same level of intellectual property protection for layout-designs (topographies) 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 the said protection will be given to citizens of such qualifying countries, territories or areas as are designated by regulation by the Chief Executive. The Integrated Circuits Regulation, with a schedule setting out those countries, territories or areas that have acceded to the WTO, has been made for this purpose.

Proposed Amendments to the Schedules

6. The above four schedules are amended from time to time to reflect the updated list of contracting parties to the Paris Convention and membership position of the WTO. Since the previous updating exercise in February 2010, one more country (i.e. Brunei Darussalam) has become a contracting party to the Paris Convention and five more countries (i.e. the Lao People’s Democratic Republic; Montenegro; the Russian Federation; the Independent State of Samoa; and the Republic of Vanuatu) have acceded to the WTO. To reflect these changes, we need to amend the respective schedules to the PO, the RDO, the TMO and the Integrated Circuits Regulation.

7. Moreover, amendments are needed to update the English name and/or Chinese translation of some countries, territories or areas to align with their latest official names. We will also take the opportunity to add “European Union” to the WTO membership list in the Schedule to the Integrated Circuits Regulation (paragraph 5 above) as it is a member of the WTO in its own right.¹ Details of the proposed amendments are at Annex.

Legislative Timetable

8. We are now drafting the necessary amendment Order and Regulations and plan to table these pieces of subsidiary legislation at the Legislative Council for negative vetting by mid 2013.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
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¹ The European Union (in the name of the European Community) and all its member countries being WTO members have been included in the schedules to the PO, the RDO and the TMO. For the Integrated Circuits Regulation, all European Union member countries being WTO members have also been designated in its Schedule. Inclusion of the “European Union” to the Schedule to the Integrated Circuits Regulation will ensure consistency with the PO, the RDO and the TMO.

Proposed Amendments

I. Patents Ordinance (Cap. 514)

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

(i) To add :

- “Brunei Darussalam” (文萊達魯薩蘭國)

(ii) To replace :

- “The Great Socialist People’s Libyan Arab Jamahiriya” (大阿拉伯利比亞人民社會主義民眾國) by “Libya” (利比亞)

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

(i) To delete :

- “Negara Brunei Darussalam”² (文萊達魯薩蘭國)

(ii) To add :

- “The Independent State of Samoa” (薩摩亞獨立國)
- “The Republic of Vanuatu” (瓦努阿圖共和國)

(iii) To replace :

- “European Community” (歐洲共同體) by “European Union” (歐洲聯盟)
- “The Republic of The Fiji Islands” (斐濟群島共和國) by “The Republic of Fiji” (斐濟共和國)
- “The Union of Myanmar” (緬甸聯邦) by “The Republic of the Union of Myanmar” (緬甸聯邦共和國)

² As Negara Brunei Darussalam (the name of which is to be amended to Brunei Darussalam being an existing WTO member) has become a contracting party to the Paris Convention, it is necessary to move its name from the list of “WTO member countries, territories and areas (not including Paris Convention countries)” to the list of “Paris Convention countries”.

II. Registered Designs Ordinance (Cap. 522)

II(a) The proposed 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 proposed 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.

III. Trade Marks Ordinance (Cap. 559)

III(a) The proposed 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 Lao People’s Democratic Republic” (老撾人民民主共和國)
- “Montenegro” (黑山)
- “The Russian Federation” (俄羅斯聯邦)
- “The Independent State of Samoa” (薩摩亞獨立國)
- “The Republic of Vanuatu” (瓦努阿圖共和國)

(ii) To replace :

- “Negara Brunei Darussalam” by “Brunei Darussalam”
- “European Community” (歐洲共同體) by “European Union” (歐洲聯盟)
- “The Republic of The Fiji Islands” (斐濟群島共和國) by “The Republic of Fiji” (斐濟共和國)
- “The Union of Myanmar” (緬甸聯邦) by “The Republic of the Union of Myanmar” (緬甸聯邦共和國)

- “Netherlands – For the Kingdom in Europe and for the Netherlands Antilles” (荷蘭—在歐洲的王國及荷屬安的列斯群島) by “The Kingdom of the Netherlands”³ (荷蘭王國)

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

For the list of “Qualifying countries, territories or areas” in the Schedule –

- (i) To add :
- “European Union”(歐洲聯盟)
 - “The Lao People’s Democratic Republic” (老撾人民民主共和國)
 - “Montenegro” (黑山)
 - “The Russian Federation” (俄羅斯聯邦)
 - “The Independent State of Samoa” (薩摩亞獨立國)
 - “The Republic of Vanuatu” (瓦努阿圖共和國)
- (ii) To replace :
- “Negara Brunei Darussalam” by “Brunei Darussalam”
 - “The Republic of The Fiji Islands” (斐濟群島共和國) by “The Republic of Fiji” (斐濟共和國)
 - “The Union of Myanmar” (緬甸聯邦) by “The Republic of the Union of Myanmar” (緬甸聯邦共和國)
 - “Netherlands – For the Kingdom in Europe and for the Netherlands Antilles” (荷蘭—在歐洲的王國及荷屬安的列斯群島) by “The Kingdom of the Netherlands” (荷蘭王國)

³ The name “The Kingdom of the Netherlands” is already shown in the list of “Paris Convention countries” and the list of “Countries which have acceded to the Paris Convention” on the current schedules to the PO and the RDO respectively; hence no relevant schedule amendment is needed for these two Ordinances.