

**For discussion
on 18 November 2014**

Legislative Council Panel on Commerce and Industry

**Consultation on
Proposed Application of the
Protocol Relating to the Madrid Agreement Concerning the International
Registration of Marks to the
Hong Kong Special Administrative Region**

Purpose

The Administration has launched a three-month consultation exercise on the proposed application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) to Hong Kong. This paper outlines the issues and arrangements of the consultation.

Background

2. A trade mark is a sign that is capable of distinguishing the goods and services of one trader from those of others. A trade mark can be words (including personal names), logos, signatures, letters, characters, numerals, figurative elements, colours, sounds, smells, the shape of the goods or their packaging or any combination of these. A sign must be capable of being represented graphically in order for it to be registered as a trade mark. A registered trade mark is a property right obtained by the registration of the trade mark under the Trade Marks Ordinance (Cap.559) (TMO).

3. Registration of a trade mark¹ in Hong Kong gives the owner an exclusive right to use the trade mark in relation to the goods or services for which the mark is registered in Hong Kong.

¹ In Hong Kong, the registration of a trade mark is valid for a period of 10 years and registration may be renewed for further periods of 10 years each. In other words, the validity of a trade mark registration is potentially perpetual.

4. Trade mark rights are territorial in nature and are granted in each jurisdiction independently according to its own laws and practice. In other words, these rights are confined to the place in which the mark is being applied for and registered. For example, the trade mark registration system in Hong Kong provides protection of marks registered in Hong Kong only. Trade marks registered in Mainland China or other countries or regions do not automatically receive protection in Hong Kong. Thus, traditionally, a trader needs to apply for registration of his trade mark in each jurisdiction where he wishes to obtain protection by registration.

5. To facilitate the obtaining of protection of marks and the subsequent management in multiple countries or jurisdictions, the International Bureau (IB) of the World Intellectual Property Organization (WIPO) administers a system for international registration of trade marks (Madrid System). Currently, the Madrid System is not applicable in Hong Kong. We believe that it would be in Hong Kong's overall interest to join the System and we are consulting the public on the proposals. Our initial considerations and views are set out in the consultation paper attached. The gist is set out below.

Consultation Issues

The Madrid System

6. The Madrid System is governed by two international treaties, namely the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement)² and the Madrid Protocol³. Under the Madrid System, an international application can be filed by a natural person or a legal entity that has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a contracting party to the Madrid Agreement or the Madrid Protocol (contracting party) via the trade mark office where the basic mark⁴ is held (Office of Origin). An applicant can simply file a single

² The Madrid Agreement was concluded in 1891 providing a system for extension of trade mark registration from one country to other countries but major trading nations such as Australia, Japan, South Korea, the United Kingdom and the United States did not accede to the Madrid Agreement.

³ The Madrid Protocol was adopted in 1989 with the introduction of a number of new features, with a view to addressing certain concerns and limitations under the Madrid Agreement. See paragraph 10 below. In recent years, most of the new accessions are to the Madrid Protocol only. Almost all contracting parties to the Madrid Agreement have also joined the Madrid Protocol.

⁴ A basic mark refers to the trade mark right of a basic registration or basic application on which the international application is based. A basic mark under the Madrid Protocol may refer to the mark of a basic registration or a pending basic application at the trade mark office of a contracting party in which the applicant is qualified to file an international application, whereas only the mark of a basic registration may be used as a basic mark under the Madrid Agreement.

international application in English, French or Spanish⁵, pay one set of fees with the Office of Origin and designate one or more contracting parties in which he or she wishes to register his or her mark.⁶ The Madrid System also simplifies the post-registration management of the marks through a central depository of WIPO which enables trade mark owners to centrally request and record further changes, or renew the registrations, through a single procedural step with the IB. (See paragraphs 2.4-2.6 of the consultation paper for more details about the procedures of application under the Madrid System.)

Advantages of the Madrid System⁷

7. There are several advantages for the owner of the trade mark in using the Madrid System. On the basis of a basic mark, the trade mark owner has to file only one application in one language (English, French or Spanish), and pay fees to the Office of Origin instead of making separate applications in different contracting parties in different languages, and paying separate sets of fees to different trade mark offices. This process of applying for multinational trade mark registrations through one single procedural step⁸ dispenses with filing an individual application in each jurisdiction in which protection is sought. This trade mark regime enables considerable savings in terms of time and costs for trade mark owners.

8. After the trade mark has been registered through the Madrid System, the holder of the international registration can extend the registration to additional contracting parties in a quick, simple and cost-effective manner. He can manage his trade mark portfolio⁹ in different designated contracting parties through a single procedure with the IB and the payment of one fee. With the Madrid System, the process of seeking trade mark protection in multiple countries or jurisdictions is greatly simplified.

9. Only sovereign states or qualified inter-governmental organisations

⁵ Subject to what is prescribed by the trade mark office of the contracting party where the basic mark is held and hence the international application is made (Office of Origin). See Rule 6(1) of the Common Regulations under the Madrid Agreement and Protocol (Common Regulations) (http://www.wipo.int/wipolex/en/wipo_treaties/text.jsp?file_id=281712#P259_21724).

⁶ A national office may specify any one of the following as its working language, namely, English, French or Spanish. The IB of WIPO will translate its notifications from the language in which the international application was filed into one of the other two working languages as per the request of the national office, and also translate the recording and the publication of the international registration from one of the said three languages into the other two languages, which will facilitate further processing by the national office.

⁷ Paragraphs 2.11-2.14, Part A of the Guide to the International Registration of Marks and also Chapter 3 of the consultation paper.

⁸ The IB of WIPO will conduct checks on formality and classification before forwarding the international application to the designated contracting parties.

⁹ Including recordal of changes, renewal of trade mark registrations, registration of licences and assignments of trade marks.

(e.g. the European Union (EU)) may become contracting parties to the Madrid System. China is a contracting party to both the Madrid Agreement and the Madrid Protocol. In respect of the Hong Kong Special Administrative Region (HKSAR), China gave notice to WIPO in 1997 that, pending a study and until further notice, territorial extension of the international registration of marks under the Madrid System to the HKSAR would be deferred.

10. While China is a contracting party to both the Madrid Agreement and the Madrid Protocol, we take the view that it would be pragmatic to consider only the application of the Madrid Protocol to the HKSAR for the reason that the Madrid Protocol has introduced a number of features, in particular the following, to address certain concerns/limitations under the Madrid Agreement-

- (a) An applicant for international registration under the Madrid Protocol may base its application on a pending national application, rather than having to wait for a national registration, which is required under the Madrid Agreement.
- (b) A national trade mark office may opt for a longer period to notify the IB of objections to the international registration under the Madrid Protocol i.e. 18 months, or longer in the case of refusals based on oppositions, instead of a fixed 12-month period under the Madrid Agreement. This will provide more flexibility and allow for a more reasonable turnaround time for processing an international application taking into account the domestic legal and procedural requirements.
- (c) The Madrid Protocol allows a national office to receive an “individual fee” (capped by the equivalent fee charged under its domestic system diminished by the savings resulting from the international procedure). On the other hand, the Madrid Agreement provides for fixed fees which lack flexibility and may not enable cost recovery by national trade mark offices.
- (d) An international registration which is cancelled at the request of the Office of Origin, for example because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration, may be transformed into national (or regional) applications in the contracting parties whose designations are governed by the Madrid Protocol and where the international registration has effect. The transformation mechanism is not

available under the Madrid Agreement.

11. There has been a rapid increase in the number of contracting parties to the Madrid Protocol, from only five contracting parties in 1995 to 49 in 2000. To date, there are 91 contracting parties to the Madrid Protocol¹⁰, with seven recent accessions in 2012 and 2013. Most of the new accessions are to the Madrid Protocol only. According to WIPO, with the adoption of the ASEAN Intellectual Property Rights Strategic Plan 2011-2015, the remaining ASEAN member states which are not yet party to the Madrid Protocol, i.e. Brunei Darussalam, Cambodia, Indonesia, Laos, Malaysia, Myanmar and Thailand, have committed themselves to joining by 2015.

Benefits of the Application of the Madrid Protocol to Hong Kong

12. An assessment of the benefits of applying the Madrid Protocol to Hong Kong is set out below-

- (a) A more efficient trade mark registration and management system - Trade mark owners who have the requisite connections with Hong Kong can enjoy the convenience of the one-stop service in seeking trade mark protection in multiple countries. Having obtained international registrations through the Madrid Protocol, they can manage their trade mark portfolio in different designated contracting parties through a single procedure.
- (b) Enhancing competitiveness of Hong Kong as a place for business - For businesses operating in Hong Kong, the streamlined procedures offered by the Madrid Protocol could save time and reduce the costs of obtaining and managing international registration of their trade marks. Equally, it will become more cost-effective for overseas companies with an interest in the Hong Kong market to protect their trade marks in Hong Kong by requesting territorial extension of their international trade mark registration to Hong Kong through the Madrid Protocol. Thus implementation of the Madrid Protocol may provide overseas companies with more incentive to explore business opportunities for offering their goods and services in Hong Kong. It may also enhance the competitiveness of Hong Kong as a place for setting up and doing business. In fact, some business associations have

¹⁰ There are 55 contracting parties to the Madrid Agreement.

expressed their views that the deferral of the application of the Madrid System to Hong Kong would affect the opportunity of local businesses in taking part in transactions involving international trade mark registrations and undermine the credibility of Hong Kong as an international business hub.

- (c) Facilitating local businesses to explore global business opportunities - In line with the globalisation trend, more local businesses would like to venture overseas to exploit the international market. The Madrid Protocol facilitates local businesses to reach out to the world market by providing an efficient and less costly means for them to protect their trade marks overseas.
- (d) Promoting Hong Kong as an IP trading hub - In a knowledge-based economy, IP rights are increasingly commercialised and traded around the world. The Government has recognised Hong Kong's potential to develop itself into an IP trading hub and is working with stakeholders to study the overall promotion strategy and support measures in this regard. The implementation of the Madrid Protocol in Hong Kong would enable us to reap the benefits offered by the Madrid Protocol particularly in terms of the provision of a one-stop trade mark registration and management system and given the growing licensing business of Hong Kong. It is conducive to attracting more trade mark owners to choose Hong Kong as a place for entering into trading transactions of their trade marks, thus promoting our policy objective.
- (e) Reinforcing our international image - There are 91 contracting parties to the Madrid Protocol which include many of our major trading partners such as the US, the EU, Australia, Japan and Korea. A number of other economies in Asia such as Singapore, the Philippines, Vietnam and India have also joined the league. Several ASEAN member states have committed themselves to joining by 2015. Application of the Madrid Protocol to Hong Kong could enhance the credibility of our trade mark regime and reinforce our reputation as an international city and a knowledge-based economy.

Implications for Stakeholders

Overseas and local businesses

13. Regarding the business sectors, in particular foreign companies in Hong Kong, the application of the Madrid Protocol would facilitate their strategies of acquisition and management of trade marks in Hong Kong. Overseas investors will be able to register marks in Hong Kong through a one-stop process available under the Madrid System, without the trouble of going through a separate application in Hong Kong. It will be more convenient and cost-effective for overseas companies to protect their trade marks in Hong Kong by means of the Madrid System.

14. Local companies that have expanded their business overseas or plan to do so would be able to take advantage of the local one-stop service available under the Madrid System, and save the time and costs involved in filing separate applications in different overseas countries. Establishing such an efficient international trade mark registration system in Hong Kong would offer incentives for local companies to explore more global business opportunities.

Trade mark agents

15. Some trade mark agents may have reservation or concern about applying the Madrid Protocol to Hong Kong for fear that it would have an adverse impact on their business due to the possible decrease in the number of domestic applications made by foreign applicants in Hong Kong. Under the Madrid Protocol, a foreign applicant may designate a contracting party in the international application filed with his or her Office of Origin without providing an address for service in the designated contracting party or engaging any trade mark agent in that place. As a result, trade mark agents in Hong Kong may only be involved in handling a provisional refusal or opposition arising from international applications designating Hong Kong.

16. The negative impact on incoming registration business for trade mark agents might be partly mitigated over the longer term as the utilisation of the Madrid System and the designations to Hong Kong increases, which may result in more local agents being engaged in handling increasing volumes of provisional refusals or oppositions. In addition, in order to defend and protect their rights in Hong Kong, foreign international applicants or registration holders may be more prepared to engage local lawyers in connection with infringement actions and dispute settlements. Thus the application of the Madrid Protocol to Hong Kong might result in increased volume and value of work for our legal profession. This would be conducive to enhancing Hong

Kong's status as a regional centre for international legal services and dispute resolution.

17. Moreover, there may be new business opportunities for trade mark agents following the implementation of the Madrid Protocol in Hong Kong. Annex 8 of the consultation paper shows the number of trade mark applications filed by HKSAR applicants in the trade mark offices of our trading partners such as Australia, Japan, the EU, Singapore, the UK and the US between 2008 and 2013. The total number of applications filed in these jurisdictions amount to some 4 000 in 2012, having increased by almost 50% from 2 700 in 2008. Potentially a number of applicants from Hong Kong may be interested in filing international applications in Hong Kong (with intention to designate a number of contracting parties to the Madrid Protocol) should the Madrid Protocol be implemented in Hong Kong.

Summing Up

18. Balancing the benefits and implications as examined, it appears in the overall interest of Hong Kong to implement the Madrid Protocol.

Proposed Application of the Madrid Protocol to Hong Kong

19. China is a contracting party to both the Madrid Agreement and the Madrid Protocol. The Central People's Government (CPG) may apply the Madrid Protocol to Hong Kong in accordance with Article 153 of the Basic Law.¹¹ Should we seek the application of the Madrid Protocol to Hong Kong, implementation details would need to be worked out with the CPG and the IB, for example, regarding the fees level, language requirements of incoming and outgoing international applications and the procedures for receiving and processing such applications.

Necessary Steps for Implementation and Tentative Timing

20. The Government will take into account the views and suggestions received in this consultation exercise and discuss with the relevant authorities the proposed application of the Madrid Protocol to Hong Kong and the implementation plan. Among other things, amendments would have to be made to the existing Trade Marks Ordinance and Trade Marks Rules to accommodate

¹¹ Article 153 of the Basic Law provides that:

"The application to the Hong Kong Special Administrative Region of international agreements to which the People's Republic of China is or becomes a party shall be decided by the Central People's Government, in accordance with the circumstances and needs of the Region, and after seeking the views of the government of the Region. ..."

international applications pursuant to the Madrid Protocol in Hong Kong's legislation. Implementation of the Madrid Protocol would require additional resources and manpower, e.g. the information technology infrastructure would need to be modified and enhanced for receiving and handling international applications and post-registration matters, and training of staff would also be needed. It is estimated that it will take some three to four years to implement the Madrid Protocol in Hong Kong after a decision has been made.

Separate Issue: Possible Arrangement between Mainland China and Hong Kong

21. As we examine the prospect of applying to Hong Kong the Madrid Protocol as an international treaty designed to facilitate trade mark filings among different sovereign states and qualified inter-governmental organisations which are contracting parties, it is also opportune for us to consider some possible domestic arrangement within China to facilitate trade mark applications by Hong Kong applicants for registration in Mainland China and vice versa, given the close economic relationship between the two places. An appropriate facilitating arrangement should be able to benefit trade mark owners both in Hong Kong and in Mainland China. In any event, any proposed arrangement would be subject to careful studies and exploration between the Hong Kong and Mainland authorities, without prejudice to the proposed application of the Madrid Protocol to Hong Kong.

Consultation Arrangements

22. The three-month consultation exercise started on 11 November 2014, and the consultation paper and arrangements can be found at government websites.¹² In sum, we aim to seek views and comments on the following issues:

- (a) The proposed application of the Madrid Protocol to Hong Kong, in particular -
 - the benefits and implications;
 - practical arrangement;
 - steps for implementation; and
 - tentative timing.
- (b) The need for and the desirable features of a possible special arrangement between Hong Kong and Mainland China to

¹² www.cedb.gov.hk/citb
www.ipd.gov.hk

facilitate the reciprocal filing of trade mark applications.

23. We welcome views from the public, particularly from stakeholders such as professional bodies in the trade mark business. We will consider the views and comments received during the consultation carefully before reaching a final decision on the application of the Madrid Protocol to Hong Kong.

Advice Sought

24. Members are invited to take note of the public consultation and give their views.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
November 2014

**Proposed Application of the
Protocol Relating to the
Madrid Agreement Concerning the
International Registration of Marks to the
Hong Kong Special Administrative Region**

Consultation Paper

**Commerce and Economic Development Bureau
Intellectual Property Department
November 2014**

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Chapter 1

The Trade Mark System in Hong Kong

Nature and Function of a Trade Mark

1.1 A trade mark is a sign that distinguishes the goods and services of one trader from those of others. A trade mark can be words (including personal names), logos, signatures, letters, characters, numerals, figurative elements, colours, sounds, smells, the shape of the goods or their packaging or any combination of these. A sign must be capable of being represented graphically in order for it to be registered as a trade mark.¹ A registered trade mark is a property right obtained by the registration of the trade mark under the Trade Marks Ordinance (Cap.559) (TMO).²

1.2 Trade marks are the most widely used form of registered intellectual property (IP) throughout the world. The essential function of a trade mark is to guarantee the identity of the origin of the marked goods or services to the consumers. It is an important tool for branding, market innovation and competition. It facilitates business acquisition, licensing, franchising and all innovative forms of IP trading.

Rights of the Owner of a Trade Mark Registered in Hong Kong

1.3 As an owner of a registered trade mark in the Hong Kong Special Administrative Region (Hong Kong or the HKSAR), he or she has the exclusive right to use the trade mark in relation to the goods or services for which the mark is registered throughout the territory of Hong Kong.³ If another person uses a

¹ Section 3 of TMO.

² Section 10 of TMO.

³ Section 14 of TMO.

mark identical or similar to the registered trade mark in the course of trade or business in Hong Kong in relation to identical or similar goods or services without consent from the owner of the registered trade mark, and such a use is likely to cause confusion to the public, that person may be liable for infringement of the registered trade mark.⁴ Where a registered trade mark qualifies as a well-known trade mark, protection may be available against unauthorised use of an identical or similar mark in relation to goods or services not covered by the registration in cases where harm is caused to the distinctive character or repute of the registered mark as a result of use without due cause.⁵ Its owner may take legal action against the infringer.

1.4 In Hong Kong, the registration of a trade mark is valid for a period of 10 years and registration may be renewed for further periods of 10 years each.⁶ In other words, the validity of a trade mark registration is potentially perpetual.

Procedures of Application for Registration of Trade Marks in Hong Kong

1.5 Registration of a trade mark under the TMO would provide it with statutory protection as a registered trade mark. A trade mark owner seeking registration is required to file an application with the Hong Kong Trade Marks Registry (TM Registry) using specified forms and pay the prescribed fees. Upon receipt of the application, the TM Registry will conduct deficiency checking. If the application has no deficiencies or if deficiencies are remedied within the prescribed period, it will proceed to the stage of search and examination. After substantive examination of the application, if the registration requirements are met, the TM Registry will publish the application in the Hong Kong Intellectual Property Journal (HKIP Journal) to allow possible

⁴ Sections 18(1) to (3) of TMO.

⁵ Section 18(4) of TMO.

⁶ Section 49 of TMO.

opposition.

1.6 If no opposition is filed or all the opposition proceedings in respect of the application are withdrawn or decided in favour of the applicant, the trade mark shall be registered. Please refer to **Annex 1** for more details regarding the procedures of the trade mark application.

Trade Mark Statistics of Hong Kong

1.7 **Annex 2** shows the total number of applications for and registrations of trade marks in Hong Kong, including statistics of countries or regions of origin of the applicants between 2009 and 2013. There is a marked increasing trend as accounted for in paragraph 1.10 below.

Territorial Protection of Registered Trade Marks

1.8 Trade mark rights are territorial in nature and are granted in each jurisdiction independently according to its own laws and practice. In other words, these rights are confined to the place in which the mark is being applied for and registered. The trade mark registration system in Hong Kong therefore provides protection of marks registered in Hong Kong only. Trade marks registered in Mainland China⁷ or other countries or regions do not automatically receive protection in Hong Kong.

International and Regional Trends

1.9 In recent decades, the demand for trade marks has intensified to unprecedented levels internationally. Global trade mark demand quadrupled from under 1 million applications per year in 1985 to 4.2 million by 2011.

⁷ See also paragraph 5.1 of Chapter 5 of this paper.

During the same period, trade mark applications in Mainland China increased nearly 30 times to about 1.4 million. By 2001, Mainland China's trade mark office (CTMO) had become the top recipient of trade mark filings in the world.⁸

Annex 3 shows the number of domestic trade mark applications and registrations in Mainland China (including figures originating from Hong Kong applicants) between 2009 and 2013. In 2013, CTMO received 1 733 361 trade mark applications, with 67 889 originated from Hong Kong. Trade marks have become important assets of businesses and enterprises all over the world.

1.10 Hong Kong has also seen a steady increase in trade mark applications in recent years. In 2009, the Intellectual Property Department (IPD) received 24 754 trade mark applications. The number rose by 50% to 37 092 in 2013. During the same period, the number of trade mark applications filed by overseas owners increased by 54% from 15 300 to 23 496, of which 8 020 originated from Mainland China.

⁸ See WIPO, "World Intellectual Property Report 2013 – Brands: Reputation and Image in the Global Marketplace" (page 47) at www.wipo.int/export/sites/www/econ_stat/en/economics/wipr/pdf/wipr_2013_chapter1.pdf.

Chapter 2

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks⁹

The Madrid System

2.1 The Madrid system for international registration of trade marks (Madrid System) is administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO). It is governed by two international treaties, the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol).¹⁰ The Madrid System greatly simplifies the process of seeking trade mark protection in multiple countries or jurisdictions.

2.2 An international application under the Madrid System can be filed by a natural person or a legal entity that has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a contracting party (i.e. a member country) to the Madrid Agreement or the Madrid Protocol (contracting party) via the trade mark office where the basic mark is held.¹¹ An applicant can simply file a single international application in English, French or Spanish subject to what is prescribed by the trade mark office of the contracting

⁹ The full text of the Madrid Protocol is available at http://www.wipo.int/wipolex/en/wipo_treaties/text.jsp?file_id=283484.

¹⁰ Any State which is a party to the Paris Convention for the Protection of Industrial Property (Paris Convention) may become a party to the Madrid Agreement or the Madrid Protocol or both. In addition, an intergovernmental organisation may become a party to the Madrid Protocol (but not the Madrid Agreement) where the following conditions are fulfilled: at least one of the Member States of the organisation is a party to the Paris Convention and the organisation maintains a regional office for the purposes of registering marks with effect in the territory of the organisation (provided that such office is not the subject of a notification under Article 9*quater* (i.e. the third article after Article 9) of the Madrid Protocol). The major differences between the Madrid Agreement and the Madrid Protocol are set out in paragraph 2.11 of this paper.

¹¹ A basic mark refers to the trade mark right of a basic registration or basic application on which the international application is based. A basic mark under the Madrid Protocol may refer to the mark of a basic registration or a pending basic application at the trade mark office of a contracting party in which the applicant is qualified to file an international application, whereas only the mark of a basic registration may be used as a basic mark under the Madrid Agreement.

party where the basic mark is held and hence the international application is made (Office of Origin)¹², pay one set of fees with the Office of Origin and designate one or more contracting parties in which he or she wishes to register his or her mark.¹³

2.3 After a jurisdiction has joined the Madrid System and become a contracting party, an applicant of that jurisdiction may still choose to file separate national applications for registration of a trade mark directly with the overseas trade mark offices.¹⁴

*Procedures of International Application under the Madrid Protocol*¹⁵

2.4 As mentioned in paragraph 2.2, the applicant of an international application¹⁶ must have a basic mark in the Office of Origin, which will be used as the basis of the international application. The international application will designate one or more other Madrid Protocol contracting parties, these being the

¹² Rule 6(1) of the Common Regulations under the Madrid Agreement and Protocol (Common Regulations) (http://www.wipo.int/wipolex/en/wipo_treaties/text.jsp?file_id=281712#P259_21724).

¹³ A national office may specify any one of the following as its working language, namely, English, French or Spanish. The IB of WIPO will translate its notifications from the language in which the international application was filed into one of the other two working languages as per the request of the national office, and also translate the recording and the publication of the international registration from one of the said three languages into the other two languages, which will facilitate further processing by the national office.

¹⁴ There are circumstances under which an applicant may prefer to file separate national applications directly with overseas trade mark offices instead of filing an international application under the Madrid System. For example, the basic mark may have been filed in English only but the applicant seeks to protect its Chinese, Korean or French equivalent in overseas markets, or the applicant seeks to protect the same basic mark but in respect of a different scope of goods and services.

¹⁵ For the purposes of the present consultation, the procedures of international registration refer to those governed exclusively under the Madrid Protocol (see also the section on Comparison between the Madrid Protocol and the Madrid Agreement in paragraphs 2.11-2.12). Reference is made to the text of the Madrid Protocol, the Common Regulations and Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (updated 2014) (Guide to International Registration of Marks) issued by WIPO (<http://www.wipo.int/export/sites/www/madrid/en/guide/pdf/guide.pdf>) (paragraphs 2.07-2.10 of Part A; paragraphs 7.77, 18.01, 83.01-83.06 of Chapter II, Part B).

¹⁶ The applicant must either be a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Protocol, or which has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Madrid Protocol, or is a national of a member State of such an organization (Article 2 of the Madrid Protocol).

countries or territories where the applicant would like to protect his mark. The international application must be filed via the Office of Origin.

2.5 Upon receiving the international application, the Office of Origin shall certify that it falls within the scope of the basic mark and forward it to the IB of WIPO. The IB will check the formalities of the international application including the indication and classification of goods and services. Upon checking that all the filing requirements are met, the IB shall register and publish the mark and notify each designated contracting party of the international registration.

2.6 Substantive examination of the trade mark under the Madrid Protocol is handled by the trade mark office of the particular designated contracting party (Designated Office) in accordance with the respective local laws and procedures. Each Designated Office shall notify the IB of any refusal within the time limit specified in the Madrid Protocol. If no refusal is notified to the IB within the prescribed time limit, the protection of the mark in each designated contracting party is the same as if the mark has been registered by the trade mark office of that contracting party. See **Annex 4** for more details.

Dependency Period of Basic Mark

2.7 If, during the first five years following the date of the international registration, the basic application is refused, successfully opposed or withdrawn, or the basic registration is revoked or invalidated, the entire international registration in all designated contracting parties must also be cancelled.¹⁷ The holder of a cancelled international registration under the Madrid Protocol may apply to transform the international registration into a series of national applications in the designated countries, while retaining the filing date of the original international registration. At the end of the five-year dependency period, the international

¹⁷ This effect of attacking an international registration by a single action against the basic mark by a third party is sometimes referred to as “central attack”.

registration becomes independent of the basic mark.¹⁸ An international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees.¹⁹

Management of International Registrations of Trade Marks

2.8 Subsequent to registration of the mark under the Madrid Protocol, there is the possibility of designating additional Madrid member countries where protection is sought.²⁰ Such subsequent designations are useful where new countries accede to the Madrid Protocol or simply where the holder's interest develops after the international registration has been made. Furthermore, the post-registration management of the marks can be handled through a central depository of WIPO which enables trade mark owners to centrally request and record further changes,²¹ or renew the registrations,²² through a single procedural step.

*Advantages of the Madrid System*²³

2.9 There are several advantages for the owner of the trade mark in using the Madrid System. As mentioned in paragraph 2.2, on the basis of a basic mark, the trade mark owner has to file only one application in one language (English, French or Spanish), and pay fees to the Office of Origin in order to designate one or more contracting parties in which he or she wishes to register his or her mark instead of making separate applications in different contracting parties in different languages, and paying separate sets of fees to different trade mark offices. This

¹⁸ Paragraphs 83.01-83.06, Chapter II, Part B of the Guide to the International Registration of Marks.

¹⁹ Articles 6 and 7 of the Madrid Protocol.

²⁰ Article 3^{ter}(2) of the Madrid Protocol.

²¹ Article 9 and 9^{bis} of the Madrid Protocol.

²² Article 7(3) of the Madrid Protocol and Rule 30 of the Common Regulations.

²³ Paragraphs 2.11-2.14, Part A of the Guide to the International Registration of Marks and also Chapter 3 of this paper.

process of applying for multinational trade mark registrations through one single procedural step²⁴ dispenses with filing an individual application in each jurisdiction in which protection is sought. This trade mark regime enables considerable savings in terms of time and costs for trade mark owners.

2.10 After the trade mark has been registered through the Madrid System, the holder of the international registration can extend its geographical scope to additional contracting parties in a quick, simple and cost-effective manner. He or she can manage his or her trade mark portfolio in different designated contracting parties (including recordal of changes, renewal of trade mark registrations, registration of licences and assignments of trade marks) through a single procedure with the IB and the payment of one fee.

Comparison between the Madrid Protocol and the Madrid Agreement

2.11 The Madrid Agreement was concluded in 1891 but major trading nations such as Australia, Japan, South Korea, the United Kingdom (UK) and the United States (US) are not contracting parties to the Agreement. The Madrid Protocol was adopted in 1989 with the introduction of a number of new features, in particular the following, with a view to addressing certain concerns or limitations under the Madrid Agreement -

- (a) An applicant for international registration under the Madrid Protocol may base its application on a pending national application, rather than having to wait for a national registration, which is required under the Madrid Agreement.

²⁴ The IB of WIPO will conduct checks on formality and classification before forwarding the international application to the designated contracting parties.

- (b) A national trade mark office may opt for a longer period to notify the IB of objections to the international registration under the Madrid Protocol i.e. 18 months, or longer in the case of refusals based on oppositions, instead of a fixed 12-month period under the Madrid Agreement. This will provide more flexibility and allow for a more reasonable turnaround time for processing an international application taking into account the domestic legal and procedural requirements.
- (c) The Madrid Protocol allows a national office to receive an “individual fee” (capped by the equivalent fee charged under its domestic system diminished by the savings resulting from the international procedure). On the other hand, the Madrid Agreement provides for fixed fees which lacks flexibility and may not enable cost recovery by national trade mark offices.
- (d) An international registration which is cancelled, at the request of the Office of Origin, for example because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration, may be transformed into national (or regional) applications in the contracting parties whose designations are governed by the Madrid Protocol and where the international registration had effect. The transformation mechanism is not available under the Madrid Agreement.

2.12 As can be seen from the list of contracting parties at [Annex 5](#), in recent years, most of the new accessions are to the Madrid Protocol only. Almost all contracting parties to the Madrid Agreement have also joined the Madrid Protocol. For all practical purposes, any consideration of joining the Madrid System should focus on the possible application of the Madrid Protocol which is the subject of this Consultation Paper.

Hong Kong's Position and International Trend

2.13 Only sovereign states or qualified inter-governmental organisations (e.g. the European Union (EU)) may become contracting parties to the Madrid System. China is a contracting party to both the Madrid Agreement and the Madrid Protocol. In respect of the HKSAR, China gave notice to WIPO in 1997 that, pending a study and until further notice, the requests for territorial extension of the international registration of marks to China under the Madrid System would “be deferred to be applied to the HKSAR”.²⁵

2.14 According to the statistics from WIPO,²⁶ there has been a rapid increase in the number of contracting parties to the Madrid Protocol, from only 5 contracting parties in 1995 to 49 in 2000.²⁷ To date, there are 91 contracting parties to the Madrid Protocol, with 7 recent accessions in 2012 and 2013.²⁸ According to WIPO, with the adoption of the ASEAN Intellectual Property Rights Strategic Plan 2011-2015, the remaining ASEAN member states which are not yet party to the Madrid Protocol, i.e. Brunei Darussalam, Cambodia, Indonesia, Laos, Malaysia, Myanmar and Thailand, have committed themselves to joining by 2015.²⁹ Statistics relating to the international registrations via the Madrid System in 2013 and the number of international registrations designating Mainland China between 2009 and 2013 are set out in **Annex 6** and **Annex 7** respectively.³⁰

²⁵ See “Deferred Application of the Madrid Agreement and the Protocol to the Hong Kong Special Administrative Region”, Madrid (Marks) Notification No. 91, June 10, 1997 (http://www.wipo.int/treaties/en/notifications/madridp-gp/treaty_madridp_gp_91.html). Neither is the Madrid System applied to the Macau Special Administrative Region.

²⁶ See http://www.wipo.int/treaties/en/StatsResults.jsp?treaty_id=8&lang=en.

²⁷ See also paragraph 3.8 of this paper.

²⁸ They include the Philippines, Colombia, New Zealand and Mexico in 2012 and India, Rwanda and Tunisia in 2013.

²⁹ See Madrid Highlights, June 2012, No. 02/2012 (http://www.wipo.int/export/sites/www/madrid/en/highlights/2012/pdf/madrid_highlights_2_2012.pdf).

³⁰ Madrid Yearly Review 2014 – International Registration of Marks published by WIPO

2.15 Against the above background, it is high time for the Government to assess whether we should seek the application of the Madrid Protocol³¹ to Hong Kong with a view to enhancing the competitiveness of Hong Kong as an international business and IP trading hub.

(http://www.wipo.int/export/sites/www/freepublications/en/marks/940/wipo_pub_940_2014.pdf) at pages 66 to 68.

³¹ We find it pragmatic to consider only application of the Madrid Protocol to Hong Kong for the reason that the Madrid Protocol has a number of advantages over the Madrid Agreement (see discussion in paragraphs 2.11 to 2.12).

Chapter 3

Justifications for Application of the Madrid Protocol to Hong Kong

3.1 An assessment of the benefits and implications of applying the Madrid Protocol to Hong Kong are set out below.

Benefits of the Application of the Madrid Protocol to Hong Kong

A more efficient trade mark registration and management system

3.2. Trade mark owners who have the requisite connections with Hong Kong can enjoy the convenience of the one-stop service in seeking trade mark protection in multiple countries. Having obtained international registrations through the Madrid Protocol, they can manage their trade mark portfolio in different designated contracting parties (including recordal of changes, e.g. change in name and/or address of the holder or a limitation of the list of goods and services in respect of all or some of the designated contracting parties, renewal of trade mark registrations, registration of licences and assignments of trade marks) through a single procedure.

Enhancing competitiveness as a place for business

3.3 For businesses operating in Hong Kong, the streamlined procedures offered by the Madrid Protocol could save time and reduce the costs of obtaining and managing international registration of their trade marks. Conversely, it will become more cost-effective for overseas companies with an interest in the Hong Kong market to protect their trade marks in Hong Kong by requesting territorial extension of their international trade mark registration to Hong Kong through the Madrid Protocol.

3.4 Given the above benefits, implementation of the Madrid Protocol may

provide overseas companies with more incentive to explore business opportunities for offering their goods and services in Hong Kong. It may also enhance the competitiveness of Hong Kong as a place for setting up and doing business. In fact, some business associations have expressed their views that the deferral of the application of the Madrid System to Hong Kong would affect the local protection of trade marks and undermine the credibility of Hong Kong as an international business hub.

Facilitating local business to explore global business opportunities

3.5 In line with the globalisation trend, more local businesses would like to venture overseas to exploit the international market. The Madrid Protocol facilitates local businesses to reach out to the world market by providing an efficient and less costly means for them to protect their trade marks overseas.

Promoting Hong Kong as an IP trading hub

3.6 In a knowledge-based economy, IP rights are increasingly commercialised and traded around the world. The Government has recognised Hong Kong's potential to develop itself into an IP trading hub and is working with stakeholders to study the overall promotion strategy and support measures in this regard.³²

3.7 The implementation of the Madrid Protocol in Hong Kong would enable us to reap the benefits offered by the Madrid Protocol particularly in terms of the provision of a one-stop trade mark registration and management system and given

³² The Chief Executive announced in his 2013 Policy Address to set up a working group to study the overall strategy for promoting Hong Kong as a hub for IP trading. A working group consisting of members drawn from IP creators, IP users, IP intermediaries, the Hong Kong Trade Development Council and the Government and chaired by Secretary for Commerce and Economic Development was accordingly appointed in March 2013.

the growing licensing business of Hong Kong.³³ It is conducive to attracting more trade mark owners to choose Hong Kong as a place for entering into commercial transactions of their trade marks, thus promoting our policy objective.

Reinforcing our international image

3.8 There are 91 contracting parties to the Madrid Protocol which include many of our trading partners such as the US, the EU, Australia, Japan and Korea. A number of other economies in Asia such as Singapore, the Philippines, Vietnam and India have also joined the league. As mentioned in paragraph 2.14, several ASEAN member states which are not yet party to the Madrid Protocol have committed themselves to joining by 2015. Application of the Madrid Protocol to Hong Kong could enhance the credibility of our trade mark regime and reinforce our reputation as an international city and a knowledge-based economy.

Implications for Stakeholders

Overseas and local businesses

3.9 Regarding the business sectors, in particular foreign companies in Hong Kong, the application of the Madrid Protocol would facilitate their strategies of acquisition and management of trade marks in Hong Kong. Overseas investors will be able to register marks in Hong Kong through a one-stop process overseas available under the Madrid System, without the troubles of going through a separate application in Hong Kong. It will be more convenient and cost-effective for overseas companies to protect their trade marks in Hong Kong

³³ According to the Hong Kong Trade in Services Statistics in 2012 compiled by the Census and Statistics Department at <http://www.statistics.gov.hk/pub/B10200112012AN12B0100.pdf> (page 34), Hong Kong's export of "charges for the use of IP", which include trade mark and franchise licensing fees and charges for the use of other IP rights, reached HK\$4.03 billion in 2012, having increased by 14% from the figure of HK\$3.58 billion in 2011.

by means of the Madrid System.

3.10 Local companies that have expanded their business overseas or plan to do so would be able to take advantage of the local one-stop service available under the Madrid System, and save the time and costs involved in filing separate applications in different overseas countries. Establishing such an efficient international trade mark registration system in Hong Kong would offer incentives for local companies to explore more global business opportunities.

Trade mark agents

3.11 Some trade mark agents may have reservation or concern about applying the Madrid Protocol for fear that it would have an adverse impact on their business due to the possible decrease in the number of domestic applications made by foreign applicants in Hong Kong. Under the Madrid Protocol, a foreign applicant may designate a contracting party in the international application filed with his or her Office of Origin without providing an address for service in the designated contracting party or engaging any trade mark agent in that place. As a result, trade mark agents in Hong Kong may only be involved in handling a provisional refusal or opposition arising from international applications designating Hong Kong. The negative impact, however, might be partly mitigated over the longer term as the utilisation of the Madrid System and the designations to Hong Kong increases, which may result in more local agents being engaged in relevant work.

3.12 Moreover, there may be new business opportunities for trade mark agents following the implementation of the Madrid Protocol in Hong Kong. **Annex 8** shows the number of trade mark applications filed by HKSAR applicants in the trade mark office of our trading partners such as Australia, Japan, the EU, Singapore, the UK and the US between 2008 and 2013. The total number of applications filed in these jurisdictions amount to some 4 000 in 2012,

having increased by almost 50% from 2 700 in 2008. Potentially a number of applicants from Hong Kong may be interested in filing international applications in Hong Kong (with intention to designate a number of contracting parties to the Madrid Protocol) should the Madrid Protocol be implemented in Hong Kong.

Summing Up

3.13 Balancing the benefits and implications as examined, it appears in the overall interest of Hong Kong to implement the Madrid Protocol.

Chapter 4

Proposed Application of the Madrid Protocol to Hong Kong

4.1 This chapter focuses on practical considerations of the proposed application of the Madrid Protocol to Hong Kong.

Possible Implementation Arrangement in Hong Kong

4.2 As mentioned in Chapter 2, only sovereign states or qualified inter-governmental organisations (e.g. the EU) may become contracting parties to the Madrid Protocol. China is a contracting party to both the Madrid Agreement and the Madrid Protocol. The HKSAR is a local administrative region of the People's Republic of China, which enjoys a high degree of autonomy and comes directly under the Central People's Government. The Central People's Government of China may apply the Madrid Protocol to the HKSAR in accordance with Article 153 of the Basic Law.³⁴

4.3 Under the Madrid Protocol, an applicant may file an international application for registration of a trade mark via the Office of Origin where the basic mark is held and designate one or more contracting parties. With the application of the Madrid Protocol to Hong Kong, Hong Kong applicants may file an international application at the Hong Kong TM Registry on the basis of a basic mark held in Hong Kong and make designations to other contracting parties of the Madrid Protocol pursuant to the relevant agreed arrangement. Conversely, international applicants may seek trade mark protection in Hong Kong by designating Hong Kong in international applications filed under the Madrid

³⁴ Article 153 of the Basic Law provides that:
“The application to the Hong Kong Special Administrative Region of international agreements to which the People's Republic of China is or becomes a party shall be decided by the Central People's Government, in accordance with the circumstances and needs of the Region, and after seeking the views of the government of the Region...”.

Protocol. It is for the TM Registry of Hong Kong to examine such applications according to the same criteria as domestic applications under the TMO.

4.4 Should we seek the application of the Madrid Protocol to Hong Kong, implementation details would need to be worked out with the Central People's Government and the IB, for example, regarding the fees level and language requirements of incoming and outgoing international applications and the procedures for receiving and processing such applications.

Necessary Steps for Implementation and Tentative Timing

4.5 The Government will take into account the views and suggestions received in this consultation and discuss with the relevant authorities the proposed application of the Madrid Protocol to Hong Kong and the implementation plan. Among other things, amendments would have to be made to the existing TMO and Trade Marks Rules (TMR) to accommodate international applications pursuant to the Madrid Protocol in Hong Kong's legislation.

4.6 Implementation of the Madrid Protocol would require additional resources and manpower, e.g. the information technology infrastructure would need to be modified and enhanced for receiving and handling international applications and post-registration matters, and training of staff would also be needed.

4.7 Subject to passage of the necessary legislation and completion of other implementation preparations, the Government will have to formally request the Central People's Government to notify WIPO of the application of the Madrid Protocol to the HKSAR. It is estimated that it will take some three to four years to implement the Madrid Protocol in Hong Kong after a decision has been made.

Chapter 5
Separate Issue:
Possible Arrangement between
Mainland China and Hong Kong

Current Situation

5.1 As mentioned in Chapter 1, given the territorial nature of trade mark protection, trade marks registered in Hong Kong are not automatically protected in Mainland China, and vice versa. To obtain registration protection of a trade mark both in Hong Kong and Mainland China under their respective trade mark laws, owners must apply for registration in the two places separately. The authority responsible for the registration and administration of trade marks in Mainland China is the CTMO of the State Administration for Industry and Commerce of China (SAIC). The Trademark Review and Adjudication Board (TRAB) of the SAIC is responsible for handling matters of trade mark disputes in Mainland China such as requests for review of the decision of CTMO in accordance with the Trade Mark Law of China. The aforesaid Mainland authorities and the TM Registry of the IPD of the HKSAR Government handle trade mark applications received in accordance with their own independent trade mark laws and procedures.

Applications filed by Hong Kong applicants for registration in Mainland China³⁵

5.2 In Mainland China, Hong Kong applicants can file their trade mark applications directly (provided that such an applicant has a “habitual residence”

³⁵ See CTMO’s webpage on “如何申请注册商品商标或服务商标” (How to Apply to Register Trade Marks for Goods or Services), 1 May 2014, at http://sbj.saic.gov.cn/sbsq/sqzn/201404/t20140430_144506.html, “商标注册流程简图” (Trade Marks Registration Flow Chart), 1 May 2014, at http://sbj.saic.gov.cn/sbsq/sqzn/201404/t20140430_144507.html and Trademark Law of the People's Republic of China, at http://sbj.saic.gov.cn/flfg1/flfg/201309/t20130903_137807.html.

or “place of business”³⁶ in Mainland China) or through a trade mark agent to CTMO. CTMO will conduct formality checking of the application. If the application requires no amendment or if amendments are made within the prescribed period, it will proceed to substantive examination. After substantive examination, CTMO will preliminary approve and publish the application if it fulfills the registration requirements. If no opposition is filed or the opposition fails, the application will be approved for registration and published. For details of the registration procedure, please refer to **Annex 9**.

Applications filed by Mainland applicants for registration in Hong Kong

5.3 Mainland applicants, like Hong Kong applicants and other overseas applicants, can file their trade mark applications directly or through trade mark agents to the TM Registry. The applicant has to file an address for service which must be a residential or business address in Hong Kong.³⁷ The application procedure is the same for all applicants including Mainland applicants (see Chapter 1).

Need for Special Arrangement between Mainland China and Hong Kong

5.4 As we examine the prospect of applying to Hong Kong the Madrid Protocol as an international treaty designed to facilitate trade mark filings among different sovereign states and qualified inter-governmental organisations which are contracting parties, it is also opportune for us to consider some possible domestic arrangement within China to facilitate trade mark applications by Hong Kong applicants for registration in Mainland China and vice versa, given the close economic relationship between the two places. An appropriate facilitating

³⁶ Rule 5 of the Implementing Regulations of the Trade Mark Law of China at http://sbj.saic.gov.cn/flfg/201405/t20140522_145379.html and CTMO’s webpage, “商标注册申请须知” (Guidance Notes on Trade Mark Registration), 1 May 2014, at http://sbj.saic.gov.cn/sbsq/sqzn/201404/t20140430_144508.html.

³⁷ Rule 105 of TMR.

arrangement should be able to benefit trade mark owners both in Hong Kong and in Mainland China. There may be possible policy implications as well as practical concerns to identify and address.

5.5 Any proposed arrangement would be subject to careful studies and exploration between the Hong Kong and Mainland authorities, without prejudice to the proposed application of the Madrid Protocol to Hong Kong.

Chapter 6

Issues for Consultation

6.1 Your views are sought on the following issues:

- (a) The proposed application of the Madrid Protocol to Hong Kong, in particular -
 - the benefits and implications;
 - practical arrangement;
 - steps for implementation; and
 - tentative timing.

- (b) The need for and the desirable features of a possible special arrangement between Hong Kong and Mainland China to facilitate the reciprocal filing of trade mark applications.

How to Respond

6.2 You are invited to provide your views on the issues set out in this consultation paper on or before 11 February 2015 through the post, email or fax –

Mail : Director of Intellectual Property
Intellectual Property Department, the HKSAR Government
25th Floor, Wu Chung House
213 Queen's Road East
Wanchai
Hong Kong
Email : mp_consultation@ipd.gov.hk
Fax : 2574 9102

6.3 You may decide whether or not to supply your personal data when providing views on this consultation paper. Any personal data provided with a submission will only be used for the purposes of this public consultation exercise.

6.4 The submissions and personal data collected may be passed to relevant Government bureaux and departments for purposes directly related to this consultation exercise. The Government bureaux and departments receiving any personal data are bound by the purposes in their subsequent use of such data.

6.5 This Bureau may publish the submissions made in response to this consultation paper for public viewing after the conclusion of the consultation exercise, and may publish your name or your affiliation (or both). If you do not wish to disclose your identity when we publish the public views received, please state so when making your submission.

6.6 Any sender providing personal data in the submission will have the rights of access and correction with respect to such personal data. Any requests for data access or correction of personal data should be made in writing.

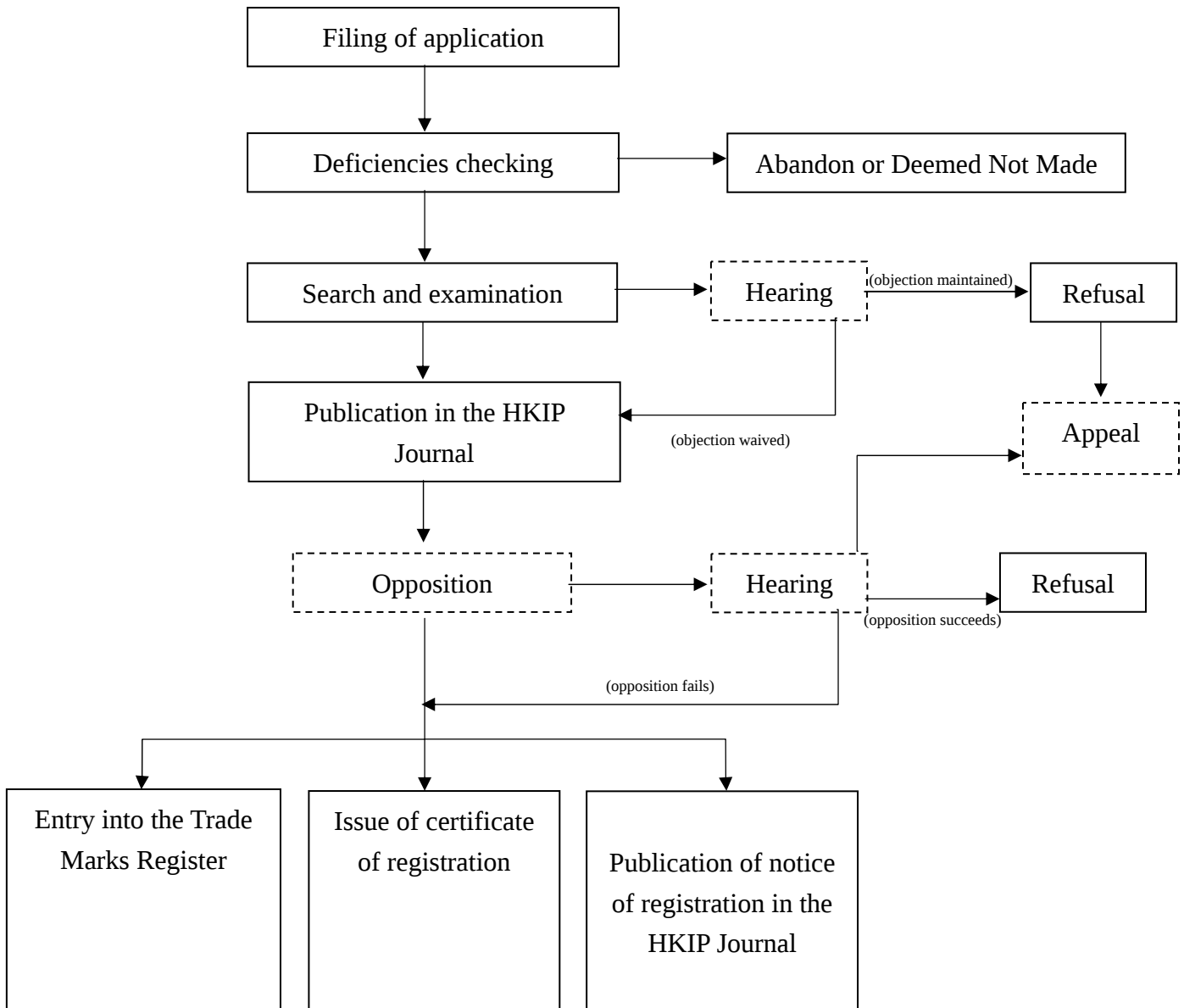
6.7 An electronic copy of this document is available at the following websites –

<http://www.cedb.gov.hk/citb>

<http://www.ipd.gov.hk>

Annex 1

Procedures of Application for Registration of Trade Marks in Hong Kong



- **Application**

An applicant is required to file its application using specified forms and pay the prescribed fees.³⁸ All applicants should provide an address for service in Hong Kong.³⁹

- **Deficiencies Checking**

Upon receipt of the application, the TM Registry will conduct deficiency checking. The applicant is required to remedy any deficiencies within two months after the date of notification, failing which the application shall be treated as abandoned or deemed never to have been made.⁴⁰ If the application has no deficiencies or if deficiencies are remedied within time, it will proceed to the stage of search and examination.

- **Search & Examination⁴¹**

For the purpose of examination, the TM Registry will conduct a search of the trade mark records to see if there is an earlier registration or application for an identical or similar mark in respect of the same or similar goods and services.⁴² In respect of an application which fails to meet the registration requirements, the TM Registry will raise an objection by issuing an opinion and the applicant has 6 months (and a further 3 months extension may be granted) to meet the requirements.⁴³ If the TM Registry still maintains that the applicant does not satisfy the requirements for registration after considering the applicant's response, it will issue a further opinion and the applicant has 3 months (and extended period(s) may be granted under limited circumstances) to meet the requirements or call for a hearing.⁴⁴

- **Hearing**

If the applicant calls for a hearing, all the evidence for and against the registration of the trade mark will be considered at a hearing, and a decision will be issued which is subject to appeal to the Court.⁴⁵

³⁸ Section 38 of TMO and rules 4 and 6 of TMR

³⁹ Rule 105(1)(a) and (2) of TMR

⁴⁰ Rule 11 of TMR

⁴¹ Section 42 of TMO

⁴² Section 42(2) of TMO

⁴³ Rule 13(1) to (3) of TMR

⁴⁴ Rule 13(4) to (6) of TMR

⁴⁵ Section 70 of TMO and rule 74 of TMR; section 84(1) of TMO

- **Publication for Opposition**

If it appears to the TM Registry that the registration requirements are met, the application will be accepted for publication in the HKIP Journal for opposition.⁴⁶

- **Opposition**

Anyone may lodge an opposition to the application after publication of the particulars of the application in the HKIP Journal.⁴⁷ A notice of opposition has to be filed within the 3-month period (which is extendable once by 2 months) beginning on the publication date.⁴⁸ The applicant shall file a counter-statement within 3 months (which is extendable once by 2 months) after the date of receipt of a copy of the notice of opposition. If the applicant does not file a counter-statement within the prescribed period, he shall be deemed to have withdrawn his application.⁴⁹ The opponent and the applicant are given the opportunity, within certain time limits, to file evidence in support of the opposition and application respectively.⁵⁰ When all the evidence has been received, a hearing will take place before a hearing officer who will then make a decision which is subject to appeal to the Court.⁵¹

- **Registration**

If no opposition is filed or all the opposition proceedings in respect of the application are withdrawn or decided in favour of the applicant, the Registrar of Trade Marks shall register the trade mark by entering the details of the trade mark in the trade mark register and issue a certificate of registration to the applicant.⁵² Notice of the registration will be published in the HKIP Journal and the registration of the trade mark will date back to the filing date of the application.⁵³

⁴⁶ Section 43 of TMO

⁴⁷ Section 44 of TMO

⁴⁸ Rule 16 of TMR

⁴⁹ Rule 17 of TMR

⁵⁰ Rules 18 to 20 of TMR

⁵¹ Section 70 of TMO and rule 21 of TMR; section 84(1) of TMO

⁵² Sections 47(1) and (2) of TMO

⁵³ Sections 47(3) and 48 of TMO

Statistics of trade mark applications and registrations in Hong Kong**A. Number of trade mark applications in Hong Kong by countries/regions of origin of applicants**

Country/Region	2009	2010	2011	2012	2013
Andorra	0	0	0	1	0
Angola	0	3	1	0	0
Anguilla	1	1	1	7	4
Argentina	35	14	14	15	39
Armenia	0	0	1	5	0
Aruba	2	2	0	1	1
Australia	248	329	323	304	379
Austria	33	48	37	58	58
Azerbaijan	0	1	0	0	1
Bahamas	8	18	25	21	22
Bahrain	2	0	0	1	2
Bangladesh	3	1	0	6	1
Barbados	7	7	12	5	9
Belarus	0	0	0	1	0
Belgium	60	56	53	78	104
Belize	1	0	2	3	15
Bermuda	21	31	39	22	25
Brazil	14	22	37	36	57
British Indian Ocean Territory	0	1	1	0	0
British Virgin Islands	404	460	529	641	523
Brunei Darussalami	4	0	1	0	3
Bulgaria	0	0	1	18	12
Cambodia	0	0	0	1	1
Canada	98	130	171	124	182
Canary Islands	1	0	0	0	0

Country/Region	2009	2010	2011	2012	2013
Cayman Islands	197	179	142	140	213
Channel Islands	1	2	1	3	2
Chile	19	29	27	25	22
Mainland China	4,620	5,332	6,728	6,964	8,020
Colombia	10	1	4	3	9
Congo	0	0	0	2	2
Cook Islands	8	8	6	4	0
Costa Rica	0	0	0	0	1
Cuba	0	1	2	0	0
Curacao	0	0	0	0	2
Cyprus	4	12	25	17	14
Czech Republic	4	4	20	21	8
Denmark	47	69	94	79	69
Dominican Republic	0	0	2	1	0
Ecuador	0	1	0	0	1
Egypt	4	0	2	2	2
Estonia	0	0	1	1	2
Fiji	0	1	5	4	2
Finland	25	25	29	43	53
France	572	662	829	876	934
French Polynesia	0	0	0	0	1
French Southern Territories	0	1	0	0	0
Georgia	1	0	0	0	0
Germany	462	563	621	681	739
Gibraltar	0	9	0	1	1
Greece	12	8	14	19	12
Guernsey	3	4	1	6	0
Guyana	0	0	0	1	
Hong Kong, China	9,454	10,902	11,703	13,204	13,596
Hungary	24	7	7	9	0
Iceland	15	1	1	2	12

Country/Region	2009	2010	2011	2012	2013
India	46	38	75	56	52
Indonesia	36	55	39	40	41
Iran	3	6	2	5	0
Iraq	0	0	5	1	1
Ireland	36	96	64	59	86
Isle of Man	8	12	6	6	20
Israel	19	20	40	28	39
Italy	322	361	515	574	570
Jamaica	2	0	4	1	0
Japan	1,810	2,349	2,541	2,818	2,143
Jersey	1	4	2	2	5
Jordan	0	0	0	3	0
Kazakhstan	0	0	0	0	1
Kenya	0	0	2	0	0
Korea, Democratic People's Republic of	0	0	0	1	0
Korea, Republic of	354	426	479	496	655
Kuwait	4	4	1	2	1
Latvia	2	0	1	2	2
Lebanon	7	3	7	0	6
Liberia	0	2	0	0	0
Liechtenstein	12	12	31	23	36
Lithuania	0	3	1	1	0
Luxembourg	42	92	113	140	115
Macau, China	36	48	43	58	66
Madagascar	0	2	1	0	0
Madeira	0	0	0	3	0
Malaysia	115	95	106	172	123
Maldives	0	0	0	0	2
Malta	23	2	5	21	47
Marshall Islands	0	1	2	2	16
Mauritius	18	13	12	11	16

Country/Region	2009	2010	2011	2012	2013
Mexico	25	30	18	28	25
Moldova	10	0	0	0	0
Monaco	10	6	19	14	21
Mongolia	5	6	1	1	7
Morocco	1	0	0	0	0
Namibia	2	0	0	0	0
Nepal	1	0	0	1	0
Netherlands	210	267	249	241	274
Netherlands Antilles	22	11	4	0	0
New Zealand	63	60	91	118	119
Niger	0	1	0	0	0
Nigeria	2	0	1	0	1
Norway	13	14	25	20	9
Oman	0	1	2	0	0
Pakistan	0	14	17	1	10
Panama	2	20	13	17	28
Papua New Guinea	4	0	0	0	0
Paraguay	1	0	1	0	1
Peru	1	1	7	1	2
Philippines	10	16	27	18	17
Poland	5	4	13	7	26
Portugal	14	24	17	40	44
Puerto Rico	2	6	2	0	0
Qatar	1	4	5	4	7
Romania	0	2	0	1	1
Russia	18	29	15	21	33
Saint Vincent and the Grenadines	0	0	0	1	0
Samoa	4	6	10	11	5
San Marino	1	1	0	0	2
Saudi Arabia	12	18	13	19	8
Seychelles	2	6	3	13	15

Country/Region	2009	2010	2011	2012	2013
Singapore	290	336	376	346	437
Slovakia	1	0	0	0	0
Slovenia	0	6	7	3	5
South Africa	41	37	26	49	49
Spain	154	127	205	228	213
Sri Lanka	2	1	4	2	8
Sweden	105	114	85	127	129
Switzerland	588	658	657	727	777
Syrian Arab Republic	3	0	0	0	6
Taiwan, China	470	638	649	695	821
Thailand	59	51	66	65	100
Togo	0	0	0	0	1
Trinidad and Tobago	0	0	0	0	1
Tunisia	1	0	0	0	1
Turkey	25	16	35	41	41
Turks and Caicos Islands	0	0	3	1	0
Ukraine	0	0	3	4	3
United Arab Emirates	16	41	29	37	42
United Kingdom	499	582	710	826	855
United States of America	2,693	3,070	3,497	3,786	3,723
Uruguay	1	2	3	10	5
Venezuela	1	1	9	1	3
Vietnam	10	12	14	20	18
West Indies	2	0	1	3	1
Yemen	3	1	1	1	0
Others (Note 1)	29	43	17	0	0
Total Number of Applications	24,754	28,872	32,559	35,530	37,092
Total Countries/Regions	102	100	106	109	107

Note 1: Starting from 2012, the category “Others” is no longer in use and the statistics show the “Countries/Regions” of applicants.

B. Number of trade mark registrations in Hong Kong by countries/regions of origin of applicants

Country/Region	2009	2010	2011	2012	2013
Andorra	0	0	0	1	0
Angola	0	2	2	0	0
Anguilla	0	2	1	0	10
Argentina	33	6	7	19	20
Armenia	1	0	0	1	4
Aruba	3	1	0	2	1
Australia	256	226	273	269	276
Austria	38	29	45	29	38
Azerbaijan	0	0	1	0	0
Bahamas	14	7	16	25	16
Bahrain	2	0	0	0	0
Bangladesh	0	3	0	0	6
Barbados	5	3	8	7	1
Belarus	0	0	0	0	1
Belgium	72	61	47	52	78
Belize	0	1	0	3	6
Bermuda	26	25	37	31	26
Brazil	26	13	27	27	43
British Indian Ocean Territory	1	0	2	0	0
British Virgin Islands	347	395	423	419	507
Brunei Darussalami	4	1	0	1	0
Bulgaria	1	0	0	4	14
Cambodia	0	0	0	0	1
Canada	104	103	134	124	130
Canary Islands	2	0	0	0	0
Cayman Islands	100	236	123	120	182
Channel Islands	1	1	2	0	2
Chile	30	23	19	21	23

Country/Region	2009	2010	2011	2012	2013
Mainland China	3,552	4,181	4,719	5,212	6,221
Colombia	11	4	3	2	3
Congo	0	0	0	0	2
Cook Islands	5	9	6	4	0
Costa Rica	0	0	0	0	1
Cuba	2	0	1	1	1
Cyprus	2	6	10	12	31
Czech Republic	5	5	6	19	19
Denmark	66	45	63	77	94
Dominican Republic	0	0	2	0	1
Ecuador	0	0	1	0	1
Egypt	5	1	1	0	2
Estonia	0	0	0	1	1
Fiji	0	0	1	0	2
Finland	23	22	24	39	36
France	602	567	613	697	865
French Southern Territories	0	1	0	0	0
Georgia	0	1	0	0	0
Germany	580	477	456	534	707
Gibraltar	1	0	5	2	0
Greece	6	15	7	6	13
Guernsey	3	0	4	0	5
Guyana	0	0	0	0	1
Hong Kong, China	7,524	8,482	8,430	9,111	11,144
Hungary	12	9	11	3	8
Iceland	15	10	1	0	6
India	31	45	43	59	34
Indonesia	30	34	26	32	42
Iran	3	2	3	3	3
Iraq	0	0	0	5	0
Ireland	52	77	56	56	82

Country/Region	2009	2010	2011	2012	2013
Isle of Man	19	10	2	8	17
Israel	29	16	16	33	41
Italy	389	316	365	459	520
Jamaica	0	1	6	0	0
Japan	2,224	1,841	2,107	2,156	2,545
Jersey	0	1	4	1	1
Jordan	0	0	0	2	1
Kenya	0	0	0	1	0
Korea, Democratic People's Republic of	0	0	0	0	1
Korea, Republic of	268	331	339	448	498
Kuwait	3	7	0	2	3
Latvia	0	1	0	1	2
Lebanon	7	3	6	4	4
Liechtenstein	28	13	20	22	24
Lithuania	0	0	2	0	1
Luxembourg	42	50	99	80	112
Macau, China	36	30	41	32	56
Madagascar	1	2	0	1	0
Madeira	0	0	0	1	0
Malaysia	104	88	84	97	139
Malta	17	8	1	3	14
Marshall Islands	1	0	0	2	0
Mauritius	20	13	14	4	7
Mexico	29	25	22	22	25
Moldova	0	9	0	0	0
Monaco	5	11	9	14	23
Mongolia	1	8	0	1	1
Morocco	1	0	0	0	0
Namibia	0	2	0	0	0
Nepal	2	1	0	0	1
Netherlands	203	212	205	196	240

Country/Region	2009	2010	2011	2012	2013
Netherlands Antilles	9	5	13	0	0
New Zealand	59	61	53	78	117
Nigeria	0	2	0	1	0
Norway	16	10	18	19	13
Oman	0	0	2	1	0
Pakistan	4	11	11	0	8
Panama	10	6	8	5	13
Papua New Guinea	4	0	0	0	0
Paraguay	1	0	0	1	0
Peru	1	2	0	6	1
Philippines	20	7	16	19	15
Poland	10	3	7	9	8
Portugal	18	15	13	20	37
Puerto Rico	0	2	5	0	0
Qatar	2	0	4	6	2
Romania	3	0	1	1	0
Russia	25	21	24	12	19
Saint Vincent and the Grenadines	0	0	0	0	1
Samoa	1	8	3	8	11
San Marino	0	2	0	0	0
Saudi Arabia	28	12	10	18	14
Seychelles	3	2	3	3	14
Singapore	241	263	330	300	314
Slovakia	1	0	0	1	1
Slovenia	1	2	4	7	1
South Africa	40	24	27	27	29
Spain	137	111	150	162	225
Sri Lanka	0	2	1	5	2
Sweden	97	103	74	99	108
Switzerland	662	597	605	557	734
Syrian Arab Republic	4	1	0	0	3

Country/Region	2009	2010	2011	2012	2013
Taiwan, China	478	445	485	564	635
Thailand	61	69	45	56	60
Tunisia	1	0	0	0	0
Turkey	18	24	15	38	30
Turks and Caicos Islands	0	0	0	2	0
Ukraine	0	0	0	3	1
United Arab Emirates	33	15	25	31	28
United Kingdom	558	496	535	669	702
United States of America	2,911	2,580	2,612	3,010	3,300
Uruguay	5	1	5	7	3
Venezuela	1	0	3	5	3
Vietnam	10	4	14	12	24
West Indies	2	0	0	0	1
Yemen	0	3	0	1	1
Others (Note 2)	0	4	0	0	0
Total Number of Registrations	22,500	23,043	24,122	26,383	31,464
Total Countries/Regions	98	97	91	98	105

Note 2: Starting from 2012, the category “Others” is no longer in use and the statistics show the “Countries/Regions” of applicants.

Source: Intellectual Property Department, the Government of the Hong Kong Special Administrative Region

**Statistics of trade mark applications and registrations
in Mainland China⁵⁴**

A. Number of trade mark applications and registrations in Mainland China

	2009	2010	2011	2012	2013
Domestic applications received	741,763	973,460	1,273,827	1,502,540	1,733,361
Domestic registrations	737,228	1,211,428	926,330	919,951	909,541

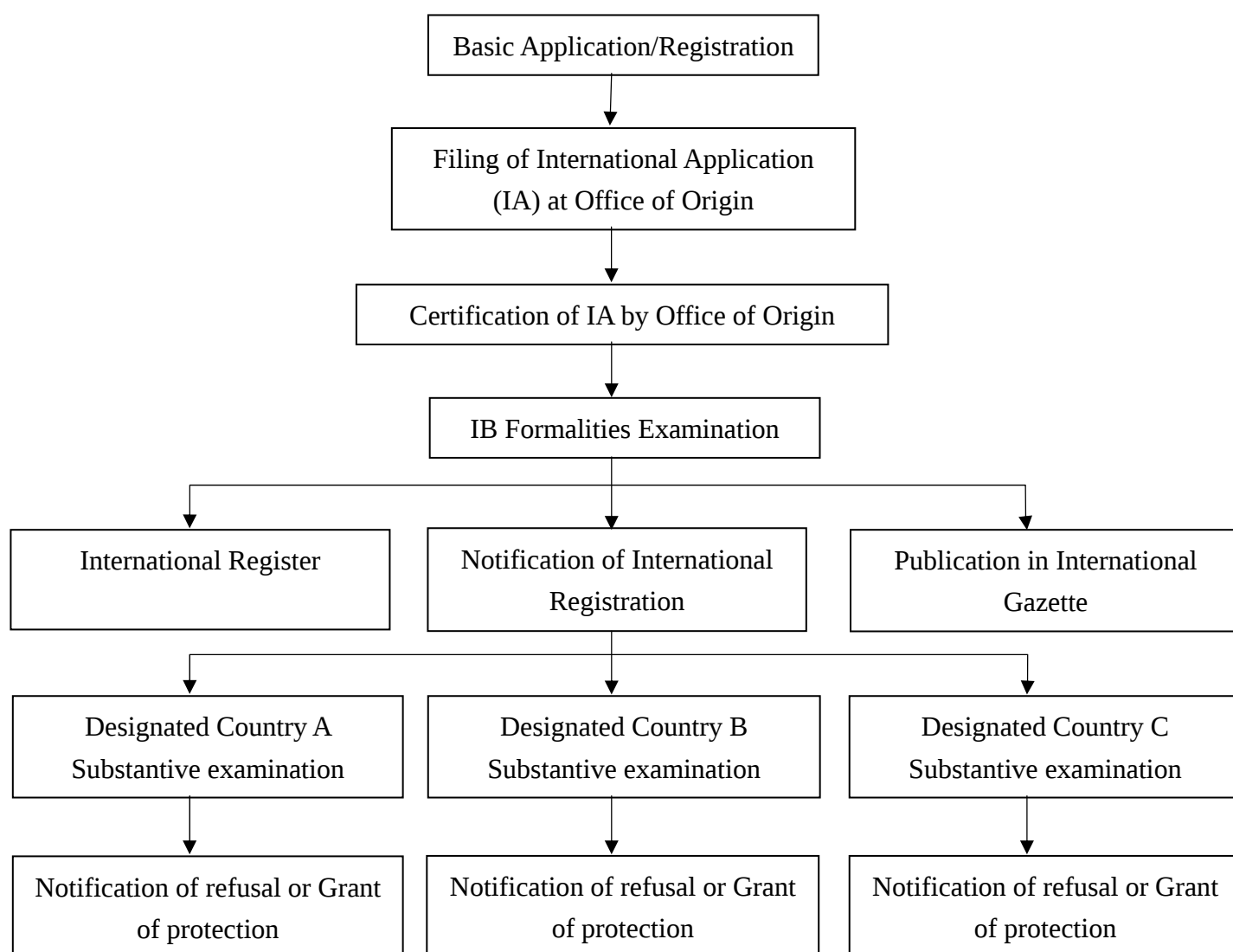
B. Number of trade mark applications and registrations from Hong Kong applicants in Mainland China

	2009	2010	2011	2012	2013
Domestic applications received	21,930	32,515	41,744	53,039	67,889
Domestic registrations	14,175	34,651	28,452	28,680	29,907

Source: Annual Development Reports on China's Trademark Strategy 2009 – 2013, SAIC
<http://www.saic.gov.cn/zwgk/ndbg/201004/P020100426570088955856.pdf>,
<http://www.saic.gov.cn/zwgk/ndbg/201104/P020110421498353114920.pdf>,
<http://www.saic.gov.cn/zwgk/ndbg/201205/P020120507585851695079.pdf>,
<http://www.saic.gov.cn/zwgk/ndbg/201305/P020130503549386295068.pdf>,
<http://www.saic.gov.cn/zwgk/ndbg/201405/P020140506325447493616.pdf>)

⁵⁴ See also Annex 7 for the number of international trade mark registrations designating Mainland China between 2009 and 2013.

Procedures of International Application under the Madrid Protocol



- **Basic Application/Registration**

A basic application or basic registration of a trade mark is a domestic application filed or domestic registration obtained by the owner for his trade mark in a contracting party to the Madrid Protocol in which the owner is qualified to apply for an international application under the Madrid Protocol.⁵⁵

- **International Application**

An international application must be filed on the prescribed form⁵⁶ via the Office of Origin on the basis of a basic application or basic registration⁵⁷ and it must specify the contracting parties (except the Office of Origin) to which the protection is sought.⁵⁸

- **Certification of IA**

The Office of Origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of certification, in the basic application or basic registration.⁵⁹

- **Formalities Check by IB**

The IB will check that the international application complies with the filing requirements of the Madrid Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification,⁶⁰ and that the required fees have been paid.⁶¹ If the IB finds irregularities in the international application, both the applicant and the Office of Origin will be informed and given 3 months to remedy.⁶²

- **Registration, Publication and Notification**

If all the filing requirements are met, the IB shall register the mark in the International Register, notify the international registration to the trade mark office of the designated contracting parties, and publish the international registration in the WIPO Gazette of International Marks.⁶³

⁵⁵ Article 2(1) of the Madrid Protocol

⁵⁶ Article 3(1) of the Madrid Protocol

⁵⁷ Article 2(2) of the Madrid Protocol

⁵⁸ Articles 3*bis* and 3*ter*(1) of the Madrid Protocol

⁵⁹ Article 3(1) of the Madrid Protocol

⁶⁰ Article 3(2) of the Madrid Protocol and rule 9 of the Common Regulations

⁶¹ Rule 10 of the Common Regulations

⁶² Rules 11 to 13 of the Common Regulations

⁶³ Article 3(4) of the Madrid Protocol

- **Substantive Examination**

Substantive examination of the trade mark is handled by the trade mark office of the designated contracting parties in accordance with the respective local laws and procedures, and the office has the right to refuse protection as if the mark had been filed direct with the office concerned.⁶⁴

- **Notification of Refusal or Grant of Protection**

Each contracting party shall notify the IB of its refusal within the time limit specified in the Madrid Protocol.⁶⁵ The IB shall notify the holder of the international registration such refusal and the holder shall have the same remedies as if the mark had been filed direct with the trade mark office concerned.⁶⁶ If no refusal is notified to IB within the prescribed time limit or the refusal notified has been withdrawn subsequently, the mark is protected in the designated contracting party as if it had been registered by the trade mark office of that contracting party.⁶⁷

⁶⁴ Article 5(1) of the Madrid Protocol

⁶⁵ In principle, any refusal must be issued no later than 12 months from the date on which the trade mark office concerned was notified of the designation. However, a contracting party may declare that this period is to be extended to 18 months. Such contracting party may also declare that a refusal based on an opposition may be issued after the expiry of the 18-month period, provided that the trade mark office concerned has, within the 18-month period, notified the IB of this possibility (see Article 5(2) of the Madrid Protocol). At the end of the applicable time limit for refusal, the holder of an international registration is in a position to know whether his mark has been accepted or refused for protection in each of the designated contracting parties, or whether there is still a possibility of refusal on the basis of an opposition in a particular country.

⁶⁶ Article 5(3) of the Madrid Protocol

⁶⁷ Article 4(1)(a) of the Madrid Protocol

5. Madrid Agreement Concerning the International Registration of Marks

Madrid Agreement (Marks) (1891), revised at Brussels (1900), at Washington (1911),
at The Hague (1925), at London (1934), Nice (1957) and at Stockholm (1967), and amended in 1979

and

6. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol (1989), amended in 2006 and in 2007

(Madrid Union)¹

Status on October 15, 2014

State/IGO	Date on which State became party to the Madrid Agreement ²	Date on which State/IGO became party to the Madrid Protocol (1989)
Albania	October 4, 1995	July 30, 2003
Algeria	July 5, 1972	—
Antigua and Barbuda	—	March 17, 2000
Armenia	December 25, 1991	October 19, 2000 ^{6,10}
Australia	—	July 11, 2001 ^{5,6}
Austria	January 1, 1909	April 13, 1999
Azerbaijan	December 25, 1995	April 15, 2007
Bahrain	—	December 15, 2005 ¹⁰
Belarus	December 25, 1991	January 18, 2002 ^{6,10}
Belgium	July 15, 1892 ³	April 1, 1998 ^{5,6}
Bhutan	August 4, 2000	August 4, 2000
Bosnia and Herzegovina	March 1, 1992	January 27, 2009
Botswana	—	December 5, 2006
Bulgaria	August 1, 1985	October 2, 2001 ^{6,10}
China	October 4, 1989 ¹	December 1, 1995 ^{4,5,6}
Colombia	—	August 29, 2012 ^{5,6}
Croatia	October 8, 1991	January 23, 2004
Cuba	December 6, 1989	December 26, 1995
Cyprus	November 4, 2003	November 4, 2003 ⁵
Czech Republic	January 1, 1993	September 25, 1996
Democratic People's Republic of Korea	June 10, 1980	October 3, 1996
Denmark	—	February 13, 1996 ^{5,6,7}
Egypt	July 1, 1952	September 3, 2009
Estonia	—	November 18, 1998 ^{5,6,8}
European Union	—	October 1, 2004 ^{5,10}
Finland	—	April 1, 1996 ^{5,6}
France	July 15, 1892 ⁹	November 7, 1997 ⁹
Georgia	—	August 20, 1998 ^{6,10}
Germany	December 1, 1922	March 20, 1996
Ghana	—	September 16, 2008 ^{5,6}
Greece	—	August 10, 2000 ^{5,6}
Hungary	January 1, 1909	October 3, 1997
Iceland	—	April 15, 1997 ^{6,10}
India	—	July 8, 2013 ^{5,6,8}
Iran (Islamic Republic of)	December 25, 2003	December 25, 2003 ⁵
Ireland	—	October 19, 2001 ^{5,6}
Israel	—	September 1, 2010 ^{5,6}
Italy	October 15, 1894	April 17, 2000 ^{5,6}
Japan	—	March 14, 2000 ^{6,10}
Kazakhstan	December 25, 1991	December 8, 2010
Kenya	June 26, 1998	June 26, 1998 ^{5,6}
Kyrgyzstan	December 25, 1991	June 17, 2004 ⁶
Latvia	January 1, 1993	January 5, 2000
Lesotho	February 12, 1999	February 12, 1999
Liberia	December 25, 1995	December 11, 2009
Liechtenstein	July 14, 1933	March 17, 1998
Lithuania	—	November 15, 1997 ³
Luxembourg	September 1, 1924 ³	April 1, 1998 ^{3,6}
Madagascar	—	April 28, 2008 ¹⁰
Mexico	—	February 19, 2013 ^{6,10}
Monaco	April 29, 1956	September 27, 1996

5. Madrid Agreement Concerning the International Registration of Marks

Madrid Agreement (Marks) (1891), revised at Brussels (1900), at Washington (1911), at The Hague (1925), at London (1934), Nice (1957) and at Stockholm (1967), and amended in 1979

and

6. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol (1989), amended in 2006 and in 2007

(Madrid Union)

(continuation)

State/IGO	Date on which State became party to the Madrid Agreement ²	Date on which State/IGO became party to the Madrid Protocol (1989)
Mongolia	April 21, 1985	June 16, 2001
Montenegro	June 3, 2006	June 3, 2006
Morocco	July 30, 1917	October 8, 1999
Mozambique	October 7, 1998	October 7, 1998
Namibia	June 30, 2004	June 30, 2004 ⁸
Netherlands	March 1, 1893 ^{3,11}	April 1, 1998 ^{3,6,11}
New Zealand	—	December 10, 2012 ^{5,6,12}
Norway	—	March 29, 1996 ^{5,6}
Oman	—	October 16, 2007 ¹⁰
Philippines	—	July 25, 2012 ^{5,6,8}
Poland	March 18, 1991	March 4, 1997 ¹⁰
Portugal	October 31, 1893	March 20, 1997
Republic of Korea	—	April 10, 2003 ^{5,6}
Republic of Moldova	December 25, 1991	December 1, 1997 ⁶
Romania	October 6, 1920	July 28, 1998
Russian Federation	July 1, 1976 ¹³	June 10, 1997
Rwanda	—	August 17, 2013
San Marino	September 25, 1960	September 12, 2007 ^{6,10}
Sao Tome and Principe	—	December 8, 2008
Serbia ¹⁴	April 27, 1992	February 17, 1998
Sierra Leone	June 17, 1997	December 28, 1999
Singapore	—	October 31, 2000 ^{5,6}
Slovakia	January 1, 1993	September 13, 1997 ¹⁰
Slovenia	June 25, 1991	March 12, 1998
Spain	July 15, 1892	December 1, 1995
Sudan	May 16, 1984	February 16, 2010
Swaziland	December 14, 1998	December 14, 1998
Sweden	—	December 1, 1995 ^{5,6}
Switzerland	July 15, 1892	May 1, 1997 ^{6,10}
Syrian Arab Republic	—	August 5, 2004 ⁵
Tajikistan	December 25, 1991	June 30, 2011 ^{6,10}
The former Yugoslav Republic of Macedonia	September 8, 1991	August 30, 2002
Tunisia	—	October 16, 2013 ^{5,6}
Turkey	—	January 1, 1999 ^{5,6,8}
Turkmenistan	—	September 28, 1999 ^{6,10}
Ukraine	December 25, 1991	December 29, 2000 ^{5,6}
United Kingdom	—	December 1, 1995 ^{5,6,15}
United States of America	—	November 2, 2003 ^{5,6}
Uzbekistan	—	December 27, 2006 ^{6,10}
Viet Nam	March 8, 1949	July 11, 2006 ⁶
Zambia	—	November 15, 2001
Total: (92)	(55)	(91)

¹ The Madrid Union is composed of the States party to the Madrid Agreement and the Contracting Parties to the Madrid Protocol.

5. Madrid Agreement Concerning the International Registration of Marks

Madrid Agreement (Marks) (1891), revised at Brussels (1900), at Washington (1911),
at The Hague (1925), at London (1934), Nice (1957) and at Stockholm (1967), and amended in 1979

and

6. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol (1989), amended in 2006 and in 2007

(Madrid Union)

(continuation)

² All the States party to the Madrid Agreement have declared, under Article 3bis of the Nice or Stockholm Act, that the protection arising from international registration shall not extend to them unless the proprietor of the mark so requests.

³ The territories of Belgium, Luxembourg and the Kingdom of the Netherlands in Europe are to be deemed a single country, for the application of the Madrid Agreement as from January 1, 1971, and for the application of the Protocol as from April 1, 1998.

⁴ Not applicable to either Hong Kong, China or Macao, China.

⁵ In accordance with Article 5(2)(b) and (c) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months and that, where a refusal of protection results from an opposition to the granting of protection, such refusal may be notified after the expiry of the 18-month time limit.

⁶ In accordance with Article 8(7)(a) of the Protocol, this Contracting Party has declared that, in connection with each request for territorial extension to it of the protection of an international registration and the renewal of any such international registration, it wants to receive an individual fee, instead of a share in the revenue produced by the supplementary and complementary fee.

⁷ Not applicable to the Faroe Islands but applicable to Greenland as of January 11, 2011.

⁸ In accordance with Article 14(5) of the Protocol, this Contracting Party has declared that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

⁹ Including all Overseas Departments and Territories.

¹⁰ In accordance with Article 5(2)(b) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months.

¹¹ The instrument of ratification of the Stockholm Act and the instrument of acceptance of the Protocol were deposited for the Kingdom in Europe. The Netherlands extended the application of the Madrid Protocol to the Netherlands Antilles with effect from April 28, 2003. The Netherlands Antilles ceased to exist on October 10, 2010. As from that date, the Protocol continues to apply to Curaçao and Sint Maarten. The Protocol also continues to apply to the islands of Bonaire, Sint Eustatius and Saba which, with effect from October 10, 2010, have become part of the territory of the Kingdom of the Netherlands in Europe.

¹² With a declaration that this accession shall not extend to Tokelau unless and until a declaration to this effect is lodged by the Government of New Zealand with the depositary on the basis of appropriate consultation with that territory.

¹³ Date of accession by the Soviet Union, continued by the Russian Federation as from December 25, 1991.

¹⁴ Serbia is the continuing State from Serbia and Montenegro as from June 3, 2006.

¹⁵ Ratification in respect of the United Kingdom and the Isle of Man.

Table 1: International registrations via the Madrid System, 2013

Name	Origin ¹			Designated member	
	Number of registrations	Designations	Subsequent designations	Designations	Subsequent designations
Albania	2	49	-	2,027	480
Algeria	10	55	-	1,268	398
Antigua and Barbuda	-	-	-	588	127
Armenia	33	229	21	2,567	458
Australia	1,173	4,396	648	10,420	1,255
Austria	1,095	6,890	930	2,741	201
Azerbaijan	6	57	10	3,333	659
Barbados (a)	3	54	-	-	-
Bahamas (a)	1	6	2	-	-
Bahrain	-	-	-	1,816	574
Belarus	327	1,710	150	5,330	777
Belgium (b)	720	4,646	763	-	-
Belize (a)	2	14	16	-	-
Benelux Office for Intellectual Property	-	-	-	2,651	247
Bhutan	-	-	-	529	133
Bonaire, Sint Eustatius and Saba	-	-	-	465	92
Bosnia and Herzegovina	12	84	13	3,029	559
Botswana	1	6	-	629	190
Bulgaria	225	2,694	225	1,795	259
Canada (a)	57	314	13	-	-
Chile (a)	1	7	-	-	-
China	2,544	31,176	1,687	18,192	2,083
China, Macao SAR (a)	1	4	13	-	-
Colombia	9	57	-	2,376	910
Croatia	119	591	136	3,728	572
Cuba	2	43	-	1,134	296
Curaçao	4	31	55	493	128
Cyprus	159	2,135	310	830	186
Czech Republic	397	3,899	548	2,004	257
D.P.R. of Korea	1	1	-	899	149
Denmark	524	2,781	835	1,466	248
Dominica (a)	3	172	-	-	-
Dominican Republic (a)	1	4	-	-	-
Egypt	26	281	29	3,712	759
Estonia	84	371	48	1,376	193
European Union	-	-	-	16,660	938
Fiji (a)	4	24	-	-	-
Finland	427	2,139	347	1,324	261
France	3,973	25,269	4,000	3,505	202
Georgia	28	346	20	2,797	525
Germany	6,446	37,423	7,646	4,384	254
Ghana	-	-	7	950	405
Greece	98	652	43	1,400	248
Hungary	267	4,100	152	1,834	208
Iceland	127	763	41	2,051	401
India	12	53	-	1,889	27
Indonesia (a)	2	27	-	-	-
Iran (Islamic Republic of)	23	366	24	2,555	584
Ireland	146	1,647	144	1,118	213
Israel	173	815	38	3,786	947
Italy	2,608	17,363	3,909	3,321	226
Japan	1,917	11,041	1,287	11,813	1,366
Kazakhstan	68	356	2	5,496	952
Kenya	2	10	-	1,430	389
Kuwait	2	8	-	-	-
Kyrgyzstan	2	9	1	2,488	413
Latvia	106	747	19	1,618	228
Lebanon (a)	6	54	9	-	-
Lesotho	-	-	-	542	126
Liberia	-	-	-	658	175
Libya (a)	1	18	-	-	-
Liechtenstein	91	993	42	2,142	299
Lithuania	110	414	80	1,693	240
Luxembourg (b)	325	3,078	321	-	-
Madagascar	3	4	-	727	188
Malaysia (a)	6	53	-	-	-

Malta (c)	39	368	86	-	-
Mauritius (a)	3	69	-	-	-
Mexico	31	242	-	3,760	1,335
Monaco	38	222	30	2,073	302
Mongolia	1	8	-	1,586	364
Montenegro	6	28	-	2,671	541
Morocco	49	160	14	3,268	648
Mozambique	-	-	-	878	283
Namibia	-	-	-	738	172
Netherlands (b)	1,357	6,548	1,639	-	-
New Zealand	237	955	21	3,379	1,105
Nigeria (a)	1	1	-	-	-
Norway	336	1,403	185	7,785	994
Oman	-	-	-	1,766	542
Panama (a)	9	103	9	-	-
Peru (a)	1	11	17	-	-
Philippines	43	290	-	3,121	159
Poland	332	2,461	448	2,646	334
Portugal	250	1,194	299	1,656	216
Republic of Korea	437	3,124	215	9,352	1,615
Republic of Moldova	55	432	39	3,033	565
Romania	98	728	131	1,980	300
Russian Federation	1,035	11,045	1,361	16,532	1,707
Rwanda	-	-	-	48	52
Saint Kitts and Nevis (a)	1	5	1	-	-
Saint Vincent and the Grenadines (a)	2	4	-	-	-
San Marino	13	101	6	947	165
Sao Tome and Principe	-	-	8	442	94
Serbia	144	1,026	165	3,996	667
Seychelles (a)	1	29	-	-	-
Sierra Leone	-	-	-	598	142
Singapore	202	1,259	93	7,354	1,228
Sint Maarten (Dutch Part)	-	-	-	509	112
Slovakia	113	909	72	1,629	232
Slovenia	178	2,321	125	1,480	216
South Africa (a)	-	-	4	-	-
Spain	1,111	5,638	1,512	2,804	261
Sri Lanka (a)	1	12	-	-	-
Sudan	-	-	-	1,020	261
Suriname	1	1	-	-	-
Swaziland	-	-	-	587	147
Sweden	651	3,614	642	1,624	274
Switzerland	3,016	23,076	4,299	12,274	941
Syrian Arab Republic	-	-	-	1,315	321
T F Y R of Macedonia	22	234	18	2,683	527
Tajikistan	-	-	-	2,073	390
Thailand (a)	5	29	6	-	-
Tunisia	-	-	-	63	75
Turkey	1,249	13,744	2,348	8,618	1,220
Turkmenistan	-	-	-	2,151	370
Ukraine	388	2,827	305	8,404	1,185
United Arab Emirates (a)	8	157	12	-	-
United Kingdom	2,395	13,186	2,601	3,756	346
United States of America	5,856	36,129	3,445	15,898	1,424
Uzbekistan	4	119	-	2,366	438
Viet Nam	73	566	31	4,853	1,019
Zambia	-	-	-	751	186
Others	107	1,139	709	-	-
Total	44,414	306,046	45,480	306,046	45,480

Note: Only countries/territories of origin and designated Madrid member countries are listed for which 2013 Madrid System statistics exist.

' - ' = zero or not applicable

¹ Origin is defined as the stated address of residence of the holder of an international registration.

(a) Not a member of the Madrid System as of December 31, 2013. Applicants from this jurisdiction are eligible to file via the Madrid System by claiming commercial activity or domicile in a country, or in the jurisdiction of a regional office, that is a member of the Madrid System. The IP office of the country of origin cannot be designated by an applicant that uses the Madrid System.

(b) IP office is the regional Benelux Office for Intellectual Property (BOIP), which receives designations on behalf of this country.

(c) Member of the Madrid System via membership in the European Union

Source: WIPO Statistics Database, March 2014

**Number of international trade mark registrations designating
Mainland China between 2009 and 2013**

	2009	2010	2011	2012	2013
Regular designations	13,267	14,237	16,584	17,584	18,192
Subsequent designations	1,494	1,906	2,140	2,536	2,083
Total designations	14,761	16,143	18,724	20,120	20,275

Source: WIPO IP Statistics Data Center

**Number of trade mark applications filed by
Hong Kong applicants in Australia, Japan, the EU,
Singapore, the UK and the US**

	2008	2009	2010	2011	2012	2013
Australia	218	221	240	300	318	Not available
Japan	204	162	189	249	262	Not available
EU (Note 1)	476	487	673	718	805	871
Singapore	433	415	513	564	614	856
UK (Note 2)	161	226	110	194	278	571
US	1,211	1,162	1,190	1,492	1,768	1,785

Note 1: The statistics relating to the EU as shown in the table above comprises only of the number of community trade mark applications received by the Office for Harmonization in the Internal Market (OHIM) during the relevant year.

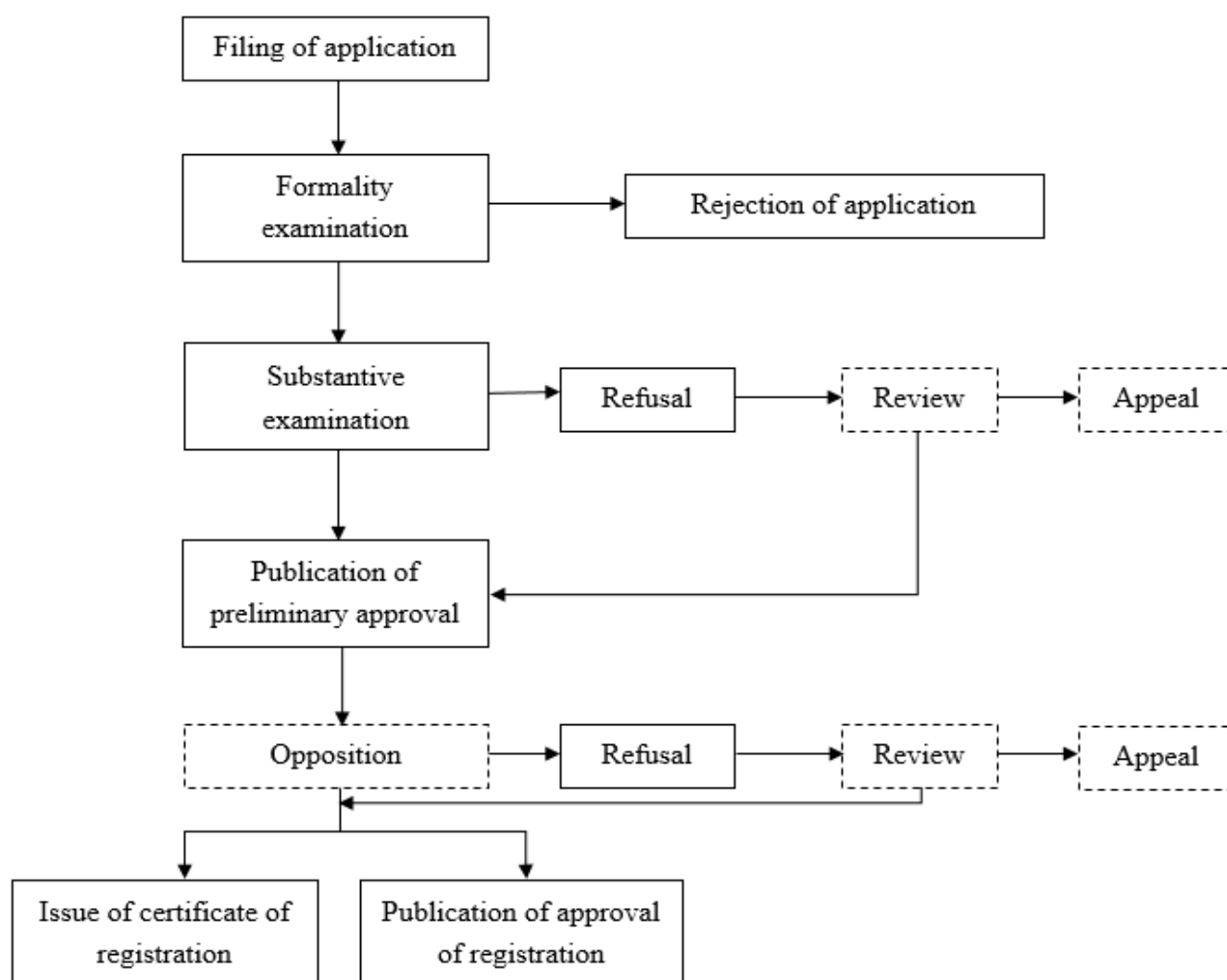
Note 2: According to the statistics from the Intellectual Property Office of the UK, the number of trade marks applied for by Hong Kong applicants in the UK relates to the number of applications filed and the number of additional classes filed during the relevant year.

Sources:

- (1) Trade mark data from IP Australia's database,
<http://www.ipaustralia.gov.au/about-us/what-we-do/ip-statistics/>
- (2) Japan Patent Office (JPO), Annual Report 2009, Part 5—Statistical Data, p.150,
http://www.jpo.go.jp/shiryou_e/toushin_e/kenkyukai_e/pdf/annual_report2009/part5.pdf
- (3) JPO, Annual Report 2010, Part 5—Statistical Data, p.177,
http://www.jpo.go.jp/shiryou_e/toushin_e/kenkyukai_e/pdf/annual_report2010/part5.pdf
- (4) JPO, Annual Report 2012, p.169,
http://www.jpo.go.jp/shiryou_e/toushin_e/kenkyukai_e/pdf/annual_report2012/all.pdf

- (5) JPO, Annual Report 2013, p. 161,
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- (6) OHIM, “SSC003.1-Statistical travel pack by country-the Hong Kong Special Administrative Region of the People’s Republic of China”, p.1/3,
[https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/the_office/statistics_per_country/SSC003.1%20-%20Statistical%20travel%20pack%20by%20country%20\(HK\).pdf](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/the_office/statistics_per_country/SSC003.1%20-%20Statistical%20travel%20pack%20by%20country%20(HK).pdf)
- (7) Intellectual Property Office of Singapore (IPOS), “Statistics 2001-2010”, p. 7,
<http://www.ipos.gov.sg/Portals/0/About%20IP%20%28Statistics%29/IPOSstatistics20012010final1.pdf>
- (8) IPOS, “Statistics 2010-2011”,p. 7,
http://www.ipos.gov.sg/Portals/0/About%20IP%20%28Statistics%29/IPOSStatistics2010_2011_Designs_Patents_TM_HMG_Des.pdf
- (9) IPOS, “Statistics 2011-2012”, p. 8,
[http://www.ipos.gov.sg/Portals/0/About%20IP%20\(Statistics\)/2011-2012_revised.pdf](http://www.ipos.gov.sg/Portals/0/About%20IP%20(Statistics)/2011-2012_revised.pdf)
- (10) IPOS, “Statistics 2012-2013”, p. 7,
[http://www.ipos.gov.sg/Portals/0/About%20IP%20\(Statistics\)/Website%20Stats%202014%20.pdf](http://www.ipos.gov.sg/Portals/0/About%20IP%20(Statistics)/Website%20Stats%202014%20.pdf)
- (11) Intellectual Property Office (UKIPO), “Facts & figures—2008-2009”, p.31,
<http://www.ipo.gov.uk/about-facts0809.pdf>
- (12) UKIPO, “Facts & figures—2009-2010”, p.31, <http://www.ipo.gov.uk/about-facts0910.pdf>
- (13) UKIPO, “Facts & figures—2010-2011”, p.24, <http://www.ipo.gov.uk/about-facts1011.pdf>
- (14) UKIPO, “Facts & figures—2012-2013”, p.32,
https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/318346/Facts_and_Figures.pdf
- (15) United States Patent and Trademark Office (USPTO), “Performance and Accountability Report—Fiscal Year 2012”, p. 195,
<http://www.uspto.gov/about/stratplan/ar/USPTOFY2012PAR.pdf#page=176>
- (16) USPTO, “Performance and Accountability Report—Fiscal Year 2013”, p. 207,
<http://www.uspto.gov/about/stratplan/ar/USPTOFY2013PAR.pdf#page=191>

**Procedures of Application for registration of Trade Marks
in Mainland China**



Application

A Hong Kong applicant may file his trade mark application directly (provided that he has a “habitual residence” or “place of business” in the Mainland) or through a trade mark agent to CTMO⁶⁸ using the specified forms and paying the prescribed fees.⁶⁹

- **Formality Examination**

Upon receipt of the application, the CTMO will conduct formality examination. The applicant is required to make necessary amendments, if any, within 30 days from the date of receiving the notification, or else the application shall not be accepted.⁷⁰ If no amendment is required or the amendments are made within time, it will proceed to the stage of substantive examination.⁷¹

- **Substantive Examination**

The CTMO shall complete its examination of a trade mark within 9 months from the date of receipt of the application.⁷² The CTMO may, in the course of examination, require the applicant to explain or correct the contents of the application and the applicant has 15 days to respond.⁷³ If an application does not meet the registration requirements or is identical or similar to a trade mark which has been registered or preliminarily approved on the same or similar goods, CTMO shall refuse the application.⁷⁴ The CTMO shall notify the applicants in writing of such refusal and the applicant may, within 15 days from the date of receiving the notification, apply to the Trademark Review and Adjudication Board (TRAB) for review.⁷⁵

- **Review**

On a request for review of the CTMO’s refusal, the TRAB shall make a decision within 9 months (an extension of 3 months may be allowed subject to approval)

⁶⁸ Article 18 of the Trade Mark Law of China (TML) and rule 5 of the Implementing Regulations of TML (IR)

⁶⁹ Rule 18 of IR

⁷⁰ Rule 18 of IR

⁷¹ Rule 21 of IR

⁷² Article 28 of TML

⁷³ Article 29 of TML and rule 23 of IR

⁷⁴ Article 30 of TML

⁷⁵ Article 34 of TML

from the date of receipt of the request and notify the applicant in writing. Such decision is subject to appeal to the judicial authorities.⁷⁶

- **Preliminary approval and Publication**

If it appears to the CTMO that the registration requirements are met, the application will be preliminarily approved and published.⁷⁷

- **Opposition**

Anyone may lodge an opposition against a preliminarily approved and published application within 3 months from the date of publication⁷⁸ and the applicant has 30 days to file a reply.⁷⁹ The opponent and the applicant are given 3 months from the date of filing of the documentation of opposition and the reply thereof to file evidence in support of the opposition and application respectively.⁸⁰ The CTMO shall hear the facts and grounds stated by the opponent and the applicant and make its decision, within 12 months (an extension of 6 months may be allowed subject to approval) from the date of publication of the preliminary approval, on whether or not to approve registration and notify the parties the decision in writing. If the opposition succeeds, the applicant may file a request to TRAB within 15 days from the date of receiving the notification of the decision for review of CTMO's decision. The TRAB shall make its review decision within 12 months (an extension of 6 months may be allowed subject to approval) from the date of receipt of the request and notify the parties in writing. Such review decision is subject to appeal to judicial authorities.⁸¹ However, if the opposition fails and CTMO allows the mark to proceed to registration, the opponent may only challenge the registration by filing an application for declaration of invalidity with TRAB and the decision of TRAB is subject to appeal to judicial authorities.⁸²

⁷⁶ Article 34 of TML

⁷⁷ Article 28 of TML

⁷⁸ Article 33 of TML

⁷⁹ Rule 27 of IR

⁸⁰ Rule 27 of IR

⁸¹ Article 35 of TML

⁸² Articles 35, 44 and 45 of TML

- **Registration**

If no opposition is raised, the application shall be approved for registration and the CTMO shall issue a registration certificate for the mark and publish the registration.⁸³ If an opposition is raised and the CTMO makes a decision to approve the registration, it shall issue a registration certificate for the mark and publish the registration.⁸⁴ The registration of the trade mark shall be valid for a period of 10 years from the date on which the application is approved for registration.⁸⁵

⁸³ Article 33 of TML

⁸⁴ Article 35 of TML

⁸⁵ Article 39 of TML

LIST OF ABBREVIATIONS

China	- the People's Republic of China
Common Regulations	- Common Regulations under the Madrid Agreement and the Madrid Protocol
contracting party	- a contracting party to the Madrid Agreement or the Madrid Protocol, or both (depending on the context)
CTMO	- Trademark Office of the SAIC
Designated Office	- the trade mark office of the particular designated contracting party
EU	- the European Union
HKIP Journal	- Hong Kong Intellectual Property Journal
Hong Kong or the HKSAR	- the Hong Kong Special Administrative Region
IA	- International Application
IB	- the International Bureau
IP	- intellectual property
IPOS	- the Intellectual Property Office of Singapore
IPD	- the Intellectual Property Department
IR	- the Implementing Regulations of TML
JPO	- the Japan Patent Office
Madrid Agreement	- Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol	- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
Madrid System	- Madrid system for the international registration of marks
Office of Origin	- The trade mark office of the contracting party to the Madrid Protocol where the basic mark is held and the international application is filed.
OHIM	- the Office for Harmonization in the Internal Market
SAIC	- the State Administration of Industry and Commerce
TML	- Trade Mark Law of China
TMO	- Trade Marks Ordinance
TMR	- Trade Marks Rules
TM Registry	- the Trade Marks Registry
TRAB	- the Trademark Review and Adjudication Board of the SAIC
UK	- the United Kingdom
UKIPO	- The Intellectual Property Office of the UK
US	- the United States
USPTO	- The United States Patent and Trademark Office
WIPO	- the World Intellectual Property Organization