

For Information

Legislative Council Panel on Commerce and Industry

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

Introduction

This paper informs Members of an annual exercise to propose technical amendments to the respective schedules to the Patents Ordinance (Cap. 514) (“PO”), the Registered Designs Ordinance (Cap. 522) (“RDO”), the Trade Marks Ordinance (Cap. 559) (“TMO”) and the Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation (Cap. 445B) (“Integrated Circuits Regulation”). The proposed amendments seek to update these schedules setting out the list of contracting parties to the Paris Convention for the Protection of Industrial Property (“Paris Convention”) and the membership list of the World Trade Organization (“WTO”).

Background

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

3. Under Article 4 of the Paris Convention, the HKSAR is obliged to grant to a person who has filed an application for a patent or for registration of a design or trade mark in a Paris Convention country a right of priority during a prescribed period for the purpose of filing the same application in the HKSAR. Separately, Article 2.1 in Part I of the Agreement on Trade-Related Aspects of Intellectual Property Rights

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

4. We have complied with the above international obligations by making specific provisions in the PO, the RDO and the TMO to the effect that a person who has filed an application in a Paris Convention country or WTO member country, territory or area will enjoy a right of priority when filing the same application in the HKSAR within a prescribed period. We have also set out in a schedule to each of the afore-mentioned Ordinances the lists of Paris Convention countries and WTO member countries, territories or areas. In this regard, the Chief Executive in Council is empowered to amend the relevant schedule to the PO by an order published in the Gazette. In the case of the RDO and the TMO, the Chief Executive in Council may amend the relevant schedules by regulation.

5. Separately, Article 35 in Part II of the TRIPS Agreement requires the HKSAR to grant the same level of intellectual property protection for layout-designs (topographies) of integrated circuits to nationals of other WTO member countries, territories or areas, as to HKSAR residents. To meet this requirement, we have provided in the Layout-design (Topography) of Integrated Circuits Ordinance (Cap. 445) that the said protection will be given to nationals of such qualifying countries, territories or areas as are designated by regulation by the Chief Executive. The Integrated Circuits Regulation, with a schedule setting out those countries, territories or areas that have acceded to the WTO, has been made for this purpose.

Proposed Amendments to the Schedules

6. We have been undertaking annual exercises to update the above-mentioned Schedules to reflect the updated list of contracting parties to the Paris Convention and membership position of WTO. The last round of updates were implemented by Order and Regulations tabled at the Legislative Council on 4 June 2014 for negative vetting. Since then, one more country which is an existing WTO member (i.e. the State of Kuwait) has become a contracting party to the Paris Convention and one more country (i.e. the Republic of Yemen) has become a member of

the WTO. To reflect these changes, we need to amend the respective schedules to the PO, the RDO, the TMO and the Integrated Circuits Regulation.

7. Moreover, the official English name of a member of the WTO (i.e. the Republic of Cabo Verde) has to be updated with reference to the United Nations Multilingual Terminology Database, with a view to achieving consistency in terminology.

8. In addition, a revision to the Chinese heading of the second part of the Schedule to the RDO is required to achieve textual consistency with its corresponding English heading. Details of the proposed amendments are at Annex.

Legislative Timetable

9. We are now drafting the necessary amendment Order and Regulations and plan to table these pieces of subsidiary legislation at the Legislative Council for negative vetting by mid 2015.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
February 2015

Proposed Amendments

I. Patents Ordinance (Cap. 514)

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

(i) To add :

- “The State of Kuwait” (科威特國)

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

(i) To delete :

- “The State of Kuwait” (科威特國)¹

(ii) To replace :

- “The Republic of Cape Verde” by “The Republic of Cabo Verde”

II. Registered Designs Ordinance (Cap. 522)

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

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

II(c) In the Chinese heading of the second part of the Schedule –

(i) To replace :

¹ As the State of Kuwait became a contracting party to the Paris Convention on 2 December 2014, it is necessary to move its name from the list of “WTO member countries, territories and areas (not including Paris Convention countries)” to the list of “Paris Convention countries”.

- “已加入《世界貿易組織協議》的國家、地區或地方(但並不包括已加入《巴黎公約》的國家)” by “已加入《世界貿易組織協議》的國家、地區及地方(但並不包括已加入《巴黎公約》的國家)”.²

III. Trade Marks Ordinance (Cap. 559)

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

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

(i) To add :

- “The Republic of Yemen” (也門共和國)

(ii) To replace :

- “The Republic of Cape Verde” by “The Republic of Cabo Verde”

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

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

² The current English heading of the second part of the Schedule is “Countries, territories **and** areas which have acceded to the World Trade Organization Agreement (not including countries which have acceded to the Paris Convention)”.