

Comparison of the Relevant Provisions in the Trade Marks Ordinance (“TMO”) and the Trade Marks Bill (“The Bill”) with reference to the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”) and the Paris Convention

Introduction

Although Hong Kong, China (“Hong Kong”) is compliant with the TRIPS Agreement, the Bill contains provisions which more precisely reflect what appears in the Agreement as well as the Paris Convention. The following table sets out the major provisions.

Issue	The Bill	TMO	Paris Convention	TRIPS Agreement
Definition of trade mark	Clause 3 defines trade mark as any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically. The requirement that a trade mark has to be visually perceptible has been removed.	Section 2(1) provides that a mark means any sign that is visually perceptible and capable of being represented graphically.		The Bill reflects Article 15(1) .

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Infringement	Clauses 17(1) to (3) set out the exclusive rights given to a registered proprietor to use the trade mark in respect of goods or services. These rights are infringed if someone uses an identical or similar mark in relation to identical or similar goods or services , and that the use of the mark in relation to those goods or services is likely to cause confusion.	The relevant provisions are ss.27, 27A, 28 and 28A. These provisions refer to identical or resembling trade marks in relation to goods in respect of which a mark is registered or goods of the same description.		The Bill reflects Article 16(1).
	Clause 17(4) has specific provision to deal with the use of an identical or similar trade mark in relation to dissimilar goods or services.	There is no specific provision on dissimilar goods or services.		The Bill reflects Article 16(3)
Well-known marks	Clause 61 provides for specific protection of well-known marks.	There is no specific provision on registration of well-known marks.	Article 6 ^{bis} stipulates protection for well-known marks.	Article 16(2) applies Article 6 ^{bis} of the Paris Convention to service marks.

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Revocation for non-use	Clause 50 provides that the period for non-use shall be 3 years for the purpose of revocation.	S.37 enables a trade mark to be removed from the Trade Marks Register if there has been no bona fide use of the trade mark for 5 years or longer.		Article 19(1) provides a minimum of 3 years of non-use for the cancellation of a registered trade mark.
Claim to priority	Clause 39(2)(b) provides that the registrability of a trade mark shall not be affected by any use of the trade mark in Hong Kong in the period between the date of filing of the first Convention application or WTO application and the date of application for registration.	There is no specific provision stating that any subsequent filing of an application should be affected by the use of a mark accomplished in the interval.	The Bill reflects Article 4B	

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	<p>Clauses 39(5) and (6) specifically provide that a subsequent application concerning the same subject as a previous first application shall be considered as the first application for the purpose of determining priority if, at the time of the filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.</p>	<p>There is no specific provision on this point.</p>	<p>The Bill reflects Article 4C(4)</p>	
<p>Armorial bearings, national emblems, flags, etc.</p>	<p>Clauses 62(1) and (2) contain detailed provisions in relation to Article 6^{ter} of the Paris Convention. Clauses 62(1), (2) and (3) prohibit the registration of flags, armorial bearings, state emblems, or official signs of a Paris Convention or WTO member.</p>	<p>The relevant provision is Rule 5. Any attempt to register the items mentioned in Rule 5 as a trade mark (which was not duly authorized) could be opposed on the ground that it was in breach of s.12(1). A mark which had been registered could also be rectified from the register on the ground that</p>	<p>The Bill reflects Article 6^{ter}(1)(a)</p>	

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		it had been wrongly placed on the register (s.48).		
	Clause 63 contains detailed provisions relating to armorial bearings, flags, emblems, etc. of international intergovernmental organizations. It also constitutes an absolute ground for refusal under Clause 10(7).	Reliance could be placed on Rule 5, s.12(1) and s.48 in respect of rectification.	The Bill reflects Article 6 ^{ter} (1)(b)	
	Clause 63(5) provides that the rights of a person whose use in good faith of a trade mark began before the entry into force of the Paris Convention, i.e. 16 November 1977 would not be affected.	The relevant provision is Rule 5 under which the Registrar has a discretion as to whether to intervene.	The Bill reflects Article 6 ^{ter} (1)(c)	
Notification on the list of state emblems, etc.	Clause 64 deals specifically with notification of national emblems etc. of countries and international organizations.	There is no specific reference in the TMO.	The Bill reflects Article 6 ^{ter} (3) to Article 6 ^{ter} (4)	

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Prohibition of unauthorized use in trade of state armorial bearings	Clause 62(6) empowers the relevant authorities to restrain by injunction any unauthorized use of any marks referred to in Clause 62. See also Clause 63(6) in respect of unauthorized use of emblems etc. of international organizations.	There is nothing specific on this in the TMO.	The Bill reflects Article 6 ^{ter} (9)	
Refusal of registration	An application for registration may be refused on relative grounds under Clause 11. This section provides much broader grounds for refusing an application if such would infringe the rights of an earlier unregistered mark.	S.20 deals with conflicts with earlier registered trade marks as a ground for refusing an application. A mark registered in violation of this could be rectified under s.48 as an entry made on the register without sufficient cause.	The Bill reflects Article 6 ^{quinquies} B(1)	
Devoid of distinctive character, etc.	Clauses 10(1)(b), (c) and (d) deal in a more transparent way with Article 6 ^{quinquies} B(2) of the Paris Convention. A mark registered in violation of these clauses may be declared invalid under Clause 51.	Ss. 9(1)(d) and (e) and 10(2) provide that such marks are not regarded as distinctive or capable of distinguishing goods. A mark registered in ss.9 or 10 could be rectified under s.48 as an entry made on the register without sufficient cause.	The Bill reflects Article 6 ^{quinquies} B(2)	

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Morality and public order	A trade mark shall not be registered if it is contrary to accepted principles of morality or is likely to deceive the public as provided for under Clause 10(4).	The relevant section is s.12(1).	The Bill reflects Article 6 ^{quinquies} B(3)	
Collective marks	Clause 59 and Schedule 1 provide specifically for collective marks.	The TMO does not provide for collective marks.	The Bill reflects Article 7 ^{bis}	
Comparative Advertising	Clause 17(7) legitimizes comparative advertising if it is in accordance with honest practices in industrial or commercial matters.	There is no such equivalent provision.	The Bill reflects Article 10 ^{bis}	
Disposal	Clause 23 enables a court to make an order for disposal. Clause 23(4) only permits the removal of a trade mark in certain circumstances.	There is no such relevant provision.	The Bill reflects Article 46	

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