

Letterhead of Legislative Council Secretariat Legal Service Division

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By Fax No. 2869 4420
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Dear Mr. Wong,

Trade Marks Bill

I am scrutinising the legal and drafting aspects of the above Bill with a view to advising Members and should be grateful if you would clarify the following:

1. Clause 2 on the definition of "Paris Convention Country" and Clause 91(a)

Under section 13A(7) of the existing Trade Marks Ordinance (Cap. 43), the Chief Executive may by order published in the gazette add to, delete from or amend the Schedule of the Paris Convention countries. In the definition of "Paris Convention country", "WTO member" and clause 91(a) of this Bill, it is stated that "the Chief Executive in Council may by regulation designate any country, territory or area which has acceded to the Paris Convention or World Trade Organisation Agreement". Can the Chief Executive in Council delete the name of a country, a territory or an area which has denounced and withdrawn from the Convention or WTO? Should the word "amend" be used instead of "designate any country ... which has acceded to the Paris Convention"?

2. Clause 3 - meaning of "trade mark" and clause 36(2)(d)

In the first meeting of the Bills Committee, the Assistant Director of Intellectual Property, Mr. Perera stated that "sound", "smell" and "taste" can be registered as trade marks. How can "smell" and "taste" be represented graphically? In the Chinese version of clause 36(2)(d), "該商標的圖示" (a representation of the trade mark) has to be filed for application of a registration of a trade mark. Should representation include "以書寫方式表述" and not just "圖示"? (See also the definition of trade mark in clause 3.)

3. Clause 4

In the Chinese version of clause 4(1)(c), what does it mean by "在香港設有真實而實際的工業或商業機構"? Should "effective establishment" mean "有效" instead of "實際"?

4. Clause 9(3)

What does the word "organ" intend to cover? Does it cover private organ only? Would this Ordinance apply to state organs and "offices set up in the Hong Kong Special Administrative Region by the Central People's Government" (see G.N. No. 3630 of 1999)? Please elaborate on the intended effect of this provision.

5. Clause 12(1)(b)

The Registrar and the court are given a very wide discretion under this clause. This clause is not found in the U.K. Trade Marks Act 1994. Under what "other circumstances" can the Registrar or the court say that "it is proper for the trade mark to be registered"? Should there be "just and equitable circumstances" and not just "other circumstances"?

6. Clause 39

Will the filing of an application for registration of a trade mark in Hong Kong enjoy the right of priority for a period of 6 months in Mainland of China as in a Paris Convention country? Is there any arrangement between Mainland and Hong Kong on the according of registration of trade mark priority?

7. Clause 69(3)

"Any order made by the Registrar under this section shall, with leave of the court, be enforceable in like manner as an order of the court". According to Rule 16(2), Order 24 of The Rules of the High Court of the High Court Ordinance (Cap. 4 sub. leg.), "if any party against whom an order for discovery or production of documents is made fails to comply with it, then, ... he shall be liable to committal". Can the Registrar commit a person to prison for failing to produce documents? What power in like manner, does the Registrar have to enforce an order made under clause 69(1)?

8. Clause 85(1)

Courts may award costs to any party but "the Registrar shall not be ordered to pay the costs of any other of the parties". Is there any reason for depriving the court's power in awarding costs? Has the judiciary been consulted on this clause?

9. Clause 95(4)

The Chinese version seems to be dissimilar with the English version. This is not a newly drafted clause. Similar clause is found in section 57 of the Securities and Futures Commission Ordinance (Cap. 24). Is there any special reason for departing from the previous version which is easier to understand?

10. Clause 98

The Trade Marks Rules (Cap. 43 sub. leg.) are to be repealed. The new Trade Mark Rules have not been submitted to the Legislative Council for scrutiny. According to Part XI, all subsidiary legislation will be under negative vetting of this Council. Will positive vetting be considered if there are going to be substantial amendments to the Rules? Will there be any substitute provisions for the Trade Marks (Emergency) Ordinance (Cap. 263)?

11. Schedule 4, section 8

In section 9(3) of the Trade Description Ordinance (Cap. 362), there is the reference to "section 27 or 67 of the Trade Marks Ordinance (Cap. 43)". Should this reference be consequentially amended?

12. In the first meeting, Mr. Perera has mentioned "comparative advertising". Which provision in the Bill refers to this "comparative advertising"?

The above are some of the points noted. I would be much appreciated if you could let me have your reply in both Chinese and English at your earliest convenience.

Yours sincerely,

(Anita Ho)
Assistant Legal Adviser

c.c. D of J (Attn: Mr. Jeffrey E Gunter, SALD and Ms Phyllis Poon, GC)

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