

**Comparison of Other Changes between the Trade Marks Ordinance (Cap.43)(“TMO”)
and the Trade Marks Bill (“The Bill”)**

TMO	The Bill	Observations/Remarks by the Assistant Legal Advisor to the Legislative Council	Government’s Responses
1. Section 2 (Interpretation)	Clause 2	Some definitions such as “assignment”, “registered user”, “seal” and “tribunal” are not reproduced in the Bill whilst some new definitions such as “corporation”, “infringement proceedings”, “Paris Convention country” and “WTO member” are added.	<p>“Assignment” — The definition may be useful in Cap.43 which contains provisions referring to parties or persons concerned in assignments. However, there are no such provisions in the Bill .</p> <p>“Registered user” — this has been replaced by “licensee” and “exclusive licensee”.</p> <p>“Seal” — There is no definition for a “seal” in either the Patents Ordinance or the Registered Designs Ordinance. In any case, the definition in Cap.43 only describes the place where the Registrar’s seal is kept, i.e. the Registry.</p> <p>“Tribunal” — There is no need for this definition as it is not used in the Bill.</p> <p>“Corporation” — The term has been inserted in the Bill for clarity.</p> <p>“Infringement proceedings” — inserted for clarity</p> <p>“Paris Convention country” and “WTO member” — necessitated by Clause 39.</p>

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2. Section 3 (Register of trade mark)	Clause 65 (Register to be kept)	<ul style="list-style-type: none"> ● Similar. ● cf. section 63 of the UK Trade Marks Act 1994 (“the UK Act”). 	Noted.
3. Section 5 (Trust not be entered in register)	Clause 28 (Trust and equities)	Clause 28(3) is added and not found in section 26 of the UK Act.	Clause 28(3) is added for greater clarity; to remove doubt whether or not a trustee can register a trade mark or registrable transaction.
4. Section 6 (Inspection of register)	Clause 66 (Right to inspect the register)	Substantially similar.	Noted.
5. Section 7 (Copies and extracts from register)	Clause 67 (Right to copies of entries)	<ul style="list-style-type: none"> ● Similar. ● Definition of “certified copy” in section 7(3) is omitted in the Bill. 	A definition of “certified copy” is set out in clause 78(5) of the Bill. This is similar to the one in section 7(3) of Cap.43
6. Section 8 (Trade Mark must be for particular goods or services)		Not reproduced in the Bill	Section 8 of TMO is implicit in Clause 36(2)(c) and Clause 45.
7. Section 11 (Coloured trade marks)		Not reproduced in the Bill.	This will be taken up in the Rules.

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8. Section 13 (Application for registration)	Clause 36 (Application for registration)	<ul style="list-style-type: none"> ● TMO provides for registration in Part A or Part B of the register which is no longer applicable in the Bill. ● Provision on appeal for non-registration is not reproduced in the Bill. ● Clause 36 is similar to section 32 of the UK Act except Clauses 36(2)(e) and (4). Clause 36(4) states that the application shall be filed in <u>one</u> of the official languages. 	<ul style="list-style-type: none"> ● Clause 83 provides for an appeal to the court from any order or decision of the Registrar. ● Clause 36(2)(e) is to cater for flexibility. ● Clause 36(4) is necessary as HKSAR now has 2 official languages.
9.	Clause 37 (Filing date)	New clause similar to section 33 of UK Act.	Noted.
10.	Clause 38 (Classification of goods and services)	New clause similar to section 34 of the UK Act.	Noted.
11. Section 13A (Priority for application made in Convention country)	Clause 39 (Claim to priority)	Clause similar to section 36 of the UK Act except Clause 39(9) wherein the definitions of “Convention application” and “WTO application” are added.	<ul style="list-style-type: none"> ● Clause 39 simplifies the structure in section 13A of TMO. ● Definitions of “Convention application” and “WTO application” have been added for clarity.
12.	Clause 40 (Examination of application)	Similar to section 37 of the UK Act except the proviso in Clauses 40(5) and (6).	Clauses 40(5) and (6) have been added to empower the Registrar to withdraw acceptance if decision was made in error. It reflects section 17(1) of TMO.

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13. Section 14 (Advertisement of application)	Clause 41 (Publication of particulars of application)	<ul style="list-style-type: none"> ● Wording different with TMO and Clause 38 of the UK Act. ● Particulars of application shall be published in the official journal. 	This provides flexibility in the event of, for example, outsourcing of publications regarding the applications.
14. Section 15 (Opposition of registration)	Clause 42 (Opposition proceedings)	<ul style="list-style-type: none"> ● Clause similar to section 38 of the UK Act except that there is a procedure of making observation by any person of an application in section 38(3) of the UK Act. ● The opposition procedure provided in section 15 has not been reproduced in the Bill. 	<ul style="list-style-type: none"> ● Section 38(3) of the UK Act has not been reproduced. ● Opposition procedures will be laid out in the Rules.
15. Section 17(4) (failure to complete Registration)		<ul style="list-style-type: none"> ● If an applicant fails to have a trade mark registered within 12 months, the Registrar may treat the application as abandoned. ● Not reproduced in the Bill. 	<ul style="list-style-type: none"> ● The Draft Rules will deal with what happens if an applicant fails to publish an application which has been approved.
16. Section 18 (Application to be assigned to corporation to be constituted)		Not reproduced in the Bill.	<ul style="list-style-type: none"> ● This is considered unnecessary. ● An applicant simply needs to comply with Clause 36(3). Anything else is a matter for the applicant.
17. Section 22 (Concurrent use)	Clause 12 (Honest concurrent use)	<ul style="list-style-type: none"> ● Wording different. ● cf. section 7 of the UK Act. 	The contents are substantially similar.

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18. Section 23 (Protection of marks registered in countries of origin)		Not reproduced in the Bill.	<ul style="list-style-type: none"> ● Section 23 is not reproduced as it is considered to be too wide. ● Anyone aggrieved by the proposed registration may resort to opposition.
19. Section 25 (Combined trade mark)		Not reproduced in the Bill.	Section 25 is not reproduced as it reflects something that is self-evident.
20. Section 29 (Registration to be prima facie evidence of validity)	Clause 78 (Register is prima facie evidence)	Similar.	Noted.
21. Section 30 (Registration in Part A to be conclusive as to validity after 7 years)		Not reproduced in the Bill.	Removed on account of abolition of Parts A & B.
22. Section 31 (Equities in respect of trade mark)	Clause 28(2)	Similar.	Noted.

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23. Section 32 (Infringement by breach of certain restrictions)		Not reproduced in the Bill.	This is primarily a matter of contract between the trade mark owner and user.
24. Section 33 (Saving for vested rights)		Not reproduced in the Bill.	This is covered by Clause 18(4).
25. Section 34 (Saving for use of name, address or description of goods or services)		Not reproduced in the Bill.	This is covered by Clause 18(3).
26. Section 35 (No action for infringement of unregistered trade mark)		Not reproduced in the Bill.	This is taken up in Clause 9(4).
27. Section 36 (“Passing off” action)		Not reproduced in the Bill.	See Clause 9(4) which states that nothing in the Ordinance affects the law relating to passing off.

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28. Section 37 (Removal from register on ground of non-use)	Clause 50 (Revocation of registration)	<ul style="list-style-type: none"> ● In section 37, registration of trade mark can be removed if there is no bona fide use of trade mark for 5 years. ● In the Bill, if trade mark is not put to genuine use in Hong Kong by the owner for 3 years and there is no valid reason for non-use, registration can be removed. ● cf. Section 46 of the UK Act, 5 years. ● Clause 50(2)(e) and (8) are not found in the UK Act. ● Proviso in section 46(3) of the UK Act is not reproduced in the Bill. 	<ul style="list-style-type: none"> ● Choice of 3 years is the result of wording in Article 19(1) TRIPS. ● Clause 50(2)(e) i.e. contravention of condition entered in register, is a ground for revocation. The UK has not retained conditions. ● Clause 50(8) makes it clear that services provided outside HK can constitute use of trade mark in HK for revocation purposes. (cf. section 39 (1A) of TMO) ● See Clause 50(5) which mirrors section 46(3) of the UK Act.
29.	Clause 51 (Declaration of invalidity of registration)	<ul style="list-style-type: none"> ● Clause 51(7) is new, not found in section 47 of the UK Act. 	There can be no declaration of invalidity if a mark has been registered on the basis of honest concurrent use. There may be a gap in the UK law.

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30. Sections 38 – 40 (Use and non-use of trade marks)		Not reproduced in the Bill.	<ul style="list-style-type: none"> ● Section 38 is not reproduced as there will not be any more associated marks. ● Section 39 is covered by Clause 50(8). ● Section 40 is removed because the idea of connection in the course of trade (see definition of trade mark in section 2 of TMO) is not reproduced in the new law.
31. Section 45 (Renewal of registration)	Clause 48 (Renewal of registration)	<ul style="list-style-type: none"> ● Wordings different. ● cf. section 43 of the UK Act. 	Wording is revised for clarity. (cf. UK section 43). The UK format is preferred.
32. Section 46 (Procedure on expiry of period of registration)		Not reproduced in the Bill.	Reproduced in Clauses 48(2), (5) and (6).
33. Section 47 (Status of unrenewed trade mark)		Not reproduced in the Bill.	Where a mark is not renewed, it is removed from the Register and not cited.

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34. Section 48 (General power to rectify entries in register)	Clause 55(1) (Rectification or correction)	<ul style="list-style-type: none"> ● In TMO, any person aggrieved by the error or omission in the register may apply to the court or the Registrar to rectify the register. ● In the Bill, any person having a sufficient interest may apply for rectification. ● cf. section 64 of the UK Act. 	Noted.
35. Section 49 (Power to expunge or vary registration for breach of condition)		Reproduced in Clause 50(2)(e) (Revocation of registration) and Clause 52 (Variation of registration).	Noted.
36. Section 50 (Correction of register)	Clause 55 (Rectification or correction)	<ul style="list-style-type: none"> ● Clause 55(6) is new and enables the Registrar to correct any error made by him in any entry in the register. ● Not found in the UK Act. 	To allow for flexibility.
37. Section 51 (Alteration of registered trade mark)	Clause 53 (Alteration of registered trade mark)	<ul style="list-style-type: none"> ● Wording different. ● cf. section 64 of the UK Act. 	<ul style="list-style-type: none"> ● Alteration of registered trade mark is provided for in section 44 (and not section 64) of the UK Act. ● The intention is to cut down the instances when a mark can be altered.

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38. Sections 52 and 52A (Words used as name or description of an article or an activity)		Not reproduced in the Bill.	This is a matter that can be dealt with under Clause 50(2)(c) of the Bill.
39.	Clause 54 (Surrender of registered trade mark)	New.	<ul style="list-style-type: none"> ● This is not new. Section 50(1)(c) and (d) of TMO empowers the Registrar, upon the request from the registered proprietor, to cancel the entry of a trade mark on the register or to strike out any goods or services from those in respect of which a trade mark is registered. ● cf. section 45 of UK Act, which covers substantially the same issue.
40. Section 53 (Removal of trade mark from register on proof of prior registration in country of origin)		Not reproduced in the Bill.	See comments at item. 18 in respect of section 23, <i>supra</i> .

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41. Section 54 (Adaptation of entries in register to amended classification of goods)	Clause 56 (Amendment of entries to accord with new classification)	Wording mainly from section 65 of the UK Act.	Noted.
42.	Clause 57 (Effect of acquiescence)	cf. section 48 of the UK Act.	Noted.
43. Section 58 – 63 (Registered users)		Not reproduced in the Bill.	Provisions for licensees can be found in Clauses 31 and 32.
44.	Clause 59 and Schedule 1 (Collective mark)	cf. section 49 of the UK Act.	Noted.
45. Section 64 – 72 (Certification trade marks)	Clause 60 – Schedule 2 (Certification marks)	cf. section 50 of the UK Act.	Noted.
46.	Clauses 61 – 64 (Paris Convention and World Trade Organization Agreement)	cf. sections 50 -59 of the UK Act.	<ul style="list-style-type: none"> ● To give effect to Article <i>6bis</i> and Article <i>6ter</i> of the Paris Convention. ● See sections 55 to 59 of UK Act.

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47. Section 73 (Preliminary advice by Registrar)	Clause 70 (Power to give preliminary advice, etc.)	Substantially similar.	Noted.
48. Section 73 (Powers and duties of Registrar)	Clause 68 (Exercise of Registrar's discretionary powers)	Wordings different.	Section 74 (and not 73) and Clause 68 are substantially similar.
49.	Clause 69 (Registrar's powers in proceedings before the Registrar)	New.	This expands on section 83 of TMO.
50.	Clause 71 (Power to specify official journal, etc.)	New.	cf. item 13, <i>supra</i> .
51.	Clause 72 (Power to require use of forms)	<ul style="list-style-type: none"> ● New. ● cf. section 66 of the UK Act. ● The Registrar may require the use of forms by notice published in the official journal. ● These notices are not subsidiary legislation and they are not subject to vetting of the Legislative Council. 	Noted.

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52.	Clause 73 (Information about applications and registered trade marks)	<ul style="list-style-type: none"> ● New. ● cf. section 67 of the UK Act. 	Noted.
53.	Clause 74 (Immunity of Registrar as regards official acts)	<ul style="list-style-type: none"> ● New. ● cf. section 70 of the UK Act. 	Registrar is nevertheless bound by the principles of natural justice to act fairly, reasonably and judicially.
54.	Clause 75 (Language of proceedings before Registrar)	New.	To accommodate bilingual official languages.
55. Section 75 (Certificate of validity)	Clause 80 (Certificate of validity of contested registration)	cf. section 73 of the UK Act with some minor differences.	Noted.
56. Section 76 (Trade usage, etc. to be considered)		Not reproduced in the Bill.	Not considered necessary to reproduce section 76.
57. Section 77 (Registrar's appearance in proceedings involving rectification)	Clause 82 (Registrar's appearance in proceedings involving the register)	<ul style="list-style-type: none"> ● cf. section 74 of the UK Act. ● Section 74(3) is not reproduced in the Bill. 	Delegation is covered by section 5 of DIP Ordinance (Cap.412) and section 44 of Cap.1.

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58. Section 78 (Appeal from Registrar)	Clause 83 (Appeals from decisions or orders of Registrar)	<ul style="list-style-type: none"> ● cf. section 76 of the UK Act. ● In UK, any appeal may be brought to an appointed person or to the court. ● In HK, any appeal that lies to the court shall be heard in public. 	There is no concept of an appointed person in HK.
59. Section 79 (Appeal to Court of Appeal)		Not reproduced in the Bill.	<ul style="list-style-type: none"> ● Clause 83(1) deals with appeals to the court. "Court" is defined in Clause 2 as Court of First Instance. (Any further appeals will be dealt with under the Rules of the High Court.) ● Section 79(2) is covered by Clause 84.
60.	Clause 84 (General powers of court)	New.	See comment on item 59, <i>supra</i> .
61. Section 80 (Procedure in case of option to apply to Court or Registrar)	Clause 76 (Procedure in case of option to apply to court or Registrar)	Clause 76(2) is newly added.	Clause 76(2) puts the position beyond doubt.
62.	Clause 77 (Application of rules of evidence)	New.	This Clause is designed to nullify the effect of St. Trudo's case (1995) FSR 345.

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63.	Clause 81 (burden in civil proceedings of proving use of trade mark)	New.	The owner is the best person to prove whether a mark has been used.
64. Section 81 (Costs of proceedings before the Court)	Clause 85 (costs of proceedings before court)	Clause 85(2) and (3) are newly added.	<ul style="list-style-type: none"> ● Clauses 85(2) and 85(3) are added for clarity. ● Clause 85(3) defines “any other of the parties” referred to in section 85(1).
65. Section 82 (Costs of proceedings before the Registrar)	Clause 86 (Costs of proceedings before Registrar)	<ul style="list-style-type: none"> ● cf. section 68 of the UK Act. ● Clause 86(2) and (3) are new. 	<ul style="list-style-type: none"> ● Clause 86(2) of the Bill is not new. It is similar to section 82 TMO. ● Clause 86(3) expands on section 15(10) of the TMO as it applies to <u>any</u> proceedings before the Registrar.
66. Section 83 – 85 (Evidence)		Not reproduced in the Bill.	Clauses 69(1)(a) and (b) relate to the attendance of witnesses and evidence on oath.

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67. Section 86 (Falsification of entries in register)	Clause 92 (Falsification of the register)	<ul style="list-style-type: none"> ● In TMO, any person who makes a false entry in the register commits an offence and is liable on conviction upon indictment to a fine of \$50,000 and to imprisonment for 7 years. ● In the Bill, <ul style="list-style-type: none"> (a) on summary conviction, to a fine at level 5 and to imprisonment for 6 months; and (b) on conviction on indictment, to a fine at level 5 and to imprisonment for 2 years. 	cf. section 94 of UK Act 1994.
68. Section 87 (Falsely representing a trade mark as registered, etc.)	Clause 93 (Falsely representing trade mark as registered)	<ul style="list-style-type: none"> ● In TMO, the fine is \$500. ● In the Bill, any person is liable on conviction to a fine at level 3 (i.e. \$5,001 to \$10,000). 	The penalty level has been updated to a more reasonable level.
69.	Clause 94 (Misuse of title "Trade Marks Registry")	<ul style="list-style-type: none"> ● New. ● Any person who uses in his place of business the words "Trade Marks Registry" commits an offence and is liable on summary conviction to a fine at level 4. 	A new offence is created to cater for misuse of the title "Trade Marks Registry".

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70. Section 88 (Restraint of use of Royal Arms)		<ul style="list-style-type: none"> ● Not reproduced in the Bill. 	Not necessary any more.
71.	Clause 95 (Offences committed by and proceedings relating to corporations)	New.	cf. sections 101(2) and (5) of UK Act 1994.
72.	Clause 96 (Transitional matters, etc.)	<ul style="list-style-type: none"> ● New. ● Chief Executive in Council may make regulations for transitional or savings matters. ● Provisions of Schedule 3 shall prevail over any regulations made under this section in the event of an inconsistency. 	There are necessary to provide for the transition from the TMO to the new trade marks law.
73.	Clause 97 (Consequential amendments)	See Schedule 4.	
74.	Clause 98 (Repeals)	Trade Marks Ordinance (Cap. 43) and its Rules are to be repealed.	

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75. Section 89 (Recognition of agents)	Clause 87 (Recognition of agents)	<ul style="list-style-type: none"> ● Clause 87(1) specifies that an agent can be authorized orally. ● Clause 87(2) and (3) are new. ● cf. section 82 of the UK Act. ● In UK, a register of agents will be kept (section 83 of the UK Act.) 	<ul style="list-style-type: none"> ● Modernises and expands on wording of section 89 TMO. ● No register of agents is provided for as no system has yet been established to determine qualification for trade mark agents, nor has the merit of such a register been finally established.
76.	Clause 89 (Government's right to sell forfeited articles)	New.	Noted.
77. Section 90 (Power of Chief Executive in Council to make rules)	Clause 90 (Rules)	<ul style="list-style-type: none"> ● The Registrar may make rules. ● These rules are more detailed. ● Rules prescribing fees shall be made with the consent of the Financial Secretary and may be fixed at levels that provide for the recovery of expenditure incurred. 	Noted.
78.	Clause 91 (Regulations)	The Chief Executive in Council may by regulation designate any country which has acceded to the Paris Convention or WTO Agreement and amend Schedule 1 and 2.	Noted.

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79. Section 90A (Hours of business and excluded days)	Clause 88 (Hours of business and business days)	Wording from section 80 of the UK Act.	Noted.
80.	Schedule 3 (Transitional Matters)	<ul style="list-style-type: none"> ● 19 provisions on transitional matters. ● Existing registered marks shall be deemed to be transferred on the commencement date to the new register. ● Associated marks shall cease to have effect. 	Noted.
81.	Schedule 4 (Consequential and related amendments)	<ul style="list-style-type: none"> ● Definition of “trade mark” is amended in Trade Descriptions Ordinance (Cap. 362). Section 9A is added. This creates a new offence in respect of certain goods and articles made outside Hong Kong. ● Any person who forges trade marks, imports or exports goods with forged trade mark, makes any die for the purpose of forging trade mark etc. commits an offence and is liable or conviction on indictment to a fine of \$500,000 and to imprisonment for 8 years. (In TMO, the imprisonment term used to be 5 years.) 	Updated penalty levels more in keeping with present day circumstances.

Trade and Industry Bureau

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