

## **Bills Committee on Trade Marks Bill**

### **Issues raised during clause-by-clause examination of the Bill (as at 17 April 2000)**

<b>Clause</b>	<b>Issues</b>	<b>Position</b>
	<u>The Administration is requested -</u>	
4	to provide the proposed amendments to clause 4 on the definition of well-known marks;	Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
(9)3	to review the drafting of clause 9(3). Members note with concern that the Bill intends to bind the Government but the present drafting of clause 9(3) may not be the best way to achieve the intended purpose;	Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
-	to clarify whether presumption of registration has ever been intended by the Bill. The submissions of both International Trademark Association and Deacons Graham & James seem to suggest that there is a right to registration;	Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
10(3) & (3)(c)	to elaborate on the rationale for the policy of disallowing the registration of a sign as a trade mark if it consists exclusively of shape under clause 10(3) and to give some examples under clause 10(3)(c);	Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
10(4)(a)	to consider adding the concept of "public order" as a ground for refusing registration under clause 10(4)(a);	Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
11(8)	to provide CSA to stipulate that the Registrar could not refuse registration where the owner of an earlier trade mark consents to the registration;	

- 17(4)(b) to consider refining clause 17(4)(b) in the light of a proposed definition of a well-known mark;
- 17(7) to consider including express reference to comparative advertising in clause 17(7) and improving the drafting of the last two phrases (" if the use is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark");
- 18(3)(a) to review the need to exempt the use of a registered trade mark by a person of the name of his predecessors in business;
- to advise the extent of the problem in respect of the use of inconsistent terms in the Trade Marks Bill and the Trade Descriptions Ordinance (Cap. 362); Administration's response at LC Paper No. CB(1)1193/99-00(03) (discussed).
  - to consider incorporating all criminal trade mark offences in the Trade Descriptions Ordinance in the Trade Marks Ordinance at appropriate time in future so that the Trade Marks Ordinance shall be self-contained; Administration noted the request.
- 19 to provide an explanatory note on Lanham Act in relation to parallel importation; Administration's response at LC Paper No. CB(1)1391/99-00(02) (discussed).
- 19 to clarify the legal liability for breaching the various laws governing safety and other requirements in respect of different types of consumer goods. Members are concerned who will be held legally responsible for contravening the statutory requirements - manufacturers, importers, distributors, or retailers; Administration's response at LC Paper No. CB(1)1370/99-00(02) (discussed).
- 19 to respond to the suggestion of the Bills Committee to incorporate a requirement to label the name and address of the importer of goods in clause 19;

- 20 to 23 to explain the reasons for the different treatment between the various intellectual property laws regarding the jurisdiction of the District Court in handling intellectual property proceedings and to advise whether the opinion of the Secretary for Justice on the matter could be released;
- 24 to review the scope of application of clause 24. Members are concerned that proceedings for relief from groundless threats of infringement proceedings could be instituted against principals and trade mark agents alike. The Administration is requested to provide the relief for groundless threats provisions in the trade marks laws in the United Kingdom, Australia, Singapore and Ireland and explain with examples as to how often these provisions have been invoked; Administration's response at LC Paper No. CB(1)1327/99-00(02) (to be discussed).
- 27(4) to clarify the meaning of ownership of a registered trade mark in the Bill. Members have pointed out the ambiguity on the meaning of an owner of a mark under clause 2 and clause 27(4). They are concerned whether registration of a transaction constitutes ownership and about the remedy available to an assignee for infringement of the mark occurring in the interim period after the date of transaction and before the registration of the mark with the Registrar of Trade Marks;
- 37 & 40(3) to provide the Committee Stage amendments to clause 37 and clause 40(3) in due course;
- 40 to make a comparison between the existing and the proposed new regimes in respect of time limits and extensions of time in relation to application for trade mark registration under both the primary and the subsidiary legislation; Administration's response at LC Paper No. CB(1)1370/99-00(05) (to be discussed).

- 40(4) to put it beyond doubt that "specified period" in clause 40(4) includes extensions of time approved by the Registrar;
- 48(7) to replace "復" with "復" in clause 48(7) by way of Committee Stage amendment;
- 50(2)(a) to review the appropriateness of the words "genuine use" in clause 50(2)(a) and to provide case law on their meaning. Members are concerned whether the present wording of the clause would leave room for debate; Administration's response at LC Paper No. CB(1)1370/99-00(06) (to be discussed).
- 50(2)(a) & (b) to merge clauses 50(2)(a) and 50(b);
- 50(2)(c) to expand clause 50(2)(c) to cover trade marks which may not be a name;
- 51(3) to replace "已" with "以" in clause 51(3) by way of Committee Stage amendment;
- 53 to advise overseas practices concerning alteration of registered trade marks and to explain with examples how section 51(1) of the Trade Marks Ordinance operates in this respect; Administration's response at LC Paper No. CB(1)1391/99-00(03) (to be discussed).
- 55(6) & 74 to clarify government's liability in law in connection with clauses 55(6) and 74;
- 67 & 78 to clarify whether the term "certified copy" in clauses 67 and 78 has different meanings and to consider the need to include the term under the interpretation clause;
- 69 to review the drafting of clause 69 as it is not entirely clear as to whether the parties to proceedings before the Registrar have the authority to call witnesses;
- 74 to review the need for clause 74. Members are concerned whether an express provision is necessary if there is

already a general provision to immune public officers from incurring any liability in exercise of statutory duties. The Administration is requested to give justifications for subclause (a);

- 81 to consider adding "licensee" in clause 81 so that the burden of proving use of the registered trade mark in proceedings would rest with the owner or the licensee. The present drafting of the clause does not seem to allow the licensee to show use of the mark. The Administration is requested to explain with examples on how members' concern could be addressed if it considers it inappropriate to make the proposed change;
- 85(1) to advise how costs of proceedings relating to trade marks are dealt with at present;
- 91(a) to review the drafting of clause 91(a). Members are concerned that the present drafting cannot address cases where a country or area has acceded to but later has renounced the Paris Convention or the World Trade Organization Agreement; Administration's response at LC Paper No. CB(1)962/99-00 (discussed).
- to provide a paper to explain whether the Trade Marks Bill has any relevance to the registration or protection of Internet domain names; Administration's response at LC Paper No. CB(1)1099/99-00 (discussed).
- Para. 3(1) in Schedule 3 to confirm whether it is the general rule that proceedings instituted before the commencement of a new law will be dealt with under the old law both procedurally and substantively; and
- Paras. 7, 8 & 11 in Schedule 4 to review whether it is appropriate to deal with paragraphs 7, 8 and 11 in Schedule 4 in the context of the Bill. Members are concerned that the said paragraphs are not textual in nature or consequential amendments to the Bill.