

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

### **Issues raised during clause-by-clause examination of the Bill (as at 21 February 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 (to be 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 (to be 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 (to be 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 (to be 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 (to be 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);
  - 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;
- 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.

- 27 to review the propriety of depriving the right of an assignee in seeking damages from the assignor for infringement of the trade mark occurring during the interim period after the date of transaction and before the registration of the transaction with the Registrar of Trade Marks;
- 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; and Administration's response at LC Paper No. CB(1)962/99-00 (to be discussed).
- To provide a paper to explain whether the Trade Marks Bill has any relevance to the registration or protection of domain names. If the Bill is considered not the proper context to tackle the issue, the Administration is requested to advise where and how it should or could be addressed.