

TRADE MARKS BILL

**COMMITTEE STAGE**

Draft Amendments to be moved by the Secretary for Trade and  
Industry

| <u>Clause</u> | <u>Amendment Proposed</u>  |
|---------------|--|
| Long title    | By deleting "Amend and consolidate the law relating to" and substituting "Make new provision in respect of".   |
| 2(1)          | (a) By deleting the definition of "Paris Convention country" and substituting -<br>"Paris Convention country" (巴黎公約國)<br>means -<br>(a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;<br>(b) any territory or area subject to the authority or under the suzerainty of any country referred |

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to in paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;".

(b) In the definition of "WTO member", by deleting "designated by regulation made under section 91 (regulations) as" and substituting "for the time being specified in Schedule 1 as being".

(c) By adding -

"certified" (核証), in relation to a copy or extract, means certified by the Registrar and sealed with the seal of the Registrar;".

3(2) By deleting "numerals, figurative elements, the shape of goods or their packaging, a combination of colours" and substituting "characters, numerals, figurative elements, colours, sounds, smells, the shape of goods or their packaging".

4 (a) In subclause (1), by deleting "well-known" and substituting "well known".

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|               | (b) By adding -<br>"(1A) In determining for the purposes of subsection (1) whether a trade mark is well known in Hong Kong, the Registrar or the court shall have regard to Schedule 2.".  |
| New           | By adding, before Part II -<br>" <b>8A. Ordinance binds Government</b><br>This Ordinance binds the Government.".   |
| 9(3)          | (a) By deleting the clause.  |
| 11            | (a) In subclause (4), by deleting "has a reputation in Hong Kong" and substituting "is entitled to protection under the Paris Convention as a well-known trade mark".<br>(b) In subclause (8), by deleting "unless the Registrar is satisfied that the use of the trade mark, in relation to the goods or services in respect of which it is proposed to be registered, is likely to cause confusion on the part of the public". |
| 12(1)(b)      | By adding "special" before "circumstances".  |

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| 13(2)         | By deleting "and section 19 (exhaustion of rights conferred by registered trade mark)" and substituting ", section 19 (exhaustion of rights conferred by registered trade mark) and section 19A (use in advertising, etc.)".   |
| 17            | (a) In subclause (4)(b), by deleting "has a reputation in Hong Kong" and substituting "is entitled to protection under the Paris Convention as a well-known trade mark".<br>(b) By deleting subclause (7).   |
| 18            | By deleting subclause (3) and substituting -<br>"(3) A registered trade mark is not infringed by -<br>(a) the use by a person of his own name or address or the name of his place of business;<br>(b) the use by a person of the name of his predecessor in business or the name of his predecessor's place of business;<br>(c) the use of signs which serve to designate the kind, quality, quantity, intended purpose, value, geographical origin, |

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time of production of goods or rendering of services, or other characteristics of goods or services; or

(d) the use of the trade mark where it is necessary to indicate the intended purpose of goods or services (for example, as accessories or spare parts), provided the use is in accordance with honest practices in industrial or commercial matters."

New

By adding, before the subheading "**Infringement proceedings**" -

**"19A. Use in advertising, etc.**

(1) Nothing in section 17 (infringement of registered trade mark) shall be construed as preventing the use by any person of a registered trade mark for the purpose of identifying goods or services as those of the owner of the registered trade mark or a licensee, but any such use which is otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade

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mark.

(2) In determining for the purposes of subsection (1) whether the use is in accordance with honest practices in industrial or commercial matters, the court may consider such factors as it considers relevant including, in particular, whether

-

- (a) the use takes unfair advantage of the trade mark;
- (b) the use is detrimental to the distinctive character or repute of the trade mark; or
- (c) the use is such as to deceive the public.

(3) For the avoidance of doubt, nothing in this section shall be construed as applying to the interpretation of section 19 (exhaustion of rights conferred by registered trade mark).".

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By adding -

"(7) Nothing in this section makes a barrister or solicitor liable to proceedings under this section for any act done by him in a professional capacity on behalf of a client.".

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| 25(5)         | By adding "that an assignment or assent be signed" after "subsection (4)".  |
| 37            | By deleting subclause (1) and substituting -<br>"(1) The filing date of an application for registration of a trade mark is the date on which documents containing everything required by section 36(2)(a) to (d) (application for registration) are filed with the Registrar.<br>(1A) If the documents are filed on different dates, the filing date is the last of those dates."<br> |
| 40            | By deleting subclauses (3) and (4) and substituting -<br>"(3) If it appears to the Registrar that the requirements for registration are not met, the Registrar shall, by notice in writing -<br>(a) inform the applicant of the Registrar's opinion;<br>(b) inform him that he may make representations to the Registrar to establish that the requirements for                       |

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registration are met or that he may amend the application so as to meet those requirements, but that he must do so within the prescribed period; and

(c) inform him of the provisions of subsection (4).

(4) The Registrar shall refuse to accept the application if the applicant -

(a) fails to respond to the notice before the end of the period prescribed for the purposes of subsection (3)(b); or

(b) fails, before the end of that period, to satisfy the Registrar that the requirements for registration are met or to amend the application so as to meet those requirements."

Subheading In the subheading after clause 41, by deleting "**restriction**".



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| 43            | <p>(a) In the heading, by deleting "<b>or restriction</b>".</p> <p>(b) In subclause (1), by deleting "or restrict the goods or services covered by the application".</p> <p>(c) In subclause (2), by deleting "or restriction".</p>                        |
| 44            | <p>By adding -</p> <p>"(2A) An application for registration of a trade mark may be amended -</p> <p>(a) for the purpose of restricting the goods or services covered by the application; or</p> <p>(b) for such other purposes as may be prescribed.".</p> |
| 48(7)         | By deleting "復" and substituting "復".  |
| 49(2)(b)      | By deleting "as to".   |

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- 50 (a) In subclause (2), by deleting paragraphs (a) to (c) and substituting -
- "(a) that the trade mark has not been genuinely used in Hong Kong by the owner or with his consent, in relation to the goods or services for which it is registered, for a continuous period of at least 3 years, and there are no valid reasons for non-use (such as import restrictions on, or other governmental requirements for, goods or services protected by the trade mark);
- (b) that the trade mark consists of a sign that, in consequence of the acts or the inactivity of the owner -
- (i) has become the common name in the trade for goods or services for which the trade mark is registered; or
- (ii) has become generally accepted within the trade as the sign that

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describes goods or  
services for which the  
trade mark is  
registered;".

(b) In subclause (3) -

- (i) in paragraph (a), by deleting  
"and";
- (ii) in paragraph (b), by deleting the  
full-stop and substituting "; and";
- (iii) by adding -

"(c) use of a trade mark in  
Hong Kong includes,  
where the trade mark is  
registered in respect  
of services, use in  
relation to services  
provided or to be  
provided outside Hong  
Kong.".

(c) In subclauses (4) and (5), by deleting "or  
(b)".

(d) By deleting subclause (8) and substituting -

"(8) For the purposes of subsection  
(2)(a), the 3-year period may begin at  
any time on or after the actual date on  
which particulars of the trade mark  
were entered in the register under

| <u>Clause</u> | <u>Amendment Proposed</u>  |
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|               | section 45(1) (registration).".  |
| 51            | (a) In subclause (3), by deleting "已" and substituting "以".  |
|               | (b) In subclause (5), by adding "also" after "may".  |
|               | (c) By deleting subclause (6) and substituting -<br>"(6) The registration of a trade mark may not be declared invalid under subsection (5) if the owner of the earlier trade mark or other earlier right has consented to the registration.".  |
| 52(2)         | By adding "only" after "varied".   |
| 55            | By deleting subclauses (5) and (6) and substituting -<br>"(5) The Registrar may, on request made by the owner of a registered trade mark or a licensee, or by any person having an interest in or charge on a registered trade mark the particulars of which have been entered in the register under section 27 (registration of transactions affecting registered trade mark), enter any change in his name or address, or in any other particulars identifying such person, as |

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recorded in the register.

(6) Where the Registrar is satisfied that an error or omission in the register is attributable to an error or omission on his part or on the part of the staff of the Registry, he may on his own initiative correct the error or omission in the register, but before doing so he shall give notice of the proposed correction to any person who appears to him to be concerned."

- 58 (a) In subclause (1), by deleting "well-known" and substituting "exceptionally well known in Hong Kong".
- (b) In subclause (7), by deleting "50(2)(a), (b), (c) and (d)" and substituting "50(2)(a), (b) and (c)".
- 59(2) By deleting "Schedule 1" and substituting "Schedule 3".
- 60(2) By deleting "Schedule 2" and substituting "Schedule 4".
- 68 By deleting the clause and substituting -
- "68. Decisions of Registrar to be taken after hearing**

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(1) Without prejudice to any rule of law or to any provision of this Ordinance requiring the Registrar to hear any party to proceedings before him, or to give any such party an opportunity to be heard, the Registrar shall, before taking any decision on any matter under this Ordinance or the rules which is or may be adverse to any party to any proceedings before him, give that party an opportunity to be heard.

(2) The Registrar shall give a party to proceedings before him at least 14 days' notice of the time when he may be heard unless that party consents to shorter notice."

70(3) By deleting "or restriction".

73 By deleting the clause.

78(5) By deleting the clause.

81 By deleting the clause and substituting -

**"81. Burden in civil proceedings of proving use of trade mark**

(1) If, in any civil proceedings under this Ordinance in which the owner of

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a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with the owner.

(2) If, in any civil proceedings under this Ordinance in which a licensee of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with -

(a) the owner of the trade mark, where he is a party to the proceedings; or

(b) the licensee, where the owner is not a party to the proceedings."

- 85
- (a) In subclause (1), by deleting "and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties".
- (b) By deleting subclause (3).

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By deleting the clause and substituting -

**"91. Regulations**

The Chief Executive in Council may by regulation -

- (a) add to Schedule 1 (Paris Convention countries and WTO members) the name of -
  - (i) any country which has acceded to the Paris Convention;
  - (ii) any country, territory or area which has acceded to the World Trade Organization Agreement;
- (b) delete from Schedule 1 the name of -
  - (i) any country which has denounced the Paris Convention;
  - (ii) any country, territory or area which has denounced the World Trade Organization Agreement;
- (c) otherwise amend Schedule 1;



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|                    | (d) amend Schedule 2 (determination of well-known trade marks);   |
|                    | (e) amend Schedule 3 (collective marks); and  |
|                    | (f) amend Schedule 4 (certification marks).".   |
| 95                 | By deleting subclause (4) and substituting -<br>"(4) A person shall not be treated as a director of a corporation by reason only that the directors of the corporation act on advice given by him in a professional capacity.". |
| 96(1), (4) and (6) | By deleting "Schedule 3" and substituting "Schedule 5".   |
| 97                 | By deleting "Schedule 4" and substituting "Schedule 6".   |

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New

By adding -

"SCHEDULE 1 [ss. 2 & 91]

PARIS CONVENTION COUNTRIES AND WTO MEMBERS

**Countries which have acceded to  
the Paris Convention**

**Countries, territories and areas which have  
acceded to the World Trade Organization  
Agreement (not including countries which  
have acceded to the Paris Convention)**

".

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New

By adding -

"SCHEDULE 2 [ss. 4 & 91]

DETERMINATION OF WELL-KNOWN TRADE MARKS

1. **Factors for consideration**

(1) In determining for the purposes of section 4 (meaning of "well-known trade mark") whether a trade mark is well known in Hong Kong, the Registrar or the court shall take into account any factors from which it may be inferred that the trade mark is well known in Hong Kong.

(2) In particular, the Registrar or the court shall consider any information submitted to the Registrar or the court from which it may be inferred that the trade mark is, or is not, well known in Hong Kong, including, but not limited to, information concerning the following -

- (a) the degree of knowledge or recognition of the trade mark in the relevant sectors of the public;
- (b) the duration, extent and geographical area of any use of the trade mark;

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- (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the trade mark, to the extent that they reflect use or recognition of the trade mark;
- (e) the record of successful enforcement of rights in the trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by competent authorities in foreign jurisdictions; and
- (f) the value associated with the trade mark.

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(3) The factors mentioned in subsection (2) are intended to serve as guidelines to assist the Registrar and the court to determine whether the trade mark is well known in Hong Kong. It is not a pre-condition for reaching that determination that information be submitted with respect to any of those factors or that equal weight be given to each of them. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not mentioned in subsection (2). Such additional factors may be relevant alone, or in combination with one or more of the factors mentioned in subsection (2).

(4) For the purpose of subsection (2)(a), "relevant sectors of the public" ( ) includes, but is not limited to -

(a) actual or potential consumers

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of the type of goods or services to which the trade mark applies;

- (b) persons involved in channels of distribution of the type of goods or services to which the trade mark applies; and
- (c) business circles dealing with the type of goods or services to which the trade mark applies.

(5) Where a trade mark is determined to be well known in at least one relevant sector of the public in Hong Kong, it shall be considered to be well known in Hong Kong.

(6) For the purpose of subsection (2)(e), "competent authorities in foreign jurisdictions" ( ) means administrative, judicial or quasi-judicial authorities in jurisdictions other than Hong Kong that are competent to determine whether a trade mark is a well-known trade mark, or in enforcing the protection of well-known trade marks, in their respective jurisdictions.

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**2. Factors not required to be established**

For the purpose of determining whether a trade mark is well known in Hong Kong, it is not necessary to establish -

- (a) that the trade mark has been used, or has been registered, in Hong Kong;
- (b) that an application for registration of the trade mark has been filed in Hong Kong;
- (c) that the trade mark is well known, or has been registered, in a jurisdiction other than Hong Kong;
- (d) that an application for registration of the trade mark has been filed in a jurisdiction other than Hong Kong; or
- (e) that the trade mark is well known by the public at large in Hong Kong."

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| Schedule 1    | <p>(a) By deleting "SCHEDULE 1" and substituting "SCHEDULE 3".</p> <p>(b) In section 4(3), by deleting "section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance" and substituting "section 44 of this Ordinance (amendment of application)".</p>   |
| Schedule 2    | <p>(a) By deleting "SCHEDULE 2" and substituting "SCHEDULE 4".</p> <p>(b) Within the square brackets, by adding "&amp; Sch. 5" after "91".</p> <p>(c) In section 5(3), by deleting "section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance" and substituting "section 44 of this Ordinance (amendment of application)".</p> |
| Schedule 3    | <p>(a) By deleting "SCHEDULE 3" and substituting "SCHEDULE 5".</p> <p>(b) In section 6(2), by deleting "Schedule 2" and substituting "Schedule 4".</p> <p>(c) In section 8(6), by deleting "after that date" and substituting "made on or after</p>  |



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that date".

- (d) In section 10 -
  - (i) by deleting subclause (2) and substituting -
    - "(2) Section 15 of the repealed Ordinance (opposition to registration) and any other provisions of the old law relating to oppositions to registration continue to apply in relation to an application mentioned in subsection (1).";
  - (ii) in subclause (3), by deleting "a notice of opposition" and substituting "an opposition to registration";
- (e) In section 11(3), by deleting "immediately after" and substituting "on".
- (f) In section 16(2), by deleting "grounds mentioned in section 50(2)(a) or (b)" and substituting "ground mentioned in section 50(2)(a)".
- (g) In section 18(1), by deleting "Schedule 2" and substituting "Schedule 4".
- (h) In the Annex -
  - (i) within the square brackets, by deleting "Sch. 3" and substituting

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|               | "Sch. 5";  |
|               | (ii) in the heading, by deleting<br>"SCHEDULE 3" and substituting<br>"SCHEDULE 5";   |
|               | (iii) in section 37(2A)(a) and (b), by<br>deleting "country or territory"<br>and substituting "country,<br>territory or place".  |
| Schedule 4    | (a) By deleting "SCHEDULE 4" and substituting<br>"SCHEDULE 6".   |
|               | (b) By deleting section 7.   |
|               | (c) By deleting section 8 and substituting -<br><b>"8. Offences in respect of trade marks</b><br>Section 9 is amended -<br>(a) by repealing subsection (3) and<br>substituting -<br>"(3) For the purposes of<br>this section but subject to<br>subsection (3A), a person shall<br>be deemed -<br>(a) to forge a trade<br>mark who either -<br>(i) without the<br>consent of<br>the owner of<br>the trade |

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mark, makes  
that trade  
mark or a mark  
so nearly  
resembling  
that trade  
mark as to be  
calculated to  
deceive; or

(ii) falsifies any  
genuine trade  
mark, whether  
by alteration,  
addition,  
effacement or  
otherwise;

(b) falsely to apply  
to goods a trade  
mark who without  
the consent of the  
owner of that  
trade mark applies  
that trade mark to  
goods,

and "forged trade mark"

) shall be construed  
accordingly.

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(3A) A person shall not be deemed under subsection (3) to forge a trade mark, or falsely to apply to goods a trade mark, if the person proves -

- (a) that he acted without infringing any right of the owner of the trade mark conferred by the Trade Marks Ordinance ( of 2000);
- (b) that the trade mark or mark was not used by him in the course of any trade or business as a trade mark in relation to goods;
- (c) that the use made by him of the trade mark or mark is not a use in relation to goods for which the trade mark is

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registered and is  
not a use in  
relation to goods  
similar to those  
for which it is  
registered; or

(d) that the use made  
by him of the trade  
mark or mark is a  
use to which the  
rights of the owner  
of the trade mark  
do not extend by  
reason of a  
disclaimer,  
limitation or  
condition to which  
the trade mark is  
subject.";

(b) in subsection (4), by repealing  
"assent of the proprietor" and  
substituting "consent of the  
owner".

(d) By deleting section 11.