

TRADE MARKS BILL

COMMITTEE STAGE

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

<u>Clause</u>	<u>Amendment Proposed</u>
2(1)	<p>(a) by deleting the definition of "Paris Convention country" and substituting -</p> <p>"Paris Convention country" (巴黎公約國)</p> <p>means -</p> <p>(a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;</p> <p>(b) any territory or area subject to the authority or under the suzerainty of any country referred 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;".</p>

Clause

Amendment Proposed

- (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), in the English text, by deleting "well-known in Hong Kong" and substituting "well known in Hong Kong".
- (b) By adding -
- "(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.".

<u>Clause</u>	<u>Amendment Proposed</u>
New clause	By adding, after clause 8 - <b>"8A. Ordinance binds Government</b> This Ordinance binds the Government."
9	(a) By deleting subclause (3). (b) By renumbering subclause (4) as subclause (3).
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". (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".

Clause

Amendment Proposed

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".
- (b) By deleting subclause (7).

Clause

Amendment Proposed

18(3) By deleting the subclause and substituting -

"(3) A registered trade mark is not infringed by -

- (a) the use by a person of his own name or address or the name of his place of business;
- (b) the use by a person of the name of his predecessor in business or the name of his predecessor's place of business;
- (c) the use of signs which serve to designate the kind, quality, quantity, intended purpose, value, geographical origin, 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."

Clause

Amendment Proposed

New  
clause

By adding after clause 19 -

**"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 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.

Clause

Amendment Proposed

(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).".

25(5) By adding "that an assignment or assent be signed" after "subsection (4)".

40 By deleting subclause (3) and (4) and substituting -

"(3) If it appears to the Registrar that the requirements for registration are not met, the Registrar shall, by notice in writing -

- (a) inform the applicant of the Registrar's opinion;
- (b) inform him that he may make representations to the Registrar to establish that the requirements for 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).

Clause

Amendment Proposed

(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."

43 (a) In subclause (1), by deleting "or restrict the goods or services covered by the application".

(b) In subclause (2), by deleting "or restriction".

48(7) In the Chinese text, by deleting "復" and substituting "復".

49(2) (b) In the English text, by deleting "as to".

50 (a) In subclause (2) -



Clause

Amendment Proposed

(i) 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

Clause

Amendment Proposed

generally accepted  
within the trade as  
the sign that  
describes goods or  
services for which  
the trade mark is  
registered,;".

(ii) by renumbering paragraphs (d) and (e)  
as paragraphs (c) and (d),  
respectively.

(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 subclause (4) and (5), by deleting "or  
(b)".

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

Clause

Amendment Proposed

"(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 section 45(1) (registration).".

51 (a) In subclause (3), in the Chinese text, by deleting "已" and substituting "以".

(b) In subclause (5), by adding "also" after "may".

(c) By deleting subclause (6) and substituting -

"(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 subclause (5) and (6) and

Clause

Amendment Proposed

substituting -

"(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 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."

Clause

Amendment Proposed

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**

(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

Clause

Amendment Proposed

proceedings before him at least 14 days' notice of the time when he may be heard unless that party consents to shorter notice."

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 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

Clause

Amendment Proposed

is not is a party to the  
proceedings."

91 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

Clause

Amendment Proposed

Agreement;

- (c) otherwise amend Schedule 1;
- (d) amend Schedule 2 (determination of well-known trade marks);
- (e) amend Schedule 3 (collective marks); and
- (f) amend Schedule 4 (certification marks).".

95(4) By deleting the subclause and substituting -

"(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 In subclause 96(1), (4) and (6), by deleting "Schedule 3" and substituting "Schedule 5".

97 By deleting "Schedule 4" and substituting "Schedule 6".

New By adding -



<u>Clause</u>	<u>Amendment Proposed</u>
Schedule	"SCHEDULE 1 [ss. 2(1) & 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)**

" .

New By adding -

<u>Clause</u>	<u>Amendment Proposed</u>
Schedule	"SCHEDULE 2 [s. 4]

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;
- (c) the duration, extent and

Clause

Amendment Proposed

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.

(3) The factors mentioned in subsection (2) are intended to serve as guidelines to assist the Registrar and the court to

Clause

Amendment Proposed

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

(b) persons involved in channels of

Clause

Amendment Proposed

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.

**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

Clause

Amendment Proposed

- 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."

Schedule 1 By deleting "SCHEDULE 1" and substituting  
"SCHEDULE 3".

Schedule 2 By deleting "SCHEDULE 2" and substituting  
"SCHEDULE 4".

Schedule 3 (a) By deleting "SCHEDULE 3" and substituting

Clause

Amendment Proposed

"SCHEDULE 5".

- (b) In section 6(2), by deleting "Schedule 2" and substituting "Schedule 4".
- (c) In section 8(6), by deleting "after that date" and substituting "made on or after that date".
- (d) In section 11(3), by deleting "immediately after" and substituting "on".
- (e) In section 16(2), by deleting "grounds mentioned in section 50(2)(a) or (b)" and substituting "ground mentioned in section 50(2)(a)".
- (f) In section 18(1), by deleting "Schedule 2" and substituting "Schedule 4".
- (g) In the Annex -
  - (i) in the heading, by deleting "SCHEDULE 3" and substituting "SCHEDULE 5";
  - (ii) in section 37(2A)(a) and (b), by deleting "country or territory" and substituting "country, territory or place".

Schedule 4 (a) By deleting "SCHEDULE 4" and substituting

Clause

Amendment Proposed

"SCHEDULE 6".

(b) By deleting clause 7.

(c) By deleting clause 8 and substituting -

**"8. Offences in respect of trade marks**

Section 9 is amended -

(a) by repealing subsection 9(3) and substituting -

"(3) For the purposes of this section but subject to subsection (3A), a person shall be deemed -

(a) to forge a trade mark who either -

(i) without the consent of the owner of the trade mark, makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive; or

(ii) falsifies any



Clause

Amendment Proposed

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.

(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

Clause

Amendment Proposed

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  
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

Clause

Amendment Proposed

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 clause 11.