

For Information

Legislative Council Panel on Commerce and Industry

**Proposed Amendments to the Schedules to the
Patents Ordinance (Cap. 514),
Registered Designs Ordinance (Cap. 522),
Trade Marks Ordinance (Cap. 559) and
Layout-design (Topography) of Integrated Circuits (Designation
of Qualifying Countries, Territories or Areas) Regulation (Cap. 445B)**

Introduction

This paper informs Members of certain proposed technical amendments to the respective schedules to the Patents Ordinance (“PO”), the Registered Designs Ordinance (“RDO”), the Trade Marks Ordinance (“TMO”) and the Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation (“Integrated Circuits Regulation”). The proposed amendments seek to update these schedules setting out the list of contracting parties to the Paris Convention for the Protection of Industrial Property (“Paris Convention”) and the membership list of the World Trade Organization (“WTO”).

Background

2. China is a contracting party to the Paris Convention. The Central People's Government (“CPG”) applied the Paris Convention to the Hong Kong Special Administrative Region (“HKSAR”) with effect from 1 July 1997. Besides, the HKSAR (in the name of Hong Kong, China) is a member of the WTO in its own right.

3. Under Article 4 of the Paris Convention, the HKSAR is obliged to grant to a person who has filed an application for a patent or for registration of a design or trade mark in a Paris Convention country a right of priority during a prescribed period for the purpose of filing the same application in the HKSAR. Separately, Article 2.1 in Part I of the Agreement on Trade-Related Aspects of Intellectual Property Rights

(“TRIPS Agreement”) under the WTO regime obliges the HKSAR to do the same in respect of an application filed in a WTO member country, territory or area.

4. We have met the above international obligations by making specific provisions in the PO, the RDO and the TMO to the effect that a person who has filed an application in a Paris Convention country or WTO member country, territory or area will enjoy a right of priority. We have also set out in a schedule to each of the afore-mentioned Ordinances the lists of Paris Convention countries and WTO member countries, territories or areas. The Chief Executive in Council is empowered to amend the relevant schedule to the PO by an order published in the Gazette. In the case of the RDO and the TMO, the Chief Executive in Council may amend the relevant schedules by regulation.

5. Separately, Article 35 in Part II of the TRIPS Agreement requires the HKSAR to grant the same level of intellectual property protection for layout-designs (topographies) of integrated circuits to nationals of other WTO member countries, territories or areas, as to HKSAR residents. To meet this requirement, we have provided in the Layout-design (Topography) of Integrated Circuits Ordinance that the said protection will be given to nationals of such qualifying countries, territories or areas as are designated by regulation by the Chief Executive. The Integrated Circuits Regulation, with a schedule setting out those countries, territories or areas that have acceded to the WTO, has been made for this purpose.

Proposed Amendments to the Schedules

6. The above four schedules are amended from time to time to reflect the updated list of contracting parties to the Paris Convention and membership position of the WTO. Since the previous updating exercise in 2013, one more country (i.e. the Independent State of Samoa) has become a contracting party to the Paris Convention and one more country (i.e. the Republic of Tajikistan) has become a member of the WTO. To reflect these changes, we need to amend the respective schedules to the PO, the RDO, the TMO and the Integrated Circuits Regulation.

7. Moreover, amendments are needed to update the official

English and/or Chinese name(s) of some countries with reference to the documentation of the United Nations as appropriate, with a view to achieving consistency in terminology. Details of the proposed amendments are at Annex.

Legislative Timetable

8. We are now drafting the necessary amendment Order and Regulations and plan to table these pieces of subsidiary legislation at the Legislative Council for negative vetting by mid 2014.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
March 2014

Proposed Amendments

I. Patents Ordinance (Cap. 514)

I(a) For the list of “Paris Convention countries” in Schedule 1 –

(i) To add :

- “The Independent State of Samoa” (薩摩亞獨立國)

(ii) To replace :

- “The Democratic People’s Republic of Algeria” by “The People’s Democratic Republic of Algeria”
- “The Republic of Bolivia”(玻利維亞共和國) by “The Plurinational State of Bolivia”(多民族玻利維亞國)
- “The Republic of France” by “The French Republic”
- “The Cooperative Republic of Guyana”(圭亞那合作共和國) by “The Republic of Guyana”(圭亞那共和國)
- “The Republic of Hungary”(匈牙利共和國) by “Hungary”(匈牙利)
- “Kyrgyz Republic” by “The Kyrgyz Republic”
- “Malta”(馬耳他) by “The Republic of Malta”(馬耳他共和國)
- “The United States of Mexico” by “The United Mexican States”

I(b) For the list of “WTO member countries, territories and areas (not including Paris Convention countries)” in Schedule 1 –

(i) To delete :

- “The Independent State of Samoa” (薩摩亞獨立國)¹

¹ As the Independent State of Samoa has become a contracting party to the Paris Convention, it is necessary to move its name from the list of “WTO member countries, territories and areas (not including Paris Convention countries)” to the list of “Paris Convention countries”.

II. Registered Designs Ordinance (Cap. 522)

II(a) The proposed amendments in paragraph I(a) above for the Patents Ordinance apply to the list of “Countries which have acceded to the Paris Convention” in the Schedule.

II(b) The proposed amendments in paragraph I(b) above for the Patents Ordinance apply to the list of “Countries, territories and areas which have acceded to the World Trade Organization Agreement (not including countries which have acceded to the Paris Convention)” in the Schedule.

III. Trade Marks Ordinance (Cap. 559)

III(a) The proposed amendments in paragraph I(a) above for the Patents Ordinance apply to the list of “Countries which have acceded to the Paris Convention” in Schedule 1.

III(b) For the list of “Countries, territories and areas which have acceded to the World Trade Organization Agreement” in Schedule 1 –

(i) To add :

- “The Republic of Tajikistan” (塔吉克斯坦共和國)

(ii) To replace :

- “The Republic of Bolivia”(玻利維亞共和國) by “The Plurinational State of Bolivia”(多民族玻利維亞國)
- “The Republic of France” by “The French Republic”
- “The Cooperative Republic of Guyana”(圭亞那合作共和國) by “The Republic of Guyana”(圭亞那共和國)
- “The Republic of Hungary”(匈牙利共和國) by “Hungary”(匈牙利)
- “Kyrgyz Republic” by “The Kyrgyz Republic”
- “Malta”(馬耳他) by “The Republic of Malta”(馬耳他共和國)
- “The United States of Mexico” by “The United Mexican States”

**IV. Layout-design (Topography) of Integrated Circuits
(Designation of Qualifying Countries, Territories or Areas)
Regulation (Cap. 445B)**

The proposed amendments in paragraph III(b) above for the Trade Marks Ordinance apply to the list of “Qualifying countries, territories or areas” in the Schedule.