

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 a regular exercise to propose technical amendments to the respective Schedules to the Patents Ordinance (Cap. 514) (“PO”), the Registered Designs Ordinance (Cap. 522) (“RDO”), the Trade Marks Ordinance (Cap. 559) (“TMO”) and the Layout-design (Topography) of Integrated Circuits (Designation of Qualifying Countries, Territories or Areas) Regulation (Cap. 445B) (“Integrated Circuits Regulation”). The proposed amendments seek to update these Schedules which set out the membership list of the World Trade Organization (“WTO”).

Background

2. The People’s Republic of China is a contracting party to the Paris Convention for the Protection of Industrial Property (“Paris Convention”). The Central People’s Government of China 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 a corresponding application in the HKSAR. 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 comply with Article 4 of the Paris Convention and grant to a person who has filed an application for a patent or for registration of a design or trade mark in a WTO member country, territory or area the same right of priority during a prescribed period for the purpose of filing the corresponding application in the HKSAR.

4. In addition, Article 35 in Part II of the TRIPS Agreement requires the HKSAR to grant the same level of intellectual property protection for layout-design (topography) of integrated circuits to nationals of other WTO member countries, territories or areas, as to the HKSAR residents.

5. We have complied with the above international obligations concerning the right of priority for patents, designs and trade marks 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 when filing a corresponding application in the HKSAR within a prescribed period. We have also set out in a schedule to each of the above-mentioned Ordinances the list(s) of Paris Convention countries and/or WTO member countries, territories or areas. In this regard, 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.

6. As for the international obligation concerning layout-designs (topographies) of integrated circuits, we have provided in the Layout-design (Topography) of Integrated Circuits Ordinance (Cap. 445) 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

7. We have been undertaking regular exercises to update the

above-mentioned Schedules to reflect the updated list of contracting parties to the Paris Convention and membership position of the WTO. The last round of updates has been implemented by Order and Regulations tabled at the Legislative Council on 17 June 2015 for negative vetting. Subsequent to the last revision exercise, there was no new accession to the Paris Convention and four more countries, namely, the Islamic Republic of Afghanistan, the Republic of Kazakhstan, the Republic of Liberia and the Republic of Seychelles, have become members 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. 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 early 2017.

Commerce, Industry and Tourism Branch
Commerce and Economic Development Bureau
November 2016

Proposed Amendments

I. Patents Ordinance (Cap. 514)

For the list of “WTO member countries, territories and areas (not including Paris Convention countries)” in Schedule 1, to add “The Islamic Republic of Afghanistan” (阿富汗伊斯蘭共和國).

II. Registered Designs Ordinance (Cap. 522)

For 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, to add “The Islamic Republic of Afghanistan” (阿富汗伊斯蘭共和國).

III. Trade Marks Ordinance (Cap. 559)

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

- “The Islamic Republic of Afghanistan” (阿富汗伊斯蘭共和國)
- “The Republic of Kazakhstan” (哈薩克斯坦共和國)
- “The Republic of Liberia” (利比里亞共和國)
- “The Republic of Seychelles” (塞舌爾共和國).

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

For the list of “Qualifying Countries, Territories or Areas” in the Schedule, to add –

- “The Islamic Republic of Afghanistan” (阿富汗伊斯蘭共和國)

- “The Republic of Kazakhstan” (哈薩克斯坦共和國)
- “The Republic of Liberia” (利比里亞共和國)
- “The Republic of Seychelles” (塞舌爾共和國).