



中華人民共和國香港特別行政區
Hong Kong Special Administrative Region of the People's Republic of China



立法會秘書處 法律事務部
LEGAL SERVICE DIVISION
LEGISLATIVE COUNCIL SECRETARIAT

來函檔號 YOUR REF : CITB CR 06/47/1
本函檔號 OUR REF : LS/B/10/18-19
電 話 TELEPHONE : 3919 3504
圖文傳真 FACSIMILE : 2877 5029
電 郵 EMAIL : rkt dai@legco.gov.hk

By Fax (2840 1621)

4 April 2019

Miss CHOI Man-kwan, Alice
Prin AS for Commerce & Economic Development
(Commerce & Industry)3
Commerce and Economic Development Bureau
22/F to 23/F, West Wing
Central Government Offices
2 Tim Mei Avenue, Tamar, Hong Kong

Dear Miss CHOI,

Re: Trade Marks (Amendment) Bill 2019

We are scrutinizing the captioned Bill with a view to advising Members.

Please find attached a schedule listing our observations in relation to the captioned Bill. We should be grateful if you could let us have your response in both English and Chinese as soon as possible, preferably before the second meeting of the Bills Committee.

Yours sincerely,

(Rachel DAI)
Assistant Legal Adviser

c.c. Department of Justice
(Attn: Ms Cindy CHEUK, SGC and
Mr Vincent FUNG, GC) (By Fax: 3918 4613)
Legal Adviser
Senior Assistant Legal Adviser 3
Clerk to Bills Committee

Schedule

General

1. It is noted that China is a Contracting Party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol"), but Hong Kong is not. It is further noted from the Madrid (Marks) Notification No. 91 that China gave notice to the World Intellectual Property Organization in 1997 that, pending a study and until further notice, the Madrid Protocol and the requests for territorial extension of the international registration of marks to China under the Madrid System would be deferred to be applied to Hong Kong. Please clarify:
 - (a) the status of Hong Kong in respect of the Madrid Protocol upon the application of the Madrid Protocol to Hong Kong; and
 - (b) under which provision(s) of the Madrid Protocol would the protection resulting from the international registration of a trade mark be extended to Hong Kong.

Clause 6 – relative grounds for refusal of registration

2. Currently, under section 12(4) of the Trade Marks Ordinance (Cap. 559), a trade mark which is identical or similar to an earlier trade mark (that is entitled to protection under the Paris Convention as a well-known trade mark) and proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected shall not be registered under certain conditions. Clause 6 of the Bill seeks to remove the requirement of "proposed to be registered for goods or services which are not identical or similar to those for which the earlier trade mark is protected" from section 12(4)(b). Please explain the rationale for the proposed amendment (which appears to be a substantive amendment rather than just a technical amendment as described in the Legislative Council Brief (File Ref.: CITB CR 06/47/1) dated 4 February 2019).

Clause 7 – infringement of registered trade mark

3. Currently, section 18(4)(a) of Cap. 559 provides that a person infringes registered trade mark if he uses in the course of trade or business a sign which is identical or similar to an earlier trade mark (that is entitled to protection under the Paris Convention as a

well-known trade mark) in relation to goods or services which are not identical or similar to those for which the earlier trade mark is registered. Clause 7 of the Bill seeks to amend section 18(4)(a) of Cap. 559 by replacing the reference to "goods or services which are not identical or similar to those for which the trade mark is registered" by "any goods or services". Please explain the rationale for the proposed amendment (which appears to be a substantive amendment rather than just a technical amendment as described in the Legislative Council Brief (File Ref.: CITB CR 06/47/1) dated 4 February 2019).

Clauses 8 and 9 – application for registration and filing date

4. Section 38 of Cap. 559 currently sets out the particulars that must be included in an application for registration of a trade mark. Clause 8 of the Bill seeks to amend section 38 of Cap. 559 to require a corporate applicant to provide, among others, information as to its place of incorporation (the proposed new section 38(2)(a)(iii)). Clause 9 of the Bill seeks to amend section 39 of Cap. 559 to provide that the filing date of an application for registration of a trade mark is the date on which the documents containing the particulars required by section 38(2)(a)(i), (ii), (iv) and (v) or (b)(i), (ii), (iii) and (iv) are filed with the Registrar and the fees payable under section 38(5) are paid. Please explain why the filing of document(s) containing the particulars required by section 38(2)(a)(iii) is not required under the proposed amendment to section 39 of Cap. 559.

Clause 11 – rectification or correction

5. It is noted that while the proposed amendment to section 57(6) of Cap. 559 empowers the Registrar to correct an error or omission in the register on application in writing by a person having a sufficient interest if the error or omission is attributable to the Registrar, the Registrar's existing power under section 57(6) to correct an error or omission in the register that is attributable to an error or omission on the part of the staff of the Registry would be removed. Please explain the reason for the change.

Clause 15 – enforcement

Proposed new sections 96B and 96K – appointment of enforcement officers and delegation

6. Under the proposed new section 96B, the Commissioner of Customs and Excise ("Commissioner") may appoint in writing a public officer as an enforcement officer for the purposes of Cap. 559. Under the proposed new section 96K, the Commissioner may, in writing, delegate to a public officer any of his or her functions or powers under the proposed new Part XIIA of Cap. 559. Please provide examples of public officers who may be appointed as an enforcement officer or who may be delegated functions or powers by the Commissioner under the proposed new sections 96B or 96K, and consider whether the rank(s) of public officers to be appointed or delegated should be provided for in the Bill. Reference can be made to section 79(3) of the Merchant Shipping (Seafarers) Ordinance (Cap. 478) and section 52 of the Public Order Ordinance (Cap. 245).

Proposed new section 96D – warrant to enter and search etc.

7. Under the proposed section 96D(4)(b), a warrant issued under the proposed section 96D(2) authorizes the enforcement officer to seize, remove and detain anything in the place that appears to the officer to be specified evidence. Please consider whether there should be any provision in the Bill similar to section 131(2) of the Copyright Ordinance (Cap. 528) to require that a notice of the seizure or detention be served on the owner of the thing before a certain date.

Proposed new section 96F – offences relating to investigation etc.

8. Under the proposed new section 96F(2)(a) and (b), a person commits an offence if the person obstructs the enforcement officer in the exercise of the officer's power or in the performance of the officer's duties under the proposed new Part XIIA of Cap. 559 or fails to comply with a requirement under the proposed new section 96C(1)(e) or (f). Unlike, for example, section 124(1)(a) and (b) of Cap. 528 and section 17(1)(a) and (b) of the Trade Descriptions Ordinance (Cap. 362) which refer to "wilfully obstructs an authorized officer in the exercise of his powers or the performance of his duties" and "wilfully fails to comply with any requirement properly made to him by any such authorized officer",

the proposed new section 96F(2)(a) and (b) do not include "wilfully" as the *mens rea* (criminal intent). Please consider whether "wilfully" should be include. If the answer is negative, please explain the rationale for the proposed arrangement.

Proposed new section 96I – notification requirement for certain intended applications

9. Under the proposed new section 96I, the Commissioner must notify the owner of a forfeitable item or the owner's authorized agent that the Commissioner intends to make a forfeiture application or sale application if the owner of the item can be found ("notification requirement"). It is noted that the proposed new section 96H(5) seeks to provide that the Commissioner may make a proceeds application. Please consider whether the Commissioner should also be required to give similar notification for an intended proceeds application.
10. In relation to the notification requirement under the proposed new section 96I, please clarify under what circumstances the owner of a forfeitable item would be considered cannot be found. Please also consider whether there should be any provision in the Bill to state expressly the steps that would need to be taken to prove that the owner of the forfeitable item cannot be found.

Proposed new section 96J – international co-operation

11. Under the proposed new section 96J, the Commissioner may, for the purpose of promoting international co-operation in the protection of intellectual property rights, disclose any information obtained under the proposed new Part XIIA of Cap. 559 to certain authorities, including any authority that is responsible for the enforcement of those rights in any country, territory or area as the commissioner considers appropriate. Please provide the justification(s) for allowing such disclosure of information under the proposed new section 96J. Please clarify whether it is a requirement under the Madrid Protocol. If so, please identify the relevant provision(s) of the Madrid Protocol.
12. Please clarify the scope of information that may be disclosed under the proposed new section 96J. Please also clarify whether there would be any relevant safeguards relating to such disclosure of information.

Proposed new section 96L – immunity from civil liability

13. The proposed new section 96L seeks to provide for the Commissioner's and an enforcement officer's immunity from civil liability. Please clarify whether a public officer would be protected from criminal liability in respect of any act done or any omission by reason of his performance or purported performance in good faith of any function under the Bill.
14. Please consider whether the persons giving the enforcement officers assistance as required under the proposed new section 96C(1)(f), for example, disclosing information in breach of duty of confidence, should be protected from civil liability under the proposed section 96L or any other provisions.