

**THE INTERNATIONAL TRADEMARK ASSOCIATION  
COMMENTS ON  
TRADE MARK (AMENDMENT) BILL 2019  
April 2019**

**Introduction**

The International Trademark Association (INTA) is pleased to provide comments on the Trade Marks (Amendment) Bill 2019 of the Hong Kong Special Administrative Region ("Hong Kong").

INTA is a not-for-profit global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation.

INTA's has 7,200 member organizations from 191 countries. INTA members collectively contribute almost US \$12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. For comparison, the 2016 annual GDP of the top three global economies was \$11.2 trillion (China), \$16.4 trillion (European Union) and \$18.6 trillion (United States).

The Association's member organizations represent over 31,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms, and nonprofits.

Headquartered in New York City, INTA also has offices in Brussels, Santiago, Shanghai, Singapore, and Washington D.C. and representatives in Geneva and New Delhi.

**Comments on Issues for Consultation**

We understand the amendments of the Trade Mark Bill 2019 would interest the following:

- Trade Marks Ordinance (Cap. 559), Trade Marks Rules (Cap. 559 sub. leg. A), and Trade Descriptions Ordinance (Cap. 362);
- International Registration of Trade Marks under Madrid Protocol; and
- Enforcement

**i) On International Registration of Trade Marks under Madrid Protocol**

INTA welcomes the proposed application of the Madrid Protocol to Hong Kong and has the following comments in support of this development. As already stated in our previous comments<sup>1</sup> submitted in February 2015 on the Consultation Paper issued by the Intellectual Property Department of the Commerce and Economic Development Bureau of the Hong Kong Special Administrative Region regarding the

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<sup>1</sup> [https://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/Submissions/ITA.pdf](https://www.ipd.gov.hk/eng/intellectual_property/trademarks/Submissions/ITA.pdf)

proposed application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks to Hong Kong, INTA wishes to reiterate its view of the benefits that Hong Kong could derive from such application, in terms of facilitating local businesses (in particular small and medium-size entities) to reach out to the world market; of enhancing Hong Kong's attractiveness as a place of business; of promoting Hong Kong as an IP trading hub; and of reinforcing its international image.

As a result, INTA welcomes and is in favour of the amendments to the Trade Marks Ordinance to provide for the implementation of an international registration system of trade marks under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks; and to enhance the mechanism for registering trade marks.

INTA also hopes that the Hong Kong Administration will continue discussing the possibility of putting in place separate administrative arrangements to facilitate reciprocal applications by Hong Kong applicants and applicants from the People's Republic of China, so as not to hold up the overall progress of the implementation of the Madrid Protocol in Hong Kong. INTA hopes for such reciprocal arrangements to be established in the near future.

#### ii) On Enforcement

The Amendments to the Bill seek to confer powers on the Customs and Excise Department to enforce the criminal provisions related to trade mark registration under the Trade Marks Ordinance.

As the Hong Kong Police Force is currently taking criminal sanctions under the ordinance for offences including falsifying the Register of Trademarks, falsely representing a trademark as registered and misusing the title of the Register, to enhance the synergy in the enforcement of IP laws, the Bill proposes to unify the enforcement of criminal provisions relating to trademarks in the same enforcement unit, since Customs have always been responsible for taking criminal sanctions against copyright infringement under the Copyright Ordinance and trademark infringement under the Trade Descriptions Ordinance.

INTA welcomes the amendments to streamline domestic and international coordination among law enforcement agencies and wishes to also highlight the importance of information sharing between brand owners and enforcement agencies to achieve effective brand protection.

INTA supports the development and passage of legislation, regulations, and trade agreements throughout the world that increase national and international enforcement mechanisms against counterfeiting and other intellectual property crimes.

For any questions relating to this submission please contact Seth Hays, Chief Representative, China and Asia Pacific, at