

Trade Marks (Amendment) Bill 2019

Contents

Clause	Page
Part 1	
Preliminary	
1.	Short title and commencement C67
2.	Enactments amended C69
Part 2	
Amendments to Trade Marks Ordinance (Cap. 559)	
3.	Long title amended C71
4.	Section 2 amended (interpretation) C71
5.	Section 5 amended (meaning of <i>earlier trade mark</i>) C75
6.	Section 12 amended (relative grounds for refusal of registration) C77
7.	Section 18 amended (infringement of registered trade mark) C77
8.	Section 38 amended (application for registration) C79
9.	Section 39 amended (filing date) C81
10.	Section 46 amended (amendment of application) C81
11.	Section 57 amended (rectification or correction) C83
12.	Section 72 substituted C85
72.	Power to give preliminary advice etc. C85

Clause	Page
13.	Part XA added C91

Part XA

International Registration of Trade Marks under Madrid Protocol

Division 1—General

90A.	Interpretation of Part XA C91
90B.	Rules for implementing Madrid Protocol C93

Division 2—International Registration of Trade Marks

90C.	Rules for international application C93
90D.	Rules for international designation (HK) and protected international trade mark (HK) C95

Division 3—Miscellaneous

90E.	Rules for other matters C97
14.	Section 91 heading amended (rules) C99
15.	Part XIIA added C99

Part XIIA

Enforcement

Division 1—Interpretation

96A.	Interpretation of Part XIIA C101
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Division 2—Investigation

96B.	Appointment of enforcement officers C103
96C.	Power to investigate etc. C103
96D.	Warrant to enter and search etc. C107

Clause	Page
Division 3—Arrest, Offences and Forfeiture	
96E.	Power to arrest etc. C109
96F.	Offences relating to investigation etc. C109
96G.	General provision on disposal of things C111
96H.	Provision on perishable things C113
96I.	Notification requirement for certain intended applications C117
Division 4—Miscellaneous	
96J.	International co-operation C117
96K.	Delegation C117
96L.	Immunity from civil liability C119
16.	Section 100 added C119
100.	Transitional and savings provisions for Trade Marks (Amendment) Ordinance 2019 C119
17.	Schedule 5 amended (transitional matters) C119
18.	Schedule 7 added C121
Schedule 7	Transitional and Savings Provisions for Trade Marks (Amendment) Ordinance 2019 C121
Part 3	
Amendments to Trade Marks Rules (Cap. 559 sub. leg. A)	
19.	Rule 11 amended (deficiencies in application) C125

Clause	Page
20. Rule 29 amended (registration)	C125
21. Rule 63 amended (entry in the register of particulars of registrable transaction)	C125
22. Rule 66 amended (correction of errors or omissions in the register)	C129
23. Rules 72 and 73 repealed	C129
24. Rule 73A added	C129
73A. Preliminary advice by Registrar	C131
25. Rule 95 amended (non-extendible time limits)	C131
26. Schedule amended (fees)	C133

Part 4

Consequential Amendments to Trade Descriptions Ordinance (Cap. 362)

27. Section 2 amended (interpretation)	C137
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A BILL

To

Amend 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; to enhance the mechanism for registering trade marks; to include enforcement powers; and to provide for related or technical amendments.

Enacted by the Legislative Council.

Part 1

Preliminary

1. Short title and commencement

- (1) This Ordinance may be cited as the Trade Marks (Amendment) Ordinance 2019.
- (2) Subject to subsection (3), this Ordinance comes into operation on the day on which it is published in the Gazette.
- (3) Section 5 and Part 4 come into operation on a day to be appointed by the Secretary for Commerce and Economic Development by notice published in the Gazette.

2. Enactments amended

The enactments specified in Parts 2, 3 and 4 are amended as set out in those Parts.

Part 2

Amendments to Trade Marks Ordinance (Cap. 559)

3. Long title amended

The long title—

Repeal

“new provision in respect of the registration of trade marks”

Substitute

“provision for the registration of trade marks, to give effect to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.”.

4. Section 2 amended (interpretation)

(1) Section 2(1)—

Repeal the definition of *corporation*

Substitute

“*corporation* (法團) means—

- (a) a company as defined by section 2(1) of the Companies Ordinance (Cap. 622); or
- (b) any other body corporate incorporated or established in or outside Hong Kong;”.

(2) Section 2(1), definition of *court*, before “means”—

Add

“, except in Part XIIA.”.

(3) Section 2(1)—

Repeal the definition of *rules*

Substitute

“*rules* (《規則》) means rules made under Part XA or section 91;”.

- (4) Section 2(1)—

Add in alphabetical order

“*International Bureau* (國際局) means the International Bureau of the World Intellectual Property Organization established under the Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967;

international designation (HK) (國際指定(香港)) means a request, made under Article 3^{ter} of the Madrid Protocol, for extension to Hong Kong of the protection resulting from the international registration of a trade mark;

International Register (國際註冊簿) means the register of trade marks maintained for the purposes of the Madrid Protocol by the International Bureau;

international registration (國際註冊) means the registration of a trade mark in the International Register;

Madrid Protocol (《馬德里議定書》) means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on 27 June 1989, as amended from time to time;

protected international trade mark (HK) (受保護國際商標(香港)) means a trade mark on which protection resulting from international registration of the mark is conferred in Hong Kong in accordance with the rules made under Part XA;”.

5. Section 5 amended (meaning of *earlier trade mark*)

(1) Section 5(1), after “another trade mark”—

Add“(*other trade mark*)”.

(2) Section 5(1)—

Repeal paragraph (a)**Substitute**

“(a) a registered trade mark, or an international trade mark (HK), that has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed (if any) in respect of—

- (i) the registered trade mark and the other trade mark; or
- (ii) the international trade mark (HK) and the other trade mark; or”.

(3) After section 5(3)—

Add

“(4) In this section—

international trade mark (HK) (國際商標(香港))—

- (a) means a trade mark—
 - (i) that is the subject of an international designation (HK); and
 - (ii) that is entitled to protection in accordance with the rules made under Part XA; and
- (b) without limiting paragraph (a), includes a protected international trade mark (HK).”.

6. Section 12 amended (relative grounds for refusal of registration)

(1) Section 12—

Repeal subsection (4)

Substitute

“(4) Subject to subsection (6), a trade mark (*later trade mark*) that is identical or similar to an earlier trade mark must not be registered if, or to the extent that—

(a) the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark; and

(b) the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”.

(2) Section 12(6)—

Repeal

“one or more”.

7. Section 18 amended (infringement of registered trade mark)

(1) Section 18(4), Chinese text—

Repeal

“就某些貨品或服務而”.

(2) Section 18(4)(a)—

Repeal

“goods or services which are not identical or similar to those for which the trade mark is registered”

Substitute

“any goods or services”.

8. Section 38 amended (application for registration)

Section 38—

Repeal subsection (2)**Substitute**

“(2) The application must include—

- (a) for an applicant that is a corporation—
 - (i) a request for registration of the trade mark;
 - (ii) the name and address of the corporation;
 - (iii) the place under the law of which the corporation was formed and registered, incorporated or established;
 - (iv) a statement of the goods or services in relation to which registration of the trade mark is sought;
 - (v) a representation of the trade mark; and
 - (vi) any other information, document or matter that the rules may require; or
- (b) for any other applicant—
 - (i) a request for registration of the trade mark;
 - (ii) the name and address of the applicant;
 - (iii) a statement of the goods or services in relation to which registration of the trade mark is sought;
 - (iv) a representation of the trade mark; and
 - (v) any other information, document or matter that the rules may require.”.

9. Section 39 amended (filing date)

(1) Section 39—

Repeal subsection (1)**Substitute**

“(1) The filing date of an application for registration of a trade mark is the date on which both of the following conditions are fulfilled—

(a) all 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;

(b) the fees payable under section 38(5) are paid.”.

(2) Section 39—

Repeal subsection (2).**10. Section 46 amended (amendment of application)**

(1) Section 46—

Repeal subsection (2)**Substitute**

“(2) The Registrar may amend an application for registration of a trade mark to add a representation of a registered trade mark together with the registered particulars of that trade mark the Registrar considers appropriate.

(2A) However, the application may be amended only if all the following conditions are met—

(a) at the time the request is made, the registered trade mark is registered in the applicant’s name;

- (b) the application is made in respect of any or all of the goods or services for which the registered trade mark is registered;
 - (c) the date of registration of the registered trade mark is earlier than the date of the application.
- (2B) If the application is amended as provided for under subsection (2), the registered particulars have effect only in relation to the part of the amended application that is a representation of the registered trade mark.”.

(2) After section 46(5)—

Add

“(6) In this section—

registered particulars (註冊詳情), in relation to a registered trade mark—

- (a) means the particulars or matters that are entered in the register under section 67(2); and
- (b) without limiting paragraph (a), includes—
 - (i) a statement that claims a colour or a 3-dimensional shape as the trade mark or an element of the trade mark;
 - (ii) a statement that the trade mark consists wholly or partly of a sound or smell; and
 - (iii) a disclaimer, limitation or condition that applies to the trade mark.”.

11. Section 57 amended (rectification or correction)

(1) Section 57, heading, after “**correction**”—

Add

“etc.”.

(2) Section 57—

Repeal subsection (6)**Substitute**

- “(6) The Registrar may correct an error or omission in the register if satisfied that the error or omission is attributable to the Registrar.
- (6A) The power to correct may be exercised—
- (a) on the Registrar’s own initiative; or
 - (b) on application in writing by a person having a sufficient interest.
- (6B) Before making a correction, the Registrar must give notice of the proposed correction to any person the Registrar considers should be notified of the proposed correction.
- (6C) To avoid doubt, the power to correct is exercisable regardless of whether the error or omission may affect the validity of the registration of a trade mark.”.

12. Section 72 substituted

Section 72—

Repeal the section**Substitute****“72. Power to give preliminary advice etc.**

- (1) The Registrar may give advice on the following matters to a person who proposes to apply for the registration of a trade mark—

-
- (a) without taking section 11(2) into consideration, whether the trade mark is likely to be refused registration on a ground mentioned in section 11;
 - (b) whether the trade mark is likely to be refused registration on a ground mentioned in section 12(1), (2) or (3) because of an existing trade mark.
 - (2) A person who wishes to obtain advice on a matter mentioned in subsection (1) must file a request with the Registrar in the prescribed manner.
 - (3) The Registrar must give advice to the person—
 - (a) on receipt of the request; and
 - (b) on payment of the applicable prescribed fee.
 - (4) If there is a ground for refusing registration in respect of only some of the goods or services covered by the request, the advice does not have to specify the goods or services to which the ground applies.
 - (5) An applicant for the registration of a trade mark is entitled to a refund of the fees paid for filing the application if—
 - (a) the Registrar has given advice under subsection (1) that the trade mark is unlikely to be refused registration on a ground mentioned in section 11 or 12(1), (2) or (3);
 - (b) the applicant makes the application within 3 months after the advice is given;

- (c) the Registrar, after further investigation or consideration, gives notice to the applicant, stating the Registrar's objection to the registration of the trade mark on any specified ground; and
 - (d) the applicant withdraws the application within the prescribed period.
- (6) However, the applicant is not entitled to a refund if—
- (a) a change occurs after the search date in the particulars entered in the register; and
 - (b) the change results in the Registrar's objection mentioned in subsection (5)(c).

(7) In this section—

existing trade mark (現有商標) means a trade mark that has already been entered in the register as at the search date;

search date (查冊日期) means the date of the search of the register by the Registrar for giving advice under this section;

specified ground (指明理由)—

- (a) in relation to advice that a trade mark is unlikely to be refused registration on a ground mentioned in section 11, means that a ground for refusing registration mentioned in that section applies to the trade mark; or
- (b) in relation to advice that a trade mark is unlikely to be refused registration on a ground mentioned in section 12(1), (2) or (3), means that a ground for refusing registration mentioned in those provisions (whichever is

applicable in a particular case) applies to the trade mark.

- (8) In this section (except in the definition of *existing trade mark* in subsection (7)), a reference to a trade mark does not include a certification mark or a collective mark.”.

13. Part XA added

After Part X—

Add

“Part XA

**International Registration of Trade Marks under
Madrid Protocol**

Division 1—General

90A. Interpretation of Part XA

- (1) In this Part—

basic application (基礎申請) means an application filed under section 38 and on the basis of which an international application is made;

basic registration (基礎註冊) means a registration under section 47 and on the basis of which an international application is made;

international application (國際申請) means an application made to the International Bureau through the Registry for registration of a trade mark in the International Register.

- (2) In this Part, a reference to an application filed under section 38 in the definition of *basic application* in subsection (1) includes a reference to an application for registration of a mark dealt with under section 10(1) of Schedule 5.

90B. Rules for implementing Madrid Protocol

- (1) The Registrar may make rules to give effect in Hong Kong to the provisions of the Madrid Protocol.
- (2) Without limiting subsection (1), rules made under this Part may provide for the application of any provision in this Ordinance to the extent and in the way specified in the rules in relation to—
 - (a) an international application;
 - (b) an international designation (HK); or
 - (c) a protected international trade mark (HK).
- (3) Sections 90C, 90D and 90E do not limit the Registrar's powers under subsection (1).

Division 2—International Registration of Trade Marks

90C. Rules for international application

The Registrar may make rules to provide for—

- (a) matters relating to an international application (including the procedure for making or dealing with the application);
- (b) the procedure to be followed when—
 - (i) a basic application fails, or is divided or merged; and

- (ii) a basic registration ceases to be in force, or is merged; and
- (c) the communication of information to the International Bureau.

90D. Rules for international designation (HK) and protected international trade mark (HK)

- (1) The Registrar may make rules to provide for matters relating to an international designation (HK) and a protected international trade mark (HK).
- (2) Without limiting subsection (1), the rules may provide for the following matters—
 - (a) the procedure for dealing with an international designation (HK), including—
 - (i) the examination of the designation by the Registrar;
 - (ii) the publication of the particulars of the designation in the official journal;
 - (iii) the conduct of proceedings for opposing the conferring of protection on the designation; and
 - (iv) the amendment, division or merger of the designation;
 - (b) the communication of information to the International Bureau (including information relating to the Registrar's examination of an international designation (HK));
 - (c) the possible effects of correcting an international registration on an international designation (HK) or a protected international trade mark (HK);

- (d) the protection conferred on a protected international trade mark (HK) and the circumstances in which protection is conferred (including any change in those circumstances);
- (e) the circumstances in which the protection ceases and the procedure to be followed in cases of cessation;
- (f) the keeping of a register that contains matters relating to international designations (HK) and protected international trade marks (HK);
- (g) the correction, amendment or removal of any information in the register;
- (h) the transformation of an international designation (HK), or a protected international trade mark (HK), into an application for registration of the trade mark in Hong Kong;
- (i) the treatment of a protected international trade mark (HK) that is concurrent with a registered trade mark under Article 4*bis*(1) of the Madrid Protocol;
- (j) any matter incidental to or necessary to give effect to a matter mentioned in this section.

Division 3—Miscellaneous

90E. Rules for other matters

The Registrar may make rules to provide for—

- (a) matters relating to payments to the Registry in relation to an international application, an international designation (HK) and a protected international trade mark (HK), including fees and charges;

- (b) the requirements in respect of the documents or other information to be filed with, or served on, the Registrar;
- (c) the rectification by the Registrar of irregularities in the procedure;
- (d) the Registrar's power to—
 - (i) extend any time limit prescribed by the rules;
 - (ii) order security for costs; and
 - (iii) tax costs;
- (e) the inspection of a document and the supply of copies of a document;
- (f) the publication of a notice, order or any other document or matter (whether or not it is required by the rules to be published in the official journal); and
- (g) the record keeping and disposal arrangements of the Registry.”.

14. Section 91 heading amended (rules)

Section 91, heading, after “**Rules**”—

Add

“for general purposes”.

15. Part XIII added

After Part XII—

Add

“Part XIII

Enforcement

Division 1—Interpretation

96A. Interpretation of Part XIII

In this Part—

Commissioner (關長) means the Commissioner of Customs and Excise and includes any Deputy or Assistant Commissioner of Customs and Excise;

court (法院) means a court of competent jurisdiction of the Hong Kong Special Administrative Region and includes a magistrate;

document (文件) includes information recorded in any form;

enforcement officer (執法人員) means—

- (a) a member of the Customs and Excise Service established by section 3 of the Customs and Excise Service Ordinance (Cap. 342); or
- (b) an officer appointed under section 96B(1);

forfeitable item (可予沒收物件) means anything in respect of which an offence under this Ordinance has been committed;

forfeiture application (沒收申請) means an application to the court for an order set out in section 96G(3);

proceeds application (收益申請) means an application to the court for an order set out in section 96H(6);

sale application (售賣申請), in relation to a forfeitable item, means an application to the court for an order set out in section 96H(4);

specified evidence (指明證據) means anything that is or that contains, or that is likely to be, or to contain, evidence of an offence under this Ordinance;

specified recipient (指明收受者), in relation to a forfeitable item, means a person who appears to the Commissioner to be the owner of the item, one of its owners or an owner's authorized agent.

Division 2—Investigation

96B. Appointment of enforcement officers

- (1) The Commissioner may appoint in writing a public officer as an enforcement officer for the purposes of this Ordinance.
- (2) When exercising a power under this Part, an enforcement officer must produce evidence of the officer's identity.

96C. Power to investigate etc.

- (1) If an enforcement officer reasonably suspects an offence under this Ordinance has been or is being committed, the officer may do all or any of the following things for the purposes of conducting an investigation—
 - (a) subject to section 96D, enter and search any place;

- (b) stop, board and search any conveyance that the officer reasonably suspects contains anything that appears to the officer to be specified evidence;
- (c) make any inquiry that the officer reasonably requires for the investigation;
- (d) inspect, examine, search, seize, remove or detain anything that appears to the officer to be specified evidence;
- (e) require a specified person to provide the officer with any information, document or any other thing that the officer reasonably believes to be relevant to the investigation;
- (f) require a specified person to give the officer all other assistance that the officer reasonably requires for the investigation.

(2) In this section—

specified person (指明人士), in relation to an offence that an enforcement officer reasonably suspects has been or is being committed, means—

- (a) a person who has or may have possession or control of any information, document or any other thing relevant to the investigation of the offence; or
- (b) a person who may otherwise be able to assist the officer in relation to the investigation of the offence.

96D. Warrant to enter and search etc.

- (1) Subject to subsection (5), an enforcement officer may only enter and search any place under the authority of a warrant issued under subsection (2).
- (2) A magistrate may issue a warrant authorizing an enforcement officer to enter and search any place if the magistrate is satisfied by information on oath that there is reasonable ground for suspecting that any specified evidence is in the place.
- (3) If a warrant has been issued under subsection (2), an enforcement officer must produce the warrant when exercising a power under this section.
- (4) A warrant issued under subsection (2) authorizes the enforcement officer to—
 - (a) forcibly enter and search the place;
 - (b) inspect, examine, search, seize, remove and detain anything in the place that appears to the officer to be specified evidence; and
 - (c) detain any person found in the place until the place has been searched.
- (5) The Commissioner may authorize an enforcement officer to exercise the power under subsection (1) without a warrant if—
 - (a) there is reasonable ground for suspecting that any specified evidence is in the place; and
 - (b) either—
 - (i) the delay necessary to obtain a warrant is likely to result in the loss or destruction of evidence; or

- (ii) for any other reason it would not be reasonably practicable to obtain a warrant.

Division 3—Arrest, Offences and Forfeiture

96E. Power to arrest etc.

- (1) If an enforcement officer reasonably suspects that a person has committed an offence under this Ordinance, the officer may stop, search, arrest and detain the person without a warrant.
- (2) If any person resists or attempts to evade the search, arrest or detention, an enforcement officer may use any force that is reasonably necessary to effect the search, arrest or detention.
- (3) An enforcement officer who arrests a person may—
 - (a) search the person and the vicinity of the arrest for anything that the officer reasonably suspects is of value (whether by itself or together with anything else) to the investigation of the offence; and
 - (b) search and take possession of the thing.

96F. Offences relating to investigation etc.

- (1) A person commits an offence if the person—
 - (a) in purported compliance with a requirement under section 96C(1)(e), provides any information or document that is false or misleading in a material particular; and
 - (b) knows that, or is reckless as to whether, the information or document is false or misleading in a material particular.

- (2) A person commits an offence if the person—
 - (a) obstructs the enforcement officer in the exercise of the officer's powers or in the performance of the officer's duties under this Part; or
 - (b) fails to comply with a requirement under section 96C(1)(e) or (f).
- (3) A person who commits an offence under subsection (1) or (2) is liable on conviction to a fine at level 3 and to imprisonment for 6 months.
- (4) It is a defence for a person charged with an offence under subsection (2)(b) if the person establishes that at the time of the alleged offence, the person had a reasonable excuse for failing to provide the information or document, or to give the assistance (as the case may be).
- (5) A person charged with an offence under this Part is taken to have established a matter that needs to be established for a defence under this Part if—
 - (a) there is sufficient evidence to raise an issue with respect to that matter; and
 - (b) the contrary is not proved by the prosecution beyond reasonable doubt.

96G. General provision on disposal of things

- (1) The Commissioner may, subject to any conditions the Commissioner considers appropriate and specifies in writing, release a forfeitable item or any other thing seized, removed or detained under this Part to a specified recipient.
- (2) Alternatively, the Commissioner may make a forfeiture application in relation to a forfeitable item.

- (3) On hearing a forfeiture application and being satisfied of compliance with section 96I(1), the court may order that the forfeitable item—
 - (a) be forfeited to the Government;
 - (b) be destroyed; or
 - (c) subject to any condition that the court specifies in the order—
 - (i) be released to its owner, one of its owners or an owner's authorized agent; or
 - (ii) be dealt with in any other way.
- (4) A forfeitable item is liable to forfeiture, destruction or other disposal, whether or not any person has been charged for the offence concerned.

96H. Provision on perishable things

- (1) Without limiting section 96G, this section applies if the Commissioner is of the opinion that a forfeitable item is, by its nature—
 - (a) perishable;
 - (b) difficult to store; or
 - (c) likely to deteriorate before the conclusion of any proceedings relating to it.
- (2) The Commissioner may release the forfeitable item to a specified recipient if the recipient pays the Commissioner by way of security an amount not less than the value of the item as assessed by the Commissioner or an enforcement officer.
- (3) Alternatively, the Commissioner may—

-
- (a) if the Commissioner considers the forfeitable item is perishable, order that it—
 - (i) be sold and the sale proceeds be retained by the Commissioner; or
 - (ii) be destroyed; or
 - (b) if the Commissioner considers the forfeitable item is difficult to store or likely to deteriorate before the conclusion of any proceedings relating to it—make a sale application.
- (4) On hearing a sale application and being satisfied of compliance with section 96I(1), the court may order that the forfeitable item be sold and the sale proceeds be retained by the Commissioner.
- (5) Also, the Commissioner may make a proceeds application.
- (6) On hearing a proceeds application, the court may—
- (a) order the payment made to the Commissioner under subsection (2) to be—
 - (i) forfeited to the Government; or
 - (ii) paid to the person giving the security or the person entitled to claim the payment or the forfeitable item; and
 - (b) order the sale proceeds retained by the Commissioner under subsection (3)(a)(i) or by order under subsection (4) to be—
 - (i) forfeited to the Government; or
 - (ii) paid to the person entitled to claim the proceeds or the forfeitable item.

96I. Notification requirement for certain intended applications

- (1) 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—
 - (a) the application is to be made otherwise than in any proceedings for an offence under this Ordinance; and
 - (b) the owner of the item can be found.
- (2) If there is more than one owner of the forfeitable item, it is sufficient to give notice to one of the owners or an owner's authorized agent.

Division 4—Miscellaneous**96J. International co-operation**

The Commissioner may, for the purpose of promoting international co-operation in the protection of intellectual property rights, disclose any information obtained under this Part to any authority that is responsible for the enforcement of those rights in—

- (a) a Paris Convention country;
- (b) a WTO member; or
- (c) any other country, territory or area as the Commissioner considers appropriate.

96K. Delegation

The Commissioner may, in writing, delegate to a public officer any of his or her functions or powers under this Part.

96L. Immunity from civil liability

- (1) Neither the Commissioner nor an enforcement officer is civilly liable for an act done or omitted to be done by him or her in good faith in—
 - (a) performing or purportedly performing a function conferred on him or her by this Part; or
 - (b) exercising or purportedly exercising a power conferred on him or her by this Part.
- (2) Subsection (1) does not affect any liability of the Government for the act or omission.”.

16. Section 100 added

Before Schedule 1—

Add

“100. Transitional and savings provisions for Trade Marks (Amendment) Ordinance 2019

Schedule 7 sets out transitional and savings provisions that have effect for the purposes of the amendments made to this Ordinance by the Trade Marks (Amendment) Ordinance 2019 (of 2019).”.

17. Schedule 5 amended (transitional matters)

Schedule 5—

Repeal

“[s.”

Substitute

“[ss. 90A &”.

18. Schedule 7 added

At the end of the Ordinance—

Add

“Schedule 7

[s. 100]

**Transitional and Savings Provisions for Trade
Marks (Amendment) Ordinance 2019****1. Interpretation**

In this Schedule—

Amendment Ordinance (《修訂條例》) means the Trade Marks (Amendment) Ordinance 2019 (of 2019);

commencement date (生效日期) means the date on which the Amendment Ordinance is published in the Gazette;

pre-amended Ordinance (《修訂前的條例》) means this Ordinance as in force immediately before the commencement date;

pre-amended Rules (《修訂前的規則》) means the Trade Marks Rules (Cap. 559 sub. leg. A) as in force immediately before the commencement date.

2. Applications for registration filed under section 38 of pre-amended Ordinance

- (1) If an application for registration of a trade mark has been filed before the commencement date under section 38(1) of the pre-amended Ordinance (***old application***), but is still pending on that date, the pre-

amended Ordinance and the pre-amended Rules continue to apply in relation to that application.

- (2) However, if, on or after the commencement date, a request to amend an old application under section 46 is filed, the provisions of this Ordinance apply in relation to the request.”.
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Part 3

Amendments to Trade Marks Rules (Cap. 559 sub. leg. A)

19. Rule 11 amended (deficiencies in application)

(1) Rule 11(2)(a)—

Repeal

“section 38(1), (2)(e), (3), (4) or (5)”

Substitute

“section 38(1), (2)(a)(iii) or (vi) or (b)(v), (3) or (4)”.

(2) Rule 11(2)(b)—

Repeal

“section 38(2)(a), (b), (c) or (d)”

Substitute

“section 38(2)(a)(i), (ii), (iv) or (v) or (b)(i), (ii), (iii) or (iv) or (5)”.

20. Rule 29 amended (registration)

After rule 29(1)(d)—

Add

“(da) for an owner that is a corporation—the place under the law of which the corporation was formed and registered, incorporated or established;”.

21. Rule 63 amended (entry in the register of particulars of registrable transaction)

(1) Rule 63(1)(a)(i)—

Repeal

“; and”

Substitute a semicolon.

- (2) After rule 63(1)(a)(i)—

Add

“(ia) for an assignee that is a corporation—the place under the law of which the corporation was formed and registered, incorporated or established; and”.

- (3) After rule 63(1)(b)(i)—

Add

“(ia) for an assignee that is a corporation—the place under the law of which the corporation was formed and registered, incorporated or established;”.

- (4) Rule 63(1)(e)(i)—

Repeal

“; and”

Substitute a semicolon.

- (5) After rule 63(1)(e)(i)—

Add

“(ia) for a person mentioned in subparagraph (i) that is a corporation—the place under the law of which the corporation was formed and registered, incorporated or established; and”.

- (6) After rule 63(1)(f)(i)—

Add

“(ia) for a transferee that is a corporation—the place under the law of which the corporation was formed and registered, incorporated or established;”.

22. Rule 66 amended (correction of errors or omissions in the register)

(1) Rule 66—

Repeal subrule (1).

(2) Rule 66(2)—

Repeal

“subrule (1)”

Substitute

“section 57(6B) of the Ordinance”.

(3) Rule 66—

Repeal subrule (3)

Substitute

“(3) If any person to whom a notice is sent under section 57(6B) of the Ordinance files written objections within the period specified in subrule (2), the Registrar must consider the objections and—

(a) if satisfied that the objections have merit—not make the proposed correction; or

(b) if satisfied that the objections have no merit—make the proposed correction.”.

23. Rules 72 and 73 repealed

Rules 72 and 73—

Repeal the rules.

24. Rule 73A added

At the end of Part 10—

Add

- “73A. Preliminary advice by Registrar**
(s. 72 of the Ordinance) (Form T1) (Fee Nos. 24, 25 & 25A)
- (1) A request filed under section 72(2) of the Ordinance must be in the specified form.
 - (2) The request must—
 - (a) include a representation of the trade mark that is proposed to be registered; and
 - (b) specify the goods or services (classified in accordance with the International Classification) for which the trade mark is proposed to be registered.
 - (3) The period prescribed for the purposes of section 72(5)(d) of the Ordinance is the 6-month period beginning on the day after the date on which the Registrar gives a notice of objection under section 72(5)(c) of the Ordinance.”.

25. Rule 95 amended (non-extendible time limits)

- (1) Rule 95, English text, heading—

Repeal

“Non-extendible”

Substitute

“Non-extendable”.
- (2) Rule 95(1)—

Repeal paragraph (q)

Substitute

“(q) rule 73A(3) (time limit for the purposes of section 72(5)(d) of the Ordinance);”.

26. Schedule amended (fees)

- (1) The Schedule, Fee No. 24—

Repeal

“search of records under rule 72”

Substitute

“Registrar’s advice on the matter referred to in section 72(1)(a) of the Ordinance”.

- (2) The Schedule, Fee No. 24—

Repeal

“preliminary advice under rule 73”

Substitute

“advice on the matter referred to in section 72(1)(b) of the Ordinance”.

- (3) The Schedule, Fee No. 25—

Repeal

“preliminary advice under rule 73”

Substitute

“advice on the matter referred to in section 72(1)(b) of the Ordinance”.

- (4) The Schedule, Fee No. 25—

Repeal

“search of records under rule 72”

Substitute

“Registrar’s advice on the matter referred to in section 72(1)(a) of the Ordinance”.

- (5) The Schedule, Fee No. 25A—

Repeal

“search of records under rule 72 and for Registrar’s preliminary advice under rule 73”

Substitute

“Registrar’s advice on the matters referred to in section 72(1)(a) and (b) of the Ordinance”.

Part 4

Consequential Amendments to Trade Descriptions Ordinance (Cap. 362)

27. Section 2 amended (interpretation)

- (1) Section 2(1), definition of *trade mark*—

Repeal

“means—”

Substitute

“means any of the following—”.

- (2) Section 2(1), Chinese text, definition of 商標, paragraph (a)—

Repeal

“指”.

- (3) Section 2(1), Chinese text, definition of 商標, paragraphs (b), (c) and (d)—

Repeal

“亦指”.

- (4) Section 2(1), definition of *trade mark*, after paragraph (d)—

Add

- “(e) a protected international trade mark (HK) as defined by section 2(1) of the Trade Marks Ordinance (Cap. 559);”.
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Explanatory Memorandum

The main purposes of this Bill are to amend the Trade Marks Ordinance (Cap. 559) (*Ordinance*) to provide for the implementation of an international registration system of trade marks (*Madrid system*), to enhance the mechanism for registering trade marks, and to provide for enforcement matters.

2. The Bill is divided into 4 Parts.
3. Clause 1 sets out the short title and provides for commencement.

Madrid Protocol and System for International Registration of Trade Marks

4. The proposed legislation for implementing the Madrid system seeks to give effect in Hong Kong to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (*Madrid Protocol*).
5. The Madrid system has been established to facilitate the registration and management of trade marks in the contracting parties to the Madrid Protocol. The Madrid system is administered by the International Bureau of the World Intellectual Property Organization (*International Bureau*).
6. In accordance with the Madrid system, an international application in respect of a trade mark may be filed through the Trade Marks Registry in the Intellectual Property Department (*Registry*). The Registry acts as an office of origin for registering trade marks in the register maintained by the International Bureau (*International Register*). Also, the Registry

may, as a designated office, receive from the International Bureau requests for extending the protection of a trade mark registered in the International Register to Hong Kong (*international designation (HK)*).

Amendments to Ordinance for International Registration of Trade Marks

7. Clause 3 amends the long title of the Ordinance. Clause 5 amends section 5 of the Ordinance so that after the Madrid system is implemented in Hong Kong, an international trade mark (HK) may also be an earlier trade mark in relation to another trade mark. Clause 13 adds a new Part XA to the Ordinance to empower the Registrar of Trade Marks (*Registrar*) to make rules to implement the Madrid system.
8. Division 1 (new sections 90A and 90B) of the new Part XA defines terms for the interpretation of that Part and empowers the Registrar to make rules to give effect in Hong Kong to the provisions of the Madrid Protocol.
9. Division 2 (new sections 90C and 90D) of the new Part XA empowers the Registrar to make rules to deal with international applications and international designations (HK).
10. Division 3 (new section 90E) of the new Part XA contains enabling provisions for other matters relating to the implementation of the Madrid system.

Enhancing Mechanism for Registering Trade Marks

11. Section 38 of the Ordinance states the particulars that must be included in an application for registration of a trade mark. Clause 8 amends that section to require a corporate applicant

to provide information as to its place of incorporation (or its equivalent). Clauses 19, 20 and 21 make related amendments to the Trade Marks Rules (Cap. 559 sub. leg. A) (*Rules*). Clause 4 makes technical amendments to the definition of *corporation* to bring it into line with definitions in recent legislation.

12. To enhance fairness of the registration system of trade marks, clause 9 amends section 39 of the Ordinance to require application fees to be paid before an application for registration of a trade mark is given a filing date.
13. Clause 10 amends section 46(2) of the Ordinance to allow the representation and the registered particulars of a registered trade mark to be added to an application for registration of a trade mark under certain conditions if the Registrar considers appropriate. One of the conditions is that the application is made in respect of any or all of the goods or services for which the registered trade mark is registered.
14. Clause 11 amends section 57 of the Ordinance to make it possible to apply to the Registrar to correct errors or omissions in the register that are attributable to the Registrar. Clause 22 amends rule 66 of the Rules to provide for the related procedures.
15. Clause 12 amends section 72 of the Ordinance to allow the Registrar to give preliminary advice as to whether a prospective application for registration of a trade mark is likely to be refused on a ground specified in that section. The amended section 72 also clarifies when an applicant can be refunded the application fee of an application to register a trade mark. Clause 23 repeals rules 72 and 73 of the Rules and clause 24 adds a new rule 73A to the Rules to set out the requirements

for a request for the advice. Clauses 25 and 26 make related amendments to the Rules.

Technical Amendments

16. Section 12(4) of the Ordinance currently provides that a trade mark identical or similar to an earlier trade mark (that is entitled to protection under the Paris Convention as a well-known trade mark) must not be registered if certain conditions exist. Clause 6 amends that section so that the Registrar, when determining whether a trade mark is registrable, does not have to consider whether the goods or services for which the trade mark is proposed to be registered are identical or similar to those for which the earlier trade mark is protected.
17. Clause 7 makes a similar amendment to section 18(4)(a) of the Ordinance, which explains when a registered trade mark is infringed. Under the amended section 18(4)(a), in determining whether a person who uses a sign infringes a registered trade mark (that is entitled to protection under the Paris Convention as a well-known trade mark), it is irrelevant whether the goods or services relating to the sign are identical or similar to those for which the well-known trade mark is registered.

Enforcement Powers

18. Clause 15 adds a new Part XIIA to the Ordinance to provide for enforcement powers in relation to the offences under the Ordinance.
19. Division 1 (new section 96A) of the new Part XIIA defines terms for the interpretation of that Part.

20. Division 2 (new sections 96B, 96C and 96D) of the new Part XIA provides for the appointment of enforcement officers by the Commissioner of Customs and Excise (*Commissioner*) and their powers of investigation.
21. Division 3 (new sections 96E to 96I) of the new Part XIA covers the enforcement officers' powers of arrest and provides for the forfeiture of items seized in exercising powers under that Part. It also contains offence provisions regarding non-compliance with enforcement officers' requirements during investigation.
22. Division 4 (new sections 96J, 96K and 96L) of the new Part XIA deals with miscellaneous matters, such as the Commissioner's co-operation with authorities outside Hong Kong and the delegation of powers by the Commissioner.
23. Clauses 16 and 18 add a new Schedule 7 to the Ordinance setting out transitional provisions relating to the amendments in the Bill.
24. Clause 27 makes consequential amendments to the Trade Descriptions Ordinance (Cap. 362).