

立法會
Legislative Council

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Paper for the House Committee meeting on 19 May 2000

Report of the Bills Committee on Trade Marks Bill

Purpose

This paper reports on the deliberations of the Bills Committee on Trade Marks Bill.

Background

2. Hong Kong has had an independent trade mark registration system since 1873. The Trade Marks Ordinance (TMO) (Cap. 43) sets out the criteria and the procedures for registration and maintenance of trade marks. As TMO has remained largely unchanged since 1955, there is a need to modernize the legislation on trade mark to keep it in line with prevailing international practice on the protection of intellectual property rights.

3. In 1993 the Administration issued a consultation paper entitled "Review of the Trade Marks Ordinance" which outlined the proposals for the modernization of the trade marks regime in Hong Kong. Following that, the first and the second drafts of the Trade Marks Bill were issued for consultation in 1997 and 1998 respectively. The LegCo Panel on Trade and Industry also gave views on the second draft of the bill in December 1998.

The Bill

4. The Trade Marks Bill was introduced into the Council on 5 May 1999, aiming at modernizing the trade mark law of Hong Kong, taking into account international development in the protection of intellectual property rights. The Bill intends to provide for enhanced protection to trade mark owners and simplify the application and maintenance procedures of registered trade marks.

The Bills Committee

5. Members agreed at the House Committee meeting on 7 May 1999 to

form a Bills Committee to study the Bill. Hon Margaret NG was elected Chairman of the Bills Committee. A copy of the membership list of the Bills Committee is at **Appendix I**.

6. The Bills Committee has conducted a total of 23 meetings. In view of the complexity of the Bill, the Bills Committee has found it necessary to invite interested parties and professional groups to give views on the policy and technical aspects. Two rounds of consultations were conducted on the proposal concerning parallel importation in the Bill. The Bills Committee met 22 deputations and received 46 written submissions. The Administration was invited to each of its meetings to exchange views with members on the details of the Bill and respond to the views expressed by the deputations. A list of the deputations which have made oral presentation to the Bills Committee is at **Appendix II**.

Deliberations of the Bills Committee

7. Recognizing that the Bill is an important piece of legislation on the protection of intellectual property, members of the Bills Committee have examined both the policy and technical aspects of the Bill in depth. Taking into account the concerns raised by deputations and the contents of the Bill, members of the Bills Committee have focused their deliberations mainly on the following broad areas:

- (a) need for introducing the Bill;
- (b) scope of registration and protection of trade marks;
- (c) registration criteria and application procedures; and
- (d) infringement of registered trade marks, including parallel importation, and related proceedings.

8. Under each of the broad areas, major issues have been identified by members for close scrutiny. The deliberations of the Bills Committee on each of these major issues are summarized below.

Need for introducing the Bill

9. The Bills Committee notes that the enactment of the World Trade Organization Amendments Ordinance 1996 before the change of sovereignty has ensured the compliance of the local intellectual property laws with the relevant World Trade Organization (WTO) requirements. As such, there appears no immediate need for implementing a new trade mark law. However, the Bills Committee accepts the Administration's explanation that most provisions of TMO have remained largely unchanged since 1955. There is a

need to provide transparency in the current TMO for meeting the minimum standards for the protection of intellectual property under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of WTO. Development of trade mark laws in other common law jurisdictions also provides an impetus for Hong Kong to reform its law. The United Kingdom (UK), Australia, New Zealand, Ireland, India, Singapore and South Africa have all modernized their trade mark laws in recent years. If the present trade mark law remains unchanged, Hong Kong will be lagging behind by international standard.

10. The Bills Committee notices that the Bill is closely modelled on the UK Trade Marks Act 1994 (the 1994 Act) which was enacted to bring in the European Harmonization Directives. These Directives however do not apply to Hong Kong. In explaining the reason for adhering closely to the 1994 Act, the Administration has pointed out that the current TMO was in fact modelled on the UK Trade Marks Act 1938. It is therefore logical for the Bill to follow closely the 1994 Act in order to maintain continuity. The reform of the trade marks laws in Ireland, Singapore, Australia and South Africa has also been based on the 1994 Act. Hong Kong will have the advantage of guidance from a large number of case law, even though the cases are of persuasive authority to the courts only.

Scope of registration and protection of trade marks

(i) Registrable trade marks (Clause 3)

11. Members of the Bills Committee welcome the removal of the present requirement that a trade mark has to be visually perceptible. Under the broadened definition of trade mark in the Bill, sound marks and smell marks which hitherto are unregistrable may be registered. Notwithstanding this policy intention, members consider that the proposed definition in the Bill has failed to reflect this clearly. To put the policy intention beyond doubt, the Administration has taken on board the suggestion of the Bills Committee to move an amendment to clause 3(2) of the Bill to make express reference to sound and smell as registrable marks.

12. As regards shape, members note that the Bill disallows the registration of a sign as a trade mark if it consists exclusively of a shape which results from the nature of the goods themselves, or is necessary to obtain a technical result, or adds substantial value to the goods. Members accept the rationale behind such a policy which exists in the present law. Members agree that the function of a trade mark is to indicate the origin of goods. If the shape of goods serves a utilitarian purpose, this should be protected by way of patents or registered designs and not by trade mark. The rights conferred by a patent or a registered design last for a limited period of time. Upon the expiry of the prescribed period under the relevant laws, these rights will be exhausted and other persons will be free to use the goods. However, if the shape is allowed

to be registered as a trade mark, the owner could monopolize the use indefinitely since the existing law or the Bill allows automatic renewal of the registration of a trade mark, subject to the payment of a prescribed fee.

(ii) *Well-known trade marks (Clause 4)*

13. On well-known trade marks, members of the Bills Committee support the incorporation of provisions concerning the protection of these trade marks but note with concern the absence of their meaning in the Bill. The Administration admitted that there was no international consensus on the meaning of well-known trade marks when the Bill was being drafted. However, in September 1999 the World Intellectual Property Organization (WIPO) passed a joint resolution concerning provision on the protection of well-known trade marks. In view of this development, the Administration accept members' view on the need to specify in the Bill the criteria for determining what is a well-known trade mark in Hong Kong. Based on the recommendation of WIPO, the Administration proposes to set out in Schedule 2 to the Bill a list of non-exhaustive factors for consideration by the Registrar of Trade Marks and the court in determining whether a trade mark is well known in Hong Kong. A Committee Stage amendment will be moved in this respect.

Registration criteria and application procedures

(i) *Registration test (Clauses 10 and 11)*

14. Concern has been raised by some deputations that the Bill seems to impose an additional registration criterion, namely that a sign must possess *inherent* capacity to distinguish the goods or services of one undertaking from those of other undertakings before it could be registered as a trade mark. Their concern arises because of the wording of the provision concerning absolute grounds for refusal of registration of trade marks. Clause 10(1) of the Bill provides, amongst other things, that trade marks which are "devoid of any distinctive character" should not be registered. These deputations are of the view that this phrase, reading together with the definition of a trade mark in clause 3(1) which stipulates that a trade mark must be "capable of distinguishing" goods and services of one undertaking from those of other undertakings, may be interpreted to mean that a trade mark need to have inherent distinctiveness. This would change the registration test under the present law, making it more difficult to apply successfully for registration of a trade mark.

15. The Administration does not agree with this analysis. It has pointed out to members that the proposed definition of trade mark in the Bill follows that in the TRIPS Agreement. Contrary to the view of those deputations, the Bill has discarded precisely the notion of inherent distinctiveness of a sign under the existing TMO. At present, a trade mark which is perfectly

distinctive in fact could be refused registration if it does not have the inherent capacity to distinguish the goods of one undertaking from those of other undertakings. However, under the Bill, a mark which is considered not distinctive could be registered if it has become distinctive through use before the date of application for registration. Members note that the relevant provisions in the Bill have been interpreted in a number of court cases in the UK. Since this provides clear guidance on their meaning, the deputations' concern could be allayed.

16. The Administration has taken on board the suggestion of the Bills Committee to remove the power of the Registrar of Trade Marks to refuse registration of a trade mark identical or similar to an earlier trade mark if the owner of the earlier trade mark consents to the registration. A Committee Stage amendment to clause 11(8) will be moved by the Administration to achieve the purpose.

(ii) Time limits for trade mark application (Clause 40)

17. The lack of guidelines on the time limit within which an applicant may respond to the rejection of a trade mark application by the Registrar has been another cause of concern to deputations. The Administration's original intention is to specify that time limit in the work manual to facilitate future amendment. The trade considers such an approach unacceptable precisely on the ground that the work manual could be amended by the Registrar without going through any legislative process. Members appreciate the need to give flexibility to the Administration in making amendment but at the same time consider it necessary to provide fairness and certainty to trade mark practitioners. After discussion, the Administration agrees to specify all time limits and extensions of time in relation to trade mark application, opposition and proceedings in the Trade Marks Rules. A Committee Stage amendment will be moved to clause 40 to achieve the effect.

18. Members take note that the proposed time limits and extensions of time in relation to trade mark application in the draft Trade Marks Rules largely follow the existing arrangement. According to the Administration, the draft Rules will be finalized after thorough consultation with the trade and the Bill, if passed, will come into operation in 2001 after the Rules are ready. Since consultation on the Rules is underway and the Rules, being subsidiary legislation, will be subject to the scrutiny of the Legislative Council after gazettal, members have decided not to examine the draft Rules in depth in the context of the Bills Committee.

Infringement of registered trade mark and related proceedings

(i) Infringement test (Clause 17)

19. Whether the test for infringement of registered trade marks under the

Bill is the same as that under TMO has been examined by the Bills Committee. Some depositions have drawn members' attention to the requirement in the Bill that there must be confusion on the part of the public as to the origin of goods in order to establish infringement. They consider that this requirement which is absent in the existing law should be deleted. According to the Administration, the element of confusion exists in the present provisions of TMO. This element is crucial because the function of a trade mark is to suggest origin of goods. A person infringes a trade mark if he uses in the course of business a similar or identical sign which would make the customer believe that his goods are associated with the goods provided by the owner of the trade mark. This test of confusion has been used for establishment of infringement cases over the years. It covers likelihood of confusion without actual instances of confusion. Members accept that the element of confusion is necessary because without which many trade marks which could be legitimately used in the market will be knocked out, making the law over-protective on the rights of the registered trade mark owners.

(ii) *Comparative advertising (Clause 17(7))*

20. The proposal to legitimize comparative advertising is another issue of concern to the Bills Committee under the scope of infringement. Comparative advertising is advertisement in which a trader uses a competitor's trade mark to identify his product for comparison purpose. The Bill allows comparative advertising provided that the use of the competitor's trade mark is honest and does not take unfair advantage of or is detrimental to the repute of the mark. The discussion of the Bills Committee revolves around two aspects, namely whether there is a need for an express provision on comparative advertising, and whether the proposed provision sets out categorically the circumstances under which comparative advertising does not infringe a trade mark.

21. Members take note that at present, comparative advertising is an infringement if the trade mark quoted in the advertisement has been registered in Part A of the trade mark register. The position as regards trade marks in Part B of the register is uncertain as there is no definitive case law on the issue. According to the Administration, an express provision on comparative advertising in the local law is necessary to enshrine the principle in Article 10 *bis* of the Paris Convention on Protection of Industrial Property (the Paris Convention) to outlaw unfair competition. As defined in the Paris Convention, unfair competition means any act of competition contrary to honest practices in industrial or commercial matters. In the Administration's view, provided that the advertisement is honest, it is reasonable to allow product or service providers to inform consumers of the relative merits of competing products.

22. Whilst accepting the Administration's explanation on the need for a provision on comparative advertising to fulfil treaty obligations, members consider that it is not clear in the proposed provision as to the circumstances under which the use of a competitor's trade mark will not be considered an

infringement. They also notice that there is no express reference to "advertising" in the provision. The Administration has explained that whether advertising is done in accordance with honest practices is the determining factor. The test of honesty is objective. Honesty is determined by what is reasonably expected by the relevant consumers of the goods or services. The provision in the Bill is modelled on the UK 1994 Act and has been interpreted in a number of court cases. Notwithstanding, for the purpose of allaying members' concern, the Administration agrees to revise the provision to make it more explicit the factors which may be considered by the court in determining the meaning of honest practices. These factors include, among others, whether the use of the trade mark in advertising is to deceive the public, as suggested by members. The Administration also agrees to make an express reference to "advertising" in the heading of the provision without changing the policy intention that the provision will cover situations other than advertising. The Administration will add a new clause 19A to replace clause 17(7) to achieve the purpose.

(iii) Parallel importation of trade mark articles (clause 19)

23. The most contentious issue considered by the Bills Committee lies with the proposal concerning parallel importation of trade mark articles. Parallel imports are products that are legitimately produced and marketed abroad with the consent of the owner of the intellectual property right but are then imported into a country or territory without the agreement of that owner or the exclusive licensee in the place of importation. Clause 19(1) of the Bill provides that once a trade mark article has been put on the market anywhere in the world with the consent of the owner, whether express or implied or conditional or unconditional, the rights of the owner will be exhausted. This is called international exhaustion of rights. Put it in another way, once the trade mark owner has consented to the selling of goods bearing his trade mark anywhere in the world, he could not take infringement actions against parallel importers. Clause 19(2) provides an exception whereby the owner can prevent parallel importation if the conditions of the parallel-imported goods have been changed to the detriment of the distinctive character or repute of the trade mark.

24. Views received by the Bills Committee on the subject are divided. Organizations which are in favour of the proposal to liberalize parallel importation stress that parallel importation makes available to consumers wider choices of goods at cheaper prices. Parallel imports are genuine goods and not counterfeit or sub-standard products. Any difference between parallel-imported goods and mainstream goods is a matter of choice rather than of substance or quality. Hong Kong consumers are sophisticated enough to differentiate between various kinds of products under the same brand name. Goods which are of limited demand or which cater for a small segment of the community are normally not supplied by authorized distributors; parallel importation fills up this gap. The supporters of the liberalization proposal

share the Administration's view that the proposal is in line with the free trade policy of Hong Kong and the irreversible trend of globalization of the world market. The development of electronic commerce makes it difficult if not impossible to set territorial boundaries to restrict circulation of goods.

25. Equally forceful arguments have been put forth by organizations objecting the liberalization proposal. The opponents have pointed out that many major trading partners of Hong Kong including the United States and the European Union have not adopted the policy of international exhaustion of rights. If Hong Kong adopts this policy unilaterally, it will only put itself in a disadvantaged position. Parallel importers are free-riders, taking unfair advantage of the efforts and the resources made by trade mark owners and authorized distributors in building up the reputation of the trade mark and in marketing the trade mark goods. Liberalization of parallel importation discourages trade mark owners from investing in brands and in developing new products. Authorized distributors have no choice but to reduce promotional and marketing activities in order to make the mainstream goods more competitive. These chain effects will adversely affect the employment opportunities in certain sectors, notably the advertising field, and the economy of Hong Kong in the long run. From the consumers' perspective, the liberalization proposal is not without disadvantage. The reasons are that parallel imports generally have a shorter shelf-life. Apart from the fact that after-sales services are not available, the quality of parallel imports is a cause for concern, in particular that of pre-packed food, beverages and pharmaceuticals. The opposing organizations stress that permitting parallel imports makes it more difficult to prevent and to identify counterfeits. It would also make Hong Kong become a dumping ground for expired or low quality goods.

26. Recognizing that the issue of parallel importation is complex and there is no international consensus on the subject, members of the Bills Committee have taken a very prudent approach to examine the proposal in the Bill. The first question raised by members is whether clause 19 changes the existing law. According to the Administration, the existing provisions in TMO are ambiguous as regards parallel importation. Clause 19 of the Bill clarifies the existing law and puts it in clear terms the adoption of the principle of international exhaustion of rights. The Administration has stressed that it has consistently upheld the policy of free trade and has not objected to parallel importation. In practice, there is a proliferation of businesses selling parallel-imported goods.

27. Members of the Bills Committee do not agree with the Administration's view that clause 19 merely clarifies the existing law as regards parallel importation. As understood by members, under section 27(3) of TMO, parallel importation will not infringe a trade mark owner's right if the owner has at any time, expressly or impliedly, consented to the use of the trade mark. It would depend on the facts of each case to determine whether the owner has

given his consent and whether parallel importation infringes his rights. If it can be proved that he has not given express or implied consent, he may then sue a parallel importer for infringement, although this has never been successfully tested in local courts. Since clause 19 expressly legitimizes parallel importation, the conclusion reached by members is that it does change the existing law.

28. Members of the Bills Committee appreciate that parallel importation is a fact of life and could not be prohibited. However, in liberalizing parallel importation, members consider it essential to ensure that consumers' interests are adequately safeguarded. Members are concerned in particular about safety of goods put on the market and whether consumers are provided with sufficient information on goods at the time of purchase. In this context, members of the Bills Committee have critically examined the adequacy or otherwise of the existing safety and labelling requirements on goods.

29. According to the Administration, specific legislation governing safety and labelling requirements have been put in place for certain products such as pharmaceutical products, foodstuff, tobacco, electrical appliances and children products, taking into account their unique characteristics. All consumers goods not covered by specific legislation are governed by the Consumer Goods Safety Ordinance (Cap. 456). This Ordinance imposes a statutory duty on manufacturers, importers and suppliers of consumer goods to ensure the safety of goods supplied for local consumption. The safety requirements in different statutes apply to all goods supplied for local consumption regardless of whether they are mainstream goods or parallel imports. In the Administration's view, the existing safety requirements on goods are adequate and there is no compelling reason for imposing additional statutory labelling requirements solely because of the liberalization of parallel importation. Any such requirement will inevitably increase the cost of goods which will ultimately be borne by consumers.

30. As far as safety of goods is concerned, members accept that the existing laws are adequate. As regards labelling of goods, members notice that the various legislation governing specific products require the provision of the name and address of the manufacturer of goods. However, none of the existing laws concerning consumer goods, except for toys and children's products, requires the labelling of the importer of goods. Such information is useful to consumers as they could know where to seek redress should they have bought defective or substandard goods. In this connection, members take note of the grievances of authorized distributors that on various occasions consumers have wrongly lodged complaints with them and hold them liable for supplying defective parallel-imported products. Members appreciate that requiring the provision of information on the importer of goods in addition to the existing labelling requirements may increase the costs of goods to a very limited extent but consumers' interests should not be assessed solely from the perspective of the price of goods. Given the varied quality of parallel imports,

the majority of members of the Bills Committee consider it necessary in the interest of consumers to require the provision of information on the importer of goods in proceeding with the proposal to liberalize parallel importation. These members therefore propose to amend clause 19 of the Bill to the effect that parallel importation of trade mark goods does not infringe the registered trade mark provided that the person who imports the goods into Hong Kong for sale is identified when the goods are put on the retail market. Members reckon that labelling of the importer on goods may not be the best or a practicable way in some circumstances in view of the myriad types of goods on the market. Different ways to identify the importer of goods would be accepted. The name and address of the importer could be marked on the goods, the package of the goods, a label affixed to the package, a document enclosed in the package, or a document which is exhibited in a conspicuous place where the goods are displayed for sale. The proposed amendment will also allow any other ways to identify the importer as provided by the Trade Marks Rules. To give legislative effect to the proposal, the majority of members of the Bills Committee agree that Hon Margaret NG shall move amendments to clause 19 on behalf of the Bills Committee.

31. The Administration objects to the proposed amendments to clause 19. Its reasons are that providing consumers with information on the importer of goods will not enhance their interest. Consumers seldom turn to the importer as the first port of call if they have bought defective goods. Often they would seek remedy from the retailer. Given that there is no contractual relationship between consumers and the importer, consumers could not seek compensation from the importer even they know who he is. Moreover, since clause 19 concerns parallel-imported goods only, the proposed requirement for identifying the importer will not apply to mainstream goods. Should this requirement be implemented, parallel importers will not be competing on a level-playing field with importers of mainstream goods.

32. Hon CHAN Kam-lam indicates that he supports the provision of more information on goods to consumers. However, he considers that the proposal to identify the name and address of the importer of goods may not achieve the intended purpose of enhancing consumers' interest. Moreover, since the proposed requirement only applies to parallel imports, it will have stigmatization effect. He therefore objects the proposed amendment to clause 19.

(iv) Relief from groundless threats of infringement proceedings (Clause 24)

33. The inclusion of provisions in the Bill on the remedy against groundless threats of infringement proceedings has been vigorously discussed by the Bills Committee. The Bill provides for relief from groundless threat of infringement proceedings by way of declaration that the threats are unjustifiable, injunction against continuance of the threats and damages. In examining the need for such provisions, members recognize the pernicious

nature of threats of intellectual property proceedings and their ability to inflict commercial damages even where the claims are not pursued. Fear of high cost of defending an intellectual property claim is often sufficient to bring the person who has received the threat of infringement proceedings to succumb. A typical example is to cease supplying the allegedly infringed trade mark goods. To prevent the making of totally unsupported allegations of trade mark infringement, members accept the need for the provisions for relief from groundless threats. Members take note that similar provisions are found in the Patents Ordinance (Cap.514), the Registered Designs Ordinance (Cap.522) and the Copyright Ordinance (Cap.528).

34. After establishing the need for the provisions on remedy for groundless threat of infringement proceedings, the Bills Committee has assessed the merits of providing exemption from liability for trade mark agents and legal practitioners who act in their professional capacity. In this connection, members take note that different intellectual property laws treat the matter differently. Whilst the Patents Ordinance and the Registered Designs Ordinance do not provide for such immunity, the Copyright Ordinance includes an exemption provision. Likewise, different jurisdictions handle the subject in different ways. The trade mark laws in Australia and India exempt trade mark agents and legal practitioners from liability, whereas those in the UK, Ireland and Singapore do not. To address the concern of deputations and in view of the absence of a registration system for trade mark agents in Hong Kong now, members suggest and the Administration agrees to provide exemption for barristers and solicitors from liability to proceedings for any act done by him in a professional capacity on behalf of a client. The Administration will move an amendment to add a new clause 24(7) to achieve the effect.

(v) *Cost of Infringement proceedings and burden of prove (Clauses 81 and 85)*

35. The way in which the Bill deals with costs of proceedings relating to trade marks has been criticized by members of the Bills Committee. Under the Bill, the court may award to any party such costs as it may consider reasonable but it could not order the Registrar of Trade Marks to pay the costs of any other party to the proceedings. Members consider such an arrangement unfair. It has been a well-established principle that cost follows the event and the losing party pays costs. Where a party is aggrieved by the Registrar's decision and has been vindicated on appeal to the court, it is unreasonable that he has to shoulder the costs of the proceedings which has been initiated because of a wrong decision made by the Registrar in the first place. After discussion, the Administration agrees to remove the exemption for the Registrar from liability to the costs of court proceedings. It has also agreed to permit the licensee of a registered trade mark to show use of the mark in proceedings in which a question arises as to the use of the mark. Committee Stage amendments will be moved to clause 81 and clause 85 to achieve the effect.

Consolidation of trade mark laws

36. Members notice that there are now two different ordinances to deal with trade mark matters. TMO covers civil actions including infringement and rectification of the trade mark register, whereas the Trade Descriptions Ordinance (Cap.362) tackles criminal wrongs. Whilst reckoning the different criteria for instituting civil as opposed to criminal proceedings, members have called on the Administration to incorporate the relevant provisions in the Trade Descriptions Ordinance in the Trade Marks Bill at appropriate time in future, so that all provisions relevant to one subject will be contained in one piece of legislation.

37. The Administration has accepted members' suggestion to repeal amendments to certain provisions in the Trade Descriptions Ordinance which are not consequential to the passage of the Bill. Committee Stage amendments will be moved to delete clauses 7, 8 and 11 in Schedule 4 to the Bill..

Committee Stage amendments

38. Other than the major Committee Stage amendments mentioned in the foregoing paragraphs, the Administration has taken on board the Bills Committee's suggestions to improve the text of the Bill and will move the relevant amendments. A copy each of the Committee Stage amendments to be moved by the Administration and Hon Margaret NG on behalf of the Bills Committee are at **Appendices III and IV** respectively.

Recommendation

39. The Bills Committee recommends the resumption of the Second Reading debate on the Bill on 31 May 2000.

Advice sought

40. Members are requested to support the recommendation of the Bills Committee at paragraph 39 above.

Legislative Council Secretariat

18 May 2000

Bills Committee on Trade Marks Bill

Membership list

Hon Margaret NG (Chairman)

Hon Kenneth TING Woo-shou, JP

Hon Mrs Selina CHOW LIANG Shuk-ye, JP

Hon MA Fung-kwok

Hon James TO Kun-sun

Hon HUI Cheung-ching

Hon CHAN Kam-lam

Hon Mrs Sophie LEUNG LAU Yau-fun, JP

Hon SIN Chung-kai

Hon FUNG Chi-kin

Total : 10 members

Appendix II

Bills Committee on Trade Marks Bill

Name of organizations meeting with the Bills Committee

- (1) China Patent Agent (HK) Ltd
- (2) Consumer Council
- (3) Deacons Graham & James
- (4) Hong Kong & Kowloon Electrical Appliances and Merchants Association Limited
- (5) Hong Kong Photo Marketing Association
- (6) Hong Kong Retail Management Association
- (7) International Trademark Association
- (8) Liquor and Provision Industries Association
- (9) Lloyd Wise & Co
- (10) Pepsico Inc.
- (11) Radio Association of Hong Kong
- (12) Swiss Business Council in Hong Kong
- (13) The American Chamber of Commerce in Hong Kong
- (14) The British Chamber of Commerce in Hong Kong
- (15) The Cosmetic & Perfumery Association of Hong Kong Ltd
- (16) The Hong Kong Association of the Pharmaceutical Industry
- (17) The Hong Kong Brewers Association
- (18) The Hong Kong Food Council
- (19) The Hong Kong Group of Asian Patent Attorneys Association
- (20) The Hong Kong Institute of Trade Mark Practitioners
- (21) The Law Society of Hong Kong
- (22) Unilever Hong Kong Ltd

TRADE MARKS BILL

COMMITTEE STAGE

Draft Amendments to be moved by the Secretary for Trade and
Industry

Clause

Amendment Proposed

- Long title By deleting "Amend and consolidate the law relating to" and substituting "Make new provision in respect of".
- 2(1) (a) By deleting the definition of "Paris Convention country" and substituting -
 "Paris Convention country" (巴黎公約國)
 means -
 (a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;
 (b) any territory or area subject to the authority

Clause

Amendment Proposed

or under the suzerainty of any country referred to in paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;".

(b) In the definition of "WTO member", by deleting "designated by regulation made under section 91 (regulations) as" and substituting "for the time being specified in Schedule 1 as being".

(c) By adding -

"certified" (核証), in relation to a copy or extract, means certified by the Registrar and sealed with the seal of the Registrar;".

3(2) By deleting "numerals, figurative elements, the shape of goods or their packaging, a combination of colours" and substituting "characters, numerals, figurative elements, colours, sounds, smells, the shape of goods or their packaging".

4 (a) In subclause (1), by deleting "well-known"

Clause

Amendment Proposed

and substituting "well known".

(b) By adding -

"(1A) In determining for the purposes of subsection (1) whether a trade mark is well known in Hong Kong, the Registrar or the court shall have regard to Schedule 2.".

New

By adding, before Part II -

"8A. Ordinance binds Government

This Ordinance binds the Government.".

9(3)

(a) By deleting the clause.

11

(a) In subclause (4), by deleting "has a reputation in Hong Kong" and substituting "is entitled to protection under the Paris Convention as a well-known trade mark".

(b) In subclause (8), by deleting "unless the Registrar is satisfied that the use of the trade mark, in relation to the goods or services in respect of which it is proposed to be registered, is likely to cause confusion on the part of the public".

<u>Clause</u>	<u>Amendment Proposed</u>
12(1)(b)	By adding "special" before "circumstances".
13(2)	By deleting "and section 19 (exhaustion of rights conferred by registered trade mark)" and substituting ", section 19 (exhaustion of rights conferred by registered trade mark) and section 19A (use in advertising, etc.)".
17	(a) In subclause (4)(b), by deleting "has a reputation in Hong Kong" and substituting "is entitled to protection under the Paris Convention as a well-known trade mark". (b) By deleting subclause (7).
18	By deleting subclause (3) and substituting - "(3) A registered trade mark is not infringed by - (a) the use by a person of his own name or address or the name of his place of business; (b) the use by a person of the name of his predecessor in business or the name of his predecessor's place of business; (c) the use of signs which serve to designate the kind, quality,

Clause

Amendment Proposed

quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; or

(d) the use of the trade mark where it is necessary to indicate the intended purpose of goods or services (for example, as accessories or spare parts), provided the use is in accordance with honest practices in industrial or commercial matters."

New

By adding, before the subheading "**Infringement proceedings**" -

"19A. Use in advertising, etc.

(1) Nothing in section 17 (infringement of registered trade mark) shall be construed as preventing the use by any person of a registered trade mark for the purpose of identifying goods or services as those of the owner of the registered trade mark or a licensee, but any such use which is otherwise than in accordance with honest practices in

Clause

Amendment Proposed

industrial or commercial matters shall be treated as infringing the registered trade mark.

(2) In determining for the purposes of subsection (1) whether the use is in accordance with honest practices in industrial or commercial matters, the court may consider such factors as it considers relevant including, in particular, whether

-

(a) the use takes unfair advantage of the trade mark;

(b) the use is detrimental to the distinctive character or repute of the trade mark; or

(c) the use is such as to deceive the public.

(3) For the avoidance of doubt, nothing in this section shall be construed as applying to the interpretation of section 19 (exhaustion of rights conferred by registered trade mark).".

24

By adding -

"(7) Nothing in this section makes a barrister or solicitor liable to proceedings under this section for any act

Clause

Amendment Proposed

done by him in a professional capacity on behalf of a client."

- 25(5) By adding "that an assignment or assent be signed" after "subsection (4)".
- 37 By deleting subclause (1) and substituting -
" (1) The filing date of an application for registration of a trade mark is the date on which documents containing everything required by section 36(2)(a) to (d) (application for registration) are filed with the Registrar.
(1A) If the documents are filed on different dates, the filing date is the last of those dates."
- 40 By deleting subclauses (3) and (4) and substituting -
" (3) If it appears to the Registrar that the requirements for registration are not met, the Registrar shall, by notice in writing -
(a) inform the applicant of the Registrar's opinion;
(b) inform him that he may make representations to the

Clause

Amendment Proposed

Registrar to establish that the requirements for registration are met or that he may amend the application so as to meet those requirements, but that he must do so within the prescribed period; and

(c) inform him of the provisions of subsection (4).

(4) The Registrar shall refuse to accept the application if the applicant -

(a) fails to respond to the notice before the end of the period prescribed for the purposes of subsection (3)(b); or

(b) fails, before the end of that period, to satisfy the Registrar that the requirements for registration are met or to amend the application so as to meet those requirements.".

Subheading In the subheading after clause 41, by deleting ",

Clause

Amendment Proposed

restriction".

- 43 (a) In the heading, by deleting "**or restriction**".
- (b) In subclause (1), by deleting "or restrict the goods or services covered by the application".
- (c) In subclause (2), by deleting "or restriction".
- 44 By adding -
- "(2A) An application for registration of a trade mark may be amended -
- (a) for the purpose of restricting the goods or services covered by the application; or
- (b) for such other purposes as may be prescribed."
- 48(7) By deleting "復" and substituting "復".
- 49(2)(b) By deleting "as to".

Clause

Amendment Proposed

accepted within the
trade as the sign that
describes goods or
services for which the
trade mark is
registered;".

(b) In subclause (3) -

- (i) in paragraph (a), by deleting
"and";
- (ii) in paragraph (b), by deleting the
full-stop and substituting "; and";
- (iii) by adding -

"(c) use of a trade mark in
Hong Kong includes,
where the trade mark is
registered in respect
of services, use in
relation to services
provided or to be
provided outside Hong
Kong.".

(c) In subclauses (4) and (5), by deleting "or
(b)".

(d) By deleting subclause (8) and substituting -

"(8) For the purposes of subsection
(2)(a), the 3-year period may begin at
any time on or after the actual date on

Clause

Amendment Proposed

which particulars of the trade mark were entered in the register under section 45(1) (registration).".

- 51 (a) In subclause (3), by deleting "已" and substituting "以".
- (b) In subclause (5), by adding "also" after "may".
- (c) By deleting subclause (6) and substituting -
- "(6) The registration of a trade mark may not be declared invalid under subsection (5) if the owner of the earlier trade mark or other earlier right has consented to the registration.".
- 52(2) By adding "only" after "varied".
- 55 By deleting subclauses (5) and (6) and substituting -
- "(5) The Registrar may, on request made by the owner of a registered trade mark or a licensee, or by any person having an interest in or charge on a registered trade mark the particulars of which have been entered in the register under section 27 (registration of transactions affecting registered trade mark), enter any change in

Clause

Amendment Proposed

his name or address, or in any other particulars identifying such person, as recorded in the register.

(6) Where the Registrar is satisfied that an error or omission in the register is attributable to an error or omission on his part or on the part of the staff of the Registry, he may on his own initiative correct the error or omission in the register, but before doing so he shall give notice of the proposed correction to any person who appears to him to be concerned."

- 58 (a) In subclause (1), by deleting "well-known" and substituting "exceptionally well known in Hong Kong".
- (b) In subclause (7), by deleting "50(2)(a), (b), (c) and (d)" and substituting "50(2)(a), (b) and (c)".
- 59(2) By deleting "Schedule 1" and substituting "Schedule 3".
- 60(2) By deleting "Schedule 2" and substituting "Schedule 4".
- 68 By deleting the clause and substituting -

Clause

Amendment Proposed

"68. Decisions of Registrar to be taken after hearing

(1) Without prejudice to any rule of law or to any provision of this Ordinance requiring the Registrar to hear any party to proceedings before him, or to give any such party an opportunity to be heard, the Registrar shall, before taking any decision on any matter under this Ordinance or the rules which is or may be adverse to any party to any proceedings before him, give that party an opportunity to be heard.

(2) The Registrar shall give a party to proceedings before him at least 14 days' notice of the time when he may be heard unless that party consents to shorter notice."

70(3) By deleting "or restriction".

73 By deleting the clause.

78(5) By deleting the clause.

81 By deleting the clause and substituting -

"81. Burden in civil proceedings of proving use of trade mark

(1) If, in any civil proceedings

Clause

Amendment Proposed

under this Ordinance in which the owner of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with the owner.

(2) If, in any civil proceedings under this Ordinance in which a licensee of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with -

(a) the owner of the trade mark, where he is a party to the proceedings; or

(b) the licensee, where the owner is not a party to the proceedings."

85 (a) In subclause (1), by deleting "and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties".

(b) By deleting subclause (3).

Clause

Amendment Proposed

91 By deleting the clause and substituting -

"91. Regulations

The Chief Executive in Council may by regulation -

- (a) add to Schedule 1 (Paris Convention countries and WTO members) the name of -
 - (i) any country which has acceded to the Paris Convention;
 - (ii) any country, territory or area which has acceded to the World Trade Organization Agreement;
- (b) delete from Schedule 1 the name of -
 - (i) any country which has denounced the Paris Convention;
 - (ii) any country, territory or area which has denounced the World Trade Organization Agreement;

<u>Clause</u>	<u>Amendment Proposed</u>
	(c) otherwise amend Schedule 1;
	(d) amend Schedule 2 (determination of well-known trade marks);
	(e) amend Schedule 3 (collective marks); and
	(f) amend Schedule 4 (certification marks).".
95	By deleting subclause (4) and substituting - "(4) A person shall not be treated as a director of a corporation by reason only that the directors of the corporation act on advice given by him in a professional capacity.".
96(1), (4) and (6)	By deleting "Schedule 3" and substituting "Schedule 5".
97	By deleting "Schedule 4" and substituting "Schedule 6".

Clause

Amendment Proposed

New

By adding -

"SCHEDULE 1 [ss. 2 & 91]

PARIS CONVENTION COUNTRIES AND WTO MEMBERS

**Countries which have acceded to
the Paris Convention**

**Countries, territories and areas which have
acceded to the World Trade Organization
Agreement (not including countries which
have acceded to the Paris Convention)**

".

Clause

Amendment Proposed

New

By adding -

"SCHEDULE 2 [ss. 4 & 91]

DETERMINATION OF WELL-KNOWN TRADE MARKS

1. **Factors for consideration**

(1) In determining for the purposes of section 4 (meaning of "well-known trade mark") whether a trade mark is well known in Hong Kong, the Registrar or the court shall take into account any factors from which it may be inferred that the trade mark is well known in Hong Kong.

(2) In particular, the Registrar or the court shall consider any information submitted to the Registrar or the court from which it may be inferred that the trade mark is, or is not, well known in Hong Kong, including, but not limited to, information concerning the following -

- (a) the degree of knowledge or recognition of the trade mark in the relevant sectors of the public;
- (b) the duration, extent and geographical area of any use

Clause

Amendment Proposed

of the trade mark;

- (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the trade mark, to the extent that they reflect use or recognition of the trade mark;
- (e) the record of successful enforcement of rights in the trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by competent authorities in foreign jurisdictions; and
- (f) the value associated with the

Clause

Amendment Proposed

trade mark.

(3) The factors mentioned in subsection (2) are intended to serve as guidelines to assist the Registrar and the court to determine whether the trade mark is well known in Hong Kong. It is not a pre-condition for reaching that determination that information be submitted with respect to any of those factors or that equal weight be given to each of them. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not mentioned in subsection (2). Such additional factors may be relevant alone, or in combination with one or more of the factors mentioned in subsection (2).

(4) For the purpose of subsection (2)(a), "relevant sectors of the public" () includes, but is not limited to -

Clause

Amendment Proposed

- (a) actual or potential consumers of the type of goods or services to which the trade mark applies;
- (b) persons involved in channels of distribution of the type of goods or services to which the trade mark applies; and
- (c) business circles dealing with the type of goods or services to which the trade mark applies.

(5) Where a trade mark is determined to be well known in at least one relevant sector of the public in Hong Kong, it shall be considered to be well known in Hong Kong.

(6) For the purpose of subsection (2)(e), "competent authorities in foreign jurisdictions" () means administrative, judicial or quasi-judicial authorities in jurisdictions other than Hong Kong that are competent to determine whether a trade mark is a well-known trade mark, or in enforcing the protection of well-known trade marks, in their respective jurisdictions.

Clause

Amendment Proposed

2. Factors not required to be established

For the purpose of determining whether a trade mark is well known in Hong Kong, it is not necessary to establish -

- (a) that the trade mark has been used, or has been registered, in Hong Kong;
- (b) that an application for registration of the trade mark has been filed in Hong Kong;
- (c) that the trade mark is well known, or has been registered, in a jurisdiction other than Hong Kong;
- (d) that an application for registration of the trade mark has been filed in a jurisdiction other than Hong Kong; or
- (e) that the trade mark is well known by the public at large in Hong Kong."

<u>Clause</u>	<u>Amendment Proposed</u>
Schedule 1	<p>(a) By deleting "SCHEDULE 1" and substituting "SCHEDULE 3".</p> <p>(b) In section 4(3), by deleting "section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance" and substituting "section 44 of this Ordinance (amendment of application)".</p>
Schedule 2	<p>(a) By deleting "SCHEDULE 2" and substituting "SCHEDULE 4".</p> <p>(b) Within the square brackets, by adding "& Sch. 5" after "91".</p> <p>(c) In section 5(3), by deleting "section 43 (withdrawal or restriction of application) and section 44 (amendment of application) of this Ordinance" and substituting "section 44 of this Ordinance (amendment of application)".</p>
Schedule 3	<p>(a) By deleting "SCHEDULE 3" and substituting "SCHEDULE 5".</p> <p>(b) In section 6(2), by deleting "Schedule 2" and substituting "Schedule 4".</p> <p>(c) In section 8(6), by deleting "after that</p>

Clause

Amendment Proposed

date" and substituting "made on or after that date".

- (d) In section 10 -
 - (i) by deleting subclause (2) and substituting -
 - "(2) Section 15 of the repealed Ordinance (opposition to registration) and any other provisions of the old law relating to oppositions to registration continue to apply in relation to an application mentioned in subsection (1).";
 - (ii) in subclause (3), by deleting "a notice of opposition" and substituting "an opposition to registration";
- (e) In section 11(3), by deleting "immediately after" and substituting "on".
- (f) In section 16(2), by deleting "grounds mentioned in section 50(2)(a) or (b)" and substituting "ground mentioned in section 50(2)(a)".
- (g) In section 18(1), by deleting "Schedule 2" and substituting "Schedule 4".
- (h) In the Annex -
 - (i) within the square brackets, by

Clause

Amendment Proposed

deleting "Sch. 3" and substituting
"Sch. 5";

(ii) in the heading, by deleting
"SCHEDULE 3" and substituting
"SCHEDULE 5";

(iii) in section 37(2A)(a) and (b), by
deleting "country or territory"
and substituting "country,
territory or place".

Schedule 4 (a) By deleting "SCHEDULE 4" and substituting
"SCHEDULE 6".

(b) By deleting section 7.

(c) By deleting section 8 and substituting -

"8. Offences in respect of trade marks

Section 9 is amended -

(a) by repealing subsection (3) and
substituting -

"(3) For the purposes of
this section but subject to
subsection (3A), a person shall
be deemed -

(a) to forge a trade
mark who either -

(i) without the
consent of
the owner of

Clause

Amendment Proposed

the trade
mark, makes
that trade
mark or a mark
so nearly
resembling
that trade
mark as to be
calculated to
deceive; or

(ii) falsifies any
genuine trade
mark, whether
by alteration,
addition,
effacement or
otherwise;

(b) falsely to apply
to goods a trade
mark who without
the consent of the
owner of that
trade mark applies
that trade mark to
goods,

and "forged trade mark"

) shall be construed

Clause

Amendment Proposed

accordingly.

(3A) A person shall not be deemed under subsection (3) to forge a trade mark, or falsely to apply to goods a trade mark, if the person proves -

- (a) that he acted without infringing any right of the owner of the trade mark conferred by the Trade Marks Ordinance (of 2000);
- (b) that the trade mark or mark was not used by him in the course of any trade or business as a trade mark in relation to goods;
- (c) that the use made by him of the trade mark or mark is not a use in relation to goods for which

Clause

Amendment Proposed

the trade mark is registered and is not a use in relation to goods similar to those for which it is registered; or

(d) that the use made by him of the trade mark or mark is a use to which the rights of the owner of the trade mark do not extend by reason of a disclaimer, limitation or condition to which the trade mark is subject.";

(b) in subsection (4), by repealing "assent of the proprietor" and substituting "consent of the owner".

(d) By deleting section 11.

Appendix IV

TRADE MARKS BILL

COMMITTEE STAGE

Amendments to be moved by the Honourable Margaret Ng

<u>Clause</u>	<u>Amendment Proposed</u>
19	<p>(a) By deleting subclause (2) and substituting -</p> <p>"(2) Subsection (1) does not apply under one or both of the following -</p> <p>(a) where the condition of the goods has been changed or impaired after they have been put on the market, and the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the trade mark;</p> <p>(b) in the case of goods imported into Hong Kong in the course of trade or business and subsequently put on the retail market, where the person who imported the goods is not identified."</p> <p>(b) By adding -</p> <p>"(3) The person mentioned in subsection (2)(b) shall be treated to have been identified if the name and address of that person in either the Chinese or English language, or in both languages are, -</p> <p>(a) in accordance with the rules, marked on -</p> <p>(i) the goods;</p>

- (ii) any package containing the goods;
- (iii) a label securely affixed to the goods or any package containing the goods;
- (iv) a document enclosed with any package containing the goods;
- (v) a document which relates to the goods and is exhibited in a conspicuous place where the goods are displayed for retail purchase; or

(b) marked as provided by the rules.

(4) Subsection (2)(b) does not apply to any goods in transit or goods in the course of transshipment."