

**Bills Committee on Trade Marks (Amendment) Bill 2019**

**Government's Responses to Written Submissions and Views of Deputations**

On 15 April 2019, the Bills Committee on the Trade Marks (Amendment) Bill 2019 convened a meeting inviting deputations to give their views on the Bill.

2. The Bills Committee received 18 written submissions, including 15 before the meeting and three after the meeting. Nine deputations attended the meeting. The attached table summarises the views expressed and our responses.

Commerce and Economic Development Bureau  
Intellectual Property Department  
Customs and Excise Department  
April 2019

**Bills Committee on Trade Marks (Amendment) Bill 2019**

**Government's Responses to Written Submissions Received by the Bills Committee and Comments from Deputations**

Item	Summary of the views expressed	Deputations <sup>1</sup>	Government's Responses
1.	Support the implementation of the Madrid Protocol in Hong Kong which can confer benefits on businesses, for example, by providing one-stop service to save time and costs for SMEs in applying for trade marks and facilitating their brands to reach out to the global markets, enhancing Hong Kong's attractiveness as an international commercial centre and capabilities as an intellectual property ("IP") trading hub.	<ul style="list-style-type: none"> <li>• ALA</li> <li>• CMA</li> <li>• DAB</li> <li>• FHKI</li> <li>• HKBPA</li> <li>• HKFII</li> <li>• HKFITMI</li> <li>• HKGCC</li> <li>• HKIPA</li> <li>• HK IP Association</li> <li>• HKKPMUA</li> <li>• HKOMA</li> <li>• HKTDC</li> <li>• INTA</li> <li>• LP</li> <li>• PVCHK</li> </ul>	We note the support expressed by the vast majority of respondents for the proposed implementation of the Madrid Protocol in Hong Kong.
2.	Look forward to special arrangements to facilitate filing of trade mark applications between Hong Kong and the Mainland.	<ul style="list-style-type: none"> <li>• CMA</li> <li>• DAB</li> <li>• HKFITMI</li> <li>• HKIPA</li> <li>• HK IP Association</li> <li>• HKKPMUA</li> <li>• HKOMA</li> <li>• INTA</li> <li>• LP</li> </ul>	We note the views expressed by the respondents, and will continue discussing with the relevant Mainland authorities the possibility of putting in place separate arrangements to facilitate reciprocal applications by Hong Kong and Mainland applicants.

<sup>1</sup> Arranged in alphabetical order. Full list of deputations and their abbreviations adopted herein are set out in the [Appendix](#).

Item	Summary of the views expressed	Deputations <sup>1</sup>	Government's Responses
3.	Support that enforcement of criminal provisions under the Trade Marks Ordinance (“TMO”) (e.g. the provision dealing with falsely representing a trade mark as registered) be taken up by the Customs and Excise Department (“C&ED”) would enhance the IP protection regime in Hong Kong.	<ul style="list-style-type: none"> <li>• ALA</li> <li>• CMA</li> <li>• INTA</li> </ul>	We note the support expressed for our proposal for C&ED to take up the enforcement of the criminal provisions under TMO.
4.	Look forward to an increased funding provision for promoting IP protection and respect for IP rights in Hong Kong.	<ul style="list-style-type: none"> <li>• ALA</li> </ul>	We attach great importance to the promotion and education work for enhancing the awareness of and respect for IP rights. According to a survey in 2018 commissioned by the Intellectual Property Department (“IPD”), the general public in Hong Kong has a high awareness of IP rights protection and respect for IP rights. We will continue the efforts to put across the messages by works including the “No Fakes Pledge” Scheme <sup>2</sup> , the “I Pledge” Campaign <sup>3</sup> and a diverse range of publicity and education activities (e.g. talks, creativity competitions, Announcements in the Public Interest, school visits). We will keep in view the need for any additional resources for the relevant work.
5.	Propose that consent be required from the owner of a “senior mark” in the situation where a trade mark applicant wishes to invoke section 46(2) (as amended by Clause 8 of the Bill) to amend a trade mark under application by adding to it another trade mark which was itself registered in the first place by consent of the owner of an earlier trade mark (i.e. “the senior mark”).	<ul style="list-style-type: none"> <li>• HKAPAA</li> </ul>	<p>We have thoroughly considered the merits of HKAPAA’s proposed mandatory requirement for a fresh consent in an amendment of trade mark application made under section 46 of TMO but do not agree with the proposal.</p> <p>Where the Registrar of Trade Marks (“the Registrar”) raises an objection to a trade mark application, section 46(2) of TMO gives the applicant flexibility to apply to add the representation of a registered trade mark that belongs to him/her in an attempt to overcome the Registrar’s objection, provided that the conditions set out in the existing section 46(2)(a) to (c) are met. In practice, many applicants</p>

<sup>2</sup> “No Fakes Pledge” Scheme encourages retail merchants to pledge not to sell counterfeit and pirated products.

<sup>3</sup> “I Pledge” Campaign encourages consumers not to buy or use pirated and counterfeit goods.

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			<p>rely on this facility to enhance the distinctiveness of their marks applied for.</p> <p>The existing section 46(2) allows the addition of the representation of a registered trade mark that was accepted for registration by virtue of consent obtained from a senior mark owner. However, a trade mark application amended under section 46(2) will not necessarily be accepted for registration. On examining the amended mark (containing the registered mark) as a whole, if it is found to be similar to the senior mark, the Registrar would raise objections. The applicant could seek to overcome the objections by various means as appropriate, including by way of obtaining consent from the senior mark owner.</p> <p>If the Registrar either raises no objections at the examination stage or accepts the amended application for registration after his objections have been overcome, the Registrar is required to publish the particulars of the application for opposition, and it will be open to the senior mark owner to object to such an application. This mechanism has been working well all along. In practice, applications to amend trade mark applications by adding trade marks registered by virtue of consent from senior mark owners have been rare.</p> <p>We consider that it is in the interest of the applicants that the flexibility of overcoming a citation through different options in such circumstances be preserved. At the same time, we consider that the interest of the senior mark owners are adequately protected through the Registrar's examination process as well as third party's opposition proceedings. Moreover, we note that there is so far no consensus among trade marks practitioners on HKAPAA's proposal. We will continue to engage HKAPAA and other trade marks practitioners on this technical issue as appropriate.</p>

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6.	<p>Support the proposal of requiring a trade mark applicant, assignor, assignee, vested person or transferee, if it is a corporation, to provide information on its place of incorporation or equivalent. Propose extending the same requirement to a licensee or a party holding interest in a trade mark or application, if it is a corporation. Also propose that, whether the party in any of the above capacities is a natural person, identity card number be required.</p>	<ul style="list-style-type: none"> <li>• HKAPAA</li> </ul>	<p>The Government is keen on keeping a business-friendly regime for trade mark registration and maintenance of registered trade marks, and strives to collect necessary but not excessive information from any party.</p> <p>The owner/assignee of a trade mark holds legal title to it. Where the owner/assignee is a body corporate, the additional information on its place of incorporation would facilitate a third party in conducting due diligence by way of a company search, in the course of carrying out business transactions in respect of the trade mark. Information on the place of incorporation of a corporate owner/assignee would also enable a third party to decide whether it is the proper party against whom legal proceedings should be issued.</p> <p>Where the owner/assignee is a natural person, given that there does not exist a search mechanism by a person's identification document number akin to the company search system available in respect of body corporates, we do not see any basis in requiring a natural person to provide his/her identification document number in whatever capacity he/she may be when applying for IPD's services on trade mark registration and maintenance of registered trade marks.</p> <p>As for HKAPAA's proposal for the Registrar to update the register by adding information about the places of incorporation of corporate entities, given that there are currently over 425,000 records on registered trade marks on the register, we do not consider the proposed exercise feasible nor cost-effective.</p>
7.	<p>Suggest that a regime be put in place to regulate trade mark practitioners.</p>	<ul style="list-style-type: none"> <li>• HKCPAA</li> <li>• HKIPA</li> </ul>	<p>According to TMO, the Registrar shall refuse to recognise as an agent a person having neither residence nor a place of business in Hong Kong. In addition, the Registrar may refuse to recognise as an agent in respect of any business under TMO or the Trade Marks Rules certain specified classes of persons such as a person who has been</p>

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			<p>convicted of a criminal offence, or a person who has been suspended from acting as a barrister or solicitor. We have no immediate plans to modify the current mechanism but will continue to keep in view the situation.</p>
8.	<p>Suggest that a simple mechanism for revoking registration of trade marks which have not been used for a continuous period of 3 years should be introduced.</p>	<ul style="list-style-type: none"> <li>• HKCPAA</li> </ul>	<p>Under section 52(1) and (2)(a) of TMO, if a registered trade mark has not been genuinely used for a continuous period of at least 3 years in Hong Kong and there are no valid reasons for non-use, any person may apply either to the Registrar or the court for revocation of the registration of the trade mark.</p> <p>The revocation mechanism has been working well all along. We are of the view that it has balanced the rights between trade mark owners and parties seeking to use the mechanism. As there is no information to suggest that there will be a surge in the number of registered trade marks that may be liable to be revoked upon the implementation of the Madrid Protocol in Hong Kong, we do not see any justifications to modify the revocation mechanism or to relax its requirements.</p>

## List of Deputations

Deputations	Abbreviations
Asian Licensing Association	ALA
The Chinese Manufacturers' Association of Hong Kong	CMA
Democratic Alliance for the Betterment and Progress of Hong Kong	DAB
Federation of Hong Kong Industries	FHKI
Hong Kong Group of Asian Patent Attorneys Association	HKAPAA
Hong Kong Brands Protection Alliance	HKBPA
Hong Kong Chinese Patent Attorneys Association	HKCPAA
Hong Kong Federation of Invention and Innovation	HKFII
Hong Kong Federation of Innovative Technologies and Manufacturing Industries	HKFITMI
Hong Kong General Chamber of Commerce	HKGCC
Hong Kong Institute of Patent Attorneys Limited	HKIPA
Hong Kong Intellectual Property Association	HK IP Association
Hong Kong & Kowloon Plastic Products Merchants United Association Limited	HKKPMUA
Hong Kong Optical Manufacturers Association Limited	HKOMA
Hong Kong Trade Development Council	HKTDC
The International Trademark Association	INTA
Liberal Party	LP
The Professional Validation Council of Hong Kong Industries	PVCHK