

THE JOURNAL



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Letter from the President

Dear All,

- 1. This is my first Newsletter since taking over the Presidency in September 2005, although I believe you are already used to receiving my reports on matters going on with the Council of the Institute. This Newsletter hopefully summarises some of the matters we have been handling, and also provides you with details of new developments.*

Interactive Services and Amendments to the Trade Marks Rules

- 2. In November 2005, I forwarded you a letter received from the IPD concerning proposed amendments to the Trade Marks Rules that they considered necessary for Phase II of their introduction of interactive services. For example, certain signing requirements for applications/notices/requests for registering assignments and other transactions under the Trade Marks Rules were not consistent with the rollout of electronic services relating to such transactions.*
- 3. The IPD proposed to amend various provisions most particularly the signing requirements:*
 - (a) Under Rule 62(2) so that an application or notice to register an assignment can be signed by or on behalf of the assignor, rather than both the assignor and assignee; and*
 - (b) Under Rule 64(2) so that a request to amend registered particulars relating to the alteration of the terms of a licence or security interest can be signed by or on behalf of the grantee, rather than both the grantor and grantee, of the licence or security*



interest.

4. *The Council made submissions to the IPD expressing concern that the grantee of a licence or security interest could unilaterally amend the terms of such an interest, and that these items should be retained as requiring both grantor and grantee to sign such amendments. The IPD has agreed with our submission and the proposed amendment is withdrawn.*
5. *As you will probably have seen, the Trade Marks (Amendment) Rules 2006 were gazetted on 24th March 2006, and came into operation on 26th May 2006. The TMAR incorporate the above changes to Rule 62(2) and other practical, but relatively minor, changes to the Trade Marks Rules. The most important change is perhaps the change to Rule 11(2) to clarify that if the Registrar considers that part of an application for registration does not comply with the requirements of Rule 7(1) or (2) of the Rules, and the Applicant fails to remedy the deficiencies, only that part of the application (and not the whole application) will be treated as abandoned. Although this has effectively been the case in practice, at least from my experience, the amendment is to make this clear in the Rules.*

Copyright (Amendment) Bill 2006

6. *As many of you will be aware, the above was gazetted on 17th March 2006. In the preamble it indicates that the Bill is intended to "amend the Copyright Ordinance to make provisions or further provisions for:*
 - (a) *The acts that may be done in relation to works or performances notwithstanding the copyright in the works or the right in the performances;*
 - (b) *The rental right of copyright owners and performers;*
 - (c) *The moral rights of performers;*
 - (d) *The infringement of copyright in works or rights in performances;*
 - (e) *The technological measures which are used for the protection of copyright in works or rights in performances; and*



- (f) *Miscellaneous and transitional matters*
 - (g) *To repeal the Copyright (Suspension of Amendments) Ordinance 2001, and to make provisions for related matters."*
7. *Of note, the Bill includes provisions concerning the scope of business end-user liability. It is proposed to maintain the existing business end-user possession offence in relation to computer programs, movies, TV dramas and musical recordings. In response to the publishing industry's concerns, the Bill introduces a new "business end-user distribution offence" against serious infringing acts involving copying for distribution or distributing infringing copies of newspapers, magazines, periodicals or books. Such acts may attract criminal liability if the extent of infringement exceeds certain numerical limits to be prescribed and the acts are done on a regular or frequent basis resulting in financial loss to the copyright owners.*
 8. *The Bill also provides for directors and partners responsible for the internal management of a company to be criminally liable unless they can prove that they have not authorised the infringing act.*
 9. *The Bill also has provisions banning the rental of movies and incorporates further parallel import provisions. The Copyright Committee of the Council have reviewed the Copyright Bill and a draft submission to the Legislative Council has been prepared. We will keep you informed. Needless to say, client interests occasionally limit the extent to which the Institute can make comments on some subjects, and you may wish to review the Bill to see if your own clients' interests are affected.*

Scale of Costs for Trade Mark Cases

8. *The Registry is considering the possibility of introducing a scale of costs in trade mark opposition cases and had sought the views of various organisations. Regrettably, the proposal and the Institute's response to the IPD was not circulated to members at the time, but I am now attaching a copy of the [proposed schedule](#) of the IPD incorporating the column of the Institute's proposed figures.*



9. *We believe the figures proposed by the Institute are set at a reasonable level to ensure that fruitless oppositions are avoided, and to give reasonable compensation to the successful parties. In addition, we also believe that there should be discretion for the Registrar to award a greater level of costs than those provided for in the proposed scale.*
10. *As far as I am aware, there is no timetable for its implementation. We will continue to monitor the situation.*

Companies Registry and Companies Name Issues

11. *I believe you will all have seen the exchanges of correspondence that the Institute has had with the Companies Registrar, complaining at the apparent hole in the Companies Ordinance when it comes to seeking to enforce a Court Order requiring a company to change its name. There appears to be no power of the Companies Registrar to implement a Court Order where the defendant company refuses to do so, fails to do so, or otherwise cannot be contacted.*
12. *The Companies Registry has indicated that there is to be a full review of the Companies Ordinance commencing this year, although it is likely to be some time before any new law is proposed. We have not yet stopped work on this issue. We will explore the possibility of a minor amendment to the Companies Ordinance to deal with the issue, and we will be working to see what support we can obtain for this.*
13. *Interestingly, on 23rd February 2006 I was visited by a Councillor of the Ministry of Economics, Trade and Industry in Japan, who was here on a mission to meet the Companies Registrar to complain on behalf of a well-known Japanese company, against the problems that the particular company was facing with their company name being continuously registered here in Hong Kong, by unconnected third parties. The problems they are facing and were complaining about are exactly the same as the issues we have raised with the Companies Registry ourselves. That the Government of Japan considers it necessary to send a representative to Hong Kong to raise the issue illustrates the depth of the problem.*

Institute External Relations Officer



14. *I am pleased to inform you that Dora Chow (ex DLA) has kindly agreed to be the Institute's External Relations Officer. This is expected to involve Dora attending appropriate exhibitions in Hong Kong (and possibly the PRC) where the Institute's attendance (with a booth presence or otherwise) is considered as potentially beneficial to all the members of the Institute. I will keep you informed of Dora's activities.*

Spring Dinner 1 March 2006

15. *Many thanks for those of you who attended the above event at Kee Club. It was a great success with 46 attendees, including our guest speaker for the evening, Mike McKeivith,*



Senior Counsel of Philips Morris International, and other guests Teresa Grant of the Hong Kong IPD, and Mike Reynolds, Senior Hearing Officer of the UK Patent Office. Everyone that attended seemed to enjoy the fine food and wine and, of course, each other's company. For those who were unable to attend, look out for the next event.

Membership News

New Members

*Vera Sung (Oldham Li & Nie)
Andrea Fong (Wilkinson & Grist)
Angela Chiu (Baker & McKenzie)
John Slater (Simmons & Simmons)
Cynthia Houg (Yu & Partners)*

Professional Moves

*Lloyd Wise have relocated offices to 16/F Hutchison House, 10 Harcourt Rd, Central
Twiggy Liu has left Stephenson Harwood & Lo and has set up a new firm "Twiggy MH Liu Law Office" at 4104 Hopewell Centre, 183 Queen's Road East, Wanchai.
Chloe Lee has joined Stephenson Harwood & Lo
Bird & Bird have relocated offices to 33/F, 3 Pacific Place 1 Queens' Road East
Rebecca Lo & Co. have relocated to 1408 Dina House, Ruttonjee Centre, 11 Duddell Street*

Please could members let Justin Davidson (Justin.Davidson@dlapiper.com) know if there are any changes to their contact details. Also, if any member does not yet have a Membership Certificate and would like one, please could they contact Justin.

Regards

*Steven Birt
President*



Please send any comments about this edition of The Journal, any letters or articles for future issues, to the Editor Winnie Yue (winnie.yue@deacons.com.hk)

If any members are not receiving the Journal properly, please advise the Editor in case your contact details are not properly recorded.

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