

THE JOURNAL

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From the Editor

Welcome to the first edition of The Journal of The Hong Kong Institute of Trade Mark Practitioners. This is to be a bimonthly publication that will be sent to members by e-mail. To a large extent the contents are up to you! I hope to include a number of regular sections that will include a mixture of news, information and gossip. I hope that The Journal will also include letters from readers, and articles of general interest contributed by members.

If you do not want to receive this newsletter, just let me know and I will remove your address from our circulation list. Conversely if any members are not receiving their own personal copy, then it may be that we do not have your up to date contact details, so please let us know.

About your Institute

One of the main purposes of The Journal will be to keep members informed as to what is going on in the Institute. In this first edition a good way to start is to tell you about the Council and its sub-committees and what we are up to on your behalf.

The main decision making body of the Institute is the Council which currently has 16 members (the maximum number allowed under our Articles of Association). The Council includes five named office holders who are Graeme Hall (President), Peggy Cheung (Vice-president), Charmaine Koo (Secretary), Matthew Laight (Treasurer) and Peter Shen (Membership Secretary). The Council meets about once a month and if any member would like us to take up any issue that concerns them please do not hesitate to contact a Council member. Do also remember that half the places on Council come up for election every year at the AGM - and so if you would like to become more involved in the Institute please consider standing when the time comes.



The Council has established a number of sub-committees that work on various areas in more detail as and when required:

Trade Marks

This committee is chaired by Peggy Cheung and has been incredibly busy in the last couple of years working on the Trade Marks Bill. The committee prepared the Institute's submissions on the various draft Bills and of course also on the final Bill that was put to Legco. The committee has continued to put forward the Institute's position on various matters to Legco. A fuller summary of the current position regarding the Bill follows later in this edition of The Journal.

Patents and Designs

This is a committee that was very active in 1997 with the drafting and enacting of the new Patent and Design Ordinances, and since then has continued to monitor the implementation of the new laws by the IPD. The committee is chaired by Graeme Hall.

Copyright

The copyright committee was heavily involved in reviewing the new Copyright Ordinance in 1997, and since then has also reviewed a number of the IPD's proposals for dealing with various counterfeiting issues, such as the licensing of optical disc manufacturers and the inclusion of various offences in the Serious Crimes Ordinance. Matthew Laight chairs this committee.

Education

This committee is chaired by Sandra Gibbons and is currently very active. The purpose of this committee is to work towards the establishment of an education system for Hong Kong trade mark practitioners. This edition of The Journal also includes an article on the education proposals.

Trade Mark Bill Update

The Legco Bills Committee chaired by Margaret Ng is continuing to work its way through the Trade Marks Bill. From time to time it seems to be making the general press when the discussions touch on controversial topics such as parallel imports and comparative advertising.

There seems now to be little scope – or indeed perhaps little point – in making further submissions to Legco on the Bill, and the Bills Committee will presumably now come to its own conclusions



based on the submissions already in front of it. Instead the Institute is concentrating its efforts on the aspects of practice where we can still hopefully make a difference and which in reality are likely to have the most day-to-day impact on our practices. This means the Rules and the Work Manual.

When the Institute made oral submissions to Legco at the end of last year, one very positive result was that the Bills Committee made it clear to the IPD that they wanted to see the IPD involving the profession in the drafting of the Rules and the new Work Manual. The IPD seems to have taken this on board and the Institute's Trade Mark sub-committee is now looking at the latest draft set of Rules and the Institute has started the long process of consulting with the IPD on the Work Manual.

The one question that everyone seems to want to know however, is when the Bill will come into force. The impression gained from conversations with the IPD and from the Bills Committee is that the Bill is going ahead and in all likelihood will become law (there was last year a period of doubt when a number of parties raised questions about the need for this Bill at all), but the bottom line remains – don't hold your breath! There seems to be little prospect of the new law coming into force before early 2001.

Indeed it is more than likely that the Bill will be passed by Legco and then there will be a delay before the new law can come into force because of the need for the Registry to update its computer facilities in preparation for the new law. While this process has started, the suggestion that we have heard from the IPD is that this is likely to take longer than it will for Legco to pass the Bill.

Education

One of the most important objectives of the Institute at the moment is the establishment of an education system for trade mark practitioners. It has been an anomaly for too long that in Hong Kong there is no qualifications system that is equivalent to the ITMA exams in the UK, the many similar systems that exist in other common law countries, and indeed China's own trade mark qualification system.

Here progress is definitely been made at last. The Institute has recently started detailed discussions with the School of Professional and Continuing Education (SPACE) of the University of Hong Kong for a course that will start in the autumn. The details still have to be worked on but



the basic plan is for a two-year course comprising a number of modules on Hong Kong trade mark law and practice, and also on foreign trade mark law – with an emphasis on China and Asia.

Volunteers needed! *The education system is only going to work, however, if we can find volunteers to help run the course. This is your chance to make a major contribution to the profession in Hong Kong and to leave your mark on the next generation of practitioners! If enough people are willing to give just a little bit of their time, then the burden on each volunteer will be minimal. Please contact Sandra Gibbons at Marks & Clerk if you would be able to help. We hope to be able to come to an arrangement with the Law Society so that either teaching or attending will count for CPD points.*

In The News

Trade marks have been making the press recently – especially in the increasingly “hot” world of cyberspace. Sun Hung Kai seem to figure in most of the stories at the moment, ranging from the “cybersquatting” case of the dissatisfied hotel customer to the dispute over the “SUNEVISION” mark.

A number of news stories in the press seem to have suggested that there is no remedy in Hong Kong for cases of cybersquatting notwithstanding the UK “One in a million” case, whether existing laws do provide a way to stop cybersquatters remains to be seen perhaps. Interestingly, however, the recently launched “hk.com” domain name registry is apparently giving preference to the owners of registered trade marks in allocating hk.com domains.

Meanwhile, suggesting that administrative measures may in many cases be the way ahead, the first dispute to be settled under the Uniform Dispute Resolution Policy of ICANN (Internet Corporation for Assigned Names and Numbers) has just been settled. The World Wrestling Federation (WWF) successfully brought a complaint against a registration of www.worldwrestlingfederation.com – though presumably WWF is not an organisation to mess with!

Foreign Laws

While we are still waiting for our own new law to come into force, here are some developments from other parts of the world:



Italy: On December 16 1999 Legislative Decree 447 came into force making amendments to Italian law for the implementation of the Madrid Protocol. (Source CIPA Journal February 2000)

Kazakhstan: A new law came into force on September 4 1999. (Source CIPA Journal February 2000)

Macau:

A new law was published on December 13 1999 but has still to come into force. Practitioners should watch Macau carefully for further news of the new IP system in the Macau SAR.

Beijing Symposium

A number of Council Members, including Graeme Hall, Jeannie Smith and Henry Wheare were invited to take part in the Mainland/HKSAR Intellectual Property Symposium held from April 12 to 14 at the Intellectual Property Training Centre in Beijing. This was a success all round and a useful chance to exchange views with mainland colleagues. The symposium also included an input from Macau and it was encouraging to see the Macau SAR raising its profile in the IP world. We hope that in the future the Institute may be able to develop closer links with Macau.

From the IPD.....

So far this year we have had three Circulars from the IPD. These are:

Circular No.1 of 2000: *re Priority claims in China from Hong Kong Registered Design Applications and Short-term Patent Applications*

Circular No.2 of 2000: *Updated Lists of Circulars and Index of Decisions*

Circular No.3 of 2000 *Advertising trade mark applications*

Please remember that copies of circulars and registry decisions are available from the Institute library that is hosted by Baker & McKenzie (contact Jeannie Smith).



Dates for your diary

Hong Kong 4-7 October 2000 PTMG 61st Conference

Cebu, November 2000 APAA Council Meeting

Hong Kong, 7-8 November 2000 Hong Kong – an IP gateway (co-sponsored by
IPD/HKITMP/APAA/Law Society/Bar Association)

And finally....

Being a trade mark practitioner isn't all work of course, and as a profession we also know how to play and to have a good time. In that tradition March 1 2000 saw the Institute at play at Happy Valley with an excellent night of racing superbly organised by Charmaine Koo and Peggy Cheung. The cold and wet weather meant that only a few hardy souls ventured out onto the balcony, most people preferring to stay indoors and watch the racing on the monitor screens, but with good food and wine nobody seemed to mind that too much. Although we had a few winners, there were also plenty of betting slips being torn up in despair and everybody seemed to still have to go to work the next day...

For those who missed this event, you may like to note that a summer barbecue is being planned for July 14 2000 at Middle Island. Full details of this will be circulated in due course.

This newsletter is best viewed in Page Layout mode if you want to see the logo!

Any comments on the contents of The Journal, brickbats or bouquets, letters for publication, articles, news....please contact Graeme Hall at Lloyd Wise & Co (graemehall@lloydwise.com.hk)

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