

THE JOURNAL

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From the Editor

It was gratifying to receive a number of favourable comments on the first edition of The Journal. I am well aware though that it is far from perfect and all comments and suggestions are welcome. Of course if producing one edition was hard enough, then producing a second is even harder. Thankfully, for my sake, even in the middle of a hot Hong Kong summer there are still a number of important IP issues to talk about.

This edition includes amongst other topics a report on an Institute visit to the Macau IPD, an important decision of the High Court concerning extensions of time, Government proposals on Internet domain name allocation, and – last but certainly not least – the new Trade Marks Ordinance.

A New Trade Marks Ordinance

Unless you have been away from Hong Kong, you can hardly have failed to be aware that the new Trade Marks Ordinance was finally passed by Legco and was gazetted on June 16 2000 as Ordinance No.35 of 2000. By Section 1(2) the Ordinance will come into force on a day to be appointed by the Secretary for Commerce and Industry, and as we are all well aware the commencement will not be until well into 2001.

But at least now we all know the form that the substantive law will take, and there will be little excuse for any of us to be caught by surprise when the Ordinance finally comes into force. We will have at least the best part of a year to pore over the Ordinance with a fine toothcomb and contemplate all the possible ramifications.

In the meantime the Institute is continuing to work with the IPD on the drafting of the Work



Manual and will also be reviewing closely the next draft of the Rules.

No doubt the new law will have all sorts of problems or teething troubles in practice, but I think that we all welcome the long overdue modernisation of the law, and would want to join me in wishing the new Ordinance the best.

Court overturns Registry regarding Rule 91

Given that commencement of the new Ordinance is still about a year away, decisions on the current Ordinance remain important and from a practitioners point of view, few recent decisions are as potentially important as the decision of Mr. Justice Hartmann in Mobil Petroleum Company Inc -v- The Registrar (HCAL 19/2000).

This decision resulted from an application by Mobil for judicial review of the Registry's refusal to grant an extension of time under Rule 91 for the filing of a notice of opposition. The request for an extension was filed nine days out of time. Following the Registry Hearing, the Hearing Officer refused to grant the requested extension.

The Registry decision was based upon the Bristol-Myers Squibb Company case and the Hearing Officer held that she was bound by that case and that Bristol-Myers held that the applicant for the extension had to show satisfactory reasons for not complying with the time limit before any other issues such as prejudice and balance of convenience could be considered. On the facts of the case – a failure by Mobil's solicitor to spot an advertisement in the Gazette – the Hearing Officer found that Mobil had not passed that first test.

After reviewing the case law post 1994 (the date of Bristol-Myers) on extensions of time for complying with procedural requirements, Hartmann J. concluded that while at the time of Bristol-Myers there may have been uncertainty about the route the law should take on the subject, since 1994 a number of cases had established the law with more certainty, and in particular Hartmann J. referred to two UK Court of Appeal cases: Mortgage Corporation Ltd -v- Sandoes (The Times, 27 December 1996) and Finnegan -v- Parkside Health Authority [1998] 1 WLR 411.

In Mortgage Corporation the Court of Appeal listed ten guidelines (which are quoted by



Hartmann J. in his decision) for deciding whether an extension should be granted, and the tenth of these guidelines was effectively that the court should look at all the circumstances of a case. These guidelines were approved in Finnegan.

On this basis Hartmann J found that Bristol-Myers was no longer correct law and remitted the case back to the Registry for reconsideration under the principles of Mortgage Corporation and Finnegan.

The Institute Library

Don't forget that the Institute has a library for use by all members. It's kept by Jeannie Smith (Tel: (852) 2846 1729, Fax: (852) 2845 0476 and Email: jeannie.smith@bakernet.com) and you can get photocopies of any Registry Decisions and Circulars by contacting Jeannie during office hours. A charge of HK\$3 per page is levied, with any profit over actual cost going to the Institute.

As well as the Registry Decision and Circulars, the library also contains copies of the AGM/EGM and President's Report, Papers and submission sent to the IPD on behalf of the Institute, and details of any questionnaires sent to members. Copies of Minutes of Council Meetings and Meetings with IPD are also available (to Council Members only).

Please feel free to use your library – it's there for your convenience.

Consultation paper on the assignment of domain names

Although not widely publicised among the legal profession, the Information Technology and Broadcasting Authority (ITBA) issued a Consultation paper on the assignment of Internet domain names within the .hk domain. The Institute has now established an Internet sub-committee consisting of Matthew Laight, Jeannie Smith, Barry Yen, Steven Birt and Winnie Yue.

The sub-committee met before our last Council Meeting and prepared submissions for the approval of Council. These submissions were made to the ITBA.



The consultation paper can be found at www.info.gov.hk/digital21/eng/structure/con_paper.html and makes interesting reading. Many of the proposals are sensible, such as adopting ICANN resolution procedures, but others are more controversial. These include ambiguous comments on the trading of domain names, and the suggestion that domain name applicants should be required to use their name as given on their ID card. For more information on the consultation paper, please contact either Matthew or Jeannie.

Institute visit to Macau

On July 10 2000, four members of Council – the President Graeme Hall, two former Presidents Jeannie Smith and Nick Horvath, and the current Treasurer Matthew Laight – made something of a landmark visit to Macau to meet the head of the Macau IPD, Jose Coutinho, and a number of his colleagues. We were met with great courtesy, but what was most striking to us was the small size of the Macau IPD, fewer than ten staff in total, meaning that they are very overworked.

Mr Coutinho and his staff were very helpful, however, and are genuinely interested in making contacts with the IP profession in Hong Kong. Furthermore, while naturally one must normally engage a Macau associate to carry out the majority of work in Macau, the Macau IPD seem very willing to help directly professionals from Hong Kong where they can and they seem very open to inquiries being sent to them directly.

As many practitioners will know Macau has a single Industrial Property Code that covers patents, utility models, semiconductor topography protection, designs and trade marks. This is Law No.97/99/M of December 13 1999 and came into force in June of this year. In addition Macau also has a new copyright law that is Law 43/99/M of August 16 1999. English translations of both these laws are in the Institute library.

If practitioners have inquiries regarding the Macau IP system, then the Macau IPD would I think welcome your questions directly. But if there are enough issues of concern to members regarding the Macau system, then we consider establishing regular meetings with the Macau IPD. The address of the Macau IPD is:



Intellectual Property Department
Economic Services Directorate, Government of the Macau SAR
8/F 1-3 Rua Dr. Pedro José Lobo
Macau

or

Caixa Postal 122
Macau

Tel: (853) 562622
Fax: (853) 715291

We hope that this visit will mark the beginning of a long relationship between the Institute and the Macau IPD.

News of Members

Lloyd Wise & Co are delighted to announce that Lisa Heath has rejoined the firm after a period of time with the competition. Lisa brings back to Lloyd Wise her unique experience of Chinese patent and trade mark law and practice.

Baker & McKenzie are very pleased to announce that Peggy Cheung and Loo Shih Yann were elected to local partnership with effect from 1st July 2000. Peggy is the Vice-President of the Institute and the Chair of the Trade Marks Sub-Committee, and is also a member of the Education Sub-Committee – she is a very active member of the Institute! Shih Yann is a member of the Institute. Congratulations to both Peggy and Shih Yann on their very well deserved partnerships.

Foreign Laws

Macau:



As reported elsewhere in this edition, the new law published on December 13 1999 has now come into force.

Belize:

Belize joined the Paris Convention on June 17 2000.

OHIM:

Following a suspension because of the unexpectedly large number of CTM applications filed in the first few months, seniority examination of CTM applications has resumed for applications filed on or after 1 May 2000.

From the IPD.....

Since the last edition of The Journal a further circular has been issued by the IPD:

Circular No.4 of 2000: List of renewable deemed standard patents on IPD's website

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

Annual General Meeting

Please note that the Annual General Meeting of the Institute will be held on September 20 2000 at The Hong Kong Club. As usual there will be a dinner with a guest speaker and so I hope that as many people as possible will be able to come. Please mark your diaries now!

Please also remember that there are always Council places that come up for election every year, so please consider standing if that interests you.

Full details of the AGM will follow closer to the date.



Dates for your diary

In addition to our AGM – which is obviously the most important event! – you may wish to note the following:

Bruges 28-29 September 2000 ITMA Autumn Conference

Hong Kong 4-7 October 2000 PTMG 61st Conference

Cebu, November 10-14 2000 APAA General Assembly

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

In The News

Coffee wars seem to have started in Japan. According to an article in the Asian Wall Street Journal, Starbucks has applied for an injunction against a Japanese competitor Doutor Coffee Co. who use a circular logo allegedly similar to the Starbucks logo. Given the recent growth in coffee shops in Hong Kong, how long until a similar dispute brews up in Hong Kong?

And finally....

To celebrate Bastille Day, on July 14 2000 the Institute held a barbecue at the Aberdeen Boat Club clubhouse on Middle Island. We were very lucky with the weather because that week was lovely, but the following week poured with rain. Thanks for a successful evening go to Nick Horvath for organising, Baker & McKenzie for the loan of a junk, and to all who attended.



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

The next edition of the Journal will be sent out at the end of September following the AGM. If you have any comments on the contents of The Journal, brickbats or bouquets, letters for publication, articles, news....please contact Graeme Hall at Lloyd Wise & Co before then (fax 2868 5438 or e-mail to graemehall@lloydwise.com.hk).

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