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From the Editor

The recent Annual General Meeting, which is reported in this edition of The Journal, marked the halfway point in my term as President and so gave me cause to reflect on my first year in the job. The first thought that came to me was that if someone had told me how much work was involved, and how time-consuming being President was going to be, then I would probably never have taken on the task in the first place. It can also be very frustrating when things that you want to achieve prove hard to realise, but of course it can also be satisfying when they come off.

My biggest frustration is that our education programme is taking more time to organise than I had hoped, but this is largely because it involves far more work and preparation than I think we had ever imagined – but we are getting there, if slowly. On a more positive note the Institute has continued to be closely involved with Government on many issues, the membership numbers are healthy, and I have worked to ensure that the membership is kept informed of the Institute's activities. In my second (and final!) year I shall continue to do my best to strengthen and promote the Institute.

Annual General Meeting

The Annual General Meeting was held on Wednesday September 20 2000 at the Hong Kong Club and as you will know was combined with an Extraordinary General Meeting. I am pleased to say that about 40 members attended the AGM/EGM, a little under half of the membership, which I think is a very good turnout. The purpose of the EGM was to amend the Article defining the requirements for membership of the Institute, in particular to clarify that where the provisions require a period of experience in Hong Kong in trade mark law, that experience must be at least substantially in respect of Hong Kong trade mark law. I am pleased to report that the amendment was approved.



Two Council Members, Peter Shen and Ruby Yeung, did not stand for re-election this year and in their place I am delighted to welcome Winnie Chan and Irene Ng. There has also been one change in the office holders within the Institute, with Steven Birt becoming the new Membership Secretary. If there are any changes to your membership details please let Steven know.

A major reason for the good attendance at the AGM/EGM was no doubt the presence of Margaret Ng as our guest at the dinner that followed the meeting. Not only did Margaret Ng talk very interestingly about her experiences chairing the Trade Marks Bill Committee, but she also encouraged a stimulating question-and-answer session, which ranged far more widely than trade marks. It was obvious – if we didn't know this already - that Margaret Ng is a committed legislator who believes that whatever faults Legco may have in its current form, it is far from being the toothless body that it is often portrayed as.

Thanks go to all members who attended, and to Nick Horvath for organising the room and dinner.

IPD – Position and Strategy

On Monday September 18th the IPD held a meeting with representatives from the Institute, the Law Society and APAA to outline the current position of the IPD with regard to its workload, and to point the way that the IPD hopes to move forward in the medium term. The background to all this is of course the recent rapid increase in filings, coupled with the financial pressures put on the IPD as part of the Civil Service generally (there has been a reduction of over 20% in both headcount and total costs over the last 3 years), and the implementation of the new trade marks law.

The IPD were anxious that this meeting be publicised to the profession and this article summarises the comments of the IPD.

We will all be aware of the vast improvements that the Registry has made with regard to the speed with which applications are processed, and the reduction of the backlog of unexamined applications. While from time to time we may still take issue with some of the ways in which this has been achieved (extensions of time being the most obvious example), the figures still make



impressive reading: from a peak of over 18,000 in 1995, the number of unexamined trade mark applications has been reduced to just under 12,000 at the beginning of 1997, and to 6,475 as of May 31 2000. In 1997 the Trade Marks Registry was issuing 95.8% of examination reports within ten months, today 98.8% are issued within five months.

This improvement in performance has been achieved by a number of improvements in the internal management of the Registry and outsourcing of a number of non-specialist functions. What is more, the improvement has come while at the same time there has been a 23.9% increase in the number of applications filed.

What is clearly concerning the Registry is that all this good work could be undone by the recent large increase in the number of new filings that has been seen not only in Hong Kong but also throughout the world. What is more, there has also been an increase in opposition proceedings that is proportionately even larger than the number of new filings. As the Registry puts it, at the moment they are “having to run just to stand still” and it is clear that they see the introduction of the new law as essential to help them maintain this improved performance.

Outsourcing is clearly seen by the IPD as a key element in their strategy. Currently a new computer system for trade marks, a computer system for registered designs, and enhancements to the patents computer system are all being or are about to be sought and the IPD hope to award the first tender in the first quarter of 2001. According to the IPD the new IT systems will be introduced the three phases. Phase I is intended to be completed by June 2001 and will cover the essential office operation services, maintenance of existing systems and office automation. Phase II is scheduled for completion by the end of 2001 and will cover trade mark and design core functions, electronic publication and management information. This part of the process is essential for the new Trade Marks Ordinance to be implemented. Finally, Phase III will be late 2001 allow Internet searching, e-filing and paperless facilities for all three Registries.

I am sure that all practitioners will have some sympathy for the IPD with the problems they face, as many people and firms will have parallel issues in their own practice, and of course it is in all our interests that the IPD be successful. At the same time, however, I believe that we do have a duty to monitor the IPD to ensure that the interests of our clients are not prejudiced by any of these changes no matter how laudable the IPD's intentions. We have already seen this happen once with the change in policy on extensions of time, and we need to be vigilant in case something similar



happens again. In addition, with the increasing importance of outsourcing, it is important that quality control be maintained at all times.

Recent Decisions

So many of the most important and interesting cases these days involve the Internet, that I have decided to mention some of the most interesting Internet and domain name cases that I have come across recently.

Two recent decisions of the WIPO Arbitration and Mediation Center have provided a very valuable clarification of the Universal Dispute Resolution Policy that will be of assistance to complainants, especially when the complainants are well-known individuals. The UDRP requires a complainant to demonstrate three elements to be successful in a complaint: (1) that the domain name under complaint is identical or confusingly similar to a trade mark; (2) that the domain name holder has no legitimate interests in respect of the domain name, and (3) the domain has been registered in bad faith.

Case D2000-0235 concerned a complaint by the British author Jeanette Winterson in respect of registrations of the domains jeanettewinterson.com, jeanettewinterson.net and jeanettewinterson.org. Ms Winterson had no trade mark registration of her name and the Administrative Panel had to decide whether the UDRP required a trade mark to be registered to form the basis of a complaint. Citing the One in a Million case the Panel found that registration was not necessary and that Ms Winterson had sufficient common law rights in her name to form the basis of a complaint and since the other elements of the complaint were made out the Panel ordered the domains to be transferred to Ms Winterson. Case D2000-0210 was decided shortly after the Jeanette Winterson case and followed that case by ordering that the domain juliaroberts.com be transferred to the actress Julia Roberts. No doubt the panels were assisted in these two cases by the fact that the domain names in question were the names of well-known individuals, cases would presumably be less clear-cut in a dispute involving an unregistered trade mark of a more general kind.

Also just issued – and a case that made the South China Morning Post – was a decision on the madonna.com domain which is to be transferred to Ms Ciccone, but then she had the advantage of



a number of registrations.

Most Internet cases seem to involve disputes over ownership of domain names, cybersquatting and so on, and so a recent case in New Zealand (reported in EIPR August 2000) involving two competing domain names made a refreshing change in that no “ordinary” trade marks were involved. The Plaintiff owned the domain name nzcity.co.nz and apparently used this domain as an Internet shopping mall. The Defendant had the domain name theCity.co.nz and provided online shopping services. The Plaintiff was seeking an interim injunction on the grounds of passing off and that the Defendant was engaging in business contrary to the Fair Trading Act. Since the Plaintiff was well-established and the Defendant a newcomer, the injunction was granted but the case may be worth following if it goes to trial.

Visit of Todd Dickinson to Hong Kong

Todd Dickinson, the Commissioner of the United States Patent and Trademark Office, and Under-Secretary for Commerce, visited Hong Kong on October 17 2000 en route between Beijing and Shanghai. Not perhaps the most direct route between China’s two major cities, but no one in Hong Kong was complaining as it gave us the opportunity to welcome him here.

I hope that many members of the Institute were able to attend his speech held at IPD in the afternoon, but I have never seen the function room so crowded and I understand that there was an overflow room at the US Consulate.

In his talk Mr Dickinson was perhaps relatively predictable in some of his comments, emphasizing the importance of IP in the modern world, commending the efforts of the Hong Kong Government in attacking counterfeits and expressing hopes for further co-operation. But he also gave interesting insight into some of the plans of the US PTO for electronic filings, expressed the hope that the US would soon be a Madrid country, and also mentioned his hopes for progress with the Patent Law Treaty and future developments of the PCT and regional co-operation.

Perhaps the most interesting part of the afternoon though was the question and answer session. Mr Dickinson fielded a wide range of questions mainly on patent matters such as business method patents and biotechnology issues, and also on Internet related issues, and he answered all



questions at length without avoiding any difficult issues.

From the IPD

There have been no new Circulars from the IPD since the last edition of *The Journal*. However the IPD has issued for consultation proposed changes to the Patents and Registered Designs Ordinances. These are relatively minor and include a number of small amendments and provisions enabling electronic filing and publication in the future. They can be found on the IPD website. The Institute's Patents and Designs sub-committee chaired by Graeme Hall will consider the proposals. We have been asked to make any submissions that we may wish to by November 16, and so if any member would like us to consider any particular issues, please let us know (graemehall@lloydwise.com.hk).

Dates for your diary

November 7th-8th 2000 Hong Kong Symposium 2000 Hong Kong – an IP Gateway

Please remember to support this Symposium, which is being organized by APAA and the IPD and is supported by the Institute. The line-up of speakers promises to be very interesting and so if you haven't already registered I suggest that you do so as soon as possible.

November 10 th -14 th	Cebu City	APAA
November 15 th -18 th	Scottsdale, Arizona	INTA Mid-Year Meeting
November 30 th / December 1 st	London	INTA/Marques

Please send any comments about this edition of *The Journal*, any letters or articles for future issues, to the Editor Graeme Hall at graemehall@lloydwise.com.hk

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