

**THE HONG KONG GROUP
OF THE
ASIAN PATENT ATTORNEYS ASSOCIATION
("APAA HONG KONG GROUP")**

PRESIDENT'S REPORT

It is my pleasure to deliver my report for the year 2019 - 2020.

1 Membership

- 1.1 As at 30 November 2020, we have 112 Individual Members and 26 Organisation Members.
- 1.2 Following the election of Ella Cheong to Honorary Membership, we now have 5 Honorary Members, namely, former judge Mr. Anthony Rogers, Mr. Robin Bridge, Ms. Anna Wu, Professor Michael Pendleton and Ms. Ella Cheong.

2 Council and Committee members registered with APAA

According to the Statutes of APAA, the term of office of Council Members starts from the end of a General Assembly to the next General Assembly. Likewise appointment to the Committees of APAA was for a term between two General Assemblies. As the General Assembly intended to be held in Gold Coast, Australia, in November 2020 had to be postponed due to the COVID-19 pandemic, the following members of the Hong Kong Group will stay in office as Council Members and Members of Standing Committees of APAA until the next General Assembly, currently planned to be held in Gold Coast in November 2021:-

Council Members of APAA	Name	Remarks
	Andrew COBDEN	
	Chi Keung KWONG	Past President of APAA
	Jeffrey MCLEAN	Secretary of Hong Kong Group
	Rebecca LO	President of Hong Kong Group; member of AdCom of APAA

Victor TSE	Co-Chairperson of the Emerging IP Rights Committee of APAA
Henry WHEARE	Vice-President of APAA and Treasurer of Hong Kong Group

Standing Committees of APAA

	Name	Remarks
Anti-Counterfeiting Committee	Alan CHIU Tim HANCOCK Lawrence YEUNG	
Copyright Committee	Shirley KWOK Anita LEUNG Anthony TONG	
Designs Committee	Catherine ZHENG Benjamin CHOI Mike FLINT Tim LETTERS	Co-Chairperson of the Designs Committee
Emerging IP Rights Committee	Victor TSE Steven BIRT Andrew COBDEN Chloe LEE	Co-Chairperson of the Emerging IP Rights Committee
Patents Committee	Ted CHWU Jeffrey McLEAN Laurence THOO	
Trade Marks Committee	Serena LIM Helen TANG Adelaide YU	

3 Meetings with the Intellectual Property Department (“IPD”)

3.1 For many years, Council and Committee members of APAA Hong Kong Group have been meeting with Directorate and senior officers of IPD twice a year to discuss matters relating to the intellectual property practice. As from 2020, this arrangement is changed. IPD will hold one annual joint meeting of 3 IP organisations (namely, APAA Hong Kong Group, the IP Committee of The Law Society of Hong Kong, and Hong Kong Institute of Trade Mark Practitioners) so that matters can be discussed and followed up by IPD more efficiently. Each of the said IP organisation will still have an individual meeting with IPD to discuss matters of particular interest to that organisation. In addition, IPD holds a joint breakfast meeting annually with representatives of the 3 IP organisations to touch base on the work of IPD. Attendance of the breakfast meeting is limited to 2 representatives of each organisation. During the period covered by this report, apart from those meetings, IPD also held 2 batches of Focus Group Meetings attended by representatives of APAA Hong Kong Group as well as representatives of other organisations. More on the meetings are reported below.

3.2 A breakfast meeting was held on 20 November 2019. APAA Hong Kong Group was represented by me and Andrew Cobden. At the meeting, IPD reported on preparatory work in implementing the new patent regime (which came into force on 19 December 2019 as scheduled), and informed the attendees that IPD would embark on preparatory work for drafting the Rules to implement the Madrid Protocol whilst waiting for the Trade Marks (Amendment) Bill 2019 to be passed into law. (Note: the said Bill was ultimately passed in Trade Marks (Amendment) Ordinance 2020 in June 2020.) At the meeting, the IP organisations requested IPD to consider setting up a regime to regulate trade mark agents practising in Hong Kong and to limit representation of clients before IPD in relation to applications filed through the Madrid Protocol route to agents resident in Hong Kong. At the meeting IPD said they had no plan to do either. With regard to the IP organisations’ interest in raising the professional standard of trade mark agents, IPD indicated that an industry-led accreditation scheme would be a more pragmatic and efficient approach.

3.3 APAA Hong Kong Group’s meeting with IPD took place on 3 March 2020 in the form of a virtual meeting. Matters discussed include:

3.3.1 IPD’s special work arrangement as part of Government’s measures to control the pandemic

IPD reported on the measures taken to maintain service while complying with Government’s policy of closure of government offices other than those providing essential services.

APAA Hong Kong Group expressed gratitude to IPD for its efforts to address issues arising in those special circumstances, such as the

issuance of notices of interruption of the Registries' operations and the resulting extension of statutory deadlines.

3.3.2 Update on the implementation of the new patent system

The new patent system comprising the original grant patent ("OGP") system together with its supporting IT system were launched on 19 December 2019. The full set of examination guidelines had been uploaded to IPD's website for practitioners' and patent filers' reference.

IPD would embark on a survey on the present landscape of patent agency services with a view to exploring options of setting up a full-fledged regulatory regime of patent practitioners.

IPD reported that 37 OGP applications were received by the end of February, 17 of which were of Hong Kong origin. All the applications were under processing.

3.3.3 Amendments to Rules of the High Court and corresponding amendments to the Trade Marks Rules, Patents (General) Rules and Registered Designs Rules

Following submission of the legislative proposals to the Judiciary Administrator in August 2019, IPD had been informed that the two judges of the IP List had considered and commented on the proposals. The proposals were subject to further consideration by the Registrar of the High Court for formal submission to the High Court Rules Committee. IPD would continue to liaise with the Judicial Administrator to press ahead with this legislative exercise.

3.3.4 Application of Madrid Protocol to Hong Kong and other amendments of the Trade Marks Ordinance

The Trade Marks (Amendment) Bill 2019, which makes provisions for the application of the Madrid Protocol to Hong Kong as well as various other changes to tidy up the Trade Marks Ordinance, was passed into the Trade Marks (Amendment) Ordinance 2020 and came into operation on 19 June 2020 except section 5 and Part 4 concerning the implementation of the Madrid Protocol.

While waiting for the Bill to pass into law, IPD wasted no time and began preparation of drafting instructions on procedural rules governing processes under the Madrid Protocol as well as proposed amendments to the Trade Marks Rules which would cover matters including the refinement of certain day-to-day practices and procedures in trade mark registration.

In this connection, IPD arranged 2 batches of Focus Group Meetings to gather practitioners' views and suggestions. The focus group

meetings on procedural rules relating to implementation of the Madrid Protocol were held on 9 and 18 December 2019 and were attended by Chloe Lee, Anita Leung and Anthony Tong as representatives of APAA Hong Kong Group. The focus group meetings on amendment of the Trade Marks Rules relating to hearings were held on 13 Jan and 5 May 2020 and were attended by Henry Wheare and Anthea Loo as representatives of APAA Hong Kong Group.

3.3.5 Review of copyright exceptions for persons with print disability

The Copyright (Amendment) Bill 2019, which sought to enhance the copyright exceptions relating to persons with a print disability in the Copyright Ordinance in order to meet the standards under the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled was passed into the Copyright (Amendment) Ordinance 2020 and came into operation on 26 June 2020.

- 3.4** A joint meeting of the 3 IP organisations with IPD is scheduled to take place on 8 December 2020. A number of Council and Committee members had already registered their intention to attend the meeting. Those who have not yet responded are encouraged to do so as soon as possible.
- 3.5** A list of the Council, Committee and other members who attended various meetings with IPD is annexed hereto. I thank all these members for their time and effort in serving the interests of APAA Hong Kong Group.

4 Projects undertaken by the Council

4.1 Opening of Bank Account

Responsible council member: Henry Wheare.

Preparation is being made to open an account with the Shanghai Commercial Bank.

4.2 Modernising the Hong Kong Group website

Responsible council member: Jeff McLean.

Contract was signed with a website developer and the target is to get the website ready by March 2021. Pending that, some updating of our existing website was done to put in information about the qualifications held by our members so as to facilitate the public in engaging the right professionals to serve their IP needs.

4.3 Bidding to host APAA Meeting in Hong Kong in 2024

Responsible council member: Victor Tse.

An ad-hoc committee, led by Victor Tse and joined by Rebecca Lo, Henry Wheare and Jeff McLean, met several times to discuss on preparation of the bid and interviewed several professional conference organisers. With the help and support of the Hong Kong Tourism Board, a bid to host the APAA Meeting in Hong Kong in 2024 was submitted to APAA Secretariat in January 2020. However since the APAA Meeting in Gold Coast, Australia was postponed to 2021, and all the APAA Meetings already approved by APAA Council have to be shifted by one year, we are now working on modifying the bid and submit it APAA Secretary in January 2021 to bid for hosting the APAA Meeting, which is a General Assembly, in Hong Kong in 2025.

5 Events and Activities

5.1 During the period covered by this report, activities were low due to the pandemic. APAA Hong Kong Group was invited to participate in the following events and activities:-

5.1.1 Business of Intellectual Property (BIP) Asia Forum 2019 (5-6 December 2019) jointly organised by the Government of Hong Kong SAR, Hong Kong Trade Development Council and Hong Kong Design Centre.

APAA Hong Kong Group was a supporting organisation and our members enjoyed free passes or discounted rates for attending the conference.

5.1.2 Guangdong-Hong Kong-Macao Greater Bay Area High Value Patent Portfolio Contest 2020 (2020 年粵港澳大灣區高價值專利培育佈局大賽) co-organised by The Guangdong Province Administration for Market Regulation, IPD of Hong Kong, the Economic Bureau of Macau, Zhuhai Municipal Government and Dongguan Municipal Government.

The Contest, themed “Supporting the Quality Development of the Guangdong-Hong Kong-Macao Greater Bay Area by High-value Patents”, is open to patent applicants (owners) (either in the name of an enterprise, tertiary institution, research centre, or individual) entering as an individual participant, or as a team together with other members including IP service agencies. The Contest aims at identifying high-value patent portfolios with leading technology and huge market potential, promoting the development of effective strategies for nurturing high-value patents, and fostering the advancement of a high value-added knowledge economy in the Guangdong-Hong Kong-Macao Greater Bay Area. There will be various awards and prizes with a total value of RMB4.56 million

5.1.3 2020 Guangdong/Hong Kong Seminar on Intellectual Property and Development of Small and Medium Enterprises (Online) jointly

organised by IPD, HKTDC and Guangdong Intellectual Property Administration (廣東省知識產權局)

Under the theme of "Strategy for Development of Innovation: IP Protection and Exploitation for Enterprises in the Greater Bay Area " (創新發展攻略：大灣區企業知識產權保護和運用), the seminar provided a platform for SMEs, legal bodies and government officials to keep abreast of the latest IP development in the Greater Bay Area.

6 Social

For many years, APAA Hong Kong Group has been organising a members' dinner after the AGM to enable members to socialise with their peers. Last year's members' dinner was held at the Hong Kong Club. 44 members and guests attended the dinner and spent a very enjoyable evening together. We were very honoured to have as our guests Mr. Justice David Lok, High Court Judge assigned to handle cases on the IP Specialist List, Mr. David Wong, Director of Intellectual Property, Ms. Maria Ng, Deputy Director of Intellectual Property and Mr. Thomas Tsang, Assistant Director of Intellectual Property, join us for dinner. Prior to dinner, Mr. Justice Lok addressed our members on the latest development in how the IP Specialist List facilitated the more efficient handling of IP litigation, and Mr. David Wong addressed our members on IP legislative development and the progress of the NIS.

7 APAA Prizes

APAA Hong Kong Group has for many years been sponsoring prizes to gifted students of intellectual property law nominated by The University of Hong Kong, The Chinese University of Hong Kong and The City University of Hong Kong. Since the 2019 President's Report, the following prizes have been awarded:-

- 7.1** The 2017-18 APAA Prize in "Intellectual Property Law", in the amount of HK\$3,000, was awarded to Dr Wang Chuandao, the best student graduating from the Master of Laws in Information Technology and Intellectual Property at The University of Hong Kong.
- 7.2** The 2018-19 APAA Prize in "Issues in Intellectual Property Law or in Copyright Law", in the amount of HK\$3,000, was awarded to Mr Tang Long Yin of The University of Hong Kong. Henry Wheare attended the award ceremony on 30 August 2019 to present the APAA Prize to the awardee.
- 7.3** The 2018-19 APAA IP Law Prize, in the amount of HK\$3,000, was awarded to Lam Chi Wing, being the top student in the 2018-19 LLB IP course "IP Law: Theory Copyright & Design".
- 7.4** The Chinese University of Hong Kong course on 'Intellectual Property and the Law' was not offered in the academic year 2018/19 but will be offered again in 2019/20.

8 Opposition to Hong Kong Trade Mark Application No. 301543392

Members are aware that opposition was filed against Hong Kong Trade Mark Application No. 301543392 for the mark “Hong Kong Institute of Patent Attorneys and Device”. By agreement with the Applicant, The Hong Kong Institute of Patent Attorneys Limited, the opposition was stayed and it is likely to remain so until it becomes clear whether or not and if so how the Hong Kong patent attorneys profession will be regulated.

9 Money held in Account

The money of APAA Hong Kong Group is held in the Client Account of Nixon Peabody CWL. We are working on opening a bank account with Shanghai Commercial Bank.

Henry Wheare, Treasurer, will give a more detailed report on the state of our accounts.

The Council gives consideration from time to time on how funds should be held and so far, no conversion to other currencies has been made.

Rebecca Lo

President

1 December 2020

Meetings with IPD

Representatives of APAA Hong Kong Group attending the meetings

Breakfast Meeting on 20 November 2019

Rebecca Lo (President); Andrew Cobden (Council Member)

Procedural Rules relating to implementation of Madrid Protocol Focus Group Meetings (November & December 2019)

Chloe Lee (Committee Member); Anita Leung (Committee Member); Anthony Tong (Committee Member)

Hearing-related Matters Focus Group Meetings

Henry Wheare (Vice-President & Treasurer); Anthea Loo (Member)

Virtual Meeting on 8 March 2020

Council

Rebecca Lo (President); Henry Wheare (Vice president); Andrew Cobden; C. K. Kwong; Jeff McLean; Victor Tse

Committees

Mike Flint; Shirley Kwok; Anita Leung; Serena Lim; Anthony Tong; Catherine Zheng

(Council members Andrew Cobden, Jeff McLean and Victor Tse also attended in their capacity as Committee Members)

Joint Meeting of IP Organisations with IPD to be held on 8 December 2020

(Persons registered to attend)

Council

Rebecca Lo (President); Andrew Cobden; Jeff McLean; Victor Tse

Committees

Alan Chiu; Mike Flint; Shirley Kwok; Anita Leung; Serena Lim; Helen Tang; Anthony Tong

(Council members Andrew Cobden, Jeff McLean and Victor Tse will also attend in their capacity as Committee Members)