

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

PRESIDENT'S REPORT

It is my pleasure to deliver my report for the year 2021 - 2022.

1 Membership

As at 26 September 2022, we have 110 Individual Members, 25 Organisation Members, and 5 Honorary Members.

2 Council and Committee members registered with APAA

At the virtual Council Meeting held in Gold Coast in October 2021, appointment of the following persons was confirmed:-

<u>Council Members of APAA</u>	<u>Name</u>	<u>Remarks</u>
	Andrew COBDEN	
	Chi Keung KWONG	
	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

<u>Standing Committees of APAA</u>	<u>Name</u>	<u>Remarks</u>
Anti-Counterfeiting Committee	Alan CHIU	
	Tim HANCOCK	
	Clement LAM	
Copyright Committee	Shirley KWOK	
	Anita LEUNG	
	Anthony TONG	
Designs Committee	Catherine ZHENG	Co-Chairperson of the Designs Committee
	Benjamin CHOI	
	Chloe LEE	
	Rosita LI	
Emerging IP Rights Committee	Victor TSE	Co-Chairperson of the Emerging IP Rights Committee
	Steven BIRT	
	Andrew COBDEN	
	Douglas CLARK	
Patents Committee	Ted CHWU	
	Jeffrey McLEAN	
	Steven FUNG	
Trade Marks Committee	Serena LIM	
	Helen TANG	
	Adelaide YU	

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

3.1 Meeting re Implementation of Madrid Protocol (20 January 2022)

This was a briefing by IPD to representatives of APAA-HK and the Hong Kong Institute of Trade Mark Practitioners (“HKITMP”) about proposed procedural rules for implementing the Madrid Protocol (a) where the Trade Marks Registry (“TM Registry”) acts as an Office of Origin to process the filing by a trade mark owner in Hong Kong of an application for international registration of a trade mark under the Madrid Protocol, and (b) where the TM

Registry acts as a Designated Office to process the filing by an overseas trade mark owner of an application for international registration of a trade mark designating Hong Kong, or a request for territorial extension of an international registration (“IR”) to Hong Kong. In addition, IPD proposed to amend the procedural rules relating to contentious proceedings before the TM Registry. IPD was working with the Law Draftsman on drafting amendments to the Trade Marks Rules (Cap. 559A).

Practitioners attending the meeting provided comments about the proposed procedural rules. Practitioners also raised concerns that the amendments proposed by IPD seemed to allow agents from everywhere in the world to handle office actions and contentious proceedings before the Registrar where IR applications are concerned. The concerns subsequently led to joint efforts by HKITMP, APAA-HK and the IP Committee of the Law Society (LawSoc-IP”) to request amendment of the Trade Marks Rules to enable IPD to exercise better control over who may be treated as Hong Kong agents to handle office actions and contentious proceedings before the Registrar. See below for a more detailed report.

APAA-HK representatives attending the meeting:

Council members	Rebecca LO (President); Andrew COBDEN
Committees members:	Steven BIRT; Alan CHIU; Benjamin CHOI; Ted CHWU; Clement LAM; Chloe LEE; Rosita LI; Serena LIM; Helen TANG; Anthony TONG; Adelaide YU; Catherine ZHENG

3.2 Joint Meeting of IPD with APAA-HK, LawSoc-IP and HKITMP (17 February 2022)

Due to the pandemic, the meeting was held online. At the meeting, IPD gave progress reports on various legislative and practice developments, which are summarised below.

The following APAA-HK Council and Committee members attended the Joint Meeting:-

Council members:	Rebecca LO (President); Andrew COBDEN; Jeffrey McLEAN
Committee members:	Steven BIRT; Alan CHIU; Benjamin CHOI; Ted CHWU; Douglas CLARK; Steven FUNG; Clement LAM; Chloe LEE; Rosita LI; Serena LIM; Helen TANG; Anthony TONG; Adelaide YU; Catherine ZHENG

3.3 Patent Practice Group Meeting (17 February 2022)

This online meeting, which was also a joint online meeting of APAA-HK, LawSoc-IP and HKITMP with IPD, took place immediately after the above-mentioned Joint Meeting. At the meeting, IPD provided statistics on Original Grant Patent (“OGP”) applications and applications for examination of Short Term Patents, and reported on the pilot scheme on deferral of formality examination of OGP applications, proposed amendment to the Rules of the High Court and the Patents (General) Rules, as well as some findings of the Patent Practitioners Survey.

The following APAA-HK members attended the meeting:-

Council members:	Rebecca LO (President); Andrew COBDEN; Jeffrey McLEAN
Committee members:	Alan CHIU; Benjamin CHOI; Ted CHWU; Douglas CLARK; Steven FUNG; Clement LAM; Chloe LEE; Rosita LI; Catherine ZHENG
Members:	Justin DAVIDSON; Angus FORSYTH; Charlie LIU; Lilian SHI; Deanna WONG

3.4 Informal Meeting to discuss regulation of patent agency services (15 June 2022)

IPD called for an informal meeting with APAA-HK, LawSoc-IP and HKITMP to gather views of practitioners about regulation of patent agency services. The meeting was chaired by Ms. Joyce Poon, Assistant Director of Intellectual Property. Although the matter was only at a view-gathering stage and no decision was made yet, IPD indicated an inclination to have practitioners form a self-regulatory body to deal with accreditation of title, accreditation of courses, maintenance of the register of qualified persons, oversight of renewal of registered status, oversight of service standards and professional discipline, as well as setting rules for grandfathering. Practitioners attending the meeting shared their views on different aspects of the matter, and expressed the view that as the matter involved whether or not someone would be entitled to practise as a qualified Hong Kong patent agent, statutory backing would be required to empower the self-regulatory body to carry out its proposed functions. Some practitioners also raised the issue of funding, as the self-regulatory body would need administrative support in carrying out its proposed functions.

Ms. Joyce Poon said IPD would go through the views of various practitioner organisations and discuss internally.

After the meeting, IPD sent over information about the Professional Services Advancement Support Scheme (“PASS”) of the HK Government. However it

appears that PASS is to provide funding for specific projects of professional development and attendance at exhibitions, etc., rather than to provide funding for the operation of a self-regulatory body.

The following APAA-HK members attended the meeting:-

Council members:	Rebecca LO (President); Henry Wheare (Vice President); Andrew COBDEN; C.K. KWONG; Jeffrey McLEAN; Victor TSE
Committee members:	Benjamin CHOI; Ted CHWU; Douglas CLARK; Steven FUNG; Shirley KWOK; Chloe LEE; Catherine ZHENG
Members:	Ewan BEWLEY; James CLEEVE; Grace CHU; CHUNG Wai Yin; Justin DAVIDSON; Angus FORSYTH; Owen GEE; Frank LEE; Timothy LETTERS; Melvin LI; Charlie LIU; Twiggy LIU; David SWAIN; Kenny WONG

3.5 Meetings re Hong Kong trade mark agents (12 May 2022; 31 August 2022)

APAA-HK, LawSoc-IP and HKITMP met twice with IPD on the subject of overseas agents handling Hong Kong trade mark work. See below for further information on the matter. For both meetings, IPD put a limitation on the number of representatives from each organisation. Representatives of APAA-HK attending the meetings were:-

12 May 2022 meeting:	Rebecca LO (President); Alan CHIU; Serena LIM; Catherine ZHENG
31 Aug 2022 meeting:	Rebecca LO (President); Henry WHEARE (Vice President); Serena LIM

3.6 Trade Mark Practice Group Meeting (31 August 2022)

At the meeting, representatives of APAA-HK, LawSoc-IP and HKITMP flagged up issues regarding Trade Marks Registry practice, including how virtual goods and NFTs should be described in the specification of goods and services of trade mark applications, how those items should be classified, the purpose and effect of the Registrar accepting mp3 and mp4 files for sound marks and movement marks and including such files in the trade mark records for public search, the implication of the ® symbol, clarification on certain procedures in contentious proceedings before the Registrar, and clarification as to the significance of the font type used when registering a word mark.

The Registrar would consider the comments made by those attending the meeting and would provide guidelines and clarification as requested.

Representatives of APAA-HK attending the meeting were:-

Council members:	Rebecca LO (President); Henry Wheare (Vice President); Andrew COBDEN
Committee members:	Benjamin CHOI; Shirley KWOK; Serena LIM; Helen TANG; Catherine ZHENG
Member:	Anthea LOO (substituting committee member Anthony TONG)

3.7 APAA-HK annual meeting with IPD (23 September 2022)

APAA-HK's annual meeting with IPD took place on 23 September 2022 at the IPD Function Room. At the meeting, IPD gave progress reports on various legislative and practice developments, which are summarised below.

The following APAA-HK Council and Committee members attended the meeting:-

Council members:	Rebecca LO (President); Henry WHEARE (Vice President); Andrew COBDEN; Jeffrey McLEAN
Committee members:	Douglas CLARK; Steven FUNG; Shirley KWOK; Clement LAM; Anita LEUNG; Helen TANG; Anthony TONG; Catherine ZHENG

3.8 Summary of matters discussed at the Joint Meeting (17 February 2022) and Annual APAA-HK Meeting (23 September 2022) with IPD

3.8.1 Statistics of new applications filed

There was a drop in the number of applications received in all the Registries. The reference period is from Sep 2021 to Aug 2022, compared with the statistics for the same period last year.

	New applications received	Variation compared to same period last year
Trade Marks Registry	31,650	-11.24%
Designs Registry	3,591	-20.2%

Patents Registry		
SP (request to record)	20,719	-4.6%
Short-term Patent	561	-10.8%

3.8.2 Update on the implementation of the new patent system

From 19 December 2019 when the Original Grant Patent (“OGP”) system was introduced up to 31 August 2022, a total of 606 standard patent applications applied for through the OGP route (“Standard Patent (O)”) were received. Of these 606 applications:-

- (i) 232 applications (around 38%) were originated from Hong Kong;
- (ii) proportion of SP(O): 56% in Electricity field; 31% in Mechanical Engineering field; 13% in Chemistry field;
- (iii) a total of 29 SP(O) were granted

Up to the end of August 2022, a total of 8 applications for post-grant examination of STPs were received. So far 3 STPs were revoked, and the other examination applications were on-going.

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

IPD expects that drafts will be circulated in Q4 of 2022, with a view to submitting the Amendment Bill to LEGCO in the 2023 legislative year.

3.8.4 Application of Madrid Protocol to Hong Kong

IPD is working on 2 sets of draft amendments to the Trade Marks Rules, namely, (1) on implementation of the Madrid Protocol, and (2) to amend the rules regarding hearing procedures and other tidy-up amendments. The draft Madrid Protocol rules had been submitted to WIPO for consideration, and some comments basically on drafting style were received from WIPO. With regard to the second set of draft amendments, practitioners requested for certain amendments to be incorporated and IPD is considering practitioners’ request -- for more details, see paragraph 4 below.

IPD is working towards the target of submitting the amendment bills to LEGCO for negative vetting during the 2023 legislative year.

At the same time, IPD is updating the IT system for e-filing and search and promised that training will be provided prior to launch of the new IT system.

3.8.5 Copyright (Amendment) Bill 2022

The Copyright (Amendment) Bill 2022 was gazette on 27 May 2022. The legislative proposals cover the following five key areas:

- To introduce an exclusive technology-neutral communication right for copyright owners in light of technological developments;
- To introduce criminal sanctions against infringements relating to the new communication right;
- To revise and expand the scope of copyright exceptions to allow use of copyright works in certain common Internet activities; facilitate online learning and operation of libraries, archives and museums; and allow media shifting of sound recordings, etc;
- To introduce "safe harbour" provisions to provide incentives for online service providers to co-operate with copyright owners in combating online piracy and to provide reasonable protection for their acts; and
- To introduce two additional statutory factors for the court to consider when assessing whether to award additional damages to copyright owners in civil cases involving copyright infringements.

The Bill is now before the Bills Committee of LEGCO.

4 Verification of Hong Kong based trade mark agents

At the meeting with IPD on implementation of the Madrid Protocol (see paragraph 3.1 above), attendees learned from IPD's briefing that the draft amendment of Trade Marks Rules that the Law Draftsman was working on does not contain any provision as to who may respond to office actions in an application for international registration of a trade mark designating Hong Kong, or a request for territorial extension of an international registration to Hong Kong. Further, practitioners discovered that many agents currently handling trade mark applications and contentious proceedings before the Registrar actually operated from outside Hong Kong. This showed that IPD has failed in enforcing s88(3) of the Trade Marks Ordinance ("TMO") which provides that "The Registrar shall refuse to recognise as an agent a person having neither residence nor a place of business in Hong Kong". The situation is not conducive to nurturing a high quality trade mark profession in Hong Kong, and there are accountability concerns about those overseas agents as they are outside the reach of the Hong Kong courts.

As IPD was working with the Law Draftsman in preparing a Bill to amend the Trade Marks Rules (“TMR”), practitioners wished to take the opportunity to request IPD to include in the Bill amendments to the TMR to strengthen the enforcement of s.88(3) TMO. HKITMP, LawSoc-IP and APAA-HK worked together to produce a submission sent to the Commerce and Economic Development Bureau (“CEDB”) and IPD on 14 February 2022 setting out practitioners’ concerns, and providing examples of questionable agents who apparently did not have a place of business in Hong Kong. Representatives of the 3 organisations met with IPD on 12 May 2022 (see paragraph 3.5 above) to discuss the matter. At the meeting IPD promised to strengthen the enforcement of s88(3) TMO by adopting administrative measures but indicated a reluctance to consider any kind of amendment to the TMR.

The 3 organisations worked together to produce a supplemental submission sent to CEDB and IPD on 29 June 2022, provided further examples of questionable agents for IPD’s investigation, and asked for a further meeting with IPD.

At the second meeting with IPD on 31 August 2022 (see paragraph 3.5 above), IPD reported that of the 51 questionable agents drawn to their attention, investigation is under way with regard to 32 cases, and for the 19 investigations which were completed, no action is taken with regard to 10 agents, while 9 agents were refused. IPD further reported that the following administrative measures to strengthen the enforcement of s88(3) TMO were in progress:-

- (i) conducting robust investigations of questionable agents
- (ii) conducting proactive enquiries about agents opening e-filing accounts
- (iii) updating TM Registry Work Manual to reflect the enhanced practice of TM Registry
- (iv) updating the current e-filers list to identify which ones are legally qualified
- (v) setting up dedicated webpage about agents
- (vi) when the Madrid Protocol is implemented, IPD will highlight the statutory requirement on agents via appropriate means (e.g. IPD & WIPO’s websites, correspondence on office actions, promotional materials)
- (vii) IPD will collaborate with IP bodies in promoting HK quality professional services and possibly organize training courses

In addition, IPD is considering the following enhanced measures:-

- (viii) updating of TM Forms to highlight the statutory requirements for agents to provide their residential/business address in Hong Kong, and requiring agents to declare that the address so provided is where agent resides or carries on its business activities in Hong Kong, and that such declaration is true and accurate, with warning to the effect that making a false declaration is an offence which is liable to criminal prosecution

- (ix) seriously considering amendment of the TMR to introduce an express statutory requirement for an agent, when notifying the Registrar of its address under r.103(3)/(4) of TMR, to declare that such address is a place where it resides or carries on his business activities in Hong Kong, and that such declaration is true and accurate, and to highlight the Registrar's power to direct filing of documents, information or evidence as proof of an address provided under r.103(3)/(4) of TMR if he thinks fit
- (x) discussing with the Department of Justice about possible amendment to highlight the key pointers which the Registrar, when considering any document, information or evidence filed by an agent pursuant to the Registrar's direction, may take into account whether the documents indicate that "the agent has a physical residence or place of business in Hong Kong.

5 Projects undertaken by the Council

5.1 Opening of Bank Account

Responsible council member: Henry Wheare.

It took quite a while to gather all the documents asked for by the Shanghai Commercial Bank, including applying for an updated "Certificate of Exemption from Registration of a Society" from the Societies Officer of the Police. The required documents were all submitted to the bank and response from the bank is awaited.

Meanwhile all the money of APAA-HK continues to be held in the Client Account of Nixon Peabody CWL.

5.2 Modernising the Hong Kong Group website

Responsible council member: Jeff McLean.

Content is being gathered for putting into the website before it goes live. Meanwhile the existing website is still in use, and member information there is kept up-to-date.

5.3 Bidding to host APAA Meeting in Hong Kong in 2026

Ad hoc committee: Victor Tse; Jeffrey McLean; Henry Wheare; Rebecca Lo

As the conferences already approved by APAA were postponed due to the pandemic, APAA-HK's bid to host the meeting, originally planned for 2024 to coincide with the 50th Anniversary of APAA-HK, was deferred to 2026. The Hong Kong Tourism Board continued to support our project not only by assisting us in the preparation of the bid materials but also agreed to provide a subsidiary of HK\$400 to each overseas attendee, capped at HK\$560,000 (assuming 1,400 overseas persons attend the event) if we win the bid and host the APAA Meeting 2026 in Hong Kong.

The Recognised Group of Thailand has also submitted a bid to host the 2026 meeting in Bangkok.

The contesting bidders will be interviewed by the Conference Committee of APAA during the APAA Meeting 2022 in Busan.

6 Events and Activities

6.1 APAA Webinars

6.1.1 When AI Invents (29 July 2022) – a webinar discussing the current intellectual property and patent regimes are adequate to accommodate the impact of artificial intelligence in the development of new innovations and inventions.

6.1.2 Trademark Caravan: Spotlight on Cambodia (11 August 2022) – the Directors of the Cambodia Intellectual Property Office responsible for trademark registration and eminent trade mark practitioners of Cambodia shared practical information about registration of trade mark as well as enforcement of trade mark rights in Cambodia. Practitioners from India, Indonesia, New Zealand and Vietnam also provided updates on new developments in trade mark law and practice in their jurisdictions. I was moderator of the webinar.

6.2 APAA Hong Kong Group was invited to participate in the following events and activities:-

6.2.1 Business of Intellectual Property (BIP) Asia Forum 2021 (2-3 December 2021) jointly organised by the Government of Hong Kong SAR, Hong Kong Trade Development Council and Hong Kong Design Centre.

APAA-HK was a supporting organisation and our members enjoyed free passes or discounted rates for attending the conference.

6.2.2 IEEM IP Programme 2022: Webinar on 25 years of TRIPS Agreement (11-12 April 2022) organised by the Institute of European Studies of Macau

6.2.3 Expectations, Trends and Challenges for IP Licensing through the Lens of Industry Leaders (8 June 2022) – a webinar organised by Licensing Executives Society China, Hong Kong Sub-Chapter

6.2.4 Asian Licensing Conference Online (27-29 July 2022) organised by the Hong Kong Trade Development Council.

APAA-HK was a supporting organisation and our members enjoyed free passes or discounted rates for attending the conference.

6.2.5 Guangdong-Hong Kong-Macao Greater Bay Area High Value Patent Portfolio Layout Competition 2022 (2022 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 (Guangdong Intellectual Property Administration), the Intellectual Property Department of the

Government of the Hong Kong SAR, the Economic and Technological Development Bureau of the Government of the Macao SAR and the People's Government of Foshan Municipality.

The Competition, with the theme "High-value patents leading a quality development of innovative Greater Bay Area", aims at identifying high-value patents with leading technologies, 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. The competition 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. There are 50 awards with a total prize value of RMB 3,950,000.

7 Social

A members dinner was held on 4 August 2021 after the 2021 AGM. Close to 30 members attended the dinner.

8 APAA Prizes

In 2021, two prizes were awarded to students of The Chinese University of Hong Kong, namely:

- LLB programme: "Intellectual Property and the Law" -- awarded to Mr. Lee Kwan Lok
- JD programme: "International and Comparative Intellectual Property" -- awarded to Ms. Tam Shuen Wai

9 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.

10 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

27 September 2022