

TRADE MARKS ORDINANCE (CAP. 559)

OPPOSITION TO TRADE MARK APPLICATION NO. 300514160

MARK:



CLASS: 43

APPLICANT: REX DUBAI LLC

OPPONENT: WARNER BROS. ENTERTAINMENT INC.

STATEMENT OF REASONS FOR DECISION

Background

1. On 19 October 2005 (“Application Date”), Rex Dubai LLC (“the Applicant”) filed an application under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”) for the registration of the following mark (“suit mark”) –



Registration is sought in respect of the following services in Class 43 –

Class 43

cafes, cafeterias, catering (food and drink), restaurants, restaurants (self service), snack bars, camp services (holiday), canteens, rental of chairs, tables, table linen, glassware, reservations (temporary accommodation) tourist homes, hotel reservations, hotels, houses (boarding), motels rental of temporary accommodation

The Applicant has not claimed any colour as an element of the suit mark.

2. Particulars of the subject application were published on 6 January 2006. On 5 June 2006, Warner Bros. Entertainment Inc. (“the Opponent”) filed a notice of opposition against the subject application together with a statement of the grounds of

opposition. In response to the notice of opposition filed, the Applicant filed a counter-statement on 5 September 2006. As evidence in support of the opposition, the Opponent filed a statutory declaration made by Janet A. Korbin (“the Korbin Declaration”). The Applicant did not file any evidence or any written submissions.

3. The opposition was fixed to be heard on 10 August 2010. Only the Opponent filed a notice of intention to appear at the hearing, but it subsequently indicated its intention not to attend the scheduled hearing. The Applicant is treated as not intending to appear at the hearing pursuant to rule 74(5) of the Trade Marks Rules (cap. 559, sub. leg.) (“TMR”). I now proceed to decide the matter without a hearing under rule 75 of the TMR.

Grounds of opposition

4. The grounds of opposition stated in the notice of opposition filed are sections 11(1)(a), 11(4)(b), 11(5)(a), 11(5)(b), 12(1), 12(2), 12(3), 12(4) and 12(5) of the Ordinance. I wish only to deal with the grounds of opposition under sections 11(5)(b) and 12(5).

5. The Opponent seeks to rely on its ownership in the two trade marks below –



Mark A:

Mark B: CENTRAL PERK

Mark A and Mark B are hereafter collectively referred to as the “Opponent’s Marks”.

Opponent’s evidence

6. I will only set forth a brief description of the contents of the Korbin Declaration and leave the details in the discussions below. In general, the Korbin Declaration gives a picture of the Opponent’s business in film and television entertainment and the corporate structure of its group. In addition, there is mention of the registration of the Opponent’s Marks in relation to a broad range of goods and services in many classes. However, details of where the Opponent’s Marks are registered have not been provided; nor have any of the registration certificates been

submitted.

7. The more important part is where the deponent averred to the production of the highly successful and popular television sitcom “Friends” by the Opponent, which was shown all over the world. The sitcom was originally broadcast from 1994-2004 in the US and from 1996 in Hong Kong, and it had since been repeated in the US and other parts of the world including Hong Kong where it was, at the time the Korbin Declaration was made, still being broadcast. “Central Perk” is the name of the fictional coffee shop based in New York and one of the main focal points of the characters of the sitcom.

8. According to the Korbin Declaration, the Opponent has capitalized on the popularity of the sitcom and applied the Opponent’s Marks on products like clothing, posters, restaurant services, printed matter and computer games. These items were either sold directly by the Opponent or through licensees all over the world. Loads of samples can be found in the various exhibits to the Korbin Declaration but they relate mostly to goods with marks of the Opponent applied on them, as well as literature about the sitcom and its popularity. Although they mostly demonstrate use of the name of the sitcom, the Opponent’s Marks can clearly be considered as secondary marks of the Opponent.

9. Amongst the pictures in Exhibit “JAK-9”, there are a handful about an internet café operated by Warner Bros. Studios, licensee of the Opponent, in the USA. Other than this, there is no further indication that the Opponent’s Marks have been used in the provision of services in Class 43 anywhere in the world. It is also noted from the list of the licensees of the Opponent in Exhibit “JAK-10” that none of the licences relates to restaurant services or goods or services that can be considered as similar to the services applied for.

10. Apart from ownership of the Opponent’s Marks, the Opponent also claims ownership of the copyright in Mark A, with a copy of the certificate showing registration with the Copyright Office of the USA exhibited in Exhibit “JAK-2”. In Exhibit “JAK-2”, there is also shown an artist’s certificate and assignment, by which a Michael Bruza certifies to the creation in 1994 of a logo during the course of his employment by Warner Bros. Television Production, a division of Time Warner Entertainment Company L.P., for use in connection with the Central Perk coffee house in the “Friends” television series. Also notable from this exhibit is the recordal with the Copyright Office of the USA of the assignment of the copyright in

Mark A to the Opponent.

Section 12(5)(b)

11. Section 12(5) of the Ordinance reads as follows:

“Subject to subsection (6), a trade mark shall not be registered if, or to the extent that, its use in Hong Kong is liable to be prevented –

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or business (in particular, by virtue of the law of passing off); or

(b) by virtue of an earlier right other than those referred to in paragraph (a) or in subsections (1) to (4) (in particular, by virtue of the law of copyright or registered designs),

and a person thus entitled to prevent the use of a trade mark is referred to in this Ordinance as the owner of an “earlier right” in relation to the trade mark.”

12. In the notice of opposition, although the Opponent did include section 12(5) as one of the grounds for objection to the registration of the suit mark by the Applicant, the nature of the objection as described in paragraph 19 of the statement of the grounds of opposition would seem to refer to the ground of objection under section 12(5)(a) and not that under section 12(5)(b). Nonetheless, as the Opponent has elsewhere referred to the grounds of opposition under different sub-paragraphs of other sections specifically, and it has included the details of the claim to copyright in Mark A of the Opponent’s Marks in the Korbin Declaration, as indicated in paragraph 10 above and in respect of which there has not been any challenge by the Applicant, I find it appropriate for me to consider this ground of objection.

13. To consider whether the Opponent has an earlier right by virtue of the law of copyright, it is necessary to go through the relevant provisions of the Copyright Ordinance (Cap. 528) (“the CO”)¹. The CO came into effect on 27 June 1997. Prior to this, copyright is governed by the Copyright Act 1956 of the United Kingdom (“the 1956 Act”)². The position on copyright of works created prior to the commencement of the CO is set forth in the transitional provisions in Schedule 2 of the CO (“the Schedule”). According to paragraph 5(2)(a) of the Schedule, a work created prior to 27 June 1997 will only qualify for copyright protection if it meets the requirements

¹ Full text available at <http://hklaw.cngo.hksarg/eng/home.htm> and the provisions of the CO that have been quoted here are reproduced in the Appendix hereto.

² Provisions of the 1956 Act that have been quoted here are also reproduced in the Appendix hereto.

under section 177 or 188 of the CO had it been made or published after that date. Effectively, by virtue of section 177 of the CO, a work created by an author of whatever domicile or residence qualifies for copyright protection. Hence, Mark A qualifies for protection under the CO.

14. Next to consider is whether, as stipulated in paragraph 5(2)(b) of the Schedule, copyright under the 1956 Act in Mark A would not have expired had copyright subsisted in it under that Act. An original artistic work is a work in which copyright shall subsist under section 3 of the 1956 Act and included in the definition of “artistic work” in that section are drawings, irrespective of artistic quality. In coming up with the artwork that constitutes Mark A, skill and labour would certainly have been invested. I therefore have no reservations in finding Mark A to be an original artistic work within the meaning of section 3 of the 1956 Act. The term of copyright protection is set forth in section 3(4) of the 1956 Act, namely copyright subsists until the end of the period of 50 years from the end of the calendar year in which the author died and shall then expire. Mr. Bruza was still alive in 1999 when he signed the certificate referred to in paragraph 10 above. Hence, the condition specified in paragraph 5(2)(b) of the Schedule is also met.

15. Having determined that copyright subsists in Mark A under the CO, I need to then look at the duration of copyright protection which is governed by paragraph 13 of the Schedule. The work in question does not come within the descriptions in sub-paragraphs (2), (3), (4) or (5) of that paragraph and so applying sub-paragraph (6), the position is that provided for in section 17 of the CO, which is the same as that under the 1956 Act – copyright expires at the end of the period of 50 years from the calendar year in which the author dies. Since Mr. Bruza could not have died more than 50 years ago, copyright in Mark A has not expired yet.

16. Ownership of copyright in Mark A has to be ascertained too. For this, it is first necessary to consider authorship. As stated in paragraph 9 of the Schedule, authorship is to be determined in accordance with the law in force at the time the work was created. Section 4 of the 1956 Act is thus relevant. Mr. Bruza claims authorship and this has not been challenged by the Applicant. Whether he created Mark A in the course of employment is not important because of the assignment (as documented by the certificate in Exhibit “JAK-2”) by Mr. Bruza to Warner Bros. Television Production, a division of Time Warner Entertainment Company, L.P., in the course of whose employment Mr. Bruza created the work in question. Eventually, by virtue of the assignment recorded with the Copyright Office in USA, the Opponent

has become the owner of the copyright in Mark A.

17. Having decided that copyright does subsist in Mark A, the protection of which has not expired, and that the Opponent is the owner of such copyright, the only logical conclusion is that the Opponent is the owner of an earlier right within the meaning of section 12(5)(b) of the Ordinance.

18. I still have to assess whether the use of the suit mark by the Applicant is liable to be prevented by virtue of the law of copyright. Paragraph 14 of the Schedule directs the answer to this question to the provisions in Divisions II and III of Part II of the CO. The main provision is to be found in section 22 of the CO. According to section 22(2) of the CO, copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorizes another to do, any of the acts restricted by copyright. The acts restricted by copyright are set forth in section 22(1) of the CO and for simplicity sake, I will only consider the very first one, namely, the act of copying.

19. Elaboration of what amounts to copying of a copyright work can be found in section 23 of the CO. Section 23 relates to the manner in which copying is done and I do not think there can be any serious doubt that the use of the suit mark by the Applicant will involve one form or another of the copying mentioned in the provision. One question remains to be answered though is whether there will be the commission of a restricted act within the meaning of section 22(3) of the CO. Section 22(3) of the CO stipulates that an act restricted by copyright will only be committed if done in relation to the work as a whole or any substantial part of it. Case law on this point indicates that what amounts to a substantial part of a work is a question of quality as well as quantity³. For this purpose, a comparison of Mark A and the suit mark is called for.

20. A careful examination of the two marks will show that there are indeed some differences between the two marks. The cups in Mark A are white or light-coloured while those in the suit mark appear in a darker hue. There are also the different tones adopted for the background to the word “CENTRAL” and for the background to the word “PERK” in the two marks. In addition, in the case of the curly lines that are depicted above the surface of the cups and which give the viewers the impression that the liquids inside the cups are steaming hot, the one on the far right coming up from the cup on the left and the one on the far left coming up from

³ *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 All ER 465

the cup on the right are slightly obscured from sight in the case of Mark A but those lines are unblocked in the suit mark. There are also two dots in the suit mark, one on either end of the word “PERK”, which are not found in Mark A. These are however very minor details and the main features of Mark A are all found in the suit mark. In particular, I note that there has been no colour claim in the application for the registration of the suit mark and if registered, protection will not be restricted to a particular colour combination or shading. Apart from the differences mentioned above, the suit mark is the spitting image of Mark A. Having taken into consideration all the above matters, I consider that the use of the suit mark will, both in terms of quantity and quality, involve the copying of a substantial part of Mark A. Thus, the use of the suit mark by the Applicant is liable to be prevented by the copyright in Mark A. The opposition under section 12(5)(b) of the Ordinance therefore succeeds.

Section 11(5)(b)

21. Lest I be wrong in my finding in paragraph 12 above, I shall proceed to deal with the ground of opposition under section 11(5)(b) of the Ordinance as well. Section 11(5)(b) is phrased as follows:-

“A trade mark shall not be registered if, or the extent that –

(b) the application for registration of the trade mark is made in bad faith.”

22. There is no definition of the term “bad faith” in the Ordinance. In ***Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd*** [1999] RPC 367, Lindsey J had, at page 379, expressed his views on the meaning of the term, as follows:-

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

23. Also worth noting is what the Appointed Person said in the case of *Ajit Weekly Trade Mark* [2006] RPC 25, at paragraph 44 of the decision –

“The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standards of honest people, the defendant’s own standards of honesty being irrelevant to the determination of the objective element.”

24. In paragraph 12 of the statement of the grounds of opposition filed, the Opponent pleaded that since the application for registration of the suit mark was made with knowledge of the reputation of the Opponent in its trade marks, it was therefore made in bad faith. In response, in paragraph 12 of the counter-statement, the Applicant denied any bad faith on its part and claimed that it had acquired rights to use the suit mark worldwide by virtue of a franchise from Mr. Louis Perdrizat.

25. In paragraphs 40-42 of the Korbin Declaration and in the materials found in Exhibits “JAK-18”, “JAK-19” and “JAK-20”, the Opponent gives the following information about how the Applicant came to realize its concept for the operation of the Central Perk cafés –

- (a) in an undated article about an interview with a Mr. Mojtaba Asadian (in Exhibit “JAK-18”), there is an admission by Mr. Asadian of his awareness of the Central Perk set used in the FRIENDS sitcom and his picking of the name for his own coffee shop when he first found out in September 2005 that it was not registered by the Opponent;
- (b) in the article referred to in (a) above, there is acknowledgement by Mr. Asadian that he made countless enquiries about the Central Perk brand to check its registration status to see where he could obtain it and his recognition that it had been registered by the Opponent in some countries;
- (c) there is a report of the launch of the first Central Perk coffee shop in the Middle East on 2 March 2006 which has been extracted from the website of the Applicant in Exhibit “JAK-18” and which indicates

that Mr. Asadian is the CEO of the Applicant;

- (d) in another article, published on 9 May 2006, with the title “Where Friends hang out” (in both Exhibits “JAK-18” and “JAK-19”), there is the narrative of the promotion of the cafés of the Applicant by the actor that played the manager of the fictional café in the FRIENDS sitcom and he is described as being dressed in a Central Perk T-shirt and cap, when making cappuccino for guests and going up to tables to chat with them, signing autographs and posing for photographs for his fans;
- (e) in the article referred to in (d) above, the reason given for the patronage of the Applicant’s café in Dubai by a group of guests is the association of the café has with the themes of the sitcom.

I take note that the materials referred to above post-date the filing of the application for registration of the suit mark. Nonetheless, they throw light on the intention of the Applicant at the time the subject application was filed. Thus, it is appropriate for me to take into account such matters when considering the issue of bad faith.

26. Although given the chance, in deciding not to file any evidence of its own, the Applicant chooses not to dispute or challenge any of the matters disclosed in the Opponent’s evidence. Particularly worthy of note as well is the absence of any evidence to substantiate the Applicant’s claim that it has acquired the rights over the suit mark through a franchise from a Mr. Louis Perdrizat. With the picture as presented by the Opponent, being the only factors I have before me, I do not think there can be any serious contention that the Applicant did not know about the Opponent’s Marks and its popularity when it decided to use the suit mark for its own purpose. In view of the highly successful worldwide broadcasting of the sitcom FRIENDS, the only conclusion that I can come to is that there has been the deliberate appropriation of the suit mark by the Applicant.

27. The matter does not stop at that. From what is disclosed by the Korbin Declaration, it is clear that the Applicant did not set off merely to pick a name created by someone else. Rather, it had the full intention to have a free ride on the popularity that comes with the name too. For the promotion of its cafés, the Applicant engaged the actor who played the manager of the fictional café in the sitcom FRIENDS, albeit not a very important role, on purpose. The effect of having

him around is as expected and reflected in the feedback from the group of guests interviewed in the article mentioned in paragraph 25(e) above. In addition, by its own admission recorded in the article referred to in paragraph 25(a) and (b) above, the Applicant has only sought registration of the suit mark where the Opponent has failed to register first. With the countries where the Opponent has already secured registration of its marks, there is no claim or suggestion at all that the Applicant itself has a better right in respect of the services applied for.

28. Furthermore, adding to the above factors is the finding, as illustrated in the analysis in paragraphs 11-20 above, that the use of the suit mark by the Applicant will amount to infringement of the copyright in Mark A. Seeking to secure rights over a trade mark through registration where the copyright in it is vested in another party should not be condoned nor does such act meet the standards of acceptable commercial behaviour observed by reasonable and experienced men in the relevant field.

29. Taking into consideration all the relevant circumstances of the case, in particular the knowledge of the Applicant of the popularity of the sitcom FRIENDS, its blatant intention to benefit from it and the copyright protection that the Opponent is entitled to, I find that the conduct of the Applicant falls short of the standards of honest people. The registration of the suit mark is therefore one made in bad faith and hence precluded under section 11(5)(b) of the Ordinance.

Costs

30. As the opposition is successful, I award the Opponent costs. Subject to any representations, as to the amount of costs or calling for special treatment, made by either party within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, unless otherwise agreed.

Caroline Chow
For Registrar of Trade Marks
27 August 2010

Appendix

Extracts from the Copyright Ordinance (Cap. 528)

Section 17

- (1) The following provisions have effect with respect to the duration of copyright in a literary, dramatic, musical or artistic work.
- (2) Copyright expires at the end of the period of 50 years from the end of the calendar year in which the author dies, subject as follows.
- (3) If the work is of unknown authorship, copyright expires-
 - (a) at the end of the period of 50 years from the end of the calendar year in which the work was first made;
or
 - (b) if during that period the work is made available to the public, at the end of the period of 50 years from the end of the calendar year in which it is first so made available,subject as follows.
- (4) Subsection (2) applies if the identity of the author becomes known before the end of the period specified in subsection (3)(a) or (b).
- (5) For the purposes of subsection (3) making available to the public includes-
 - (a) in the case of a literary, dramatic or musical work-
 - (i) performance in public; or
 - (ii) being broadcast or included in a cable programme service;
 - (b) in the case of an artistic work-
 - (i) exhibition in public;
 - (ii) a film including the work being shown in public; or
 - (iii) being included in a broadcast or cable programme service;
 - (c) making available of copies of a work to the public within the meaning of section 26, but in determining generally for the purposes of that subsection whether a work has been made available to the public no account is to be taken of any unauthorized act.
- (6) If the work is computer-generated the above provisions do not apply and copyright expires at the end of the period of 50 years from the end of the calendar year in which the work was made.
- (7) The provisions of this section are adapted as follows in relation to a work of joint authorship-
 - (a) the reference in subsection (2) to the death of the author is to be construed-
 - (i) if the identity of all the authors is known, as a reference to the death of the last of them to die;
and
 - (ii) if the identity of one or more of the authors is known and the identity of one or more others is not, as a reference to the death of the last whose identity is known; and
 - (b) the reference in subsection (4) to the identity of the author becoming known is to be construed as a reference to the identity of any of the authors becoming known.
- (8) This section does not apply to Government copyright or Legislative Council copyright (see sections 182 to 184) or to copyright which subsists by virtue of section 188 (copyright of certain international organizations).

Section 22

- (1) The owner of the copyright in a work has, in accordance with the following provisions of this Division, the exclusive right to do the following acts in Hong Kong-
 - (a) to copy the work (see section 23);
 - (b) to issue copies of the work to the public (see section 24);
 - (c) to rent copies of the work to the public (see section 25); (Replaced 15 of 2007 s. 5)
 - (d) to make available copies of the work to the public (see section 26);
 - (e) to perform, show or play the work in public (see section 27);
 - (f) to broadcast the work or include it in a cable programme service (see section 28);
 - (g) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 29),and those acts are referred to in this Part as the "acts restricted by the copyright".
- (2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorizes another to do, any of the acts restricted by the copyright.

- (3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it-
- (a) in relation to the work as a whole or any substantial part of it; and
 - (b) either directly or indirectly,
- and it is immaterial whether any intervening acts themselves infringe copyright.
- (4) This Division has effect subject to-
- (a) the provisions of Division III (acts permitted in relation to copyright works); and
 - (b) the provisions of Division VIII (provisions with respect to copyright licensing).

Section 23

- (1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies are construed as follows.
- (2) Copying of a work means reproducing the work in any material form. This includes storing the work in any medium by electronic means.
- (3) In relation to an artistic work copying includes the making of a copy in 3 dimensions of a 2-dimensional work and the making of a copy in 2 dimensions of a 3-dimensional work.
- (4) Copying in relation to a film, television broadcast or cable programme includes making a photograph of the whole or any substantial part of any image forming part of the film, broadcast or cable programme.
- (5) Copying in relation to the typographical arrangement of a published edition means making a facsimile copy of the arrangement.
- (6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work.

Section 177

- (1) Copyright subsists in a work if-
- (a) the author satisfies the qualification requirements set out in section 178; or
 - (b) it is published in Hong Kong or elsewhere; or
 - (c) in the case of a broadcast or cable programme, it is made or sent from Hong Kong or elsewhere.
- (2) If the qualification requirements of this Division, or section 182, 184 or 188 (Government copyright, Legislative Council copyright or copyright of certain international organizations) are once satisfied in respect of a work, copyright does not cease to subsist by reason of any subsequent event.

Schedule 2

- 5.(1) Copyright subsists in an existing work after commencement if copyright subsisted in it immediately before commencement.
- (2) Copyright subsists in an existing work after commencement if-
- (a) it would qualify for copyright protection under section 177 or 188 of this Ordinance-
 - (i) had it been made after commencement;
 - (ii) had it been published after commencement; or
 - (iii) in the case of a broadcast or cable programme, had it been made or sent after commencement; and
 - (b) copyright under the 1956 Act in the work would not have expired had copyright subsisted in it under that Act.
- (3) Copyright in an existing work qualifying for copyright protection under subparagraph (2) expires at the time when copyright in the work would expire under the following provisions had copyright subsisted in it immediately before commencement.

9. The question who was the author of an existing work is to be determined in accordance with the new copyright provisions for the purposes of the rights conferred by Division IV of Part II (moral rights), and for all other purposes is to be determined in accordance with the law in force at the time the work was made.

13. (1) The following provisions have effect with respect to the duration of copyright in existing works.

The question which provision applies to a work is to be determined by reference to the facts immediately before commencement; and expressions used in this paragraph which were defined for the purposes of the 1956 Act have the same meaning as in that Act.

- (2) Copyright in the following descriptions of work continues to subsist until the date on which it

would have expired under the 1956 Act-

- (a) literary, dramatic or musical works in relation to which the period of 50 years mentioned in the proviso to section 2(3) of the 1956 Act (duration of copyright in works made available to the public after the death of the author) has begun to run;
 - (b) engravings in relation to which the period of 50 years mentioned in paragraph (a) of the proviso to section 3(4) of the 1956 Act (duration of copyright in works published after the death of the author) has begun to run;
 - (c) published photographs and photographs taken before 12 December 1972;
 - (d) published sound recordings and sound recordings made before 12 December 1972;
 - (e) published films.
- (3) Copyright in anonymous or pseudonymous literary, dramatic, musical or artistic works (other than photographs) or films continues to subsist-
- (a) if the work is published, until the date on which it would have expired in accordance with the 1956 Act; and
 - (b) if the work is unpublished, until the end of the period of 50 years from the end of the calendar year in which the new copyright provisions come into force or, if during that period the work is first made available to the public within the meaning of section 17(5) or 19(6) of this Ordinance (duration of copyright in works of unknown authorship), the date on which copyright expires in accordance with that provision,
- unless, in any case, the identity of the author becomes known before that date, in which case section 17(2) or 19(2) of this Ordinance applies (general rule: life of the author plus 50 years).
- (4) Copyright in the following descriptions of work continues to subsist until the end of the period of 50 years from the end of the calendar year in which the new copyright provisions come into force-
- (a) literary, dramatic and musical works of which the author has died and in relation to which none of the acts mentioned in paragraphs (a) to (e) of the proviso to section 2(3) of the 1956 Act has been done;
 - (b) unpublished engravings of which the author has died;
 - (c) unpublished photographs taken on or after 12 December 1972;
 - (d) unpublished films of which the person by whom the arrangements necessary for the making of the film were undertaken has died.
- (5) Copyright in an unpublished sound recordings made on or after 12 December 1972 continues to subsist until the end of the period of 50 years from the end of the calendar year in which the new copyright provisions come into force unless the recording is published before the end of that period in which case copyright in it continues until the end of the period of 50 years from the end of the calendar year in which the recording is published.
- (6) Copyright in any other description of existing work continues to subsist until the date on which copyright in that description of work expires in accordance with sections 17 to 21 of this Ordinance.
- (7) The above provisions do not apply to works subject to Government or Legislative Council copyright (see paragraphs 32 to 34 below).

14. (1) The provisions of Divisions II and III of Part II as to the acts constituting an infringement of copyright apply only in relation to acts done after commencement; the provisions of the 1956 Act and the Copyright Ordinance continue to apply in relation to acts done before commencement.

(2) Section 25 of this Ordinance does not apply in relation to a copy of a sound recording or computer program acquired by any person before 10 May 1996 for the purpose of renting it to the public.

(3) Where any person has before 1 January 1995 incurred any significant expenditure or liability in connection with the rental of any copy of a work or subject-matter in a manner that at the time was lawful, or for the purpose of or with a view to such a rental at a time when it would have been lawful but for the commencement of section 10 of the WTO Ordinance, nothing in that Ordinance shall diminish or prejudice any right or interest arising from or in connection with such action that is subsisting and valuable immediately before the commencement of that section if that person pays to the person who by virtue of the commencement of that section becomes entitled to restrain the rental such equitable remuneration as the parties agree, or failing such agreement, as the Copyright Tribunal may determine.

(4) For the purposes of section 35 of this Ordinance (meaning of "infringing copy") the question whether the making of an article constituted an infringement of copyright, or would have done if the article had been made in Hong Kong, is to be determined-

- (a) in relation to an article made on or after 10 May 1996 and before commencement, by reference to the 1956 Act as amended by the WTO Ordinance;

- (b) in relation to an article made on or after 12 December 1972 and before 10 May 1996, by reference to the 1956 Act immediately before it was amended by the WTO Ordinance; and
 - (c) in relation to an article made before 12 December 1972, by reference to the 1911 Act.
- (5) For the purposes of section 35 of the Ordinance (meaning of "infringing copy"), if an article has been imported before commencement without infringing copyright under the law existing at the time of importation, the terms of any exclusive licence agreement relating to that article are to be disregarded and, for the avoidance of doubt, any possession or dealing in the article which takes place after commencement shall not infringe copyright within the terms of sections 31 and 118 to 133 of the Ordinance.
- (6) For the purposes of the application of sections 40(2) and 71(3) of this Ordinance (subsequent exploitation of things whose making was, by virtue of an earlier provision of the section, not an infringement of copyright) to things made before commencement, it is to be assumed that the new copyright provisions were in force at all material times.
- (7) Section 63 of this Ordinance (articles for producing material in a particular typeface) applies where articles have been marketed as mentioned in subsection (1) of that section before commencement with the substitution for the period mentioned in subsection (2) of that section of the period of 25 years from the end of the calendar year in which the new copyright provisions come into force.
- (8) Section 64 of this Ordinance (transfer of copies, adaptations, &c. of work in electronic form) does not apply in relation to a copy purchased before commencement.
- (9) In section 74 of this Ordinance (reconstruction of buildings) the reference to the owner of the copyright in the drawings or plans is, in relation to buildings constructed before commencement, to the person who at the time of the construction was the owner of the copyright in the drawings or plans under the 1956 Act or the 1911 Act.

Extracts from the UK Copyright Act 1956

Section 3

- (1) In this Act "artistic work" means a work of any of the following descriptions, that is to say,—
- (a) the following, irrespective of artistic quality, namely paintings, sculptures, drawings, engravings and photographs;
 - (b) works of architecture, being either buildings or models for buildings;
 - (c) works of artistic craftsmanship, not falling within either of the preceding paragraphs.
- (2) Copyright shall subsist, subject to the provisions of this Act, in every original artistic work which is unpublished, and of which the author was a qualified person at the time when the work was made, or, if the making of the work extended over a period, was a qualified person for a substantial part of that period.
- (3) Where an original artistic work has been published, then, subject to the provisions of this Act, copyright shall subsist in the work (or, if copyright in the work subsisted immediately before its first publication, shall continue to subsist) if, but only if, —
- (a) the first publication of the work took place in the United Kingdom, or in another country to which this section extends, or
 - (b) the author of the work was a qualified person at the time when the work was first published, or
 - (c) the author had died before that time, but was a qualified person immediately before his death.
- (4) Subject to the last preceding subsection, copyright subsisting in a work by virtue of this section shall continue to subsist until the end of the period of fifty years from the end of the calendar year in which the author died, and shall then expire:
- Provided that—
- (a) in the case of an engraving, if before the death of the author the engraving had not been published, the copyright shall continue to subsist until the end of the period of fifty years from the end of the calendar year in which it is first published;
 - (b) the copyright in a photograph shall continue to subsist until the end of the period of fifty years from the end of the calendar year in which the photograph is first published, and shall then expire.
- (5) The acts restricted by the copyright in an artistic work are—
- (a) reproducing the work in any material form;
 - (b) publishing the work;
 - (c) including the work in a television broadcast;

(d) including the work in a cable programme.

Section 4

(1) Subject to the provisions of this section, the author of a work shall be entitled to any copyright subsisting in the work by virtue of this Part of this Act.

(2) Where a literary, dramatic or artistic work is made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, and is so made for the purpose of publication in a newspaper, magazine or similar periodical, the said proprietor shall be entitled to the copyright in the work in so far as the copyright relates to publication of the work in any newspaper, magazine or similar periodical, or to reproduction of the work for the purpose of its being so published; but in all other respects the author shall be entitled to any copyright subsisting in the work by virtue of this Part of this Act.

(3) Subject to the last preceding subsection, where a person commissions the taking of a photograph, or the painting or drawing of a portrait, or the making of an engraving, and pays or agrees to pay for it in money or money's worth, and the work is made in pursuance of that commission, the person who so commissioned the work shall be entitled to any copyright subsisting therein by virtue of this Part of this Act.

(4) Where, in a case not falling within either of the two last preceding subsections, a work is made in the course of the author's employment by another person under a contract of service or apprenticeship, that other person shall be entitled to any copyright subsisting in the work by virtue of this Part of this Act.

(5) Each of the three last preceding subsections shall have effect subject, in any particular case, to any agreement excluding the operation thereof in that case.

(6) The preceding provisions of this section shall all have effect subject to the provisions of Part VI of this Act.