UPDATE ON THE PROPOSED APPLICATION OF
THE PROTOCOL RELATING TO
THE MADRID AGREEMENT CONCERNING
THE INTERNATIONAL REGISTRATION OF MARKS
TO HONG KONG SAR

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Commerce and Economic Development Bureau
Intellectual Property Department
THE MADRID SYSTEM

• An international arrangement to facilitate the registration and management of trade marks in multiple jurisdictions, administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO)

• Governed by
  • the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement)*
  • the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol)

• Currently have 98 contracting parties

* As Algeria acceded to the Madrid Protocol in October 2015, all members to the Madrid Agreement have acceded to the Madrid Protocol. Accession to the Madrid Agreement has been suspended, effectively making the Madrid System a one-treaty system.
INTERNATIONAL APPLICATION/REGISTRATION

• Application filed by a natural person or a legal entity that has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a Madrid Protocol contracting party

• Application via the trade mark office where the basic registration/application is held (Office of origin)

• Simply file a single international application, pay one set of fees, and designate one or more contracting parties

• Manage post-registration matters of trade mark portfolio (e.g. renewal, recording of licenses and assignments) in different designated contracting parties through a single procedure with the IB and the payment of one fee
THE CONSULTATION ON THE PROPOSED APPLICATION OF THE MADRID PROTOCOL TO HONG KONG SAR (THE CONSULTATION)

• Government conducted a three-month consultation (November 2014 to February 2015) to invite views on:

  • the benefits and implications, practical arrangement, steps for implementation, and tentative timing of the proposed application of the Madrid Protocol to Hong Kong SAR (Hong Kong)

  • the need for and desirable features of a possible special arrangement between the Mainland and Hong Kong to facilitate the reciprocal filing of trade mark applications
RESPONSES TO THE CONSULTATION

• 21 written submissions mainly from trade associations, chambers of commerce and professional bodies

• Majority of the respondents support the application of the Madrid Protocol to Hong Kong

• Many respondents support the further exploration of a possible reciprocal trade mark filing arrangement between the Mainland and Hong Kong
SINCE THE CONSULTATION

• The Working Group on IP Trading recommended (March 2015) pursuing the proposed application of the Madrid Protocol to Hong Kong
• Outcome of the Consultation reported to the LegCo Panel on Commerce and Industry in May 2015
• Conducted studies on the Madrid Protocol and practices
• Discussions with the Central People’s Government (CPG) and WIPO on the possible arrangements to implement the Madrid Protocol should it be applied to Hong Kong
• The Government now proposes to adopt the international registration system under the Madrid Protocol in Hong Kong
FEATURES OF THE PROPOSED IMPLEMENTATION ARRANGEMENTS

• Hong Kong Trade Marks Registry
  • act as an Office of origin and a designated office
  • submit international applications to the IB directly after certification
  • receive from the IB and process incoming requests for territorial extension of protection directly

• A request made to an office outside China for territorial extension of protection which designates only the Mainland will not automatically apply to Hong Kong, and vice versa. An applicant has to designate both if he wants to be protected in both places

• As the Madrid System only deals with international trade mark registrations and management, for an application made in Hong Kong, the applicant cannot designate the Mainland (the reverse also holds true)
FEATURES OF THE PROPOSED IMPLEMENTATION ARRANGEMENTS

• Matters concerning the Madrid Protocol at the treaty level fall within the purview of CPG

• Direct communication between the Trade Marks Registry and the IB on operational and technical matters
ENTITLEMENT TO FILE INTERNATIONAL APPLICATIONS IN HONG KONG

• An international application based on a basic registration/application with the Hong Kong Trade Marks Registry can be filed via the Registry (acting as an Office of origin) if the applicant is:

  • a Chinese national (wherever his/her place of residence);
  • domiciled in Hong Kong; or
  • a natural person or a legal entity that has a real and effective industrial or commercial establishment in Hong Kong
FILING OF INTERNATIONAL APPLICATIONS BY CHINESE NATIONALS

- A Chinese national with a basic registration/application with the Hong Kong Trade Marks Registry is entitled to file international application via the Registry acting as an Office of origin.

- A Chinese national with a basic registration/application with the Trade Mark Office of the State Administration for Industry & Commerce (CTMO) of the Mainland is entitled to file international application via CTMO acting as an Office of origin.
SOME PRELIMINARY INCLINATIONS ON IMPLEMENTATION

• To file a declaration for extending the time limit for notifying the IB of provisional refusal of international registration from 12 months to 18 months from the date the IB notifies the Registry of the request for territorial extension of protection

• The Registry to prescribe its own individual fees (the fees will not be higher than the fees for domestic trade mark application or renewal (taking into account savings resulting from the international procedure))

• The Registry will not collect fees for and on behalf of the IB

• International applications be made in English

• English as the language of communication between the Registry and the IB
TENTATIVE TIMETABLE

• 2017-2018
  • Consult the LegCo Panel on Commerce and Industry
  • Legislative work
  • Formulation of workflow
  • Planning on dedicated IT system, fees setting etc.

• 2018-2019
  • Procurement and design of a dedicated IT system
  • Manpower planning and training. Preparing guidance notes and manuals etc.
  • Preparing declarations to be made by CPG on behalf of Hong Kong upon application of the Madrid Protocol
TENTATIVE TIMETABLE

• 2019-2020
  • Application of the Madrid Protocol to Hong Kong by CPG in 2019 at the earliest
POSSIBLE TRADE MARK FILING ARRANGEMENT BETWEEN THE MAINLAND AND HONG KONG

• During the consultation, a number of respondents noted that the trade mark laws and practices of the Mainland and Hong Kong are very different and certain technical complexities would need to be overcome.

• The Government also needs to study the impact of any feasible arrangement from the administrative and financial angle. At this stage, the Government will focus on the proposal to implement the Madrid Protocol in Hong Kong.
Thank you