

Hong Kong Prepares to Implement the Madrid Protocol and Makes Other Changes: Trade Marks (Amendment) Ordinance 2020

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On June 19, 2020, the Trade Marks (Amendment) Ordinance was published in the Gazette of the Hong Kong Special Administrative Region Government, providing a basis for the application of the Madrid Protocol, consolidating the criminal enforcement powers, and making some other technical

amendments to the Trade Marks Ordinance (Cap. 559, *Laws of Hong Kong*).

Getting ready for the implementation of the Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, known as the “Madrid Protocol”, currently has 106 contracting parties including the U.S., China and many other countries and jurisdictions. It provides a cost-effective

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and convenient solution for trademark owners by allowing them to apply to the International Bureau of the World Intellectual Property Organization (WIPO) through one single office for registration of trademarks, and seek to extend the protection of trademark registrations in multiple jurisdictions by a one-stop application process through such registrations.

Currently, Hong Kong entities would need to apply to the individual jurisdictions for registration of their trademarks. Likewise, foreign trademark owners would need to file local trademark applications with the Trade Marks Registry in Hong Kong if they would like to have registered trademark protection in Hong Kong.

The Trade Marks Ordinance has now been amended with a new Part XA that deals with international registration under the Madrid Protocol in Hong Kong. The Madrid Protocol has yet to be applied to Hong Kong. The Hong Kong government is now preparing subsidiary legislation to provide for the relevant procedural details, setting up a dedicated information technology system and drawing up detailed workflows for processing various cases under the international registration system.

The relevant sections of the Trade Marks Ordinance for the implementation of the Madrid Protocol will come into force on a day to be appointed by the Secretary for Commerce and Economic Development by notice published in the Gazette after completing the relevant preparatory work, which is expected to happen in 2022-2023 the earliest.

Consolidating the criminal enforcement powers to the Customs and Excise Department

The Customs and Excise Department in Hong Kong has been responsible for enforcing the criminal provisions relating to the infringement of trademarks registered in Hong Kong under the Trade Descriptions Ordinance (Cap. 362, *Laws of Hong Kong*), whereas the Hong Kong Police has been responsible for the enforcement of offences such as “falsification of the register”, “falsely representing that a trademark as registered” and “misuse of title of ‘Trade Marks Registry’” under the Trade Marks Ordinance.

The Trade Marks Ordinance has now been amended to consolidate the criminal enforcement powers by authorizing the Customs and Excise Department to enforce the criminal provisions of the Trade Marks Ordinance.

Other technical amendments

With the National Anthem Ordinance (Instrument A405) that came into effect on June 12, 2020, the “Absolute grounds for refusal” chapter of the Trade Marks Registry Work Manual in Hong Kong has been updated to provide a new absolute ground for refusal of registration concerning use of the national anthem (or its lyrics or score) in applied-for trademarks, which is now prohibited. The Trade Marks Ordinance has also made corresponding changes to reflect this new absolute ground.

Further, under the amended Trade Marks Ordinance, an applicant is now required to

provide its “place of incorporation” and “state of incorporation” (the latter for US corporations only) when filing a trademark application or recording a registrable transaction relating to a trademark application or registration (such as a trademark license or assignment) in Hong Kong. However, the Trade Marks Registry will not verify the information provided by the applicant in that respect.

As a result of all of these amendments, the Hong Kong Trade Marks Registry also amended the trade mark forms effective from June 19, 2020 with a 6-month transitional period for using the existing forms and the revised forms until December 19, 2020.

Hong Kong has been dedicated to improving its IP protection mechanism and to promoting itself as a premier IP trading hub in the region. The recent amendment to the Trade Marks Ordinance that provides the framework for the implementation of the Madrid Protocol is a welcome development. It also further equips Hong Kong to serve as an ideal place for commercial activities and IP trading.