

## Differences between Hong Kong, Chinese and British TM law

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### Introduction

We have reviewed the trade mark laws in these jurisdictions in order to determine their differences. We have also looked at areas of law that are closely linked to trade mark law and practice, for instance, company registration and food and drugs regulation.

### IP Offices

#### **Are trade mark applications filed online, or are they filed manually?**

**Hong Kong** - Both online and manual applications are acceptable.

**China** – Whilst paper filings are common; however, electronic filings are on the increase.

**Britain** - Online and manual applications are permitted by the IPO.

#### **Is there a Part A/Part B dichotomy in your trade mark legislation?**

**Hong Kong** - The current trade mark law has abolished the differences between PART A and PART B registrations.

**China** - Disclaimed parts can apply for the registration of a trademark. It appears the dichotomy still exists in China.

**Britain** - There is no such division in Britain.

#### **How are certificates of registration signed?**

**Hong Kong** - The signature of the Registrar is printed electronically on the certificates of registration without signature by hand.

**China** - The Commissioner of the CTMO signs the certificate, with an Office Seal.

**Britain** - The Registrar of trade marks signs all registration certificates electronically.

## Is there a close relationship between the trade mark office and company registry?

**Hong Kong** – There is no close working relationship between company registry and trade mark office.

**China** - They are governed by different administrative departments, i.e., local-level Administrations of Industry and Commerce (AIC) for company registration and Beijing-based China Trademark Office (CTMO) for trademark registration.

**Britain** - Both the IPO (UK trade mark office) and Companies House (the UK company registry) are administered by the Government Department for Business, Innovation & Skills. There is a natural overlap between the two departments especially in relation to trade marks and ensuring that company names are not registered contrary to registered trade marks.

## Does your trade mark office operate as a tribunal of first instance?

**Hong Kong** - The trade mark office in Hong Kong, i.e. Hong Kong Intellectual Property Office, serves as a tribunal of first instance in trade mark matters except for trade mark infringements. Appeal against any decision or order of the Registrar made under the Trade Marks Ordinance is possible and such an appeal should be made to the High Court.

**China** - The first-instance trademark dispute goes to the district courts (basic-level). The appeal from the Office goes to the Trademark Review and Adjudication Board (TRAB). The appeal from TRAB goes to Beijing No.1 Intermediate People's Court.

**Britain** - The IPO can serve as a tribunal of first instance in trade mark disputes although parties can choose to go to courts directly. An appeal from the IPO can go either to the High Court or the Intellectual Property Enterprise Court (IPEC) depending on factors such as the value and complexity of the claim.

## Are unconventional/non-traditional trade marks registrable?

**Hong Kong** – Sound and smell trade mark applications are accepted in Hong Kong. Holograms and movement marks are registrable in Hong Kong. A movement mark or a hologram has to be a sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings, and also capable of being represented graphically.

**China** - The sound mark is registrable in addition to its graphical representation. Smells, however, are not registrable in China.

**Britain** - Unconventional/non-traditional trade marks are in principle capable of registration in the UK so long as they comply with the registration requirements set out in the UK Trade Marks Act 1994. Colours, smells, sounds and holograms, for example, can all benefit from trade mark protection if they can be clearly graphically represented and that representation distinguishes the good or service from those of another company. So far no smell has overcome this hurdle successfully but other non-traditional trade marks have been successfully registered.

Moving images can be registered as trade marks provided that they can be represented graphically. This is achieved by filing a series of pictures which shows movement when viewed in quick succession. There is specific IPO guidance on this point. In addition to the filing of the successive images, the filing must include:

- that the mark is a moving image;
- what the image depicts, that is, what the change in appearance is;
- how many images are involved in the complete sequence of movement;
- what the sequential order is of the images; and
- that there is a single sequence of movement (not variable).

### **Are slogans and 3-D marks registrable?**

**Hong Kong** - Slogans and 3-D marks are registrable in Hong Kong.

**China** - 3-D marks are protected in China, whilst slogans are not.

**Britain** - Both are allowed, provided they satisfy the criteria for registration.

### **Are geographical indications of origin protected?**

**Hong Kong** - A mark consisting of nothing more than a designation of geographical origin must be refused registration.

**China** – China provides protection for geographical indications of origin.

**Britain** - The UK provides protection for geographical indications of origin. In addition, the European Community protected geographical indicators are enforceable in the UK.

### **How are opposition proceedings conducted?**

**Hong Kong** - Opponent can oppose within 3 months of publication, and can be extended for 2 months. As regards the 3-month deadline for filing an opposition to registration, it is 3 months **minus 1 day** from publication of application to be exact. Please refer to the following example as a better illustration:

<u>Publication Date</u>	<u>Deadline</u>
25 March 2014	24 June 2014

**China** – The time limit for filing a request for opposing a mark is within 3 months of the CTMO publication. No extension is available for opposition proceedings.

**Britain** - The normal time limit to file an opposition in relation to a trade mark application is two months. This initial two-month period is extendable by one month. This period begins on the date the trade mark was advertised in the IPO on-line journal.

### **How are cancellation proceedings conducted?**

**Hong Kong** - A trade mark out of use for a continuous period of at least three years will be subject to revocation unless there are valid reasons for non-use.

**China** - Three years of non-use renders the mark liable to cancellation.

**Britain** - After 5 years of non-use and in the event there are no proper reasons for non-use, then a trade mark is liable for revocation (removal from the register).

### **Will a trade mark applicant be notified prior to removal of his trade mark?**

**Hong Kong** – Registrar will notify the applicant to the extent that the address of service on record is accurate in respect of the trade mark applicant.

**China** - Office communications will be issued to the recorded trademark agent.

**Britain** - The IPO will inform the trade mark proprietor in the event that a successful revocation action is brought.

## **IP Courts**

### **Are there specialist courts for IP matters?**

**Hong Kong** - There is no court that possesses exclusive jurisdiction over registered trade mark and other intellectual property matters. In other words, various courts in Hong Kong possess various jurisdictions over trade mark and IP matters.

**China** - The district courts in cities and counties where the defendant resides or infringement occurs determines the court with jurisdiction over the matter.

**Britain** - The complexity of the IP dispute will be the key consideration in determining which court has jurisdiction to hear the dispute. Broadly speaking, the IPEC and the High Court hear IP related disputes. IPEC deals with the less complex and valuable cases in monetary terms. The Chancery Division in the High Court deals with the higher value and more complex claims. In large part the parties can choose to be heard at the High Court even if the IPEC may be a more appropriate forum.

### **Are there customs records for trade marks?**

**Hong Kong** – There are no customs records for trade marks in Hong Kong.

**China** - The customs recordation services are intended for potential border infringement.

**Britain** – It is possible to notify Customs and Excise about registered trademarks and concerns about infringing/counterfeit goods being imported but there is no public register.

### **Are there criminal law proceedings/penalties for counterfeit matters?**

**Hong Kong** – There are criminal law proceedings/penalties for counterfeit cases in Hong Kong.

**China** – There are criminal law proceedings/penalties for counterfeit cases in China. The punitive compensation can be one to three times the amount of damages in case of bad-faith infringement, which is of a severe nature. The upper limit for statutory compensation soars from RMB500,000 (US\$80710.50) to RMB3,000,000 (US\$ 481426.00).<sup>1</sup>

**Britain** – Britain has a number of criminal law provisions which cover counterfeit cases. The penalties depend on a number of factors such as the particular offence committed and the scale of counterfeiting. The penalties for counterfeiting include fines and possibly custodial sentences depending on the seriousness of the offence.

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<sup>1</sup> Exchange rate as at 19 March 2014.

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