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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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INFORMATION FROM MEMBERS ON ANY SYSTEMS FOR THE REGISTRATION OF GEOGRAPHICAL INDICATIONS WHICH THEY OPERATE

Communication from Hong Kong, China

Addendum

At its meeting of 27 February 1997, the Council for TRIPS agreed to initiate preliminary work on issues relevant to the negotiations specified in Article 23.4 of the TRIPS Agreement through an information-gathering activity. In this connection, the Council invited Members to submit information on any systems for the registration of geographical indications which they operate. Reference is made to paragraph 73 of document IP/C/M/12.

The present document reproduces the information received from Hong Kong, China, by a communication from the Hong Kong Economic and Trade Office dated 16 September 1997.

Protection of Geographical Indications in Hong Kong, China

This submission is to contribute to the information-gathering exercise as earlier agreed by the Council. The submission shall in no way prejudice and should not be interpreted as the position of Hong Kong, China on the matter of protection of geographical indications.

1. General

(i) The present law on trademarks in Hong Kong, China is governed by the Trade Marks Ordinance (Cap.43) ("TMO") as amended by the Intellectual Property (World Trade Organization Amendments) Ordinance ("WTO Ord"). At present, it is possible to protect a geographical indication by way of a certification trademark in Hong Kong. Sections 64-72 of the TMO contain provisions relating to certification trademarks. A certification trademark as regards goods is registered in Part A of the Trade Marks Register in Hong Kong, China, and is defined as a mark which distinguishes in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified. Pursuant to Section 23 of the WTO Ord, an amendment was made to the TMO so that the fact that a mark consists of signs or indications which may serve, in trade, to designate the geographical origin of goods shall not be precluded from being registered as a certification trademark in Part A of the register in respect of those goods.

- (ii) Under the Trade Descriptions Ordinance (Cap.362), any person who:
- (a) in the course of any trade or business, applies a false trade description to any goods; or supplies or offers to supply any goods to which a false trade description is applied; or
 - (b) possesses for sale or for trade or manufacture, any goods to which a false trade description is applied,

is liable:

- on conviction on indictment, to a fine of HK\$500,000 and to imprisonment for 5 years; and
- on summary conviction, to a fine of HK\$100,000 and to imprisonment for 2 years.

It is also an offence to forge a trademark and to falsely apply to any goods any trademark or any mark so nearly resembling a trademark as to be calculated to deceive.

The TRIPS Agreement

2. Article 22.1 - definition "indications which identify a good as originating in the territory of a member, or region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin".

- Section 2(1) of the TMO defines a trademark as "any sign that is visually perceptible and capable of being represented graphically and may, in particular, consist of words, personal names, letters, numerals, figurative elements or combination of colours, and includes any combination of such signs".
- This definition is broad enough to include geographical indications.

3. Article 22.2 - Rights conferred by protection

- The owner of a certification trademark in respect of goods has the rights accorded to it under Section 67 of the TMO, and may bring an infringement action. Section 67 provides that the owner of the certification mark has the exclusive right to use the trademark in relation to the goods and that right is deemed infringed by any person who, not being proprietor of the trademark or a person authorized by him under the regulations in that behalf, uses a mark identical with it or nearly resembling it.
- The owner of a geographical indication may resort to the law of passing off under the common law to protect his geographical indication (see paragraph 6 below).
- There may be an offence committed under the Trade Descriptions Ordinance (see paragraph 1(ii) above).

4. Article 22.3 - Refusal or invalidation of trademarks consisting of geographical indications

- The certification trademark, which can currently be used to a geographical indication, is a trademark under the TMO. The registration of a certification trademark may be refused if it is in breach of S.12(1) of the TMO. S.12(1) provides that it shall not be lawful to register as a trademark or part of a trademark any matter the use of which would be likely to deceive or would be disentitled to protection in the court of justice or would be contrary to law or morality or any scandalous design.
- An attempt to register a certification trademark would also fail if it conflicts with other certification trademarks already registered on the register (S.20 of the TMO). S.20 prohibits the registration of a mark that is identical with or nearly resembles a trademark belonging to a different proprietor and already registered.
- Under S.68 of the TMO, the entry of a certification trademark may be varied or expunged by the Registrar of Trade Marks or the court if it can be shown, *inter alia*, that the proprietor is no longer competent to certify the goods, or it is no longer to the public advantage that the trademark should be registered.

5. Article 22.4 - Protection against misleading the public

- S.12 of the TMO provides that it is not lawful to register a mark that would be likely to deceive (see paragraph 4 above). There is also the possibility of a prosecution under the Trade Descriptions Ordinance (see paragraph 1(ii) above).

6. Article 23.1 - Use of geographical indications of wines not originating in the place indicated, even where ...

- A person who feels aggrieved may obtain protection under the common law under the law of passing off.
- There might be an offence committed under the Trade Descriptions Ordinance (see paragraph 1(ii) above).

7. Article 23(2) - Refusal or invalidating of trademarks

- See paragraph 4 above.

8. Article 23(3) - Homonymous GIs

- A trademark which closely resembles another trademark may be registered if it complies with Section 22 of the TMO. Section 22 enables identical or nearly resembling marks to be registered in the case of honest concurrent use.