



Wilkinson & Grist
Solicitors & Notaries



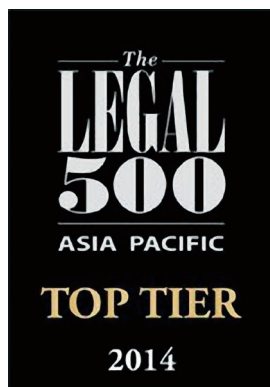
Reflecting on the past year, Hong Kong has made leaps and bounds on the legal front with significant amendments to the Trade Descriptions, Trustee and Residential Properties Ordinances. On the IP side, the report on the Review of the Hong Kong Patent System was announced as efforts continued by the HKSAR Government in developing Hong Kong into a premier IP trading hub. In 2014, we look forward to the New Hong Kong Companies Ordinance which will come into effect on 3 March 2014 and the long awaited and much welcomed changes to the China Trademark Law in May 2014.

As we prepare for the imminent arrival of the Year of the Horse, we wish for world peace, good health and happiness to all.

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NEW HONOURS



For consecutive years, we have been recognized as a **Top-Tier Firm** for **Intellectual Property** in Hong Kong in The Client's Guide to the Asia Pacific Legal Profession by The Legal 500.

"Anne Choi leads Wilkinson & Grist's intellectual property practice, which handles portfolio management for multinational clients, as well as providing patent and domain name registration and enforcement advice."

We have also been **Recommended** in other practice areas, namely **Corporate (including M&A), Dispute Resolution and Restructuring and Insolvency** in Hong Kong and **TMT-foreign firm** in China.

"Leading Hong Kong firm Wilkinson & Grist is active in the local and PRC markets with Raymond Chan to the fore."

"At Wilkinson & Grist, Keith Ho and John Budge are two prominent Hong Kong litigators. Ho has continued to represent Chinachem Charitable Foundation in relation to the long running and headline Nina Wang case."

"Wilkinson & Grist handles corporate restructuring, insolvency litigation and bankruptcy matters. Recommended practitioners include Lawrence Chan and Keith Ho, who is currently chairman of the Insolvency Law Committee of the Hong Kong Law Society."

Asia IP 2013 Trademark Survey

We are pleased to have been ranked again as a **Tier 1 Law Firm** for Hong Kong in both **Trademark Prosecution** and **Trademark Contentious** work in 2013 Asia IP Trademark Survey, A Guide to Asia's Trademark Laws published in Asia IP August 2013, a publication by Apex Asia that provides in depth coverage on IP written for in-house Counsel and private practice lawyers.

asialaw PROFILES

THE GUIDE TO

Asia-Pacific's Leading Domestic Law Firms 2014

It is an honour to be named again as a **Highly Recommended Firm** in Hong Kong for **Construction and Real Estate, Dispute Resolution and Intellectual Property** practices in this 2014 Guide.

Congratulations

We are proud of the recognition given to our partners and congratulate them on their achievements.



Anne Choi



Yvonne Chua

Anne Choi and **Yvonne Chua**, partners, Intellectual Property Practice Group, have been named as Leading Individuals in Intellectual Property Practice in Hong Kong in The Client's Guide to the Asia Pacific Legal Profession 2014, a guide to commercial law firms in Asia Pacific.



John Budge



Keith Ho



Raymond Chan



Lawrence Chan

John Budge and **Keith Ho**, partners, Dispute Resolution Practice Group, **Raymond Chan**, managing partner and Head of Corporate Practice Group, and **Lawrence Chan**, partner, Restructuring and Insolvency Practice Group, are all recommended in their respective areas of practice in Hong Kong.



Anne Choi



Yvonne Chua



Andrea Fong



Keith Ho

Anne Choi, **Yvonne Chua** and **Andrea Fong** have again been voted as leading lawyers in Hong Kong in Intellectual Property practice in Asialaw Leading Lawyers 2013. **Keith Ho** has also received the same honour in Dispute Resolution practice. The nominations are based on extensive consultation with the market and research that involves a combination of sources including interviews with law firms and clients.

Appointments

Through strong participation in major national and international bodies, our lawyers contribute to the community.

Steering
Committee on
Mediation

John Budge, partner, Litigation and Dispute Resolution Group, has been re-appointed by the Secretary for Justice as a member of the Steering Committee on Mediation and its Accreditation Sub-committee for another 12 months from 27 November 2013. The Steering Committee was set up by the Department of Justice as part of its continuing efforts to promote the wider use of mediation to resolve disputes in Hong Kong.

Hong Kong
International
Arbitration Centre

John was also recently elected as the Vice Chairman of the Hong Kong International Arbitration Centre ("HKIAC"). HKIAC is the foremost venue for alternative dispute resolution in Asia and the preferred seat for complex disputes involving parties from across the globe, including the United States and China. In addition to the promotion of arbitration of international commercial disputes, HKIAC is working with the Hong Kong SAR Government with regard to promoting the development of Hong Kong as an IP trading hub and for the use of arbitration and mediation in the event of a dispute between the parties.

Appeal Board
Panel (Town
Planning)

Lawrence Chan, partner, Litigation and Dispute Resolution Practice Group, has been re-appointed by the HKSAR Government as a Member of the Appeal Board Panel (Town Planning) for a term of two years as from 19 December 2013. The Panel is an independent statutory body established under the Town Planning Ordinance (Cap 131) to review decisions of the Town Planning Board upon applications of the persons aggrieved by the decisions.

BIP Asia 2013

Yvonne Chua, partner, Intellectual Property Practice Group, also President of Licensing Executives Society International 2013-4, has been invited by the Hong Kong Trade Development Council ("HKTDC") to be an honorary advisor for the third Business of IP Asia Forum (BIP Asia) 2013. The event is jointly organized by the HKTDC, the Hong Kong Design Centre with the support from the Intellectual Property Department ("IPD") of the HKSAR Government and aims to promote Hong Kong as the regional IP marketplace.

HK Institute of Trade
Mark Practitioners

Andrea Fong, partner, Intellectual Property Practice Group, has been re-elected as Council Member of the Hong Kong Institute of Trade Mark Practitioners.

International
Trademark
Association

Andrea has also been re-appointed as a member of the Asia-Pacific Trademark Office Relations Subcommittee of the Trademark Office Practices Committee for the 2014-2015 committee term at INTA.

Against Child
Abuse Ltd.

Paul Liu, partner, Litigation and Dispute Resolution Group, has been invited to serve as the Honorary Legal Advisor for the Against Child Abuse Ltd., a non-governmental organization established since 1979 that focuses on child protection with the mission of promoting a caring and non-violent environment for the optimal growth of children.

New Faces

We warmly welcome the following newcomers to our firm.

Stan Cheung joined our firm as a trainee solicitor in August 2011. After completing his two years traineeship, he was admitted as a solicitor in Hong Kong in October 2013 and joined our Litigation and Dispute Resolution Practice Group. He obtained his Bachelor of Laws degree and PCLL from The Chinese University of Hong Kong. Stan now advises our clients on various types of civil and commercial disputes.



David Kwok joined our Litigation and Dispute Resolution Practice Group as an associate in April 2013. Prior to joining us, he spent over three years in a specialist insolvency and restructuring firm in Hong Kong and was involved in various insolvency, restructuring, receivership and forensic accounting engagements. David is qualified as a CPA in Australia and obtained his Bachelor of Commerce (Accounting) and Bachelor of Laws from The University of Adelaide in Australia. He then obtained his PCLL from The University of Hong Kong. David currently advises our clients on various legal disputes including auditors' negligence claims, insolvency and restructuring related disputes.



Sophia Zhang Miaomiao re-joined our Beijing Office as a PRC Counsel in October 2013 after spending a year in Washington D.C. She obtained her Bachelor of Laws degree from the University of Tianjing, China in 2003, and Master of Laws degree from University of Sheffield, England in 2004. She passed the PRC Bar Examination in 2008 and had worked in our Beijing Office from 2007 to 2012. Her main area of practice is in IP counselling and trade mark prosecution.



Edith Ruan Xingfei joined our Beijing Office as PRC Counsel in October 2013, focusing on IP enforcement. She obtained her Bachelor of Laws degree from Sun Yat Sen University in Guangzhou, PRC and completed a Master of Laws degree from The University of Hong Kong and Stanford Law School of the United States respectively. She passed the PRC Bar Examination in 2008 and New York Bar Examination in 2013. With over 4 years' experience in IP work, Edith will add strength to our China Enforcement Team.



Liv Yang Xiaoli, PRC Trade Mark Agent, joined our Beijing Office in April 2013, having obtained her Bachelor of Arts degree from Taiyuan Teachers College in 2006 and her Master of Arts degree from Chongqing University in 2009. Her main area of practice is in trade mark prosecution and related contentious work.





Yang Ming, PRC Trade Mark Agent, joined our Beijing Office in August 2013. She obtained her Bachelor of Arts degree from the Capital University of Economics and Business in Beijing, China in 2006 and a Master of Laws degree from the University of Bristol, England in 2013. Her practice is in trade mark prosecution and related contentious work.



Steven Li Ran, PRC Trade Mark Agent, joined our China Trade Mark Prosecution Team in our Beijing Office in July 2013. He obtained his Bachelor of Arts degree from Jilin Huaqiao Foreign Languages Institute in 2007. Before joining us, Steven worked as a patent and trade mark attorney for six years. His practice is in trade mark prosecution and related contentious work.

Talks & Seminars

We are pleased to be involved in, and contribute to, legal education in Hong Kong, China and other regions.

Legal Week's
Private Client
Forum Hong Kong
2013

John Budge, partner, spoke at Legal Week's Private Client Forum Hong Kong 2013 in the session "Keeping it in the family: disputes and the role of family offices", sharing how families should have proper succession planning and detailed plans in place at an early stage to avoid disputes.

Joint Mediation
Helpline Office
Conference
2013

John was also a speaker at the 2013 Hong Kong Joint Mediation Helpline Office Conference, "The Amazing Changes with the New Mediation Ordinance and Latest Development in Hong Kong Mediation". He is the Chairman of the Hong Kong Mediation Accreditation Association and spoke on the topic "The Way Forward – Accreditation Body and Mediation Service Providers".



John Budge on the left with Mr Antony Man, Chairman, Joint Mediation Helpline Office on the right.

Yvonne Chua, partner, also President of Licensing Executives Society (“LES”) International, gave the opening address at the “International Forum and Mock Trials on ITC Investigation and Patent Damages” co-organized by LES Chinese Taipei with other organizations and held in Taipei on 14 October 2013. She was also a panelist at the session on “Calculation of Damages and Royalty Rates”.

LES Chinese Taipei



*Yvonne Chua at the front row 2nd from the right
with organisers and other speakers*

Yvonne was also a keynote speaker at the LES Asia Pacific Regional Meeting held in Hangzhou, China on 16 October 2013 when she spoke on “Recent IP Trends in Asia Pacific”.

LES Asia Pacific
Regional Meeting



*Yvonne Chua on the left with Ms Patricia Bunye, moderator, and
Mr Naresh Prasad, Executive Director and Chief of Staff of
World Intellectual Property Office*

About Us

Licensing
Executives Society
International

Our partner **Yvonne Chua** was elected as President of Licensing Executives Society International at the International Management and Delegates Meeting held in Philadelphia in September 2013.



Yvonne Chua at front row 3rd from the left, with her Board members.

Intellectual
Property Rights
Protection
Alliance

Our partner **Andrea Fong**, currently vice-chair of the Intellectual Property Rights Protection Alliance, attended the Annual General Meeting on 11 December 2013 at the Hong Kong Customs Headquarters.



Andrea Fong (2nd from the left) with Mr Albert Ho (4th from left), Assistant Commissioner of the Hong Kong Customs, addressing the members on the prevailing IP crime trend and enforcement strategies of the Hong Kong Customs.

Publications

We are happy to provide upon request copies of the following published articles written by our lawyers.

“Pre-emptive trademark registration successfully challenged”
- Florence Lam

World Trademark
Review Daily
30 September 2013

“New Trademark Law finally promulgated”
- Esther Ho and Shireen So

Intellectual Asset
Management Magazine
9 October 2013

World Trademark
Review LEXOLOGY
9 October 2013

Conferences

Our members will be attending the following conferences and will be delighted to make arrangements in advance for meeting with clients and associates.

LESI Global Technology Impact Forum Geneva, Switzerland, 19 – 21 January 2014

INTA Hong Kong, 10 – 14 May 2014

LES Int’l Management & Delegates’ Meeting Moscow, 16 – 18 May 2014

LES International Annual Conference Moscow, 18 – 21 May 2014

ECTA Annual Conference Alicante, Spain, 18 – 20 June 2014

IPO Annual Meeting Vancouver, Canada, 7 – 9 September 2014

AIPPI Toronto, Canada, 14 - 18 September 2014

MARQUES Copenhagen, Denmark, 23 – 26 September 2014

LES USA & Canada Annual Meeting San Francisco, USA, 5 – 8 October 2014

PTMG Chicago, USA, 8 – 11 October 2014

LES Asia Pacific Regional Meeting Seoul, Korea, 5 – 6 November 2014

APAA Penang, Malaysia, 8 – 11 November 2014

INTA Leadership Meeting Phoenix, Arizona, USA, 11 – 15 November 2014

Hong Kong



Raymond Chan

“... personal data obtained from the public domain should only be used for purposes for which it was collected or a directly related purpose...”

Guidance on Use of Personal Data Obtained from the Public Domain

On 13 August 2013, the Office of the Privacy Commissioner for Personal Data (“PCPD”) issued the Guidance on Use of Personal Data Obtained from the Public Domain (“the Guidance”). The Guidance was issued after an investigation on a smartphone application known as “Do No Evil” which had seriously invaded privacy by allowing searches directed at individuals’ litigation and bankruptcy data. Following investigation, an Enforcement Notice was issued against the relevant data user, Glorious Destiny Investment Limited. The Guidance now addresses the common misconception that personal data obtained in the public domain such as through a public register, is not subject to restricted use – by requiring data users in the use of such personal data to observe and act in compliance with the Personal Data (Privacy) Ordinance (“PDPO”) and in particular Data Protection Principle 3 (“DPP 3”).

The major aspects of the Guidance are as follows:-

- 1) DPP 3 of the PDPO provides that personal data obtained from the public domain should only be used for the purposes for which it was collected or a directly related purpose, unless express and voluntary consent of the data subject is obtained.
- 2) As such, data users should first ascertain the original purpose of making the personal data available in the public domain. They should then question whether the re-use of such data is for the same purpose or a directly-related purpose and consider whether there is any restriction imposed by the data users on further uses and/or the reasonable expectation of the use of the personal data of the data subjects.
- 3) However, the right to privacy is not absolute. Exemptions from the DPP 3 application include uses in relation to domestic purpose, crime, health, legal proceedings, news, statistics and research and emergency situation.
- 4) PCPD further proposes for stronger administrative and technological measures, such as controlling access and preventing automated programmed search of personal data, to be put in place to safeguard against any improper use of publicly available information.

The Guidance reaffirms the need to carefully handle personal data in a manner consistent with the DPPs and PDPO. In the light of the prevalent abusive use

of information collected from the public domain, it is believed that further amendments to legislation, such as the consideration of incorporating a particular provision into the new Companies Ordinance which ensures full identification number and residential addresses of company directors not be made available, are likely to be the way forward to better afford protection of personal data as a whole.

Law Reform in Hong Kong – Charities

In 2007, the Law Reform Commission of Hong Kong (“the Commission”) established the Charities Sub-Committee to review the law and regulatory framework relating to charities in Hong Kong and to make recommendations for reform as may be considered appropriate. Our partner John Budge is pleased to serve in this Sub-Committee. On 6 December 2013, the Commission released their report (“the Report”). Whilst the Commission considers that it would be prudent not to recommend the setting up of a charity commission at this stage because of the lack of consensus amongst the public on this issue, this should be a long term goal for the Administration of the Government of HKSAR (“the Administration”). In gist, the Commission has made a number of recommendations for reform:-

1. There should be a clear definition of what constitutes a “charitable purpose” in order to provide greater certainty. Such “charitable purpose” should be exclusively charitable and also for the public benefit.
2. All charitable organizations which solicit from the public for the donation of cash or its equivalent and/or have sought tax exemption should be subject to the requirement of registration. Since there is currently no comprehensive and conclusive list of charities, the public is unable to ascertain whether a particular organization which represents itself as a charity is in fact a charity.
3. Measures to improve and enhance the accountability and transparency of charities in their activities should be imposed, including without limitation establishing a list of registered organizations for public inspection; adopting a specific financial reporting standard; standardising the application forms and conditions in the charitable fundraising licence or permit applications (such as disclosure of the objective of the charitable fundraising and the use of the funds collected); displaying the charitable organization’s registration number for all forms of charitable fundraising activities; publishing certain documents, such as the financial statements and activities’ reports on websites.



Florence Chan

*“...the
Commission
has made a
number of
recommendations
for reform (on
charities)...”*

4. The Administration should designate a government bureau/department to be responsible for enforcement action for non-compliance with the filing and disclosure requirements as recommended in the Report.
5. Non-statutory codes of good practice should be issued in relation to the protection and respect of the donors' rights and privacy; the contracting of services of professional fundraisers; and the recruitment of the elderly, the disadvantaged and disabled persons in soliciting donations on the street.

The Report is now under consideration by the Administration. We shall wait and see whether and how the Commission's recommendations will be implemented and adopted into legislation.

Hong Kong Alerts

Cooperation Agreement with SIPO on Patent Review

On 6 December 2013, the IPD of the HKSAR Government entered into a Cooperation Arrangement in the area of patent with the State Intellectual Property Office ("SIPO"), under which SIPO will provide technical assistance and support to the IPD on substantive examination of patent applications and the training of manpower in connection with the original grant patent ("OGP") system to be implemented in Hong Kong. An Advisory Committee on Review of the Hong Kong patent system as appointed by the HKSAR Government has in February 2013 recommended the introduction of the OGP system in order to facilitate the development of Hong Kong into a regional innovation and technology hub, and the premier IP trading hub in Asia.

AsiaIPEX

To support the HKSAR Government's efforts to develop Hong Kong as the IP trading hub in Asia, in December 2013, the Hong Kong Trade Development Council launched the Asia Intellectual Property Exchange (AsiaIPEX) to serve as a one stop online IP trading platform for global IP players and to enhance IP trading between the East and the West. The portal has 15 partners, including four overseas strategic partners from the US, Denmark, Beijing and Shanghai. Local strategic partners include five R & D centres and the technology transfer offices of six universities.

China

Patent Guidelines by the Beijing Higher People's Court

On October 9, 2013, the Beijing Higher People's Court published the *Guidelines in Determining Patent Infringement* ("the Guidelines"). The Guidelines will effectively replace the Court's *Opinions on Several Issues Related to the Determination of Patent Infringement* of 2001.

Comprising 133 articles, the Guidelines are a very substantive document, covering such aspects as (1) patent scope determination; (2) the meaning of equivalent features (doctrine of equivalents); (3) scope of functional features (means-plus-function claims); (4) standard in determining same or similar design or article; (5) the meaning of different infringing acts such as "use", "making", "sale", "importation" of patents or patented articles; (6) the meaning of joint infringement, including whether or not such term encompasses "co-infringement", as well as such secondary acts as "assisting" and "procuring", and "providing conveniences" in the primary infringements; and (7) defence.

The Guidelines are very comprehensive and a valuable practical guidance relating to claim construction and patent infringement and defence. Though not formally binding as law, being the views of the Beijing Higher People's Court, probably the most authoritative Court in China other than the Supreme People's Court of China, the Guidelines will indeed be very persuasive to the other Courts.



Howard Tsang

"The Guidelines are very comprehensive and a valuable practical guidance relating to claim construction and patent infringement and defence."

China Alert

New rules on cross border funds transfer of IP transactions

Effective 1 September 2013, new rules are implemented to simplify the registration process on making foreign currency payments for intellectual property transactions. Except for certain restricted import/export categories, it is no longer required to obtain registration certificates from the Ministry of Commerce or the State Intellectual Property Office to convert renminbi to foreign currencies for transactions involving patents, copyright, trade marks, know-how and technical services of US\$50,000 or less. For payments exceeding US\$50,000, registration certificates are also not required, but Chinese payers will still need to provide evidence of the relevant intellectual property transfer and pay the relevant taxes.

Notice: This newsletter is intended for general information only and should not be taken as legal advice of Wilkinson & Grist. For any enquiries, please contact Ms Anita Kwan at anitakwan@wilgrist.com.

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Hong Kong
Beijing

Wilkinson & Grist



HK/China base with International Focus

Major areas of
practice:

- Banking
- Bankruptcy & Insolvency
- China Trade
- Civil Litigation & Arbitration
- Company & Commercial
- Conveyancing & Real Estate
- Employment & Labour Relations
- Family & Matrimonial
- Intellectual Property
- Information Technology
- Private Client
- Securities & Investment

- A long tradition of excellence since 1860's
- Our own IP agency in Beijing
- Hong Kong lawyers joining forces with PRC counsel, trade mark agents and patent agents.

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