

Newsletter |

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WILKINSON & GRIST  
Solicitors & Notaries

2021



*Year of the Ox*

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## NEW HONOURS



We are honored to have won the award of **2020 Country Award: Hong Kong** in the 2020 Annual Global Legal Awards by The Lawyers Global. This award is recognized, all over the world, by law firms and legal industry businesses, as the industry Awards and Rankings System that offers a high level of prestige and global visibility. We are also ranked as outstanding in the award of **2020 Sub-Region Award: Eastern Asia**.



For consecutive years, we have been **Recommended** in the practice areas of Dispute Resolution: Litigation, Intellectual Property, and Restructuring and Insolvency in Hong Kong in The Legal 500 Asia Pacific 2021, The Client's Guide to the best law firms and top lawyers.

## CHAMBERS GLOBAL 2021 ASIA-PACIFIC 2021

We are pleased to be ranked as one of the leading **International Firms – China for Intellectual Property** in Chambers Global and Chambers Asia-Pacific 2021 Guide.

## Congratulations

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



LITIGATION 2020  
TRADE MARKS 2020  
WOMEN IN BUSINESS LAW 2020



Keith Ho



Andrea Fong



Mena Lo



Florence Lam



John Budge

**Keith Ho**, Senior Partner and Head of our Dispute Resolution Practice Group, and **John Budge**, Consultant of our Dispute Resolution Practice Group, have been named as one of the world's leading practitioners in the area of Litigation in Hong Kong in the Expert's Guide published by Legal Media Group. **Andrea Fong**, **Mena Lo** and **Florence Lam**, respectively Head and Partners of our Intellectual Property Practice Group, are all named in the areas of Trade Marks in Hong Kong and Women in Business Law.

CHAMBERS  
GLOBAL 2021  
ASIA-PACIFIC 2021



Keith Ho



Andrea Fong



Yvonne Chua

In Chambers Global and Chambers Asia-Pacific 2021, **Keith Ho**, Senior Partner and Head of our Dispute Resolution Practice Group, is ranked as **Leading Individual** for Dispute Resolution (International Firms) – China. **Andrea Fong** and **Yvonne Chua**, respectively Head and Consultant of our Intellectual Property Practice Group, are ranked as **Recognised Practitioner** and **Eminent Practitioner** for Intellectual Property, China respectively in Chambers Global 2021 and also as **Leading Individual** and **Senior Statespeople** respectively for Intellectual Property, China in Chambers Asia-Pacific 2021.



Keith Ho



Andrea Fong



Lawrence Chan

**Keith Ho**, Senior Partner and Head of our Dispute Resolution Practice Group, has been recommended in Hong Kong in Dispute Resolution: Litigation and Restructuring and Insolvency in The Legal 500 Asia Pacific 2021. **Lawrence Chan**, Partner of our Restructuring and Insolvency Practice Group, has received the same honour in Restructuring and Insolvency. **Andrea Fong**, Head of our Intellectual Property Practice Group, has been named as leading individual and recommended in Intellectual Property.



John Budge

Our Consultant, **John Budge**, recently received an Individual Gold Award in the 2020 Pro Bono and Community Work Recognition Programme of The Law Society of Hong Kong. This is the third time that John has received this award. In addition, he also received the Award for Elderly Service. He has been very involved in public service in Hong Kong for many years.

## Appointments

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

Hong Kong Institute  
of Certified Public  
Accountants

**Andrea Fong**, Partner and Head of our IP Practice Group, has been re-appointed by the Secretary of Financial Services and the Treasury as the Investigation Committee Convenor and concurrently a member of Investigation Panel A of the Hong Kong Institute of Certified Public Accountants for a further term of one year from 1 February 2021 to 31 January 2022. The Investigation Panel is vested with statutory powers to investigate any irregularity concerning a certified public accountant or registered practice unit.



**Annie Tsoi**, Partner, Intellectual Property Practice Group, has been appointed as a member of the Intellectual Property Committee of the Law Society of Hong Kong.

The Law Society of  
Hong Kong

**Annie Tsoi**, Partner, Intellectual Property Practice Group, has been re-elected as council member (and elected as the Secretary) of the Licensing Executives Society China, Hong Kong Sub-Chapter (LESCHK) for the two-year term 2021-2022. LESCHK is part of an international IP organisation with over 10,000 members around the world involved in the business of IP.

Licensing  
Executives Society  
China, Hong Kong  
Sub-Chapter

## New Faces

*We warmly welcome the following newcomers to our firm.*

**Sara Chan** joined our firm as a trainee solicitor in 2018. After her admission, she joined our Dispute Resolution Practice Group as an assistant solicitor in 2020. She obtained her BBA (Law) and LLB degrees and PCLL from The University of Hong Kong. Sara currently works on a variety of litigation and arbitration matters in relation to contractual disputes, shareholders' disputes and insolvency.



**Charlie Lau** joined our Dispute Resolution Practice Group as an associate in 2020 after completing his training with our firm. He obtained his BBA (Law) and LLB degrees and PCLL from The University of Hong Kong. Charlie currently works on a variety of litigation matters, including commercial dispute resolution, contractual disputes, insolvency, as well as estate administration disputes.



**Michael Leung** joined our Company and Commercial Practice Group and Real Estate Practice Group as an associate in 2020 after completing his training with our firm. He obtained his BBA (Law) and LLB degrees and PCLL from The University of Hong Kong. Michael currently works on banking, real estate, corporate and commercial matters, including sale and purchase of properties, loan transactions, leases and tenancies and commercial contracts.



## Talks & Seminars

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

Vocation  
Training  
Council

**Annie Tsoi**, Partner, Intellectual Property Practice Group, upon invitation by the Vocation Training Council gave an online talk on “IP Registration in Mainland China 內地知識產權註冊機制” on 15 October 2020, being part of the IP Manager Scheme PLUS organized by the Hong Kong Intellectual Property Department. The talk was attended by over 150 local entrepreneurs, owners and managers of SMEs with interest in IP trading and management in Mainland China.

## Hong Kong SAR



Paul Liu

### Hong Kong and Mainland China strengthen cross-border mutual enforcement of arbitral awards

On 27 November 2020, the HKSAR Government and the Supreme People's Court of the People's Republic of China (the “**SPC**”) signed the “Supplemental Arrangement Concerning Mutual Enforcement of Arbitral Awards between the Mainland and the Hong Kong Special Administrative Region” (the “**Supplemental Arrangement**”). The Supplemental Arrangement aimed at enhancing enforcement under the Arrangement Concerning Mutual Enforcement of Arbitral Awards between the Mainland and the Hong Kong Special Administrative Region, which entered into force on 1 February 2000 (the “**Arrangement**”). The amendments introduced in the Supplemental Arrangement include:-

1. References to “enforcement” of arbitral awards in the Arrangement shall be interpreted to include “recognition and enforcement” of arbitral awards;
2. The scope of application is expanded to include all Mainland awards issued under the Arbitration Law of the People's Republic of China. Scope of application regarding Hong Kong awards remains unchanged, ie awards issued under the Hong Kong Arbitration Ordinance;
3. Simultaneous enforcement applications may now be made to both



Hong Kong and Mainland courts, subject to the limitation that the total value of assets to be enforced by courts of both jurisdictions must not exceed the amount determined in the award;

4. Pursuant to parties' application and the law of place of enforcement, the court may adopt preservation or mandatory measures before or after acceptance of the enforcement application.

Amendments 1 and 4 became effective on 27 November 2020, while Amendments 2 and 3 shall come into force on a date to be announced by the SPC after relevant procedures are completed in Hong Kong.

## China

### Strengthened IP protection in the PRC

In late 2020, the Standing Committee of the National People's Congress passed the Fourth Amendments to the PRC Patent Law and the Third Amendments to the PRC Copyright Law.

Notably, the amendments in both Laws aim at enhancing protection against infringements, in particular:-

- The ceiling of statutory damages for both patent and copyright infringement will be increased to RMB 5 million (cf RMB 1 million and RMB 0.5 million respectively under the current laws).
- The court is empowered to impose punitive damages in cases of blatant and willful infringement of serious nature, which can range between 1 and 5 times of the damages suffered by the patentee/copyright owner, the profit made by the infringer, or the patent/copyright royalty.
- To ease the difficulty of the patentee/copyright owner in proving the quantum of damages, the burden of proof will shift from the patentee/copyright owner to the infringer. To effect this, the court can order the infringer to provide financial records in order to ascertain the amount of profit arising from the infringement, failing which the court can determine the quantum of damages based on the claims made and evidence provided by the patentee/copyright owner.



Annie Tsoi

Other notable amendments are as follows:-

### Patent Law

#### 1. *Extension of limitation period*

The limitation period for instituting legal proceedings against patent infringements is extended to three years counting from the date on which the patentee or any interested party becomes aware or has knowledge of the infringing act and the infringer, to be consistent with the Civil Code which came into effect on 1 January 2021.

#### 2. *Introduction of the “open license” system*

Any patentee that wishes to authorize any institution or individual to implement the patent can make a declaration to China National Intellectual Property Administration (CNIPA), and the CNIPA will announce and implement such open license. During the exploitation of the open license, the annuity paid by the patentee shall be reduced or exempted accordingly.

#### 3. *Protection of pharmaceutical patent*

In view of the typically long review process of new drugs, the patentee may apply for an extension of patent term to compensate for any unreasonable delay not attributable to the applicant in granting the patent.

To facilitate early resolution of pharmaceutical patent dispute, a patent linkage system between the examination of drug marketing authorisations and patent disputes arising during this stage will be established. The patentee or any interested party may take action in court or file administrative complaint after the publication of the drug marketing authorisation if it becomes aware of any possible infringement of its patent.

#### 4. *Expansion of design patent protection*

The term of a design patent will be extended from 10 years to 15 years. Further, partial design can be the subject matter for a design patent.

## Copyright Law

### 1. *Expansion of types of work*

The type of copyright work “film and work created by film-like methods” is re-categorized as “audio-visual work” to cover new types of work surfaced in recent years such as live network, live game, microfilm and short video. “Other copyright work stipulated by the laws and regulations” is re-named “other intellectual output/achievement qualifying as copyright work” to leave room for new types of copyright work in the future.

### 2. *Introduction of “technical measures” taken by copyright owner to strengthen protection*

A new chapter is introduced to provide for the copyright owner’s rights in taking technical measures to protect its copyright and related rights, and no one shall willfully circumvent or destroy such technical measures without the copyright owner’s consent unless otherwise provided by laws. Any such willful circumvention or destruction, as well as any willful manufacture, import or provision of equipment for such purpose would constitute infringement.

The above amendments to the PRC Patent Law and PRC Copyright Law will take effect on 1 June 2021.

## Criminal Law

In addition to the above amendments to the Patent and Copyright Laws, the Eleventh Amendments to the PRC Criminal Law were passed in December 2020.

Some of the notable amendments relating to intellectual property include:-

- The maximum sentence of IP crimes is generally increased from seven years’ imprisonment to ten years’ imprisonment, except that sale of infringing copies (under copyright crimes) is subject to imprisonment of up to five years.
- Infringing use of a trademark not only on products but services is subject to criminal liability.

- Below acts of copyright infringements are added subjecting to criminal liability:-
  - without consent from the performer, copy or distribute any audio-visual product featuring his/her performance, or broadcast such performance to the public through information network;
  - without consent from the copyright owner, willfully circumventing or destroying the technical measures taken by the copyright owner in protecting the copyright and the related rights in his/her work or audio-visual products.

The above amendments to the PRC Criminal Law will take effect on 1 March 2021.

The latest amendments to the above laws demonstrate the state's commitment to strengthen intellectual property protection in China, and to adapt to the advancement of the society and technology. It is expected that detailed regulations, rules and interpretations will be announced in due course to facilitate the implementation of these amendments.

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](mailto:anitakwan@wilgrist.com).

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