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# CONTENTS

<b>Message from our Senior Partner .....</b>	<b>2</b>
<b>New Honours .....</b>	<b>2-4</b>
<b>Congratulations .....</b>	<b>4-5</b>
<b>Talks and Seminars .....</b>	<b>5</b>
<b>About Us .....</b>	<b>6</b>
<b>Hong Kong SAR .....</b>	<b>6-9</b>
- Proposed amendments to the Personal Data (Privacy) Ordinance to curb doxxing.....	6
- A major step forward: Mutual Recognition of and Assistance to Insolvency/Bankruptcy Proceedings between Hong Kong and PRC .....	7-9
<b>China .....</b>	<b>10-11</b>
- Supreme People's Court of China issued new interpretations on punitive damages in intellectual property cases.....	10-11
<b>China Alert .....</b>	<b>11</b>
- Scope of Necessary Personal Information to be collected by Mobile Internet Applications defined .....	11

### Message from our Senior Partner

I am very honoured and privileged to become the Senior Partner of the Firm as from 1 April 2021, not a role I would have envisaged when I first set foot in the Firm in 1986 as a summer student. Throughout the years with the Firm, I have been given endless opportunities to grow, learn and develop a strong passion in my career and commitment to the Firm. My predecessors have demonstrated a high standard of integrity, perseverance, efficacy and quality in delivering legal services. It is my mission to continue their legacy and join hands with my partners to lead the Firm through thick and thin.



Andrea Fong

COVID 19 has posed severe challenge to the world and turned many abnormalities into becoming part of our daily lives. But looking back, when were we short of challenges in the past years and decades? Dressed up in different magnitudes and forms, challenges are always there to try us and sift out the fitness. Together with our clients, colleagues and stakeholders, we shall strive to defeat crises, breed opportunities and work towards a better and brighter tomorrow.

## NEW HONOURS



We are honoured to be recognized as one of the leading **International Firms** for **Intellectual Property (Copyright)**, **Intellectual Property (Trademark)** and **Real Estate & REITS** in the 2021 China Business Law Awards which are based on nominations received from China-focused corporate counsel and legal professionals around the world.

Managing  
Intellectual  
Property

# IP STARS

## TRADE MARK SURVEY 2021

For consecutive years, we have been voted as a **Tier 1 Law Firm** for **Trademark Prosecution** work in Hong Kong in this annual world survey which provides in depth analysis and rankings for trade mark works. We are also recognized as a **Top Tier Law Firm** for **Trademark Contentious** work in Hong Kong. We are pleased to be also ranked as **Top Tier Foreign Firm** for **Trademark** in China.



## The World's Leading Trademark Professionals 2021

We have received the highest ranking for **Trademark** prosecution and strategy and have also been recommended for **Trademark** enforcement and litigation for Hong Kong in the WTR 1000 publication which identifies the firms and individuals that are deemed outstanding in this area of practice.

*“Wilkinson & Grist’s long-established IP practice has been serving rights holders for over 50 years. The team consists of 30 professionals spread out across offices in Hong Kong and Beijing. Among the top filers in the special administrative regions, the firm occupies a well-earned spot in the gold tier for prosecution and strategy, although it offers high-quality enforcement services too. Practitioners are known for their ‘professionalism, deep expertise and commerciality’ and provide ‘speedy, nuanced legal advice that takes all aspects of a matter into consideration’.”*



## IP RANKINGS 2021

### ASIA’S BEST FIRMS FOR INTELLECTUAL PROPERTY

We are pleased to be identified as **Tier 1 Law Firm** for **Patents** and **Copyright/Trademarks** in Hong Kong by Asian Legal Business (ALB) in its latest issue of IP Rankings 2021. ALB drew information from firm submissions, interviews, editorial

resources and market suggestions to identify and rank the top firms for intellectual property in Asia.

## DOYLES

We are pleased to be ranked as **First Tier Intellectual Property Law Firm** in Hong Kong in the Doyle's Guide 2020 which details firms practising within the areas of Intellectual Property, Patent, Trademark & Copyright Law matters (contentious and/or non-contentious) in the Hong Kong legal market who have been identified by their clients and peers for their expertise and abilities in these areas.

## Congratulations

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

## DOYLES



Andrea Fong



Mena Lo



Florence Chan



Annie Tsoi



John Budge



Keith Ho

**Andrea Fong**, Head of our Intellectual Property Practice Group, has been named as **Leading Lawyer** in **Intellectual Property** whereas **Mena Lo** and **Annie Tsoi**, both Partners of our Intellectual Property Practice Group, have been named as **Recommended Lawyer** in the Doyle's Guide 2020. **Keith Ho**, Consultant, and **Florence Chan**, Partner, both of our Dispute Resolution Practice Group, have been respectively named as **First Tier Lawyer** and **Second Tier Lawyer** in **Estates, Probate & Succession Litigation** whereas **John Budge**, Consultant of our Dispute Resolution Practice Group, has been named as **Recommended Lawyer** in the same Guide.





## The World's Leading Trademark Professionals 2021



Andrea Fong



Mena Lo



Annie Tsoi



Esther Ho

**Andrea Fong, Mena Lo and Annie Tsoi**, respectively Head and Partners of our Intellectual Property Practice Group, have been ranked as **leading individual** in **Trademark** prosecution and strategy whereas **Mena** and **Esther Ho**, Partners of our Intellectual Property Practice Group, have been ranked as **leading individual** in **Trademark** enforcement and litigation, in the WTR 1000 listings following an exhaustive qualification research process.

## Talks & Seminars

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

Hong Kong  
Intellectual  
Property  
Department  
(IPD)

**Shireen So**, Partner of our Intellectual Property Practice Group, conducted the online workshop “Practical Workshop for IP Managers” organized by the IPD on 5 March 2021. This is the fourth re-run of a series of workshops to take place for the years 2020-2022 under the IPD’s IP Manager Scheme. The workshops aim at equipping IP managers of SMEs with practical knowledge of managing IP assets effectively and integrating IP assets into their overall business strategy.

## About Us

We are honoured to be one of the hole sponsors to The Community Chest BEA Charity Golf Day 2021 organized by The Bank of East Asia, Limited as a fund raising event for The Community Chest of Hong Kong.

The  
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Chest BEA  
Charity Golf  
Day

## Hong Kong SAR

### Proposed amendments to the Personal Data (Privacy) Ordinance to curb doxxing

In May 2021, the Constitutional and Mainland Affairs Bureau submitted a paper to the Legislative Council (“**LegCo**”) proposing amendments to the Personal Data (Privacy) Ordinance (Cap 486) (“**PDPO**”) to combat doxxing acts. The proposals include:-



Raymond Chan

1. Introducing a new doxxing offence under section 64 of the PDPO. A person will commit the new offence if (i) the person discloses the personal data of a data subject without the data subject's consent, (ii) with an intent to threaten, intimidate, harass or cause psychological harm to the data subject or any immediate family member; and (iii) the disclosure actually causes psychological harm to the data subject or any immediate family member. Such person may be liable on conviction on indictment to a fine of HK\$1 million and to imprisonment of 5 years, or on summary conviction to a fine of HK\$100,000 and to imprisonment of 2 years; and
2. Empowering the Privacy Commissioner for Personal Data (the “**Commissioner**”) to carry out criminal investigation, initiate prosecution in its own name and serve Rectification Notices demanding rectification of doxxing contents. Failure to comply with the Commissioner's investigation or any Rectification Notice without reasonable excuse may also attract criminal liabilities.

The government is consulting the Panel on Constitutional Affairs of the LegCo on the proposed amendments and aims to submit the corresponding Amendment Bill to the LegCo within the current legislative year.



Paul Liu



Iris Chan

## A major step forward: Mutual Recognition of and Assistance to Insolvency/Bankruptcy Proceedings between Hong Kong and PRC

### Introduction

With the ever-closer economic ties between Hong Kong and PRC, the Hong Kong Companies Court has been faced with an increasing number of cross-border insolvency proceedings.

As neither Hong Kong nor PRC has adopted the UNCITRAL Model Law on Cross-Border Insolvency and neither has a relevant statutory mechanism, the Hong Kong Courts have had to rely on common law principles in these cases (See *Re CEFC Shanghai International Group Ltd* [2020] 1 HKLRD 676 and *Re Shenzhen Everich Supply Chain Co Ltd* [2020] HKCFI 965 where the Court recognised the appointment of administrators by the Courts of Shanghai and Shenzhen, indicating for the first time the willingness of the Hong Kong Courts to provide assistance to PRC administrators; and *Re Ando Credit Limited* [2020] HKCFI 2775 where provisional liquidators were appointed in Hong Kong for the purpose of enabling them to seek recognition in PRC).

Whilst there might have been fruitful judicial cooperation between the two jurisdictions at different levels, there has not been any breakthrough in the liquidation regime given its complexity. The Court has at times expressed concerns over, and called for improvement in, the efficiency and effectiveness of cross-border insolvency proceedings.

### The New Framework

There has since been some significant development. On 14 May 2021, the Supreme People's Court of PRC ("SPC") and the Government of Hong Kong signed the *Record of Meeting of the Supreme People's Court and the Government of the Hong Kong Special Administrative Region on Mutual Recognition of and Assistance to Bankruptcy (Insolvency) Proceedings between the Courts of the Mainland and of the Hong Kong Special Administrative Region*, signifying a long-awaited step forward by insolvency practitioners in both jurisdictions, as it establishes a cooperation mechanism for Hong Kong liquidators and PRC administrators to seek mutual recognition and assistance.

Details of the cooperation framework are set out in the SPC's *Opinion on Taking Forward a Pilot Measure in relation to the Recognition of and Assistance to Insolvency Proceedings in the Hong Kong Special*



*Administrative Region* and the *Practical Guide* issued by the Hong Kong Department of Justice. Key features of the new framework are as follows:

1. The People's Courts in Shanghai, Xiamen and Shenzhen (each a "**Pilot Area**" and collectively "**Pilot Areas**") are the designated courts for the recognition of and assistance to "Hong Kong Insolvency Proceedings", which cover (i) compulsory winding-up; (ii) creditors' voluntary winding-up; and (iii) schemes of arrangement sanctioned by the Hong Kong Courts.
2. For recognition and assistance to be granted in PRC in relation to Hong Kong Insolvency Proceedings, the centre of main interests of the debtor must have been in Hong Kong for at least 6 months. The centre of main interests generally means the place of incorporation of the debtor; but other factors such as the place of its principal office, its principal place of business, the place of its principal assets, etc will be considered.
3. The debtor's principal assets in PRC must be in one of the Pilot Areas, or it must have a place of business or a representative office in one of the Pilot Areas. Procedures for making the recognition application are to be made in accordance with the rules of the relevant Pilot Area.
4. An administrator in PRC bankruptcy proceedings may apply to the Hong Kong Court for recognition of bankruptcy liquidation, reorganisation and compromise proceedings under the Enterprise Bankruptcy Law of PRC, recognition of his office as an administrator, and grant of assistance for discharge of his duties as an administrator. This process involves first seeking a "letter of request" from the relevant Court in a Pilot Area addressed to the Hong Kong Court setting out the order sought from the Hong Kong Court. Upon issuance of that letter, the PRC administrator may make an application to the Hong Kong Court.
5. A liquidator or a provisional liquidator in Hong Kong Insolvency Proceedings ("**Hong Kong Administrator**") may apply to the relevant Intermediate People's Court in a Pilot Area for recognition and assistance.

6. Once the relevant Intermediate People's Court grants recognition of and assistance to Hong Kong Insolvency Proceedings, the Hong Kong Administrator may perform its duties within the scope provided by the Enterprise Bankruptcy Law of PRC and the laws of Hong Kong. The Hong Kong Administrator will be empowered to, for example, seize property, corporate seals, account books, documents and other data of the debtor, investigate into the financial position of the debtor, decide on the matters relating the debtor's internal management, manage and dispose of the debtor's property, and participate in legal actions, arbitrations or any other legal proceedings on behalf of the debtor. The Hong Kong Administrator may apply for the designation of a PRC administrator by a PRC court to perform such duties. A Hong Kong Administrator may apply for preservation measures to the same court after an application for the recognition of and assistance to Hong Kong Insolvency Proceedings is made and before such recognition and assistance is granted.
7. Where the relevant Intermediate People's Court recognises and assists Hong Kong Insolvency Proceedings, the property of the debtor in PRC will first satisfy preferential claims under PRC laws. The remainder of the property will be distributed in accordance with the corresponding Hong Kong Insolvency Proceedings.

### Conclusion

The new cooperative framework is a critical and welcomed development in cross-border insolvency proceedings. It can be expected that the arrangement will gradually extend beyond the Pilot Areas.

The Secretary for Justice has stated that the new framework will hopefully encourage the use of restructuring of debts to revive businesses with a view to reaching consensus among creditors from both places and abroad. It may provide more opportunities for the debtor to look for a successful rescue. In the long run, it is hoped that the framework will give additional assurance to investors and further improve the business environment in PRC and Hong Kong.

# China

## Supreme People's Court of China issued new interpretations on punitive damages in intellectual property cases

The PRC Civil Code, which came into force on 1 January 2021, provides that intellectual property right proprietors are entitled to claim punitive damages in cases of (i) serious and (ii) intentional infringement of intellectual property rights. Punitive damages are also provided for under the current PRC Patent Law, Trade Mark Law and Copyright Law, among others.

To provide clarity and consistency as to how punitive damages can be applied and assessed, the PRC Supreme People's Court recently issued the Interpretation on the Application of Punitive Damages to the Trial of Civil Cases of Infringement of Intellectual Property Rights 《最高人民法院關於審理侵害知識產權民事案件適用懲罰性賠償的解釋》 (the “**Interpretation**”), which took effect on 3 March 2021.

Key provisions of the Interpretation include:-

1. Although worded differently, the limb of “intentional” (故意) infringement as required in the Civil Code, Patent Law and Copyright Law is clarified to include and be the same as “bad faith” (惡意) as referred to in the Trademark Law and Anti-Unfair Competition Law.
2. The court is expected to comprehensively consider all relevant factors when assessing whether an infringement is “intentional”. Prima facie evidence that establishes such intent includes:-
  - despite prior notice or warning, the infringer still carries on the infringing act;
  - the infringer has business, employment or agency relationship with the intellectual property right proprietor (to include business negotiations), and has been exposed to the right infringed.



Annie Tsoi

3. When assessing whether an infringement is “serious”, the court is expected to comprehensively consider the means, frequency, duration, geographical scope, scale and consequences of the infringement. An infringement will be deemed “serious” when:-
  - the infringer infringes others’ intellectual property rights for a living;
  - the infringer fabricates, destroys or conceals infringing evidence;
  - the infringer refuses to comply with any preservation order;
  - immense loss is suffered by the right proprietor as result of the infringement;
  - the infringing act potentially harms national security and public interest.
4. When determining the amount of punitive damages, the court should base on the actual loss suffered by the plaintiff, or the infringer’s illegal earnings or profit arising from the infringement, in accordance with the relevant intellectual property law(s). Where the above cannot be ascertained, the court may take reference of the licensing fees of the respective intellectual property right.

The Interpretation provides clear and practical guidance on when and how punitive damages can apply in intellectual property cases. It is expected that this will provide better protection for intellectual property rights and a stronger deterrence effect against intellectual property infringement.

## China Alert

### Scope of Necessary Personal Information to be collected by Mobile Internet Applications defined

On 1 May 2021, Provisions on the Scope of Necessary Personal Information Required for Common Mobile Internet Applications 《常見類型移動互聯網應用程序必要個人信息範圍規定》 (the “**Provisions**”) became effective.

The Provisions specify the scope of necessary personal data that is typically required by 39 common mobile internet applications (“**App**”), which encompass instant messaging, social networking, online shopping, money lending, job searching and hotel services. In particular, the Provisions seek to prohibit the App operators from refusing users’ access to the basic functions of the respective App simply because the users do not agree to provide personal information beyond the specified scope.

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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