

W i l k i n s o n & G r i s t  
S o l i c i t o r s & N o t a r i e s

## Welcome Message

*2014* has been a strong year for Wilkinson & Grist with the growth of our key practices and the international recognitions to our work and our partners on our commitment to excellence. None of these achievements would have been possible without the support and trust placed in us by our valued clients and associates.

In this special year, as we celebrate the 10th anniversary of our Beijing IP Agency which marks an important milestone in our history as the first wholly foreign owned IP Agency approved by the Chinese Government, we are excited about continuous progress in our China practice especially with the significant recent changes in the China IP arena.

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## NEW HONOURS



We are honored to be ranked as a Tier 1 law firm in Hong Kong for Patent Prosecution, Trade Mark Prosecution and Trade Mark Contentious work in the IP Stars Handbook 2014, the Definitive Guide to leading IP Firms and Lawyers. This widely respected publication by the leading directory Managing Intellectual Property followed from a survey covering 80 countries, with the rankings based on extensive research among IP practitioners. We are pleased to be also ranked for Trade Mark in China as foreign firm.

*“Wilkinson & Grist’s IP practice has a long presence in Hong Kong serving clients for over 40 years. Housing a large team of professionals including Hong Kong lawyers, patent and trade mark agents and mainland China legal counsel, this highly-regarded firm is a top choice amongst domestic and international clients looking for quality IP services in Hong Kong and the mainland.”*



## The World’s Leading Patent Practitioners 2014

We are pleased to have been named as a **Highly Recommended** law firm in Patent Prosecution for Hong Kong in the IAM Patent 1000, a guide to leading private practice patent practitioners and firms in the world’s key jurisdictions. We are also named for our Patent practice on Litigation and transactions.

*“Intellectual property is a central pillar at full-service outfit Wilkinson & Grist. It is equally comfortable operating on both sides of the contentious/non-contentious divide.”*

## Congratulations

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



Yvonne Chua



Andrea Fong



John Budge



Keith Ho



Raymond Chan



Michael Ma

**Yvonne Chua** and **Andrea Fong**, respectively Head and Partner of our Intellectual Property Practice Group, have for consecutive years been voted as leading lawyers in Hong Kong in Intellectual Property Practice. **Keith Ho** and **John Budge**, respectively Head and Consultant of our Dispute Resolution Practice Group, have received the same honour in Dispute Resolution whereas **Raymond Chan** and **Michael Ma**, respectively Head and Partner of our Corporate Practice Group, are named as leading lawyers in Corporate/M&A Practice.



Yvonne Chua



Andrea Fong

**Yvonne Chua** and **Andrea Fong** have been named as IP Stars 2014, pursuant to their outstanding practice on Trade Mark including strategy, counselling and enforcement.



## TRADE MARK 2014



Yvonne Chua



Andrea Fong



Mena Lo

**Yvonne Chua** and **Andrea Fong** with **Mena Lo**, also Partner of our Intellectual Property Practice Group, have been named in this 2014 Guide to the World's Leading Trade Mark Lawyers, the international legal market's legal guide to the top legal practitioners in the field of Trade Mark, as experts in Hong Kong.



## LITIGATION AND PRODUCT LIABILITY 2014



John Budge



Keith Ho

**Keith Ho** and **John Budge** are recognized in this 2014 Guide to the World's Leading Litigation and Product Liability Lawyers as top litigators who are considered by clients and peers to be the best in their field in Hong Kong.





### The World's Leading Patent Practitioners 2014



Yvonne Chua

**Yvonne Chua** is named as a “Recommended” practitioner for Hong Kong in this world patent experts guide.

**Yvonne** balances “*busy practices alongside active participation in industry associations*”, and is “*highly respected for*” her “*pioneering work in driving the development of the profession.*”



Yvonne Chua

**Yvonne Chua** has further been chosen in this 2014 Asia IP Issue as one of the top 50 patent lawyers in 15 jurisdictions around Asia and the Pacific who are recognized as among the best on obtaining, defending and opposing patents.



## TRADEMARKS 2014



Yvonne Chua



Andrea Fong

**Yvonne Chua** and **Andrea Fong** have again been recognized as the world's leading Trademark Lawyers in this publication which acknowledges through lengthy research leaders in the field in 77 jurisdictions.

## Appointments

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

**Yvonne Chua**, Senior Partner, has been re-appointed by the Hong Kong Bible Society as a member of the Board of Governors from 2014 to 2017.

Hong Kong  
Bible Society

**Yvonne** has also been re-appointed as a board member of the China Graduate School of Theology for the term 2014-2017 as well as its legal advisor.

China Graduate  
School of Theology

## Talks & Seminars

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

**Howard Tsang**, Head of our Beijing IP Agency, chaired the table topic of "Proven strategies on how to successfully prove monetary damages in China" at the 2014 Annual Meeting of International Trademark Association held in Hong Kong.

INTA

## About Us

### Hong Kong Science and Technology Parks IP Panel

We are pleased to be again appointed by the Hong Kong Science and Technology Parks Corporation (“HKSTPC”) to the Panel of Legal & Intellectual Property Firms (2014 – 2017) to provide legal/intellectual property services to HKSTPC partner companies. HKSTPC is a statutory organization inaugurated by the Government of the Hong Kong SAR to take a leading role in transforming innovation and technological advancement into value creation that benefits Hong Kong, Mainland and the world.

### Success in recent probate case

Our Civil Litigation Practice Group has a recent success in upholding the validity and due execution of the last will and testament of the late Mr Kwok Wing Fai at the trial in the Court of First Instance. Mr Kwok was known to have established a business in egg trading and was highly successful. His wife and eldest son contested the validity of the will alleging that it contradicted Mr Kwok’s earlier verbal instructions and that he was mentally incapable and unduly influenced when he executed the will. In representing the two executors, who are also Mr Kwok’s children, we are pleased to have protected Mr Kwok’s final wishes.

## Conferences

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

AIPPI World IP Congress

Toronto, Canada, 14 - 17 September 2014

MARQUES Annual Meeting

Copenhagen, Denmark, 23 – 26 September 2014

LES USA & Canada Annual Meeting

San Francisco, USA, 5 – 8 October 2014

Licensing Association of Thailand Grand Opening Seminar

Bangkok, Thailand, 13-14 October 2014

LES Asia Pacific Regional Meeting

Seoul, Korea, 5 – 6 November 2014

APAA Annual Meeting

Penang, Malaysia, 8 – 11 November 2014

INTA Leadership Meeting

Phoenix, Arizona, USA, 11 – 15 November 2014



# Publications

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

“The International Comparative Legal Guide to Trade Marks 2014” <ul style="list-style-type: none"><li>- Hong Kong - Trade Marks 2014 – Andrea Fong, Annie Tsoi</li><li>- China – Trade Marks 2014 – Howard Tsang, Jean Wang</li></ul>	Global Legal Group 16 April 2014
“Application for ‘Cool Fresh’ in Class 3 refused on absolute grounds” <ul style="list-style-type: none"><li>- Mena Lo, KY So</li></ul>	Intellectual Asset Management Magazine 30 April 2014
“10 things Europeans need to know about Chinese Trade-Mark Law” <ul style="list-style-type: none"><li>- Howard Tsang</li></ul>	ECTA Special Gazette May 2014
“Google defeated by Chinese author over Google Books” <ul style="list-style-type: none"><li>- Mena Lo, Jacqueline Ko</li></ul>	Intellectual Asset Management Magazine 7 May 2014
“How easily (difficult) can the special category of trademark be registered” <ul style="list-style-type: none"><li>- Annie Tsoi</li></ul>	Euromoney Trade Mark Expert Guide 2014 June 2014
“Guidelines for examining and ascertaining trademark rights in administrative cases” <ul style="list-style-type: none"><li>- Annie Tsoi, KY So</li></ul>	World Trademark Review Daily 8 July 2014
“New Guidelines for examining and ascertaining trademark rights in administrative cases” <ul style="list-style-type: none"><li>- Annie Tsoi, KY So</li></ul>	World Trademark Review LEXOLOGY 9 July 2014
	Intellectual Asset Management Magazine 9 July 2014
“Filing requirement for sound marks clarified” <ul style="list-style-type: none"><li>- Annie Tsoi</li></ul>	World Trademark Review LEXOLOGY 23 July 2014
	Intellectual Asset Management Magazine 23 July 2014
	World Trademark Review Daily 28 July 2014
“New regulations on well-known trademarks issued” <ul style="list-style-type: none"><li>- Annie Tsoi, Jean Wang</li></ul>	Intellectual Asset Management Magazine 20 August 2014
“Bill proposes to update copyright regime” <ul style="list-style-type: none"><li>- Mena Lo</li></ul>	Intellectual Asset Management Magazine 4 September 2014

## Hong Kong



Mena Lo

*“...strike a balance between the legitimate right and interest of copyright owners and other public interest”*

### Proposed update of Hong Kong's copyright regime

The Government of the Hong Kong SAR recently introduced the Copyright (Amendment) Bill 2014 into the Legislative Council for first and second reading. The Bill combines new proposals formulated following earlier public consultation on the treatment of parody together with legislative proposals under the former Copyright Bill of 2011, which for a number of reasons, failed to get to second reading in the Legislative Council in 2012.

Key proposals under the Bill include:

1. Recognising a technology-neutral exclusive right for copyright owners to communicate their works through any mode of electronic transmission and at the same time introducing corresponding criminal sanctions against unauthorised communication of copyright works to the public where the infringing act is conducted either in the course of trade or for profit or to an extent that prejudicially affects the copyright owner.
2. Expanding the scope of permitted acts to facilitate users to use copyright works under appropriate circumstances without obtaining authorisation from copyright for purposes of:
  - a. parody, satire, caricature and pastiche;
  - b. commenting on current events;
  - c. quotation;
  - d. caching data by online service providers;
  - e. media shifting of sound recordings;
  - f. giving educational instructions (especially for distance learning) and facilitating daily operations of libraries, archives and museums.
3. Establishing a safe harbour for online service providers to limit their potential liability for copyright infringement occurring on their service platforms provided that they meet certain conditions including taking reasonable steps to limit or stop the infringement when notified of an alleged infringement.

The Bill aims to enhance copyright protection in the digital environment and to strike a balance between the legitimate right and interest of copyright owners and other public interest such as reasonable use of copyright and freedom of expression.

The Government is keen to have the Bill passed into law as early as possible as a robust copyright regime is the cornerstone for the development of creative industries and will also contribute to the vibrancy of Hong Kong's economy.

## Exchange of information relating to taxes between Hong Kong and the United States

*“... the Commissioner of Inland Revenue of Hong Kong shall, upon the request of the US Secretary of the Treasury, provide information that is foreseeably relevant to the administration and enforcement of the internal laws of the US concerning federal taxes on income, federal taxes related to employment and self-employment, federal estate and gift taxes, and federal excise taxes...”*



Raymond Chan

On 25 March 2014, the Government of the Hong Kong Special Administrative Region and the Government of the United States of America signed an agreement for the exchange of information relating to taxes (the “Agreement”). The Agreement was the first Tax Information Exchange Agreement (“TIEA”) signed by Hong Kong ever since a legal framework enabling Hong Kong to enter into stand-alone TIEAs with other jurisdictions was put in place via the enactment of the Inland Revenue (Amendment) (No 2) Ordinance 2013 on 19 July 2013.

***“The Agreement was the first Tax Information Exchange Agreement ... signed by Hong Kong ever ...”***

Pursuant to the Agreement, the Commissioner of Inland Revenue of Hong Kong shall, upon the request of the US Secretary of the Treasury, provide information that is foreseeably relevant to the administration and enforcement of the internal laws of the US concerning federal taxes on income, federal taxes related to employment and self-employment, federal estate and gift taxes, and federal excise taxes. Insofar as the requested information is held by authorities in Hong Kong or is in the possession or control of persons who are within the geographical area within which the tax laws of Hong Kong apply, such information shall be disclosed to the US Secretary of the Treasury regardless of the residence or nationality of the person holding such information or to whom such information relates.

The Agreement aims to provide the necessary basis for the Inland Revenue Department of Hong Kong (“IRD”) to provide for exchange of information to the Internal Revenue Service of the US (“IRS”) upon requests made by them in relation to the information expected to be reported by financial institutions in Hong Kong pursuant to the US Foreign Account Tax Compliance Act (“FATCA”).

In general, FATCA is a US federal income tax law that imposes a 30% withholding tax on withholdable payments to non-US financial institutions (“FFIs”). FFIs may avoid FATCA withholding by entering into an agreement with the IRS, agreeing to implement account on-boarding procedures that are FATCA-compliant and to report information regarding the financial accounts (ie depository accounts, custodial accounts etc) of their US clients and certain individuals or corporate entities related to such US clients.

FATCA is expected to take effect on 1 July 2014. The specific details as to how participating financial institutions in Hong Kong may comply with FATCA requirements shall be delineated in an intergovernmental agreement (“IGA”) to be concluded by Hong Kong and the US in due course.

The IGA shall be underpinned by the Agreement. In order to give effect to the Agreement in preparation of the signing of the IGA, the Chief Executive in Council has recently made the Inland Revenue (Exchange of Information relating to Taxes) (United States of America) Order (the “Order”) pursuant to Section 49(1A) of the Inland Revenue Ordinance (Cap 112). The Order was published in the Gazette on 25 April 2014 and was subject to negative vetting at the Legislative Council. As no resolution was made by the Legislative Council to amend the Order, the Order came into operation on 20 June 2014. On the same day, Hong Kong sent a notification to the US confirming completion of the necessary internal procedures and as a result, the Agreement came into force on 20 June 2014 pursuant to Article 10 thereof. The Agreement shall have effect for all requests in respect of any period that starts on or after 20 June 2014, and for all charges to tax arising on or after 20 June 2014.

In view of Hong Kong’s growing commitment to promote and to assist other jurisdictions in the promotion of tax transparency, financial institutions in Hong Kong should evaluate the potential implications of FATCA on their business operations as well as their existing banking relationships with their US clients.

## Hong Kong Alert

### Stamp Duty (Amendment) (No 2) Ordinance 2014

The Stamp Duty (Amendment) (No 2) Ordinance 2014 was published in the gazette on 25 July 2014. It doubles the rates of ad valorem stamp duty (“AVD”) and imposes AVD on agreements for sale and purchase of non-residential properties. With retrospective effect from 23 February 2013, unless exemption is applicable, all agreements for sale and purchase of immovable properties and all conveyances on sale of immovable properties not preceded by agreements for sale and purchase will be chargeable with AVD at the new rates.

# China

## China's New Implementation Regulations of the Trade Mark Law

The new Trade Mark Law came into force in China on 1 May 2014 (an overview was provided in the September 2013 issue of our Newsletter).

Designed to offer details and clarifications of the new Law, a new set of Implementation Regulations was issued and took effect also on 1 May 2014.

Some of the highlights of the new Implementation Regulations are:-

### *Time limits in examination – calculation clarified*

- ✧ The time limits in examination are generally expedited under the new Trade Mark Law.
- ✧ The new Implementation Regulations clarify that the following periods are disregarded in calculating time limits:-
  - (1) the time required for serving documents by the Trade Mark Office or Trademark Review and Adjudication Board by way of gazette publication;
  - (2) the time required for supplementing evidence or documents by the parties, and any additional time required by the parties to file response;
  - (3) for applications filed on the same day, the time required for filing user evidence, negotiating or drawing lots;
  - (4) the time required for ascertaining priority rights;
  - (5) the time periods during which the proceedings are suspended upon the petitioner's request.

In light of the above, it is expected that the examination periods do in practice exceed 9 or 12 months as stipulated in the new Trade Mark Law.

### *Sound marks – filing requirements clarified*

- ✧ Sound marks are registrable under the new Trade Mark Law. The new Implementation Regulations set out the basic filing requirements:-
  - (1) the request for sound mark protection should be expressly indicated in the application;
  - (2) a sample of the sound mark is required;
  - (3) a description of how the sound mark is intended to be used; it should be represented by a stave or numbered musical notion, with any additional written description;



Howard Tsang



Annie Tsoi

***"The new Implementation Regulations offer details and clarifications of the new Chinese Trade Mark Law ..."***



- (4) if the description cannot be represented by a stave or numbered musical notion, a written description is mandatory.

### ***Trademark Infringement – factors and elements clarified***

- ✧ Under the new Trade Mark Law, deliberate facilitation of others' infringing acts with a view to aiding the infringements constitutes trademark infringement. It is clarified under the new Implementation Regulations that providing storage, transport, mail delivery, concealment, publication, business operator and online trading platforms qualifies as such facilitation. The latter 3 elements are newly introduced.
- ✧ Under the new Trade Mark Law, in cases of trademark infringement, the Administration for Industry and Commerce may issue different levels of fine against infringers depending on the amount of illegal revenue. The new Implementation Regulations outline the following factors when determining the amount of illegal revenue:-
  - (1) the sale price of the infringing goods;
  - (2) the listed price of the infringing goods not yet sold;
  - (3) the average actual sale price of the confirmed infringing goods;
  - (4) the average market price of the goods being infringed;
  - (5) the infringer's income arising from the infringement;
  - (6) any other factor that may reasonably affect the value of the infringing goods.
- ✧ Under the new Trade Mark Law, an infringer may be exempted from being fined if it is able to prove and identify the legitimate source of the infringing goods which are allegedly dealt with without knowledge of infringement. Under the new Implementation Regulations, the following qualify as such proof:-
  - (1) where there are delivery note(s) and payment receipt(s) from the supplier containing the supplier's company seal/signature, duly approved by that supplier or otherwise verified;
  - (2) where there is a signed supply and purchase agreement by the parties, duly verified and performed;
  - (3) where there are legitimate invoices the particulars of which correspond with the goods in question.

### ***Trademark agents and agencies – obligations clarified***

- ✧ Under the new Trade Mark Law, trademark agents and agencies will be sanctioned if found to be engaged in certain prohibited acts, one of which is disturbing the good order of the industry of trademark agency by improper means. Under the new Implementation Regulations, the following would



constitute such improper means:-

- (1) soliciting business by way of fraud, false advertising, misrepresentation or commercial bribery;
- (2) concealing facts or providing false evidence, coercing or inducing others to do these acts;
- (3) representing both parties in the same trademark case where there is a conflict.

✧ The new Implementation Regulations provide that, where a trademark agent or agency is sanctioned, the Trade Mark Office and Trademark Review and Adjudication Board may refuse to accept cases made by said agent or agency for a period between 6 months and indefinitely.

## Filing requirements for sound marks clarified

Sound marks are registrable in China pursuant to the new Trademark Law, effective 1 May 2014. The Trademark Implementation Regulations, effective on the same date, have clarified the filing requirements.

The applicant must:

- expressly indicate the request for sound mark protection in the application form;
- state how the sound mark is intended to be used;
- provide a sample of the sound mark:
  - the audio file should be in wav or mp3 format not exceeding 5 megabytes and stored on a CD; or
  - if the application is made by paper (not electronic) filing, the sample should be stored in a read-only CD;
- provide a description of the sound mark:
  - if the sound is musical, it should be represented by a stave or numbered musical notation, with any additional written description; or
  - if the sound is not musical, and thus cannot be represented by a stave or numbered musical notation, a written description of the sound mark is mandatory; and
- ensure that the description is consistent with the sample of the sound mark.

In contrast to Hong Kong, where any sample of a sound mark submitted to the Trademarks Registry is of only referential value when assessing registrability, applicants in China should bear in mind that such sample is mandatory for filing in China, and is as important as the graphical representation and written description.



Annie Tsoi

***“Applicants in China should bear in mind that the sample of a sound mark...is as important as the graphical representation and written description when filing.”***



Annie Tsoi



Jean Wang

***"It is now expressly stated... that recognition of a well-known mark is made on a case-by-case basis..."***

## New Regulations on Well-known Trade Marks issued in China

On 3 July 2014, the State Administration for Industry and Commerce ("SAIC") of China has issued a new set of Regulations for the Recognition and Protection of Well-known Trade Marks ("the 2014 Regulations").

The 2014 Regulations take effect in August 2014, superseding the 2003 version.

Comparing with the 2003 regulations:-

1. It is now expressly stated in the 2014 Regulations that recognition of a well-known mark is made on a case-by-case basis and upon a separate request in writing made with the following authorities:-
  - Trade Mark Office ("TMO"), Trademark Review and Adjudication Board
    - in trademark opposition or invalidation proceedings
  - Local Administration for Industry and Commerce ("AIC")
    - in an administrative action based on trade mark infringement, the municipal AIC (or authority above) will report the request through the provincial level AIC to the TMO for a decision to be made
2. While the scope of evidence required remains about the same, the 2014 Regulations have differentiated the extent of evidence of use required:-
  - if the mark seeking recognition as well-known is registered:-
    - the mark has been registered for over 3 years; or
    - the mark has continuously been used for over 5 years
  - if the mark seeking recognition as well-known is not registered:-
    - the mark has continuously been used for over 5 years

prior to the filing date of the disputed mark in opposition/invalidation proceedings, or the filing date of the request for recognition as well-known in administrative actions before the AIC.

3. Under the 2003 regulations, the owner of a well-known trademark based on such recognition is entitled to apply to the authorities for deregistering a registered company name containing a well-known trademark likely causing confusion. In line with the changes to the Implementation Regulations of the Trade Mark Law, this entitlement is no longer provided under the 2014 Regulations. The proper remedy for company name deregistration is in the

#### Anti-Unfair Competition Law.

4. Under the 2003 regulations, if a trademark owner's request for recognition as well-known is refused, it is prohibited from re-submitting that request within 12 months based on the same grounds and facts. This prohibition is no longer expressly provided under the 2014 Regulations. We will see how this could benefit trademark owners in practice, and certainly it is hoped that this would give trademark owners flexibility when seeking the recognition as well-known.

## Guidelines for examining and ascertaining trademark rights in administrative cases

The Beijing Higher People's Court has issued a set of guidelines for examining and ascertaining trademark rights in administrative appeals/proceedings filed with the court against decisions made by the Trademark Review and Adjudication Board (TRAB) under the new Trademark Law, effective 1 May 2014.



Annie Tsoi

The guidelines consist of 30 articles covering five major issues, namely:

1. the recognition and protection of well-known trademarks;
2. the recognition and protection of geographical indications;
3. the determination of consumer confusion;
4. the protection of prior rights, including rights in personal names and copyright; and
5. procedural matters.



K Y So

Some of the notable provisions are highlighted below:-

- In a dispute involving a third-party trademark, the relevant date for the petitioner to claim and prove the recognition of its prior mark as well known is the filing date of the disputed mark. Only when the petitioner's prior mark has been recognised as well known can the court consider other issues, such as whether the disputed mark constitutes an imitation of the prior mark, the extent of consumer confusion and the potential damage caused to the owner of the well-known mark.
- A petitioner cannot, based upon an earlier registered ordinary trademark, oppose or invalidate a geographic indication or collective trademark, and vice versa.

***"In order to claim that an unregistered mark is distinguishable from an earlier mark by virtue of prior use, such use must be continuous and precede the filing date of the earlier mark."***

- In order to claim that an unregistered mark is distinguishable from an earlier mark by virtue of prior use, such use must be continuous and precede the filing date of the earlier mark. Such use must be established by evidence. When considering the likelihood of confusion, the court must take into account the evidence submitted by the owner of the disputed mark and the owner of the earlier mark, as well as the subjective status of the owner of the disputed mark (eg, its good or bad faith). Market surveys (which must contain prescribed elements) are expressly allowed as evidence to show whether the marks concerned are distinguishable.
- Registration of the name of a public (political, religious or historical) figure may constitute “other negative influence” under the law and therefore be prohibited. The court would not consider that the registration of the name of a living natural person with damage to his/her personal name rights falls under the category of “other negative influence”.
- The issue of whether a device mark constitutes a copyright work shall be governed by the Chinese Copyright Law. The drawings, copyright registration certificate, commission agreements, copyright assignment agreements etc of the device can serve as preliminary evidence to determine the ownership of the copyright. Any copyright registration certificate obtained after the commencement of the opposition or invalidation proceedings is, *per se*, insufficient to prove copyright ownership.
- An opposed application may be refused, even though its owner is not liquidated but has only had its licence revoked, if the following conditions are met:
  1. the business licence of the owner of the opposed mark has been revoked for over three years at the time when the administrative decision is made;
  2. there is no evidence showing that the opposed mark has been assigned or licensed to others;
  3. the owner of the opposed mark has neither participated in the TRAB and subsequent proceedings, nor made any statement on its corporate status or the opposed mark; and
  4. the opposed mark is an imitation or copy of the earlier mark and the goods covered by the marks are related.

The new guidelines provide more certainty during trademark administrative proceedings. We expect these guidelines to have some persuasive (albeit not binding) value on the Chinese Trademark Office and the TRAB when adjudicating contentious trademark matters.

# China Alerts

## Control over foreign investments relaxed by NDRC

The requirement that all foreign investment projects should be subject to the examination and approval of the National Development and Reform Commission (“NDRC”) has changed since 17 June 2014.

According to the Administrative Measures for Approval and Record-filing of Foreign Investment Projects (the “New Measures”) newly promulgated by NDRC which came into effect on 17 June 2014, only specified foreign investment projects as listed in Article 4 of the New Measures are subject to the approval regime by NDRC or its delegates. The establishment of other types of foreign investment enterprises not listed in the said Article 4 will only need to attend to the filing of the appropriate records with the competent investment department of the local government.

This simplified regime is expected to attract more foreign investments in China.

## China endorsed establishment of specialized IP Courts

China’s Leading Group for Overall Reform led by President Xi Jinping passed the “Plan Concerning Establishment of Intellectual Property Courts” in their meeting held on 6 June 2014. President Xi regards the establishment of specialized IP courts as one of the basic and institutional measures of judicial reform in China. Passing of the Plan is an important step to implement the reforms on strengthening IP protection. It is expected that a number of major cities will soon establish their first IP courts.

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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Hong Kong  
Beijing

# Wilkinson & Grist



HK/China base with International Focus

Major areas of  
practice:

- Banking
- Bankruptcy & Insolvency
- China Trade
- Company & Commercial
- Conveyancing & Real Estate
- Dispute Resolution
- Employment
- Family
- Information Technology
- Intellectual Property
- Private Client
- Securities & Investment

- A long tradition of excellence for 130 years
- Our own IP agency in Beijing
- Hong Kong lawyers joining forces with PRC counsel, trade mark agents and patent agents.

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