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## NEW HONOURS

### asialaw PROFILES

#### The Guide to the leading regional and domestic law firms in Asia-Pacific

We are pleased to have been named as **Outstanding Law Firm** for Dispute Resolution, Intellectual Property and Restructuring & Insolvency in **Hong Kong** in this Asialaw Profiles 2020 Guide. We are also **Highly Recommended** for Banking & Finance and Construction and **Recommended** for Banking & Financial Services, Consumer Goods & Services, Real Estate, Technology & Telecommunications, Corporate/M&A Practice, Investment Funds and Private Client and named as **Other Notable Firms** for Labour & Employment.



We are pleased to be awarded **Hong Kong Firm of the Year** in Asialaw Regional Awards 2019. The awards recognised leading law firms across eight practice areas, seven industries and 25 jurisdictions across the region.



#### IP RANKINGS 2019 BEST LAW FIRMS FOR PATENTS, TRADEMARKS AND MORE

We are pleased to be identified as **Tier 1 Law Firm** for **Copyright/Trademarks** and **Top Tier Law Firm** for **Patents** in both the jurisdictions of China (International) and Hong Kong by Asian Legal Business (ALB) in its latest issue of IP Rankings 2019. ALB drew information from firm submissions, interviews, editorial resources and market suggestions to identify and rank the top firms for intellectual property in Asia.



## Asia IP 2019 Trademark Survey

We are ranked once again as **Tier 1 Law Firm** for **Hong Kong** in **Trademark Prosecution** and a **top tier firm** in **Trademark Contentious** work in this 2019 Trademark Survey – an in-focus guide from Asia IP published by Apex Asia that contains comprehensive rankings of the best IP firms and editorial depth coverage of key trademark developments across Asia.

**CHAMBERS  
GLOBAL**

**CHAMBERS  
ASIA  
PACIFIC**

We are pleased to be ranked as one of the leading International Firms – **China for Intellectual Property** in both Chambers Global 2019 and Chambers Asia Pacific 2019.

## Congratulations

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



Andrea Fong

**Andrea Fong**, Head of our Intellectual Property Practice Group, has been named in IP Stars 2019/20 for her outstanding practice in Trade Mark in Hong Kong. This MIP Handbook is the indispensable reference guide and directory for global in-house counsel since 1993.

asia<sup>law</sup>  
**PROFILES**

asia<sup>law</sup>  
**LEADING** LAWYERS

**The Guide to Asia-Pacific's Market-Leading Lawyers  
and Leading Lawyers**



Keith Ho



Andrea Fong



Raymond Chan



Mena Lo



Michael Ma



Annie Tsoi



Yvonne Chua

**Keith Ho**, Senior Partner and Head of our Dispute Resolution Practice Group, has been voted as **Elite Practitioner** in Hong Kong in Dispute Resolution. **Andrea Fong**, Head of our Intellectual Property Practice Group, and **Raymond Chan**, Head of our Corporate Practice Group, have received the same honour in Intellectual Property and Corporate and M&A respectively. **Mena Lo** and **Annie Tsoi**, Partners of our Intellectual Property Practice Group, are named as **Notable Practitioner** in Intellectual Property whereas **Michael Ma**, Partner of our Corporate Practice Group, is named as **Distinguished Practitioner** in Corporate and M&A. **Yvonne Chua**, Consultant of our Intellectual Property Practice Group, is endorsed as **Senior Statesman** in Intellectual Property.



### CHAMBERS GLOBAL

### CHAMBERS ASIA PACIFIC



Keith Ho



Andrea Fong



Yvonne Chua

In Chambers Global 2019 and Chambers Asia Pacific 2019, **Keith Ho**, Senior Partner and Head of our Dispute Resolution Practice Group, is ranked as **Leading Individual** for Dispute Resolution (International Firms) - China whereas **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.



### LITIGATION 2019 TRADE MARKS 2019 WOMEN IN BUSINESS LAW 2019



Keith Ho



Andrea Fong



Mena Lo



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 Guides published by Legal Media Group. **Andrea Fong** and **Mena Lo**, respectively Head and Partner of our Intellectual Property Practice Group, are both named in the areas of Trade Marks in Hong Kong and Women in Business Law.



*Who's Who Legal: Trademarks 2019*



Andrea Fong



Yvonne Chua

**Andrea Fong** and **Yvonne Chua**, respectively Head and Consultant of our Intellectual Property Practice Group, have again been recognized as the world's leading Trademark Lawyers for Hong Kong in Who's Who Legal: Trademarks 2019, a comprehensive guide to the leading practitioners in the field comprising over 1,000 lawyers across over 80 jurisdictions.

## Appointments

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

**Cleresa Wong**, Consultant, Real Estate Practice Group, was re-appointed by the Chief Executive as a member of the Telecommunications (Competition Provisions) Appeal Board for two years from 31 August 2019. The Appeal Board is an independent statutory body established under the Telecommunications Ordinance (Cap 106) to determine appeals against the opinions, determinations, directions or decisions of the Communications Authority in relation to the competition provisions of the Ordinance.

Telecommunications  
(Competition  
Provisions) Appeal  
Board

### INTA Non-Traditional Marks Committee

**Annie Tsoi**, Partner, Intellectual Property Practice Group, has been re-appointed to serve on the Non-Traditional Marks Committee of the International Trademark Association (INTA) for a 2-year term starting 1 January 2020. The Committee develops and advocates the Association's policy regarding the balanced protection of non-traditional trademarks such as sound, colour, and trade dress.

## About Us

### Licensing Executives Society International (LESI)

**Yvonne Chua**, Consultant of our Intellectual Property Practice Group, has been awarded the Gold Medal by Licensing Executives Society International (LESI) with the presentation held in May at the 2019 LESI Annual Conference in Japan. The Gold Medal is the highest and an exceptional award given by LESI for awardee who has rendered outstanding contribution to LESI with an enduring impact. Yvonne is privileged and honoured to have served in various leading roles in LESI for over 15 years including being the 41<sup>st</sup> President of LESI during the 2013/2014 term.



*(From right to left) Our Yvonne Chua with Mr Francois Painchaud, then President of LESI*



Our Gelato Day returned for a third year on a Friday afternoon in August. It was a refreshing treat to all staff of the Firm amidst the long summer months.

W&G's  
Gelato Day



## Talks & Seminars

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

**Annie Tsoi**, Partner of Intellectual Property Practice Group, upon invitation by the HKIPD again gave a talk on “IP Management and Protection in the Mainland 內地的知識產權管理與保護” as part of the IP Manager Scheme organized by the HKIPD in Hong Kong on 18 June 2019. There were over 150 attendees being IP managers of local SMEs.

Hong Kong  
Intellectual  
Property  
Department  
(HKIPD)

## Conferences

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

FICPI Open Forum

Vienna, Austria, 9 – 12 October 2019

APAA Council Meeting

Taipei, Taiwan, 8 – 12 November 2019

## Hong Kong



Raymond Chan

### New disclosure requirements of non-Hong Kong companies

The Non-Hong Kong Companies (Disclosure of Company Name, Place of Incorporation and Members' Limited Liability) Regulation (Cap 622M) (the "**Regulation**") came into operation on 1 August 2019.

From that date onwards, all companies incorporated outside Hong Kong that are registered under Part 16 of the Hong Kong Companies Ordinance (including all Hong Kong listed companies incorporated outside Hong Kong) must state its (i) name; (ii) place of incorporation; and (iii) where its members have limited liability, a statement of that fact in every "communication document" and "transaction instrument" of the company in Hong Kong. Such information must also be displayed at every "business venue".

Failure to comply with the requirements relating to the display and disclosure of the aforesaid information constitutes an offence. The company, every responsible person of the company, and every agent of the company who authorizes or permits the contravention is liable to a fine at level 3.

The Regulation can be viewed at  
<https://www.gld.gov.hk/egazette/pdf/20192311/es22019231131.pdf>.

## China



Annie Tsoi

### The Cyberspace Administration of China (CAC) issued draft measures to strengthen personal data protection

To provide supplementary guidance on the PRC Cybersecurity Law, the Cyberspace Administration of China ("CAC") has published two draft measures for public consultation this summer. Both drafts seek to clarify and lay out the duties of a network operator (which is widely defined to include the "owner or administrator of a network or a network service provider"), in respect of the collection, use and management of personal data.

**I. Draft Measures on Data Security Management 《數據安全管理辦法(徵求意見稿)》**

These Measures primarily regulate three major data activities, namely (1) data collection, (2) data processing and use and (3) data security supervision and management. They govern not only personal data but also data that have an impact on China's national security, economic security, social stability, or public health and security.

Under these Draft Measures, a network operator is required to (among others):-

1. devise clear data collection policies to include certain prescribed information and to disclose and make available such policies to data subjects;
2. record its data collection policies with the local CAC if it collects important data or sensitive personal data for business purposes;
3. display prominently “targeted advertisement” when sending promotional messages to data subjects, and provide data subjects with an option to opt-out of such messages;
4. obtain necessary prior approval from the respective industry regulator for any publication or export of important data upon assessing associated security risks;
5. be jointly liable (in full or in part) for damages as a result of data breach caused by third-party applications unless the network operator can prove it has no fault in such data breach.

**II. Draft Measures on Security Assessment of Cross-border Transfer of Personal Data 《個人信息出境安全評估辦法(徵求意見稿)》**

These Measures aim at regulating the transfer of personal data collected by network operators. Transfers which are assessed to have an impact on China's national security and public interest are prohibited.

Security assessment has been mandatory only when the transferred data reach a specific threshold in terms of quantity and content etc. Under these Draft Measures, before any personal data is transferred, a network operator is required to (among others):-

1. conduct security self-assessment and file such assessment report with local CAC - such security assessment must be conducted on each foreign data recipient and re-submitted at least every two years;
2. enter into contracts with foreign data recipients listing the purpose and particulars etc of the data transfer, and include such contracts in the assessment report above;
3. maintain a record of all transfer of personal data for at least 5 years;
4. comply (in the case of foreign entities collecting personal data online) with the duties and obligations under these Measures through their legal representatives or institutions in China.

The consultation of both draft measures has just ended. We anticipate that most if not all of the changes in the drafts will be confirmed since they are in line with China's recent efforts in strengthening its data protection regime.



Annie Tsoi

## Draft provisions issued to regulate bad faith trademark applications

As discussed in the May 2019 issue of our Newsletter, certain amendments will be made to the PRC Trade Mark Law which will take effect on 1 November 2019. To facilitate the implementation of those amendments, the State Administration for Market Regulation published a draft set of Provisions on Regulating Trademark Registration Behavior 《關於規範商標申請註冊行為的若干規定(徵求意見稿)》 (the “**Draft Provisions**”) for public comments on 30 August 2019.

Under the to-be amended Article 4 of the Trade Mark Law, applications that are filed in bad faith *without intention to use* will be refused. As provided in the Draft Provisions, the authorities may take into account the following factors when determining whether the said Article 4 is violated:-

1. the number of trademark applications, their designated class(es) of goods/services and any trademark transaction etc pursued by the applicant and/or associated entity or person;
2. the industry in which the applicant operates and its business condition;

3. any finding of bad faith or infringing behavior (arising from the inappropriate trademark use) of the applicant as recognized in administrative decision/ruling and/or judicial judgment that have become effective;
4. the trademark applied-for is identical or similar to a third-party mark that has acquired a certain level of reputation;
5. the trademark applied-for is identical or similar to a famous person's name, trade name, company's abbreviated name and other business signs etc;
6. the trademark applied-for is identical or similar to the name of a well-known place or tourist attraction etc; and
7. any other factor considered relevant by the authorities.

The local Administration for Market Regulation is empowered to issue administrative penalties to (local) applicants which violate the said Article 4. Information concerning such administrative penalties will become available for public inspection through the National Enterprise Credit Information Publicity System (國家企業信用信息公示系統).

The consultation ended on 8 September 2019. It is expected that the Draft Provisions will be adopted and confirmed to facilitate the implementation of the approved amendments of the Trade Mark Law.

## China Alerts

### 2-year time-bar increased to 3 years under CND RP

As from 18 June 2019, the time bar to file domain name dispute proceedings under the CNNIC ccTLD Dispute Resolution Policy (CND RP) (which governs all .CN domain names) has been revised from 2 years to 3 years. The general wording of the amended CND RP suggests that the new 3-year time bar applies to .CN domain names registered before and after the amendments came into effect.



### Reduction of PRC trademark official fees

Effective from 1 July 2019, the China National Intellectual Property Administration (CNIPA) has adjusted the official fees for certain trademark matters as below:-

- The official fee for trademark renewal is reduced from RMB1,000 to RMB500;
- The official fees for application for change of owner's name/address and change of agent are reduced from RMB250 to RMB150, while official fees are now exempted when applications are filed electronically; and
- For e-filing and electronic communication of certain trademark matters including renewal of trademark registration, recordal of licence and assignment, application for certified copy of international registration and re-issuance of national registration certificate, the official fees are reduced by 10%.

### Newly Amended Guidelines for Patent Examination

The China National Intellectual Property Administration (CNIPA) in mid-September 2019 published amendments to the Guidelines for Patent Examination to improve the efficiency and quality of patent examination.

The amendments include detailing the requirements on design patent applications concerning graphical user interfaces, introduction of the deferral of examination policy, clarification of the priority examination policy, summarization of basic strategies and steps of patent search, relaxation of the restrictions on the scope of allowable subject matters relating to human embryonic stem cells, and slight adjustments on inventive step, invalidation, further divisional application, telephone interview, transfer of patent rights, etc.

These amended Guidelines will take effect on 1 November 2019.

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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