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Wilkinson & Grist
Solicitors & Notaries

Newsletter

SEPT 20

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NEW HONOURS

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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 2021 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 and Private Client and named as **Other Notable Firms** for Labour & Employment.



Asia IP 2020 Trademark Survey Asia IP 2020 Patent Survey Asia IP 2020 Copyright Survey

We are ranked once again as **Tier 1 Law Firm** for Hong Kong in **Trademark Prosecution** and **Top Tier Firm** in **Trademark Contentious, Patent Contentious and Prosecution** and **Copyright** work in this 2020 Trademark, Patent and Copyright 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.



IP RANKINGS 2020

ASIA'S BEST FIRMS FOR INTELLECTUAL PROPERTY

We are pleased to be identified as **Tier 1 Law Firm** for **Copyright/Trademarks** and **Top Tier Law Firm** for **Patents** in Hong Kong by Asian Legal Business (ALB) in its latest issue of IP Rankings 2020. ALB drew information from firm submissions, interviews, editorial resources and market suggestions to identify and rank the top firms for intellectual property in Asia.



PATENT SURVEY 2020

COPYRIGHT SURVEY 2020

For consecutive years, we have been recognized as a **Top Tier Law Firm** for **Patent Contentious and Prosecution** and **Copyright & related rights** work in Hong Kong in this annual world survey which provides in depth analysis and rankings of 1,900 IP firms and 5,200 practitioners globally for trade mark, patent and copyright works.



The World's Leading Patent Professionals 2020

We are pleased to be named as **Recommended Law Firm** in Hong Kong for our Patent practice on **Patent Prosecution** in the IAM Patent 1000, a guide to leading private practice patent professionals and firms in the world's key jurisdictions.

Congratulations

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

asialaw PROFILES

asialaw LEADING LAWYERS

The Guide to Asia-Pacific's Market-Leading Lawyers and Leading Lawyers – 2021 Edition



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.



Andrea Fong

Andrea Fong, Head of our Intellectual Property Practice Group, has been named in Who's Who Legal: Thought Leaders – Hong Kong 2020, a guide which brings together the region's foremost practitioners across all of the practice areas, giving readers access to their insight, expertise and wisdom.

Appointment

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

Solicitors
Disciplinary
Tribunal Panel

Ivan Chu, Partner, Dispute Resolution Practice Group, has been re-appointed by the Chief Justice as a practising solicitor member of the Solicitors Disciplinary Tribunal Panel for a term of three years with effect from 4 October 2020.

Hong Kong SAR

Law of the People's Republic of China on Safeguarding National Security in the Hong Kong Special Administrative Region

The Law of the People's Republic of China on Safeguarding National Security in the Hong Kong Special Administrative Region (the “**National Security Law (HKSAR)**”), being a piece of legislation of the People's Republic of China promulgated by and added to the list of national laws in Annex III to the Basic Law of the Hong Kong Special Administrative Region (“**Hong Kong**”) by decision of the Standing Committee of the National People's Congress of the PRC on 30 June 2020, came into force in Hong Kong at 11:00 pm on the same day by notice of the Chief Executive of Hong Kong on the gazette.

Application and offences

The National Security Law (HKSAR) applies to:-

1. any person committing any offence thereunder in the territory of Hong Kong (including any vessels and aircrafts registered in Hong Kong). An offence shall be deemed to have been committed in Hong Kong territory if any act or consequence of the offence occurs in Hong Kong territory (*Article 36*);
2. any permanent resident of Hong Kong or any incorporated or unincorporated body established in Hong Kong, who or which commits any offence thereunder outside the Hong Kong territory (*Article 37*); and
3. any person not being a permanent resident of Hong Kong committing any offence against Hong Kong outside the Hong Kong territory (*Article 38*),

which offences are committed after the promulgation of the National Security Law (HKSAR) (*Article 39*).



Raymond Chan



Jack Kwan

The National Security Law (HKSAR) imposes four broad categories of offences (the “**Offences**”) against national security in relation to Hong Kong, namely, secession (*Articles 20 to 21*), subversion (*Articles 22 to 23*), terrorist activities (*Articles 24 to 27*) and collusion with foreign country or institution, organisation or individuals outside of the PRC to endanger national security (*Article 29*).

Individuals may be fined and sentenced to imprisonment for committing any of the Offences. Incorporated or unincorporated bodies committing any of the Offences may be fined, may have their operation suspended, their licence or permit of operation of business revoked and/or unlawful proceeds, funds or apparatus used or intended to be used in the commission of the Offences confiscated and forfeited (*Articles 31 and 32*).

New institutions

A Committee for Safeguarding the National Security of Hong Kong Special Administrative Region (the “**Local Committee**”) and new divisions under the Hong Kong Police Force (“**HKPF NSD**”) and the Department of Justice of Hong Kong have been established in accordance with Articles 12, 16 and 18 of the National Security Law (HKSAR) respectively. Pursuant to Article 43 of the National Security Law (HKSAR), HKPF NSD and other Hong Kong law enforcement agencies are authorised under the supervision of the Local Committee to take the following measures, in addition to the law enforcement measures available to them prior to the application of the National Security Law (HKSAR) in Hong Kong, when handling cases concerning offence against national security:-

1. search of premises, vehicles, vessels, aircraft and other relevant places and electronic devices that may contain evidence of the offence;
2. ordering any person suspected of having committed the offence to surrender travel documents, or prohibiting the person concerned from leaving Hong Kong;
3. freezing of, applying for restraint order, charging order and confiscation order in respect of, and forfeiture of property used or intended to be used for the commission of the offence, proceeds of crime, or other property relating to the commission of the offence;

4. requiring a person who published information or the relevant service provider to delete the information or provide assistance;
5. requiring a political organization of a foreign country or outside the mainland of the PRC, Hong Kong and Macau of the PRC, or an agent of authorities or a political organization of a foreign country or outside the mainland of the PRC, Hong Kong and Macau of the PRC, to provide information;
6. upon approval of the Chief Executive of Hong Kong, carrying out interception of communications and conducting covert surveillance on a person who is suspected, on reasonable grounds, of having involved in the commission of the offence; and
7. requiring a person, who is suspected, on reasonable grounds, of having in possession information or material relevant to investigation, to answer questions and furnish such information or produce such material,

and the Local Committee has made the Implementation Rules for Article 43 of the National Security Law (HKSAR) and relevant principles and guidelines for this purpose.

The Office for Safeguarding National Security of the Central People's Government of the PRC in Hong Kong (the "**National Security Office**") has been established in accordance with Article 48 of the National Security Law (HKSAR), which, among other matters, shall, only in circumstances prescribed under Article 55 of the National Security Law (HKSAR) and upon approval of the Central People's Government of the PRC on application of the Hong Kong government or the National Security Office, exercise jurisdiction over cases concerning offence against national security pursuant to Article 55 of the National Security Law (HKSAR), and such cases shall be handled by the National Security Office and other authorities of the mainland of the PRC. All the other cases will be handled within the jurisdiction of Hong Kong government. The acts in performing the duties of the National Security Office and its officers under the National Security Law (HKSAR) shall not be subject to the jurisdiction of Hong Kong (*Article 60*).

There are currently cases concerning the Offences being investigated, prosecuted and tried in Hong Kong. The full effect of the National Security Law (HKSAR) on the society of Hong Kong remains to be observed as the National Security Law (HKSAR) is implemented over the course of time.



Raymond Chan

SFC concludes consultation on changes to the OFC regime

The Securities and Futures Commission (the “SFC”) released consultation conclusions on proposed enhancements to the open-ended fund companies (“OFC”) regime on 2 September 2020.

The major changes to the OFC regime will include:-

- (1) a further relaxation of the investment scope of private OFCs, which would allow OFCs to invest in assets other than securities, futures contracts and over-the-counter (OTC) derivatives;
- (2) allowing licensed or registered securities brokers to act as custodians for private OFCs, provided that they meet certain requirements as set out in the revised Code on Open-ended Fund Companies (“OFC Code”);
- (3) requiring investment managers and custodians to have sufficient expertise and experience in managing and safekeeping asset classes in which an OFC invests (with corresponding enhancement on risk disclosure in the offering documents) and to keep proper records; and
- (4) the introduction of a statutory mechanism for the re-domiciliation of overseas corporate funds to Hong Kong as an OFC.

The removal of the investment restrictions and the expansion of the custodian eligibility requirements for private OFCs will be effective from gazettal of the revised OFC Code, while the re-domiciliation mechanism will take effect upon completion of the corresponding legislative process.



Michael Ma

Introduction of a limited partnership fund regime

The Limited Partnership Fund Ordinance (Cap 637) (“the Ordinance”), as announced by the Companies Registry seeking to establish a new limited partnership fund regime to enable private funds to be registered in the form of limited partnerships in Hong Kong, came into operation on 31 August 2020 (Companies Registry External Circular No 2 / 2020).

The limited partnership fund (“LPF”) regime is to attract private investment funds (including private equity and venture capital funds) so as to facilitate the channelling of capital into corporates, especially start-ups in the innovation and technology field in the Greater Bay Area. Generally, LPF is a fund that is structured in the form of a limited partnership which will be used for the purpose of managing investments for the benefit of its investors. There must be one general partner who has unlimited liability and also at least one limited partner with limited liability.

The application for registering a LPF must be submitted to the Registrar of Companies by a registered Hong Kong law firm or a solicitor admitted to practise Hong Kong law. It will take effect upon the issuance of a certificate of registration by the Registrar. The general partner must also apply for a business registration certificate under the Business Registration Ordinance (Cap 310).

As a matter of continuing compliance, a notification of change upon any change in the particulars relating to a LPF is required to be filed with the Registrar within the specified period of time. In addition, the general partner must file an annual return within 42 days after each anniversary.

A fund set up in the form of a limited partnership registered under the Limited Partnerships Ordinance (Cap 37) may also be registered as a LPF if it meets the eligibility requirements under the Ordinance. Upon migration to the new LPF regime, the fund would preserve its identity and continuity.

Search on LPF information could be done via a register of LPFs maintained by the Registrar. The LPF Register will be available for public inspection.

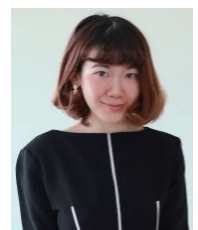
Going paperless: introduction to the Court Proceedings (Electronic Technology) Bill

Every aspect of what used to be usual and normal has inevitably experienced the impact of the COVID-19 outbreak. Court proceedings have been affected to an unprecedented extent, with hearings re-scheduled and filing of documents delayed.

Whilst measures have been taken by the Hong Kong Courts to resume court services without compromising health and safety, the Courts have in fact long been considering to expand the scope of hearings by hearing submissions by telephone, video-conferencing or similar means of visual aid and generally making use of technology, as part of the implementation of the Judiciary’s Information Technology Strategy Plan (ITSP).



Paul Liu



Iris Chan

On 27 December 2019, the Government published in the Gazette the Court Proceedings (Electronic Technology) Bill (the “**Bill**”) which seeks to provide an electronic option for handling court-related documents. The Bill was passed on 17 July 2020 in the Legislative Council.

Key proposals of the Bill include:-

- (a) electronic filing or sending of documents to the court will generally be allowed;
- (b) documents between parties may be served electronically if there is mutual consent to serve and accept documents by electronic means;
- (c) signatures other than traditional manual signatures, such as digital signature and electronic signature, for court-related documents will generally be allowed; and
- (d) provide proper legal status for printouts/copies of printouts for documents issued by the court.

The Bill also provides that the Chief Justice of the Court of Final Appeal may specify by subsidiary legislation or include in practice directions the detailed court and operational procedures for the use of electronic mode, so as to enable the Judiciary to make timely refinements to the detailed procedures and practices to take into account of the rapid technological developments.

Under the ITSP, an integrated court case management system (iCMS) (an IT system), is being implemented to streamline and standardise electronic court processes across different levels of courts as appropriate.

In particular, to enhance access to justice, electronic services and facilities of various types will be introduced as appropriate as an additional option to the existing channels, to be used on a voluntary basis. While court users can choose to continue to interact with the Judiciary and the other parties concerned by conventional means, the Judiciary will encourage court users to transact court businesses by electronic means.

The ITSP will be implemented in two phases. The first phase will consist of two stages for better management. In Stage 1 of Phase I, the iCMS will be implemented in the District Court and the Summons Courts of the Magistrates’ Courts. Development of the iCMS in these courts is at an advanced stage.

In Stage 2 of Phase I, the iCMS is expected to be extended to the Court of Final Appeal, the High Court, the remaining part of the Magistrates’ Courts and the Small Claims Tribunal. For the remaining courts and tribunals, the iCMS is planned to be implemented under Phase II.

Given that the proposed framework of e-filing is entirely voluntary, it remains to be seen how quickly stakeholders may adopt the same during the initial stages. It is hoped that the new legislation (and ancillary subsidiary legislation and practice directions) will assist in bringing Hong Kong in line with standards in other common law jurisdictions, and in encouraging litigants to go paperless in the long run and ultimately improving access to justice and efficiency of litigation as a whole.

Trade Marks (Amendment) Ordinance 2020

As mentioned in our newsletter of May 2019, the Trade Marks (Amendment) Bill 2019 (the “**Bill**”) was gazetted on 8 February 2019 seeking to amend the Trade Marks Ordinance (Cap 559) to apply the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the “**Madrid Protocol**”) in Hong Kong. The Bill was passed on 10 June 2020 and the Trade Marks (Amendment) Ordinance 2020 (the “**Amendment Ordinance**”) was then gazetted and took effect on 19 June 2020 providing a basis in Hong Kong Law for the application of the Madrid Protocol.

The Government of the Hong Kong Special Administrative Region is carrying out relevant preparatory work for the implementation of the Madrid Protocol, including preparing subsidiary legislation to provide for the relevant procedural details, setting up a dedicated information technology system, etc. Hopefully, the Madrid Protocol will be implemented in Hong Kong in 2022-2023 at the earliest.

The Amendment Ordinance also confers powers on the Customs and Excise Department to enforce the criminal provisions under the Trade Marks Ordinance (Cap 559), to include the powers to (i) enter and search any place, (ii) stop, board and search any conveyance that contains anything which appears to be specified evidence, (iii) make any inquiry reasonably required for the investigation, (iv) inspect, examine, search, seize, remove or detain anything that appears to be specified evidence, etc.

Apart from the above major amendments, the Amendment Ordinance also makes technical amendments to some existing provisions of the Trade Marks Ordinance for enhancing Hong Kong's trade mark application and registration system. Some of the major technical amendments are:-



Annie Tsoi



Jessica Leung

Filing a trade mark application

The applicant is required to identify its type (being an individual, incorporated or unincorporated entity) in the form, and state its country of incorporation if it is an incorporated entity. An applicant incorporated in the United States is further required to identify the state in which it was incorporated in the application form.

If the applicant being a corporation fails to indicate its place of incorporation in the application form, the applicant has to provide this information within two months after the Registry's notice of deficiency. Otherwise, the application in question will be treated as abandoned.

Please however note that the Registrar of Trade Marks will not verify the information provided before entering the same in the register.

Further, a trade mark application will not be accorded a filing date until the application fee is paid in full. If the applicant fails to pay the application fee within two months of the Registry's notice of deficiency, the application will be deemed never to have been made.

Amendment of a trade mark application

It is clarified in the Amendment Ordinance that in order to add a prior registered trade mark to a subsequent trade mark in the name of the same owner, the specification of goods/services of the prior registered mark must be identical to or wide enough to cover the specification of goods/services of the subsequent trade mark.

Before this amendment, the relevant provision stipulated that the specification of goods/services of the prior registered trade mark should be identical or similar to the specification of goods/services covered by the subsequent trade mark which gave rise to a misunderstanding that a prior registered mark covering only similar goods/services could be added to a subsequent trade mark. This amendment has made clear that it is not permissible to do so.

Furthermore, the Amendment Ordinance provides that certain registered particulars of the prior registered trade mark (eg a statement claiming a colour or 3-dimensional shape as an element of the trade mark, and other disclaimer, limitation, condition, etc) would be added to the amended application but only to the extent of being applicable to the prior registered trade mark being added.

Hong Kong SAR Alert

Companies Registry's fee waiver and reduction

As one of the HKSAR Government's relief measures to support the economy during the COVID-19 pandemic and to encourage the use of electronic services of the Companies Registry, the Registry recently announces that the Companies (Fees) (Amendment) Regulation 2020 will come into operation on 1 October 2020 effecting the following:-

1. ***Waiver of registration fees for annual returns for two years*** – Registration fees for annual returns delivered to the Registry on time and within the concession period from 1 October 2020 to 30 September 2022 (both dates inclusive) are waived. However, in cases of late delivery, even if the annual returns are delivered within the concession period, companies are still required to pay the statutory higher registration fees calculated based on the date of delivery.
2. ***Reduction of fees payable for the incorporation of companies and registration of non-Hong Kong companies*** – The fees (excluding Business Registration Fee and Levy) payable for applications for the incorporation of companies and registration of non-Hong Kong companies delivered in electronic form through the e-Registry will be reduced by 10%.

China

The first Civil Code passed in the PRC

The Civil Code of the PRC (draft) was first published in August 2018, and two years later, the Civil Code of the PRC (中華人民共和國民法典) was passed by the National People's Congress on 28 May 2020.

This is the only legislation officially named a “code” in the PRC. The Civil Code codifies the fundamental rules of law on personal rights and property rights. It consists of 1,260 articles under 7 parts, namely, (1) general principles (總則), (2) property laws (物權), (3) contracts (合同), (4) personality rights (人格權), (5) marriage and family (婚姻家庭), (6) inheritance (繼承) and (7) tort liabilities (侵權責任).

The part on contracts contains more than 500 articles and is the largest part. There will be 19 typical types of contracts, amongst which guarantee contract, factoring contract, property service contract and partnership contract are the four new additions. There is also a new part on personality rights, which elaborates, among other issues, on the protection of privacy right and personal information.



Raymond Chan

The Civil Code will take effect on 1 January 2021.

When the Code takes effect, many laws and regulations which have been very important for many years, such as the Marriage Law of the PRC, the Law of Succession of the PRC, the General Principles of the Civil Law of the PRC, the Adoption Law of the PRC, the Security Law of the PRC, the Contract Law of the PRC, the Real Property Rights Law of the PRC, the Tort Law of the PRC and the General Rules of the Civil Law of the PRC will be simultaneously repealed.



Annie Tsoi

Provisions on intellectual property law in the first-ever Civil Code of the PRC

Despite its extensive coverage, the Civil Code of the PRC does not provide for a specific section on intellectual property law. Various articles relating to intellectual property are covered under different parts in the Code, to name a few:-

1. Article 123 of the Code provides that civil entities enjoy intellectual property rights in accordance with the law in the following aspects:- (1) works (作品); (2) inventions (發明), utility models (實用新型), designs (外觀設計); (3) trademarks (商標); (4) geographical indications (地理標誌); (5) trade secrets (商業秘密); (6) layout designs of integrated circuits (集成電路布圖設計); (7) new varieties of plants (植物新品種); and (8) other objects specified by laws (法律規定的其他客體).
2. Articles 843 to 887 of the Code provide for rules governing technology contracts (技術合同) which may involve transfer and licensing of patents, and the rights to apply for patents.
3. Article 1185 of the Code provides that intellectual property right proprietors are entitled to claim corresponding punitive damages (懲罰性賠償) in cases of serious and intentional infringement of intellectual property rights.

In the context of intellectual property law, punitive damages are now statutorily available in trademark cases and unfair competition cases only. While punitive damages are included in the latest draft amendments to the PRC Copyright Law and the PRC Patent Law, these amendments are pending approval by the National People's Congress. Hence, since 1 January 2021, article 1185 of the Code arguably provides for a legal basis for claims of punitive damages in copyright and patent cases, pending the forthcoming legislative reform in these areas.

This article may also be read together with Articles 1.15 to 1.18 of the Guiding Opinion on Assessment of Compensation for Damages for Cases of Infringement of Intellectual Property Rights and Unfair Competition and Standard of Assessment of Statutory Compensation issued by the Higher People's Court of Beijing on 21 April 2020, which set out a non-exhaustive list of instances where pre-requisites to punitive damages would be found to exist. Please refer to our May 2020 newsletter for details about this Guiding Opinion.

It is expected that the introduction of the Civil Code, as well as the recent legislative reforms in the areas of trademark, unfair competition, copyright and patents, would further improve the intellectual property protection regime in the PRC.

China Alerts

Second draft amendments to the PRC Patent Law

On 3 July 2020, the National People's Congress published the second draft amendments to the Patent Law of the People's Republic of China 《專利法修正案(草案二次審議稿)》 for public consultation which ended on 16 August 2020. Notable amendments include:-

1. ***Expanded scope of design patent protection*** – Apart from extending the term of a design patent to 15 years, the second draft specifies that partial design can be the subject matter for a design patent.
2. ***Compensation for invention and pharmaceutical patent terms*** – The patent holder may apply for an extension of patent term to compensate for unreasonable delays not attributable to the applicant in granting the patent.
3. ***Patent linkage system for 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 patent holder or 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. ***Enhanced protection against patent infringement*** – The maximum statutory damage for patent infringement is increased to RMB 5 million, and punitive damage is proposed. The limitation period for instituting legal proceedings concerning patent infringement 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.

CNIPA scaled up online trademark filing services

Following the introduction of electronic filing of trade mark matters (of a limited scale) in 2019, on 20 May 2020 the China National Intellectual Property Administration (“CNIPA”) announced that the online filing system would since then accept trade mark applications to be e-filed with non-standard specifications, indicating that e-filing became fully available for new trade mark applications. “Non-standard specifications” refer to items which are not identified in the Classification of Similar Goods and Services (類似商品和服務區分表) issued by the CNIPA, but they are still required to be specific, accurate and conform to the principles of classification of goods and services.

Starting from 28 June 2020, e-filing became available also to applications for re-examination of refused trade mark applications.

E-filing offers several key advantages:-

- The official fees for trademark matters that are e-filed are 10% lower than those filed by paper, as discussed in the September 2019 issue of our Newsletter.
- Since a document issued/served electronically is deemed received 15 days from the date it is uploaded in the online system, applicants effectively have this extra period of time (ie 15 days on top of the usual response period) to consider any official notice of formality or substantive objection raised by the CNIPA.
- Since the online filing system can perform mechanical checks automatically for eg typographical errors, formality objections in this regard can be avoided.

The expansion of electronic filing services improves the efficiency of examination by the CNIPA in general. The average time for examination of a trade mark application was shortened to 4.5 months in 2019, and the CNIPA pledged in reducing it further to less than 4 months. The average time for re-examination of a refused application has also been shortened to 6.5 months.

It is expected that the CNIPA will continue to expand the e-filing services. In particular, the CNIPA announced in July 2020 that applications for trade mark oppositions, invalidations and non-use cancellations would become available for e-filing by the end of 2020.

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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