

Consultation Relating to the Proposed Application of Madrid Protocol to Hong Kong

Views of Hong Kong Bar Association

1. The Hong Kong Bar Association (“**HKBA**”) has been invited to render its views on the Consultation Paper relating to the proposed application of the Madrid Protocol to Hong Kong (the “**Consultation Paper**”) published by the Intellectual Property Department of the Commerce and Economic Development Bureau.
2. As noted in Chapter 3 of the Consultation Paper, the application of the Madrid Protocol to Hong Kong would provide a more efficient and cost-effective trade mark registration option for Hong Kong trade mark owners who wish to seek protection in multiple countries. Additionally, it will also become more convenient for overseas companies with an interest in the Hong Kong market to protect their trade marks in Hong Kong by requesting territorial extension of their international trade mark registration to Hong Kong through the Madrid Protocol. The application of the Madrid Protocol also appears to be the international trend.
3. Having considered the Consultation Paper, the HKBA agrees with the view therein expressed that it is in the overall interest of Hong Kong to implement the Madrid Protocol.
4. That said, it is China, not the Hong Kong SAR, which is presently a “contracting state” to the Madrid Protocol. However, the Hong Kong SAR and China have different legal systems, different trade mark laws and separate trade marks registries. Accordingly, in the application of the Madrid Protocol to Hong Kong, care must be taken to ensure that such differences are appropriately addressed and applications for marks intended to be registered in Hong Kong should separately designate Hong Kong (and not be considered to be covered by a designation of China) so that substantive examination of the trade marks applied for will be conducted by the Hong Kong Trade Marks Registry.

Dated: 26th February 2015