

# Table of Contents

<i>Preface</i> .....	v
<i>Table of Cases</i> .....	xv
<i>Table of Statutes</i> .....	xxxvii

<b>Introduction</b> .....	1
Intellectual Property .....	1
The Subject Matter of Intellectual Property: Information as a Product of the Intellect.....	2
Property Rights in Information .....	3
The Doctrinal Basis of the Nature and Function of Property in Intangibles.....	3
Innovation, Originality, Creation and Copying.....	4
Balancing Competing Interests .....	4
Pirates and Counterfeiters — It's Not That Simple .....	5
What is Honest Copying? .....	6
What Should Intellectual Property Protect?.....	6
An Outline of a Case for a General Remedy for Misappropriation .....	9
<b>1 Common Law Trade Marks — The Action for     Passing Off</b> .....	17
Historical Development of the Action.....	18
Plaintiff's Reputation or Goodwill.....	20
The plaintiff's badge of recognition with the relevant public .....	23
Names and logos .....	23
Utilitarian get-up.....	25
Non-utilitarian get-up .....	25
Collective Goodwill .....	25
Reputation as a purchaser rather than as a retailer.....	26
Descriptive trade names and acquisition of secondary meaning.....	26
Personal names .....	27
Character merchandising, personality rights and sponsorship.....	27
Transnational reputation and goodwill .....	33

Defendant's Misrepresentation – The Test of Deception or Confusion.....	39
The defendant's state of mind .....	40
Explicit or implicit disclaimers of connection with the plaintiff.....	41
Proof of likely deception, or assisting in the deception of a foreign populace.....	43
Damage or Likelihood of Damage .....	44
Parallel imports and passing off .....	46
Remedies .....	47
<b>2 Registered Trade Marks .....</b>	<b>49</b>
Historical background .....	50
The old law vs the new law .....	51
Definition of Trade Marks .....	52
What is a mark?.....	52
Sound, smell and colour marks.....	56
Shape marks.....	57
Registrability of Trade Marks .....	60
Registrability requirements under the old TMO.....	60
Absolute grounds for refusal under the TMO .....	62
Section 11(1)(a) – signs not satisfying section 3(1).....	63
Section 11(1)(b) – devoid of any distinctive character.....	65
Section 11(1)(c) – signs exclusively designating quality or quantity, etc.....	67
Section 11(1)(d) – customary language.....	70
Section 11(2) – evidence of use.....	71
Section 11(3) – shape marks.....	72
Section 11(4)(a) – contrary to morality.....	72
Section 11(4)(b) – likely to deceive the public.....	73
Section 11(5) and (6) .....	75
Relative grounds for refusal under the TMO .....	76
Similarity of goods or services .....	78
Similarity of marks .....	80
Likelihood of confusion.....	81
Section 12(4) – protection of well-known trade marks.....	83
Honest concurrent use and Registrar's discretion.....	87
Registration of Trade Marks .....	89
Application and registration procedures.....	90
Term and scope of registration .....	90
Collective and Certification trade marks .....	91
Defensive and Well-known trade marks .....	92
Ownership and Use of Registered Trade Marks .....	93

Assignment and licensing .....	93
Transitional provisions.....	94
<b>Infringement of Registered Trade Marks .....</b>	<b>94</b>
Infringement by use .....	94
Comparative advertising .....	100
Exceptions to infringement.....	103
Parallel imports and exhaustion of rights.....	104
Groundless threats.....	105
Criminal Sanctions.....	106
Revocation and Declaration of Invalidity .....	111
Rectification and Correction of the Register.....	116
Ancillary Matters .....	117
Bilingualism.....	117
Not bound by rules of evidence .....	117
Appeals .....	118
<b>3 Copyright .....</b>	<b>119</b>
Constitutional basis of Hong Kong copyright.....	120
The Copyright Ordinance and its predecessors .....	120
Copyright analysis .....	122
Stage one: Subsistence analysis .....	123
Stage two: Infringement analysis .....	123
Subsistence of Copyright .....	124
Original work of one of the specified categories .....	124
Literary works .....	125
Original in a copyright sense.....	126
Dramatic works .....	128
Musical works .....	130
Artistic works .....	131
Fixation .....	134
Qualifying factors .....	135
Duration of Copyright .....	136
Copyright and Industrial Designs .....	137
Authorship and Ownership of Copyright .....	138
First ownership.....	140
Assignment and Licensing.....	140
Infringement of Copyright .....	142
Primary infringement.....	142
Copying – the concept.....	142
Taking a substantial part of a copyright work .....	147
Reproduction in a material form .....	152
Authorising infringement of copyright .....	154
The exceptions to infringement .....	158
Fair dealing.....	158
The education exception.....	161
The library exception .....	164

Public interest and public policy.....	164
Secondary infringement.....	165
Permitting performances in public.....	166
Infringing copies.....	167
Transshipment.....	169
Remedies.....	170
Criminal Sanctions.....	175
Copyright Ordinance.....	175
Penalties.....	182
Proceedings relating to importation of infringing articles.....	185
Anti-circumvention of technological measures for copyright protection.....	187
Prevention of Copyright Piracy Ordinance (Cap 544).....	188
Organized and Serious Crimes Ordinance (Cap 455).....	189
Copyright Interest Groups and Licensing Schemes.....	189
CASH.....	190
CISAC.....	190
HKCLA.....	190
HKRRLS.....	191
IFPI.....	191
MPA.....	191
PA.....	191
Concluding Remarks.....	192
<b>4 Registered Designs.....</b>	<b>193</b>
United Kingdom Registered Designs.....	193
Registrability.....	194
General.....	194
Meaning of design under the unamended UK Act.....	195
Meaning of 'article'.....	196
Applied to an article by any industrial process or means.....	197
Meaning of design under the Ordinance and the amended UK Act.....	198
Registrable Designs.....	199
Novelty.....	199
Designs excluded from registration.....	200
The Application.....	201
The applicant.....	201
Method and contents of application.....	201
Filing date and priority right.....	202
Withdrawal, reinstatement and amendment of application.....	202
Rights in applications.....	203
Examination and registration.....	203

Term of Registered Designs.....	204
Term of design registered under the Ordinance.....	204
Term of design deemed registered under the Ordinance.....	205
Nature of Rights in Registered Design.....	206
Registered designs personal property.....	206
Co-owners.....	206
Transaction affecting rights in registered designs.....	206
Determination of rights in registered designs.....	207
Effect of transfer of registered design.....	207
Infringement of Registered Designs.....	208
Infringement under the Ordinance.....	208
Infringement under the Registered Designs Act.....	209
Not substantially different.....	209
Nature of infringing article.....	211
Right of third party to continue use under section 35.....	212
Infringement Procedure.....	212
Actionable by owner.....	212
Action by exclusive licensee.....	212
Restrictions on recovery of damages and profits.....	213
Orders for delivery up and disposal of infringements – sections 53 and 54.....	213
Declaration of non-infringement.....	214
Certificate of contested validity.....	214
Action for Threats.....	214
Revocation of Registered Designs.....	215
Design not registrable.....	215
Public order or morality.....	215
Registered owner not entitled to design.....	215
<b>5 Patents.....</b>	<b>217</b>
Summary of the Patents Ordinance.....	218
The types of patent which can be registered.....	218
Application for and grant of a standard patent.....	218
Application for and grant of a short-term patent.....	218
Terms of patents granted under the Ordinance.....	219
Property in patents and applications; registration.....	219
Employees' inventions.....	220
'Tie in Clauses' as to patented products.....	221
Compulsory licences for standard patents.....	221
Government use of patented inventions.....	222
The rights conferred by patents and patent applications.....	222
Infringement.....	223
Amendment of patents and applications.....	224
Revocation of patents.....	225

Language of proceedings; authentic text .....	227
Offences .....	227
Repeal .....	227
Transitional arrangements .....	228
The Registration of Patents Ordinance .....	229
The privileges and rights conferred .....	229
Validity .....	233
Novelty .....	233
Obviousness or lack of inventive step .....	234
Added matter .....	235
Infringement .....	236
The scope of the patentee's monopoly and the validity of the patent .....	238
The Significance of Doctrines for Interpreting Patents Claims .....	238
Anglo-Commonwealth approaches to construction of a patent specification .....	240
United Kingdom – <i>Catnic v Hill &amp; Smith</i> .....	240
The <i>Catnic</i> test of essentiality .....	243
Hong Kong approach to patent interpretation .....	246
Australian courts by and large pay mere lip service to purposive construction a la <i>Catnic</i> .....	250
Move towards true <i>Catnic</i> style purposive construction in Australia .....	255
Most recent developments in Australian case law .....	257
United States court's approach to patent interpretation .....	258
Conclusion .....	260
<b>6 Trade Secrets – the Action for Breach of Confidence</b> .....	261
Trade Secrets defined .....	262
Know-how .....	262
Confidential information as property – the Hong Kong lead .....	263
Privacy and confidential information .....	263
New tort of invasion of privacy and corporate privacy .....	265
Existing Law .....	269
Information must possess the necessary quality of confidence .....	269
Minimum intellectual effort .....	271
Information must not be public knowledge .....	271
Public domain after <i>Spycatcher</i> .....	275
Springboards and headstarts .....	276

Personal knowledge, skill or experience acquired at work .....	279
Confidential information and the employment contract .....	280
Convenants against disclosure .....	281
Information imparted under circumstances importing an obligation of confidence .....	286
Confidential information as a property – <i>Linda Chih Ling Koo &amp; Anor v Lam Tai Hing</i> .....	289
The relationship between breach of confidence and discovery .....	290
Confidential information privileged from discovery .....	291
Discovered information impressed with obligations of confidence .....	293
Third party discloses of confidential information .....	293
An unauthorised disclosure of the information causing detriment to the discloser .....	294
Negligent disclosure of confidential information .....	297
Defences .....	297
The public interest in confidential information .....	297
Bona fide purchaser in good faith of confidential information .....	299
Disclosure of confidential information pursuant to a contract .....	299
Confidential information acquired by independent means .....	299
Remedies .....	300
Injunction .....	300
Damages .....	300

Appendix 1 Layout-design (Topography) of Integrated Circuits Ordinance (Cap 445) .....	301
Appendix 2 Plant Varieties Protection Ordinance (Cap 490) .....	313
Index .....	333