The Hong Kong Institute of Trade Mark Practitioners
香港商標師公會

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29 October 2009

Intellectual Property Department
25th Floor, Wu Chung House
213 Queen's Road East
Hong Kong

Attn: Ms. Winnie W H Ng
Director of Intellectual Property

Consultation Paper on Copyright Tribunal Rules

Background

This submission is made by The Hong Kong Institute of Trade Mark Practitioners Limited ("HKITMP"), the membership of which consists of solicitors, barristers, trade mark agents and patent agents, who are principally engaged in trade mark and other intellectual property practice. The HKITMP's aim is to protect the interests of trade mark owners, for which purpose we are active in regular liaison with the Intellectual Property Department and other relevant industry bodies.

The HKITMP acts as a conduit and forum for discussion, and promotes the views of the professionals who engage in trade mark and other intellectual property works.

This submission on behalf of the HKITMP has been prepared by the HKITMP's Copyright Committee, consisting of Council members who have a particular interest and expertise in the issue of Copyright. The views expressed are from a legal and policy perspective in our capacity as solicitors and intellectual property law practitioners, acting independently without regard to the views of any particular copyright body or organization.

Submission

(a) Applying the relevant principles of the Civil Justice Reform as the fundamental value of dispute resolution before the Tribunal

1. The Institute agrees with the principle that the Tribunal should provide a forum for just and fair resolution of disputes, similar to the courts in our judicial system, and the proposal to adopt the underlying objectives of the Civil Justice Reforms which would be beneficial. The objectives are general and set out the goals of maximizing costs-effectiveness, expediency, reasonable proportion, fairness, facilitate settlement and ensuring resources are distributed fairly. We believe the Government should not follow too closely the actual civil procedure rules as set out in the White Book. We believe that the Government wishes to encourage the use of the Tribunal and adopting a procedural approach closely aligned with the CJR could well operate contrary to the Government's intention.

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2. However, we understand that the intention is for the Tribunal to have its own set of self-contained rules, which will contain tailor-made provisions to reflect any practices and procedures of arbitration applicable to proceedings before the Tribunal.

(b) One standard procedure and form for all types of applications/references before the Tribunal

3. The Institute supports a system which is as simple and straight forward as possible, provided that this is not unnecessarily restrictive or restrains the presentation of any particular type of application/reference. We see no reason why this cannot be achieved.

(c) Exercising active case management

4. The Institute supports the proposed measures of active case management where appropriate, provided there is flexibility in the approach that may be adopted by the Tribunal. We agree with the specific measures proposed in point 4(c) of the Consultation Paper i.e. requiring Statements of Truth, convene case management conferences and pre-hearing review, and powers to impose sanctions if they will facilitate the speedy disposal of a matter as well as discourage parties from hiding or lying about facts or using delay tactics, which will all increase the cost and length of proceedings.

(d) Promotion of Alternative Dispute Resolution (ADR)

5. ADR is an increasingly important element of modern day dispute resolution. This is an issue where there was some difference of opinion between members. Some felt that whilst ADR is actively encouraged in the CJR, it is usually a general desire to resolve disputes amicably without recourse to the courts or any tribunal (and the costs that involves), that is the driving force for ADR or settlement negotiations to be considered. Some members felt that the Government suggestion of expressly *"empowering the Tribunal ... to encourage and facilitate use of mediation in appropriate cases"* is not necessary for the purpose of the proposed rules.

6. Those members believe parties will attempt to resolve matters amicably, where they can, whether with or without any "encouragement" from a Tribunal. They do not believe the Tribunal should be empowered to require ADR, which itself is an approach that requires legal costs. However, those members did also believe that if a procedural step of "consider settlement" was included after the initial pleadings, with a short window (say 4 weeks) before the next procedural step, this may be worthwhile.

7. However, other members felt that the encouragement of mediation should be there as some parties really need an independent third party (like a judge or tribunal officer) to tell them that they should consider mediation/settlement and explain to them the benefits before they will rationally consider such an option.

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Therefore, they tended to agree with the proposal that the Tribunal can encourage mediation and appoint mediators where the parties agree to mediate (although not require mediation as in many cases, this merely escalates costs). A procedural step of "consider settlement", as encouraged by the Tribunal officer is good, particularly if this is done at an early stage before substantial costs are incurred.

(e) *Empowering a single member of the Tribunal to exercise certain adjudication powers*

8. It is not clear to us whether the Government's intention is for the Tribunal members to be legally qualified and/or experienced in copyright matters. The Institute believes that Tribunal members should be legally qualified and experienced in copyright matters. The extent to which a Tribunal member is legally qualified and/or experienced potentially has a bearing upon the Government's proposed rule that all interlocutory applications should be heard singly under Section 172(1A), and the presiding single member being empowered to exercise active case management. It also impacts upon the efficiency of the process and the soundness of the decision.

9. There may be cases arising where an interlocutory matter should ideally be dealt with by more than one Tribunal member, and therefore, the Rules should make provision for the single member to order a particular matter to be heard by more than one Tribunal member, or for the parties themselves to be able to make an application to the Tribunal that a single member be replaced by a multiple member panel.

(f) Use of Practice Directions to regulate proceedings, if appropriate

10. This is another area where there was a difference of opinion. Some members felt that whilst Practice Directions have become a recognized aspect of civil court procedure, the Government should avoid the need for Practice Directions by ensuring that the Rules are as fully encompassing as they need to be, having regard to the Government's experience under the current Tribunal system.

11. We are not aware of Practice Directions or other guidance having been issued under the current system, and are not aware of the existence of circumstances whereby a power to issue Practice Directions would have assisted.

12. The Government will also appreciate that under the current system, where procedural principles are "missing" or not explicitly provided for in particular circumstances, it has commonly been the practice of Tribunal panels and the parties to have regard to the manner in which such matters are dealt with in the High Court. Such an approach has also been adopted in Arbitration proceedings. Some members thought there is no reason why this practice should not continue.

13. However, others felt that although the Tribunal rules are intended to be as fully encompassing as possible, it is inevitable that there will be situations not

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addressed by the rules. In such cases, it is better to empower the Tribunal to issue Practice Directions where appropriate, rather than be forced to follow the White Book, which should be avoided. This will allow the Tribunal to provide for simpler procedures than what is set out in the White Book.

(g) *Prescribing a set of self-contained rules - de-linking all direct links/cross-references to the Arbitration Ordinance (Cap 341)*

13. The Institute encourages the proposed de-linking and approach to ensuring that the proposed Rules are self-contained.

14. Our comments in paragraph 12 should be noted.

Additional comments

15. We understand that the UK is proposing to introduce a small applications "fast track" system for cases of low financial value in order to improve accessibility for small businesses and individuals. This is something that perhaps could be considered here. In any case, if the CJR underlying objectives (proportionality) and case management flexibility are adopted, then the Tribunal should have the powers to fast track and simplify low value cases.

Please let us know if you have any questions or comments about our submission.

Yours faithfully

Barry Yen
Copyright Committee
HKITMP