

A Practical Guide on Trademark





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Table of contents

Introduction	3
Fact sheet of Hong Kong trade mark	4
Why are trade mark registrations in Hong Kong important?	6
Registrability of trade mark in Hong Kong.....	7
Classification	9
Trade marks in Chinese characters	10
Trade mark protection in Hong Kong	10
Squatters and trade marks.....	12
Un-registered trade marks	14
Search and registration requirements	15
Application procedure	16
Claiming priority	17
International trade mark registration	19
Trade mark opposition and invalidation.....	23
Infringement and litigation	28
Our trade mark practice	30
About us	32
Contact us	33

Introduction

Brand name is among the most important intangible assets of an enterprise. “Apple”, “Google” and “Microsoft” are three of the most valuable brand names in the world, reportedly worth over USD75 billion each. A business corporation should have the basic understanding of what constitutes a trade mark and how to effectively enforce its trade mark rights, in order to capture this valuable intellectual property and avoid legal dispute. This practical guide will give a brief account of the trade mark system in Hong Kong, and the tips in obtaining an effective protection.

Fact sheet of Hong Kong trade mark

Governing Ordinance	Trade Marks Ordinance (Cap.559)
Filing System	First-to-use ¹
Territorial protection	Protection restricted to Hong Kong only. Registered mark in China, Taiwan, Macau and other jurisdictions has no protection in Hong Kong.
Filing in series	Available, maximum 4 marks in a series in an application (Marks in series should be very similar to each other and can only differ as to minor matters of a non-distinctive character.)
Classes	1-45 (NICE classification applicable)
Filing in multiple classes	Yes
Official fee	HK\$2,000 for first class; HK\$1,000 for each additional class
Power of Attorney	Not required
Period of priority claim	6 months, no certified prior application document required

¹ However, it is prudent to obtain trade mark registration which gives the registrant exclusive right to use a trade mark and priority over subsequent trade mark applications.

Protection period	10 years from application date, renewable
Examination on absolute grounds	Yes
Examination on relative grounds	Yes
Opposition period	3 months from the date of publication, before registration
Use requirement	Subject to revocation if mark not being used for 3 years
Assignment / License	Assignment/license ineffective against bona fide third party until recordal
Collective mark	Yes
Certification mark	Yes
Defensive mark	Yes
Non-traditional mark	Sound, colour composition, smell, shape of goods are registrable subject to whether mark is “graphically representable”, sufficiently distinctive and not exclusively descriptive.

Why are trade mark registrations in Hong Kong important?

Hong Kong is known as the shopping paradise and a trend-setting city for fashions, luxury goods and technology gadgets. Consumers from mainland China and overseas come to Hong Kong to look for the newest release from the fashion brands and the most updated products in the industry. Consumers are confident in the products sold in Hong Kong being genuine products and sold at a reasonable price.

Brand names are protected by the Trade Marks Ordinance (Chapter 559) if they are registered as trade marks in Hong Kong. Owners of registered trade marks can prevent unauthorized parties from selling or dealing with goods using their trade marks. Brand name owners may obtain injunction from Court to restrain the unauthorized use of the registered trade marks and claim damages. They may also require the Hong Kong Customs and Excise Department to take raid action against the infringing activities in relation to the registered trade marks.

To be able to enforce the above rights in Hong Kong, the brand name owners have to register their brand names and/or signs used to distinguish their goods or services as trade marks in Hong Kong.

Registrability of trade mark in Hong Kong

What is the definition of trade mark in Hong Kong?

Any sign which is capable of distinguishing the goods or services from one provider to another, and is capable of represented graphically is registrable as trade marks in Hong Kong.

What types of trade marks are registrable?

The most common trade marks consist of words, names, logos, letters, numerals, characters (for example Chinese, Japanese, Korean characters) and colours. Some uncommon types of trade marks are sounds, smells and the shape of goods (3-dimensional marks) or their packaging, which require specific requirements to be fulfilled for registration.

What marks are not registrable in Hong Kong?

Non-distinctive mark

The most commonly rejected non-distinctive marks are those which are:

- ordinary names for the goods or services (for example “*Marker*” for pen);
- highly descriptive terms on the goods or services (for example “*Fresh & Clean*” for detergent);
- common terms used in the industry (for example “*Network*” for computer goods);
- laudatory words or slogans (such as “*Purewater*” and “*The best drinks on earth*” for distilled water).

Solution: The only exception is that the applicant can provide evidence to support that the mark has acquired distinctiveness through long period of use before the date of application. Such evidence should be provided in the form of a statutory declaration. The average period suffice to support acquired distinctiveness is 5 years.

A coined mark, that is, a new word created by the applicant, is more likely to be considered distinctive and can usually avoid being rejected by this ground.

Mere geographical origin

Mere geographical origin is not registrable as trade mark in Hong Kong.

Solution: A mark containing a distinctive element in addition to the geographical origin is generally registrable in Hong Kong, subject to the requirement to disclaim the exclusive use of words which indicate such geographical origin.

Mark identical or similar to mark(s) registered

Examiner conducts search not only in class(es) being applied for, but also related classes, to check if identical or similar marks have been registered. It is therefore a good practice to conduct a trade mark search before filing application.

Solution: The Trade Marks Registry will allow registration if the applicant can provide a valid and applicable consent signed by the owner of the cited mark.

Alternatively, the applicant may file evidence to show that there has been honest concurrent use of the mark in Hong Kong before the date of application. Use for 5 years prior to

the date of application is generally sufficient. Such evidence should be provided in the form of a statutory declaration.

Other potential solutions include an application for revocation of the cited mark, an application for a declaration of invalidity against the same, an assignment of the cited mark to the applicant, and/or a request for amendment of the representation and/or the specification of goods and services in the application.

Classification

Trade marks are registered in different classes (for example clothing, toys, watches, insurance etc.) depending on the goods or services the marks are used for. Usually a brand name will cover not only products or services concerned but also related products and/or services which span over more than one class. Some goods are not so obvious as to which class(es) they belong to. The applicant should carefully select the relevant classes when filing application in order to obtain sufficient scope of protection.

It should be noted that even a mark has been registered by another party, it may not affect your registration if your mark is not applied in the same class and related classes.

Trade marks in Chinese characters

Since over 95% of Hong Kong consumers (including tourists from Mainland China) use and speak Chinese, it is very likely that a trade mark will be referred to in Chinese by consumers. If a mark is in English or other languages, it is important to also register the mark by its transliteration or translation in Chinese characters as its official mark in Chinese, and use that Chinese mark in trade. Such registration in Chinese will secure the ownership of the official brand name in Chinese for the owner and prevent it to be registered by another party.

As the Chinese in the mainland China use simplified Chinese characters and local Hong Kong consumers use standard Chinese characters, it is suggested that the Chinese mark should be registered in both simplified and standard Chinese characters in a series of two marks in one application.

Trade mark protection in Hong Kong

What are the rights of a trade mark owner?

A trade mark owner has the exclusive right to use the registered trade mark in the course of trade or business. He has the right to take legal action under the Trade Marks Ordinance against any infringing or unauthorized use of his trade mark.

What constitutes infringement of a registered trade mark?

The unauthorized use of any mark similar or identical to a registered trade mark in the course of trade or business on identical or similar goods or services registered under the registered mark, and which causes confusion to the consumers (in the case of similar marks or similar goods/services only), constitutes trade mark infringement.

The above use includes, among others:

- applying the mark to goods or their packaging;
- offering goods for sale under the mark;
- putting goods on the market under the mark;
- stocking goods under the mark for sale;
- supplying services under the mark;
- importing or exporting goods under the mark; and
- using the mark on business papers or in advertising.

What remedies are available for trade mark infringement?

The registered trade mark owner is entitled to the following relief:

- Damages;
- Account of profits;
- Injunction;
- Delivery up of infringing goods.

Squatters and trade marks

Trade mark squatting

Trade mark squatting is getting more and more common in Hong Kong. Squatters usually identify trade marks of upcoming brands in Europe and US which have not become popular in Hong Kong, and register the marks for selling to brand name owners at exorbitant prices. Recently, PRC famous marks are also the target of trade mark squatters. An early registration of trade mark by the brand owner is the most effective way to protect its mark from trade mark squatting.

Company name squatting

It is relatively easy to register a company in Hong Kong. In order to allow companies to be incorporated efficiently, the Hong Kong Companies Registry only conducts search for “identical” company names in the Companies Register and rejects such names, and does not conduct any trade mark search or require any proof of trade mark registration in relation to the company name. It is easy for anyone to register a company name consisting of a famous brand, and it is up to the brand owner to take any necessary action.

In the case of such bad faith registration of company name, the Hong Kong trade mark registration will be the prima facie evidence that the brand owner is the trade mark owner in Hong Kong. The brand name owner may rely on its registered trade mark to take Court action against such misuse of the brand name in company name and obtain an injunction. Without the trade mark registration, the brand name owner can only rely on passing off as cause of action,

which requires proof of its goodwill in Hong Kong. It will not be easy to fulfil such requirement if the brand is still relatively new in Hong Kong.

Further, within 12 months after the incorporation or the change of the company name of a Hong Kong company, the Registrar of Companies of Hong Kong may direct that company to change its name(s), on the ground that such name(s) is/are too like the name of a company in the Index of Companies. If a brand name owner has set up an associated company in Hong Kong (but not elsewhere), it may file a complaint with the Companies Registry within 11 months after the bad faith incorporation of company or change of company name.

Domain name squatting

Domain name registration is another popular area for squatting. Dispute in relation to this kind of domain name registration in bad faith can be effectively dealt with by arbitration. What the arbitrator looks for in the first place is whether the disputed keyword in the domain name has been registered as a trade mark which shows that the claimant has proprietary interests in the domain name. A trade mark registered owner can effectively rely on its trade mark registration to demand the domain name squatter to transfer or deregister the domain name which has been registered in bad faith.

Un-registered trade marks

If the trade mark user has used the marks for a period of time without registering the mark, it may rely on the common law rights established from its use to deter others from using the mark in the related business. The rights owner will need to provide extensive evidence to show the Court that sufficient goodwill has been acquired through its use and cannot rely on the Hong Kong Trade Marks Ordinance (Cap.559) to enforce its rights due to the lack of registration. A trade mark registration is a prima facie evidence that the registered owner is entitled to the protection under the Hong Kong Trade Marks Ordinance. Therefore, it is not necessary for the claimant to prove its goodwill in Court if the trade mark has been registered.

An owner of a Hong Kong registered trade mark can prevent others from registering an identical or similar trade mark in Hong Kong, including bad-faith registration, as the Hong Kong Trade Marks Registry will conduct a search for identical or similar registered trade marks as a standard procedure before approving the registration, and reject the application if identical or similar marks in identical and/or similar classes are located. Unregistered trade marks are not within the scope of its search. The rights owner can lodge opposition to prevent registration of such marks when an application is being made for registration.

Search and registration requirements

Search

A trade mark search can be conducted to check whether any marks identical or similar to the proposed mark in identical and/or similar classes have been registered to assess the chance of successful registration, before filing an application which will incur application and official fee. We also provide opinion on inherent registrability of the mark with the search result. As such, a trade mark search can save an applicant unnecessary application and official fee if the trade mark is likely to be refused. The applicant may then amend the mark or choose another mark to avoid being similar to other existing registered trade marks or avoid objection on the basis of inherent registrability.

Particulars of the applicant

The applicant may be an individual or company. The applicant should provide its name and address in Chinese or English, and a copy of the Certificate of Incorporation or Business Registration Record (for company), the Hong Kong Identity Card (for Hong Kong citizen), or the Passport (for overseas citizen) for verification.

Trade mark

The applicant should provide a soft copy of the mark if it includes any logo or graphic design or if the mark is stylised.

Class and specification of goods/services

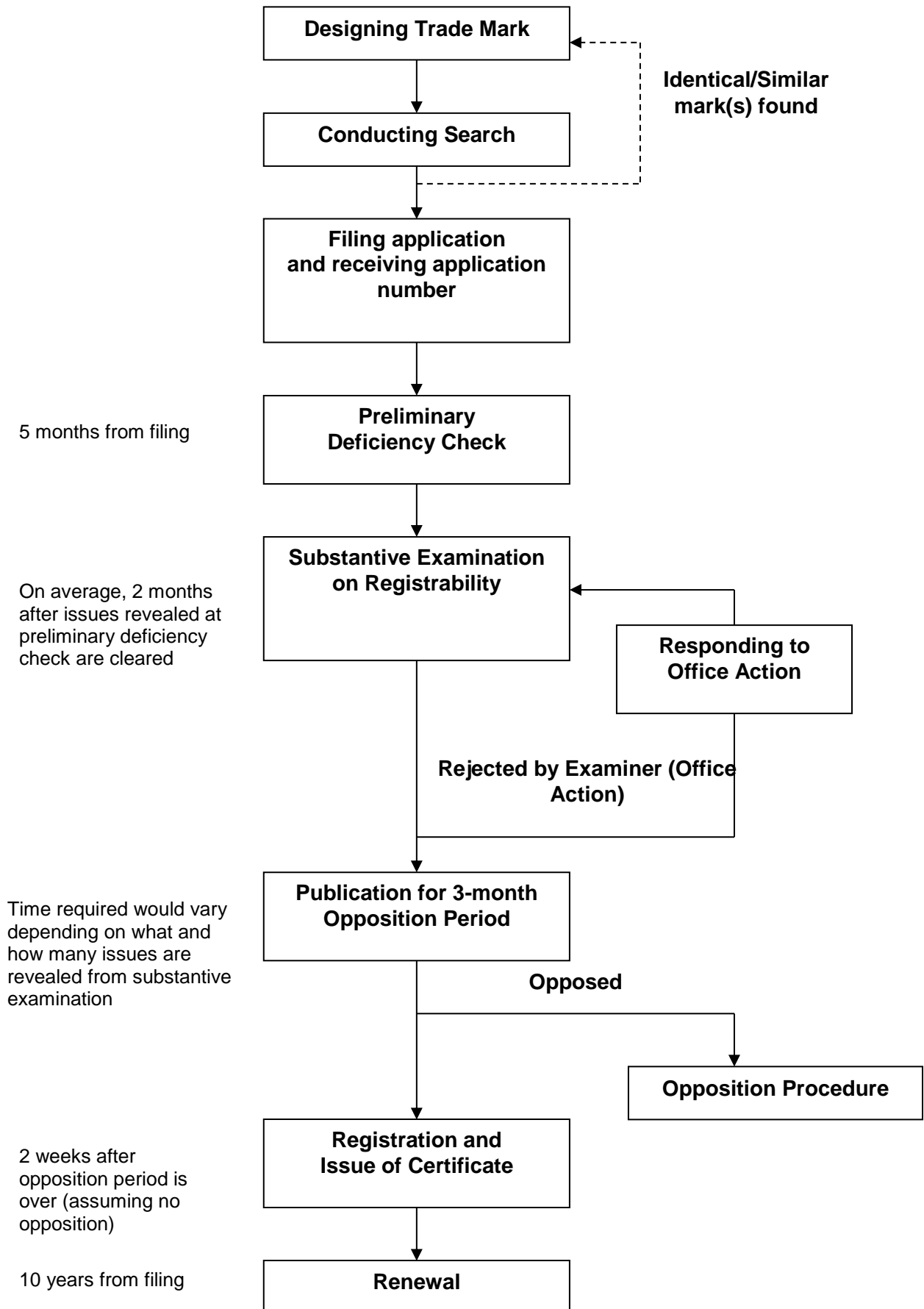
The applicant should provide a list of the goods/services currently or anticipated to be sold/provided under the mark for the determination of classes and drafting of the specification of goods/services. In many circumstances, the

mark should be registered in more than one class of goods, or also in the classes of services (for example retail services) in order to obtain a full protection. It is recommended to provide the applicant's website or brochure for us to ascertain the classes and draft the specification of goods/services.

Application procedure

It generally takes about 6 months to 1 year from filing application to obtaining the trade mark certificate for a smooth application. An application may be rejected by the Examiner during the examination (by way of office action). The applicant will then have 6 months to file a response to the office action to convince the Examiner that the mark should be allowed for registration. An application may also be opposed by any third party during the 3-month opposition period after the Examiner's approval and the publication by the Trade Marks Registry. If the mark is opposed, the application will enter into opposition proceedings and subject to the outcome of the opposition.

The following flowchart summarizes the application procedure and the estimated time frame:



Claiming priority

What is claiming priority?

Within 6 months from the first filing date of a trade mark application in any countries which is a member of the Paris Convention, the applicant may file a subsequent trade mark application in another member state of the Paris Convention, claiming the earlier filing date as the application date for the subsequent application, for the same mark and same goods and/or services.

What is the advantage?

The advantage is that when the Examiner searches for similar and identical marks, only the marks registered before the **earlier application date** will be cited for rejection. In other words, any marks filed by another party between the earlier filing date and the actual filing date of the present application will not be cited against the present application.

Since an applicant may not be able to register the trade mark in all countries at the same time, claiming priority provides a way against bad faith registration which targets at up-and-coming brand names with business potential. Where applicable, it is recommended to claim priority when securing trade mark registration.

What is required for claiming priority?

For claiming conventional priority in a Hong Kong trade mark application, we need to know the filing date, the country, and the application number of the earlier application, and a copy of the earlier application document or filing receipt for verification.

International trade mark registration

Trade mark registration is territorial. In other words, a trade mark has to be registered in each country you seek protection in. There is no single trade mark registration which can cover all the countries in the world. However, there are two distinct trade mark systems, the European Union Trade Mark (EUTM) system and the Madrid system, which make it easier for an applicant to register a mark in various countries.

European union trade mark (EUTM) system

What is EUTM?

The European Union Trade Mark system is managed by European Union Intellectual Property Office (EUIPO) and allows a single application to cover 28 countries of the European Union (EU) including Austria, Benelux (Belgium, the Netherlands and Luxembourg), Bulgaria, Croatia, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom. There is only a single examination by EUIPO on the inherent registrability of the mark. Once approved, the mark will be open to opposition for 3 months. A registration automatically covers all the said 28 EU countries.

What is the advantage of EUTM?

EUTM is a relatively economical way to register trade mark in the EU countries, when compared to filing separate application in each EU country. In term of costs, it is recommended to apply for EUTM registration if the

applicant will apply for 3 or more EU countries.

What is the disadvantage of EUTM?

The main disadvantage is that if the mark is being successfully opposed by a trade mark owner in any of the 28 countries, the whole application will fail (however, it is possible to convert into national applications). The EUTM registration is a unified right throughout all 28 EU countries, and cannot be elected to cover only some of the countries.

Madrid trade mark system

What is Madrid system?

The Madrid Trade Mark System is managed by the World Intellectual Property Office (WIPO) and operated under the Madrid Agreement and the Madrid Protocol. The applicant has to be a national of, domiciled in or has a real and effective industrial or commercial establishment in a contracting state. The Madrid application will base on the home trade mark application or registration of the applicant. Most countries are now contracting parties of Madrid Agreement and/or Madrid Protocol. Currently, for example, Hong Kong, Macau, Taiwan, Thailand and Canada are still not parties to the Madrid System.

What is the advantage of Madrid system?

Trade mark application through the Madrid System is a relatively economical way to register trade mark in the Madrid countries, compared to filing separate application in each corresponding country.

What is the disadvantage of Madrid system?

In the first 5 years, the validity of subsequent designations

in the Madrid countries depend on the home registration. In other words, if the home registration is invalidated, the registrations in the other Madrid countries will fail as well, except in some cases, the Madrid registration in subsequently designated countries may be transformed to national registrations. As Hong Kong is not yet a party to the Madrid Agreement or the Madrid Protocol, Madrid System is generally not applicable to a Hong Kong individual or company.

US trade mark registration

As US is one of the largest markets in the world, it is recommended to consider US as a country for obtaining trade mark protection. It is worth noting that the USPTO (US Patent and Trademark Office) requires that the applicant to file a Declaration of Use of the mark in the US before it will complete the registration. In other words, the applicant has to have the mark actually used in the trade on the goods/services applied for registration before the USPTO will grant the registration. However, the applicant may file request for time extension for up to 3 years for filing such Declaration.

China trade mark registration

The trade mark registration of China is completely independent from the Hong Kong trade mark registration. In other words, a Hong Kong registered mark (not registered in the PRC) is not entitled to protection in China and vice versa. A separate application must be filed in China to obtain trade mark protection in China. Bad-faith trade mark registration is a serious issue in China as China adopts “first-to-file” regime. The unregistered trademark will

receive no protection until it is officially registered. It is recommended to always conduct a search before filing application, and right owners should file application for famous or emerging brand names as soon as possible. For a trade mark in English or other non-Chinese language, it is also recommended to file a corresponding trade mark in Chinese to protect its name in Chinese, before someone else registers it to take advantage.

Trade mark opposition and invalidation

What are opposition and invalidation?

Once a trade mark application is approved by the Hong Kong Trade Marks Registry, the application will be published on the Hong Kong Intellectual Property Journal. Any party may file an opposition of the application within 3 months from the publication date. If no opposition or extension of time for filing a notice of opposition is filed, the mark will be successfully registered.

Even after the 3-month opposition period, a registered trade mark may still be invalidated subsequently. Some of the grounds applicable for opposition can be applied in invalidation.

If the applicant chooses not to defend the opposition, the application for registration shall be treated as withdrawn.

What are the usual grounds for opposition (and invalidation)?

Similar to earlier registered trade mark

The Opponent should have an earlier identical or similar Hong Kong registered mark registered in identical or similar goods/services as those applied for under the subject mark, and it has to prove that the subject mark is likely to cause confusion to the consumers. If the goods/services registered by the Opponent are very different from the goods/services under the subject mark, the Opponent has to further prove that its mark is a well-known trade mark in Hong Kong.

Passing off

If the Opponent does not have an earlier registered mark in Hong Kong, but has used its mark in business in Hong Kong to certain extent, it may allege that the use of the subject mark will constitute passing off against its goods/services. The Opponent will need to prove its mark has sufficient goodwill in Hong Kong, the use of the subject mark constitutes misrepresentation and that there is damage to goodwill.

Bad faith application

There are more and more trade mark applications in Hong Kong for some famous (or to-be-famous) brand names in the PRC or overseas filed by some unrelated parties with a view to gain advantages from the genuine trade mark owners.

Usually it is required to establish that the applicant is aware of the Opponent's mark before filing the application. The requirement is that the application would be considered a dishonest act under the standards of acceptable commercial behaviour observed by reasonable and experienced business men.

It is advisable that a trade mark owner of famous mark in the PRC or overseas also files trade mark application in Hong Kong to protect its mark from bad-faith application.

Non-use

A Hong Kong trade mark may be revoked if it has not been put into genuine use in Hong Kong for a continuous period of at least 3 years.

Generic names

The trade mark owner should prevent the use of its mark from being used as a generic word. An example of such mark is “Botox” which is gradually becoming a generic term for the Botulinum toxin preparations being used in cosmetic procedure for removing wrinkles. Once a mark has become a generic term in the industry, it may not be entitled trade mark protection.

What are the procedures?

Opposition procedure

Stage 1: The Opponent files Notice of Opposition with the Opposition Grounds. The applicant is required to file Counter-Statement within 3 months. Otherwise, the application is deemed to be abandoned by the applicant.

Stage 2: The Opponent files evidence by way of Statutory Declaration within 6 months from filing the Counter-Statement by the applicant. The applicant may file evidence by way of Statutory Declaration within 6 months.

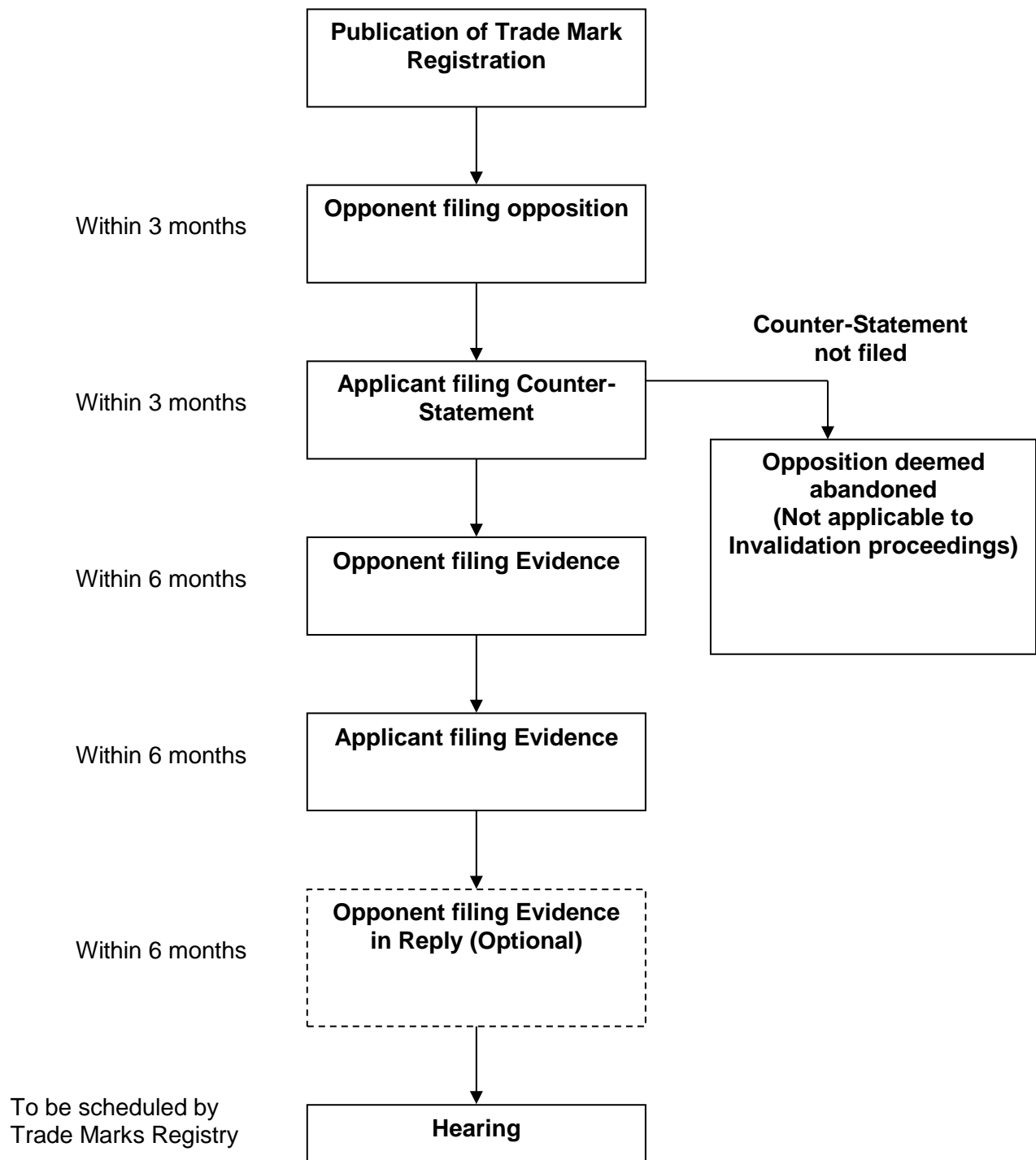
Stage 3 (optional): The Opponent may file further evidence in reply to the applicant’s evidence within 6 months. Either party may apply for leave to file further evidence (the Opponent has the right to be the last to file evidence).

Stage 4: After the evidence rounds have been completed, the case will be scheduled for a hearing. Sometimes a Counsel will be instructed to appear in the hearing if complicated issues are involved in the case.

Invalidation procedure

The invalidation procedure is similar to that of opposition, except the case has to proceed through stages 2-4 even if no Counter-Statement is filed to defend the case.

The following flowchart summarizes the opposition / invalidation procedure and the estimated time frame:



(For invalidation proceedings, the words “Opposition”, “Opponent” and “applicant” shall be replaced by “Invalidation”, “applicant” and “Registrant” respectively.)

Infringement and litigation

Civil action

To commence a civil action for trade mark infringement in Hong Kong, the complainant must be able to produce the basic evidence of infringement, for example, the infringing goods (or infringing use of mark on services) or the related promotion materials, the receipt of such goods/ promotion materials identifying the seller/ distributor, the date and the location of the sale or distribution. Sometimes an investigator will be engaged to conduct the collection of evidence.

For infringement of registered trade mark, the complainant should have a valid registration of the trade mark covering the goods/services being infringed. In most circumstances, a cease and desist letter will be sent to the infringing party to demand the infringing activities to be ceased immediately, and any infringing goods to be delivered up to the trade mark owner. If the infringing activities continue, the complaint may commence court action to obtain injunction and damages.

To support the case, a witness statement or affirmation describing the infringing activities, in particular, the purchase of the infringing goods by the trade mark owner has to be produced. The trade mark owner should keep detailed records of the purchase of the infringing goods. In addition to damages or account of profits, costs incurred in the legal proceedings can be claimed against the infringing party.

Criminal action

The complainant may also report to the Hong Kong Customs and Excise Department to request a raid action against the infringing party. The Customs may initiate criminal proceedings against the infringing party. However, the burden of proof is of a much higher standard compared to that of a civil action. Upon receiving the complaint, the Customs officers will conduct investigation and evaluate the case to determine whether to conduct any raid action. The pursuit of criminal action will highly depend on the evidence collected during the raid action.

Our trade mark practice

We are experienced in prosecuting Hong Kong and worldwide trade mark applications, including conventional trade marks and unconventional trade marks such as slogan mark, certified mark and 3-D mark. We have successfully convinced the Examiners by filing submissions to office actions and secured registration for many objectionable trade marks which have been preliminary refused by the Trade Marks Registry. We give advice on how to devise and apply for registration of trade marks in order to give the best protection.

We are experienced in handling trade mark opposition and invalidation proceedings, and representing clients in opposition and invalidation hearings. We have successfully opposed and invalidated many trade mark registrations in Hong Kong, including many famous marks which were registered in bad faith.

We enforce trade mark rights for our clients against trade mark infringers, and obtain court injunction to require trade mark infringing companies to amend their company names which incorporated our clients' registered trade marks. We also file complaint to the Customs and Excise Department to take criminal action against trade mark infringers.

We are a member of the International Trademark Association (INTA) and have international network to file trade mark applications in most of the jurisdictions in the world.

We regard each and every trade mark as a corporation's most important asset. We place great value in each trade

mark and use our expertise to provide you with the best trade mark protection.

About us

ONC Lawyers is a professional and dynamic legal practice based in Hong Kong. We have been growing continuously since our establishment in 1992, and have now become one of the largest local law firms with more than 40 lawyers and a total staff of over 130.

We offer a full range of legal services to both corporate and individual clients, including:

- Arbitration
- Asset Management & Funds
- Banking & Finance
- Capital Markets
- China Practice
- Commercial Crime
- Competition
- Construction
- Corporate Finance
- Corporate & M&A
- Employment, Privacy & Discrimination
- Family & Matrimonial
- Family Office & Private Clients
- Insolvency & Restructuring
- Insurance & Personal Injury
- Intellectual Property
- Litigation & Dispute Resolution
- Private Equity & Venture Capital
- Real Estate
- Regulatory & Compliance
- Shipping & Logistics
- Tax Advisory
- Technology
- Wills, Probate & Trust

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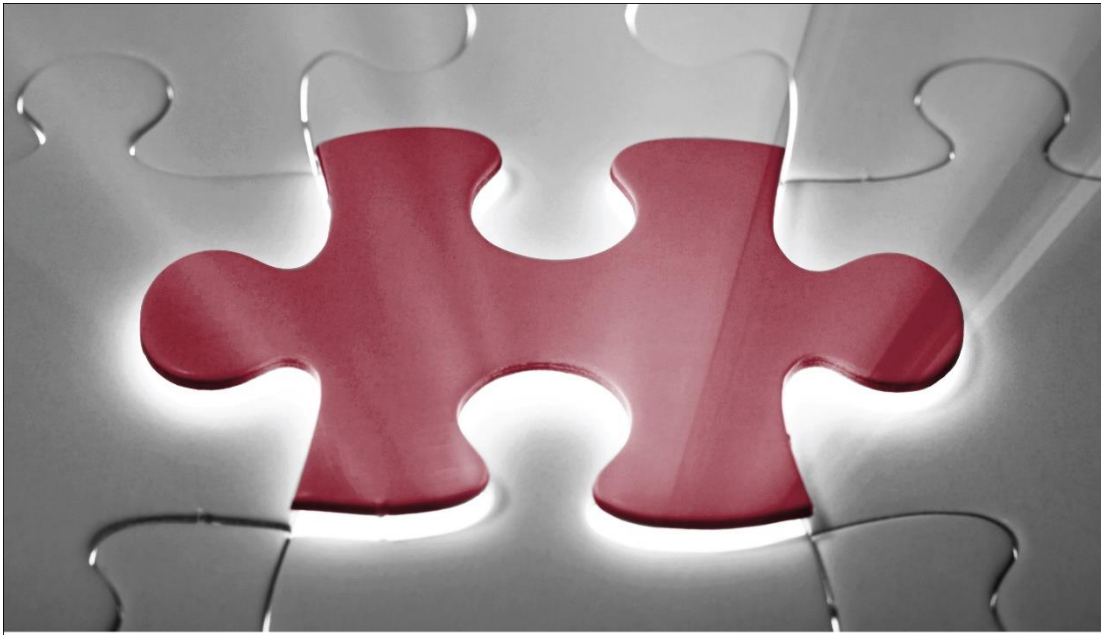
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