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# Designs 2016

**Hong Kong  
Letters & Thoo**

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**A Global Guide**

# LOOKING TO PROTECT DESIGNS & TRADE MARKS IN HONG KONG?



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# Hong Kong

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## Legal framework

In Hong Kong, exclusive rights to the design of an industrial article may be pursued under the Registered Designs Ordinance 2010 and the Registered Designs Rules 2004, both of which are based on the UK Registered Designs Act 1949.

Although sovereignty over Hong Kong was passed from the United Kingdom to China in 1997, Hong Kong remains a separate and independent legal jurisdiction from mainland China. Further, Hong Kong has an independent registration system for all IP rights matters, including industrial design registration and enforcement.

Hong Kong is a signatory to all major international conventions and treaties, including:

- the Paris Convention for the Protection of Intellectual Property;
- the Agreement Establishing the World Trade Organisation; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

However, it is not a signatory to the Hague Agreement Concerning the International Registration of Designs.

Hong Kong has a common law system and the established and rich body of UK case law has been retained. This underpins the Hong Kong design legislation, which provides design protection for a maximum term of 25 years.

## Unregistered designs

No Hong Kong law provides for protection of unregistered design rights. Thus, in order to enforce a design right, registration under the Hong Kong Registered Designs Ordinance is required.

Where no registered design right exists, alternative laws may be applicable for the protection of an article (as discussed below).

## Registered designs

### Who can apply for a design?

The designer or his or her successor in title may apply to register a new design. Where the applicant is not the actual designer, entitlement

to apply may be derived through assignment from the designer (or his or her successor in title) or by way of commissioned works.

### What is registrable

For a design to be registrable under Hong Kong law, it must fall within the statutory definition of a 'design' – that is, it must comprise features of shape, configuration, pattern or ornamentation that are industrially applied and that, in the finished article, appeal to and are judged by the eye. Features of colour and colour contrast are not expressly excluded from protection, and may in certain circumstances be considered as features of pattern or ornamentation capable of protection.

Anomalously, since the Hong Kong law is based on the UK Registered Designs Act (1949), it still applies the old UK test for 'eye appeal', despite UK law having removed this requirement in line with the EU Design Directive (98/71/EC). Further, when considering eye appeal, the features of the design need not be visible at the point of sale, provided that they are visible during normal use of the article or when the article is used as intended.

Only new designs are registrable under Hong Kong law. A design will not be considered new if it:

- is the same as a prior registered design, regardless of whether the prior registered design covers the same or a different article;
- is the same as a design that has been published anywhere in the world before the filing date, regardless of whether the design has been published to cover the same or a different article; or
- differs from previously registered or published designs only in immaterial details or features which are variants commonly used in the trade.

Hong Kong law provides no general grace period where the design has been publicly disclosed. Only a few narrow and specific exemptions from loss of rights due to prior public disclosure exist – most notably, certain disclosures made in bad faith or exemptions in respect of recognised international exhibitions.

### What is not registrable

Registered design protection is not applicable to

methods or principles of construction, features of shape or configurations of an article which are:

- dictated solely by the function of the article; or
- dependent on the appearance of another article of which the article is intended to form an integral part.

A design is also not registrable in respect of articles for which the appearance and aesthetic considerations are not material or not normally taken into account by persons acquiring or using such articles.

Other exclusions from registrability include:

- computer programs;
- protected layout designs (topographies);
- works of sculpture;
- wall plaques;
- medals and medallions;
- designs for articles of a primarily literary or artistic character; and
- designs that are deemed contrary to public order or morality.

### Procedures

Hong Kong design applications do not undergo substantive examination for novelty, but must comply with formal requirements before proceeding to registration.

### Minimum filing requirements

Initially, the application will be examined for compliance with minimum filing requirements for securement of a filing date. An application must include:

- a request for registration of the design in prescribed form;
- a representation of the design suitable for reproduction;
- the name and address of the applicant; and
- the official filing fee and advertisement fees.

### Examination for formal requirements

Once a filing date has been allocated to the application, it will be further examined for compliance with formal requirements, including the furnishing of:

- a statement explaining how the applicant has derived entitlement from the designer (if the applicant is not the designer) – for example, by assignment, employment

contract or commissioned work. The name of the designer is not required.

- an address for service in Hong Kong;
- a statement identifying the article to which the design is to be applied, in English and Chinese;
- a statement identifying the Locarno classification of the article to which the design is to be applied;
- a statement of novelty describing the features of the design which the applicant considers to be new, in English and Chinese; and
- if a priority application exists, details of the priority date, priority application number and priority country; a simple copy of a certified copy of the priority application as filed (and a verified translation if not in English or Chinese); and the registration certificate issued in respect of the priority application.

If formal requirements are not met, a defects notice will typically issue approximately one month after the filing date; this triggers a three-month period for the applicant to address the defects (extendable by a further three months on request).

### **Registration and deferred publication**

On meeting all formal requirements, the details of the design application are entered in the Register of Designs; the certificate of registration is issued shortly thereafter; and advertisement of registration of the design is published in the *Official Journal*.

There is no formal mechanism for deferring publication. However, publication may effectively be deferred typically by up to eight months from the filing date, where issuance of a defects notice triggers a three-month window for responding and a further three-month extension is sought.

### **Revocation**

A request for revocation of a registered design may be brought directly before a court by any person on various grounds – including that at the time of registration, the design was not new or was otherwise unregistrable.

Further, any party may apply to the registrar of designs to revoke a design

registration on grounds that it is contrary to public morality. The registrar may refer the question of revocation to a court.

### **Representations**

Although not expressly required under Hong Kong law or practice, the representations featured in a design application should preferably include six orthogonal views (ie, back, front, top, bottom, left-side and right-side views) and a perspective view of the design. Fewer views may be acceptable where the overall features of the design can readily be derived or where symmetry exists.

The representations may comprise line drawings or photographs. Computer-generated renderings are generally acceptable; however, it is advisable to delete rendering lines and shading lines where appropriate. Referential views which do not form part of the scope of the design may also be included for interpretive purposes (eg, to demonstrate various configurations of an article).

### **Statement of novelty**

A statement of novelty is required, which may be directed to the three-dimensional (3D) attributes of the design (ie, its shape or configuration), the two-dimensional (2D) attributes of the design (ie, pattern or ornamentation) or a combination of both.



**Groundless threat provisions exist under Hong Kong law, so due care must be taken before alleging infringement or asserting one's rights, as statutory penalties may apply**

### Disclaimed design features and indefinite length

It is possible to disclaim certain features shown in the design representations from the scope of the design in the statement of novelty. In addition to such textual disclaimer, features may also be disclaimed by clearly marking them with hashed or red lines or depicting them in dashed or dotted lines.

A design may be applicable to an article of indefinite length under Hong Kong law if the cross-sectional profile of the article is considered uniform (eg, an extruded article). In order to denote the indefiniteness of length

along an axis of the article, break lines may be included by convention.

### Multiple design applications

It is possible to file more than one design in a multiple design application if the designs are applicable to articles within the same Locarno classification. There is no express limit on the number of designs that may be filed in a single application and the official government fee for filing a multiple design application tends to be slightly lower than for filing separate applications.

Each design covered by a multiple design



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Timothy Letters has extensive experience in patent, trademark and design matters in Hong Kong, China and Southeast Asia, and is recognised in the *IAM Patent 1000* for his “sublime blend of technical and commercial savvy”.

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registration may be renewed, licensed or assigned separately, if required. Procedurally, it may be advantageous to file separate design applications, as an issue arising in respect of only one of the designs in the multiple design application may result in a delay to all of the designs covered by the application. Accordingly, if swift registration is sought for enforcement or commercial reasons, separate design applications should be filed.

### Enforcement

The registered owner or exclusive licensee of a registered design may exclusively enforce the rights conferred by it.

The test for infringement of a registered design under Hong Kong law is whether an infringing article is “not substantially different from” the registered design.

All actions for infringement of IP rights (including design rights) may be heard before the High Court or the District Court, depending on the nature of the claim.

As in most common law jurisdictions, available remedies include injunctive relief, awards of damages or accounting of profits and orders for delivery up of infringing articles.

Although the Registered Designs Ordinance was enacted only in 1997, in view of the similarities between the ordinance and the UK Registered Designs Act, Hong Kong courts have a vast body of law and jurisprudence on which to draw when hearing registered design infringement actions.

Groundless threat provisions exist under Hong Kong law, so due care must be taken before alleging infringement or asserting one’s rights, as statutory penalties may apply.

### Ownership changes and rights transfers

An assignment of rights in a registered design is void unless it is in writing and executed by the assignor. Where co-owners are involved, one co-owner cannot assign or license its share of rights in the registered design without first obtaining the consent of the other co-owners.

For recordal purposes, the filing of a simple copy of the assignment instrument at the Designs Registry will suffice to prove

the assignment transaction; notarisation, legalisation or certification is not required. However, the assignment instrument must expressly recite the registration number of the registered design being assigned.

It is not compulsory to record an assignment of rights or an exclusive licence; however, if such transaction instrument is not filed within six months of the date of the transaction instrument or as soon as practicable thereafter, it may adversely affect the ability to claim an award of damages or accounting of profits or create difficulty for an exclusive licensee to enforce the rights.

### Related rights

Under Hong Kong law, copyright protection for industrially applied articles that incorporate an unregistered design continues for 15 years from the end of the calendar year in which the article is first marketed. Where an article incorporates a registered design, copyright will co-exist with the registered design rights for 25 years from the end of the calendar year in which the article is first marketed.

Although it is not necessary to register copyright in Hong Kong, a declaration of originality of the 3D product and 2D labelling must be furnished during enforcement proceedings.

An assignment instrument transferring ownership and entitlement of a registered design right should also assign the copyright, for the sake of thoroughness. **WTR**



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