

Design Protection in the Hong Kong Special Administrative Region

What is a design?

Design elements of a wide range of products such as the shape, configuration, pattern or ornament of an article can be registered as registered designs provided that they appeal to and can be judged by the eye in the finished article.

Owners of registered designs have the right to prevent others from manufacturing, importing, using, selling or hiring out their design products.

Territorial protection of registered designs

The design registration system of the Hong Kong Special Administrative Region (the Hong Kong SAR) provides territorial protection. Hence, designs registered with the National Intellectual Property Administration of the People's Republic of China or designs registries of other countries or regions do not automatically receive protection in the Hong Kong SAR. In order to obtain protection as registered designs in the Hong Kong SAR, designs must be registered under the Registered Designs Ordinance (Chapter 522) and the Registered Designs Rules (Chapter 522A) of the Hong Kong SAR.

Why register a design?

If you have registered a design, you will have the exclusive right to the design in relation to the article for which the design is registered. If other people use it in the course of trade or business in the Hong Kong SAR in relation to the same or similar articles without your consent, they may be liable for infringement of your design and you may take legal action against him.

The period of protection of a registered design is renewable for periods of five years, up to a maximum of 25 years.

Filing your design application

You should complete the application form and fill in an address for service in Hong Kong and send it to the Designs Registry (the "Registry") of the Intellectual Property Department (IPD) of the Government of the Hong Kong SAR. The application fee for the registration of a single design includes a filing fee of HK\$785 and an advertisement fee of HK\$155. For the details of the application forms and fees, please refer to the website of the IPD of the Hong Kong SAR Government at http://www.ipd.gov.hk/eng/forms_fees/design.htm.

How to classify the articles?

You must list out in your application form the articles in respect of which you wish to register your design. You should also classify the articles according to the class or classes in the International Classification for Designs (“the Locarno Classification”). You may refer to the latest edition of the Locarno Classification at <http://www.wipo.int/classifications/fulltext/locarno/enmn01.htm>.

If you wish to apply for registration of a design in respect of “graphic symbols and logos, surface patterns, ornamentation” in Class 32 sub-class 00 of the Locarno Classification, you need to specify the article(s) to which the Class 32 sub-class 00 items are to be applied. For example, if you wish to seek registration of a design in respect of an “ornamentation” and the ornamentation is to be applied to handbags, you may specify the article as “ornamentation for handbags” in your application for registration.

If you file an application for registration of design and wish to claim priority in your application based on a previous application for registration of the same design filed in a Paris Convention country or a World Trade Organization member, you are required to specify the article and the class in your application form as mentioned in the preceding paragraph even if such previous application is classified in Class 32 sub-class 00.

How does the Designs Registry process an application for registration of a design?

The process of examining an application for registration can be divided into the following stages:

- examination of the filing date,
- formality examination,
- registration and issue of certificate of registration.

If there is no deficiency in your application and all requirements for registration are met, the application will be accepted for registration. The whole registration process may require as little as three months from the date of receipt of application by the Registry.

The first stage – examination of the filing date

Shortly after receiving the application, the Registry will send a notice to the applicant,

giving the filing date of the application.

The filing date is the date that the Registry receives the following:

- a request for registration of the design,
- a representation of the design suitable for reproduction,
- applicant's name and address, and
- the fees.

The filing date will be the registration date from which the period of registration starts. It is also the date for determining the novelty of the design (unless priority is claimed).

The second stage – formality examination

After informing the applicant of the filing date, the Registry will examine the formalities of the application. The formalities are the information required in the application form. The Registry does not conduct substantive examination on the application (e.g. whether the design is a new design or not), nor does it search records of prior registered designs.

If the application is not in order, the Registry will give notice to the applicant to correct the deficiencies within three months. Failure to correct deficiencies may result in the application being deemed withdrawn.

The third stage - registration and publication

If an application is in order, the Registry will register the design, publish the registration in the Hong Kong Intellectual Property Journal (http://www.ipd.gov.hk/eng/ip_journal.htm) and issue a certificate of registration.

Usually a certificate of registration can be issued within three months after an application is filed. A registered design owner can bring civil proceedings for infringements committed after the certificate of registration is issued.

Recommendation - What strategies should you adopt to protect your design in the Hong Kong SAR and separately in Mainland China?

You may consider adopting the following strategies to protect your design:

- Only the owner of a design is entitled to register a design. An owner may obtain ownership by commissioning the creation of the design, or under an employment

contract to create the design or by assignment of the design, etc.

- Only new designs are registrable. You need to keep your design confidential until you file an application to register it. Using your design in manufacturing, publishing it, or disclosing it, for example by publishing it in a catalogue or placing an order to manufacture the design product, before filing may mean that even if your design becomes registered, the registration will be invalid because your design could not be considered as new on the date of application.
- It is only in limited circumstances that disclosure does not destroy the novelty of a design. Section 9 of the Registered Designs Ordinance of the Hong Kong SAR provides for the specific circumstances of and requirements for confidential disclosure. If you need to disclose details of your design before filing an application to register it, you should take professional advice to ensure that the novelty of your design would not be destroyed upon disclosure.
- You should register your design both in the Hong Kong SAR and in the Mainland where there are separate systems of registration and protection. **Registering your design in the Mainland does not automatically give you protection in the Hong Kong SAR.**
- You should apply to register your design as soon as possible to ensure that it is available for use in your business and that you can take immediate action against any infringement.
- You may consider taking legal action under the Registered Designs Ordinance of the Hong Kong SAR in case of any infringement of your design taking place in the Hong Kong SAR.
- Most importantly, you should seek professional advice from an intellectual property lawyer or agent with regard to all aspects of your intellectual property rights, including trademark, copyright, patent or registered designs.

Online search

The IPD provides a free online search service at esearch.ipd.gov.hk, through which you may check information on registered designs and the persons or companies who own the designs.

E-filing Services

To file design forms via the IPD's E-filing System, you need to register as a user of electronic services with the IPD first. Every user of electronic services must provide an

address for service in Hong Kong and possess an electronic certificate issued by a recognized certificate authority. For information on e-filing services, please refer to the IPD's website at efiling.ipd.gov.hk.

Relevant websites

- Details on application forms and fees:
http://www.ipd.gov.hk/eng/forms_fees/design.htm
- The International Classification for Designs:
<http://www.wipo.int/classifications/fulltext/locarno/enmn01.htm>
- Hong Kong Intellectual Property Journal:
http://www.ipd.gov.hk/eng/ip_journal.htm
- Online search service:
esearch.ipd.gov.hk
- E-filing services:
efiling.ipd.gov.hk

Further Information

If you require help or more information, please contact the Designs Registry at:

Intellectual Property Department
24/F, Wu Chung House
213 Queen's Road East
Wanchai
Hong Kong
Telephone No.: (852) 2961 6901

Alternatively you may wish to email to enquiry@ipd.gov.hk
or visit our website at <http://www.ipd.gov.hk/>

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Important Notice

This publication only gives a brief introduction to design protection in the Hong Kong SAR. It does not seek to be exhaustive and is not meant to give legal advice. For legal advice on design protection, please seek professional opinions from an intellectual property lawyer or agent.

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