Intellectual Property Department, Hong Kong SAR Government

Duty Lawyer Service
Legal Advice Scheme

Trade Marks, Patents and Registered Designs

Intellectual Property Workshop
by
Intellectual Property Department

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Intellectual Property Department, Hong Kong SAR Government

Trade Marks
Trade Marks Ordinance

- First Trade Marks Ordinance was passed in 1873
- Trade Marks Ordinance (Cap. 43) came into effect in 1955
- Trade Marks Ordinance (Cap. 559) came into effect on 4.4.2003

What is a “trade mark”

- Sign
- Capable of distinguishing the goods/services of a proprietor from others’
- Capable of being represented graphically

(Section 3(1), TMO)
Sign

• A trade mark may consist of various kinds of signs, including:
  – words
  – designs
  – shapes

(Section 3(2), TMO)

Classification of goods/services

• The application should specify the class(es) of goods/services in respect of which the trade mark is proposed to be registered
• The classification of goods and services follows the “Nice Classification” (8th edition)
• Classes 1-34: Goods
• Classes 35-45: Services
Multi-class application

Application for registration of a trade mark can be made in respect of more than one class of goods/services

Grounds of objection against registrability of trade marks

• Absolute grounds: section 11, TMO

• Relative grounds: section 12, TMO
Absolute grounds (1):

• Devoid of distinctive character (section 11(1)(b), TMO)

• Meaning: When seeing the sign on the goods or services, consumers are unlikely to perceive it as indicating trade origin.

Absolute grounds (2):

• Consist exclusively of signs which may serve to designate the characteristics of goods/services (section 11(1)(c), TMO)
Absolute grounds (3)

- Objections under sections 11(1)(b), (c) can be overcome by establishing that the subject mark has in fact acquired a distinctive character as a result of the use made of it (section 11(2), TMO)

Absolute grounds (4):

- Contrary to morality
- Likely to deceive the public
- Use prohibited by law
- Application made in bad faith
- National/regional flag, emblem or its design (sections 11(4), (5), (6), TMO)
Relative grounds (1)

- Identical marks + identical goods/services
- Identical marks + similar goods/services + likely to confuse
- Similar mark + identical/similar goods/services + likely to confuse

(section 12, TMO)

Relative grounds (2)

- How to overcome objections on relative grounds
  - Obtaining consents to the registration and use of the subject mark in the applied-for goods/services from the owner of the earlier trade mark
    (section 12(8), TMO)
  - There has been an honest concurrent use of the subject mark
    (section 13, TMO)
Trade mark examination procedure

• Application on Form T2
• Deficiencies checking
• Examination
• Publication
• Opposition, if any
• Registration

Term

• 10 years + (10 x n) years

(section 49, TMO)
Revocation

- No genuine use in Hong Kong for 3 years;
- The trade mark has become the common name in the trade; or
- Mislead the public as to the nature, quality or geographical origin of the goods/services

(section 52(2), TMO)

Invalidation of registration

- Absolute grounds
- Relative grounds

(section 53, TMO)
Infringement (1)

- S18(1) of TMO:

  Use in the course of trade or business
  an identical sign in respect of identical goods/services

Infringement (2)

S18(2),(3) of TMO:

Use in the course of trade or business
- an identical sign in respect of similar goods/services, or
- a similar sign in respect of identical or similar goods/services

and the use is likely to cause confusion on the part of the public
Infringement (3)

“Use”
• Packaging
• Sale
• Imports/exports
• Business papers/advertising

(section 18(5), TMO)

Infringement (4)

Remedies
• Damages
• Injunctions
• Accounts for profits
• Order for delivering up
• Order for disposals

(sections 22(3), 23, 25, TMO)
“Passing off”

- Goodwill
  - Associated with the use of the mark or sign
  - Attracts consumers or business
- Misrepresentation
  - As to the source, quality, etc. of the goods/services
- Damage
  - The misrepresentation causes or is likely to cause damage

Criminal sanctions (1)

- Forges any trade mark
- Falsely applies to any goods a mark resembling a trade mark as to be calculated to deceive
- Makes/disposes of/possesses any instrument for forging a trade mark
- Sells/manufacture, any goods with a forged trade mark

(section 9(1), (2), Trade Descriptions Ordinance)
Criminal sanctions (2)

• Import or export goods with a forged trade mark

(section 12, Trade Descriptions Ordinance)

Criminal sanctions (3)

• “Trade marks” include
  – trade marks registered in Hong Kong under the TMO
  – trade marks registered in a Convention country

(section 2, Trade Descriptions Ordinance)
Criminal sanctions (4)

Penalties

• Indictment: HK$500,000 and to imprisonment for 5 years
• Summary: HK$100,000 and to imprisonment for 2 years

(section 18, Trade Descriptions Ordinance)

Patents
Patents laws

- Patents Ordinance, Cap. 514
- Patents (General) Rules, Cap 514C
- Effective on 27 June 1997

Rights of the owner of patent

The owner of a patent has the right to prevent others from

- Manufacturing
- Using
- Selling or
- Importing
his patented invention without his consent

(section 73, PO)
Patentability

• Novelty;
• Involve an inventive step; and
• Capable of industrial application

(sections 93-97, PO)

Novelty

• Not forming part of the state of the art
• Before the filing of the application, not having been disclosed to the public by means of a written or oral description, by use or in any other way

(section 94, PO)
Inventive step

• Not obvious to a person skilled in the art

(Section 96, PO)

Capable of industrial application

• Can be made or used in any kind of industry, including agriculture

(Section 97, PO)
Exclusions to patentability

Generally not regarded as inventions and not registrable: -

• Discovery
• Scientific theory
• Mathematical method
• Aesthetic creation
• Scheme, rule or method for performing a mental act, playing a game

(Section 93(2), PO)

Types of patents

• Standard patents – 20 years
  (Section 39, PO)

• Short Term Patents – 8 years
  (Section 126, PO)
Standard Patents

- Application at a designated patent office
  - State Intellectual Property Office, the PRC
  - UK Patent Office
  - European Patent Office (designating UK)

1st stage: request to record published patent application

- File a request to record in Hong Kong, China within six months after the publication of the designated patent application in the designated patent office

(.section 15, PO)
2nd stage: request for registration and grant

- Need to file a **request for registration and grant** in Hong Kong **within six months** after publication of the request to record in Hong Kong or the grant of the designated patent by the designated patent office

(section 23 PO)

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**Short-term Patent**

- Direct application in HKSAR

- Single-stage application
Infringement (1)

- Direct use of patents
- Indirect use of patents

(sections 73, 74, PO)

Infringement (2)

Remedies
- Damages
- Injunctions
- Accounts for profits
- Order for delivering up or disposal

(sections 80 PO)
Registered Designs

Registered Designs Ordinance

Registered Designs Ordinance, Cap 522
Registered Designs Rules, Cap 522A
Designs

- “Designs” mean features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye

(section 2, RDO)

Novelty (1)

- The design should be new at the time of the application for registration

(section 5, RDO)
Novelty (2)

- To be regarded as new, the design should be different from:
  - any prior registered designs
  - any designs that have been published in Hong Kong or elsewhere

(section 5, RDO)

Exclusions from registration

- A method or principle of construction (section 2, RDO)
- Functional features (section 2, RDO)
- Appearance of article is not material (section 6, RDO)
- Contrary to public order (section 7, RDO)
- Computer programs and protected layout-designs (topographies) (section 8, RDO)
Rights of the owner of registered design

The owner of a registered design has the right to prevent others from

• Selling
• Hiring
• Making for the purpose of trade or business

his registered design without consent

(section 31, RDO)

Term of protection

• Registered design protection is renewable for periods of five years up to a maximum of 25 years

(section 28, RDO)
Application for registration

Formality Examination
• After giving the filing date, we will examine the formalities of the application. The formalities are the information required in the application form. There is no substantive examination of the application and the Designs Registry does not search records of prior registered designs

Thank you