

**GUIDE TO THE NEW
DESIGNS ORDINANCE**



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*M Grewal & Co is a law firm dealing with
Intellectual Property & Commercial Law and High Court Litigation*



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THE NEW DESIGNS ORDINANCE

Article 139 of the Basic Law requires the

Hong Kong Special Administrative Region (HKSAR) on its own to formulate policies on science and technology and protect by law achievements in scientific and technological research, patents, discoveries and inventions. While this does not specifically refer to designs the view taken by the legislators is that the new independent design law is compatible with the provisions of the Basic Law.

The new Designs Ordinance came into force on 27th June, 1997. The Ordinance establishes a Designs Registry and for the first time in Hong Kong's history provides for the registration of designs in Hong Kong. The Ordinance is largely based on the UK Registered Designs Act 1949 (as amended by the UK Copyright, Designs and Patents Act 1988) with modifications to suit local Circumstances.

Prior to the enactment of the Ordinance design protection in Hong Kong was obtained by merely registering the design in the United Kingdom. There were no additional procedures for re-registration of designs in Hong Kong and, provided that the design remained registered in the United Kingdom, it was enforceable in Hong Kong. Thus protection in Hong Kong was totally dependent on obtaining and maintaining design registration in the UK.

DESIGNS

Designs are features of shape, configuration, pattern or ornamentation which are applied to an article by any industrial process, which features have an aesthetic appeal in the finished article. Aesthetic appeal does not require the design to have artistic merit.

Features of shape dictated by function or which

are dependant on the appearance of another article with which the article forms an integral part are excluded from design protection.

REGISTRABILITY

Registration of designs requires the design to be new as at the date the application is filed, or, if priority is claimed from an application in another jurisdiction, as at the priority date.

A design is not regarded as new if:

- it has been published in Hong Kong, or any where else in the world, before the filing date of the application. It is immaterial whether the prior publication is in respect of a different article; or
- if the design has been registered by a prior applicant regardless of whether it is registered in respect of the same or a different article.

Novelty is judged on a worldwide standard, rather than just local novelty.

Designs are not registrable in respect of articles if the appearance of the article is not a material consideration.

The owner of a registered design can apply for registration of the same design for other articles, or registration of a similar design to the registered design, in respect of the same article or other articles, without loss of novelty. Novelty is not lost if the application for registration is withdrawn.

APPLICATION

All applications are filed at the Hong Kong Design Registry. The applicant must file a representation of the design, provide a statement of novelty, pay the fee and give an address in Hong Kong for service. Applications can be filed in English or Chinese.

An applicant can claim priority from design applications filed in a Paris Convention country or WTO member country within 6 months from the date of filing.

EXAMINATION & REGISTRATION

The Registry does not carry out an examination as to novelty of the design, or even whether the design is properly represented in the application. It merely examines the application to ensure it complies with the formalities. Provided the application satisfies the formalities, the Registrar will issue a certificate of registration, publish a representation of the design and advertise the fact of registration in the Gazette.

The Registrar may refuse the application if the design is not new on the face of the application, or is not registrable for any other reason.

TERM

Registration is for 25 years from the date of filing of the application and renewal fees are payable every 5 years. If the renewal fees are not paid within the time limit the registration will lapse. It is possible to restore the registration by payment of the renewal fee and additional fee, within 6 months from the renewal date.

Where the design was based on a corresponding artistic work in which copyright subsists then, if the copyright expires prior to the term of design registration, the design registration expires when the copyright in the artistic work expires and cannot be extended beyond this.

EXCLUSIVE RIGHTS

Registration gives the owner the exclusive right to make in, or import into Hong Kong,

articles in respect of which the design is registered. The owner of the registered design can thus stop others from making, importing or selling articles bearing the design which is the same as, or substantially similar to the registered design.

The owner of the registered design can also stop anyone doing anything in relation to a kit that would be an infringement of the design, if it had been done in relation to the assembled article. A third party can also be stopped from making anything for a kit to be made or assembled, whether in Hong Kong or elsewhere, if the assembled article would be the same as or substantially similar to the registered design.

It is also an infringement of the exclusive right to make anything for enabling an infringing article to be made in Hong Kong or elsewhere. Thus manufacturing tools or equipment to enable someone else to infringe the design, is actionable.

LEGAL PROCEEDINGS

Proceedings for infringement can be commenced in the High Court only after the certificate of registration has been issued.

REMEDIES

The full range of remedies are available to the registered owner of the design and an exclusive licensee, who has registered the licence, as are available for infringement of any proprietary rights. In an action for infringement the registered owner is entitled to seek an injunction and damages or an account of profits and delivery up of infringing copies and tools.

There are no criminal sanctions for infringement of registered designs however falsely representing that a design is registered is an offence.

Any person may seek revocation of the design registration by application to the Registrar at any time after the design has been registered. The Registrar may refer the matter to the High Court or may determine the issue himself.

DESIGN/COPYRIGHT OVERLAP

There has always been an overlap in the law between copyright and designs. In the past people have sought to enforce copyright in their drawings for articles, rather than seek design registration. This had led to the bizarre situation where registered designs, which were deemed worthy of greater protection, enjoyed protection for 25 years, but unregistered or unregistrable designs, which were deemed worthy of lesser protection, enjoyed copyright protection for life of author plus 50 years!

To eliminate this anomaly registered designs now have concurrent copyright protection for 25 years from the first marketing of the article. After 25 years the artistic work may be copied by making articles of any description and this will not be an infringement of the copyright.

To encourage design registration and to make sure unregistrable designs do not enjoy greater protection, designs which are registrable, but have not been registered, and unregistrable designs only enjoy copyright protection for 15 years from the end of the year in which articles incorporating the unregistered design were first marketed.

TRANSITIONAL PROVISIONS

Any design registered in the UK under the Registered Designs Act (1949), prior to 27th June 1997 is deemed to be registered under the new Ordinance in respect of articles for which it is registered in the UK. The position is the same for any application for design registration which was pending on or before 27th June 1997 and where the design was registered after 27th June 1997. No fee is payable.

In order to ensure payment of renewal fees the initial period of "free" registration expires on the date on which the next renewal fee is payable in the UK. The Hong Kong design registration can then be renewed at 5 year intervals for a maximum period of 25 years from the date of initial filing in the UK.

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