The Hong Kong Institute of Trade Mark Practitioners
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16 March 2026

BY EMAIL (design_consultation@cedb.gov.hk) and BY POST

Division 3, Commerce and Economic Development Bureau
23rd Floor, West Wing Central Government Offices
2 Tim Mei Avenue, Tamar
Hong Kong

Dear Sirs,

Review of the Hong Kong Registered Designs Regime

Background

1. This submission is made by The Hong Kong Institute of Trade Mark Practitioners Limited ("**HKITMP**"), the membership of which consists of solicitors, barristers, trade mark agents and patent agents, who are principally engaged in trade mark and other Intellectual Property practices. The HKITMP's aim is to protect the interests of trade mark and other Intellectual Property rights owners, for which purpose we are active and in regular liaison with the Intellectual Property Department and other relevant industry bodies.

2. This submission on behalf of the HKITMP has been prepared by the HKITMP Patents and Designs Committee, consisting of Council members who have a particular interest and expertise in patents and registered designs. The views expressed are from a legal and policy perspective in our capacity as solicitors and Intellectual Property law practitioners, acting independently without regard to the views of any particular other body or organization.

Submission

3. The HKITMP welcomes the Government's review of the registered designs regime in Hong Kong. This review is an important initiative which will ensure Hong Kong's IP regime is updated with developments in the economy and more consistent with international practice and legal frameworks. Time marches on, and the current Registered Designs Ordinance (RDO) – unchanged since 1997 – needs to be updated. Much has changed since the passage of the RDO including new manufacturing techniques, increased relevance of the digital economy. This has in turn been driven by and drives change in other design protection and enforcement frameworks in other jurisdictions around the world.

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4. Although the RDO needs updating, many aspects can be retained. We support retaining the current novelty requirement, formality examination procedure, protecting the design in terms of the product in respect of which it is registered, and 25-year registration term without change. We also support maintaining the current overlapping protection of registered design rights and copyright.

5. Design protection should be broadened from the narrowly enumerated "features" of shape, configuration and pattern and ornamentation to "the appearance of a product". The "industrial process" requirement should be deleted. A general 12-month pre-filing grace period as well as a 12-month deferred publication mechanism would be useful inclusions. We also recommend clear identification of an owner for registered designs for legal certainty.

6. We further elaborate on these comments in the enclosed 'Specific Responses to Consultation Questions'.

Further Remarks

7. We appreciate the opportunity to provide comment and participate in the review of Hong Kong Registered Designs Ordinance, a reform which is both necessary and overdue.

8. We can be available to address any queries that the Government may have on the response. We would also welcome the opportunity to participate further in this process.

Yours faithfully,

Valerie Suen
President
The Hong Kong Institute of Trade Mark Practitioners

Encl.

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SPECIFIC RESPONSES TO CONSULTATION QUESTIONS

Chapter 2 – Definitions of "Design" and "Article"

2.18(a)(i)

Do you agree that the subject matter for design protection in Hong Kong should shift from the traditional approach of "features applied to an article" to "the appearance of a product"? Please explain.

Answer:

AGREED

Many of our applicants seeking design protection in Hong Kong do wish to seek protection specifically for aspects of colour of their design which fall outside the specified categories of statutory protection under the current ordinance.

Rather than enumerating the specific features which may be protected, it is felt that the approach of defining a design as the appearance of a product resulting from features provides maximum flexibility and is consistent with the evolutionary principles of Hong Kong's common-law, as well as being able to protect features which may develop as technology evolves (textures, animation, GUI icons etc). This is also more consistent with the international approach to design protection.

2.18(a)(ii)

Do you agree that the specific requirement that a design must be applied to an article "by an industrial process" should be removed in view of the latest and emerging technologies in manufacturing? Please explain.

Answer:

AGREED

The capability of decentralized three-dimensional printing approaches/ digital economy developments does render this requirement otiose. This is especially the case given that other jurisdictions do not have a similar requirement.

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2.18(a)(iii)

Regardless of whether or not the definition of "design" should be amended, do you agree that relevant features other than shape, configuration, pattern and ornament should also be specified? If so, what other design features do you think should be included to reflect the aspects of the design of a product that are considered valuable and important to its design (e.g. colour, lines and contours, or even moving elements)? Please explain.

Answer:

AGREED

As noted above, expectation of many design applicants in Hong Kong are that such design protection will provide protection for the appearance resulting from broader aspects than just the enumerated specific heads of pattern and ornamentation and shape and configuration.

2.18(a)(iv)

Do you think that providing a non-exhaustive list of design features (with specified examples of protectable features) in the definition of "design" would be appropriate? Please explain.

Answer:

NEUTRAL

There is an argument that providing a non-exhaustive list could potentially assist unskilled and/or unrepresented applicants in filing their own design. However, great care would need to be taken to ensure that such list was expressed to be nonlimiting and exemplary only.

Consideration would also have to be given as to how such list would be updated to remain current so that the specified examples of protectable features also remained current.

2.18(b)(i)

Do you agree that the reference to "article" in the RDO should be replaced by "product"? Please explain.

Answer:

AGREED

HKITMP confirms that this proposal would seem appropriate and more consistent with international approaches, especially if the "industrial process" requirement (noted above) is removed. It is felt that the use of the term "product" carries an implication of being associated with a commercial endeavour, rather than simply being an "article".

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2.18(b)(ii)

Do you think that Hong Kong's registered designs regime should also afford protection to designs applied to handicraft or handmade items in addition to industrial items in the traditional sense? Please explain.

Answer:

NEUTRAL

HKITMP does not have a strong view either way. It is believed that the costs associated with registering handicraft designs for small/limited production (below an "industrial" threshold number of articles) would be prohibitive for most handicraft producers. If the bar is set too low; without substantive examination this could potentially also lead to uncertainty of the scope of the designs on the register.

Chapter 3 – Scope of Design Protection

3.19(a)(i)

What types of virtual designs should or should not be protected under Hong Kong's registered designs regime? Please elaborate.

Answer:

The current protection afforded by copyright and existing designs would seem sufficient.

If design protection were broadened to include virtual designs, it would be preferable to require that the nature of the design and intended use are specified; in keeping with the emphasis on article/product.

3.19(a)(ii)

Do you think that the registrability for virtual designs should correlate to a physical product, or depend on characteristics such as the design's relevance to human interaction or its functionality in relation to the product? Please explain.

Answer:

To require functionality for virtual designs would seem to be inconsistent with the general approach of designs protecting aesthetic creations.

For example, consider the non-functional design elements (physical and virtual devices) which may be included in a "headsup" display projected onto a car windscreen. Other than observing these icons, a user does not "interact" per se with these designs, but to exclude them from registrability on this basis seems somewhat arbitrary.

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3.19(a)(iii)

Do you think other existing forms of IP protection, in particular copyright, are appropriate forms of protection for virtual designs? Please explain.

Answer:

Copyright could potentially protect such designs, but would need also to be subject to the general principles of copyright/design overlap.

3.19(a)(iv)

Should registered design protection be extended to virtual designs, would the resulting overlap with other IP rights give rise to legal uncertainty or unintended legal consequences? Please elaborate.

Answer:

Permitting virtual designs to be registered could lead to an inconsistent register if clear guidance were not provided of representations used, whether transient/static or animated designs can be protected. If protection to virtual designs is extended, it would also be necessary to broaden the bundle of exclusive rights offered by design registration to a design owner to extend to copying, downloading etc.

3.19(b)(i)

Do you think the current legal requirement that a part of an article must be "made and sold separately" is sufficiently accurate to define the scope of component and spare parts, or do you prefer the concept of "complex product" for this purpose? Please explain.

Answer:

The "made and sold separately" requirement seems somewhat out of step from the international approach of the "complex product".

This requirement exposes designs that, in substance, constitute constituent elements of a larger or more complex product - and are therefore not made and sold separately - to potential challenges to validity.

By way of illustration, it may render a partial design, in which the unclaimed portions are depicted in dashed lines, or a component of a complex article, susceptible to validity attacks. Furthermore, GUI designs, which by their nature do not satisfy the "made and sold separately" requirement, fall outside the scope of the current definition.

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3.19(b(ii)

Do you consider the "must fit" exclusion preferable to the "must match" exclusion for excluding protection for designs of spare parts? Please explain.

Answer:

"Must fit" exclusion is a narrower and more certain exclusion than the "must match" exclusion. The "must fit" exclusion is therefore arguably already present in the exclusion of designs with features which are solely dictated by function. "Must match" exclusion seems more subjective and a more difficult area.

3.19(b)(iii)

Instead of the "must match" exclusion, would a "right to repair" be a more appropriate means of addressing the right for a consumer to repair a product? Please explain.

Answer:

Right to repair is a more difficult and separate issue which would require detailed investigation and potentially standalone legislation. This would seem to be a relatively disproportionate investment of time and resources for questionable return given the HK market size and complexity of this legislation in other regions/jurisdictions.

3.19(c)

Do you think that Hong Kong's laws should be relaxed so that partial designs, whether made or sold separately, are registrable in their own right as registered designs? Please explain.

Answer:

Provided that the partial designs have their own individual character and features, it does seem appropriate in view of international trends to provide for the registration of partial designs for products which are component parts of a complex product.

Chapter 4 – Novelty & Examination of Novelty

4.19(a)(i)

Do you consider the current novelty requirement under the RDO sufficient and effective to meet the needs of the design industry? Please explain.

Answer:

The current approach under the RDO provides a cost-effective platform, with formality examination only. It may be useful to introduce a requirement for pre-enforcement examination, if there is a demonstrable harm that has arisen from enforcement of unexamined designs.

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It is expected that legal costs and prospect of damages being awarded adverse to a design holder are sufficient to dissuade such applicants from knowingly asserting designs which are invalid e.g. through lack of novelty.

4.19(a)(ii)

Do you agree that introducing into the legislation an additional registrability requirement guided by the overall impression produced by a design by reference to its individual character or distinctiveness would set a more appropriate threshold for registrability of a design for the contemporary market? Please explain.

Answer:

DISAGREE

It would seem that introducing an additional legislated registrability requirement would be difficult to articulate and unnecessary.

The approach used in ascertaining relevant features and weighting on the overall impression of a design are clearly outlined in relevant case law decisions, which also provide guidance on applicability.

Inherently, some features will need to be weighted more than others; and the evaluation is on a case-by-case basis.

This common law approach provides flexibility, and adaptability which can accommodate changes in subject matter, technology and approach in an overall framework.

4.19(a)(iii)

If your answer to question (ii) is in the affirmative, should the local legislation also lay down the approach and the factors (such as "informed user", "degree of freedom of the designer") for assessment of difference in overall impression? Please elaborate.

Answer:

Not applicable.

4.19(b)(i)

Do you agree that the current formality examination procedure (i.e. generally requiring only formality examination to be conducted for a design application) should be retained? Please explain.

Answer:

AGREED

Yes, as it provides a cost effective and efficient framework for design protection.

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4.19(b)(ii)

Should your answer to question (i) be in the affirmative, do you consider it justifiable and necessary to consider introducing any enhancement measures adopted by overseas jurisdictions as discussed in paragraphs 4.15 and 4.16 above? Please explain.

Answer:

Discussed above.

Chapter 5 – Exclusive Rights & Ownership

5.14(a)(i)

Do you consider the current scope of exclusive rights provided for registered designs under the RDO adequate? Please explain.

Answer:

In an era of disintermediated infringement (made possible by 3D printing and AI copying) it would seem appropriate to broaden the definition of 'infringing act' which a design holder obtains.

5.14(a)(ii)

To facilitate diverse legitimate uses of designs and promote effective commercialisation of the designs, particularly by making use of new technologies or digital platforms, do you consider it preferable for the scope of exclusive rights be broadened, such as to cover any business/commercial use of a registered design? Please elaborate.

Answer:

Given the advances in AI/3D printing it may be preferable to consider expanding protection along the lines of that proposed in the EU for design rights.

This would especially be important if the scope of what can be protected by a design were extended to include virtual designs. A design owner of such design would need to have rights broad enough to cover any business/commercial use of such design including:

"creating, downloading, copying and sharing or distributing to others any medium or software which records the design for the purpose of enabling a product to be made".

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5.14(a)(iii)

Do you consider it justifiable for protection of a registered design be limited to the article in respect of which the design is registered, or alternatively be extended to any article in which the design is used? Please explain.

Answer:

If designs are registered to specified products, provided such "products" (description selected/ specified by the applicant) is both specified and construed broadly, then this would seem to balance the rights of the designer and the public.

5.14(a)(iv)

Do you agree that the existing statutory exceptions under the RDO adequately strike a fair balance in addressing the reasonable uses of designs by members of the public? If not, please explain and elaborate what specific exception(s) ought to be introduced.

Answer:

Exceptions seem appropriate.

5.14(b)

In respect of commissioned designs, do you agree that it is more proper to treat the designer as the original owner of the design, subject to any agreement to the contrary? Please explain.

Answer:

This is a difficult question. The position is relatively clearer under employee/employer relationship with the employer generally retaining title for IP rights created in the course of employment.

Anecdotally, the position under copyright law where the first author of the work owns copyright in that work (absent express agreement) creates some issue for unsophisticated clients as it is contrary to their expectations.

Commercially, in the absence of an agreement expressly retaining the design rights to the party commissioning the work, most clients seem to have the expectation that in paying for the work they will own the design rights to the work.

It is of course preferable for the ownership of any IP rights created as commissioned works to be clearly specified by contract.

It is submitted there is no need necessarily to converge the position across the various types of IP rights, which protect different aspects of an inventor/designer/author's creation and evolved as a result of different economic and social considerations.

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Chapter 6 - Facilitation Measures

6.18(a)(i)

Do you agree that the scope of the current grace period prescribed in the RDO should be relaxed to cover disclosure of a design by the design owner for any purpose? Please explain.

Answer:

PARTIALLY AGREED

The inadvertent pre-filing disclosure by some applicants can prejudice the novelty of any subsequent design filed. The current 'grace' period provisions whereby such disclosures can be ignored only where the disclosure by the owner to any other person in circumstance where it is contrary to good faith for that person to disclosure; or if the disclosure occurs at certain restricted international exhibitions. The exhibitions are extremely narrow and in practice not all that helpful. Furthermore, the is no temporal limitation on the disclosure

However, if disclosure for any purpose were permitted prior to the priority date, then such self-disclosure might be limited either on a purpose or time basis as appropriate.

6.18(a)(ii)

Regardless of paragraph (i), do you agree that the duration of the grace period should be increased from 6 months to 12 months? Please explain.

Answer:

If ANY disclosure in the preceding 12 months may be ignored for the purposes of assessing novelty, then this would appear to be relatively broad and may lead to uncertainty into whether a design has been protected.

HKITMP notes that term of grace period and purpose requires a balancing act; hence if a longer 12-month period were available then it is suggested that there be some restrictions on the purposes for which such pre-filing disclosures may be ignored to avoid uncertainty from a Third-Party perspective.

It is suggested that any grace period for non-prejudicial disclosure is confined to disclosures made within a clearly defined and limited period, so as to provide predictability, prevent abuse, and ensure coherence with the underlying policy objectives of the regime.

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6.18(a)(iii)

If a design owner is allowed to disclose and use a design before filing an application as described in (i) and (ii) without prejudice to novelty, would there be any impact on your business and whether any mitigation would be needed? Please explain.

Answer:

It would be more difficult to conduct design clearance searches; as the register would be incomplete. Further investigation would need to be conducted as to when a potential design applicant first used the product in question; so as to gain an indication as to whether they could potentially subsequently register a design to the product.

6.18(b)(i)

Do you agree to introduce an option for applicants to defer publication of designs? Please explain.

Answer:

AGREED

It would be appropriate for a formal mechanism to defer publication of the design to be introduced.

It would seem appropriate that this were tempered by an "innocent infringement" defence for third parties be available during the non-disclosure period. Bibliographic details might be published during the deferment period, notwithstanding that the underlying representations may not be published.

6.18(b)(ii)

Should the aforesaid option for deferment be introduced, what should be the maximum period of deferment in order to offer designers or manufacturers sufficient flexibility? Please explain.

Answer:

The publication timeframe should be able to be delayed up to 6-12 months from the normal timeframe.

6.18(b)(iii)

On the other hand, would deferment of publication of designs have any impact on your business and whether any mitigation would be needed? Please explain.

Answer:

Answered above.

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Chapter 7 – Application & Registration Formalities

7.15(a)(i)

Do you consider it justifiable that the current statutory requirement on filing priority documents with the Registrar be dispensed with? Please explain.

Answer:

DISAGREE

The applicant in nearly all cases will be able to access the underlying priority documents.

Having the requirement to provide these documents to the Registry should be retained as it is a burden the applicant should bear in order to obtain the design registration. If such priority documents can be provided electronically by the Applicant, then this should be sufficient.

If required, a Third Party may access the priority documents to determine if the priority claim may be substantiated.

7.15(a)(ii)

For those Hong Kong design applications filed after expiry of the 6-month priority claim period, should (and if so under what conditions) the applicants be permitted to request restoration of the right of priority? Please explain.

Answer:

Our experience is that instructors are generally accustomed to the operation of the six-month priority period.

If the subsequent designs are filed outside this period, then having a discretionary extension period creates uncertainty for third parties wishing to determine if a particular design has also been filed in Hong Kong.

If a discretionary extension of the priority period were permitted, it should be permitted for a maximum of one month only; and upon provision of a declaration and evidence demonstrating that despite all reasonable care required by the circumstances, together with payment of an additional penalty fee.

7.15(b)

Do you consider the current requirements for filing multiple designs applications appropriate and practical, namely that the designs must relate to the same class or to the same set of articles? Please explain.

Answer:

Seems appropriate to have multiple designs referring to articles (products) of a similar class or the same set of articles.

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7.15(c)

Do you consider it appropriate to retain the mandatory requirement for a design application to contain a statement of novelty, or should the requirement be removed by making it optional for an applicant to make a statement to highlight the design feature(s) which is/are considered to be new or specifying the part(s) of the design to be disclaimed for protection? Please explain.

Answer:

AGREED

Statement of novelty compels applicants to commit to the scope of protection sought, and can be directed towards features which should have more weight given to them by the court when considering infringement.

Absence of a statement of novelty requirement would make the protection sought more ambiguous.

Of course, necessary changes would need to be made to the associated form(s) to allow applicants to either select design features or specify their own statement.

7.15(d)

Do you agree that the status quo in relation to the term of design protection and renewal of registration should be maintained? If you consider that there is room to enhance any aspect of the current renewal procedures, please elaborate.

Answer:

Term seems appropriate and should be maintained. Requiring payment of renewal fees at five yearly intervals disincentives the maintenance of designs which lack commercial value.

Alignment of current renewal procedure with other rights e.g. patents should be included. A discretionary restoration period, as with patents/patent applications should be possible upon provision of declaration in support of reasonable care being taken, for a six month period after the expiry of the grace period.

7.15(e)

In your experience, is there any real practical issue/matter relating to Hong Kong's registered design application and registration procedures (notably requirements of formalities, documentary requirements or time limits to follow) that you consider should be reviewed or enhanced? Please elaborate.

Answer:

Absence of ability to protect colour. Inconsistency between Examiners as to requirements to disclaim part of an article.

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Chapter 8 – Interplay with Copyright & Unregistered Design Rights

8.18(a)(i)

Do you consider that the current treatment of the interplay of registered design rights and copyright under the CO is sufficiently clear and effective in achieving its objective, and if not, whether and how the current statutory arrangements should be enhanced? Please explain.

Answer:

This is a relatively complex area in Hong Kong (and around the world). Practically, the current system seems to be providing acceptable protection, and an incentive to register design rights in view of the shortened copyright protection term. The impact of the overlap between copyright and designs could be explained more clearly and more education provided to relevant industries/exhibitors at trade fairs/IP education programs etc.

8.18(a)(ii)

Have you encountered any real and practicable difficulty arising from the blurring lines between registered design rights and copyright in enforcing your design rights? Please elaborate.

Answer:

A lack of awareness by applicants of potential loss of protection term arising from the copyright/design overlap issue.

8.18(b)(i)

Do you consider that there is any significant gap in the current domestic registered designs regime (if not otherwise filled in by the copyright regime) resulting in inadequate protection for certain unregistered designs? Please explain.

Answer:

Expanding the features and product protected by designs as discussed already would provide a useful completion of the regime.

8.18(b)(ii)

What are the potential benefits and drawbacks for introducing an unregistered designs regime in Hong Kong?

Answer:

On balance, given the relatively small HK market, and low costs of pursuing registered Hong Kong rights, we do not believe a URD right in Hong Kong.

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It is noted that the URD system creates significant legal uncertainty in whether URD has been extended/obtained; and potentially higher legal costs in ascertaining the actual legal status.

8.18(b)(iii)

If you consider there is a compelling case that Hong Kong should offer certain enhanced protection for unregistered designs, what is the proper scope of such protection, particularly in terms of the kinds of protectable design products, the duration of the protection and the exclusions/limitations pertinent to mitigating the legal uncertainty that may likely be brought onto other market players?

Answer:

Answered above.

Chapter 9 – Alignment with International Design Systems

9.9(a)

When formulating an overall IP strategy for designs or when you are handling related matters for clients as an agent, have you ever considered obtaining registered design protection in jurisdictions outside Hong Kong? If so, which jurisdictions are usually within your consideration?

Answer:

Yes, routinely.

The Chinese Mainland, European Union, Australia, United Kingdom, Japan, South Korea and United States.

9.9(b)

Do you agree that application of the Hague Agreement to the HKSAR would bring real benefits/advantages to not only promoting your business development in multiple jurisdictions but also consolidating the development of Hong Kong as a regional IP trading centre? Please explain.

Answer:

No. Hague agreement experience in CN design implementation is increased uncertainty in protection and office practice, making it more difficult for applicants to secure rights from originating foreign applications