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HONG KONG GROUP OF THE ASIAN PATENT ATTORNEYS ASSOCIATION

RESPONSE TO CONSULTATION ON REVIEW OF REGISTERED DESIGN REGIME

The Hong Kong Group of the Asian Patent Attorneys Association (HKAPAA) is a Recognised Group under the Asian Patent Attorneys Association (APAA) which is officially recognised as an observer by the World Intellectual Property Organization (WIPO). HKAPAA has been established and active in the field of Intellectual Property (IP) field for over 50 years. It is the de facto body for IP professionals in Hong Kong. Its members include the most experienced IP professionals in the field including solicitors, barristers and overseas qualified patent agents and attorneys. It has a close relationship with the Hong Kong Intellectual Property Department and connections with Government and Non-Government Organizations within the Intellectual Property community around the world.

We welcome the opportunity to provide input to the Consultation on Review of Hong Kong's Registered Design Regime, and hope you will find our comments as outlined in this submission helpful.

OVERALL COMMENTS

1. We support the comprehensive review of the Registered Designs Ordinance ("RDO") to ensure Hong Kong's IP regime remains fit for purpose in a rapidly evolving global economy.

2. We agree that some key areas in the RDO do require modernization for Hong Kong to remain relevant and support innovation. The current regime, unchanged since 1997, no longer reflects the realities of the digital economy, modern manufacturing, or international best practices. Reform is essential to maintain Hong Kong's competitiveness as a regional intellectual property trading hub.

3. Reform does not mean revolution and indeed, we find the core architecture of the RDO remains sound. We support maintaining the current novelty requirement, formality examination procedure, protecting design for the article (or product) registered, and having a 25-year registration term without change. Likewise, we also support maintaining the current overlapping protection of registered design rights and copyright. There are arguments for and against introducing an Unregistered Design Right.

4. We support targeted enhancements to update only those parts of the RDO where modernization is needed to keep pace with technology and global practices. We need to shift design protection from "features" to "the appearance of a product", removing the "industrial process" requirement, broadening protection to cover virtual designs, providing a right to repair defence, and allowing a general 12 month pre-filing grace period as well as a 12 month deferred publication opportunity; all of which could better support designers and innovative industry, particularly SMEs and startups who need to disclose their designs for market testing, crowdfunding, or investor pitching before applying for design registration or other businesses who need to delay disclosure of their designs to fit their market launch strategy or related patent filing. We also recommend legislating to require clear identification of an applicant/owner for registered designs, rationales for which include legal certainty, transparency, and harmonization to fit global norms. We further elaborate our comments below with the Consultation questions in bold text and our detailed responses underneath each question.

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:

Yes. Protecting the "appearance of a product" aligns Hong Kong with modern practice and better captures how designers and consumers experience designs. The typical consumer experiences the overall impression rather than the enumerated features of a product – this reality would be better reflected by an "appearance" definition.

Focusing on the product's overall appearance also provides flexibility to recognize attributes beyond the four exhaustive "features" (shape, configuration, pattern, ornament). This change future-proofs the regime for digital and hybrid products.

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:

Yes. Design law should protect appearance and not be concerned with manufacturing method. The requirement that a design must be applied to an article "by an industrial process" was sensible in the past when designs were applied only through traditional mass-production. However, modern realities include additive manufacturing (e.g. 3D printing), handcrafted commercial goods or even virtual objects. For instance, a design for a 3D-printed aerospace prototype cannot meaningfully be tied to an industrial process, but the market value and need for protection are clear. As such, removing the phrase prevents exclusion of valuable designs simply because they are not mass-manufactured.

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:

Yes. In addition to shape, configuration, pattern or ornament, with technological advancements, resulting effects on "products" are theoretically limitless. Hong Kong should recognize colours, lines and contours, texture/surface finish, materials, movement, transition, or their combinations, which may give a product its appearance. These are all elements that constitute modern designs and hence better reflect how consumers today perceive products.

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:

Yes. A non-exhaustive list future-proofs the RDO to accommodate unforeseeable technological evolution. While some may contend that an open list risks legal uncertainty and overly broad interpretations, courts do not automatically grant protection to novel features simply because the list is open – protection still depends on factors such as novelty and must-fit exclusions. Legal certainty depends on established judicial tests, not on a closed list. A non-exhaustive list increases clarity by providing helpful examples without freezing the law which, as it should, can stay technology neutral.

For examples of protectable features, please see our Answer to 2.18(a)(iii).

2.18(b)(i)

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

Answer:

Yes. "Article" implies a tangible, physical object, while "product" reflects modern commercial realities where protectable designs may exist in both physical and non-physical forms (e.g. in a digital environment) and is more all compassing of all features that make up the final "product".

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:

Yes. Contemporary markets feature valuable artisanal brands and small-batch production (e.g. jewellery, leatherwork, craft-tech hybrids). Protecting handmade goods deters look-alikes that exploit the designer's visual identity, regardless of production scale.

Some may contend that affording protection to handmade items may blur the line between artistic works (copyright) and industrial designs, leading to dual-protection uncertainties. However, the copyright-design boundary is not maintained by differences in production methods, but rather substantive tests and exclusions. Whether the product is handmade or industrial is irrelevant in this regard. Besides, Hong Kong already manages overlap through its copyright framework (shortened terms for industrial application). Keeping handmade items outside design protection is not the tool that defines the boundary.

As stated above (in our Answer to 2.18(a)(ii)), we support removing the requirement that a design be applied to an article (or product) by "an industrial process"; hence, when this requirement is gone, it follows that design registration should protect handicraft and handmade items.

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:

Hong Kong should explicitly protect virtual designs where the appearance forms part of a product's user interaction (UI) or functionality. This may include:

- GUIs (graphical user interface) (static or dynamic), icons, screen layouts, transitions/animations integral to user interaction
- AR/VR visual designs that function within or are integral to a product's operation (e.g., virtual shop layout in a metaverse retail experience)
- Typeface/graphic symbol designs when used as applied product elements (e.g., embedded in device UI)
- Holographic designs or projected designs displayed in the operation / functioning of a product (e.g. projected designs on a windscreen; a mask over a light; an arrangement of water jets projecting water)

Hong Kong should avoid protecting standalone virtual aesthetics (without any connection to human interaction or product functionality) under the RDO. For example:

- Purely decorative wallpapers/screensavers with no product function
- Generic logos used in marketing.

Depending on the nature and distinctiveness of features of these examples, protection could be afforded under other areas of law.

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:

Registrability should correlate to product functionality or human interaction, not strictly physical embodiment. Whether a product should be registered should tie to how users experience and operate a product in modern times, which often occur in virtual contexts (especially in the digital economy). Limiting registrability to physical articles instead would exclude commercially significant designs.

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:

No. Copyright alone does not adequately protect virtual designs.

Copyright law protects original artistic expression, not the shape or appearance of a product. It requires human creativity in the expression (i.e. creative authorship). This may exclude certain types of virtual designs from copyright protection. For instance, CAD files for 3D printing often result from automated processes (e.g. algorithmic generation), leaving little room for creative expression. The 3D printed out product may not qualify for copyright protection. To elaborate further, a designer creates an algorithm asking "make a vase starting round at the bottom and becoming squarer at the top, with its body flaring out towards the top like a trumpet and its body surface having smooth wavy ridges", and the software can generate dozens of unique vases; hence, the designer chose the formula and the pattern but never drew the final vase and it becomes arguable whether the final vase is a creative expression of the designer.

Additionally, copyright only covers features that are copied. Suppose a designer seeks to protect a GUI design with copyright. If a competitor then independently creates a GUI that looks almost identical in appearance but uses different codes, copyright does not apply. There is no copying of the original expression (i.e. codes), only the idea – which copyright does not protect. Copyright fails, but the market confusion is real. As virtual designs often compete on overall impression rather than exact replication, design law fills these gaps by focusing on product appearance instead.

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:

Each IP right serves distinct functions and adopts different legal tests: copyright protects the original expression of ideas, patents safeguard technical inventions with industrial applicability, trade marks identify the commercial origin of goods and services, while registered design rights secure the visual appearance of a product. Overlap occurs only where a product embodies multiple protectable attributes.

That said, such overlap might lead to rights inflation as creators stack multiple IP rights for the same virtual asset, using whichever cause of action that offers the most favourable remedies or procedural leverage. This may chill competition, escalate costs for start-ups, and clutter the official registers with overlapping rights.

Similarly, such overlap could lead to confusion over whether certain exceptions apply. For instance, the proposed copyright "text and data mining (TDM) exception" permits the utilisation of copyrighted works for computational analysis using AI without seeking permission or licenses from copyright owners. If such an exception is implemented under copyright, will the exception implicitly permit the analysis of registered virtual designs? If not, designers might use design law to contract around or block TDM uses that copyright would otherwise allow.

In virtual environments, design-like elements—avatars, skins, shapes—often function as brand identifiers. Registering such elements as virtual designs could overlap with trade mark protection (where the sign serves as a source indicator). This could blur distinct legal tests (likelihood of confusion vs. similarity of features judged by the eye) and complicate enforcement efforts.

However, as a matter of principle, if a product does embody the various attributes warranting different IP rights protection, it aptly deserves all these proprietary recognitions. Layers of protection not only better incentivize innovation and creativity, they also accommodate the growing complexity of modern technology products.

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:

We recommend removing the "made and sold separately" requirement as this is too restrictive and fails to fit with current market circumstances. Hong Kong should modernize the RDO to align with the global mainstream approach, such as in Mainland China, the EU, UK, and Singapore where component and spare parts are protected without such requirement.

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:

The "must fit" exclusion is preferable.

The fundamental difference between "must match" and "must fit" lies in aesthetics vs function. The "must match" exclusion concerns aesthetic coherence – features required for a product to visually match another. The "must fit" exclusion concerns mechanical interconnection – features required for a product to physically connect with another.

Registered design law exists to protect the visual appearance of products. Under this notion, designers should be able to protect aesthetic or decorative features of spare parts that form part of their stylistic value. The "must match" exclusion rests on the untested assumption that spare parts are purchased solely for repairing the original product, which is not always the case. This restriction unduly prevents designers from protecting the aesthetic identity of their products and thus should be retired. Concerns regarding consumer rights in repair scenarios should be addressed through a "right to repair" framework, rather than sacrificing design protection.

On the other hand, the purpose of the "must fit" exclusion is to avoid design monopolies mainly over purely functional components and to ensure compatibility and interoperability between products from different manufacturers. This is consistent with the aim of registered design law and is thus preferable.

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:

Yes. A "right to repair" defence ensures replacement parts that restore the original appearance of a product can be freely produced, without undermining design rights for other uses. It protects consumers rights and avoids undercutting valid design protections.

Introducing a "right to repair" helps to better balance between protecting genuine design investment and preserving competitive repair markets.

The repair and aftermarket industry is vital for consumer affordability.

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:

Yes *(but not in their own right and must specify the article or product to which the partial design is applied)*.

Given our Answers to 3.19(b)(i) – (iii) in support of removing the "made and sold separately" requirement, changing from "must match" to "must fit" and enacting a right to repair defence, we also agree that registered design should cover partial designs subject to two remarks.

- First remark, the current definition for "article" under the RDO indeed includes "any part of an article" and hence, removal of the "made and sold separately" condition and the "must match" exclusion may liberalize all sorts of partial designs (covering parts of a product, spare parts, or components) that can be protected by registration. This may risk creating ambiguity—what constitutes a "part" or "portion"? Without strict boundaries, disputes over scope and infringement would increase, creating uncertainty for consumers, businesses, and courts.

  Modern products often contain numerous visible components. If all sorts of partial designs were registrable, manufacturers could claim rights over countless small features, leading to a proliferation of overlapping design rights. This might also enable dominant manufacturers to monopolize minor aesthetic elements, which is anti-competitive.

- Second remark, we emphasize that a partial design must specify the article (or product) to which it is applied to qualify for registration. This specification requirement that a registered design must relate to an identifiable article (or product) follows Hong Kong's current rule as applied to accepting GUI or icons for design registration. It provides objective and sufficient clarity for a third party to understand the nature and use of the rights and avoids ambiguity.

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:

Yes. The novelty requirement under the RDO works well, with applicable legal principles clearly laid out under Hong Kong court case authority. Hence, we see no need for change.

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:

No. As the current novelty requirement under the RDO works well, we see no need for Hong Kong to move beyond requiring only novelty by additionally imposing a higher threshold of "individual character" or "distinctive" requirements (like the EU, the UK or Australia). To avoid obvious or run-of-the mill designs cluttering up the official register, the RDO now empowers the Hong Kong Registrar of Designs to reject a design which on the face of it is not new or is not registrable for any other reason.

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:

NA

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:

Yes. The current formality-only approach should be retained for speed and cost-effectiveness, which is particularly crucial for accessibility by SMEs and start-ups. It should also be noted that design registration has historically been underutilised in Hong Kong. Such underuse may be due to creators feeling hesitant due to cost concerns or opting for copyright protection instead, as it automatically arises upon fixation and does not require novelty. A prolonged substantive examination procedure would further discourage registration attempts.

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:

No. Introducing enhancement measures would complicate the regime unnecessarily. Hong Kong's current system grants enforceable rights upon registration after a formalities check. This is particularly favourable to SMEs and start-ups that rely on quick, affordable protection to bring products to the market confidently. Delayed enforceability would undermine this advantage and create uncertainty for businesses operating in fast-moving sectors, as it would leave the enforceability of a registered design right unclear.

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:

No. The current scope is set out with physical industrial designs in mind. However, as the forms of design become increasingly diverse, so too are the methods of infringement. Modern markets often involve digital renderings, virtual prototypes, or online product simulations, which can allow copying to occur before any manufacturing, sale or import. Consideration should be given to how the scope of protection should therefore be expanded to reflect these emerging digital realities, particularly if the design protections will be broadened to cover virtual designs.

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:

No. To open up the scope of exclusive rights to cover any business/commercial use of a registered design could unfairly and inappropriately tip the balance in favour of the designers.

The above said, expansion of the scope of protection could be considered and as a further alternative, see our Answer to 5.14(a)(iii) below.

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:

We support the current approach to limit protection of a registered design to the article (or product) in respect of which the design is registered.

An unrestricted extension to "any article in which the design is used" risks creating an excessively wide monopoly. Registered design owners enjoy exclusive rights without needing to prove copying. Extending protection to any article could allow owners to assert rights far beyond what was contemplated at registration, potentially capturing markets they never intended to enter. A blanket right thus risks extending exclusivity beyond what is reasonable, ultimately discouraging legitimate and independent design activities.

Thinking aloud – a limited expansion of the scope of protection: Further and/or in the alternative, consideration may be given for a more modest extension which comes in 3 aspects:

1. Protection extended to "closely related articles"
   Design rights can apply across product categories that share (1) functional or aesthetic similarity, (2) market substitutability or (3) consumer perception as belonging to the same "design family".

2. Protection extended to identical designs regardless of the specific article
   Where the infringing design is identical to the registered design, protection should then be extended to cover any article.

3. Protection extended to digital and virtual forms
   It should be specified that protection is extended to digital or virtual embodiments of the same design. For instance, a CAD file enabling the reproduction of a chair infringes its registered design rights.

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:

The existing exceptions are mostly adequate. However, if and in so far rights are extended, consideration could also be given for additional necessary exceptions such as the "comment, critique parody" exception. Modern commentary on products (e.g. unboxing, reviews, critiques, comparisons) frequently involves showing the appearance of a design. Introducing such public-interest exception facilitates dialogue and prevents suppression of criticism. Additionally, it mirrors protections already widely accepted in copyright law. If such exception is applicable to creative works, there is strong fairness argument to extend analogous protections to designs.

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:

Yes. Default ownership should vest in the designer, with freedom to contract otherwise. This aligns with copyright defaults and hence reduces confusion in mixed IP projects. It also incentivizes creators and clarifies bargaining positions.

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:

Yes. The grace period currently provides limited protection for disclosures made under certain prescribed conditions (i.e. at an official international exhibition). However, this is overly restrictive given the realities of modern design commercialisation. Today, designers routinely disclose their works in diverse contexts—online postings, product teasers, market testing, investor pitches, crowdfunding campaigns, and digital presentations. Limiting the grace period to a narrow set of circumstances creates unreasonable risks for designers, especially SMEs and independent creators.

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:

Yes. A 12-months window aligns with the Riyadh Design Law Treaty (RDLT) baseline and mainstream practices, which would improve international consistency for Hong Kong designers.

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:

If design owners can freely disclose designs before filing without losing novelty, businesses may find it difficult to determine whether a design shown publicly is free to use or whether they may be at risk of infringing a design that is not yet filed. As design rights do not require proof of copying, even an innocent competitor who relied on the public disclosure may later face liability once a registration is obtained.

We agree with the Consultation paper stating that the statutory "prior use defence" (section 35 of the RDO) and the "innocence defence" (section 51 of the RDO) can address such risk to some extent.

6.18(b)(i)

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

Answer:

Yes. A deferment mechanism would allow designers to secure a filing date (thus preserving novelty and priority) while maintaining confidentiality until they are commercially ready (e.g. for staged rollouts). Besides, foreign jurisdictions may treat early disclosures differently. Designers may lose overseas protection if their design is published in Hong Kong before they are ready to file internationally. Allowing applicants to defer design publication avoids jeopardizing their global rights (which could also cover patent rights).

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:

12 months. This balances flexibility with market certainty and meets the minimum 6 months deferment provided by RDLT.

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:

The deferment of publication may translate to hidden rights risk for innocent third parties as they cannot know that a registered design exists or is pending. They may unknowingly develop or market similar products, and risk suddenly falling into infringement since design protection does not depend on the infringer's knowledge (albeit the innocent infringer is not liable for damages) or proof of copying.

To mitigate this uncertainty, it is suggested that basic data should be published for deferred cases. Such information could include the applicant's name, applicant's address, applicant's resident/ incorporation jurisdiction, the filing date, the design title, classification, and statement of novelty.

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:

Yes. This requirement imposes unnecessary administrative burdens on both the applicants and the Designs Registry. Besides, foreign applicants filing in Hong Kong under the Paris Convention may face friction if their home registry is slow in issuing priority documents.

Dispensing with the requirement does not mean abandoning verification. Instead, the Registry can obtain electronic verification directly, or request documents only when needed, such as in dispute scenarios or where examination reveals inconsistencies.

It also appears as the global trend not to require submission of priority documents.

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:

Yes. Without restoration, missing the 6-month window would strip the applicant of the earlier filing date, which could cause irrevocable commercial damage. Given that the design industry is fast-moving and globally interconnected, rigid priority rules can create unfairly harsh results.

However, to balance fairness and legal certainty, restoration should only be permitted under clearly defined conditions. First, the applicant must show that all reasonable steps to observe the deadline have been taken ("due care standard"). Second, to avoid prolonged uncertainty, restoration requests must be made within 1 month (aligning the RDLT minimum) after the missed 6-month deadline. Third, applicants should be required to pay an additional fee so as to discourage careless filings and to compensate for the additional examination burden.

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:

Yes. The current same-class or same-set-of-articles requirements work neatly and well.

Some may contend that modern product ecosystems often span across categories. For instance, a smartphone, its protective case and charger can relate to commercially unified designs often created by a single design team using a coherent design language. Hence, it may be argued that one multi-design application covering different articles (whether or not forming a set) and spanning different classes should be allowed. This might serve the applicant's convenience but it could add extra effort, time and costs burden to a third party (e.g. industry stakeholders) who needs to run a search for only a certain type of article (or product) in a certain class.

To maintain the current same class / same set of articles grouping does not deprive the applicant who wishes to protect the same design when applied to different articles (or products) possibly belonging to different classes as the applicant can always file more than one design application (though some more filing fees should be paid).

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:

No, it should be made optional. An applicant for design registration should have an option to include 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. Thus, this optional novelty statement will likely move beyond Hong Kong's current stereotype – which is confined to shape, configuration, pattern, and / or ornament.

The novelty statement can be very useful to help defining the scope of novelty claimed in the event of enforcement. Hence it would be good to give an option to those serious filers to delineate the scope of the design.

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:

Yes. The current term of protection is appropriate as it accommodates different product lifecycles and encourage non-valuable designs to lapse (via the 5-year interval renewal procedures).

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.

Clear identification of applicant should be required, which is not just a formality requirement but a substantive one. To mandate for not only the full name but also the jurisdiction of residence / incorporation and registered office address (if applicable) of the applicant be stated in a design application ensures transparency and legal certainty. The same requirements should apply to assignee, mortgagee, and licensee when an application to record a registrable transaction concerning a design and to contesting parties (like opponents) in a dispute involving a design.

Hong Kong trade mark law was amended in 2020 to mandate applicants to provide specific information about their legal identity at the time of filing. Likewise, such requirements should be mandated for designs (and patents) in Hong Kong.

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:

Yes. The current system prevents copyright from being used to secure an excessively long monopoly over design products, without forcing designers to choose early on either to rely on design registration or copyright (unlike the Australian or Singapore carve out approach).

We suggest going one step further - there should not be a prejudicial and discriminatory treatment under section 87 of CO to artistic work that has no registered corresponding design by reducing the term of protection to 15 years as opposed to 25 years from the end of the calendar year in which articles incorporating the design was first published. Indeed, the parallel provision in the UK, that is, section 52 of the UK Copyright, Designs and Patents Act (this was repealed but purely done by the UK Government on a perceived need to achieve consistency with EU law), the protection afforded to industrially exploited artistic work was a uniform period of 25 years. It appears that the distinction was introduced in section 87 was purely made by the Government to hopefully boost registered design filings. With the Government strongly advocating the promotion of HK as an IP Trading Hub and the creation of an IP economy, it is time, not only for section 87 to be maintained, but also for the distinction between artistic work with or without a registered corresponding design such that the term in both cases should be 25 years.

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.

No.

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:

No (save as indicated in 8.18(b)(ii) below with regard to short lived, unregistered or unregistrable designs not otherwise protected by copyright).

8.18(b)(ii)

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

Answer:

Benefits

Currently, Hong Kong requires formal registration for design protection, and any public disclosure before filing destroys novelty. This model poses a challenge for designers as design owners often market or showcase their products before filing. Also, designers may often not be able to rely on an original drawing, sculpture or other artistic work to qualify for copyright protection.

Introducing an unregistered design rights ("UDRs") regime would give creators instant protection, without costs or formalities, which is critical for small businesses that lack resources to register every design. UDRs are particularly useful for fashion, consumer goods or digital design industries, which produce short-life-cycle designs.

UDRs also fill a gap in copyright protection because to subsist they only need be recorded in a "design document" (broadly defined any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise), or simply embodied in an article even without a design document. The artificiality, and often practical difficulty, of having to rely on an original drawing to protect a design which is not an artistic work using copyright would be removed.

Moreover, "innocent infringers" of UDRs would have the same protection as for copyright law, with the narrower requirement that the design is copied (not merely that the work or a substantial part is copied) and knowledge or reason to believe that UDR exists or that an article is infringing to claim damages and to establish liability for secondary infringers.

Drawbacks

While it is easier for businesses to protect their designs, UDRs (as with copyright) could also make it much easier for businesses to infringe these rights as no public record exists. While this creates risks and compliance costs for manufacturers, importers and retailers, the same applies to the existing copyright regime and is offset by the requirement for knowledge and proof of copying.

The UDRs regime might risk undermining the incentive to register designs. If UDRs are introduced, some designers may rely entirely on UDRs instead of formal registration due to cost concerns. The quality and completeness of Hong Kong's registered designs database may diminish.

If Hong Kong allows a 12 months grace period (see our Answer to 6.18(a)(i) above), this could alleviate to some extent the challenge for designers who need to showcase or market their designs before filing for registration.

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:

Considering both the benefits and drawbacks in the answer to question 8.18(b)(ii), we suggest that the government carefully consider the matter and balance the convenience to designers against the risks faced by manufacturers, importers and exporters who may be totally unaware that someone has a UDR without any means to check UDRs against public records.

If it is considered that URD should be introduced, there must be provision to protect those who are genuinely unaware of the existence that someone has URD.

If URD is to be introduced, an open qualification criteria (as for copyright) would afford an attractive protection for both domestic and foreign designers.

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?

Yes. Mainland China, the EU, the UK, USA, Korea, Japan, and Australia.

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. Not at present when not just a few substantial changes to the registered design regime are contemplated and if all adopted, the implementation will take time and efforts for businesses, consumers and other stakeholders concerned to get familiarized with all the changes.

Hong Kong's priority should be focussing on whether and how to make all these substantial changes to the current registered design regime. The question of whether we apply the Hague Agreement to Hong Kong can be re-visited at a later time.

OTHER – Unjustified Threats Provisions

When amending the Registered Designs Ordinance consideration may be given to the existing Section 57. Remedy for groundless threats of infringement proceedings ("Threats Actions"). For historical reasons, Hong Kong has an inconsistent approach across different IP rights to Threats Actions and their limitations.

Under the RDO, no Threats Actions may be brought where the alleged infringement is the making of an article for sale or hire or the importing of anything.

Under the Patents Ordinance no Threats Actions may be brought where the threatened alleged infringement is the making a product for putting on the market or of using a process. In the case of short-term patents there is a further requirement to have a certificate of substantive examination or to have complied with any "access request for patent information" made by the person threatened

Under the Trade Marks Ordinance, no Threats Actions may be brought where the alleged infringement is the application of the trade mark to goods or their packaging, or the supply of services under the trade mark, or in any case where an action for infringement is brought within 28 days. Acting barristers and solicitors are further exempt from liability

Under the Copyright Ordinance, Threats Actions are limited to cases concerning parallel imports and include the same exemption for barristers and solicitors.

In the UK, the law relating to Threats Actions has been harmonised and clarified under the Intellectual Property (Unjustified Threats) Act 2017. The Government is urged to undertake a similar exercise in Hong Kong.

CONCLUSION

The Hong Kong Government's consultation is both timely and necessary. By adopting the reforms outlined above, which are better fitting to modern technology and more aligned with international trends, Hong Kong can modernize its registered designs regime. This will provide a robust, clear, and efficient system that protects innovation in both the physical and digital worlds, supports local creators, and reinforces Hong Kong's status as a regional intellectual property trading hub. We urge the Government to proceed decisively with these reforms.

We are available to respond to any questions on our submissions. We would also appreciate continuing dialogue for further discussion.