REVIEW OF THE HONG KONG REGISTERED DESIGNS REGIME

PUBLIC CONSULTATION

Response of The Hong Kong Bar Association

1. Reference is made to the public consultation paper entitled "Review of the Hong Kong Registered Designs Regime" ("**the Consultation Paper**") published by the Government.

2. The Committee on Intellectual Property of the Hong Kong Bar Association supports the review of the Registered Designs Ordinance to ensure that Hong Kong's registered designs regime remains fit for purpose in light of the many changes which have impacted upon and continue to shape the needs of the trade and industry in the rapidly evolving global economy.

3. We set out below our views on the specific issues raised in the Consultation Paper. Unless otherwise stated, all references to numbered paragraphs below are to those in the Consultation Paper and the abbreviations therein have been adopted.

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

4. Our views on the issues in paragraph **2.18** are set out in *italics* below:

(a) Definition of "design"

(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.

We agree. Defining "design" by reference to "the appearance of a product" is indeed closer and more intuitive to the common conception

of a design, and will be more in line with the definitions adopted in other common law jurisdictions (e.g. the UK and Australia). It will enlarge the registered designs regime to cover not just features of "shape", "configuration", "pattern" and "ornament", but also "lines and contours", "colours" and "texture".

(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.

We agree. The present requirement of "by an industrial process" is too restrictive to accommodate the emerging technologies (for example 3D printing). There is no longer any justifiable reason why a design which is not applied to an article by an industrial process should be excluded from protection under the registered designs regime. Further, the removal of this requirement will also make protection under the registered designs regime more in line with that of the EU and other common law jurisdictions (such as the UK, Australia and Singapore).

(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 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.

We are of the view that examples of other features should be given whilst expressly stating that such examples are not intended to be exhaustive. This will make it easier to understand the legislative intent

behind the proposed amendments. Such examples of design features should include "lines", "contours", "colours", "texture", "materials" and "movement, transition or any other sort of animation of those features"[1].

(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.

Yes, providing a non-exhaustive list of design features with specified examples will make it easier for the public to understand what is intended to be protected under the registered designs regime.

(b) Definition of and reference to "article"

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

We do not have strong views on this, but in the light of the position adopted in the Chinese Mainland, the EU and other common law jurisdictions (such as the UK and Australia) which all make reference to "product" instead of "article", it may be preferable to adopt the same terminology.

(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.

[1] This will cover designs which incorporate animation and movement. For reference, see the practice in the UKIPO:- https://www.gov.uk/government/publications/designs-practice-notice-dpn-0126-practice-in-respect-of-graphic-symbolsicons-graphicalweb-user-interfaces-and-animated-designs/designs-practice-notice-dpn-0126-practice-in-respect-of-graphic-symbolsicons-graphicalweb-user-interfaces-and-animated-designs.

We do not see any good reason why the protection under the registered designs regime should not be extended to cover handicraft or handmade items as well. As we stated in our answer to (a)(i) above, the present requirement of "by an industrial process" is too restrictive.

Chapter 3: Scope of Design Protection

5. Our views on the issues in paragraph **3.19** are set out in *italics* below:

(a) Virtual designs

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

(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.

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

Only virtual designs which are correlated to a physical product should be protected under the registered designs regime as the fundamental principle of the registered designs regime has always been to confer protection on a design applied to an article of manufacture. The article to which the design is applied must be a manufactured, physical object, not just a pure conceptual design. Any designs of a non-physical nature should instead be protected under copyright law which is more suited

to the protection of such designs and has traditionally been applied and used for such purpose.

(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.

It is unclear whether it will give rise to uncertainty or unintended legal consequences as we are not aware of any case law from jurisdictions which have extended protection to virtual designs which suggests such uncertainty or unintended legal consequences.

(b) Design of spare parts and parts of articles

(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.

We are of the view that given the growing sophistication in modern design and the consumer market as well as the move away from protection being afforded to a part of an article only if it is "made and sold separately", consideration should be given to protecting a component part of a "complex product" but subject to limitations such as those now provided for under the UKRDA 1949, i.e. component parts of complex products should be protected only if such component part remains visible during use of the complex product of which it forms part and if its visible parts have the required features of novelty and individual character.

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

We consider that the "must fit" exclusion is preferable. The "must fit" exclusion is more specific to avoid protection of the design of mechanical fittings which may hinder interoperability of products of different makes. However, if the "must match" exclusion is to be removed, a limited defence of right to repair should be introduced as in Australia, the EU and the UK.

(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.

We agree. See the answer above.

(c) Partial designs

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.

We are of the view 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, because this is the global trend.

Chapter 4: Requirement of Novelty for Designs and Examination of Novelty

6. Our views on the issues in paragraph **4.19** are set out in *italics* below:

(a) Novelty requirement

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

We are not in a position to comment because we are not familiar with the needs of the design industry. Having said that, it is preferrable to have a requirement in addition to novelty: see our answer to question (ii) below.

(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.

We agree as a matter of principle to introduce an additional registrability requirement to improve the quality of the designs to be protected under the registered designs regime. However, given the different approaches adopted in different jurisdictions, careful consideration as to which additional registrability requirement should be adopted, taking into account any problems or issues which have been experienced in the jurisdictions which have introduced additional registrability requirements.

(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.

Instead of laying down the approach and the factors for assessment of difference in overall impression by local legislation, we consider that it is preferable to leave it to development by case law.

(b) Examination of novelty

(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.

We agree that the current formality examination procedure should be retained. Whether a substantive examination mechanism should be introduced depends on a number of factors, including (i) whether there will be sufficient resources to carry out the substantive examination; and (ii) whether the increased costs and time will deter entities from applying to register their designs. Pending further information and a more comprehensive review, the present procedure should be retained.

(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.

In Hong Kong, it is impracticable to impose further burden on the IPD. There seems to be no evidence of abuse of the existing system and we consider that there is sufficient protection against abuse provided by the remedy against groundless threats under section 57 of the RDO. Therefore, it may not be justifiable and necessary to consider introducing the enhancement measures adopted by overseas jurisdictions as discussed in paragraphs 4.15 and 4.16.

Chapter 5: Exclusive Rights of Registered Designs

7. Our views on the issues in paragraph **5.14** are set out in *italics* below:

(a) Exclusive rights

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

(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.

Whilst there appears not to be any general concern in Hong Kong that the current scope of exclusive rights provided for registered designs under the RDO is inadequate, we have no objection to expanding the exclusive rights to include "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" as suggested in paragraph 5.5(b).

We are of the view that the position adopted in the EU and the UK of expanding the exclusive rights to "right to use the design" as set out under paragraph 5.5(a) may potentially be too broad.

(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.

We consider it justifiable for protection of a registered design to be limited to the article in respect of which the design is registered because this has always been the position under the RDO in Hong Kong and was the position under the UKRDA 1949 until amendments were made thereto in 2001 to harmonise the UK registered designs regime with the EU registered designs regime. The limitation of protection of a registered design to the article in respect of which the design is registered does not appear to have given rise to any uncertainty or controversy as there does not appear to be any case law on the requirement in Hong Kong and there was also little case law in the UK before the UKRDA 1949 was amended in 2001. We note also that the limitation of protection of a registered design to the article in respect of which the design is registered remains under the registered designs regimes in Australia and Singapore.

Conversely, we have not been able to find the considerations and reasons behind the EU's and the UK's extension of protection to articles other than the article in respect of which the design is registered. In the 1991 European Commission Green Paper on The Legal Protection of Industrial Design, the proposed draft Article 18 already did not provide for any limitation of protection of a registered design to the article in respect of which the design is registered. However, there was no discussion of or reasons given for the adoption of this position in the Green Paper. The Green Paper eventually led to the EU's Directive 98/71/EC of 31 October 1998 upon which the 2001 amendments to the UKRDA were based. Since the 2001 amendments were to harmonise UK law with EU law, there does not appear to have been any extensive consultation undertaken before the amendments. In the short speech of Lord Sainsbury (speaking as the Parliamentary Under-Secretary for Science and Innovation) in the House of Lords

moving that the Registered Designs Regulations 2001 be adopted, he described the change to the scope of protection as being significant, pointing out that "This makes little difference when the design is the product itself but makes protection much simpler for designers of ornamentation—a floral pattern perhaps—which can be applied to many different types of product." [2]

We do not consider that making protection much simpler for certain designs such as designs of ornamentation, justifies the radical departure from the long-standing position under the RDO. As a registered design confers on its registered owner a statutory monopoly which can be breached by a third party even in the absence of copying, the current position (provided under section 11 of the RDO) of allowing the registered owner of a design to extend the scope of protection of his registered design to other articles by filing further applications for registration of the registered design or of the registered design with modifications or variations not sufficient to alter the character or substantially affect the identity thereof in respect of such other articles appears to be more justifiable than simply extending the scope of protection of a registered design to articles other than that in respect of which the design is registered. Further, given that registered designs are classified by reference to product categories, extending protection of a registered design beyond the article in respect of which it is registered may impose an extremely heavy burden on a business seeking to search the register in order to ensure that its proposed product does not infringe a registered design.

(iv) Do you agree that the existing statutory exceptions under the RDO adequately strike a fair balance in addressing the reasonable uses of

[2] HANSARD, Vol.627, 25 October 2001,

designs by members of the public? If not, please explain and elaborate what specific exception(s) ought to be introduced.

We do not object to the addition of the exceptions set out under paragraph 5.9.

In principle, insofar as applicable, the exceptions for infringement provided under the Copyright Ordinance (Cap. 528) should also be considered for inclusion as exceptions or defences under the RDO.

(b) Ownership

(i) 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.

We are of the view that the regime under the Copyright Ordinance (Cap. 528) is a sensible one which can be followed.

Chapter 6: Facilitation Measures for Application for Registration of Designs

8. Our views on the issues in paragraph 6.18 are set out in *italics* below:

(a) Grace period

(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.

We agree. The relaxation will enable designers and creators to test the product on open market. Having said that, some members have

expressed concerns that such grace period for "any purpose" is too broad and uncertain.

(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.

We are not in a position to comment on this question. The duration of the grace period should reflect the needs of the design industry.

(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.

We are not in a position to comment on this question.

(b) Deferment of publication of designs

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

In principle, we have no strong objection to the introduction of an option for applicants to defer publication of their designs, subject to there being put in place provisions to protect innocent infringers, which should be more extensive than is currently provided for. We are of the view that the "innocence defence" should be a complete defence prior to the date of publication, not only covering recovery of damages. For example, the applicant should not be allowed to seek an injunction or an account of profits during the deferment period.

(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.

We are not in a position to comment on this question.

(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.

We are not in a position to comment on this question.

Chapter 7: Application and Registration Formalities

9. Our views on the issues in paragraph **7.15** are set out in *italics* below:

(a) Priority claims in applications

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

No. We consider that it is unnecessary to dispense with the requirement to file with the Registry the earlier application and a copy of the official certificate in support of a priority claim as the applicant should already be in possession of such documents so it would not be difficult for the applicant to submit them.

(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.

Yes. We consider that applicants should be permitted to restore their right of priority after expiry of the priority claim period, subject to the same conditions stated under article 16(2) of the RDLT and Rules 12(4) and 12(5) of the RDLT Regulations, namely:

(1) the time limit to make such a request to expire not less than 1 month from the date on which the priority period expired;

(2) the request states the reasons for the failure to file within the 6-month priority claim period; and

(3) the failure to file in time occurred in spite of the applicant having taken due care as required by the circumstances or was unintentional.

(b) Applications for multiple designs

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.

We are not in a position to comment on this question.

(c) Mandatory requirement of application on statement of novelty

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.

We note that the Consultation Paper did not suggest any reason for dispensing with the requirement. It is not immediately clear to us why the requirement should be dispensed with. We consider that the retention of the requirement for a statement of novelty would be helpful to members of the public to ascertain the scope of protection claimed for the design and would not be an onerous burden for the applicant to satisfy.

(d) Design registration term and renewal of registration

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.

We agree. We note that the Consultation Paper has not suggested any reason for reducing the term of protection, and the statistics for renewals of registered designs in Hong Kong under Table 6 suggest that a significant number of owners choose to renew up to the maximum term. Thus, we consider that the status quo of a maximum term of protection of 25-years at 5-year intervals of renewal should be maintained.

(e) Other formality issues

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.

We are not in a position to comment on this question.

Chapter 8: Interplay between Registered Design Rights and Other IP Rights

10. Our views on the issues in paragraph **8.18** are set out in *italics* below:

(a) Overlapping protection of registered design rights and copyright

(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.

We are not aware of and do not see any issues arising from the current statutory arrangements.

(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.

We are not in a position to comment on this question.

(b) Unregistered design rights

(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.

We are not aware of any significant gap in practice.

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

In view of our answer to (ii) above, we do not consider it necessary to introduce an unregistered designs regime in Hong Kong.

(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?

See our answers to (i) and (ii) above.

Chapter 9: Alignment with the International Design Systems

11. Our views on the issues in paragraph **9.9** are set out in *italics* below:

(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?

We are not in a position to comment on this question.

(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.

We agree that it would be beneficial to those in the design industry.

12. We are grateful for your consideration.

Committee on Intellectual Property
Hong Kong Bar Association

Dated: 5 June 2026