



Hong Kong

Registered Design Application

**Hong Kong Trademark & Design
Protection Agency Ltd.**

Introduction

Registered design protects only the shape, visual appearance or ornamental characteristics of a new design. Protection does not extend to any functional features, which are within the reign of technical patent for invention. Nor does it cover any internal part not visible during normal use of the designed article or the interconnection between parts.

In order to obtain a valid registration, the design must also be novel, possess individual character and must be industrially applied to manufacture articles. The validity of a design can be easily challenged if its novel features are not startling, or it is largely a commonplace design, or a mere variation in craft of its trade.

New design must be kept confidential and should only be disclosed to others (eg. prototype manufacturer) under a contract containing a confidentiality clause. A new design will lose its novelty if it has been published or exposed to the public prior to the filing of its application.

Timing of application should be planned. The application should neither be made too early that some details of the design are subsequently revised or improved upon, nor too late as to be after the marketing of the designed articles.

Upon filing, the design can start to be marketed. However, after such exposure to the public or after the publication of any of the design applications, most further filing in additional foreign countries must be made within 6 months of the first application's filing date with a claim for Paris Convention or WTO priority, and requiring additional fees in both Hong Kong and the foreign countries. The alternative is to organize the applications to be filed on the same date.

The protection given by registered design is a monopoly right that is stronger than copyright. The protection extends against both deliberate copying and independent development of a closely similar design. However, this stronger right come at a price of the higher requirement of novelty, which is challengeable even after registration and the issuance of the certificate.



Benefits of Registered Design

- Registered design certificate is the best document for showing that you have claimed the design.
- Registered design certificate is the most acceptable title document for making complaint to the Legal Adviser of TDC Fairs about infringement by another exhibitor.
- Showing registered design certificate can be a sale technique for making potential customers trust your designed products.
- Registration enables lawful use of the notation "*Reg*", "*Design Registered*", or "*Registered Design No. ...*" on the product and its packaging.
- There is no need to prove knowledge when using registered design against distributors or retailers.
- Registered design gives you additional rights over and above the copyright of your design.
- Registration enhances the proof of copyright over your design.
- Registered design is a corporate asset which is essential when valuing your company in M&A or IPO situations.
- Registration in an important city and trading centre like Hong Kong is helpful for export or global marketing plans.

Fees

The fee is **HK\$3,200** for 1 article.

The fee is **all-inclusive**. Neither the Registry nor us charge any fee on registration and issuance of the design certificate. Nor do we charge any miscellaneous disbursement.

If there is more than 1 article (eg. a series of watches), each additional article is only HK\$2,400 all-inclusive.



Timeframe

The average time for application to registration is 2 months :-

Filing receipt and filing number	1 week
Formality examination	2 - 5 weeks
Publication, registration and issuance of design certificate	2 weeks

The examiner will only perform a "formality" examination, and he or she usually will not make any search for prior registered designs in Hong Kong. Hence, the registration and issuance of design certificate is not in anyway a confirmation on the question of novelty.

Upon registration, a Hong Kong registered design is initially valid for **5 years** and is renewable for 4 periods of 5 years each up to the maximum protection of 25 years.





Design Search

Anyone from anywhere can use the free online search website

<http://ipsearch.ipd.gov.hk>

of the Intellectual Property Department of Hong Kong Government to find out whether any similar registered design exists in the register.

Since the the definition of novelty is broad and the examination practice does not involve comparison with prior registered designs, pre-application search is neither useful nor relevant.

Search of prior registered designs in the Hong Kong are usually for other purposes, such as ascertaining whether the competitors or opposite party of the client has registered a similar design in Hong Kong.



Convention Priority

Within six months of the first filing of the design in a WTO member country or Paris Convention country, a priority can be claimed in the Hong Kong application. This will synchronize the Hong Kong filing date with that of the first filing for the purpose of determining the novelty of the design.

The practical result is that any disclosure of the design or marketing of the designed product after the first filing but within six months of that first filing does not jeopardize the Hong Kong design application.

Representation of Design

The most important disclosure of the design applied for rests with its representation, which consists of either drawings and/or photographs.

Drawings and/or photographs should be :

- (a) 7 Views - front, rear, left, right, top, bottom, and 3-dimensional front perspective.
- (b) There is no limitation on the number of photographs or drawings for inclusion in the application. The pertinent consideration is how to use the photographs or drawings to fully display and disclose the novel parts and features of the design. When registered, the submitted photographs or drawings will be attached to the back of the design certificate.
- (c) Any aesthetic "interior" of the designed article visible during normal use of the article, should also be photographed or drawn for inclusion in the application. Sectional view which clearly brings out the design is permissible, but sectional view showing functional features or interior structure not being part of the aesthetic design is usually not allowed.
- (d) For drawings, surface shading or texturing can be used to bring out the contour and the shape of the design.

Details Required

1. Full name and address of the applicant.
2. If the applicant is not the designer, a statement as to the applicant's ownership of the design. For examples : "Employer of designer"; "By Assignment"; or "By Commissioning the design".
3. Name of the designed article in English and Chinese.
4. Representation of the design in the form of drawings or photographs (in jpg file format sent by e-mail to us).
5. Certified copy of the first design application within the last 6 months (if any filed in a Paris Convention country or WTO member country).



