

INTELLECTUAL PROPERTY IN HONG KONG

Fourth Edition

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Mainland Registrations to the plaintiff. By applying *British Telecommunications plc v One in A Million Ltd & Ors*,¹⁷⁰ the defendants were ordered to assign the website under the objected domain name to the plaintiff as it was considered to be an instrument of deception.

¹⁷⁰ *British Telecommunications plc v One in A Million Ltd & Ors* [1999] FSR 1, [1999] 1 WLR 903 (CA, Eng).

CHAPTER 2

Trade Marks

1. INTRODUCTION

[2-1]

The current Trade Marks Ordinance (Cap 559) ('the TMO') came into operation on 4 April 2003.¹ A number of amendments were made with effect from 19 June 2020.² The Ordinance is based closely on the United Kingdom Trade Marks Act 1994, which was enacted as part of the harmonisation process for the trade mark laws of European Union members.³

[2-2]

Trade mark law can be incredibly complex. The late Henry Carr J summed this up succinctly in one decision:

Unless familiar with the law of registered trade marks, you might think that it is relatively straightforward. Regrettably, you would be wrong. As illustrated by the recent judgment of Arnold J in *Sky Plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch), [2018] RPC 5, trade mark litigation can raise multiple legal issues of Byzantine complexity.⁴

Despite the complexity of trade mark law, the number of textbooks, as opposed to the literature serving this area, is not vast. This may be due in no small measure to the success of the classical trade mark work, *Kerly on Trade Marks*, which has virtually assumed the status of a handbook in Trade Marks Registry practice.⁵

- ¹ Commencement notice LN 31 of 2003. The new Trade Marks Rules (LN 30 of 2003) as amended by Legislative Council Resolution dated 3 April 2003 (LN 97 of 2003) also came into force on the same date. The text of the TMO and of the Trade Marks Rules (as amended by Legislative Council Resolution) can be found in the database of the Laws of Hong Kong at <http://www.justice.gov.hk>.
- ² Trade Marks (Amendment) Ordinance 2020. Certain provisions relating to the introduction of the Madrid Protocol in Hong Kong will only come into effect when the Madrid Protocol takes effect.
- ³ The Trade Marks Act 1994 is the governing legislation in the United Kingdom and came into force on 31 October 1994. A table of comparisons between the TMO and the UK Act appears in **Appendix 1**.
- ⁴ *Pathway IP SARL (formerly Regus No. 2 SARL) v Easygroup Ltd (formerly Easygroup IP Licensing Ltd)* [2018] EWHC 3608 (Ch) at para 1.
- ⁵ Other useful reference works are *The Trade Mark Handbook* by the Chartered Institute of Patent Agents and the Institute of Trade Mark Agents (Sweet and Maxwell) and *The Modern Law of Trade Marks* by Morcom, Roughton and St Quintin (5th edn, LexisNexis 2016).

[2-3] The objective of this chapter is to describe the most important features of Hong Kong trade mark law and, where useful, to draw comparisons with the law in the United Kingdom and other jurisdictions. It is impossible in a work of this size to give a comprehensive overview of the Hong Kong trade mark system, let alone fulfil the encyclopaedic function of *Kerly* or the *Handbook*.

2. GOVERNING LEGISLATION, INTERNATIONAL TREATIES AND CASE LAW

2.1 The registered trade mark system

[2-4] Trade mark law in Hong Kong until 4 April 2003 was governed by the old Trade Marks Ordinance (Cap 43) enacted in 1954. The old law is, for the most part, only of historical interest and this Division only deals with the new law and authorities under the new law except where provisions of the old law have been re-enacted in the new law and the authorities can be considered to still apply.

[2-5] Current Hong Kong trade mark law is made up of the TMO and the subsidiary legislation, the Trade Mark Rules (Cap 559A), which provide rules for the handling of registry matters. In addition, the Trade Marks Registry has issued on line a Work Manual to provide practical guidance on various issues that arise in the prosecution of trademark application. The Work Manual and circulars issued by the Registrar of Trade Marks are a convenient rule of thumb but are not rules of law⁶ and as commented by the Registrar himself sometimes may not be in line with modern practice.⁷ The Work Manual is available on the Intellectual Property Department's website at www.ipd.gov.hk.⁸ Decisions of the Trade Marks Registry are also published on the IPD's website. In the early 2020s, the Registry introduced a system of neutral citations. The citations have been backdated to the early 2000s. For decisions under the current Trade Marks Ordinance (Cap 559), the neutral citations adopt the form [Year] HKTMR X. For decisions under the old Trade Marks Ordinance (Chapter 43), the neutral citations adopt the form [Year] 43 HKTMR X. The same form of citation is used for all types of decisions, including registrability,

⁶ *El Du Pont De Nemours & Co v ST Dupont* [2003] EWCA Civ 1368, [2006] 1 WLR 2793, [2004] FSR 293; *Mattel Inc v De Luxe Manufacturing Ltd* [2004] 3 HKC 672, [2004] 3 HKLRD 399 (CFI) at paras 30–31, (aff'd by the Court of Appeal at *Mattel, Inc v De Luxe Manufacturing Ltd* [2006] 1 HKLRD 143, [2005] HKCU 980 (CA) at paras 6–8).

⁷ *Nanyang Brothers Tobacco Co Ltd v NV Sumatra Tobacco Trading Co* [2019] HKCU 4819, [2019] HKCFI 3115 at para 24.

⁸ 'Trade Marks Registry Work Manual' (Intellectual Property Department) http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm last accessed 17 September 2025.

oppositions and cancellation decisions.

[2-6] The principal international conventions governing trade mark law to which Hong Kong is a party are the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPS'). Hong Kong also applies the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks⁹ which creates 34 goods classes and 11 services classes into which goods and services are classified for registration purposes.

[2-7] The Madrid Protocol that provides for international application procedures for trade marks does not yet apply to Hong Kong but it is expected to apply from sometime in 2024. In June 2019, the Trade Marks (Amendment) Ordinance was passed by LegCo to allow for Madrid Protocol applications to be made in Hong Kong. The provisions of the Ordinance principally empower the Registrar of Trade Marks to make rules to implement the protocol.¹⁰ Under the Madrid Protocol, an application for a trade mark is first made in a 'home' trade mark office. The applicant can designate up to 119 countries for which it wishes to obtain registration. The application is then sent to the World Intellectual Property Organisation for examination and registration in the international register. The application will then be examined under domestic law of the designated states.¹¹ It should be noted that because the Madrid Protocol is an international agreement, it will not be applicable to mutual designations between the Mainland and Hong Kong (which are part of the same country).

[2-8] The TMO is modelled on the United Kingdom Trade Marks Act 1994, which was, as is set out in its long title, enacted to implement European Trade Mark directives. Thus, the decisions of United Kingdom courts and tribunals, although not binding, are of persuasive authority in its interpretation and unless the provisions of law are different are generally followed by Hong Kong courts and the Trade Marks Registry. Similarly, decisions of the Court of Justice of the European Union (CJEU) (formerly the European Court of Justice (ECJ)) and the European Intellectual Property Office (EUIPO) (formerly the Office of Harmonisation of the Internal Market (OHIM)) are often referred to and followed, by the courts and Trade Marks Registry. The reasons for Hong Kong courts relying on English decisions and European decisions (for all types of cases and not just trade mark cases) were explained by the Court of Final Appeal in *A Solicitor*

⁹ Trade Mark Rules (Cap 559A), s 5; see also [2-6].

¹⁰ Trade Marks (Amendment) Ordinance 2020, Pt XA.

¹¹ See further WIPO's guidance on making international applications at <https://www.wipo.int/madrid/en/> accessed 17 September 2025.

(24/07) v *Law Society of Hong Kong*.¹² With regard to English decisions, Chief Justice Li said at para 17:

Bearing in mind that historically, Hong Kong's legal system originated from the British legal system, decisions of the Privy Council and the House of Lords should of course be treated with great respect. Their persuasive effect would depend on all relevant circumstances, including in particular, the nature of the issue and the similarity of any relevant statutory or constitutional provision.

With regard to decisions of European courts, the Chief Justice said at para 16:

After 1 July 1997, in the new constitutional order, it is of the greatest importance that the courts in Hong Kong should continue to derive assistance from overseas jurisprudence. This includes the decisions of final appellate courts in various common law jurisdictions as well as decisions of above-national courts, such as the European Court of Human Rights. Compared to many common law jurisdictions, Hong Kong is a relatively small jurisdiction. It is of great benefit to the Hong Kong courts to examine comparative jurisprudence in seeking the appropriate solution for the problems which come before them.

Following Brexit, pre-departure decisions of the CJEU remain binding on the UK lower courts. The Court of Appeal and Supreme Court may depart from decisions of the CJEU but only on the same basis that the Supreme Court has power to depart from one of its own or House of Lords precedents.¹³ Decisions from other common law jurisdictions, in particular, Singapore, which has also enacted very similar provisions to the United Kingdom Trade Marks Act 1994 as part of its law, and Australia will also be referred to.

3. COURTS WITH JURISDICTION

[2-9]

All civil applications and proceedings before the court under the TMO must be brought before the Court of First Instance with appeals to the Court of Appeal (and with leave, to the Court of Final Appeal). Section 2(1) of the TMO defines 'Court' in the Ordinance as the 'Court of First Instance, except in Part XIA'. Part XIA is a new part that provides for investigation and prosecution by the Customs and Excise Department for breaches of criminal provisions in the TMO.¹⁴ Most prosecutions will be brought in the Magistrates Courts. All civil actions should be filed in the IP Specialist List of the High Court.¹⁵

[2-10]

In *Cheung Chi Wai t/a Chi Fung Engineering Co v Chi Fung Engineering*

¹² *A Solicitor (24/07) v Law Society of Hong Kong* [2008] 2 HKC 1, (2008) 11 HKCFAR 117, [2008] 2 HKLRD 576 (CFA).

¹³ See discussion in *TuneIn Inc v Warner Music UK Ltd & Anor* [2021] EWCA Civ 441, [2021] WLR(D) 183 at para 73 et seq.

¹⁴ Section 96A of the TMO defines 'Court' for the purposes of Pt XIA as 'a court of competent jurisdiction in the Hong Kong Special Administrative Region and includes a magistrate'.

¹⁵ See [10-2].

Ltd & Ors,¹⁶ District Court Judge Winnie Tsui (as she then was) held that the District Court did not have jurisdiction to hear a trade mark infringement claim on the basis of the definition of 'Court' in s 2 as well as the fact that the Rules of the District Court make no provision for handling trade mark case whereas the Rules of the High Court (Cap 4A), at O 100, do. Judge Tsui did note that one trade mark infringement case *Wu Shun Kwan v Lam Koon Wan*¹⁷ had been tried in the District Court in 2005. The case had in fact been transferred to the District Court from the High Court. There is no published decision of the reason for transfer. However, the acts of infringement alleged in that case occurred prior to the new Trade Marks Ordinance coming into force and the case was decided under the old Trade Marks Ordinance, which did not have a specific definition of 'Court'. The District Court would therefore have had jurisdiction to hear the matter.

[2-11]

In *Chi Wing and Law Oi Ying trading as Singapore Headway Medicine Co v Law Yan Wai trading as Singapore Medicine Co*,¹⁸ the plaintiff sued in the District Court for breach of an agreement to mutually consent to trade mark registration because the defendant filed an opposition to a trademark. The court granted an injunction, ordering the opposition to be withdrawn in party. No issue as to jurisdiction appears to have been raised by the parties. The District Court can be considered to have had jurisdiction on the basis that the parties were only seeking to enforce contractual rights rather than the provisions of the TMO.

4. CLASSIFICATION OF GOODS OR SERVICES

[2-12]

Trade marks are applied for and registered in a total of 45 classes made up of 34 goods classes and 11 services classes in accordance with the 'Nice Classification'¹⁹ applied by most trademark offices worldwide. The classes are intended to assist in classification of goods and services by grouping goods or services that are similar in the same class. For example, the class heading for class 25 is 'footwear, clothing and headgear' and covers most articles that fit within that description. However, not all clothing is classified in class 25. For example, protective helmets for sports are classified in class 9 and orthopaedic footwear is in class 10. Applicants

¹⁶ *Cheung Chi Wai t/a Chi Fung Engineering Co v Chi Fung Engineering Ltd & Ors* [2017] 5 HKLRD 44, [2017] HKCU 2283 (DC).

¹⁷ *Wu Shun Kwan v Lam Koon Wan* (unreported, DCCJ 5400/2004, 7 April 2005) (DC).

¹⁸ *Chi Wing and Law Oi Ying trading as Singapore Headway Medicine Co v Law Yan Wai trading as Singapore Medicine Co* [2022] HKCU 4909, [2022] HKDC 1049.

¹⁹ See WIPO, 'Nice Classification' <https://www.wipo.int/classifications/nice/en/> accessed 17 September 2025; *Sky plc and other companies v SkyKick UK Ltd and another company* [2018] EWHC 155 (Ch), [2018] RPC 5, [2018] ETMR 23 at para 124 et seq; and the UK Supreme Court decision in *SkyKick UK Ltd & Anor v Sky Ltd & Ors* [2024] UKSC 36 at paras 22–34 for detailed discussion of the Nice Agreement and Nice Classification.

comes from or does it only tell the customer what the product or service is? Or as Jacob J put it in *Philips Electronics BV v Remington Consumer Products Ltd* [1998] RPC 283, does the sign only convey the message 'here are a particular trader's goods?'

As was stated in *Premier Luggage and Bags Ltd v The Premier Co (UK) Ltd*,³¹ examples given in the cases of signs which are incapable of satisfying this test usually concern those which are descriptive of the article, such as 'soap',³² 'Bunsen burner',³³ 'Wellington boot',³⁴ and 'banana'.³⁵ It should be noted that non-qualifying signs fall into two potential categories: those which have never been capable of distinguishing and those which once had the capacity to distinguish but have through use lost such capacity.³⁶ The question must be addressed at the date of the application.³⁷

5.3 Capable of being represented graphically

[2-17]

These words mean no more than that the sign is one which is possible to represent so that someone looking at the representation can identify precisely what it is. In *Swizzels Matlow Ltd's Application for a Three-Dimensional Trade Mark*,³⁸ the shape of the three-dimensional mark applied for (a sweet) was described only in words, no visual image being given. Simon Thorley QC (the appointed person) held that the words 'represented graphically' do not mean that there has to be a visual image of the mark but that, in view of other provisions of the UK Act such as those relating to infringement, it is essential that the graphical representation must be such as to enable the public to know exactly what the sign is. Provided that precise identification is possible, there is no restriction on the actual type of representation, be it in writing, drawing, musical notation, written description or any combination thereof. This same reasoning was applied by Geoffrey Hobbs QC (the appointed person) in *Ty Nant Spring Water Ltd's Trade Mark Application*,³⁹ who observed that there may be more than one way of representing a sign graphically so that its identity is clearly and unambiguously recorded. Special issues around smell, sound and moving image marks are discussed below.

31 *Premier Luggage and Bags Ltd v The Premier Co (UK) Ltd* [2001] FSR 461 (Ch). Terence Etherington QC (sitting as a deputy judge) (affirmed as to the validity of the registration by the Court of Appeal: *Premier Luggage and Bags Ltd v Premier Co (UK) Ltd* [2002] EWCA Civ 387, [2003] FSR 69).

32 *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (Ch) at 302 and 305.

33 *BACH and BACH FLOWER REMEDIES Trade Mark* [2000] RPC 513 at 526.

34 *BACH and BACH FLOWER REMEDIES Trade Mark* [2000] RPC 513.

35 *JERYL LYNN Trade Mark* [1999] FSR 491 (Ch).

36 *BACH and BACH FLOWER REMEDIES Trade Mark* [2000] RPC 513 at 533. An example of the latter would be the rose for the England rugby team: *Rugby Football Union v Cotton Traders Ltd* [2002] ETMR 861 (Ch).

37 *Rugby Football Union v Cotton Traders Ltd* [2002] ETMR 861 (Ch).

38 *Swizzels Matlow Ltd's Application for a Three-Dimensional Trade Mark* [1999] RPC 879.

39 *Ty Nant Spring Water Ltd's Trade Mark Application* [2000] RPC 55.

5.3.1 Smell marks

[2-18]

Smell marks create difficulties to represent a mark graphically. Some early decisions in the UK allowed for descriptions of smells.⁴⁰ However, later decisions of the ECJ have made it almost impossible to register a smell mark. In *Sieckmann v Deutsches Patent-und Markenamt*,⁴¹ an application was made for an old factory mark deposited with the German Patent and Trade Mark Office, and the chemical formula of the substance involved was set out in the application.⁴² The European Court of Justice held that the requirement of graphical representation means that the trade mark may consist of a sign which is not itself capable of being perceived visually, provided it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.⁴³ This requirement is not satisfied in respect of an olfactory mark by the chemical formula (as few people would recognise in such a formula the odour in question), by the description of the odour (which, although graphic, is not sufficiently clear, precise and objective), or by the deposit of a sample (as that does not constitute a graphic representation and is anyway not sufficiently stable or durable).⁴⁴ The court's decision was not specific on the actual description used, but appears to apply generally to any description of an odour, which may therefore call into question whether this requirement of graphical representation can ever be satisfied in relation to smell or odour as a trade mark and the correctness of the English decisions that predate this decision. In *Eden SARL v OHIM*,⁴⁵ an application to register a sign consisting of 'the smell of ripe strawberries' was refused as it is not sufficiently unequivocal or precise because different varieties of strawberries smelled different when ripe. The Hong Kong Trade Marks Registry deals with smell marks in the Deficiencies Checking section of its Work Manual where it states that a major hurdle to registering a smell mark is the lack of a generally accepted means to represent a smell mark graphically. Further, its FAQ page, in response to a question as to whether a smell mark can be registered as a chemical formula, states:

A trade mark must be clearly depicted in the application in sufficient detail to permit a proper examination to be made of the trade mark. It must also be clear to members of the public looking at the electronic register exactly what is being

40 *Venootschap onder Firma Senta Aromatic Marketings Application* [1999] ETMR 429 and *John Lewis of Hungerford Ltd's Trade Mark Application* [2001] RPC 575.

41 *Sieckmann v Deutsches Patent-und Markenamt* [2003] RPC 685.

42 The description was as follows: 'Trade mark protection is sought for the olfactory mark deposited with the Deutsches Patent-und Markenamt of the pure chemical substance methyl cinnamate (cinnamic acid methyl ester), whose structural formula is set out below. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telecom AG or, for example, via the firm E Merck in Darmstadt'.

43 *Sieckmann v Deutsches Patent-und Markenamt* [2003] RPC 685 at 693 at para 55.

44 See *Sieckmann v Deutsches Patent-und Markenamt* [2003] RPC 685 at 695 at paras 69-73.

45 *Eden SARL v OHIM* [2006] ETMR 181.

CHAPTER 5

Patents

1. INTRODUCTION

[5-1]

Until 27 June 1997, Hong Kong had no indigenous patent law. Instead, it had a system of registration and enforcement of patents obtained or recognised in the United Kingdom. The rights and privileges conferred were essentially those which the patent holder enjoyed in the United Kingdom. In view of Hong Kong's impending handover of Hong Kong to China on 1 July 1997,¹ it became necessary to enact laws which were not directly dependent on rights granted or recognised in the United Kingdom. The Patents Ordinance (Cap 514)² was, therefore, enacted and came into operation on 27 June 1997³ together with its accompanying subsidiary legislation.⁴ This Ordinance provided for the re-registration of patents registered in the United Kingdom, the European Patent Office (designating the UK) or China. A new system for registering short-term patents was introduced. In 2016, the Ordinance was amended to allow for patent applications to be directly filed in Hong Kong. The amendments came into force on 19 December 2019.⁵

2. BACKGROUND

2.1 History of patent law in Hong Kong

[5-2]

Until the enactment of the Patents Ordinance⁶ on the 27 June 1997,⁷ protection for patents in Hong Kong was closely tied to the United Kingdom patents system. That system dates back to the 16th century when monopolies were first granted by Elizabeth I in exercise of the Royal

¹ As from that date Hong Kong became a Special Administrative Region of the People's Republic of China.

² Patents Ordinance (Cap 514), Laws of Hong Kong.

³ With the exception of s 125 (applications for short-term patents based on international applications), which came into operation on 1 July 1997. See Patents Ordinance (52 of 1997) (Commencement) Notice 1997 (LN 367 of 1997).

⁴ ie, the Patents (General) Rules (Cap 514C), the Patents (Transitional Arrangements) Rules (Cap 514B) (repealed) and the Patents (Designation of Patent Offices) Notice (Cap 514A).

⁵ Patents (Amendment) Ordinance 2016 Commencement Notice, 4 October 2016 and Patents (General) (Amendment) Rules 2019 (Commencement) Notice, 4 October 2019.

⁶ Patents Ordinance.

⁷ With the exception of s 125.

Prerogative. As a result of abuse, the Statute of Monopolies of 1623 declared all monopolies unlawful apart from letters patent granted to the true and first inventor of a manner of new manufacture. The rationale of the patent system became and remains to encourage inventors by giving them a monopoly in their new inventions for a specified period, in return for which the invention must be disclosed for use by all once in the public domain. The first patent legislation enacted in Hong Kong was the Patents Ordinance 1892.⁸ Under this Ordinance, the Governor had a discretion to grant letters patent to the owner, assignee, etc of letters patent granted in the United Kingdom in respect of inventions which had not been publicly used in Hong Kong and which would in all probability be of great public utility here. This Ordinance was replaced in 1925 by the Registration of United Kingdom Patents Ordinance 1925,⁹ which provided for the registration in Hong Kong of letters patent issued in the United Kingdom and for the grant of a Hong Kong certificate of registration. The certificate of registration had to be applied for within three years of the issue of the letters patent in the United Kingdom and gave the applicant privileges and rights (subject to local laws) as though the letters patent had been issued in the United Kingdom with an extension to Hong Kong. A discretion was also given to the court to declare that the privileges and rights had not been acquired in circumstances where the letters patent could have been revoked in the United Kingdom. This 1925 Ordinance was amended three times, principally to extend the three-year period to five years¹⁰ and to include manufacture, sale and use in Hong Kong before the application date in the United Kingdom as a ground for a declaration by the court.¹¹ In 1932, the Registration of United Kingdom Patents Ordinance 1932¹² was enacted, consolidating and repealing the earlier ordinances. This 1932 Ordinance remained the law in Hong Kong until the passing of the 1997 Patents Ordinance 1892 and was subject to three substantial amendments during its lifetime. Crown Use provisions were introduced into it in 1968,¹³ amendments were incorporated in 1979 to allow for registration of European Patents (UK) granted by the European Patent Office in Munich¹⁴ and it was amended in 1996 by the Intellectual Property (World Trade Organization Amendments) Ordinance¹⁵ to allow for Government use in declared periods of extreme urgency.

⁸ Patents Ordinance (2 of 1892).

⁹ Registration of United Kingdom Patents Ordinance (13 of 1925).

¹⁰ Registration of United Kingdom Patents Amendment Ordinance 1928 (10 of 1928).

¹¹ Registration of United Kingdom Patents Amendment Ordinance 1931 (38 of 1931).

¹² Registration of United Kingdom Patents Ordinance (42 of 1932).

¹³ Registration of United Kingdom Patents (Amendment) Ordinance 1968 (24 of 1968).

¹⁴ Registration of United Kingdom Patents (Amendment) Ordinance 1979 (25 of 1979), which also deleted 'United Kingdom' from the title and other parts of the Ordinance.

¹⁵ Intellectual Property (World Trade Organization Amendments) Ordinance (11 of 1996), the patent provisions of which came into operation on the 10 May 1996: LN 186 of 1996.

2.2 The present governing legislation

[5-3]

The governing patent law in Hong Kong is the Patents Ordinance (Cap 514) and its subsidiary legislation, namely, the Patents (General) Rules (Cap 514C) which came into operation on the 27 June 1997.¹⁶ Following a review of the patent system by an advisory committee,¹⁷ in 2016, the Patents Ordinance was amended substantially to provide for a system to grant patents directly in Hong Kong (called Original Grant Patents); making improvements to the short term patents system; clarifying the law on second medical use patents as well as introducing regulations for the patent agency system ('2016 Amendments'). The amendments came into force on 19 December 2019. The Patents Ordinance is based on the United Kingdom Patents Act 1977 and the main provisions are essentially the same, meaning that United Kingdom case law can, in general, be applied in Hong Kong. United Kingdom text books are also regularly referred to.¹⁸ There are, however, some differences between the laws. For example, the provisions relating to unjustified threats or amendment of patents are different and care should be taken to check the Hong Kong legislation against the UK legislation before relying on UK case law. UK patent law is based on the provisions of the European Patents Convention (EPC). The UK courts will therefore give due regard to decisions of the European Patents Office in relation to the law on validity of patents and will follow decisions of the EPO which represent a settled view of the law even if they are contrary to UK decisions.¹⁹ The EPC is not a European Union treaty and the UK remains a member despite Brexit. (A number of other non-EU members are also members of the EPC including Turkey and North Macedonia.)

[5-4]

The principal international conventions governing patent law to which Hong Kong is a party are the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the Patent Cooperation Treaty (PCT). PCT applications intended to be registered in Hong Kong must designate China and be re-registered as a Standard Patent (R).²⁰

¹⁶ With the exception referred to in note 4. The Patents (Transitional Arrangements) Rules (Cap 514B) also came into force in 1997. They were repealed as spent in 2025.

¹⁷ The 'Report of the Advisory Committee on Review of the Patent System in Hong Kong'. Available at: https://www.ipd.gov.hk/eng/intellectual_property/patents/review_report.pdf (accessed 4 November 2018).

¹⁸ *Terrell on Patents* is the most commonly cited UK textbook. The UK Patent Office also publishes on line a Manual of Patent Practice that provides excellent reference material. This is updated regularly. In November 2018, it was available at: <https://www.gov.uk/government/publications/patents-manual-of-patent-practice>.

¹⁹ See the UK Patent Office, Manual of Patent Practice, paras 0.09–0.10 for a discussion of this point and, in particular, the Supreme Court decision in *Eli Lilly and Co v Human Genome Sciences Inc* [2011] UKSC 51, [2012] 1 All ER 1154, [2012] RPC 6.

²⁰ PCT Applicant's Guide — National Phase — National Chapter — CN. See further [5-13].

2.3 Patent Examination Guidelines

[5-5]

As part of the introduction of the system for original grant of patents in Hong Kong, the Intellectual Property Department has prepared Patent Examination Guidelines.²¹

These are broken into three major parts: Patentability, Preparation of the Specification, and Application Examination and Hearing Procedures. The Examination Guidelines comprise the following sections:

Section 1:	Novelty
Section 2:	Inventive Step
Section 3:	Industrial Application
Section 4:	Exclusions from Patentability
Section 5:	Medical or Diagnostic Use Claims
Section 6:	Specification
Section 7:	Kinds of Claims
Section 8:	Requirements for Claims
Section 9:	Sufficiency of Disclosure
Section 10:	Unity of Invention
Section 11:	Double Patenting
Section 12:	Construction of Claims
Section 13:	Patent Applications
Section 14:	Formality Examination of Patent Applications
Section 15:	Substantive Examination of Standard Patent (O) Applications and Short-term Patents
Section 16:	Amendments to Patent Applications and Patents

As with the Trademark Work Manual, the Patent Examination Guidelines are not law.²²

The court will be willing to scrutinise procedural aspects on appeal to ensure procedural fairness.²³

2.4 Relevance of the old law

[5-6]

Although the previous legislation, the Registration of Patents Ordinance (Cap 42),²⁴ has been repealed by the Patents Ordinance,²⁵ it continues to

²¹ Available at: https://www.ipd.gov.hk/eng/intellectual_property/patents/Patents_Examination_Guidelines.htm (accessed as at 1 May 2021).

²² See [2-8]. The preface to the Examination Guidelines states:

Please however note that statements made in these Guidelines are not by themselves an authority for any action by the Registrar. They also should not be regarded as the legal requirements or as a conclusive interpretation of the patent legislation.

²³ *Monkey Tower Ltd v Ability International Ltd* [2014] EWHC 18 (Pat) at para 15, per Henry Carr QC DHCJ (as he then was).

²⁴ Registration of Patents Ordinance (Cap 42) (repealed), Laws of Hong Kong 1979 edn, as amended by the Intellectual Property (World Trade Organization Amendments) Ordinance.

be relevant in two ways. First, it applies to applications for registration pending under it at that date.²⁶ While by 2017, all patents applied for in 1997 or before had expired, there can be claims for past damages to be made for up to six years until the limitation period expires (six years from the infringing act). Second, any acts commenced before the 27 June 1997 which would not have been an infringement under the old Ordinance shall not be an infringement under the Patents Ordinance if continued after that date.²⁷

3. PATENTS RECOGNISED IN HONG KONG

[5-7]

It is possible to register three types of patents in Hong Kong, namely:

- Standard Patent (O) which is registered under original grant procedures that provide for local substantive examination;²⁸
- Standard Patent (R) which is a re-registration of a patent applied for and registered in the Mainland of China or the United Kingdom (either directly or through the European Patent Office (EPO));
- short term patent registered directly in Hong Kong following formal examination only, but with the ability to apply for substantive examination.

3.1 Term and renewal

[5-8]

A standard patent takes effect on the date upon which the fact of its grant is advertised in the official journal and, subject to the payment of renewal fees, remains in force until 20 years after the date of filing of the application in Hong Kong or the designated patent office.²⁹ Renewal fees must be paid in order to keep the patent in force beyond the date three years after the anniversary of the deemed date of filing first occurring after the date of grant; they are first payable within the three-month period before that date and are then payable for every subsequent year thereafter.³⁰ A six-month extended period is granted by s 39(4) of the Patents Ordinance, during which the proprietor can pay without losing his rights.

[5-9]

A short-term patent takes effect on the date on which the fact of its grant is advertised in the official journal.³¹ Subject to renewal after four years, it remains in force for eight years from the date of filing the application.³²

²⁵ Patents Ordinance, s 154.

²⁶ Patents (Transitional Arrangements) Rules (repealed), s 5.

²⁷ Patents Ordinance, s 157(3) (repealed).

²⁸ These provisions came into effect from 19 December 2019.

²⁹ Patents Ordinance, s 39(1). The date of filing in the designated patent office is known as the 'deemed date of filing': Patents Ordinance, s 38.

³⁰ Patents Ordinance, s 39(2) and (3).

³¹ Patents Ordinance, s 126(1)(a).

³² Patents Ordinance, s 126(1)(b).

The renewal fee must be paid in the three-month period before the end of four years after the date of filing or, if the patent is granted after the end of that four-year period, within three months after the date of grant.³³ If the renewal fee and any additional fee is paid within six months after the end of either of those periods, the patent is treated as having never expired and as having remained in force.³⁴

3.2 Restoration of patent

[5-10]

Where a standard patent has ceased to have effect due to non-payment of renewal fees during the normal and extended periods, an application can be made for restoration, provided that it is made within 18 months from the date when the patent ceased to have effect.³⁵ Notice of an application for restoration must be advertised in the official journal and restoration will only be ordered if the Registrar is satisfied that non-payment occurred in spite of the applicant having taken all reasonable care required by the circumstances.³⁶ If a standard patent is restored, a degree of immunity is given to third parties who, between the end of the six-month extended period and the advertisement in the official journal of the notice of application to restore, began bona fide or made bona fide serious and effective preparations to do what would have been infringing acts. Such third parties can continue or do such acts without infringing and, if the acts are done in the course of a business, can assign or transmit the right or authorise any partner for the time being in the business to do them; but they cannot grant a licence to do the acts.³⁷

3.3 Surrender of patent

[5-11]

The proprietor may at any time offer to surrender his patent by written notice to the Registrar.³⁸ Details of the notice must be advertised in the official journal³⁹ and anyone may give notice to the Registrar of his opposition to the surrender. The Registrar must give notice to the proprietor of any opposition and either decide the question or, if he thinks fit, refer the matter to the court.⁴⁰ If the Registrar is satisfied that the patent may properly be surrendered, he may accept the offer and the patent ceases to have effect as from the date on which notice of his acceptance is advertised in the official journal.⁴¹ No action for infringement lies in respect of any act done before that date.⁴²

³³ Patents Ordinance, s 126(2) and (3).

³⁴ Patents Ordinance, s 126(5).

³⁵ Patents Ordinance, s 40(1). See also Patents (General) Rules, s 34.

³⁶ Patents Ordinance, s 40(4). See also Patents (General) Rules, s 34.

³⁷ Patents Ordinance, s 41(3)–(5).

³⁸ Patents Ordinance, s 48(1).

³⁹ Patents (General) Rules, s 30(1).

⁴⁰ Patents Ordinance, s 48(2) and (4).

⁴¹ Patents Ordinance, s 48(3).

⁴² Patents Ordinance, s 48(3).

3.4 Language of proceedings

[5-12]

A patent application must be filed in one of the official languages⁴³ and, unless otherwise provided, that language shall be used in all proceedings before the Registrar concerning the application or the resulting patent.⁴⁴ The text of the patent or application in that official language shall be the authentic text in all proceedings before the Registrar or court.⁴⁵ In the case of a Standard Patent (R) or Standard Patent (R) application, the text in the language of the designated patent office proceedings shall be the authentic text if it is in one of the official languages. If it is in another language and the translation into one of the official languages narrows the scope of protection, the translation shall be treated as the authentic text other than for revocation proceedings.⁴⁶ The proprietor or applicant can then file a corrected translation which the Registrar (on payment of the required fee) publishes. Infringements committed before the corrected publication are judged by the original text, unless the proprietor previously supplied the corrected version to the infringer; acts infringing the corrected but not the original translation, and acts in respect of which effective and serious preparations were made in good faith before the date of the corrected translation, can be continued.⁴⁷ An amendment to a patent or patent application may only be made in the language of the authentic text.⁴⁸

4. STANDARD PATENTS

4.1 Standard Patents (O)

[5-13]

Part 3 of the Patents Ordinance (ss 37A to 37ZD) which was introduced as part of the 2016 Amendments that came into force on 19 December 2019 makes provision for applications for standard patents to be filed directly in Hong Kong. The procedures are similar to the process for applying for patents in the rest of the world. The applicant may file a direct application or a Paris Convention priority application. Importantly, however, it is not possible to make an international application through the Patent Cooperation Treaty directly in Hong Kong. For PCT applications, the procedures for re-registration of a Standard Patent (R) will need to be followed (or an application made for a short term patent when the patent enters the national phase in China).⁴⁹

⁴³ English and Chinese being the official languages: Official Languages Ordinance (Cap 5), s 3.

⁴⁴ Patents Ordinance, s 104(1) and (2). Another language may be used on giving requisite notice. Patents (General) Rules, s 56(6).

⁴⁵ Patents Ordinance, s 105.

⁴⁶ Patents Ordinance, s 106(1) and (2).

⁴⁷ Patents Ordinance, s 106(3) and (4).

⁴⁸ Patents Ordinance, s 107.

⁴⁹ Patents Ordinance, s 125 provides for applications based on PCT applications for short-term patents after they enter the national phase in China. See [5-63].

4.1.1 *Formal examination*

[5-14] After filing of the patent application, the Registrar is required to conduct a formal examination of the application and if it meets the formal requirements publish the application.⁵⁰ These requirements include a specification with a description of the invention, at least one claim; any drawings referred to in the description or claims; and, any priority claim. The date of filing of the patent will be the date when the 'minimum requirement' in s 27M(3) is met, namely, an indication that a Standard Patent (O) is sought; information identifying the applicant; and 'something that appears to be a description of an invention' or a reference to a previous application. Any deficiencies are required to be corrected within two months of notification by the Registrar.⁵¹

4.1.2 *Publication of the application*

[5-15] The Registrar is required to publish the patent application on expiry of the 'prescribed time'.⁵² The application will be published either 18 months from the date of application or, if priority is claimed, 18 months from the earliest priority date.⁵³ If the applicant requests, the Registrar may publish the application earlier.⁵⁴

4.1.3 *Third party observations*

[5-16] Following the publication of the patent application, any third party may file observations on the patentability of the invention. These are required to be sent to the applicant and considered by the Registrar when substantively examining the patent. The person filing the observations does not become a party to any proceedings by filing observations.⁵⁵ The notice is required to be filed before the Registrar completes examination of the patent.⁵⁶

4.1.4 *Substantive examination*

[5-17] The applicant is required to make an application for substantive examination in accordance with the Rules.⁵⁷ The Registrar will then

⁵⁰ Patents Ordinance, s 37P.

⁵¹ Patents (General) Rules, s 31Y.

⁵² Patents Ordinance, s 37Q(1).

⁵³ Patents (General) Rules, s 31Z.

⁵⁴ Patents Ordinance, s 37Q(2).

⁵⁵ Patents Ordinance, s 37R.

⁵⁶ Patents (General) Rules, s 31ZA.

⁵⁷ Patents Ordinance, ss 37T and 37U. Full procedures for substantive examination are set out in the Patents (General) Rules, Pt 3A, Div 5 (s 31ZB et seq).

examine the application to ensure that it complies with the following requirements:

- (a) The invention is patentable under s 9A. That is, it is novel, inventive and has industrial application.
- (b) Priority has been properly claimed.
- (c) There is sufficient disclosure of the invention as required by s 77.
- (d) The claims comply with s 78 by being clear and concise, are supported by the description, and relate to one invention or group of inventions.
- (e) There is no added matter.
- (f) There is no overlap with another application by the same inventor.

[5-18] If the Registrar considers that the application does not fulfill the requirements for grant, she must inform the applicant in writing. The applicant may then make representations or seek to amend the application. Any amendments may not include added matter.⁵⁸ The Registrar must consider any representations put forward and/or amendments proposed by the applicant and either grant the patent and cause it to be published in the Gazette or refuse the application.⁵⁹

4.1.5 *Amendment and withdrawal*

[5-19] An applicant may amend its application or withdraw its application.⁶⁰

4.1.6 *Divisional applications*

[5-20] An applicant may also make a divisional application based on some of the subject matter included in the original application. A divisional application may be filed while an application is pending or within a time to be specified by the rules after refusal of an application.⁶¹

4.1.7 *Publication and grant*

[5-21] Following a decision to grant a patent, the Registrar must: (a) publish the specification of the patent, the name of the application and the name of the inventor; (b) issue a certificate of grant of the patent; and (c) advertise the grant of the patent in the official journal.⁶²

⁵⁸ Patents Ordinance, s 37V.

⁵⁹ Patents Ordinance, ss 37W-37Y.

⁶⁰ Patents Ordinance, ss 37ZA and 37ZB. Patents (General) Rules, s 31ZT.

⁶¹ Patents Ordinance, s 37Z. Patents (General) Rules, s 31ZS. The period provided is two months from refusal or a time specified by the Registrar if the refusal is under appeal.

⁶² Patents Ordinance, s 37X.

4.1.8 Appeal to the court

[5-22]

Any decision of the Registrar may be appealed to the Court of First Instance.⁶³ No specific procedures have yet been enacted for appeals and the provisions of O 55 r 3 of The Rules of the High Court (Cap 4A) should be applied and the appeal brought by way of Originating Motion. Appeals should be filed in the IP Specialist List.⁶⁴

[5-23]

While no appeals of decisions of the Registrar under the Patents Ordinance have been heard by the Hong Kong court, it can be expected that the court will show the same standard of deference it does to decisions of the Trade Marks Registry. That is, that the court will treat the decision with respect and not necessarily overturn a decision because it disagrees with it.⁶⁵ In England, in *Rockwool International AS v Knauf Insulation Ltd*,⁶⁶ Marcus Smith J set out the principles to be applied on the question of an appeal against a decision of non-obviousness (which should generally be applicable to most cases regarding registrability) as:

- (a) First, in an appeal against a finding of non-obviousness, the court should only interfere with the decision below if there has been an error of principle.⁶⁷
- (b) Secondly, although the parties dispensed with cross-examination of witnesses before the Hearing Officer by agreement, this did not entitle me to substitute my view for that of the Hearing Officer absent: (i) an error of principle; (ii) a failure on the part of the Hearing Officer to take account of material evidence before him; or (iii) the Hearing Officer paying regard to immaterial evidence. That said, were I to take the view that the Decision should be varied or set aside on appeal, given the absence of cross-examination by agreement, there would be no need to remit matters to the Hearing Officer.
- (c) Thirdly, I should not be unduly critical of the way in which the Decision is expressed: my starting point should be that an experienced tribunal such as the Hearing Officer in this case would know how to perform his functions and what matters he should take into account.⁶⁸

⁶³ Patents Ordinance, s 130 and The Rules of the High Court (Cap 4A), O 55. See further at [5-111]. Draft Rules of the Court were circulated in 2018. The IPD has advised they could only be finalised once the 2016 Amendments came into force. It is expected they will be enacted in 2019.

⁶⁴ See further [10-2] et seq.

⁶⁵ See [2-374].

⁶⁶ *Rockwool International AS v Knauf Insulation Ltd* [2020] EWHC 1068 (Pat).

⁶⁷ *Actavis Group PTC EHF & Ors v Icos Corp & Anor* [2019] UKSC 15 at 78–81, [2020] 1 All ER 213. Strictly, these principles apply to an appellate court overturning the finds of a trial judge and not a hearing officer.

⁶⁸ *Pigłowska v Pigłowski* [1999] 3 All ER 632, [1999] 1 WLR 1360 at 1372.

4.2 Standard Patents (R)

4.2.1 Nature and application

[5-24]

The Patents Ordinance provides⁶⁹ for the registration as a Standard Patent (R) of a patent which has been registered in a 'designated patent office'. The patent offices so designated are the State Intellectual Property Office of the People's Republic of China (now the China Intellectual Property Administrator), the European Patent Office (in respect of patents granted under the European Patent Convention designating the United Kingdom) and the United Kingdom Patent Office.⁷⁰ The application for a standard patent has to be made in two stages known as a 'request to record' and a 'request for registration and grant'. The person entitled to apply for a Standard Patent (R) is the person named as applicant in the designated patent application or his successor in title in Hong Kong, or, in preference to such person, the person entitled to the property in the invention in Hong Kong.⁷¹

4.2.2 Request to record

[5-25]

The applicant must, within six months of publication of an application for a patent in a designated patent office, request the Registrar of Patents to record that designated patent application.⁷² The contents of the request to record and the manner in which it is to be filed are prescribed by s 15(2) of the Patents Ordinance (Cap 514) and s 8 of the Patents (General) Rules (Cap 514C). The date at which a request to record is made is the earliest date on which the request contains the documents identified in s 17(1) of the Patents Ordinance.⁷³ Filing and advertisement fees must be paid within one month of the earliest filing of any part of the request to record; if either fee is not paid within that period or the one month grace period allowed by s 11 of the Patents (General) Rules, the application is deemed to be withdrawn.⁷⁴ If the earliest filing of any part of a request to record takes place more than six months after the publication of the designated patent

⁶⁹ In Patents Ordinance, Pt 2 (ss 10–30).

⁷⁰ Patents (Designation of Patent Offices) Notice (LN 297 of 1997) as amended by the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001), s 15.

⁷¹ Patents Ordinance, s 12(1). See also [5-105] and [5-248].

⁷² Patents Ordinance, s 15(1). Where the designated patent application is the national phase of an international application made under the Patent Cooperation Treaty, the date of publication is the date of publication in the designated patent office as serves to indicate that the international application has validly entered its national phase in the designated patent office: Patents Ordinance, s 16 and Patents (General) Rules, s 15.

⁷³ The applicant is given an opportunity to correct deficiencies as regards these filing requirements, failure to comply with which results in the application not being treated as an application for a standard patent: see Patents Ordinance, s 17(2) and (3), and Patents (General) Rules, s 17.

⁷⁴ Patents Ordinance, s 15(4).

CHAPTER 6

Registered Designs

1. INTRODUCTION

[6-1]

Before 27 June 1997, Hong Kong had no system of registering designs and merely provided a system of enforcing designs registered in the United Kingdom. On that date the Registered Designs Ordinance (Cap 522) and its subsidiary legislation¹ came into operation,² giving Hong Kong for the first time its own registered design law.

2. GENERAL

[6-2]

Whilst patents protect new inventions, registered designs protect the appearance of new designs. Although their scope of protection is fundamentally different, patents and registered designs have certain features in common. They both have novelty as a basic requirement and, if valid, they both confer true monopolies, in that (unlike copyright) no copying or even knowledge of their existence need be proved in order to establish infringement. In some jurisdictions, registered designs are known as design patents. There is, however, some overlap with the Copyright Ordinance (Cap 528) under which unregistered designs can be protected for up to 15 years. This is discussed in the Chapter on Copyright law.

3. THE GOVERNING LAW

[6-3]

The governing registered design law in Hong Kong is the Registered Designs Ordinance (Cap 522).³ This repealed the previous legislation, the United Kingdom Designs (Protection) Ordinance (Cap 44),⁴ which extended to Hong Kong the privileges and rights which the owner of a UK registered design held in the United Kingdom. As the last design registered under the old ordinance will have expired in 2022, the provisions of the old ordinance are now of historical interest only and reference to its provisions have been removed from this chapter since 2022. (Although

¹ Registered Designs Rules (Cap 522A).

² Registered Designs Ordinance (64 of 1997) (Commencement) Notice 1997 (LN 368 of 1997). The Registered Designs Rules provide that they came into operation on the same day as the Ordinance.

³ Together with the Registered Designs Rules.

⁴ Cap 44 LHK, 1964 ed. See the Registered Designs Ordinance (Cap 522), s 96(1).

there remains the small possibility of claims for damages on expired designs being made up until 2028).

4. REGISTERED DESIGNS RECOGNISED IN HONG KONG [6-4]

Hong Kong law recognises two types of registered designs: (a) those applied for and registered under the Registered Designs Ordinance (Cap 522), and (b) those deemed registered under the Ordinance. Designs deemed registered under the Ordinance are designs that were registered or pending on 27 June 1997 when the Ordinance came into force. In order to be valid in Hong Kong now, any design that was deemed to be registered must have been renewed in Hong Kong. The last deemed registrations will have expired latest by 27 June 2022.

5. REGISTRABILITY OF DESIGNS

5.1 Meaning of design under the Ordinance

[6-5]

Section 2(1) of the Registered Designs Ordinance provides that 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include:

- (a) a method or principle of construction; or
- (b) features of shape or configuration of an article which—
 - (i) are dictated solely by the function which the article has to perform; or
 - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part.

5.1.1 Features of shape, configuration, pattern or ornament

[6-6]

Shape and configuration are generally regarded as synonymous, both referring to three-dimensional features; in one case however it was held that the ribbing on a hot water bottle was a feature of configuration but probably not of shape.⁵ In *C Art Ltd v Ability Manufactory Ltd*,⁶ it was held that both the external profile and the relative positions of the speaker and control knobs in the combined bag and radio subject of the plaintiff's registered design were features of shape and configuration; further, that the relative positions of the speaker and control knobs were unusually well embraced by the ordinary meaning of 'configuration'.⁷ By contrast, pattern and ornament refer largely to two-dimensional features, although raised and engraved ornamentation would certainly also be covered. In *Apple*

⁵ *Cow (P B) & Co Ltd v Cannon Rubber Manufacturers Ltd* [1965] RPC 347.

⁶ *C Art Ltd v Ability Manufactory Ltd* [1989] 1 HKC 320 (HC).

⁷ The ordinary meaning being 'mode of arrangement, conformation, outline ...'.

Computer Incorporated v Design Registry,⁸ it was held that icons built into operating system software and appearing or capable of appearing on a computer screen when the computer was switched on were features of pattern or ornament applied to the article (namely, the computer).

5.1.2 'Must match' exception: exclusion of designs which are dependent upon the appearance of another article of which the article is intended by the author to form an integral part

[6-7]

The definition of features of shape or configuration excludes designs which 'are dependent upon the appearance of another article of which the article is intended by the author to form an integral part'.⁹ In *Ford Motor Co Ltd's Design Applications*,¹⁰ the Divisional Court upholding the Registered Designs Appeal Tribunal's decision¹¹ held that items such as main body panels, doors, bonnet lids, boot lids and windscreens fell foul of the equivalent section of the UK Act (s 1(1)(b)(ii)) in that the makers had no design freedom, given the appearance of the vehicle, which was the 'other article'.¹² The Tribunal's decision that items such as wing mirrors, seats, wheels and steering wheels which have a commercial life of their own and are subsidiary to the essential shape of the vehicle do not fall within the exception and are, in principle, registrable was not challenged.

5.1.3 Which in the finished article appeal to and are judged solely by the eye

[6-8]

The provision was analysed by the Privy Council in a Hong Kong case, *Interlego AG v Tyco Industries & Ors*.¹³ One of the issues before the Privy Council was whether the designs of the well-known Lego bricks were registrable or not. Lord Oliver held that the first part of the definition 'features which in the finished article appeal to and are judged solely by the eye' could be paraphrased by saying that the finished article must have 'eye-appeal'.¹⁴ The eye is that of the prospective customer and the appeal is that created by a distinctiveness of shape, pattern or ornamentation calculated to influence the customer's choice.¹⁵ If a design does not have

⁸ *Apple Computer Incorporated v Design Registry* [2002] FSR 602 (Registered Designs Appeal Tribunal).

⁹ It is known as the 'must match' exception: see *Ford case* (above). Section 265 of the Copyright, Designs and Patents Act 1988 (UK) has been repealed and the current UK definition of 'design' refers to a 'product' rather than an 'article': see s 1(2) of the current Registered Designs Act 1949 (UK).

¹⁰ *Ford Motor Co Ltd's Design Applications* [1994] RPC 545.

¹¹ *Ford Motor Co Ltd Design Application* [1993] RPC 399.

¹² The House of Lords refused to decide this point, confining their decision to considering whether the parts were 'articles': see [6-13]: *Ford Motor Co Ltd Design Applications* [1995] 1 WLR 18, [1995] RPC 167.

¹³ *Interlego AG v Tyco Industries Inc & Ors* [1989] AC 217, [1988] 3 All ER 949, [1988] RPC 343.

¹⁴ At 516.

¹⁵ At 517. In *Elster Metering Ltd v Billions Ltd* [2007] 2 HKLRD 319, [2007] HKCU

eye-appeal, it fails to qualify and the second exclusionary part of the definition need not be considered.¹⁶ The fact that a design cannot be seen at the time of purchase or is only transient does not matter. In *Apple Computer Inc's Design Applications*,¹⁷ the fact that the icons were only seen or capable of being seen when the computer was switched on was not a valid objection, since they were still features in the finished article.¹⁸

[6-9]

In *Glaxo Group Ltd v Chia Tai Tianqing Pharmaceutical Group Co, Ltd*¹⁹ Lok J held words 'judged by the eye' excluded cases where it is shown that the customer is not influenced in choice by appearance, but only by criteria of suitability for a purpose. He added after citing to the House of Lords decision in *Amp Inc v Utilux Pty Ltd*:²⁰

22. The eye to which appeal must be made, and the eye which is to judge, is not the eye of the court but the eye of the customer. The underlying purpose of design registration is to give to the owner of the design the commercial value resulting from customers preferring the appearance of articles which have the design, to those which do not have it.

23. Though a particular design may appeal to the aesthetic sense or to the sense of the beautiful, it has always been considered that a design need not possess any artistic merit.

24. The impression resulting from the design may influence choice and selection on the part of a person desiring to acquire the finished article carrying the design, and if it influences such a person, then the design may be considered to have 'eye appeal' for the purposes of the statutory definition. The design may be 'calculated to attract the attention of the beholder', regardless of whether or not it makes a favourable impression upon him.

5.1.4 Features of shape or configuration dictated solely by function

[6-10]

In *Interlego AG v Tyco Industries Inc*,²¹ the Privy Council held that the second part of the definition, 'but does not include ... features of shape or configuration which are dictated solely by the function which the article

681 (CFI), it was held that a design for the component parts of an internal measuring chamber of a water heater was invalidly registered. The appearance of such parts had no influence on the potential buyer's choice.

¹⁶ At 518.

¹⁷ *Apple Computer Inc's Design Applications* [2002] FSR 602 (Registered Designs Appeal Tribunal). See [6-6].

¹⁸ Following the reasoning in *Ferrero and CSpA's Application* [1978] RPC 473, where the different colours in the plaintiff's chocolate egg (the subject of the design) could only be seen when the egg was broken and *Suwa (K K) Seikosha's Design Application* [1982] RPC 166 where the bell and loudspeaker symbols of the type appearing on digital watch panels were held registrable.

¹⁹ *Glaxo Group Ltd v Chia Tai Tianqing Pharmaceutical Group Co, Ltd* [2022] HKCU 2123, [2022] HKCFI 1350.

²⁰ *Amp Inc v Utilux Pty Ltd* [1971] FSR 572.

²¹ *Interlego AG v Tyco Industries Inc* [1989] AC 217, [1988] 3 All ER 949, [1988] RPC 343 (PC).

to be made in that shape or configuration has to perform',²² meant that the whole shape or configuration should be treated as registrable (assuming that it has eye appeal) unless the whole of it is dictated solely by functional considerations.²³ All that needs to be shown is that the relevant features are brought about by, or are attributable only to, the function which the article has to perform, even if the same function could equally well be performed by an article of a different shape.²⁴ The mere coincidence of eye appeal with functional efficiency will not confer registrability if every feature of the design is dictated by the function which it is to perform.²⁵

[6-11]

In the event, the Privy Council found that the designs of the Lego bricks had eye appeal and that the actual shape and dimensions of the knobs and tubes were dictated at least in part with a view to the appearance of the articles.²⁶ The designs were therefore registrable.

[6-12]

In *Glaxo Group Ltd v Chia Tai Tianqing Pharmaceutical Group Co, Ltd*,²⁷ Lok J explained that the underlying policy of this exclusion is to prevent registered designs being used to obtain monopolies which in effect cover the functional aspects of the design of articles and that: 'Where a shape is adopted by a designer upon the sole requirement of functional ends, ie to make the article work and not to appeal to the eye, then the provision excludes it from statutory protection'.

5.1.5 Meaning of 'article'

[6-13]

It can be seen from s 1(3) of the Registered Designs Act 1949 (UK) that, in order for a design to be registrable, the features of shape, configuration, pattern or ornament have to be applied to 'an article'. Under s 44(1) of the Act:

'article' means any article of manufacture and includes any part of an article if that part is made and sold separately.²⁸

²² Methods or principles of construction (the other part of the exclusion) were not in issue.

²³ At 516. See also *Tang Fun Kee Manufacturing Co Ltd v Fortuna Plastic Manufactory* [1980] HKC 555, [1980] HKLR 184 (HC).

²⁴ At 517.

²⁵ At 519, clarifying the speech of Lord Reid in *Amp Inc v Utilux Pty Ltd* [1972] RPC 103.

²⁶ At 521. The presence of knobs and tubes was attributable to the functional purpose of providing clutch power.

²⁷ *Glaxo Group Ltd v Chia Tai Tianqing Pharmaceutical Group Co, Ltd* [2022] HKCU 2123, [2022] HKCFI 1350.

²⁸ This definition in the unamended UK Act is the same as that in s 2(1) of the Registered Designs Ordinance. In the current Registered Designs Act 1949 (UK), however, the word 'article' no longer appears in the definition of 'design' in s 2(1), which provides that 'design' means 'the appearance of the whole or a part of a product resulting from

The meaning of 'article' was considered by the House of Lords in *Ford Motor Co Ltd's Design Applications*²⁹ in the context of applications to register designs of motor vehicle components. The House³⁰ held that one must look to the characteristics which the articles will have when they fulfil their intended purpose. The last part of the definition must accordingly be read as meaning 'if that part is to be made and sold separately'.³¹ One can envisage items which fall clearly within or outside the definition: for example the meter face in *Sifam* was never intended to be sold without the meter (and was therefore not an 'article'); on the other hand, many generic articles, such as fancy steering wheels or wheel covers offered by a manufacturer as an option, are designed with the intention that some sales will be for use in vehicles other than those marketed by the manufacturer; these can properly be regarded as to be sold separately and constitute 'articles'. Lying between these clear cases are spare or replacement parts which can only be incorporated in the manufacturer's products but for which there will be a substantial ancillary market. The House held that the purpose of the definition of 'article' is to distinguish between items designed for incorporation, either as original components or spare parts, in a particular article or range of articles made by the manufacturer of the component, and items designed for general use, albeit possibly aimed principally at use with the manufacturer's own products. The former are not 'articles' within the definition whereas the latter are. It was further held that the answer to the question (at least in relation to spare parts) is in many cases answered by applying the criterion stated by the Divisional Court,³² namely that to qualify as an 'article' a spare part 'has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part'. Applying these principles, the House held that the items with which the appeal was concerned, namely main body panels, doors, the bonnet lid, the boot lid, the windscreen and other components which formed part of and contributed to the overall shape and appearance of the vehicle, were not 'articles'. In the Registered Designs Appeal Tribunal³³ and the Divisional Court,³⁴ it had been held that items subsidiary to the general shape of the vehicle, such as wing mirrors, wheels, seats and the steering wheel, where substitutions were possible while

the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation'. 'Product' is further defined in s 1(3) as 'any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get up, graphic symbols, typographic type faces and parts intended to be assembled into a complex product', while a 'complex product' means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product. The current UK provisions are the same as those in the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs.

²⁹ *Ford Motor Co Ltd Design Applications* [1995] 1 WLR 18, [1995] RPC 167 (HL).

³⁰ Lord Mustill gave the only speech.

³¹ Adopting the reasoning of Graham J in *Sifam Electrical Instrument Co Ltd v Sangamo Weston Ltd* [1971] 2 All ER 1074, [1973] RPC 899.

³² *Ford Motor Co Ltd's Design Applications* [1994] RPC 545.

³³ *Ford Motor Co Ltd's Design Applications* [1993] RPC 399.

³⁴ *Ford Motor Co Ltd's Design Applications* [1994] RPC 545.

leaving the general shape and appearance of the vehicle unaffected, were 'articles', in that they had an independent life as articles of commerce and were not merely an adjunct of a larger article of which they formed part. That holding was not appealed to the House of Lords. In *Apple Computer Inc's Design Application*,³⁵ where registration was sought for icons produced or capable of being produced on a computer screen by the operating system, it was held by the Registered Designs Appeal Tribunal that a computer with an operating system which displayed the icons would be an 'article'.³⁶

[6-14]

In Hong Kong, in *Samsonite Corp v Make Rich Ltd*,³⁷ an interlocutory injunction application, it was held that a design registration for a 'wheel system for an upright luggage case' was not an article within the definition of the Registered Designs Ordinance because there was no evidence the wheels were sold separately. However, in *Bang & Olufsen A/S v To Hok Chung*,³⁸ Cheung JA in the Court of Appeal stressed that whether an article comes within the definition must be determined by reference to the specifications contained in the application for registration, and the question of whether a design is an 'article' cannot be decided by reference to how the article is being sold or packaged in the market after the registration.

5.1.6 Applied to an article by any industrial process or means

[6-15]

These words generally give rise to no difficulty. Designs consisting of features of shape or configuration are applied by making articles embodying such shape or configuration; such making is self-evidently an industrial process or means. In *Apple Computer Inc's Design Application*,³⁹ it was held that the icons appearing or capable of appearing on the computer screen were features of pattern or ornament which had been applied to an article (namely the computer) by an industrial process, namely by being

³⁵ *Apple Computer Inc's Design Application* [2002] FSR 602 (Registered Designs Appeal Tribunal).

³⁶ In fact the application had wrongly described the articles as 'a set of user interfaces for computer display'. It was accepted that these were not 'articles' and the matter was remitted to the Registry.

³⁷ *Samsonite Corp v Make Rich Ltd* [2002] 1 HKC 692 (CFI). Compare *A Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] RPC 499 where it was held on the evidence that an umbrella case (the subject of the registration) was an article of manufacture and registrable as such. Had it been found to be only a part of an article (the umbrella), it would still have been validly registered since it was (on the evidence) made and sold separately.

³⁸ *Bang & Olufsen A/S v To Hok Chung T/A Mirage Electronic Industrial Co* [2007] 1 HKLRD 85, [2006] HKCU 2041 (CA), referring to *Sifam Electrical Instrument Co Ltd v Sangamo Weston Ltd* [1971] 2 All ER 1074, [1973] RPC 899 and *Ford Motor* (above).

³⁹ *Apple Computer Inc's Design Application* [2002] FSR 602 (Registered Designs Appeal Tribunal). See [6-6].