

**APAA DESIGNS COMMITTEE –
2012 Report by Hong Kong Recognized Group**

Since our last report submitted in 2011, there has been a slight amendment of the Registered Designs Ordinance (Cap. 522) and one court decision on the grant of an application for (i) the revocation of registered designs and (ii) an injunction grounded on abuse of the design registration system.

AMENDMENT OF THE REGISTERED DESIGNS ORDINANCE

A slight amendment was made to Section 5 (“New designs are registrable”), namely Section 5(2)(b) therein, to change the Chinese text for the term “published” from “注册” to “發表”.

The amendment became effective on 27 July 2012 by virtue of the enactment of the Statute Law (Miscellaneous Provisions) Ordinance 2012.

DECISION ON REGISTERED DESIGNS

In *Burberry Asia Limited v. Santa Roberta Polo & Racquet Club Int’l Limited*,¹ the Plaintiff made an application to (i) revoke 15 designs registered by the Defendant at the Hong Kong Designs Registry on the ground that the designs were not new as at the respective dates of the registrations, and (ii) restrain the Defendant from applying for registration of identical or similar designs in the future.

The 15 registered designs relate to 5 fabric designs registered on 26 July 2010 and 10 handbags designs registered on 3 August 2010, all in the name of the Defendant.

In support of the application, the Plaintiff submitted evidence showing the Defendant’s designs and prior publication by the Plaintiff of the same or similar designs, namely registered trademarks and advertisements and catalogues publishing the Plaintiff’s products prior to respective effective dates of the Defendant’s designs. The Defendant was absent and no evidence in support of the Defendant’s designs being new or novel was submitted.

Revocation

¹ *Burberry Asia Limited v. Santa Roberta Polo & Racquet Club Int’l Limited* HCMP 908/2011 (8 February 2012, unreported) CFI.

The Court noted that the fabric designs were not new as they were “substantially the same as” the check designs, which were the subject of a prior application for revocation commenced by the Plaintiff in *Burberry Asia Ltd v Polo Santa Roberta Ltd*,² and were consequently revoked on 21 July 2010 by Reyes J based on lack of novelty (please refer to the Hong Kong Group Report of 2011). Further, the Court noted that the shapes shown in the handbags designs were also not new.

As the evidence that all 15 designs were not new at the time of the registration was “overwhelming”, the Court adopted the previous decision of Reyes J with respect to the fabric designs and granted the application for revocation of both categories of designs on the ground of lack of novelty.

Injunction

The Court pointed out that the Defendant was, for all intents and purposes, the same entity as the defendant in *Burberry Asia Ltd v Polo Santa Roberta Ltd*, since both defendant companies were owned by the same individual, who was also the sole shareholder and a director of both defendant companies. The Court further pointed out that the applications for the 15 designs in the present case were made “almost immediately” after the decision on the above case was handed down by Reyes J.

These coincidences led the Court to conclude that this was a blatant case of the same individual, “albeit thinly disguised in different corporate clothing,” re-registering virtually identical designs and was an abuse of the legal system. In order to prevent further abuse of a similar nature, the Court did not hesitate to grant the application for an injunction to restrain the Defendant from re-registering identical or similar designs in the future.

STATISTICS AND PERFORMANCE

The following is a monthly breakdown of the statistics for design applications received and registered at the Hong Kong Designs Registry between 1 September 2011 to 31 August 2012, as released by the Hong Kong Intellectual Property Department:-

Period	No. of Designs Applied for Registration	No. of Designs Registered
September 2011	409	568
October 2011	477	387
November 2011	473	359

² *Burberry Asia Ltd v Polo Santa Roberta Ltd* HCMP 2696 / 2009 (21 July 2010, unreported) CFI.

December 2011	460	355
January 2012	266	365
February 2012	386	367
March 2012	811	419
April 2012	408	241
May 2012	464	292
June 2012	406	458
July 2012	398	456
August 2012	444	587
TOTAL	5,402	4,854

As reported in the last committee report, there were 4,357 design applications received and 3,841 design applications registered between 1 September 2010 and 31 August 2011. Compared to those figures, we can see that there has been a significant increase in both the number of applications received (by 23.98%) and in the number of applications registered (by 26.37%) during the relevant period.

We can also see that the number of design applications each month is relatively stable throughout the relevant period, with the exception of a noticeable sharp rise in number of applications in March. Also, compared with the last committee report, January has replaced February as the month recording the lowest number of applications.

The following is a breakdown, by home countries of the applicants / owners, of design applications received and registered at the Hong Kong Designs Registry during the relevant period:-

Country	No. of Applications	No. of Registrations
Antigua and Barbuda	-	-
Australia	52	45
Austria	24	2
Bahamas	1	1
Belgium	69	22
Brazil	11	12
British Virgin Islands	37	27
Canada	6	7
Cook Islands	1	1
Czech Republic	2	-
Denmark	51	51

Finland	53	66
France	144	103
Germany	350	291
Greece	4	4
Hong Kong, China	1,818	1,782
India	-	-
Ireland	2	2
Israel	6	6
Italy	139	147
Japan	416	434
Liechtenstein	14	17
Luxembourg	15	19
Macao, China	-	-
Malaysia	1	-
Netherlands	115	138
Netherlands Antilles	-	-
New Zealand	-	-
Norway	15	12
People's Republic of China	528	311
Republic of Korea	138	76
Russian Federation	3	2
Singapore	47	136
South Africa	-	-
Spain	20	-
Sweden	41	36
Switzerland	505	481
Taiwan, Province of China	25	27
Thailand	2	2
Turkey	2	7
United Arab Emirates	-	-
United Kingdom	76	68
United States of America	664	496
Others	5	23

As revealed by the above table, of the total number of design applications filed during the relevant period, the largest number of design applications were filed by Hong Kong applicants, followed by the United States, China, Switzerland, and Japan.

[G:\CAS\AC\APAA Design\Hong Kong Report2.doc]