

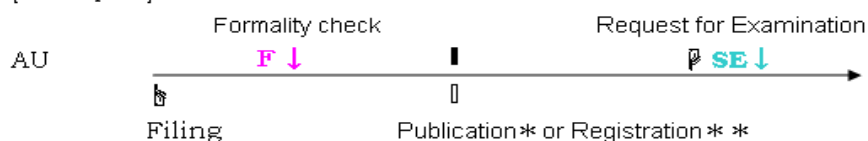
Answer: Group name – Hong Kong

- I. Prosecution procedure before the Intellectual Property Office following filing, including formality examination, substantive examination and amendment.
- II. How do you search for prior art before filing a design application?

I. Prosecution procedure before the Intellectual Property Office following filing including formality examination, substantive examination and amendment.

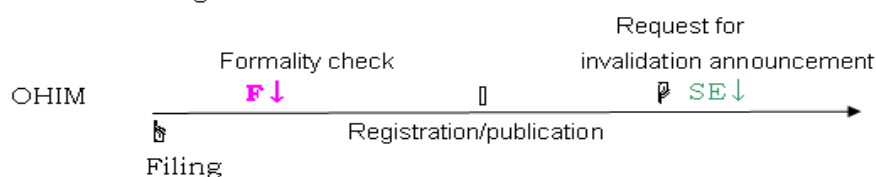
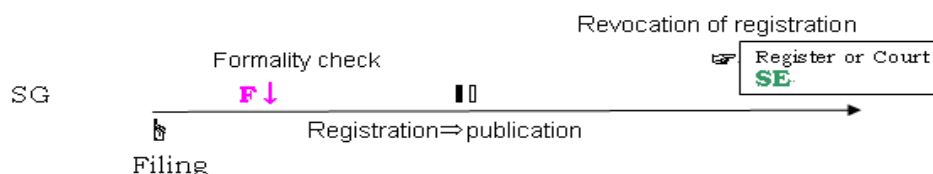
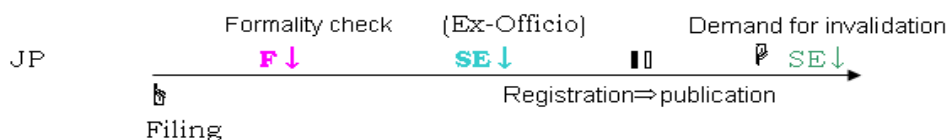
- F** ↓ : Formality check (or formality examination)
- SE** ↓ : Substantive Examination (Ex-Officio)
- I** : Registration
- : Publication
- ⌚** : Action by Applicant or Third Party
- SE** ↓ : Substantive Examination (Review)

[Examples]



*: Published designs do not give any rights

** : Registered design can be made enforceable by certification, and carry exclusive rights.



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Firstly, please make a flow diagram of your national registration proceedings below along the lines of the example flow diagrams shown on the first page.



Secondly, please answer all the following questions in view of your national design procedures.

[General]

Question 1

How long does it typically (or in case no opposition is raised) take from filing an application to registering a design?

Answer:

- Less than 2 months
- 2 or more but less than 6 months
- 6 or more but less than 9 months
- 9 or more but less than 12months
- 12 months or more

Question 2

Do you have a provision which stipulates a term for acceptance from filing to registration, e.g. 6 months, Rules 17 and 18 of Design Rules 2001, India?

Answer:

- Yes []months
- No (Section 25 of Registered Design Ordinance (Cap 552) (“**RDO**”) states that the Registrar should as soon as practicable register the design after examination. A certificate of registration usually can be issued within 3 months after an application is filed.)

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Question 3

At what stage can you amend the Design application/registration?
Please indicate all possibilities.

Answer:

- Before the formality check started
- While the formality check is being conducted
- After the formality check finished
- After the publication of the design
- During the Opposition procedure
- Before the design is registered
- After the design is registered
- On request for a substantive examination
- During the Invalidation procedure
- Other: During the revocation procedure

Application

When the application is pending, upon request by the Examiner, certain amendments can be made. These include for example clarification issues regarding the classification, title etc. Subject to s.21 RDO, pursuant to s.63 of the Registered Design Rules ("**RDR**"), any document filed in any proceeding before the Registrar and any drawing or other representation of a design may, if the Registrar thinks fit, be amended, and any irregularity in procedure in or before the Registry may be rectified on such terms as he may direct.

Further, while the application is pending, pursuant to s.21 RDO, the Registrar may amend an application of a design on request made to him by the applicant in the prescribed manner.

However, an application for registration of a design shall NOT be amended if, as a result of the amendment, the scope of the application would be increased by the inclusion of any matter that was not in substance disclosed in the application initially filed (s.21 RDO).

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Please note that where a request for amendment of an application for registration of a design has been granted under s.21 RDO and in the opinion of the Registrar the amendment has the effect of significantly altering the design for which the application was initially filed, the Registrar may exercise his powers under s.5(3) RDO to direct that for the purpose of deciding whether a design is new an application for registration shall be treated as made on a date earlier or later than that on which it was in fact made.

For both pending design applications and registered designs

Pursuant to s.66 RDO, the court can further, on the application of any person aggrieved, order the Register to be rectified by the making or the variation or deletion of any entry in it. S.50 RDR states that a copy of the application will be served on the Registrar and a notice will be made in the Register.

Pursuant to s.67 RDO, the Registrar may correct any error in the Register which may be made upon request in writing by any interested person or on the Registrar's own initiative.

Pursuant to s.76 RDO, the Registrar may upon request by any interested person correct any error of translation or transcription, any clerical error or any mistake made in:

- a) any application for registration or document filed in connection with such an application;
- b) any representation of a design; or
- c) any document filed in connection with a registered design.

Question 4

Please indicate what aspects of the Design application/registration can be amended at what stage and with what limitations, if any, on amendments.

Answer:

- Applicant/owner details
When? At any stage before and/or after registration (see

Answer: Group name – **Hong Kong**

answer to Question 3 above)

Limitations? Subject to the sections above, if it is for a pending application, then s.21 RDO applies and an amendment will not be granted if the scope of the application would be increased.

Designer details

When? N/A as designer details are not necessary.

Limitations? N/A

* (If the applicant is not the designer, the applicant should explain the applicant's rights in relation to the design(s).)

Title of Design or Name of Product / Article

When? At any stage before and/or after registration (see answer to Question 3 above especially relating to s.21 RDO during application stage)

Limitations? See answer to Question 3 above.

Statement of Newness/Novelty or Claims

When? At any stage before and/or after registration (see answer to Question 3 above especially relating to s.21 RDO during application stage)

Limitations? See answer to Question 3 above.

Representations (Drawings, photos, models or samples)

When? At any stage before and/or after registration (see answer to Question 3 above especially relating to s.21 RDO during application stage)

Limitations? See answer to Question 3 above. The amendments to the representations must also comply with the usual formality requirements.

Priority claim/priority application details

When? At any stage before and/or after registration (see answer to Question 3 above)

Limitations? See answer to Question 3 above especially

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relating to s.21 RDO during application stage.

Design classification

When? At any stage before and/or after registration (see answer to Question 3 above)

Limitations? See answer to Question 3 above.

Others

When?

Limitations?

Question 5

When voluntary amendment is requested outside the formality and substantive examination procedures, what is the procedure for processing such amendment requests?

Answer:

See answer to Question 3 & 4 above for the timing and limitation of the amendments.

- a. While the application is pending, pursuant to s.21 RDO, the Registrar may amend an application of a design on request made to him by the applicant in the prescribed manner. A request for amendment of an application for registration of a design under s.21 RDO shall be made on the specified form (Form D2).
- b. Pursuant to s.66 RDO, the court can further, on the application of any person aggrieved, order the Register to be rectified by the making or the variation or deletion of any entry in it. According to s.50 RDR, where such application is made, the applicant shall forthwith serve a copy of the application on the Registrar. The Registrar shall enter a notice of the application in the Register.
- c. Pursuant to s.67 RDO, the Registrar may correct any error in the Register which may be made upon request in writing by any interested person or on the Registrar's own initiative. According

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to s.51 RDR, such request shall be made on the specified form (Form D2) and shall clearly identify the proposed correction. The Registrar shall advertise the fact of the request and the nature of the proposed correction in the official journal. If any person wishes to oppose the request, he shall, within 2 months from the date of the advertisement in the official journal, file a notice of opposition in the specified form setting out fully the grounds on which the opponent objects to the request and the facts on which he relies. The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the person making the request. Within 3 months from the date of the sending of the copy of the notice of opposition, the person making the request shall file a counter-statement in the specified form setting out the grounds on which he relies as supporting his request and the facts, if any, alleged in the notice of opposition which he admits. The person making the request shall, at the same time as he files the counter statement, send a copy of it to the opponent. The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

- d. Pursuant to s.76 RDO, the Registrar may upon request by any interested person correct any error of translation or transcription, any clerical error or any mistake made in:
- a) any application for registration or document filed in connection with such an application;
 - b) any representation of a design; or
 - c) any document filed in connection with a registered design.

According to s.62 RDR, such request for correction (other than an address or address for service) shall be made on the specified form (Form D2) and shall clearly identify the proposed correction. The Registrar may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought. The Registrar shall advertise the fact of the request and the nature of the proposed correction in the official journal. If any person wishes to oppose the request, he shall, within 2 months from the date of the advertisement in the official journal, file a notice of

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opposition in the specified form setting out fully the grounds on which the opponent objects to the request and the facts on which he relies. The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the person making the request. Within 3 months from the date of the sending of the copy of the notice of opposition, the person making the request shall file a counter-statement in the specified form setting out the grounds on which he relies as supporting his request and the facts, if any, alleged in the notice of opposition which he admits. The person making the request shall, at the same time as he files the counter statement, send a copy of it to the opponent. The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

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[FORMALITY CHECK]

The formality check is understood to be conducted by the IP Office to check if application documents submitted to the IP Office fulfill the formality requirements for registration.

Question 6

Please inform us of the relevant Article or Articles of your IP law which relate to formality requirements and formality checks.

Answer:

s.12 RDO (Applications for registration) – which sets out, inter alia, what must be included in the application

s.15 RDO (Priority right) & s.16 RDO (Claiming priority) – which relates to the requirements to claim priority in the application

s.24 RDO (Examination of applications) & s.27 RDO (Formality examination) – which set out the mechanism and requirements of formality examination

ss.6-16 RDR – which relate to formality requirements, including forms and contents of applications, representations, statement of novelty, statement relating to confidential disclosure, statement of priority, etc.

ss.21-23 RDR – which relate to procedures of formality examination in relation to deficiencies and refusal of application

Question 7

In what case or condition do you receive an Office Action related to an error or deficiency in the formality requirements?

Answer:

Deficiency in the following matters

- a. Name of Applicant(s)
- b. Address of Applicant(s)
- c. Name of Designer(s)
- d. Address of Designer(s)
- e. Title of Design or Indication of article(s)/product(s) – statement of article(s) to which the design is intended to be

Answer: Group name – Hong Kong

applied, in both official languages

Is it possible to indicate more than one title of the design or article/product? Possible to indicate more than one article for multiple designs

f. Classification of the design(s)

Is it possible to indicate more than one class? No. But possible to indicate more than one sub-class for multiple designs.

g. Representations (Drawings, photos, models or samples)

h. Payment of the prescribed fees

i. Unity of design

j. Statement of novelty

k. Claim

l. Designs liable to contravene public order or morality

m. Others (pursuant to s.6 RDR):

- (where the applicant is not the designer) the statement explaining the applicant's rights in relation to the design
- address in Hong Kong for service of documents
- transliteration of the name of the applicant (if the name is not in Roman letters or in Chinese characters)
- details of confidential disclosure or non-prejudicial disclosure
- Priority application details and the Applicant's priority rights
- Evidence relating to armorial bearings, names or portraits, etc.
- Sample of article (if applicable)
- any other information required by prescribed application form (Form D1)

* Under s.26(1)(b) RDO, aside from notifications on deficiencies, the Registry may also refuse an application if, on the face of the application, the design is not new or is not registrable for any other reason. The Registrar will then give the applicant notice of any refusal.

Answer: Group name – Hong Kong

Question 8

When you receive an Office Action related to an error or deficiency in the formality requirements, how do you generally overcome the Office Action?

Answer

- a. By submitting an amendment - notice is given to the applicant to correct deficiencies within the prescribed period of three months. Amendments can be made subject to any applicable limitations (see our answers to Question 3 & 4 above). Failure to correct may result in application being deemed withdrawn.
- b. By submitting an argument
- c. By having an interview with the Examiner.
- d. You cannot overcome the Office Action. The filing date can be obtained after the application documents have been completed.

Question 9

In what case do you submit an argument to overcome an outstanding Office Action related to an error or deficiency in the formality requirements?

Answer:

Under circumstances such as the following:

- To explain the design in details such as differences among designs filed a the same application (for multiple designs);
- To explain the unclaimed part in dotted lines;
- To explain the purpose of use of the design;
- To maintain the desired classification or title, etc.

Question 10

How long is the term allowed for response to an outstanding Office Action after receiving the Office Action?

Answer:

3 months. Pursuant to s.22 RDR, where the Registrar determines that there are deficiencies as regards the formal requirements, he shall give written notice of the deficiencies to the applicant. Deficiencies as

Answer: Group name – **Hong Kong**

regards the formal requirements may be corrected within 3 months after the date of the notice.

As regards extension of time, please see answer to Question 12 below.

Question 11

Can an application be rejected even though the applicant submits a response?

Answer:

Yes. Pursuant to s.24(3) RDO, if any deficiencies as regards the formal requirements are not corrected within the prescribed period, the application shall be deemed to be withdrawn.

Question 12

Is it possible for an applicant to extend the term for response to an Office Action, and if so, under what circumstances? Please indicate the maximum allowable extension term.

Answer:

- Yes The longest term is not specified under RDO & RDR. However, in practice, the Registry does not normally grant longer than a 3-month extension for the time limit to respond to Office Action. Please see below.

Circumstances: _____

- No

Pursuant to s.73 RDR, the Registrar may upon application made by the person concerned and upon such notice to any person affected as he may direct, extend or further extend any period of time for doing any act or taking any proceedings under the RDR, other than the periods referred to in s.29 RDR (Renewal of registration), on such terms as he may direct. However, in practice, the Registry would not under normal circumstances grant longer than a 3 month extension for the time limit to respond to Office Action or for a further extension of time.

Please note that certain time limits under the RDO (e.g. s.15(1) RDO) and RDR (e.g. s.29(2) RDR (Renewal of registration)) are not extendible. The

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Registrar has no discretion to grant extension of time in these cases.

For extendible time limits, pursuant to s.73(2) RDR, an extension may be granted notwithstanding that the period of time in question has already expired.

In some cases, the period of extension that can be allowed is specified and the grant of the extension is subject to compliance with additional statutory requirements (e.g. s.20(2)(b) and s.20(3) RDO (Reinstatement of applications deemed withdrawn)).

Question 13

Do you think it is necessary to conduct formality examinations? Why?

Answer:

Yes

REASON: [To ensure consistency in all design applications and for provision of information

No

REASON []

Question 14

When is a design filed at the IP Office published in the Official Gazette or through the Internet?

Answer:

Before registration

After registration

If the application satisfies the formality requirements, the Registry will register the design, publish the registration in the Hong Kong Intellectual Property Journal (available online at http://www.ipd.gov.hk/eng/ip_journal.htm) and issue a certificate of registration.

Where a request is made to correct any error in the Register pursuant to s.67 RDO, according to s.51 RDR the Registrar shall advertise the fact of the request and the nature of the proposed correction in the official

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journal. Please see answer to Question 5 above.

Where a request is made to correct any error of translation or transcription, any clerical error or any mistake pursuant to s.76 RDO, according to s.62 RDR, the Registrar shall advertise the fact of the request and the nature of the proposed correction in the official journal. Please see answer to Question 5 above.

[SUBSTANTIVE EXAMINATION]

Substantive Examination is understood to be conducted to determine whether the subject design fulfills a set of prescribed requirements in order to obtain/maintain registration.

Question 15

Please inform us of the relevant Article or Articles of your IP Law which relate to substantive examination and the prescribed requirements in order to obtain/maintain registration.

Answer: In Hong Kong, the Registry does not conduct substantive examination on the application nor does it search records of prior registered designs. However, pursuant to s.26(1)(b) RDO, aside from notifications on deficiencies, the Registry may also refuse an application if, on the face of the application, the design is not new or is not registrable for any other reason. The Registrar will then give the applicant notice of any refusal.

Question 16

When is the substantive examination procedure conducted?

Answer: N/A

- After the formality check is finished
- Together with the conducting of the formality check
- After the publication of the design
- During the Opposition procedure
- Before the design is registered
- After the design is registered
- When a request for a substantive examination is filed
- During the Invalidation procedure

Answer: Group name – **Hong Kong**

Other

[]

Question 17

Please let us know who within the IP Office conducts the substantive examination. Do they have any specific qualifications?

Answer

N/A

Question 18

What is contained in the registration requirements for a design, which requirements are checked in the substantive examination?

Answer: N/A

- a. Design must be new
- b. Design must not be identical to the prior art
- c. Design must not be similar to the prior art
- d. Design must not have been easily created
- e. Design must be ornamental or not functional
- f. Design must not be composed of only shapes indispensable to secure the functions of the article.
- g. A single design must be filed in a single application (Unity of design)
- h. Design must not be liable to contravene public order or morality
- i. Design must not overlap with a design by the same owner(Double patented)
- j. Others

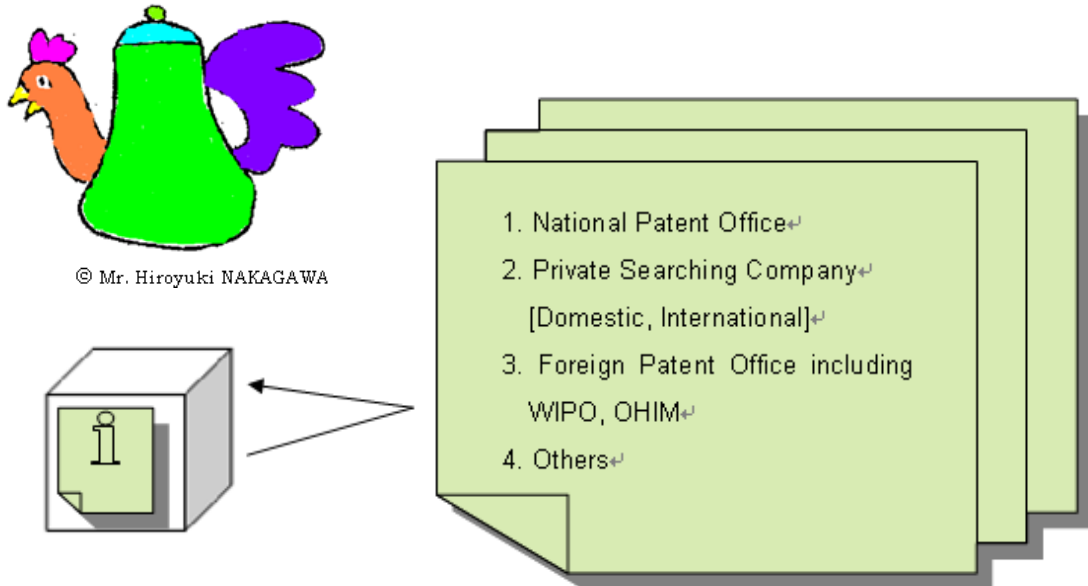
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Question 19

When you receive an Office Action related to the substantive requirements how do you overcome the Office Action?

Answer: Group name – Hong Kong

II. How do you search for prior art before filing a design application?



Question 1

Is there any search tool regarding designs available when you wish to conduct a design search by yourself in your country?

Answer:

- Yes please go on to Question 2.
- No please go on to Question 5.

Question 2

What kind of search tools in your country can you use?

Answer:

- Data base in your national IP Office:
Hong Kong Intellectual Property Department Online Search System – for Registered Designs, can be found online at <http://ipsearch.ipd.gov.hk/>
- Data base provided by organizations which can conduct a search
- Other

Answer: Group name – **Hong Kong**

Question 3

Do you also use Internet publications provided by national or International IP Offices as shown below?

Answer:

- WIPO
- OHIM
- Foreign National Offices Internet

✓		✓	✓		✓	✓	✓	✓
AU	BG	HK	IN	ID	JP	KR	MY	NZ

	✓	✓		✓	✓	✓		
PK	PH	SG	LK	TW	TH	VN		

Please fill in the name of other countries: **UK**

REASON or PURPOSE:

As Hong Kong does not have substantive examination, so from a pre-filing perspective we do not normally conduct prior art searches, unless the client intends to conduct clearance searches then we will conduct searches at the relevant jurisdictions.

Question 4

In your national IP Office designs data base, what information can you obtain, and how do you obtain it?

(i) Information to be obtained

- Registered designs
- Others

()

(ii) How do you obtain the information? Specifically, do you use any of the following search parameters?

- Filing number, registration number, or publication number
- Classification

Answer: Group name – **Hong Kong**

(ii) No

REASON: **As Hong Kong does not have substantive examination, we do not normally conduct searches unless the client instructs us to conduct infringement clearance searches.**

Question 7

Do you conduct a design search before making a decision on whether or not your client's design infringes or is infringed upon by other's design (clearance search)?

Answer:

(i) Yes [ALWAYS OFTEN SOMETIMES SELDOM]

REASON []

EXAMPLE

(ii) No

REASON: **Generally no for cost reasons, but we will do so if the client would like a clearance search**

Question 8

Please provide us with your comments on searching for prior art for industrial designs.

Answer:

Search results might not necessarily be accurate if solely relied on the Locarno classifications.

A prior art search for registered designs is unable to cover products protected by copyright.