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REGISTERED DESIGNS (AMENDMENT) RULES 2004

(Made under sections 79, 80, 81 and 82 of the Registered Designs Ordinance (Cap. 522) with the consent of the Financial Secretary)

1. Commencement

These Rules shall come into operation on the day appointed for the commencement of sections 20, 25 and 26 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Interpretation

(1) Section 2(1) of the Registered Designs Rules (Cap. 522 sub. leg. A) is amended, in the definition of “send”, by adding “, and cognate expressions are to be construed accordingly” after “give”.

(2) Section 2(1) is amended by adding—

““digital signature” (數碼簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic record” (電子紀錄) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic signature” (電子簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“information system” (資訊系統) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);”.

(3) Section 2(2)(c) is repealed and the following substituted—

“(c) to the filing of a document or other thing shall, unless the context otherwise requires, be construed as a reference to the filing of the document or thing with the Registrar in accordance with sections 60, 60A, 60B and 60C.”.

3. Section added

The following is added immediately after section 2—

“2A. Specified forms

A requirement to use a specified form is satisfied by the use of either—

(a) a replica of the specified form; or

(b) a form acceptable to the Registrar,

that contains the information required by the specified form and complies with any directions of the Registrar as to the use of the specified form or replicas of it.”.

4. Form and contents of applications

(1) Section 6(2)(b) is amended by repealing “sections 7 and 8” and substituting “section 7”.

(2) Section 6(3)(c) is repealed and the following substituted—

“(c) a statement of novelty, in accordance with section 8;”.

(3) Section 6(3)(e) is amended by adding “or in Chinese characters” after “letters”.

5. Representations

(1) Section 7(1) is repealed and the following substituted—

“(1) The representation of the design included with the application may be either a drawing or a photograph and shall be of a size of not more than 210 mm by 297 mm.”.

(2) Section 7(3) is repealed and the following substituted—

“(3) The Registrar may at any time require the applicant to file additional copies of the representation.”.

6. Statement of novelty

(1) Section 8(1) is amended by repealing “appear on each representation of the design filed under sections 6 and 7,” and substituting “be included in the application filed under section 6”.

(2) Section 8(2) and (3) is repealed.

7. Statement of priority, etc.

Section 11(2) is amended by adding “copy of a” before “certificate”.

8. Withdrawal of applications

Section 17 is amended by repealing “on the specified form” and substituting “in writing and shall state the application number of the application being withdrawn”.

9. Transactions affecting rights in registered designs

Section 33(3)(a) is amended by repealing “the assignee and”.

10. Reference

(1) Section 37(1) is amended by repealing “in duplicate”.

(2) Section 37(2) is repealed and the following substituted—

“(2) The applicant shall, at the same time as he files the application and statement, send a copy of it to the registered owner of the design.

(3) The Registrar shall enter a notice of the application in the Register and advertise the fact of the application having been filed in the official journal.”.

11. Notice of opposition

(1) Section 38(1) is amended by repealing “in duplicate”.

(2) Section 38(2) is repealed and the following substituted—

“(2) The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the applicant.”.

12. Counter-statement

(1) Section 39(1) is amended by repealing “duplicate” and substituting “copy”.

(2) Section 39(2) is repealed and the following substituted—

“(2) The applicant shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

13. Evidence in support of opposition

Section 40(1) is amended by repealing “duplicate” and substituting “copy”.

14. Sections amended

Sections 46(1), 47(1) and 50(1) are amended by repealing “certified”.

15. Correction of errors in Register

(1) Section 51(3) is amended by repealing “in duplicate”.

(2) Section 51(4) is repealed and the following substituted—

“(4) 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.”.

(3) Section 51(5) is amended by repealing “duplicate” and substituting “copy”.

(4) Section 51(6) is repealed and the following substituted—

“(6) The person making the request shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

16. Inspection of Register

Section 52 is amended by repealing “and payment of the applicable fee”.

17. Information and inspection of documents

(1) Section 55(2) and (3) is amended by repealing “(4) to (6)” and substituting “(4), (5), (5A) and (6)”.

(2) Section 55(4) is amended by repealing “before payment of the applicable fee or”.

(3) Section 55 is amended by adding—

“(5A) The right of inspection under this section extends only to documents and information kept by the Registry.”.

18. Section added

The following is added—

“55A. Form in which the records of the Registry are kept, etc.

(1) The Registrar shall determine the form in which the records of the Registry are constituted and kept and may determine the period for which such records, or any document or other thing kept by the Registry, shall be kept and the circumstances in which they may be destroyed or otherwise disposed of.

(2) Where the Registrar keeps a record of a document or other thing in a form that differs from that in which the document or thing was originally filed with, or originally generated by, the Registrar, the record of that document or thing shall be presumed, unless the contrary is shown, to accurately represent the information contained in the document or thing as originally filed or generated.”.

19. Publication of business hours and business days of the Registry

Section 56 is amended by repealing “of the Registry and” and substituting “or”.

20. Subheading substituted

The subheading “**Documents**” immediately before section 58 is repealed and the following substituted—

“**Filing and service of documents and related matters**”.

21. Translation of documents

Section 59(1) is amended by repealing “must be verified to the satisfaction of the Registrar as corresponding to the original text” and substituting “shall state the name of the translator and his official capacity, if any”.

22. Sections substituted

Sections 60 and 61 are repealed and the following substituted—

“60. Filing of documents with the Registrar

(1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered by hand to the Registrar at the Registry during the normal business hours of the Registry or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the Registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the Registry.

(3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the Registry and is recorded as received.

60A. Electronic filing

(1) The Registrar may at his discretion permit, as an alternative to the filing of a document or other thing with the Registrar in a paper or other physical form, the filing of an electronic record of that document or thing.

(2) The Registrar may at his discretion permit, as an alternative to delivering or sending a document or other thing to the Registrar in the manner provided by section 60, the sending of an electronic record of that document or thing by electronic means to an information system designated by the Registrar.

(3) The filing of an electronic record, and the sending of an electronic record by electronic means to the information system designated under subsection (2), shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person desiring to file an electronic record or to send an electronic record to the Registrar by electronic means.

(4) Where, in accordance with this section, a document or other thing in the form of an electronic record is sent by electronic means to the information system designated under subsection (2), the filing of that document or thing shall be deemed to be effected at such time as that electronic record is accepted by the designated information system.

60B. Terms for electronic filing

(1) Without limiting the generality of section 60A(3), the Registrar may specify terms under that section—

- (a) providing for the approval by the Registrar of the process that must be used to make or send an electronic record;
- (b) providing for the approval by the Registrar of the format or media in which an electronic record must be recorded or stored;
- (c) respecting the manner of authenticating an electronic record in circumstances where the document or other thing in question is required to be signed or sealed or authenticated in any manner;
- (d) requiring any document or other thing sent to the Registrar in the form of an electronic record to include or be accompanied by the electronic signature or digital signature of the person who sends it; and
- (e) respecting the manner of filing a document or other thing in cases where there is an interruption in the operation of the information system designated under section 60A(2).

(2) Without limiting the generality of section 60A(3), the Registrar may refuse to accept or to register any document or other thing that is in the form of an electronic record if—

- (a) the information contained in the electronic record is not capable of being displayed in a legible form;
- (b) the electronic record is not capable of being stored in the information system designated under section 60A(2);
- (c) the electronic record appears to the Registrar to be altered, damaged or incomplete;

- (d) any electronic signature or digital signature or other kind of authentication accompanying or included with the electronic record appears to the Registrar to be altered or incomplete; or
- (e) any term specified by the Registrar under that section has been breached.

60C. Designation of electronic mail box

(1) On the request of any person, the Registrar may designate an electronic mail box within an information system designated by the Registrar which may be used by that person to communicate with the Registrar.

(2) The use by any person of an electronic mail box within the designated information system shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person for whom the electronic mail box is designated.

(3) Where the Registrar designates an electronic mail box for a person under this section, any document or other thing required or authorized by the Ordinance or these Rules to be sent by the Registrar to that person shall be deemed to be properly sent if it is sent in the form of an electronic record to that person's designated electronic mail box.

(4) Sending to a designated electronic mail box shall be deemed to be effected at such time as the electronic record is accepted by the designated information system.

(5) An electronic record sent to a designated electronic mail box shall be deemed to be received by the addressee at such time as the electronic record is accepted and recorded by that electronic mail box.

61. Service of documents

(1) Except as provided by sections 60, 60A, 60B and 60C, where any document or other thing is required or authorized by the Ordinance or these Rules to be sent to any person—

- (a) the document or other thing may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document or other thing may be sent by post to his last known address.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the address for service of the person or, if he does not have an address for service, at his last known address, and unless the contrary is shown, the document or thing shall be deemed to have been received by that person at the time when the letter would be delivered in the ordinary course of post.”.

23. Correction of errors in filed documents

(1) Section 62(4) is amended by repealing “in duplicate”.

(2) Section 62(5) is repealed and the following substituted—

“(5) 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.”.

(3) Section 62(6) is amended by repealing “duplicate” and substituting “copy”.

(4) Section 62(7) is repealed and the following substituted—

“(7) The person making the request shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

24. Section substituted

Section 65 is repealed and the following substituted—

“65. Address for service

(1) Every person concerned in any proceedings before the Registrar shall file an address for service.

(2) The address for service must be a residential or business address in Hong Kong.

(3) A person may file an address for service—

(a) where the person files any specified form that requires the person who completes it to provide an address for service, by filing the specified form with the address for service stated on it; or

(b) in any other case, by notifying the Registrar in writing.

(4) Where a specified form referred to in subsection (3)(a) is filed in the name of 2 or more persons, the address for service stated on that form shall be treated as the address for service of each of those persons.

(5) An applicant for registration of a design or the registered owner of a design may use only one address for service for the purposes of all proceedings before the Registrar concerning that application or registered design.

(6) Subject to any filing to the contrary under this section, on the registration of a design, the address for service of the applicant for registration shall be treated as the address for service of the registered owner of the design for the purposes of all proceedings before the Registrar concerning that registered design.

(7) Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings.

(8) Where, after a person has become a party to proceedings before the Registrar, the person appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file an address for service.

(9) No act required or authorized by the Ordinance or these Rules to be done by or to a person referred to in subsection (8) in connection with the proceedings in question may be done by or to the newly appointed agent before the date on which he files an address for service.

(10) Any person may withdraw his address for service by notifying the Registrar in writing.

65A. Failure to file address for service

(1) Where an address for service is not filed as required by section 65, or where the Registrar is satisfied that the address for service of the registered owner of a design or a party to any proceedings before the Registrar is no longer valid, the Registrar may send to the person concerned, at any of the addresses referred to in subsection (2), a notice to file an address for service.

(2) For the purposes of subsection (1), the addresses are—

(a) any previously filed address for service of the person;

(b) any address of the person in Hong Kong that is shown in the Register;

(c) any residential or business address of the person in Hong Kong; and

(d) any other address of the person that is known to the Registrar.

(3) If any person to whom a notice is sent under subsection (1) fails to file an address for service within 2 months after the date of the notice—

(a) any application, notice or request filed by that person shall be treated as abandoned or withdrawn; and

(b) the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party.

(4) This section is without prejudice to the operation of sections 21 and 22.”.

25. Alteration or correction of address

Section 66(1) is amended by adding “or by notice in writing” after “specified form”.

26. Recognition of agents

Section 67(3) and (4) is repealed and the following substituted—

“(3) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, which notice shall be given in the specified form or in writing.

(4) If a person who has given notice under subsection (3) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing.

(5) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subsection (3).

(6) The Registrar may refuse to recognize as an agent in respect of any business under the Ordinance or these Rules—

- (a) a person who has been convicted of a criminal offence;
- (b) a person whose name has been struck off the roll of barristers or roll of solicitors kept under and in accordance with the Legal Practitioners Ordinance (Cap. 159) or any person who has been suspended from acting as a barrister or solicitor;
- (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognize as an agent under paragraph (a) or (b);
- (d) a person against whom a disqualification order has been made under section 168E, 168F, 168G, 168H, 168J or 168L of the Companies Ordinance (Cap. 32);
- (e) a person against whom an order has been made under section 23(1)(a) or 24(1) of the repealed Securities (Insider Dealing) Ordinance (Cap. 395); or
- (f) a person against whom an order has been made under section 214(2)(d), 257(1)(a), 258(1) or 303(2)(a) of the Securities and Futures Ordinance (Cap. 571).

Note: Section 75(4) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.”.

27. Section added

The following is added immediately after section 73—

“73A. Extension of time limits in the case of an interruption in the Registry’s operations

(1) Where on any day there is an event or circumstances causing an interruption in the normal operation of the Registry, the Registrar may notify the day as being one on which there is an interruption in the operations of the Registry.

(2) Where any period of time specified in the Ordinance or these Rules, or as extended under these Rules, for the filing of any document or other thing with the Registrar expires on a day so notified, the period shall be extended to the first day next following (not being an excluded day) that is not so notified.

(3) Any notification given by the Registrar under this section shall be posted in the Registry.

(4) In this section, “excluded day” (非辦公日) means a day that is not a business day of the Registry.”.

28. Fees

The Schedule is amended—

- (a) in Fee No. 1, in the third column, by repealing “\$1,600” and substituting “\$785”;
- (b) in Fee No. 2, in the third column, by repealing “\$3,200” and substituting “\$1,570”;
- (c) in Fee No. 3, in the third column—
 - (i) by repealing “\$1,600” and substituting “\$785”;
 - (ii) by repealing “\$1,200” and substituting “\$590”;
- (d) in Fee No. 4, in the third column—
 - (i) by repealing “\$3,200” and substituting “\$1,570”;
 - (ii) by repealing “\$2,400” and substituting “\$1,180”;
- (e) in Fee Nos. 5, 6 and 7, in the third column, by repealing “\$350” and substituting “\$170”;
- (f) in Fee No. 8, in the third column, by repealing “\$500” and substituting “\$245”;

- (g) in Fee No. 9, in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette” and substituting “\$155”;
- (h) in Fee Nos. 10 and 11, in the third column, by repealing “\$350” and substituting “\$170”;
- (i) in Fee No. 14, in the third column, by repealing “\$2,500” and substituting “\$1,230”;
- (j) in Fee No. 15, in the third column, by repealing “\$3,800” and substituting “\$1,860”;
- (k) in Fee No. 16, in the third column, by repealing “\$5,600” and substituting “\$2,740”;
- (l) in Fee No. 17, in the third column, by repealing “\$8,500” and substituting “\$4,170”;
- (m) in Fee No. 18, in the third column, by repealing “\$2,500” and substituting “\$1,230”;
- (n) in Fee No. 19, in the third column, by repealing “\$1,000” and substituting “\$490”;
- (o) in Fee Nos. 20 and 21, in the third column, by repealing “\$1,200” and substituting “\$590”;
- (p) in Fee No. 22, in the third column, by repealing “\$700” and substituting “\$345”;
- (q) in Fee No. 23, in the third column, by repealing “\$1,200” and substituting “\$590”;
- (r) in Fee No. 24, in the third column, by repealing “\$350” and substituting “\$170”;
- (s) by repealing Fee Nos. 25 and 26;
- (t) in Fee No. 27—
 - (i) in the second column, by adding “(for each design)” after “section 73”;
 - (ii) in the third column, by repealing “\$800” and substituting “\$390”.

S. R. SELBY
Registrar of Designs

6 March 2004

Explanatory Note

These Rules amend the Registered Designs Rules (Cap. 522 sub. leg. A) (“the principal Rules”) to facilitate the electronic filing and processing of applications for registered designs, to streamline the procedures in the Designs Registry (“the Registry”) and to reduce the fees payable on the filing of documents with the Registry. The amendments relating to the electronic filing and processing of documents are in furtherance of the amendments made to the Registered Designs Ordinance (Cap. 522) (“the Ordinance”) by the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Section 2(1) makes a technical amendment to the definition of “send” in section 2(1) of the principal Rules. Section 2(2) adds the new definitions of “digital signature”, “electronic record”, “electronic signature” and “information system”. The terms are used in the new sections 60A, 60B and 60C which are added by section 22 of these Rules. Section 2(3) makes a consequential amendment to section 2(2)(c) of the principal Rules.

3. Section 3 adds the new section 2A to the principal Rules to enable the Registrar of Designs (the “Registrar”) to accept forms in an electronic format.

4. Sections 4(1) and (2), 5 and 6 amend sections 6, 7 and 8 of the principal Rules to delete the requirement for the statement of novelty to appear on the representation of the design and for 6 additional representations to be submitted with every application. The Registrar will instead be able to request additional copies of the representation when necessary.

5. Section 4(3) amends section 6(3)(e) of the principal Rules to delete the requirement for a transliteration of the name of the applicant if that name is in Chinese characters.

6. Section 7 amends section 11(2) of the principal Rules to allow a copy of the certificate to be filed instead of the original.

7. Section 8 amends section 17 of the principal Rules to delete the requirement for the notice of withdrawal to be filed in the specified form and to require the notice to contain the number of the application being withdrawn.

8. Section 9 amends section 33(3)(a) of the principal Rules to delete the requirement for the assignee to sign the application.

9. Sections 10(1), 11(1), 15(1) and 23(1) amend sections 37(1), 38(1), 51(3) and 62(4) of the principal Rules to delete the requirement for duplicate copies of certain documents to be filed with the Registrar. Sections 12(1), 13, 15(3) and 23(3) make consequential amendments to sections 39(1), 40(1), 51(5) and 62(6) of the principal Rules.

10. Sections 10(2), 11(2), 12(2), 15(2) and (4) and 23(2) and (4) amend sections 37(2), 38(2), 39(2), 51(4) and (6) and 62(5) and (7) of the principal Rules to require the party initiating the proceeding to serve certain documents on the other side.
11. Section 14 amends sections 46(1), 47(1) and 50(1) of the principal Rules to delete the requirement for the copy of the document to be certified.
12. Sections 16 and 17(2) repeal the references to fees in sections 52 and 55(4) of the principal Rules.
13. Section 17(3) adds the new section 55(5A) to the principal Rules to make clear that the right of inspection only extends to information and documents kept by the Registry. Section 17(1) makes a consequential amendment to section 55(2) and (3) of the principal Rules.
14. Section 18 adds the new section 55A to the principal Rules to allow the Registrar to determine the form and content of the Registry's records and the circumstances in which records and documents may be disposed of.
15. Section 19 amends section 56 of the principal Rules to clarify the text.
16. Section 20 amends the subheading preceding section 58 of the principal Rules as a consequence of the addition of the new sections 60A, 60B and 60C.
17. Section 21 amends section 59(1) of the principal Rules to delete the requirement for the translation to be verified and to require that the name and official capacity of the translator be given instead.
18. Section 22 replaces sections 60 and 61 of the principal Rules with new provisions governing the filing and service of documents. The new section 60 provides for documents to be delivered by hand or sent by post to the Registrar. The new sections 60A and 60B provide for the electronic filing of documents and enable the Registrar to specify the terms for electronic filing in the official journal. The new section 60C enables the Registrar to designate an electronic mail box which may be used by the person for whom it is designated to communicate with the Registrar. The new section 61 specifies the manner in which documents shall be served.
19. Section 24 replaces section 65 of the principal Rules with two new provisions relating to addresses for service. The new section 65 requires a person who is concerned in any proceedings before the Registrar to file an address for service, which must be a residential or business address in Hong Kong, and provides for the manner of filing or withdrawing an address for service and for related matters. The new section 65A deals with the failure to file an address for service.

20. Section 25 amends section 66(1) of the principal Rules to allow the person making the request or the agent the option of filing a notice in writing instead of a specified form.

21. Section 26 amends section 67 of the principal Rules to require an agent to notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, to notify the Registrar of any changes in that address and to revise the list of persons whom the Registrar may refuse to recognize as an agent.

22. Section 27 adds the new section 73A to the principal Rules which provides that if a deadline expires on the day on which there is an interruption in the normal operation of the Registry, it shall be extended to the next business day.

23. Section 28 reduces certain fees set out in the Schedule to the principal Rules.