

ONC Lawyers  
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# Patents & Designs

# Patents

1. What is a patent?
2. What can be patented?
3. Types of patent applications
4. Basic requirements of patent grant
5. Rights and protections by a patent grant

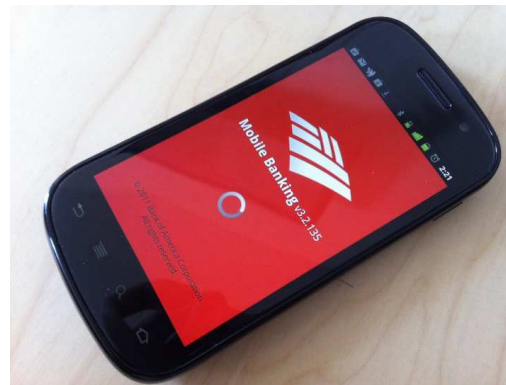
# What is a patent?

## Patent

- Legal right to protect an invention of the patent owner from being manufactured, used, sold, or imported by the others
  - e.g. 3M Post-it



Tropicana  
Naturally Sweetened Juice  
Beverage Products



Bank of America  
Monetary Transfer Approval  
via Mobile Device



Thermos  
A Heat Insulating Container and the  
Method of Manufacturing the Same

# More than 1200 patented inventions in one iPhone alone!

## CORE TECHNOLOGY AREAS OF APPLE PATENTS

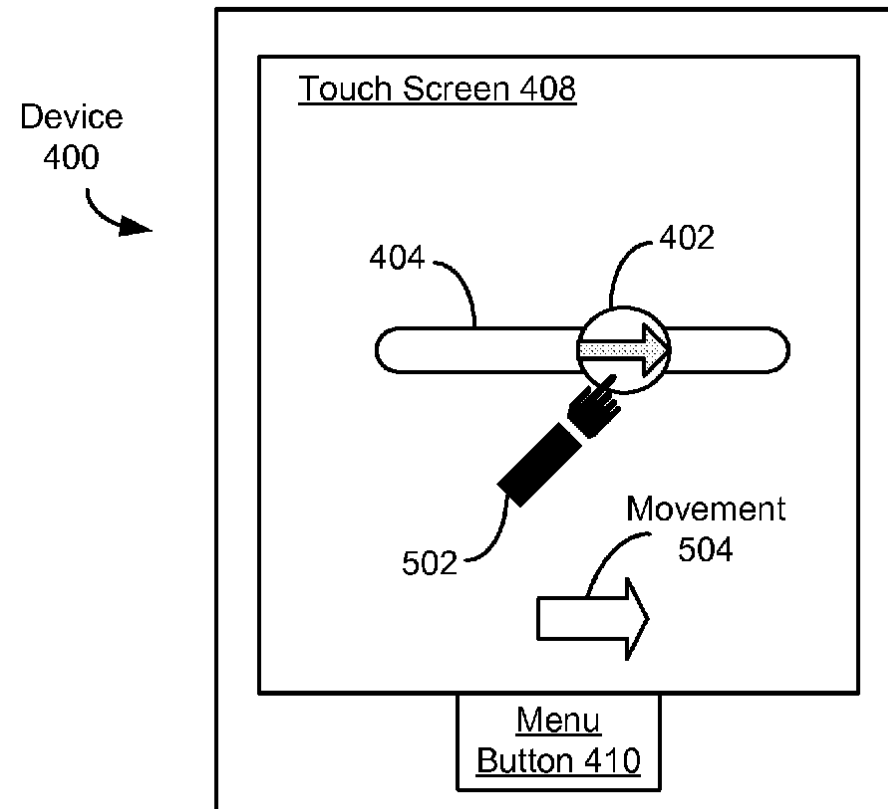
FIGURE 1

TECHNOLOGY AREA	NUMBER OF INVENTIONS (PATENTS)
iPhone, Smartphone General	416
Camera	279
User Interface	232
Image Display/Screen	149
Battery/Power Control	88
Antenna	75
Calendar	31
Contact Management	15
Voice Control	5

Source: Derwent World Patents Index\*

# Examples of iPhone Patents

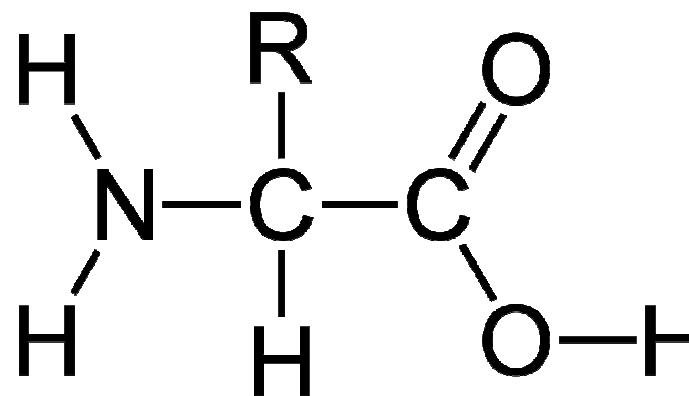
- **User interface:**  
Unlocking a device by performing gestures on an unlock image
- **Voice control:**  
Intelligent Automated Assistant  
→ SIRI



# What is a patent?

## Stages of invention

- **1<sup>st</sup> stage:** the definition of the problem to be solved or the difficulty to be overcome
- **2<sup>nd</sup> stage:** the choice of the general principle to be applied in solving the problem or overcoming the difficulty
- **3<sup>rd</sup> stage:** the choice of the particular means to be used
- **Difference between discovery and invention:** a patent cannot be obtained for a discovery in the strict sense



# What can be patented?

- **Products**

- Example: Energy recycling footwear

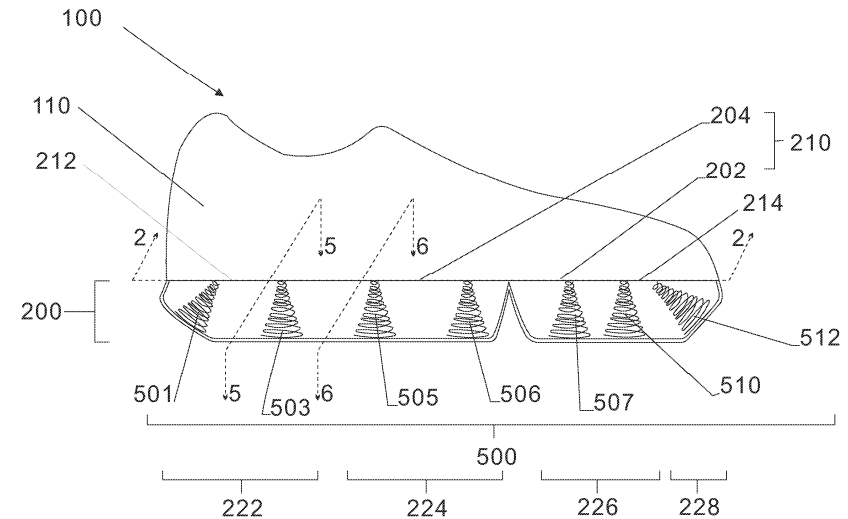


FIG. 1

- **Process and method**

- Examples: Method of using earthworms to dispose organic waste ecologically and facilities for producing organic fertilisers





# What can be patented?

## Exclusions from patentability

- The following are not regarded as inventions for the purposes of the Patents Ordinance:
  - a discovery, scientific theory or mathematical method
  - an aesthetic creation
  - a scheme, rule or method for performing a mental act, playing a game or doing business, or a programme for a computer  
Note: business methods patentable in the US
  - the presentation of information



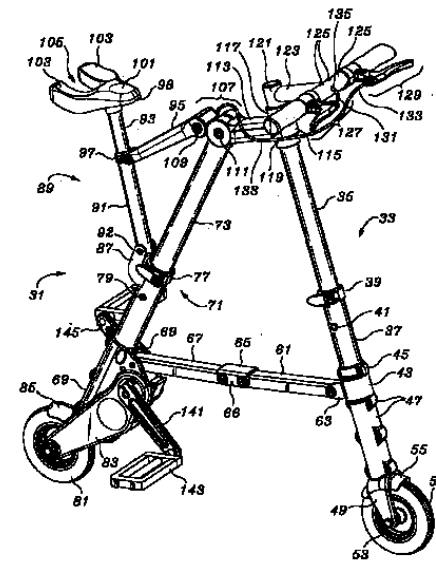
# Types of patent applications

## Hong Kong

- Standard Patent
- Short-term Patent

## PRC

- Invention Patent (發明專利)
- Utility Model Patent (實用新型)



# Types of patent applications

## Hong Kong

- **Standard Patent (2 stages)**
  - **Stage 1 (Request to Record):**  
Request to HK Patents Registry to record the designated patent application within 6 months of publication of the application by one of the designated patent offices in PRC, UK or European Patent Office
  - **Stage 2: (Request for Registration and Grant)**  
File within 6 months after the patent grant by one of the designated patent offices in PRC, UK or European Patent Office
- **Short-term Patent**
  - File the application together with the requisite documents to the Registrar of the Hong Kong Patents Registry
  - E.g. a relevant search provided by one of the prescribed searching authorities such as SIPO
  - Formality examination

## HK: Standard Patent vs. Short-term Patent

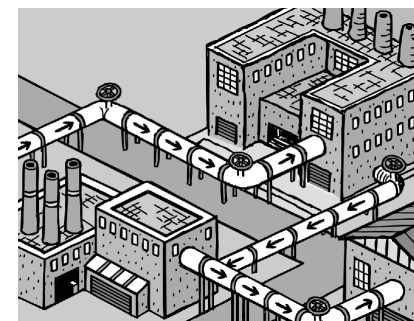
	Standard Patent	Short-term Patent
<b>Maximum Number of Years of Protection</b>	20 years	8 years (HK)
<b>Application Time</b>	Long, 3-4 years or more depending on designated patent	Short, 6 to 9 months
<b>Examination</b>	Registration based on the designated patent	Only examined on formalities
<b>Remark</b>	<p>Substantive examination in the designated patent application</p> <ul style="list-style-type: none"><li>- PRC</li><li>- UK</li><li>- EP designating UK</li></ul>	<ul style="list-style-type: none"><li>• Owner to prove patent valid in Court</li><li>• Available in some countries only<ul style="list-style-type: none"><li>- e.g. PRC, Australia</li><li>- but not in the US</li></ul></li></ul>

## PRC: Invention Patent vs. Utility Model

	Invention Patent	Utility Model
<b>Protection Period</b>	20 years	10 years
<b>Application Time</b>	Long, 3-4 years	Short, 6 – 9 months
<b>Examination</b>	Substantive examination by PRC Patent Office	Only examined on formalities
<b>Language</b>	Chinese	Chinese

# Basic requirements of patent grant

- Novelty
- Inventive Step
- Industrial application



# Basic requirements of patent grant

## Novelty

- New – does not form part of the state of the art
- State of the art – include any patent application filed before your application but published after your application
- For novelty purpose: single source of prior art
- Has not been made available to public before filing
- Publication anywhere in the world, whether written or oral
- Including being:
  - Sold on the market;
  - Promoted through advertisements;
  - Displayed at exhibitions
- If the invention is published (even by the applicant) before filing patent application, it still falls short of meeting the novelty requirement



# Basic requirements of patent grant

## Inventive step

- Not obvious to a person skilled in the art
- State of the art – include any patent application filed before your application but NOT those published after your application
- For inventive step purpose: multiple source of prior art may be applied
- Problem-solution approach: whether the solution presented to the problem is obvious (independent thought, ingenuity or skill)
- Factors:
  - Long standing technical problem, where there have been many attempts to solve the problem
  - Unexpected technical effect of a new combination of known elements
  - Choice of specific process parameters within a known range
  - Commercial success

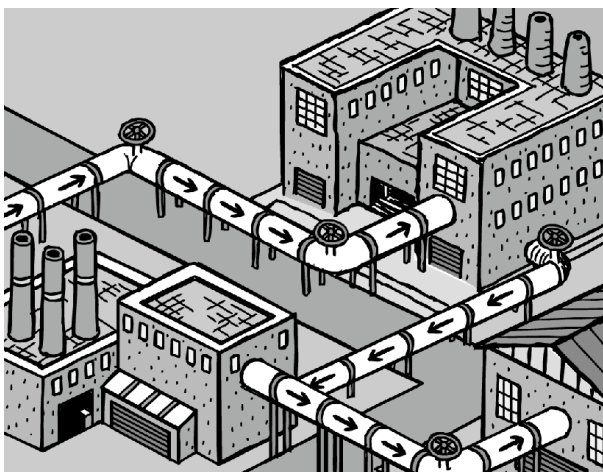




# Basic requirements of patent grant

## Industrial application

- Can be made or used in any kind of industry, including agriculture
- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are not regarded as susceptible of industrial application
- But this does not apply to a product, in particular a substance or composition, for use in any such method



## Rights and protections by a patent grant

- In exchange for full disclosure, exclusive right to:
  - For patented products: Make, put on the market, use or import, or stock the product for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise
  - For patented processes: Use or offer for use in Hong Kong
  - For products obtained directly by means of a patented process: Put on the market, use or import, or stock the product for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise

## Rights and protections by a patent grant

- May take legal action against infringement of granted patent
- Territorial protection of registered patents in Hong Kong
  - Patents must be granted in Hong Kong in order to obtain protection in Hong Kong



# Designs

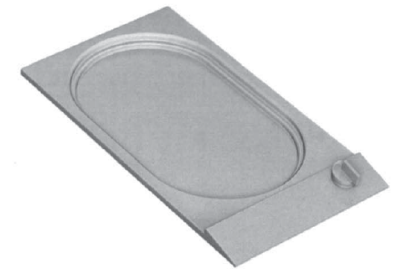
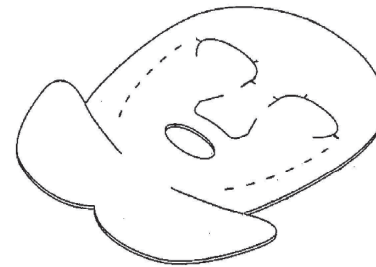
1. What is a design?
2. What can be registered?
3. Basic requirements of design registration
4. Rights and protections by a design registration
5. Comparing design and copyright

# What is a design?

- Legal right to protect the “appearance” of products

## Examples of design

- FANCL face mask
  - Shape and configuration
- BSH Bosch und Siemens Hausgerätei iron pan grill stove
  - Shape and configuration
- FIBA logo for printed matters, including advertising materials
  - Pattern or ornament



## What can be registered?

- Features of shape, configuration, pattern, or ornament applied to an article by any industrial process or means
- Being features appeal to and judged by the eye



## What can be registered?

- Material used?
  - Protection may not be granted for the feel of a texture, or what the product is actually made from
  - Only that these features may influence what the overall product looks like
- Colour? An element of design but in general unlikely to be important in registration of designs



## What cannot be registered?

- Method or principle of construction;
- Features which are:
  - Dictated solely by the function
    - Where shape has no consumer eye appeal
    - E.g. electrical connectors were held not to be designs, notwithstanding that they might, in order to perform their function, have been differently shaped
  - Dependant upon the appearance of another article
    - E.g. Main body panels, doors, bonnet lids, boot lids and windscreens (integral parts)



# How to register a design in HK?

- File the application form with the following required documents:
  - A completed application form
  - Representation of the article
  - A statement of novelty
  - A sample (for registration of a 2D design for a textile product only)



FRONT VIEW



REAR VIEW



TOP VIEW



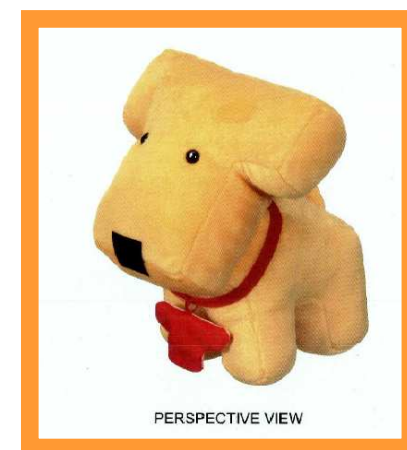
BOTTOM VIEW



RIGHT SIDE VIEW



LEFT SIDE VIEW



PERSPECTIVE VIEW

# Basic requirements of design registration

- Novelty = “new”
- Not be regarded as “new” if it is the same as
  - A prior registered design
  - A published design, in Hong Kong or elsewhere, before filing date of the application
- Publication: Disclosure to one person, free of obligations of confidence, in the form of clear and unmistakable directions as to how to make an article having the features

# Rights and protections by design registration

- Exclusive right to
  - Make in Hong Kong or import into Hong Kong (i) for sale or hire; or (ii) for use for the purpose of trade or business;
  - To sell, hire, or offer or expose for sale or hire in Hong Kong
  - Any article in respect of which the design is registered or a design not substantially different from it has been applied
- May take legal action against infringement of the registered design
- Maximum period of protection of a registered design: 25 years
- Renewable for periods of 5 years



# Comparing design and copyright

## Design

- Covers: shape, configuration, pattern, ornament
- Registration: needed for protection
- Basic requirement: new

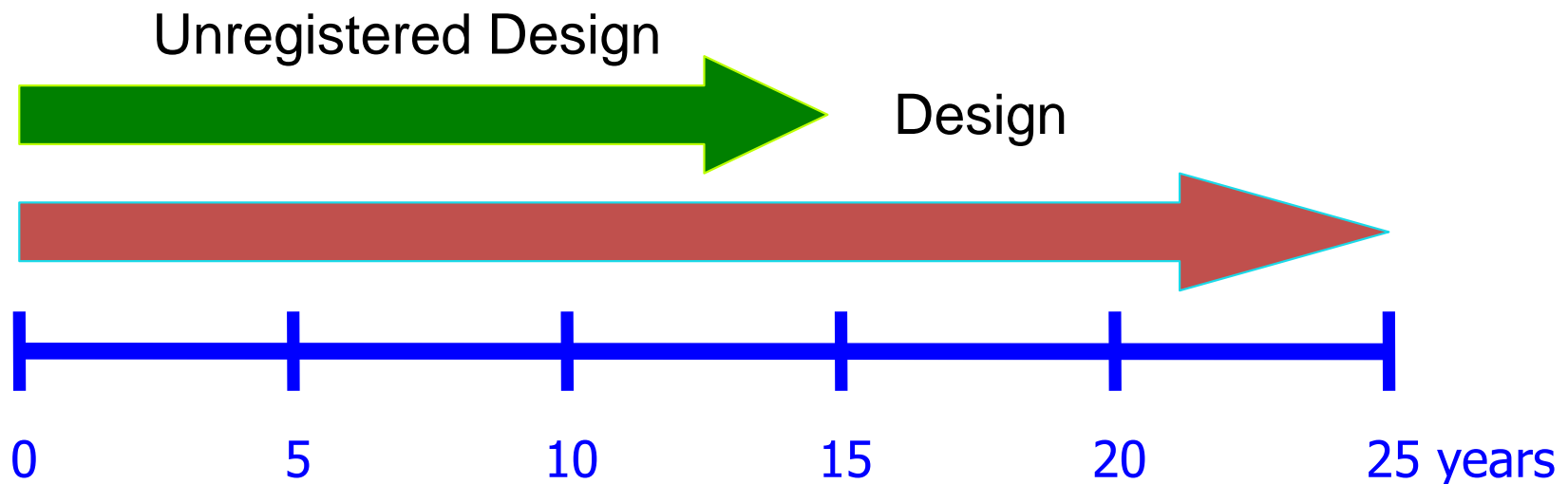
## Copyright

- Covers: literary, dramatic, musical, or artistic work; sound recordings, films, broadcasts or cable programmes; ...
- Artistic work: graphical work (drawing), photo, sculpture
- Registration: no need for registration in HK
- Basic requirement: originality

# Comparing design and copyright

## Extended period of protection

- Unregistered design derived from artistic work (industrial process): 15 years
  - Cf. Literary, artistic works: Life of the author + 50 years
- Registered design: 25 years



First made available  
to the market

# Comparing design and copyright

## Benefits of registering a design

- Given that a design is protected by copyright law, why should we register it as registered design?
- Certificate of registration as prima facie evidence of ownership of the design
  - Cf. Copyright owners need to prove originality of their works
- Additional 10 years' protection under registered design
- The defence of independent creation under copyright law is not available under the registered design regime

# Prima Facie Evidence of Ownership

知識產權署外觀設計註冊處  
Designs Registry  
Intellectual Property Department



香港特別行政區政府  
The Government of the Hong Kong  
Special Administrative Region

0900824.6

外觀設計圖或照片

## 外觀設計註冊證明書

《註冊外觀設計條例》(第 522 章)

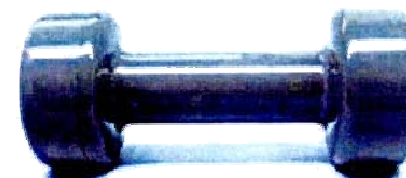
### CERTIFICATE OF REGISTRATION OF DESIGN

Registered Designs Ordinance (Chapter 522)

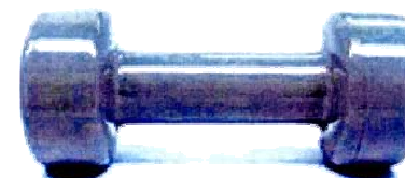
茲證明下述外觀設計之詳情於今日記入註冊紀錄冊

*I hereby certify that the design with the following particulars has been entered in the register today:*

- [11] 註冊編號 Registration No.: 0900824.6
- [15] 註冊日期 Date of Registration: 21.05.2009
- [51] 洛迦諾分類號 Locarno Classification No.: Cl. 10 - 01
- [54] 物品 Article(s)  
啞鈴形鬧鐘 Dumbbell shaped alarm clock
- [55] 外觀設計的表述 Representation of the Design  
見後附表錄 See attached representation(s)
- [57] 新穎性陳述 Statement of Novelty  
此外觀設計的新穎性，在於此等表述所示物品的形狀的特色。  
The features of the design for which novelty is claimed is the shape of the article as shown in the representation.
- [73] 註冊擁有人姓名/名稱及地址 Name and Address of Registered Owner  
高昇電子有限公司  
香港九龍觀塘成業街 11-13 號華成工商中心 8 樓 810 室



主視圖



後視圖



1

# Worldwide Registration Strategy

1. Benefits of worldwide registration
2. PCT patent applications
3. European patent applications
4. OHIM for design registration



# Benefits of worldwide registration

## Objectives of worldwide registration

- Gaining monopoly, prevent competition
- Penetrating foreign markets
  - purchaser requires patent registration as prerequisite for shelving goods
  - bargaining chips in co-operation with large company
- Registration in the relevant jurisdictions
  - place of manufacture: PRC
  - logistic hub: HK
  - Targeted markets: US, EU
- Obtaining registration with minimum costs

# Benefits of worldwide registration

## Practical worldwide registration strategy

- 1) Starting with PCT application
  - choosing the destination countries
  - entering the national phase
- 2) Simultaneous filing of patent applications
  - place of manufacture: PRC
  - logistic hub: HK
  - targeted markets: US, EU, Taiwan and other non-Paris Convention countries
- 3) Starting with HK and PRC
  - filing first application in one Paris Convention country
  - then file separate applications in other Paris Convention countries before priority deadline

# Benefits of worldwide registration

## Paris Convention for the Protection of Industrial Property

- Covers patents, designs, trade marks, utility models etc.
- Right of priority
  - Apply for protection in another contracting state within a certain period of time (12 months for patents and utility models; 6 months for industrial designs and marks) after regular first application
  - Later applications regarded as if filed on the same day as the first application
  - Later applications not affected by any event that may have taken place in the interval, e.g. any publication of the invention or sale of articles bearing the mark or incorporating the industrial design

# Paris Convention

## Example of Priority

1 November 2013	A filed patent application in Australia
15 December 2013	B filed patent application in the PRC
28 February 2014	A filed patent application in the PRC and claimed conventional priority

\* Both Australia and the PRC are Paris Convention signatory states

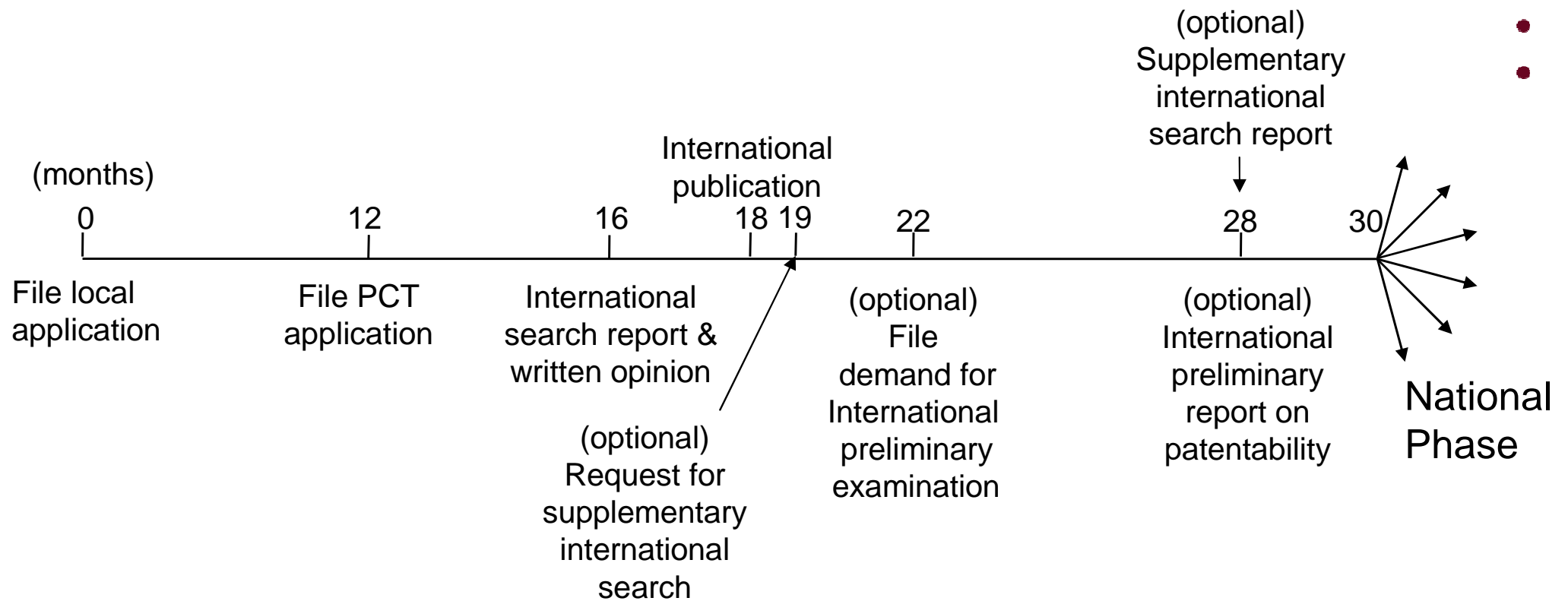
Deemed Date of A's Patent Application in the PRC:

1 November 2013 → Earlier than B's patent

# Patent Cooperation Treaty

- Members include the 148 Paris Convention countries
- Filing a single “international” patent application
  - In *one* place, in *one* language and pays *one* initial set of fees
- Favourable international search report strengthens applicant’s position vis-à-vis national/regional Patent Offices

# The PCT System



Source: WIPO (December 2011)

# European Patent Convention

- Protection in about 40 European countries on the basis of a single application
  - The applicant selects the countries in which he wants protection
- Unified body of substantive patent law
- Same legal effects as national patents
- Same term, scope of protection, binding text and grounds for revocation of European patents all contracting states
- Currently any infringement of an European patent is dealt with by national law/court
- Proposed Unified Patent Court (UPC)
  - Agreement signed on 19 February 2013 but not ratified by all signatory states yet



## OHIM / Registered Community Designs

- Office for Harmonization in the Internal Market (OHIM)
- Protection in the whole of European Union (not necessary to choose particular member states)
- Single application, single language, single administrative centre, single payment
- Valid for 5 years from the date of filing
  - Can be renewed in periods of 5 years up to a maximum of 25 years
- Registration within 1 year of first being made available to the public
- Paris Convention priority applicable



# Enforcement of Patent Rights

1. Enforcement of patent rights in HK
2. Enforcement of patent rights in PRC
3. What constitutes infringement?
4. Defence to patent infringement
5. How to respond to infringement action?

# Enforcement of patent rights in HK

- Complaint to Customs Department
  - Mainly apply to trade mark and copyright infringement
- Cease and desist letters issued by Solicitors
  - Effective way to stop infringement in Hong Kong
- Court Action
  - Injunction
  - Damages / Account of Profits

# Enforcement of patent rights in PRC

- Complaint to PRC Customs
  - Mainly apply to trade mark infringement
- Cease and desist letters issued by Solicitors
- Administrative Action
  - By Administration of Industry and Commerce (AIC)
  - Mainly apply to trade mark infringement
  - Closing shops and seizure
  - Fast and effective
- Court Action
  - Apply to all kinds of IP infringement
  - To obtain damages

## What Constitutes Infringement in patent?

- The question of infringement involves consideration of two matters:
  - 1) whether falls within the scope of the patent
  - 2) whether the alleged infringer has done any infringing act
- Falls within the scope of the patent: construe the specification and claims purposively to determine the essential integers
  - 1) If the alleged infringing article contains all the integers, there is infringement
  - 2) If contains variant of some integers, may still infringe, if the variant has no material effect upon the way the invention works, or obvious to skilled reader

# What Constitutes Infringement in design

- Design not substantially different from registered design
  - Small differences between the registered design and the prior art → no infringement if there are equally small differences between the registered design and the alleged infringing article

- *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat)



- Similarities in Design:
  - Very same screen, with a flat glass plate out to a very thin rim and a plain border under the glass
- Differences in Design:
  - Thinness of the Galaxy tablets
  - Detailing on the back of each of the tablets
- Decision: Samsung tablets do not have the same extreme simplicity which is possessed by the Apple design. **They are not as cool. The overall impression produced is different**



# How to respond to infringement action

- Court Action
  - Challenge the validity of the patent allegedly being infringed in a countersuit
- Professional advice should be sought to respond to all actions enforcing patent/design rights



# How to avoid infringing others' rights?

- Conduct patent/design searches prior to use
- Seek professional advice on infringement review



**香港特別行政區政府知識產權署**  
The Government of the Hong Kong Special Administrative Region  
Intellectual Property Department



solutions • not complications