



WHY USE
HONG KONG
LAW

Unique Aspects of Hong Kong Law – Intellectual Property

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Hong Kong IP Law

- Common Law System
- Statutes based on UK statutes
- Common Law mostly follow UK cases
- Separate laws and independent jurisdiction
from mainland China
- Court Specialist IP List



■ **HK is a member of all main international IP conventions**

- the Paris Convention for the Protection of Industrial Property (TM Rights)
- the Berne Convention for the Protection of Literary and Artistic Works (Copyright)
- the Universal Copyright Convention (Copyright)
- the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks (Trade Mark)
- the Geneva Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of Their Phonograms (Music Recordings)
- the Patent Cooperation Treaty (Patents)
- the Convention establishing the World Intellectual Property Organization (“WIPO”)



IPR Protection in HK

■ Registered Rights

- Trade Marks
- Patents
- Designs

■ Unregistered Rights

- Copyright
- Trade Secret
- Confidential Information
- Passing Off



Summary of Categories of Intellectual Property Protected in the Hong Kong SAR

| | Trade Marks | Patents | Designs | Plant Varieties | Integrated Circuit Designs | Copyright |
|--|---|-----------|--|---|---|---|
| Type of subject-matter normally protected | Signs that distinguish goods or services of one trader from those of others | Invention | Industrial product designs, fabric designs | New agricultural or horticultural plant varieties | Lay-out designs of integrated circuits ('mask' works) | Books, software, plays, music, paintings, sculpture, photographs, films, sound recordings, broadcasts, cable programmes, performances |
| Whether registration is required for effective protection in the Hong Kong SAR | YES | YES | YES | YES | NO | NO |
| Enforcement available in the Hong Kong SAR | Civil, Criminal | Civil | Civil | Civil | Civil | Civil, Criminal |

SOURCE: *ipd.gov.hk* paper on *Intellectual Property in Hong Kong*



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Some unique advantages of HK Laws

■ Trade Marks

- First to use system
 - unlike e.g. Mainland “First to file”
- Protects unregistered TM rights
 - through passing off
 - includes trade marks, get up, other misrepresentations such as authorization, association, etc.
- “Spill-over” reputation accepted
 - departed from UK position ability to create own laws
 - accepts reputation “spill over” from abroad i.e. even if a brand has not used its mark in Hong Kong

Kabushiki Kaisha Yakult Honsha & Others
VS.
Yakudo Group Holdings Limited & Others

- Son of Taiwan partner of Japanese well known “YAKULT” brand
- Started own brand “YAKUDO” + similar bottle
- Set up company in Hong Kong, Yakudo Group Holdings Limited
- Planned factory and huge sales in Hong Kong and China
- Raising funds through Hong Kong



Yakult vs. Yakudo



- Yakult obtained interlocutory injunction within a few months in HK + final judgment
- Based on passing off: packaging and mark
- HK court accepted “Spill-over” reputation from Japan and Taiwan for different Chinese trade mark “養樂多” vs HK’s “益力多”
- Stopped all infringing activities including in China
 - Closed down PRC factory due to lack of funding

■ Copyright

- No registration required
 - protects work as soon as it is created
- Protects works created by anyone anywhere in the world
- Protects commercial products designs without registration
 - unlike many countries such as mainland China, Australia – must register design
 - overlap with registered designs
 - ❖ shorter term of protection to 15 years



■ Copyright

- Unique expansion of protection against “end-user” liability
 - use of software, film, music, TV drama or publications in business
 - even if not trading or dealing



■ Parallel Imports:

- First 15 months of publication
 - dealing in copies
 - playing or showing works in public
 - civil and criminal sanctions
- After 15 months
 - ❖ may still be civil
 - ❖ although have defences

■ Patents

- 2 methods:
 - Original Grant Patent:
 - ❖ since December 2019
 - ❖ substantive examination + grant
 - Re-registration systems:
 - ❖ simple re-registration of patents filed in:
 - Mainland China
 - EU
 - UK
 - ❖ cheap and easy added protection
 - no substantive examination

Enforcement of IP Rights

- **Courts** – Specialist IP List with Judges familiar with IPR
 - Fair process, effective and efficient
 - Procedures for faster determination of case
 - Interlocutory injunction
 - Mareva injunction – freezing assets
 - Anton Pillar order – search premises and seize evidence
 - Summary judgment
 - Speedy trial

■ **Arbitrations**

- specifically allowed by new Arbitration (Amendment) Ordinance 2017 – IP arbitration is not against public policy
- large number of experienced IP practitioners from all nationalities

■ **Customs – criminal actions**

- forged trade mark
- copyright infringement
- close co-operation with enforcement agencies of other jurisdictions including Mainland China
- proactive in notification of infringement
- record examiners for expedient actions

■ **Trade fairs – effective IPR complaint procedures**



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