



IP Litigation and Enforcement Guide: Hong Kong



IP Litigation & Enforcement in Hong Kong

This is a brief guide addressing common questions and concerns of the IP litigation and enforcement landscape in Hong Kong.

Is your jurisdiction a common law or civil law jurisdiction?

Hong Kong is a common law jurisdiction.

What methods are there for enforcing IP rights in your jurisdiction?

IP Right	Civil	Administrative	Criminal	Customs
Trademark	Yes	No	Yes	Yes
Unfair competition/ passing off	Yes	No	No	No
Copyright	Yes	No	Yes	Yes (for simple cases)
Registered designs/ design patents	Yes	No	No, but 3D designs are protected as copyright works	No
Patent	Yes	No	No	No

What courts have jurisdiction to handle civil IP cases?

The District Court has jurisdiction to hear passing or copyright infringement cases up to a value of HK\$3,000,000 (USD385,000). The Court of First Instance (CFI) of the High Court has unlimited jurisdiction for all IP claims. Since 2019 an IP specialist list has been established in the CFI to hear IP cases and since then almost all IP actions have been filed in that list.

Is there any bifurcation of proceedings? For example, for determining validity or damages?

Infringement and validity are decided at the same time before the same Tribunal. For a short term patent that has not been substantively examined or held valid in court, it is generally necessary to request substantive examination before filing civil proceedings.

The general practice is for liability and quantum to be bifurcated with a trial on liability with an assessment of damages or account of profits ordered if liability is found.

What are procedures for civil enforcement?

A civil action is initiated by filing a Writ of Summons and Statement of Claim setting out the Plaintiff's claim in the form of notice pleading. The Defendant can file a Defence and the plaintiff a Reply. If the Defendant does not defend the proceedings there are procedures for obtaining a default judgment. Following the close of pleadings there will be discovery and the filing of witness statements and the action is then set down for trial. The trial will be before a judge (without a jury) where witness are called and cross-examined.

Is a power of attorney needed for civil action to be brought? If so what are the procedures and time lines?

A power of attorney to lawyers is not required to bring civil (or criminal) action in Hong Kong.

What is the average time to trial in a civil case?

A typical IP infringement case at first instance can take from 15 to 30 months from issue of the Statement of Claim through to trial, although it is sometimes possible to obtain a speedy trial timetable, getting to Court within a year.

What is the language of the proceedings? Is there a choice of language?

English and Chinese are both official languages in Hong Kong. Parties can choose to conduct hearings in either language. Interpretation services between the languages will be provided. The majority of civil cases are filed and heard in English. Where the judge and all counsel can speak English and Cantonese, the trial may be conducted bilingually with witnesses giving evidence, if they wish, in Cantonese but submissions being made in English. Similarly, where the judge and all counsel can read Chinese, documents will be referred to in either language without translations being prepared.

Is it possible to apply for summary judgment?

Yes. The test is that there is no defence to the action. Summary judgment is quite commonly granted in trade mark, passing off and simple copyright cases.

On what basis are interim injunctions granted?

Interim injunctions may be granted where the Plaintiff can establish that (i) if an injunction is not granted before trial it will suffer damage that cannot be compensated for in damages (ii) that there is a real issue to be tried (that is, the case is not frivolous) and (iii) that the balance of convenience favours a grant of an injunction (that is, the least harm will be caused by the grant).

On what basis are permanent injunctions granted?

If requested by the Plaintiff, permanent injunctions are generally granted as of right once liability is established. There are very narrow public interest grounds on which a court may decide not to grant a permanent injunction.

What appeal procedures are available from a first instance judgment?

Civil appeals from the District Court or Court of First Instance (CFI) go to the Court of Appeal. Leave to appeal is required to appeal an interlocutory decision. No leave is required if the appeal is against final judgement. There is a further appeal possible to the Court of Final Appeal. Leave must be granted for any appeal to the CFA.

What are the procedures for criminal enforcement?

Criminal actions can be brought for trade mark and copyright infringement. The Hong Kong Customs and Excise Department (C&E) is the only governmental department responsible for bringing criminal prosecutions in IP cases. Customs will seize at the border and, unlike in other jurisdictions, also conduct enforcement actions against targets (including retailers) within the borders of Hong Kong. If seized goods are determined to be counterfeit and/or infringing, C&E will seize them and lay charges against the infringer. Depending on the severity of the case, prosecutions are brought in the Magistrates Court or District Court. (Prosecutions can also be brought in the High Court, but this is extremely rare) Once the infringer has been successfully prosecuted, the counterfeit/infringing goods will be ordered to be destroyed. Customs can also bring criminal prosecutions in relation to false statements made in relation to services. Private prosecutions can be brought but are extremely rare.

What are the procedures for criminal appeals?

Appeals from magistracy verdicts can be made as of right to the Court of First Instance of the High Court. Appeals of District Court verdicts can be made as of right to the Court of Appeal. Second level appeals can be made to the Court of Final Appeal with leave.

What are the procedures for administrative enforcement?

There is no governmental administrative enforcement in Hong Kong. Certain trade fairs have rules for applying for products to be removed from display during a trade fair.

What are the measures for Customs border protection?

Hong Kong has no formal Customs recordal system, but it is possible for trade mark and copyright owners to make complaints (effectively an informal recordal system) to C&E in respect of infringing products. Customs will inspect inbound and outbound shipments and seize infringing products. Please see also the answer three questions above. It is also possible to apply for a seizure order from the High Court when it is known a shipment is about to enter Hong Kong.

What IP treaties is your jurisdiction a member of?

- WTO – TRIPS Agreement
- WIPO Performances and Phonograms Treaty
- WIPO Copyright Treaty
- Patent Cooperation Treaty
- Nice Agreement
- Paris Convention
- Berne Convention
- Geneva Convention
- Universal Copyright Convention

Further Reading

Guides:

- *IP Enforcement Guide: Hong Kong*

Articles:

- *“Made in Hong Kong” and false trade descriptions*
- *Changes are coming to the Hong Kong patent system*

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