

Introduction to New Patent System in Hong Kong

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The new patent system in Hong Kong has been formally launched on 19 December, 2019. In order to help readers better understand and use the patent system in Hong Kong, this article is aimed to make an introduction to the new patent system in Hong Kong.

I. Evolution of patent system in Hong Kong

Before the handover of Hong Kong from Britain to China, a patent could not be obtained directly from a Hong Kong application. If someone applies for a patent in Hong Kong within five years after obtaining a UK patent or a European patent with the UK as the designated country, the patent can be granted in Hong Kong.

After Hong Kong's return in 1997, pursuant to the Basic Law of the Hong Kong Special Administrative Region (HKSAR), Hong Kong established its own independent patent system. To this end, the Hong Kong legislature passed the Hong Kong Patents Ordinance and the Registered Designs Ordinance, which came into force on 27 June, 1997. As a result, Hong Kong has thus established an independent patent system consisting of the "re-registration" standard patent system and the short-term patent system.

After years of practice, the HKSAR government decided to reform its local patent system with reference to latest developments and trends of the China's patent system, in such an effort to adapt to the changes of external economic environment, enhance the competitiveness of Hong Kong, attract more enterprises to do scientific researches and business in Hong Kong, boost the advance of Hong Kong's innovative technologies, and promote Hong Kong to be an innovative technology hub and an Asia-Pacific intellectual property trade centre in the Guangdong-Hong Kong-Macao Greater Bay Area. Through eight-year preparation, the Patents (Amendment) Ordinance 2016 and the Patents

(General) (Amendment) Rules 2019 have been enacted with the effective date of 19 December, 2019 to provide the necessary legal framework for the new patent system. The Hong Kong Intellectual Property Department (HKIPD) also released the Patents Examination Guidelines for the new patent system.

II. New patent system in Hong Kong and its characteristics

The main features of the new patent system include introducing an original grant patent (OGP) system for standard patents, maintaining the "re-registration" system for standard patents, refining the existing short-term patent system and regulating patent agency services.?

OGP system for standard patents

The OGP system for obtaining a standard patent allows an applicant to file a patent application for invention directly in Hong Kong and obtain a standard patent granted by the HKIPD once the requirements of formality examination and substantive examination on the application are met. This is a newly introduced system for standard patents.

The examination procedure for OGPs basically includes determining the filing date, formality examination, publication, substantive examination, grant and issuance or rejection.

The protection term of an OGP can be as long as 20 years from the date of filing of an application.

An OGP has the following features:

1. The applicant is allowed to file a standard patent application directly with the HKIPD, that is, filing an application with one of the three designated patent offices, namely, China National Intellectual Property Administration (CNIPA), United Kingdom Patent Office (UKPO), and European Patent Office (EPO), is not a prerequisite for filing a standard patent application in Hong Kong. The new OGP system is

beneficial to applicants who do not file applications with the above three designated patent offices in that it offers a route for the applicants to seek standard patents in Hong Kong. Even for applicants who have filed applications with the three designated patent offices, it still provides an alternative route to obtain standard patents in Hong Kong.

2. The application procedure is flexible. For instance, one of the requirements for obtaining a date of filing in Hong Kong is the filing of a specification. If the applicant has already filed an earlier application, the applicant who intends to file an application for an OGP only needs to provide the information of the earlier application and state that the description and drawings (if any) of the OGP have been completely recorded in the earlier application, and the description and drawings in the official language can be submitted later.

3. Provisions concerning the claim for priority are relatively lenient. The applicant of an OGP can either restore or add the right of priority. If the applicant of an OGP misses the twelve-month deadline for claiming the benefit of priority, he may still file a request to restore the priority of an earlier application with the HKIPD within two months from the expiration of the twelve-month period. In addition, where an application for an OGP is filed within the twelve-month period, if the applicant fails to require the claim for priority in the declaration, he may require to add the right of priority within 16 months from the earliest priority date.

4. Similar to short-term patents, OGP applications can serve as the priority basis for applications filed under the Paris Convention. If the applicant files a patent application for the same subject matter in any country or region which has signed the Paris Convention or is a member state of World Trade Organization within twelve months from the date of first filing of the OGP application with the HKIPD, he is still entitled to a priority right.

5. Substantive examination is conducted by the HKIPD under the local laws in Hong Kong, and technically supported by the CNIPA.

The OGP system provides an alternative opportunity for applicants. In comparison with the “re-registration” patent system, the GOP system provides greater flexibility for applicants in terms of patent application procedure and more appropriate patent protection.

“Re-registration” system for standard patents

There are no substantive changes in the “re-registration” system for standard patents under the new patent sys-

tem, and it is renamed in order to be distinguishable from “the OGP system”. Under the re-registration system for standard patents, standard patents, which were firstly filed with one of the three designated patent offices, namely, CNIPA, UKPO, and EPO (UK as a designated country), are granted in Hong Kong by way of a two-step registration procedure.

The two steps for obtaining a standard patent under the re-registration system are listed as follows:

1. The applicant files a request to record an application with the HKIPD within six months from the publication of the firstly filed application by a designated patent office, and it will be recorded and published after it satisfies the requirement of formality examination;

2. The applicant files a request for patent registration and grant with the HKIPD within six months from the grant of patent by a designated patent office, and the patent will be registered and published after it satisfies the requirement of formality examination.

The protection term of a re-registration standard patent can be as long as 20 years from the date of filing of an application with the designated patent office.

A re-registration standard patent has the following features:

1. The applicant must firstly file a standard patent application with one of the three designated patent offices, rather than file it directly with the HKIPD.

2. The grant of patent mainly depends on the result of substantive examination conducted by the designated patent office under the law of the country or region where the designated patent office is located, and the HKIPD mainly conducts formality examination.

3. The re-registration system for standard patents guarantees the original rights of applicants who have filed patent applications with one of the three designated patent offices, and facilitates the filing of the same in Hong Kong.

Short-term patents

Short-term patents refer to simple invention patents with short-term commercial values that are directly filed with the HKIPD.

The short-term patent system is established to offer a fast way of protecting simple inventions with short-term commercial values and make the patent granted as soon as possible. The HKIPD will not conduct substantive examination of short-term patent applications prior to grant, and patent is granted as long as the application meets the requirement of formality examination. However, while filing a short-

term patent application, the applicant shall also submit a search report from a designated searching authority.

Although short-term patents are not subject to substantive examination before grant, in order to enforce a short-term patent, its owner must file a request for substantive examination of the patent with the HKIPD before any legal proceedings unless there is any court's judgement declaring the patent valid. Meanwhile, any person with justified reasons or for the sake of legitimate commercial interests may also file a request for substantive examination of the patent with the HKIPD for statutory reasons. After substantive examination, if the patent or the amended patent as required meets the relevant provisions, the HKIPD will issue a "substantive examination certificate" to it. Otherwise, the HKIPD will revoke the patent. Once the request for substantive examination is submitted, it cannot be revoked.

The substantive examination procedure of a short-term patent is approximately identical with that of an OGP application.

An owner of a short-term patent must, when threatening a person with legal proceedings relating to an unexamined short-term patent or a short-term patent for which the substantive examination certificate has been issued, provide that person with the adequate information to identify the patent upon request by that person, namely, the HK patent number of the patent and a copy of any unpublished amendment version.

If the person, who threatens others with legal proceedings concerning infringement of a short-term patent by way of announcement, notice or others, fails to provide the necessary short-term patent supporting documents (i.e. the substantive examination certificate or the materials relating to the patent), the threat shall be deemed as "unreasonable threat" in law, and the person under threat can seek for court assistance, including declaring that the threat is not fully justified, issuing an injunction to stop the threat from continuing to be made, and awarding damages for harms suffered by the threatened person as a result of the threat, if any.

The protection term of a short-term patent can be as long as 8 years from the date of filing.

The short-term patent has the following features:

1. An application may contain two independent claims, such that an applicant may be conferred with a broader scope of protection at a more cost effective approach.

2. The possible substantive examination procedures af-

ter grant can not only enhance the quality of short-term patents, but also reduce the number of "unreasonable threats" and abuse of judicial procedures by raising the threshold for legal proceedings initiated by the patent owner, and enhance the credibility of the system and maintain the overall cost effectiveness of seeking short-term patent protection in Hong Kong.

The three categories of patents complement each other well and constitute an overall protection system in the Hong Kong patent system, which attaches great importance to the overall cost effectiveness of patent protection so as to facilitate the application for patents and foster an ideal protection environment for innovative achievements. A comparative table showing main features of different types of patents is provided below.

	Standard patent (OGP)	Standard patent (re-registration)	Short-term patent
Subjects eligible for protection	Matters or activities except for exempted matters or activities (such as discoveries, scientific theories and theoretical methods)		
Features of subjects	General inventions with relatively long-term commercial values	General inventions with relatively long-term commercial values	Simple inventions with relatively short-term commercial values
Requirements for patentability	Novelty, inventiveness and industrial applicability		
Limit on the number of independent claims	Unlimited	Unlimited	Two independent claims at most
filing	Directly filed with the HKIPD	Filed first with designated patent offices (CNIPA, UKPO, and EPO (UK as a designated country)), and then with the HKIPD	Directly filed with the HKIPD
Formality examination	Required		
Substantive examination	Required	Not required, but the grant of a patent is premised on the grant by one of designated patent offices	(1) Not required for the grant of a patent; (2) The owner of a patent or a third party may request for substantive examination after the grant of the patent
Protection term	20 years	20 years	8 years

Regulating patent agency services

Before the implementation of the new patent system, Hong Kong has not set up a systematic regulatory regime for local patent practitioners. Generally speaking, anyone has the freedom to provide patent agency services in Hong Kong and practice under the title of a “patent agent” or “patent attorney”. In order to strengthen the regulation of local patent practitioners and prevent confusion among service users as a result of abuse of attractive titles, and meanwhile, in the long run, cultivate local patent professionals and pave the way for a comprehensive and systematic regulatory regime, the new patent system in Hong Kong has established an interim regulatory measure of prohibiting use of certain confusing or misleading titles and descriptions relating to patent practice in Hong Kong, requiring that a person commits an offence if he uses certain titles such as certified/registered patent agent, certified/registered patent attorney, or any other similar title or description that misleads people into believing that his qualification for patent agency services has been endorsed by the Government or recognized by law. However, a person is permitted to use a title obtained in a jurisdiction outside Hong Kong in a legal and reasonable way as long as the jurisdiction in which the qualification is obtained is clearly indicated.

III. Factors considered in launching a new patent system in Hong Kong

In order to facilitate readers’ understanding of Hong Kong’s new patent system and predict the development trend of the Hong Kong patent system, this article is going to make a brief introduction to the considerations and trade-offs for the revision of the patent system.

The Hong Kong Government has started preparations for the revision of the patent system as early as October 2011, and issued a consultation document to the public. At the same time, the Government appointed the Advisory Committee on Review of the Patent System in Hong Kong, composed of members from various circles in Hong Kong, to provide suggestions and opinions on the future development of the Hong Kong patent system. After comprehensively studying the opinions and related information collected through the public consultation, the Advisory Committee submitted a review report to the Government, recommending introducing an OGP system for standard patents, maintaining the “re-registration” system for standard patents, re-

fining the existing short-term patent system and regulating patent agency services. The recommendations of the Advisory Committee were fully adopted by the Government.

Regarding the introduction of the OGP system, the Advisory Committee has conducted researches on the global economic situation, international patent profile, *status quo* of Hong Kong, pros and cons of the “re-registration” system, benefits and difficulties of establishing an OGP system in Hong Kong, as well as the OGP system in other jurisdictions, based on which a suggestion of introducing the OGP system and maintaining the existing “re-registration” system was given from the perspective of long-term strategies of the future patent system in Hong Kong, as this will help Hong Kong become a world innovation and technology hub and keep it abreast with a majority of countries in the world in terms of the patent system.

As for the short-term patent system in Hong Kong, the Advisory Committee offered two optimization suggestions: first, substantive examination shall be requested before initiating infringement proceedings, which helps the court to decide the validity of a patent and is in line with the situation in mainland China, Australia, Denmark, Germany and Japan which also have short-term patents or utility model patents. Second, the maximum number of independent claims per application is relaxed to two instead of one, on condition that the two independent claims relate to a single inventive concept. This change makes sure that the claims of a short-term patent are not over-complicated and meanwhile provides flexibility for the short-term patent system.

As for the regulation of patent agency services, the Advisory Committee took account of costs and benefits, requirements of different patents for service quality, demand and supply of professionals, regulation of patent agency services at overseas jurisdictions, on the basis of the current regulation situations in Hong Kong and public opinions, suggesting the establishment of a comprehensive regulatory regime for patent agency services in the long run. However, it is currently appropriate to formulate an interim measure to allow only certified persons or agencies to use titles such as “patent agents” or “patent attorneys”.

Hong Kong has developed into an international financial and business centre. Although the service sector currently accounts for a large part of Hong Kong’s economy, the industrial sector still hopes to take full advantage of the opportunities brought by some Asian countries or regions serving as “world factories” to focus on various high value-

added activities, such as research and development, management of production bases located outside Hong Kong, design and innovation, and technology transfer. In short, the reform of Hong Kong's patent system is aimed to establish an OGP system, and maintain the "re-registration" system, optimize the short-term patent system and provide an interim regulatory measure for patent agency services for realizing the long-term goal of developing Hong Kong into an innovation and technology hub and intellectual property trade centre, promoting research and development, and cultivating Hong Kong's human capital in these areas.

IV. Conclusion

The new patent system in Hong Kong is just a start. With the implementation of the new patent system, the Government still has a lot to embark on, in particular enhancing its own examination capabilities at different stages in a progressive way. In addition, Hong Kong still has a long way to go in terms of subsequent right utilization and protection

from aspects like court construction, talent cultivation and experience accumulation. ■

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* This article represents only the personal views of its authors.

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