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Patent Filing Strategy in Hong Kong

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- U.S. patent attorney
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- B.Sc. Degree, first class honor (1981, HKU)
- Master degree in chemistry (1983, HKU)
- Ph.D. in chemistry (1987, University of Florida)
- Scientist at 3M company
- IP manager at Samsung Electronics
- Received more than 200 granted patents worldwide as a named inventor
- Assist clients in applying and prosecuting patent applications worldwide
- Conducting patent due diligence, patentability opinion, freedom-to-operate opinion, infringement or non-infringement opinion, invalidity or validity opinion, license agreement and other patent works
- Vice President of Hong Kong Institute of Patent Practitioners
- Vice President of Hong Kong Institute of Patent Attorneys

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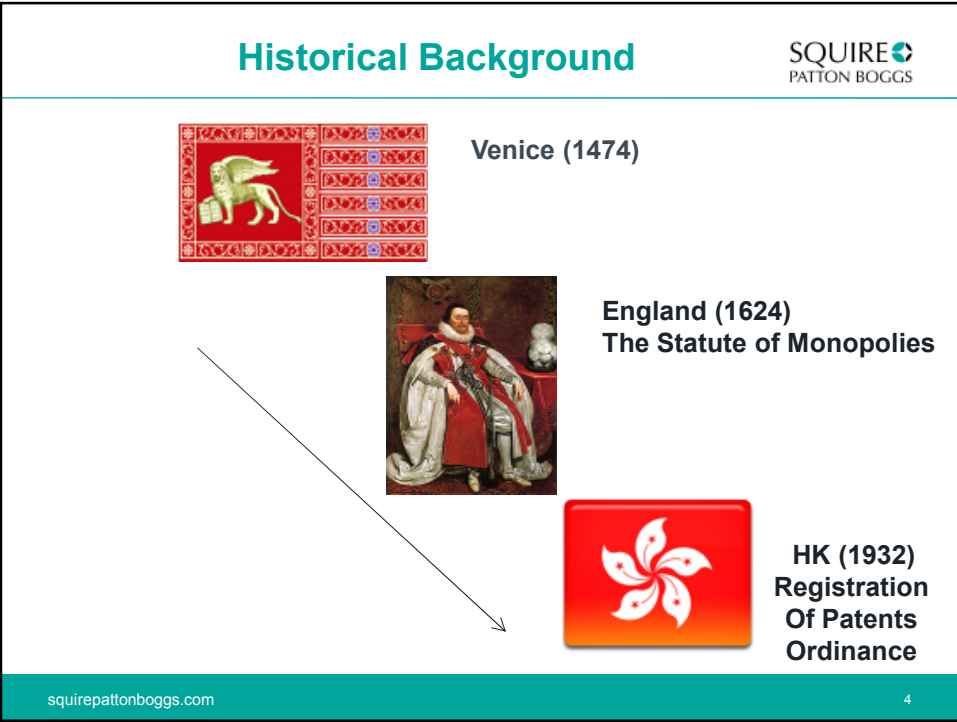
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TYPES OF PATENT SYSTEM

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1. Examination System

- has both formal and substantive examinations
- e.g., US and EP patents

2. Registration System

- has only formal examination and no substantive examination
- e.g., South Africa patent, utility model patents in CN, DE, JP

3. Re-registration System

- A re-registration system merely register patents, which are granted in one or more designated countries.
- HK, SG (until 1995), Malaysia (until 1983)

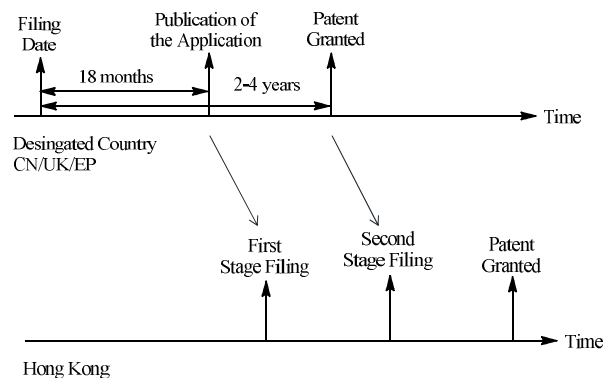
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TYPES OF PATENT SYSTEM

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3. Re-registration System



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Discouraging Effect of Re-Registration



WIPO Publication: "INTERNATIONAL PATENT SYSTEM: AN EMPIRICAL ANALYSIS"

(at page 20)

Re-registration Countries

While this system is not burdensome for foreign patentees, who just re-register those patents, which were granted elsewhere. It puts particular burden on domestic patent applicants. Domestic patentees who want to get patent protection for their inventions in their home country have to apply for a patent in a foreign country and once it is granted have to register that patent in their home country. Hence, re-registration system discourages domestic inventors in applying for a domestic patent.

Source: The publication can be downloaded at http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/study_b_dhar.pdf

Current HK Patent Systems



1. Standard Patent

- a re-registration system
- 20 year patent term

2. Short Term Patent

- a registration system
- 8 year patent term

Future HK Patent Systems



1. Original Grant Patent

- an examination system
- 20 year patent term

2. Standard Patent

- a re-registration system
- 20 year patent term

3. Short Term Patent

- a registration system
- 8 year patent term

Short-Term Patent v. Standard Patent



- Comparison of Short-Term Patent with Standard Patent

	Short Term Patent	Standard Patent
Patent term	8 years	20 years
Certainty in obtaining	Certain (No substantive Examination)	Not certain (designated patent application may be rejected)
Time required	4-12 months	2-4 years
No. of Independent Claim	Only 1	1 or more
Where to file first	Hong Kong	CN/UK/EP
Costs	Inexpensive	Expensive for HK entities
Subject Matter	All patentable subject matters	All patentable subject matters

Double Patenting

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1. Can we obtain both a short term patent and a standard patent for the same invention?
 2. Can we file two standard patent applications for the same invention?
 3. Can we file two short term patent applications for the same invention?
- May have double patenting issue.

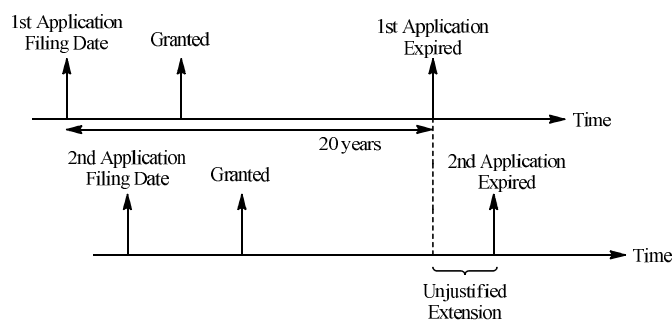
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Double Patenting

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- Double patenting is the granting of two patents for a single invention, to the same proprietor and in the same country.
- Double patenting is not allowed in most countries.
- The doctrine of double patenting seeks to prevent the unjustified extension of patent term beyond 20 years from filing date.



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Current Filing Strategy



1. Can we obtain both a short term patent and a standard patent for the same invention?
 - Section 91(1)(h) of Hong Kong Patents Ordinance (**HKPO**) allows the same patentee to own both a short-term patent and a standard patent for the same invention.

Current Filing Strategy



- Section 91. Power to revoke patents on application.
 - (1) the court may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds.....
 - (h) that
 - (i) the patent is one of 2 patents for the same invention, one such patent being a **standard patent** and the other being a **short-term patent**, the applications for which were filed by the same person and have the same deemed date of filing or date of filing; and
 - (ii) the 2 patents are **not** under the proprietorship of the same person.

Current Filing Strategy

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2. Can we file two standard patent applications for the same invention?
3. Can we file two short term patent applications for the same invention?
 - Yes, you can.
 - Section 91(1) of HKPO just says one of the patents can be revoked.

Current Filing Strategy

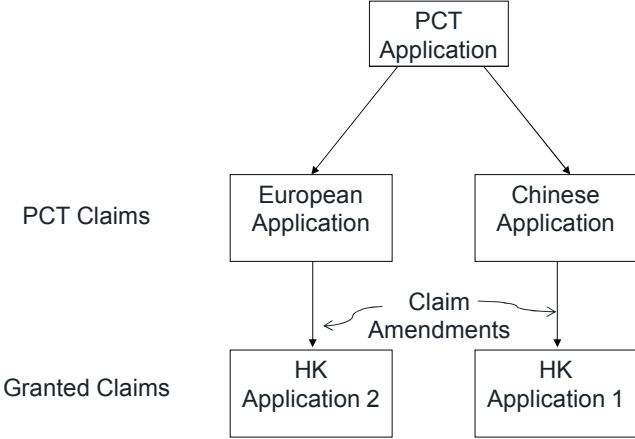
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- Section 91. Power to revoke patents on application.
 - (1) ... the court may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds.....
 - (f) that the patent is one of **2 standard patents** for the **same invention**, the applications for which were filed by the same person and have the same deemed date of filing;
 - (g) that the patent is one of **2 short-term patents** for the **same invention**, the applications for which were filed by the same person and have the same date of filing;

Current Filing Strategy



- Is there a risk of revocation of one of the standard patents?
- It depends.




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graph TD
    PCT[PCT Application] --> European[European Application]
    PCT --> Chinese[Chinese Application]
    European --> HK2[HK Application 2]
    Chinese --> HK1[HK Application 1]
    HK2 <--> |Claim Amendments| HK1
  
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Current Filing Strategy



- Claims can be amended differently in different designated countries.
- If the granted claims of the 2 designated patents have different scope, they are not the same invention under Sec. 76, HKPO.
- Section 76. Extent of invention
 - (1)(a) an invention in respect of which an application for a patent has been filed shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application, as interpreted by the description and any drawings contained in that specification;

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Current Filing Strategy

- Do you want to file 2 standard applications in HK for the same invention?
- Yes, if it is important to you.
- Reason:

The diagram illustrates the timeline for patent filings in two jurisdictions. For Designated Country X, the process starts with a Filing Date, followed by an 18-month period leading to the Publication of the Application. After a 2-4 year period, the Patent is Granted (marked with an X). For Hong Kong, the process starts with a Filing Date, followed by First Stage Filing, then Second Stage Filing, and finally Patent Granted (marked with an X).

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Current Filing Strategy

- If you have to select 1 designated patent, which one?
CN? EP/UK?

The flowchart shows the relationship between different patent applications. A PCT Application leads to both a European Application and a Chinese Application. The European Application leads to HK Application 2, and the Chinese Application leads to HK Application 1. The labels 'DISCLOSURE' and 'CLAIMS' are positioned on the left side of the diagram.

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Current Filing Strategy

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- Prosecution of a Chinese patent application is less predictable than in UK and EP.
- If the PCT is in English, there may be translation errors in the Chinese patent application.
- There is uncertainty in how will a HK court, which is used to UK case law, construe the scope of Chinese claims.
- It is recommended to select EP or UK as the designated country.

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Future Filing Strategies

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- 1. Original Grant Patent**
 - Recommended for Hong Kong entities
 - Protecting the home market
 - Avoid the risk of having patent disputes resolved in foreign jurisdictions
- 2. Standard Patent (Re-registration Patent)**
 - Recommended for foreign entities
 - Cheap and convenient
- 3. Short Term Patent**
 - Recommended for Hong Kong entities who traditionally use this system most

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Future Filing Strategies

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- Can you file revocation proceedings with HKIPD?
No.
- The validity of a standard patent can be challenged through proceedings at the Court of First Instance by filing an application to revoke (s.91) or by way of counterclaim during infringement proceedings.
- Alternatively, you can try to revoke the corresponding designated patent in the designated office under **s.91(1)(i), HKPO**.

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Conclusions

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1. You can obtain both a short term patent and a standard patent for the same invention in Hong Kong.
2. You can file two standard patent applications based on 2 designated patents for the same invention if the invention is important to you. Furthermore, there may be no double patenting if the claims of 2 designated patents are different.
3. If you file only one standard patent application, select UK or EP as the designated country.
4. Hong Kong entities should consider using the OGP system when it is available in the future.
5. Foreign entities should continue to use the re-registration system if it is available in the future.

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Q & A SESSIONS



Thank You!



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