



Hong Kong Patent Law Reform: A Half-Fought Battle

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Intellectual Property Department





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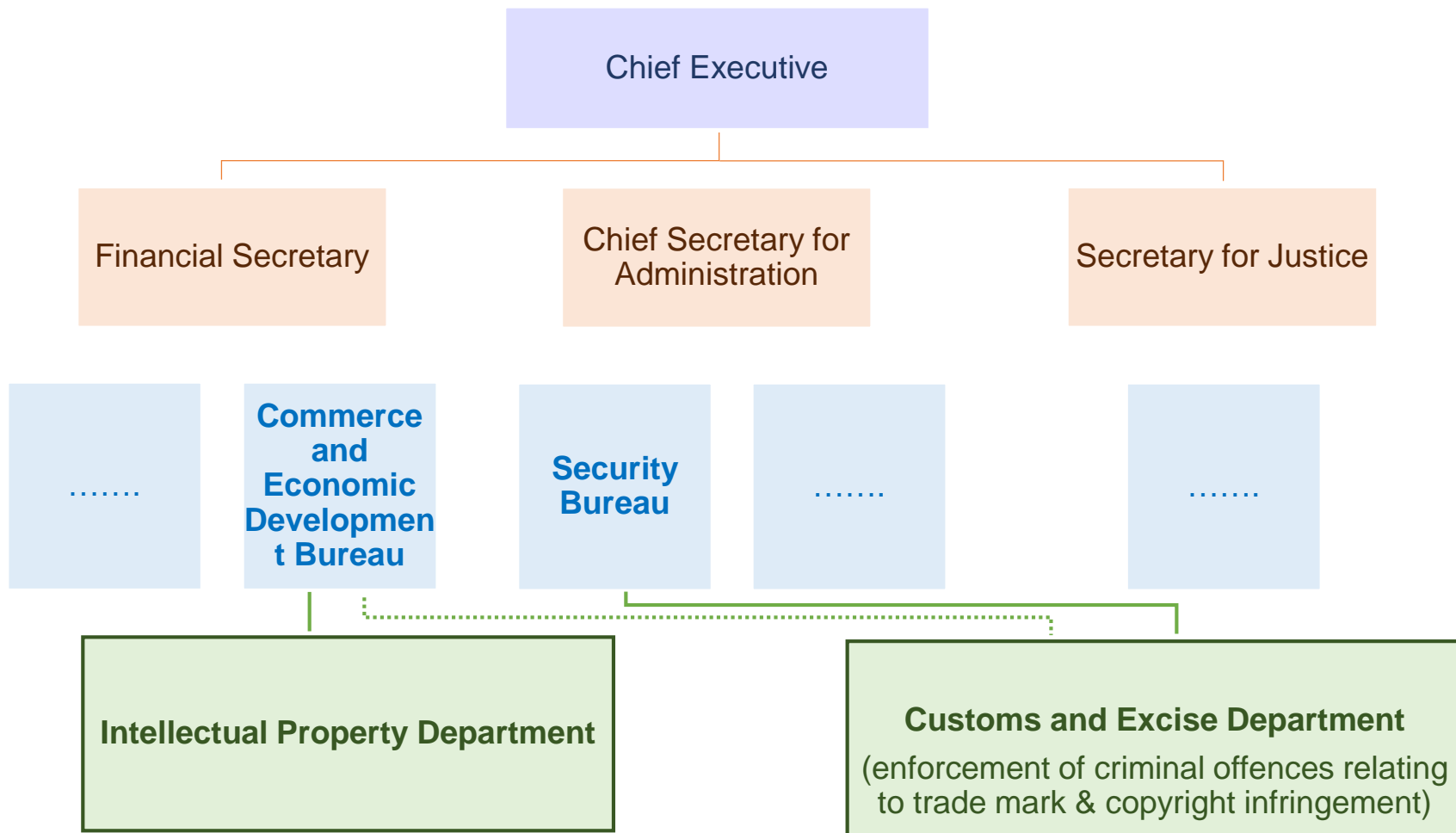


Who is in charge of the New Patent System in Hong Kong

Intellectual Property Department



Departments Responsible for Intellectual Property Protection in Hong Kong



Intellectual Property Department





IPD's Role and Functions

Established on 2 July 1990

Role and Functions

Registrar of
Trade Marks, Patents,
Designs and
Copyright Licensing
Bodies

Government IP Legal
and Policy Advisor

IP Promotion and Public
Education

Intellectual Property Department





IPD's Mission Statement

To maintain the protection of intellectual property rights to the highest international standards, so that Hong Kong, China remains a place where creativity and talent can flourish.

To provide high-quality and responsive patent, trademark and designs registration services to the public in Hong Kong, China.

To promote awareness of intellectual property rights of the individual, and a respect for the rights of others.

IPD – Organisation Chart

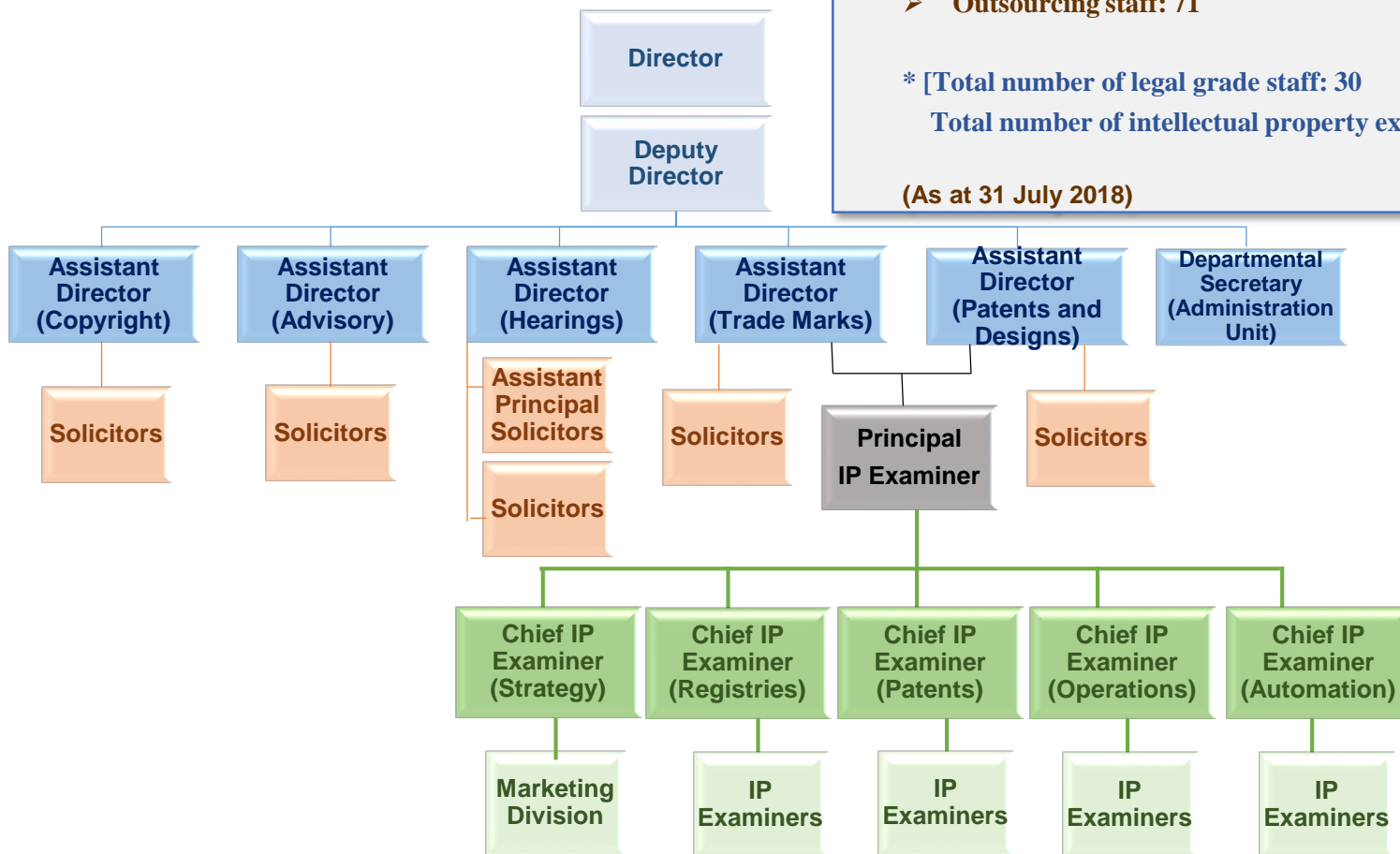
Total number of staff: 250 [*]

- Civil service staff: 157
- Contract staff: 22
- Outsourcing staff: 71

* [Total number of legal grade staff: 30

Total number of intellectual property examiner grade staff: 92]

(As at 31 July 2018)





Implementation of the New Patent System in Hong Kong

Intellectual Property Department





Current Patent System (1)

- Patents Ordinance (Cap. 514)
- Subsidiary legislation
 - Patents (Designation of Patent Offices) Notices (Cap. 514A)
 - Patents (Transitional Arrangements) Rules (Cap. 514B)
 - Patents (General) Rules (Cap. 514C)



Current Patent System (2)

	Standard Patent	Short-term Patent
Maximum Protection Term	20 years	8 years
Pre-application/ registration	First applied/registered in SIPO/UKIPO/EPO(UK)	Not required
Formality Examination	Conducted by IPD	Conducted by IPD
Substantive Examination	Conducted by the corresponding designated patent office	Not required



Current Patent System (3)

- Standard Patent
 - 1st Stage : file a request to record in HK within 6 months after publication of the designated patent application in the designated patent office
 - 2nd Stage : file a request for registration and grant in HK within 6 months after -
 - publication of the request to record in HK; or
 - the grant of the designated patent by the designated patent office, whichever is later



Current Patent System (4)

- Short-Term Patent
 - Limited to one independent claim
 - Search report in relation to the invention
 - Proprietor to establish the validity of the patent in enforcement proceedings before the court

Current Patent System (5)

Year	Total number of patent applications*			Total number of patent grants*		
	Standard patent	Short-term patent	Total	Standard patent	Short-term patent	Total
2013	13,916 *(226)	552 *(312)	14,468 *(538)	6,564 *(92)	538 *(330)	7,102 *(422)
2014	12,544 *(192)	587 *(360)	13,131 *(552)	5,932 *(88)	522 *(284)	6,454 *(372)
2015	12,212 *(239)	702 *(439)	12,914 *(678)	5,963 *(96)	495 *(272)	6,458 *(368)
2016	14,092 *(233)	762 *(483)	14,854 *(716)	5,698 *(78)	485 *(275)	6,183 *(353)
2017	13,299 *(324)	693 *(483)	13,992 *(807)	6,671 *(96)	582 *(369)	7,253 *(465)

* (Statistics for applicants/proprietors of the Hong Kong origin)



Patents (Amendment) Ordinance 2016

I. Original Grant Patent (OGP) System

- Enabling direct filing of standard patent application in HK without prior applications at any designated patent office
- Requiring both formality and substantive examinations
 - Procedural framework provided in the *2016 Ordinance* to be supplemented in the *Patents (General) Rules* currently under amendment
- Enlisting SIPO to provide technical assistance in and support to conducting substantive examination and manpower training at the beginning pending establishment of indigenous capacity
- Maintaining the “re-registration” system



Patents (Amendment) Ordinance 2016

II. Refinement of Short Term Patent (STP) System

- Relaxing the maximum number of independent claims in a STP application from 1 to 2
- Substantive examination after grant:
 - STP proprietor or any other party having a legitimate interest can apply to the Registry for substantive examination of the patent
 - Request for substantive examination of an unexamined STP is a prerequisite to commencement of enforcement action
- STP proprietor, when making a threat of infringement proceedings against a person, should furnish with that person the basic patent information
 - Otherwise, the threat may be regarded as groundless and a party aggrieved by the threat may be entitled to seek relief



Patents (Amendment) Ordinance 2016

III. Regulating Patent Practitioners – Interim Measures (1)

- Prohibition on use of certain titles or descriptions
 - (a) certified patent agent/attorney;
 - (b) registered patent agent/attorney;
 - (c) a title/description reasonably causing anyone to believe the person using or permitted to use such title/ description holds a qualification that –
 - (i) is specifically granted for approving that person to provide patent agency services in Hong Kong; and
 - (ii) is recognized by law or endorsed by the Government



Patents (Amendment) Ordinance 2016

III. Regulating Patent Practitioners – Interim Measures (2)

- Exception
 - permit use of title or description that solely relates to the person's qualification for providing patent agency services in a jurisdiction outside Hong Kong
 - as long as the use clearly indicates the jurisdiction in question



Future Patent System

	Standard Patent (re-registration)	Standard Patent (OGP)	Short-term Patent
Protection Term	20 years	20 years	8 years
Pre-application/ registration	First applied/registered in SIPO/UKIPO/EPO(UK)	Not required	Not required
Formality Examination	Conducted by IPD	Conducted by IPD	Conducted by IPD
Substantive Examination	Conducted by corresponding designated patent office	Enlisting SIPO for technical assistance at the initial stage	Not required (save post-grant (a) for commencing enforcement action; or (b) upon request of interested/legitimate third parties)



Future Patent System

What's Next? (1)

To amend the subsidiary legislation, particularly to provide for procedural framework for grant of patents under the OGP system and post-grant substantive examination of STPs

To draw up examination guidelines and design workflows in processing patent cases before the Registrar

To train patent examiners with technical credentials for processing cases

To set up new IT system for receiving and processing cases

To engage stakeholders to keep them posted on progress and seek their views and inputs



Future Patent System

What's Next? (2)

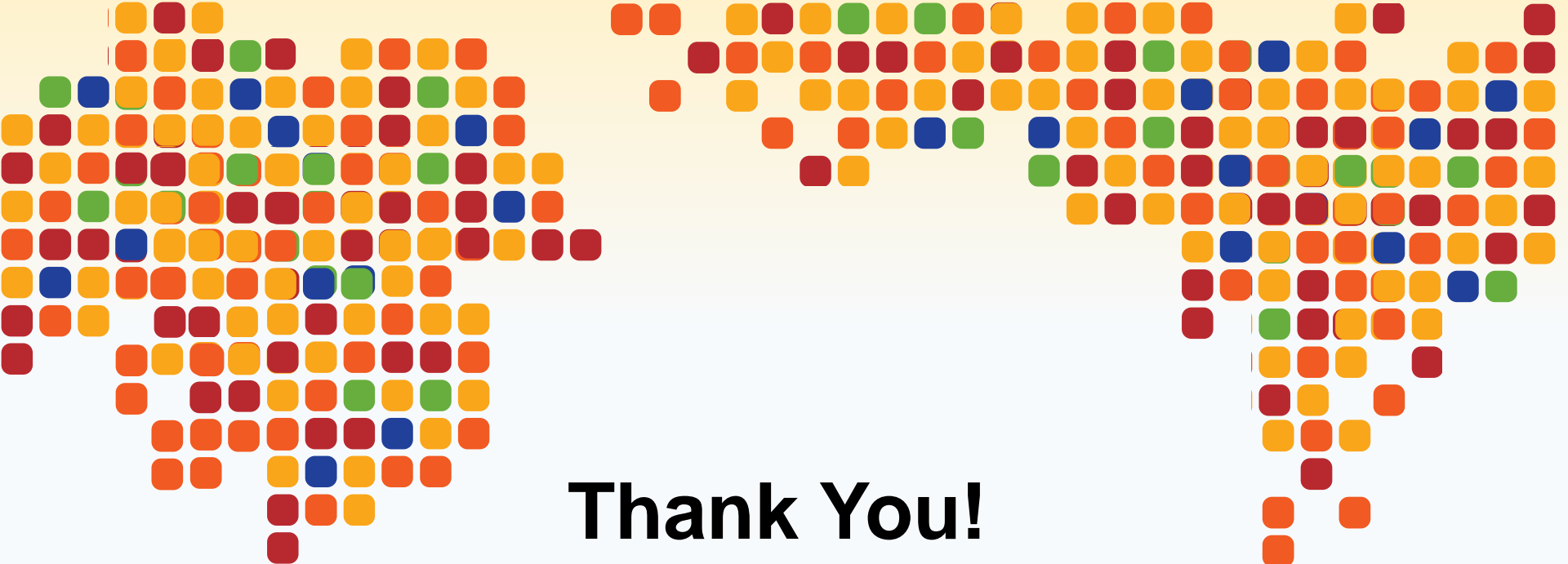
To draw up publicity plans to promote the new patent system

To explore cooperation with other patent authorities, e.g. initiating discussions for bilateral and plurilateral Patent Prosecution Highways (PPHs)

To develop incrementally in-house capacity in conducting indigenous substantive examination

To establish a full-fledged regulatory regime for local patent practitioners in medium and long term

To conduct regular reviews of patent law and operation of the new patent system, and introduce further legislative amendments when required



Thank You!



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

For more information, please visit:
IPD Website – www.ipd.gov.hk