

# Overview of the Patent System in Hong Kong and the Patents (Amendment) Bill 2015

**August 5, 2016**



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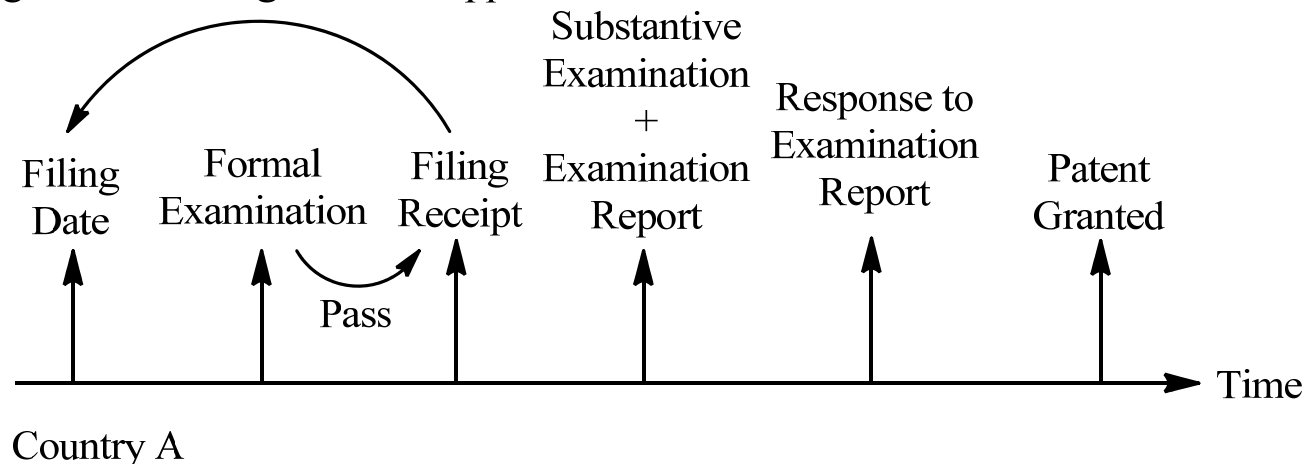
1. Types of Patent Systems
2. HK Patent Systems
3. Patents (Amendment) Bill  
2015

# TYPES OF PATENT SYSTEM

## 1. Examination System ( 審査制度 )

- has formal and substantive examinations of patents. E.g., US, EP & CN patents
  - » patentability criteria are patentable subject matter, novelty, inventive step and industrial applicability

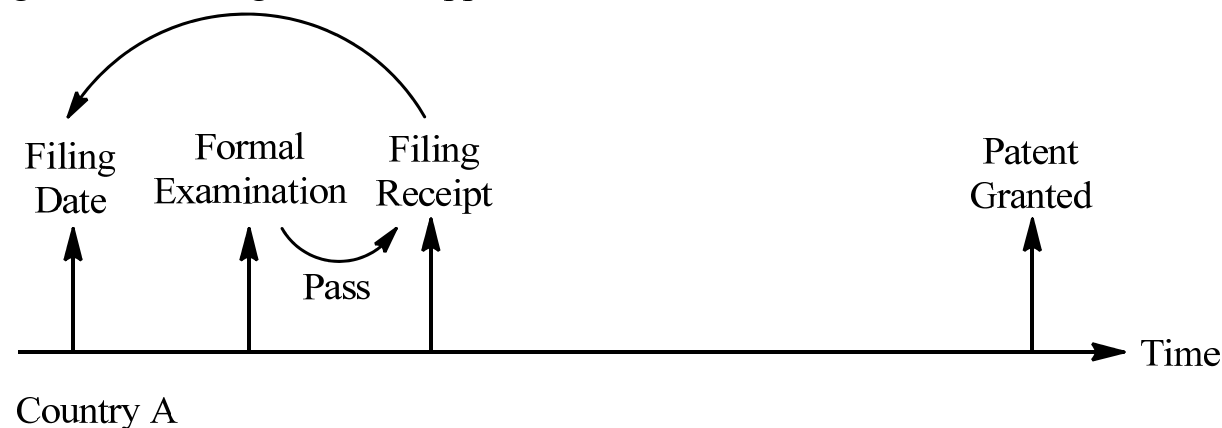
designates this filing date + an application no.



## 2. Registration System ( 註冊制度 )

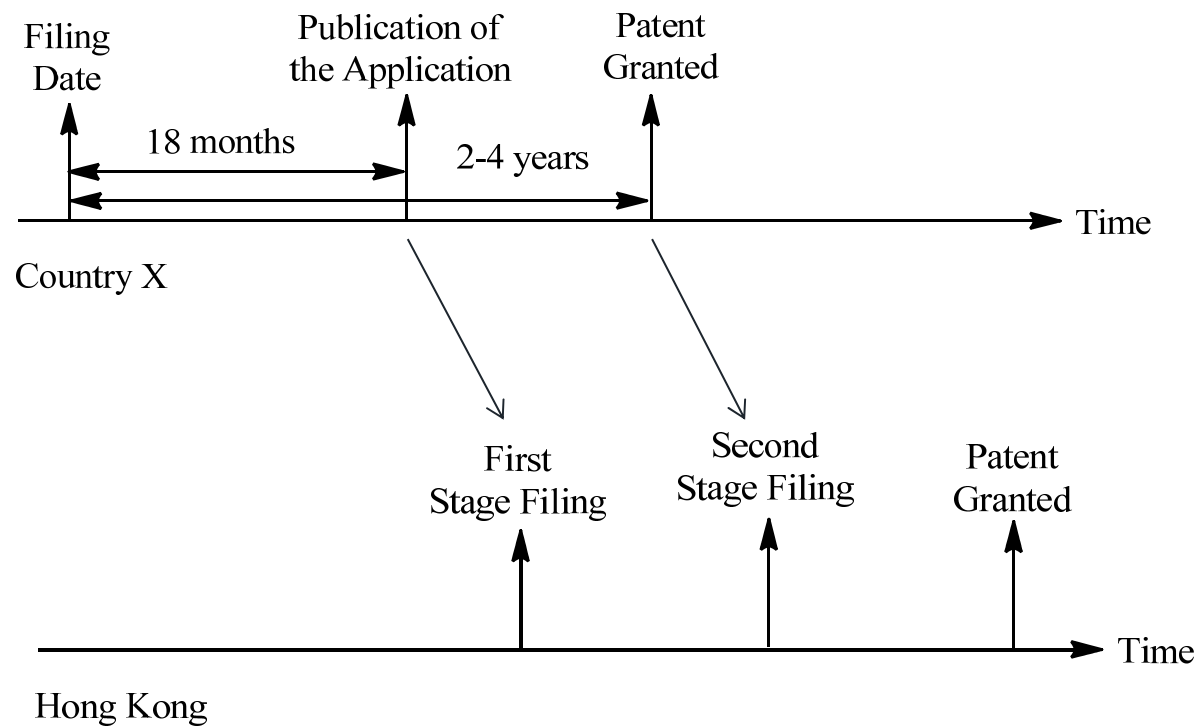
- has no substantive examination
- has only formal examination
- e.g., South Africa patent; utility model patents of CN, DE & JP; HK Short Term Pat.

designates this filing date + an application no.



# TYPES OF PATENT SYSTEM

## 3. Re-registration System



Country X = EP, UK, CN

## 3. Re-registration System ( 再注册制度 )

- A re-registration system merely register patents, which are granted in some other designated country.
- 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.
- Hong Kong (currently the only one), Singapore (until 1995), Malaysia (until 1983)

# 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 was downloaded on December 6, 2013 at [http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/study\\_b\\_dhar.pdf](http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/study_b_dhar.pdf)

## Re-registration Countries (Continued)

The argument that re-registration discourages domestic applicants can be illustrated by the proportion of domestic patent applications in total patent applications.

This proportion is

**1.79 percent for Hong Kong** and

**0.88 percent for Singapore**

**for the years 1975-98.**

*Source:* The publication was downloaded on December 6, 2013 at  
[http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/study\\_b\\_dhar.pdf](http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/study_b_dhar.pdf)



# HK Patents Ordinance

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1. 1932-1997
  - » Registration Of Patents Ordinance
2. 1997- present
  - » Patents Ordinance
3. Future (2018)

## 1. Standard Patent

- a re-registration system
- 20 year patent term

## 2. Short Term Patent

- a registration system
- 8 year patent term

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## 1. Standard Patent by Original Grant

- an examination system
- 20 year patent term

## 2. Standard Patent by re-registration

- a re-registration system
- 20 year patent term

## 3. Short Term Patent

- a registration system
- 8 year patent term

## Reform – Overview

- On Feb 28, 2011, a public forum was held by the IPD to discuss whether there is a need to reform the current patent system. The forum was participated by 170 representatives from legal, patent, research and development, academic and industrial sectors.
- In Oct 2011, a Consultation Paper entitled “Review of the Patent System in HK” was issued.
- At the same time, The Secretary for Commerce and Economic Development has appointed an Advisory Committee on Review of the Patent System in HK.

## Reform – Overview

- In Dec 2012, a report was submitted by the Committee to the Administration.
- On Feb 7, 2013, a Report of The Advisory Committee on Review of the Patent System in HK was issued.
- On March 20, 2013, the IPD has issued a Consultation on the Regulation of Patent Agency Services in HK.
- On June 2, 2016, the LegCo overwhelmingly passed the third reading of the Bill.

## Reform – Standard Patents (O)

- Introduction of the original grant patent (“OGP”) to Hong Kong with substantive examination (an examination system).
- Initially, the examination will be outsourced to the Chinese State Intellectual Property Office (“SIPO”) but ultimately done by HKIPD).
- SIPO has also agreed to train HK examiners so that they will eventually have the capability of conducting substantive examination.

## Reform – Short-Term Patents

- The short-term patent system will be retained with refinements.
  1. must contain one or more claims but not exceeding 2 independent claims.
  2. any other person (in addition to the proprietor) may request the Registrar to carry out substantive examination if the person satisfies the Registrar that there are reasonable grounds to suspect that the invention is not patentable or “because of the person’s legitimate business interests, it would be reasonable for the examination to be carried out.”

## Reform – Short-Term Patents

3. If the Registrar finds that the short-term patent is deficient, written notice setting out each noncompliance with examination requirement will be given to the proprietor and the proprietor may respond by amending specifications to enable the patent to comply with requirements.
4. Where the proprietor is unable to comply, the Registrar must revoke the short-term patent. Where the Registrar is of the view that the patent complies with requirements, the Registrar shall issue a “certificate of substantive examination” to the proprietor.



## Reform – Short-Term Patents

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5. A proprietor cannot commence enforcement proceedings before a court unless a certificate of substantive examination has been issued .

- Under **section 140(4)** of the Ordinance, the Registrar of Patents shall refuse to recognize as an agent a person who neither resides nor has a place of business in HK.
- Under **section 85(7)** of Patent (General) Rules, the Registrar may refuse to recognize the capacity of a person to act as an agent in certain circumstance e.g. being convicted of a criminal offence.
- **Any person who is residing in HK and has a place of business in HK** can practice as a patent agent or patent attorney unless disqualified under section 85(7) above.

- Use of certain titles and descriptions is prohibited
  1. certified patent agent/ attorney;
  2. registered patent agent/ attorney; or
  3. a title that gives the impression that a person holds a qualification recognized by law or endorsed by the Hong Kong government for providing patent agency services in Hong Kong.

## Regulation of Patent Agency Services

- A person holding such qualification in another jurisdiction may use such title or description so long as the jurisdiction of qualification is clearly stated, e.g. US Patent Attorney.
- Qualified legal professionals such as solicitors, barristers or registered foreign lawyers may provide patent agency services under their title as qualified legal professionals.

- **Possible interim measures:**
- It is necessary for the early building and recognition of a regulated patent agency profession in HK through increasing the awareness of users of the relevant qualifications and experience of patent attorneys/ agents.
  1. As a first step, the IPD should draw up and publish a list of patent attorneys/ agents – “Listed Patent Attorneys/ Agents” with their qualifications to the public.

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2. **“Listed Patent Attorneys/ Agents”** should possess the relevant professional qualifications and experience.
- For professional qualifications, the applicant should be a qualified member of a future professional association(s) for qualification.
  - For working experience, the applicant should possess a predetermined years of continuous working experience in patent practice.

- In order to support the OGP system in HK, it is necessary to build up a local team of **patent attorneys** and/or **patent agents**.

- Existing local professional bodies (HK Institute of Patent Attorneys, HK Institute of Patent Practitioners, Asian Patent Attorneys Association Hong Kong Branch and The Law Society of Hong Kong) will cooperate in establishing:
  1. a unified examination and/or training programs of the patent agency profession should be formulated.
  2. Grandfathering arrangement for existing service providers is required. Reference can be made to the former arrangement of “Listed Chinese Medicine Practitioners” and “Registered Chinese Medicine Practitioners”.



## Thank You!



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