

Patent Protection in Hong Kong

What is a patent?

A patent gives the inventor an exclusive right to use his invention. An invention which is new and involves an inventive step can be patented in Hong Kong by registration as long as it is susceptible of industrial application and does not belong to the excluded classes of inventions. A patent protects your invention by giving you, the patent owner, a legal right to prevent others from manufacturing, using, selling or importing your patented invention.

Territorial protection of registered patents

The patent registration system of Hong Kong provides territorial protection. Hence, patents registered with the State Intellectual Property Office of the People's Republic of China or patents registries of other countries or regions do not automatically receive protection in Hong Kong. In order to obtain protection as registered patents in Hong Kong, patents must be registered under the Patents Ordinance (Chapter 514) and the Patents (General) Rules (Chapter 514C) of Hong Kong.

Why register a patent?

If you are granted a patent, you will have the exclusive right to use the invention. If other people use it in the course of trade or business in Hong Kong without your consent, they may be liable for infringement of your patent and you may take legal action against him.

Standard and short-term patents

There are two types of patents in Hong Kong:

- standard and
- short-term

The period of protection of a standard patent can be renewed annually after the end of the third year, up to maximum term of 20 years. Protection under a short-term patent is renewable after the end of the fourth year, up to a maximum term of eight years.

Filing your patent application

You should complete the appropriate application form and fill in an address for service in Hong Kong and send it to the Patents Registry (the "Registry") of the Intellectual Property

Department (IPD) of the Government of the Hong Kong Special Administrative Region (HKSAR). Application for a standard patent is divided into two stages. The application fee for each stage includes a filing fee of HK\$380 and an advertisement fee of HK\$68. As for short-term patent applications, you need to pay a filing fee of HK\$755 and an advertisement fee of HK\$68. For details on application forms and fees, please refer to the website of the IPD of the HKSAR Government at http://www.ipd.gov.hk/eng/forms_fees/patents.htm.

Applying for a standard patent

The grant of a standard patent in Hong Kong is based on the registration of a patent granted by one of three patent offices, called “designated patent offices”:

- the State Intellectual Property Office, People's Republic of China,
- the European Patent Office, in respect of a patent designating the United Kingdom,
- the United Kingdom Patent Office.

A standard patent application is made in two stages by filing a **request to record** and a **request for registration and grant**. The applicant should file in Hong Kong:

- a **request to record within six months** after the date of publication of the patent application (“designated patent application”) in the designated patent office; and
- a **request for registration and grant within 6 months** after the date of grant of the patent (“designated patent”) by the designated patent office or publication of the request to record by the Registry of the IPD of the HKSAR Government, whichever is the later.

Applying for a short-term patent

The grant of a short-term patent in Hong Kong is based on a search report from an international searching authority or one of three designated patent offices. A short-term patent application in Hong Kong is made by filing a request for grant of short-term patent supported by the documents and information required. For details of the relevant documents and information, you may refer to the website of the IPD of the HKSAR Government at http://www.ipd.gov.hk/eng/intellectual_property/patents/how_to_apply.htm.

What happens to an application for registration of a patent after it is filed with the Registry?

The process of examining an application for a patent is divided into the following stages:

- examination of the filing date,
- formality examination,
- publication of the patent application or grant of patent, and issue of certificate of grant of patent (only applicable to request for registration and grant of standard patent and application for short-term patent).

Standard patent application – request to record

If there is no deficiency in your application and all requirements are met, the whole process may take within three months from the date of receipt of the request to record to its publication by the Registry.

Standard patent application – request for registration and grant

If there is no deficiency in your application and all requirements are met, the whole process may take within three months from the date of receipt of the request for registration and grant to the issue of the certificate of grant of patent by the Registry.

Short-term patent application

If there is no deficiency in your application and all requirements are met, the whole process may take within three months from the date of receipt of the short-term patent application to the issue of the certificate of grant of patent by the Registry.

The first stage – examination of the filing date

Shortly after receiving the application, the Registry will send a notice to the applicant, giving the filing date of the application.

Standard patent application – request to record: filing date

The Registry will accord a filing date to the request to record provided that the request states the name of the applicant, specifies the designated patent application and includes the designated patent application number, its publication number and date of publication.

Standard patent application – request for registration and grant: filing date

The Registry will accord a filing date to the request for registration and grant provided that the request identifies the applicant, specifies the designated patent and includes the publication number of the request to record, the publication number of the designated patent and its date of publication.

Short-term patent application: filing date

The Registry will accord the short-term patent application a filing date provided that it states the name of the applicant and a description of the invention is provided.

The second stage – formality examination

After giving the filing date to the applicant, the Registry will examine the formalities of the application. The formalities are the information required in the application form and the supporting documents. There is no substantive examination of the application (e.g. the novelty and inventiveness of the invention) and the Registry does not search records of prior registered patents.

If the application is not in order, the Registry will give notice to the applicant to correct the deficiencies within two months. Failure to correct deficiencies may result in the application being deemed withdrawn.

The third stage – publication and grant

If an application is in order, the Registry will publish the patent application or grant a patent, publish the patent application or advertise the grant by notice in the Hong Kong Intellectual Property Journal (http://www.ipd.gov.hk/eng/ip_journal.htm) and issue a certificate of grant of patent (only applicable to requests for registration and grant of standard patent and application for short-term patent).

Usually a certificate of grant of patent can be issued within three months after an application is filed (only applicable to request for registration and grant and application for short-term patent). The proprietor of a patent can bring civil proceedings against infringements committed after the certificate of grant of patent is issued.

Recommendation - What strategies should you adopt to protect your patent in Hong Kong and separately in Mainland China?

You may consider adopting the following strategies to protect your patent:

- Only the proprietor of a patent is entitled to register a patent for an invention. A person may obtain ownership of a patent and become its proprietor by commissioning the creation of an invention, employing somebody under a contract to create an invention or assignment of a patent, etc.
- Only new inventions are registrable. You need to keep your invention confidential until you file your corresponding designated patent application and short-term application. Using your invention in manufacturing or publishing or disclosing it (for example publishing it in a catalogue or placing an order to manufacture the invented product) before filing your patent application may mean that even if you are granted a patent for your invention, the registration may become invalid because your invention was not considered new on the date of filing the application date.
- It is only in limited circumstances that disclosure does not destroy the novelty of an invention. Sections 95 and 109 of the Patents Ordinance of Hong Kong provide for the specific circumstances of and requirements for non-prejudicial disclosure. If you need to disclose details of your invention before filing an application, you should take professional advice to ensure that the novelty of your invention would not be destroyed upon disclosure.
- You should register your patent separately in the two places in Hong Kong and in the Mainland, as there are separate systems of registration and protection. **Registering your patent in the Mainland does not automatically give you protection in Hong Kong.**
- You should apply for a patent for your invention as soon as possible to ensure that it is available for use in your business and that you can take immediate action against any infringement.
- You may consider taking legal action under the Patents Ordinance of Hong Kong in case of any infringement of your patent rights in Hong Kong.

- Most importantly, you should seek professional advice from an intellectual property lawyer or agent with regard to all aspects of your intellectual property rights, including trademark, copyright, registered design or patent.

Online search

The IPD provides a free online search service at <http://ipsearch.ipd.gov.hk>, through which you may check information on registered patents, published patent applications and proprietors of patents.

E-filing services

To file patent forms via the IPD's E-filing System, you need to register as a user of electronic services with the IPD first. Every user of electronic services must provide an address for service in Hong Kong and possess an electronic certificate issued by a recognized certificate authority. For information on e-filing services, please refer to the IPD's website at <https://iponline.ipd.gov.hk>.

Relevant websites

- Details on application forms and fees:
http://www.ipd.gov.hk/eng/forms_fees/patents.htm
- Details on the relevant documents and information:
http://www.ipd.gov.hk/eng/intellectual_property/patents/how_to_apply.htm
- Hong Kong Intellectual Property Journal:
http://www.ipd.gov.hk/eng/ip_journal.htm
- Online search service:
<http://ipsearch.ipd.gov.hk>
- E-filing services:
<https://iponline.ipd.gov.hk>.

Further Information

If you require help or more information, please contact the Patents Registry at:

Intellectual Property Department

24/F, Wu Chung House

213 Queen's Road East

Wanchai

Hong Kong

Telephone No.: (852) 2961 6901

Alternatively you may wish to email to enquiry@ipd.gov.hk

or visit our website at <http://www.ipd.gov.hk/>

Intellectual Property Department

Government of the Hong Kong Special Administrative Region

September 2006

© Hong Kong Special Administrative Region Government 2006

Important Notice

This publication only gives a brief introduction to patent protection in Hong Kong. It does not seek to be exhaustive and is not meant to give legal advice. For legal advice on patent protection, please seek professional opinions from an intellectual property lawyer or agent.

All Rights Reserved

This publication may be copied, distributed or exhibited in any form for non-commercial use without the prior permission of the Government of the Hong Kong Special Administrative Region provided that the following notice appears in the work:

<p>“This material is taken from “Patent Protection in Hong Kong” © 2006 and is used with the permission of the Government of the Hong Kong Special Administrative Region.”</p>
--