



Intellectual Property Department
The Government of the Hong Kong
Special Administrative Region

Briefing Session about the New Patent System in Hong Kong

Leslie Shay

Senior Solicitor

Intellectual Property Department, HKSAR Government

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- Short-Term Patent

Preparation for new patent system



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The Patent Laws of Hong Kong

Principal legislation

- *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)



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Current Patent System in Hong Kong

	Standard Patent	Short-term Patent
Maximum Protection Term	20 years	8 years
Pre-application/grant	First applied/registered in a designated patent office [CNIPA/UKIPO/EPO(UK)]	Not required
No. of Claims per application	Unlimited	1 independent claim
Formality Examination	Conducted by Patents Registry	Conducted by Patent Registry
Substantive Examination	Conducted by designated patent office	Not required



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Current Patent System – Standard Patent

Standard Patent Application (Re-registration)

- **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



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Current Patent System – Short-Term Patent

Short-Term Patent Application

- 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



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Review of Local Patent System

Timeline	
Oct 2011	Advisory Committee on Review of the Patent System in Hong Kong (“AC”) appointed
Oct-Dec 2011	Public Consultation
Dec 2012	AC submitted its recommendations: (i) introducing an OGP system with substantive examination; (ii) retaining re-registration system for grant of standard patents; (iii) refining short-term patent system; and (iv) developing in stages a regulatory regime on patent agency services in the long run
Feb 2013	Government accepted AC’s recommendations



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Implementation of New Patent System (Effective 19 December 2019)

Timeline	
Dec 2013	<ul style="list-style-type: none">Co-operation arrangement in the area of patent signed between Mainland and Hong Kong
Jun 2016	<ul style="list-style-type: none">Enactment of the Patents (Amendment) Ordinance 2016 (to be brought into force on December 19, 2019)
Jun 2017	<ul style="list-style-type: none">Co-operation arrangement in the area of intellectual property signed between Mainland and Hong Kong
Mar 2019	<ul style="list-style-type: none">Making of the Patents (General)(Amendment) Rules 2019 (to be brought into force on December 19, 2019)



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Patents (Amendment) Ordinance 2016 (1)

OGP System

- Direct filing of standard patent applications in Hong Kong without prior applications at any designated patent office outside HK
- Formality + **Substantive** examination



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Patents (Amendment) Ordinance 2016 (2)

Refinement of Short-Term Patent System

- Substantive examination after grant
 - STP proprietor or any other party having a legitimate interest may request
 - Such request is a prerequisite to commencement of enforcement action for an unexamined patent
- 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
- Relaxing the maximum number of independent claim per application: 1 → 2



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Patents (Amendment) Ordinance 2016 (3)

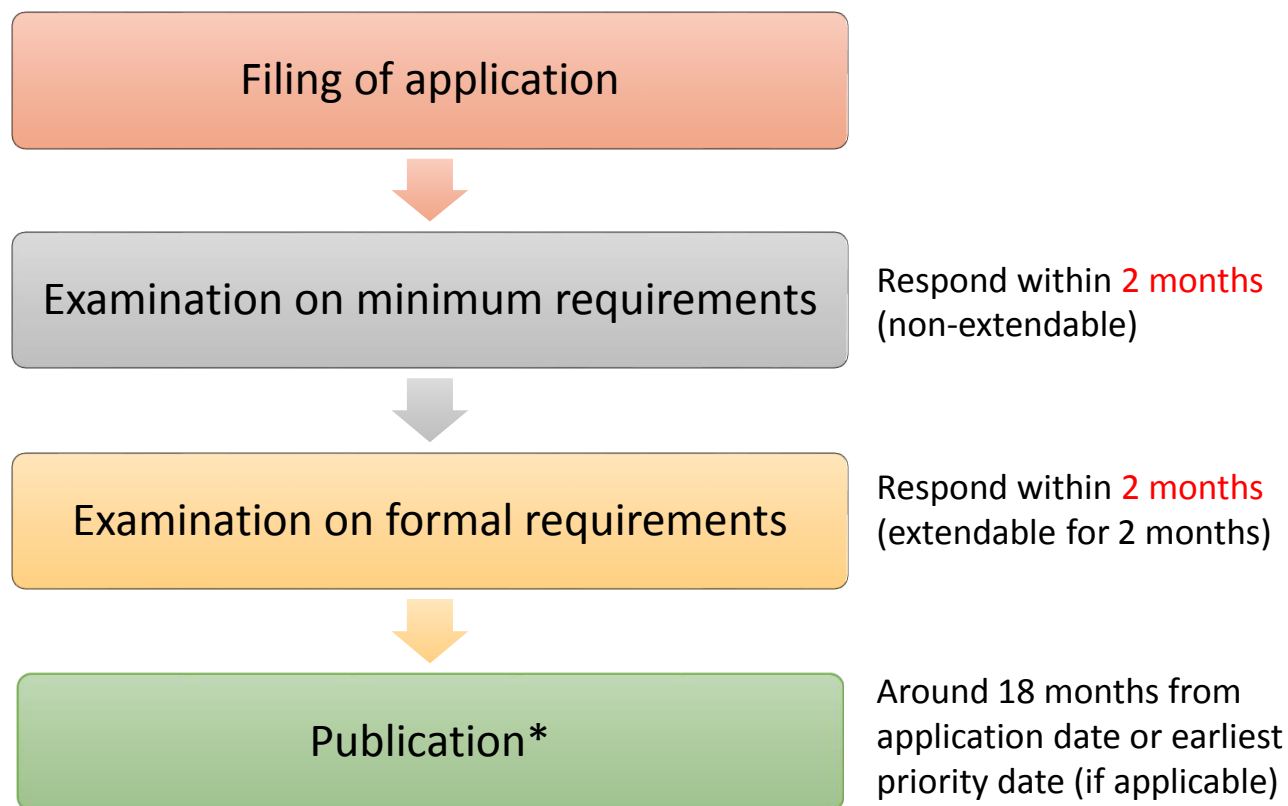
Regulating Patent Practitioners

- Prohibition on use of certain titles or descriptions:
 - certified patent agent/attorney
 - registered patent agent/attorney
 - a title/description reasonably causing a belief that a person using such title/description holds a qualification that is —
 - (i) granted for approving that person to provide patent agency services in Hong Kong; and
 - (ii) recognized by law or endorsed by the Government
- **Exception**: titles/descriptions that solely relate to a person's qualification for providing patent agency services in jurisdictions outside Hong Kong with clear indication of such jurisdictions



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Application Procedure – Standard Patent (Original Grant) (1)

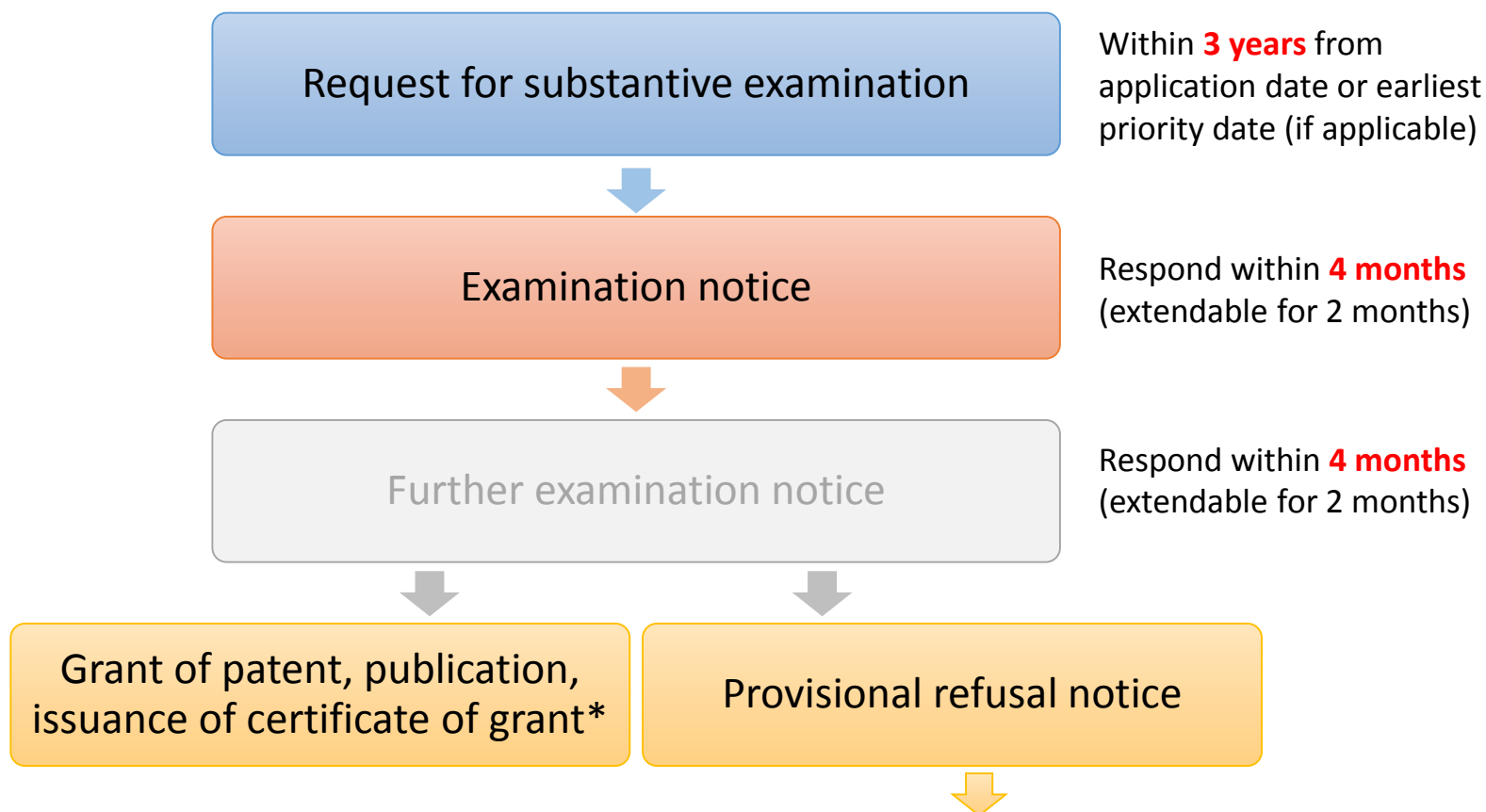


* Upon passing examinations



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Application Procedure – Standard Patent (Original Grant) (2)

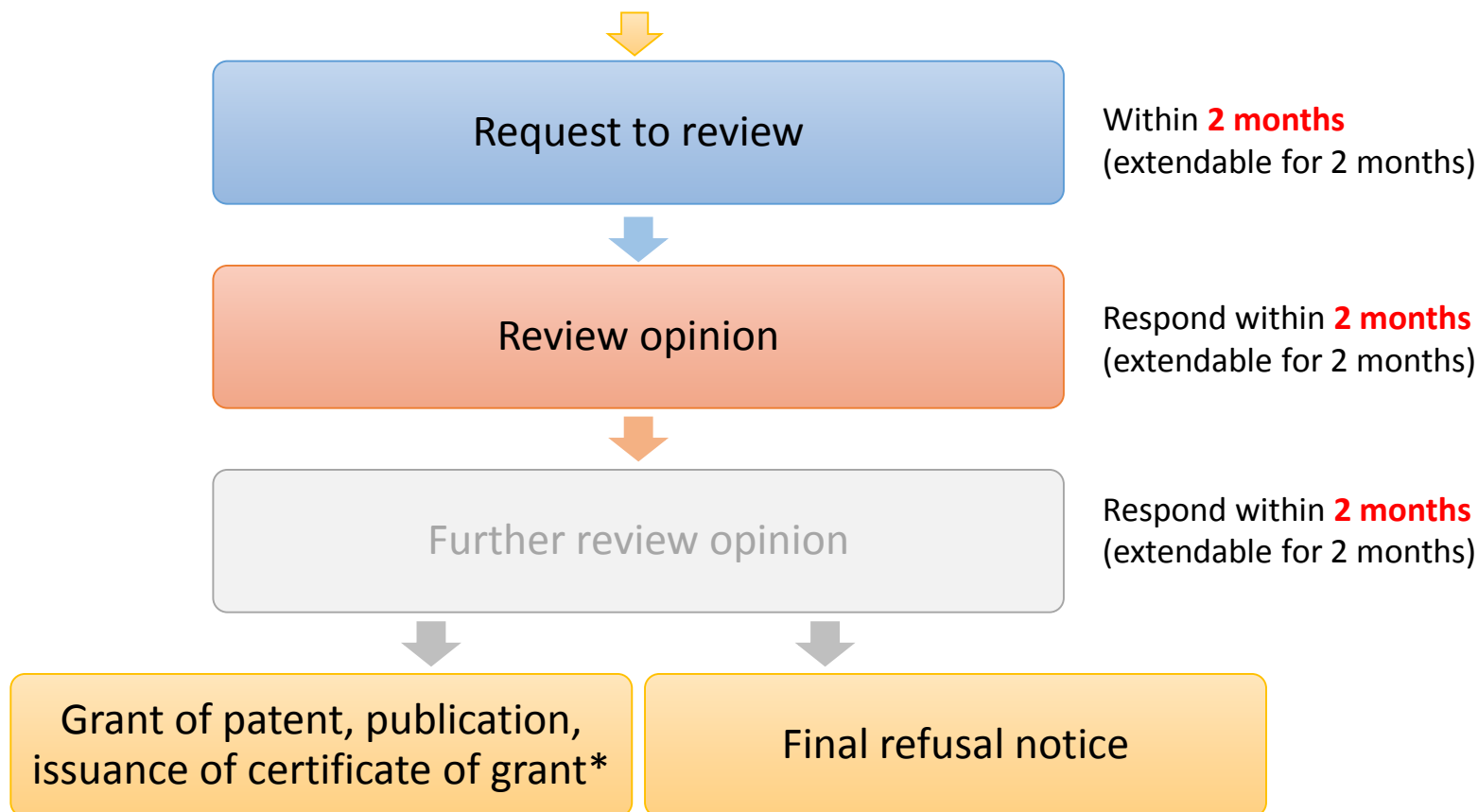


* upon passing examinations



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Application Procedure – Standard Patent (Original Grant) (3)

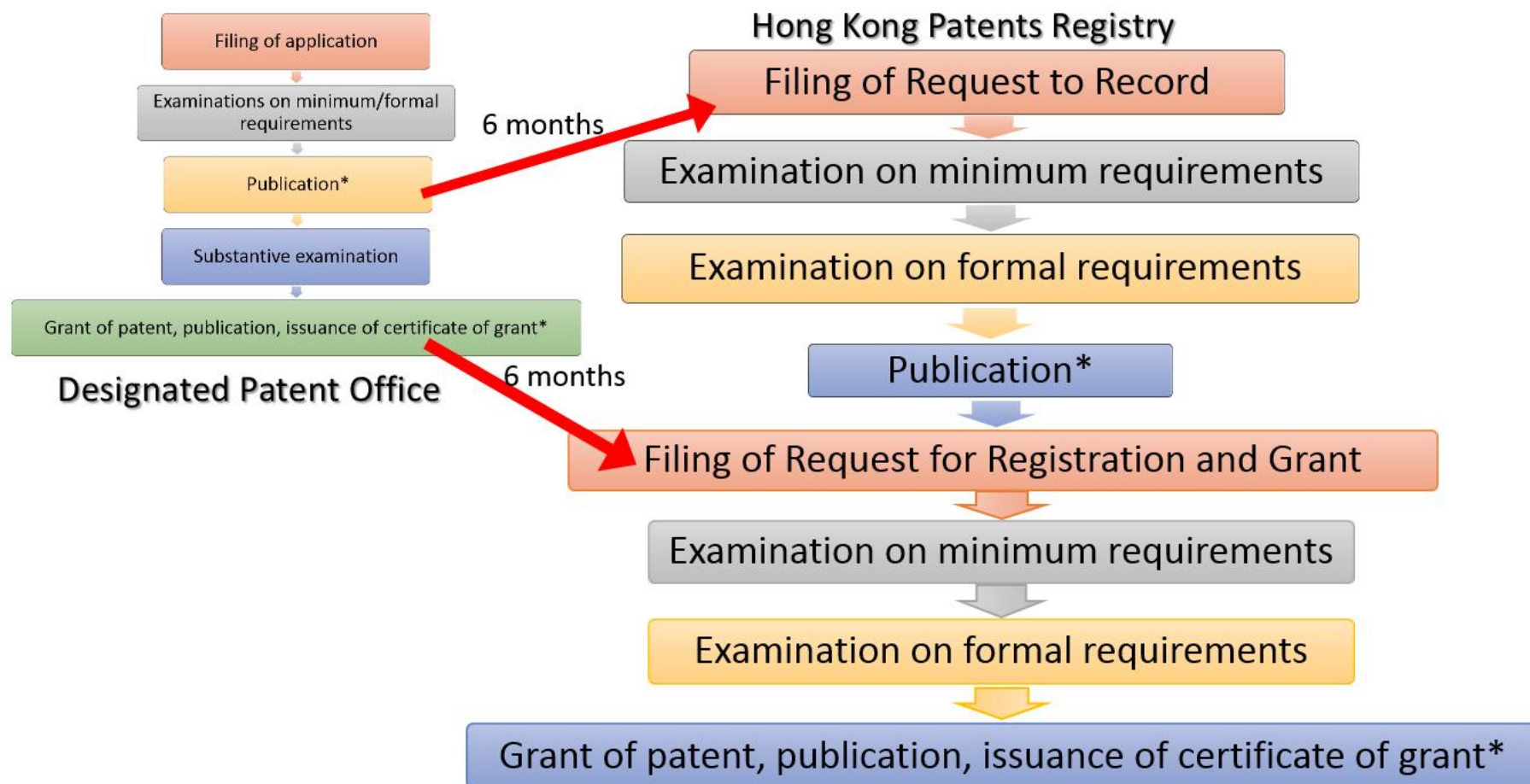


* upon passing examinations



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Application Procedure - Standard Patent (Re-registration)

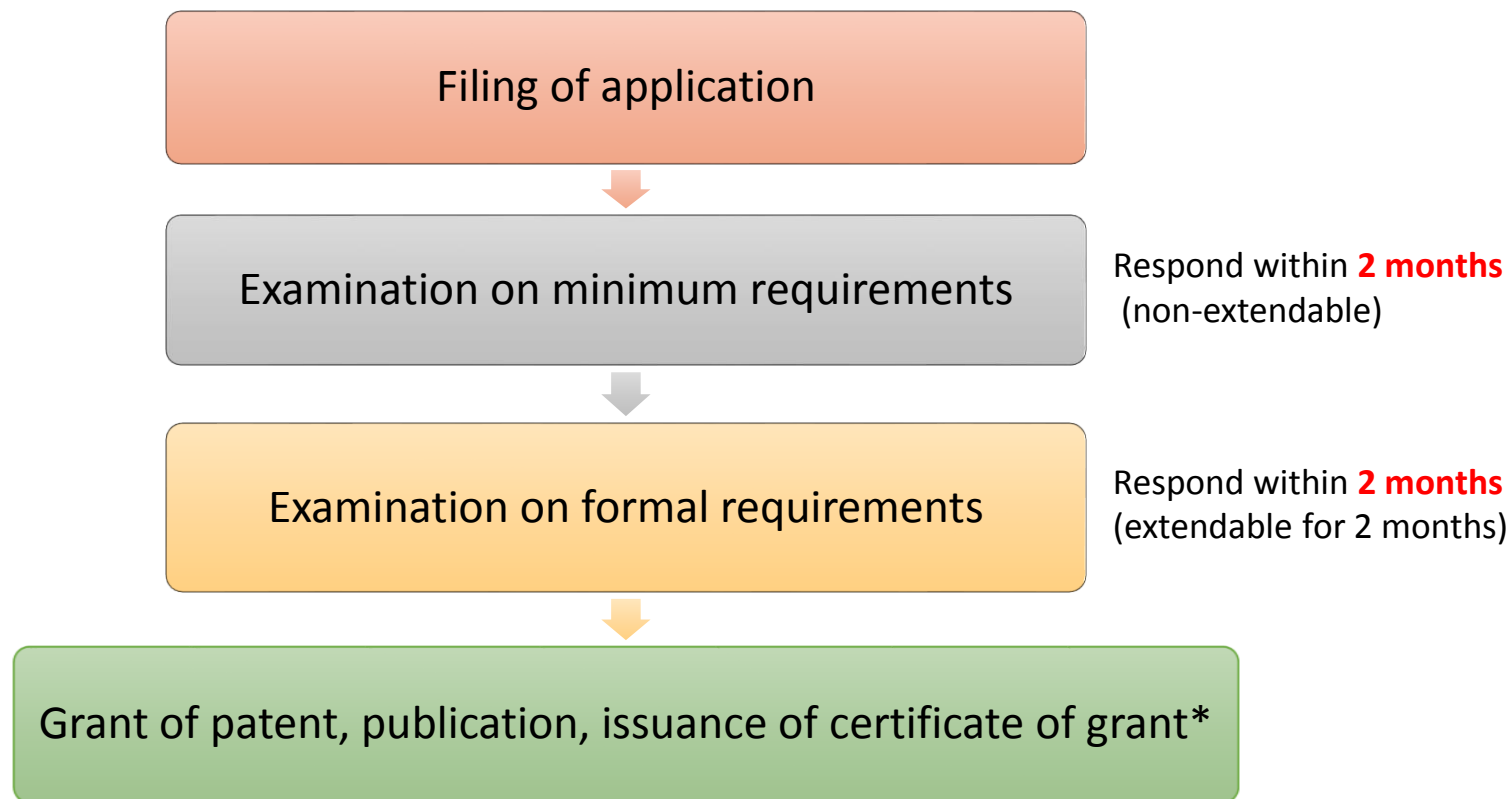


* upon passing the examinations



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Application Procedure - Short-Term Patent (1)

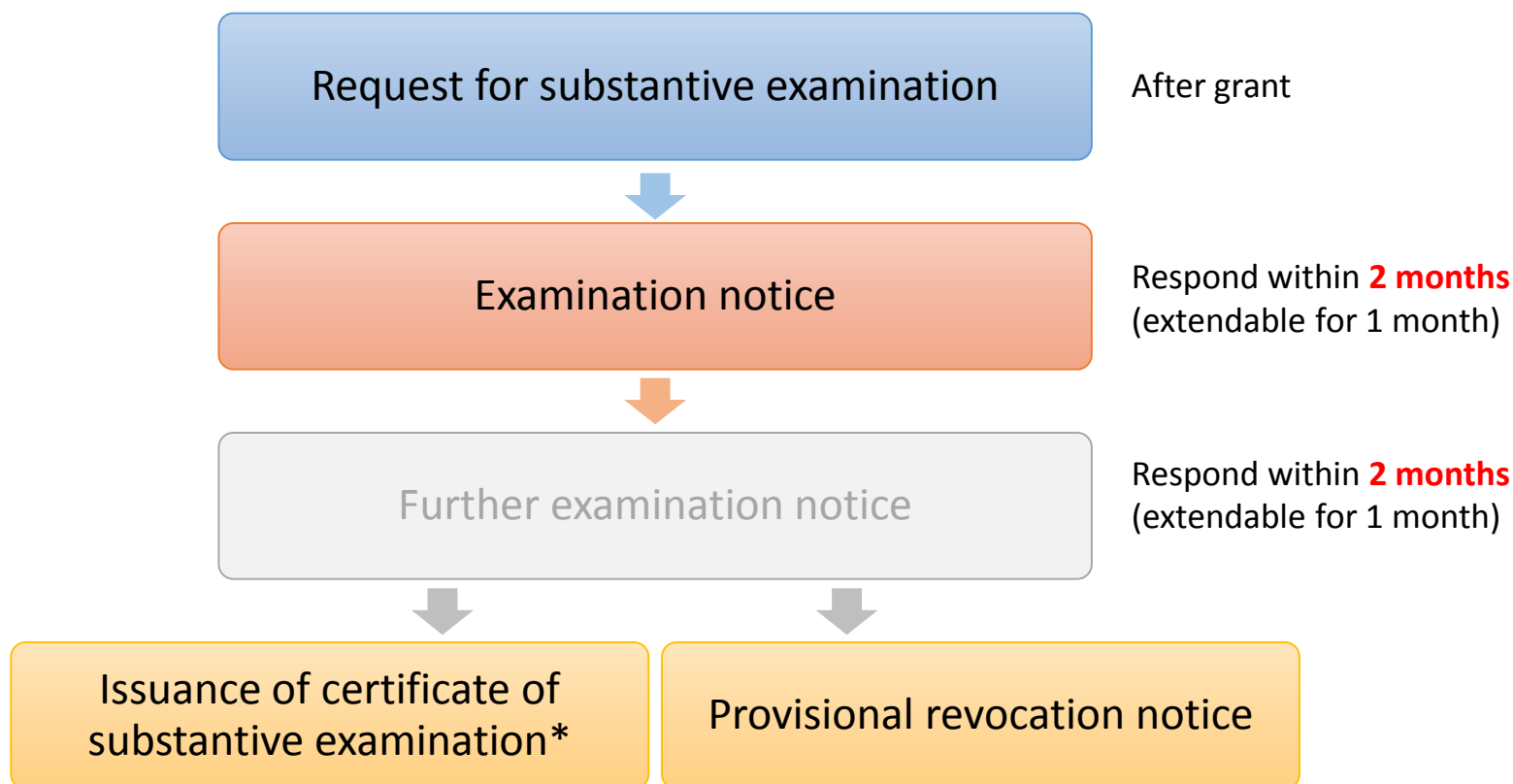


* upon passing the examinations



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Application Procedure - Short-Term Patent (2)

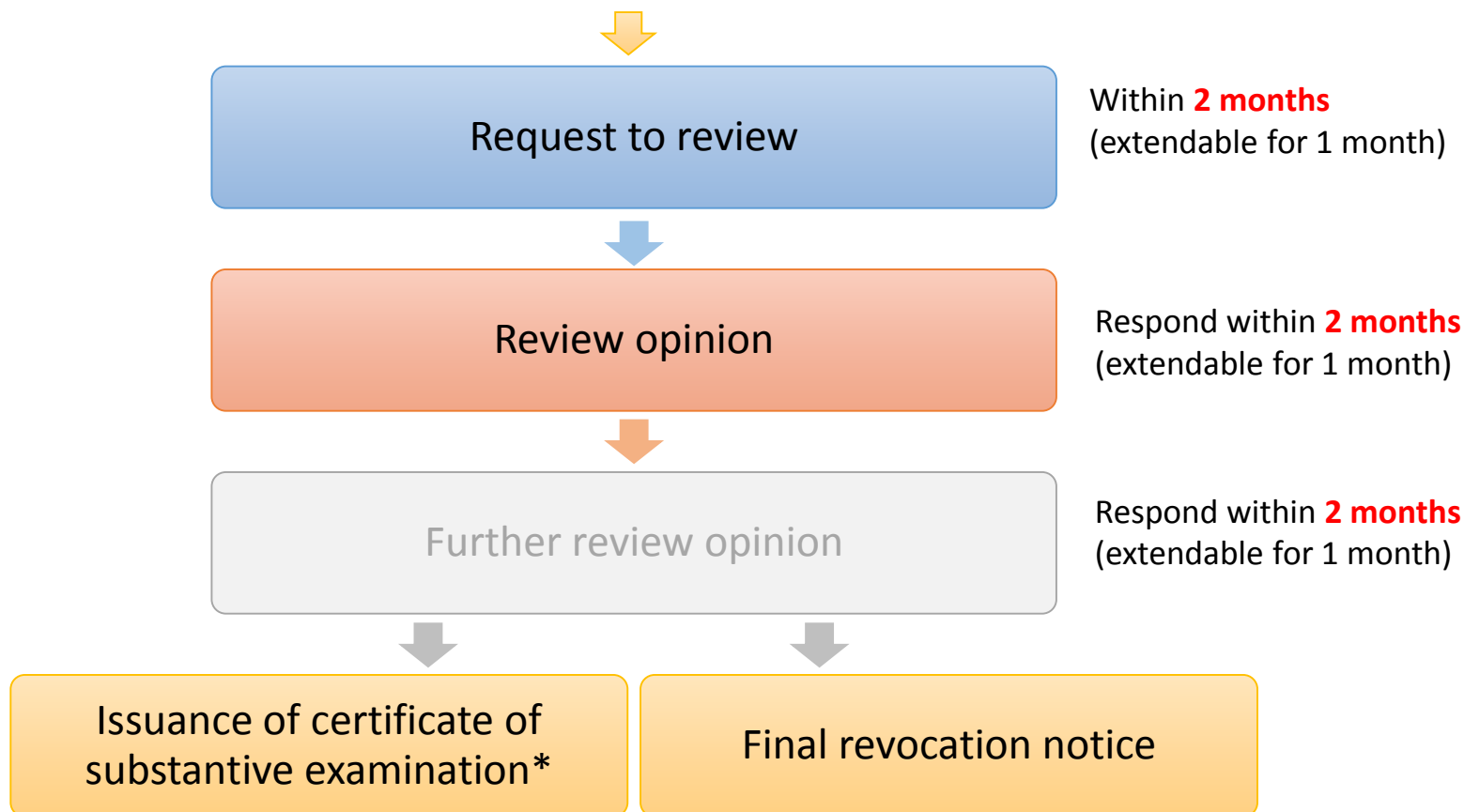


** upon passing examination and overcoming opposition against proposed amendments to the patent (if any)*



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Application Procedure - Short-Term Patent (3)



** upon passing examination and overcoming opposition against proposed amendments to the patent (if any)*



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Filing Tips for the New Patent System

Procedures	Standard Patent (O) & Short-term Patent Applications
Claiming priority rights	<ul style="list-style-type: none">-Possible restoration of priority right if a subsequent standard patent (O) or short-term patent application is filed within 2 months after the expiry of the 12-month priority period-Statement of priority and supporting documents may be filed with the Registrar within 16 months from the earliest priority date claimed
Reference to an earlier specified application	<ul style="list-style-type: none">-An alternative for filing something that appears to be a description of an invention (one of the minimum requirements for obtaining a filing date)-Applicant can file a reference to an earlier specified application together with a statement indicating that a description and the drawings (if any) of the invention are completely contained in the specified application



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Filing Tips for the New Patent System

Procedures	Standard Patent (O) & Short-term Patent Applications
Missing parts of the description or drawings	<ul style="list-style-type: none">-An applicant may, on his own initiative or as required by the Registrar, file a missing description or missing drawing within the prescribed period-If filed within the prescribed period but later than the accorded date of filing, the accorded date of filing may be changed to the date on which the missing parts of the description or missing drawings were filed (unless conditions under s. 37N(5) of PO are fulfilled)



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Major New Fees

Procedure	Amount (HK\$)
Filing OGP application (including advertisement fee)	548 (paper form) 413 (e-filing)
Filing STP application (including advertisement fee)	823 (paper form) 613 (e-filing)
Request for substantive examination OGP application/STP	4,000
Request to review Registrar's opinion on provisional refusal of OGP application or provisional revocation of STP	1,700
Renewal of a standard patent —	
(a) after expiry of the 3 rd , 4 th , 5 th , 6 th , 7 th , 8 th or 9 th year	450
(b) after expiry of the 10 th , 11 th , 12 th , 13 th or 14 th year	620
(c) after expiry of the 15 th , 16 th , 17 th , 18 th or 19 th year	850



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New Specified Forms for the New Patent System

- Draft copies are now available at IPD website for information in advance: https://www.ipd.gov.hk/eng/whats_new/news.htm



知識產權署

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Patents Form OP1

Request for grant of a standard patent (O)

Patents Ordinance (Cap. 514)
Patents (General) Rules (Cap. 514C)

Important notes

1. General notes:

- This form is available in Chinese and English. Either Chinese or English can be used as the language of proceedings. Please complete this form in English unless otherwise stated. The specification must be in English.
- By submitting this form, you will be treated as having given consent to the Patents Registry and its service provider to copy or communicate all the information provided to any third party (in or outside Hong Kong) who assists or supports the Patents Registry in performing its functions under the Patents Ordinance, Cap. 514 and its subsidiary legislation.
- This form must be signed and dated.
- If there is not enough space for any part on this form, please continue on an additional sheet. Number each



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Summary of New Patent System

	Standard Patent (OGP)	Standard Patent (Re-registration)	Short-term Patent
Protection Term	20 years	20 years	8 years
Pre-application/grant	Not required	First applied/registered in a designated patent office [CNIPA/UKIPO/EPO(UK)]	Not required
No. of Claims per application	Unlimited	Unlimited	2 independent claims
Formality Examination	Conducted by Patents Registry	Conducted by Patents Registry	Conducted by Patents Registry
Substantive Examination	Conducted by Patents Registry	Conducted by designated patent office	Not required (except for commencing enforcement action)



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Preparation for New Patent System

- To finalize the examination guidelines
- To train the patent examiners for conducting substantive examination
- To set up a new IT system for filing and processing patent cases
- To publicize and promote the new patent system
- To establish a full-fledged regulatory regime for local patent practitioners with transitional measures in the medium and long terms



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Thank you