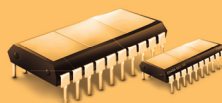


APPLICATION FOR PATENT PROTECTION IN THE HONG KONG SPECIAL ADMINISTRATIVE REGION



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



CONTENTS

INTRODUCTION	1
APPLYING FOR A PATENT IN THE HONG KONG SPECIAL ADMINISTRATIVE REGION	
A. Standard patent (O) application	5
B. Standard patent (R) application	12
C. Short-term patent application	17
ENFORCEMENT	20
POINTS TO NOTE WHEN SEEKING PATENT PROTECTION	21
ONLINE SERVICES	24

INTRODUCTION

What is a patent?

A patent for an invention gives the patent owner the right to exclude others from using the invention within a particular jurisdiction for a limited period. An invention which is new, involves an inventive step and is industrially applicable is patentable in the Hong Kong Special Administrative Region (the Hong Kong SAR) as long as it is not an excluded subject-matter or activity.¹

Territorial protection of patents


As patent protection is territorial in nature, patents granted for inventions in any jurisdiction outside the Hong Kong SAR do not afford the patent owners any protection for their inventions in the Hong Kong SAR. In other words, patent protection for an invention in the Hong Kong SAR can only be sought by properly filing a patent application under the **Patents Ordinance** (Chapter 514) and the **Patents (General) Rules** (Chapter 514C).

Why apply for a patent in the Hong Kong SAR?

If you are granted a patent for a product in the Hong Kong SAR, you will have the right to exclude others from making, putting on the market, using,



¹ Examples of excluded subject-matters are discoveries, scientific theories and surgical methods for treatment of human.



importing or stocking the patented product. If you obtain a patent for a process, you will have a similar right to exclude others from exploiting any product obtained directly by means of the patented process. As a patent owner, you are entitled to enforce your patent rights by commencing a civil action before the Court of First Instance of the High Court of the Hong Kong SAR against infringement of your patent in the Hong Kong SAR and seek remedies including an injunction, an order for delivery up, damages or an account of profits and a declaration that your patent is valid and has been infringed.

Reform of patent system in the Hong Kong SAR

The Government is committed to reforming the local patent system in order to ensure that it would continue to meet present-day circumstances and also facilitate the development of the Hong Kong SAR into a regional innovation and technology hub. In this connection, the ***Patents (Amendment) Ordinance 2016*** and the ***Patents (General) (Amendment) Rules 2019*** have been enacted with the commencement date of 19 December 2019 to provide for the necessary legal and procedural framework for the new patent system.

New patent system [Effective 19 December 2019]

The new patent system mainly introduces an original grant patent system for standard patents, refines the existing short-term patent system and introduces an interim regulatory measure of prohibiting use of certain confusing or misleading titles and descriptions relating to patent practice in the Hong Kong SAR.

Types of patents granted under the new patent system

In the Hong Kong SAR, you can choose to protect your invention by seeking a **standard patent** or a **short-term patent**.

If you opt for a longer patent protection term of up to 20 years for your invention, you may apply for a **standard patent** by filing your application either via:

- (a) the new “original grant patent” route directly in the Hong Kong SAR for a standard patent (“standard patent (O)”); or
- (b) the existing “re-registration” route for a standard patent (“standard patent (R)”) on the basis of a corresponding patent application for the same invention previously filed with a designated patent office outside the Hong Kong SAR.

Alternatively, you may opt to seek a **short-term patent** having a relatively shorter protection term of up to 8 years.



A comparative highlight of major features of different types of patents that may be granted in the Hong Kong SAR is tabulated below:

	Standard patent		Short-term patent
	Standard patent (O)	Standard patent (R)	
<i>Protection target</i>	Inventions with longer exploitation/ commercialisation terms		Simple inventions with shorter exploitation/ commercialisation terms
<i>Maximum protection term (subject to payment of renewal fees)</i>	20 years		8 years
<i>General patentability requirement</i>	Inventions that are new, involve an inventive step and are industrially applicable		
<i>Limitation of number of claims per patent application</i>	Unlimited		Not more than 2 independent claims
<i>Pre-application requirement</i>	Nil	Filing a corresponding patent application for the same invention with a designated patent office outside the Hong Kong SAR ²	Nil
<i>Formality examination of documents filed in support of applications</i>	Mandatory for patent grant		
<i>Substantive examination of patentability of inventions for which patents are applied</i>	Mandatory for patent grant	(a) Not required (b) Patent grant is subject to grant of the corresponding patent by the designated patent office	(a) Not required for patent grant (b) The patent owner or a third party may request a post- grant substantive examination to be conducted

² The China National Intellectual Property Administration, the European Patent Office (in respect of a patent designating the United Kingdom) or the United Kingdom Intellectual Property Office.

APPLYING FOR A PATENT IN THE HONG KONG SPECIAL ADMINISTRATIVE REGION

A. Standard patent (O) application

Examination of a standard patent (O) application comprises the following stages:

- (a) examination for according a date of filing to application
- (b) examination on formal requirements of application
- (c) publication of application
- (d) substantive examination of application
- (e) outcome of application: grant and publication of patent or final refusal of patent grant





Examination for according a date of filing to application

The Registrar will accord a date of filing to a standard patent (O) application if the application contains:

- (a) an indication that a standard patent (O) is sought;
- (b) information identifying the applicant, such as the name and address of the applicant; and
- (c) a description of the invention for which the application is made (or alternatively, a reference to an earlier specified application together with a statement indicating that such earlier application completely contains the description and drawings (if any) of the invention).

The Registrar will give a notice to the applicant to correct any deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the standard patent (O) application unsuccessful.

Examination on formal requirements of application

After according a date of filing to a standard patent (O) application, the Registrar will examine whether the application fulfils the formal requirements, namely it contains the supporting information and documents as required by the patent legislation before its publication.

If the application is not in order, the Registrar will give a notice to the applicant to correct the deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the application unsuccessful.

Publication of application

If a standard patent (O) application is considered by the Registrar to be in order, the Registrar will publish the application and advertise the fact of the publication by notice in the Hong Kong Intellectual Property Journal (www.ipd.gov.hk/eng/ip_journal.htm).

The publication of the patent application will be made as soon as practicable on the expiry of **eighteen months** after the date of filing of the application or the earliest date of priority claimed (if applicable). Alternatively, the applicant may request early publication of the application by indicating so in the application form.





Substantive examination of application

The applicant needs to file a request with the Registrar for substantive examination of a standard patent (O) application **within three years** after its date of filing or the earliest date of priority claimed (if applicable), or else the application will be regarded as being withdrawn.

When conducting substantive examination, the Registrar examines whether the application complies with the examination requirements, which in particular include the patentability of the underlying invention of the application, i.e. whether the invention is new, involves an inventive step and is industrially applicable.

If the application is considered as not complying with any examination requirement, the Registrar will issue an **examination notice** to the applicant. The applicant needs to respond to the examination notice **within four months** after the date of the examination notice by filing a written representation and/or a request to amend the application.

The applicant will need to elaborate, revise or clarify his response if so required by a **further examination notice** issued by the Registrar. Such elaboration, revision or clarification must be filed by the applicant **within four months** after the date(s) of the **further examination notice(s)**.

Failure to timely file a response to any examination notice or further examination notice by the applicant will render the application being regarded as being withdrawn.

If the Registrar, upon considering the applicant's response(s) to the examination notice(s) and/or any further examination notice(s), still considers

that the application does not comply with the examination requirement(s) concerned, the Registrar will make a **provisional decision** of refusal.

The applicant may file a **request to review** the **provisional decision** of refusal **within two months** after the date of the provisional decision by filing a written representation and/or a request to amend the application.

If the Registrar maintains the view that the application does not comply with the examination requirement(s) in question, he will issue a **review opinion** to that effect. The applicant could respond by filing a written representation, a request to amend the application, and/or a request for hearing (if the Registrar has offered the applicant an opportunity to be heard) **within two months** after the date of the review opinion.

If the Registrar remains unconvinced that the relevant requirements are met, he may issue one or more **further review opinion(s)** to that effect. The applicant will need to respond by providing elaboration, revision or clarification of his earlier response, and/or requesting a hearing (if the Registrar has offered the applicant an opportunity to be heard) **within two months** after the date of the relevant further review opinion. Failure to respond within the above time limit will result in a **final refusal** to grant the patent.



Outcome of application

Grant and publication of patent

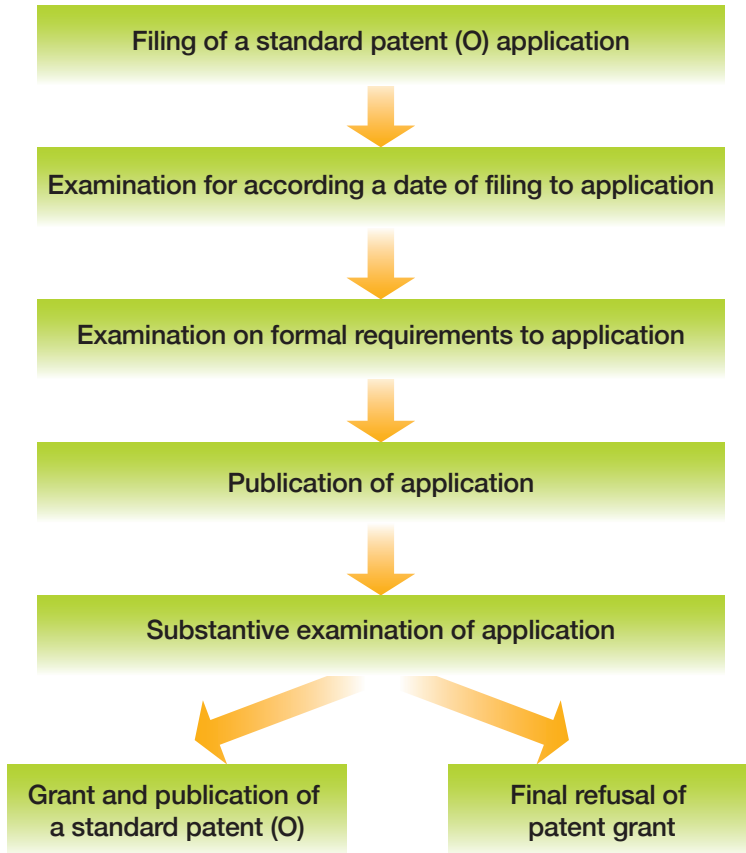
If a standard patent (O) application, upon examination, is considered by the Registrar to be in order, the Registrar will grant and publish the patent, advertise the fact of grant by notice in the Hong Kong Intellectual Property Journal (www.ipd.gov.hk/eng/ip_journal.htm), and issue a certificate of grant of the patent.

Final refusal of patent grant

In other cases, the Registrar will issue a final decision of refusal to grant the patent. The decision of the Registrar is subject to the right of appeal to the Court of First Instance.



Flowchart: Applying for a standard patent (O) for an invention in the Hong Kong SAR



B. Standard patent (R) application

The filing of an application for grant of a standard patent (R) with the Registrar must be based on an earlier filing of a corresponding patent application (“designated patent application”) with one of the three designated patent offices outside the Hong Kong SAR, namely:

- (a) the China National Intellectual Property Administration;
- (b) the European Patent Office (in respect of a patent designating the United Kingdom); or
- (c) the United Kingdom Intellectual Property Office.

A standard patent (R) application is made in two stages by filing:

- (a) a **request to record** a designated patent application (Stage 1); and then
- (b) a **request for registration of a designated patent and grant of a standard patent (R)** (Stage 2).



Stage 1- Request to record

Examination for according a date of filing to request to record

A request to record must be filed with the Registrar **within six months** after the date of publication of the designated patent application.

The Registrar will accord a date of filing to a request to record if it contains:

- (a) an indication that the request is made to record a designated patent application;
- (b) information identifying the applicant, such as the name and address of the applicant; and
- (c) a reference to the corresponding designated patent application (including the designated patent application number, its publication number and the date of its publication).

The Registrar will give a notice to the applicant to correct any deficiencies **within one month** after the date of the notice. Failure to correct any deficiency timely will render the request unsuccessful.

Examination on formal requirements of request to record

After according a date of filing to a request to record, the Registrar will examine whether the request fulfils the formal requirements, namely it contains the supporting information and documents as required by the patent legislation.

If the request is not in order, the Registrar will give a notice to the applicant to correct the deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the request unsuccessful.



Publication of request to record

If a request to record is considered by the Registrar to be in order, the Registrar will publish the request and advertise the fact of the publication by notice in the Hong Kong Intellectual Property Journal (www.ipd.gov.hk/eng/ip_journal.htm).

Stage 2- Request for registration and grant

Examination for according a date of filing to request for registration and grant

A request for registration and grant must be filed with the Registrar **within six months** after the date of grant of the designated patent by the designated patent office or publication of the request to record by the Registrar, whichever is the later.

The Registrar will accord a date of filing to a request for registration and grant if the request contains:

- (a) an indication that the request is made for the registration of a designated patent and the grant of a standard patent (R);
- (b) information identifying the applicant, such as the name and address of the applicant;
- (c) a reference to the corresponding designated patent (i.e. the publication number of the designated patent and the date of its publication); and
- (d) the publication number of the corresponding request to record.

The Registrar will give a notice to the applicant to correct any deficiencies **within one month** after the date of the notice. Failure to correct any deficiency timely will render the request unsuccessful.

Examination on formal requirements of request for registration and grant

After according a date of filing to a request for registration and grant, the Registrar will examine whether the request fulfils the formal requirements, namely it contains the supporting information and documents as required by the patent legislation.

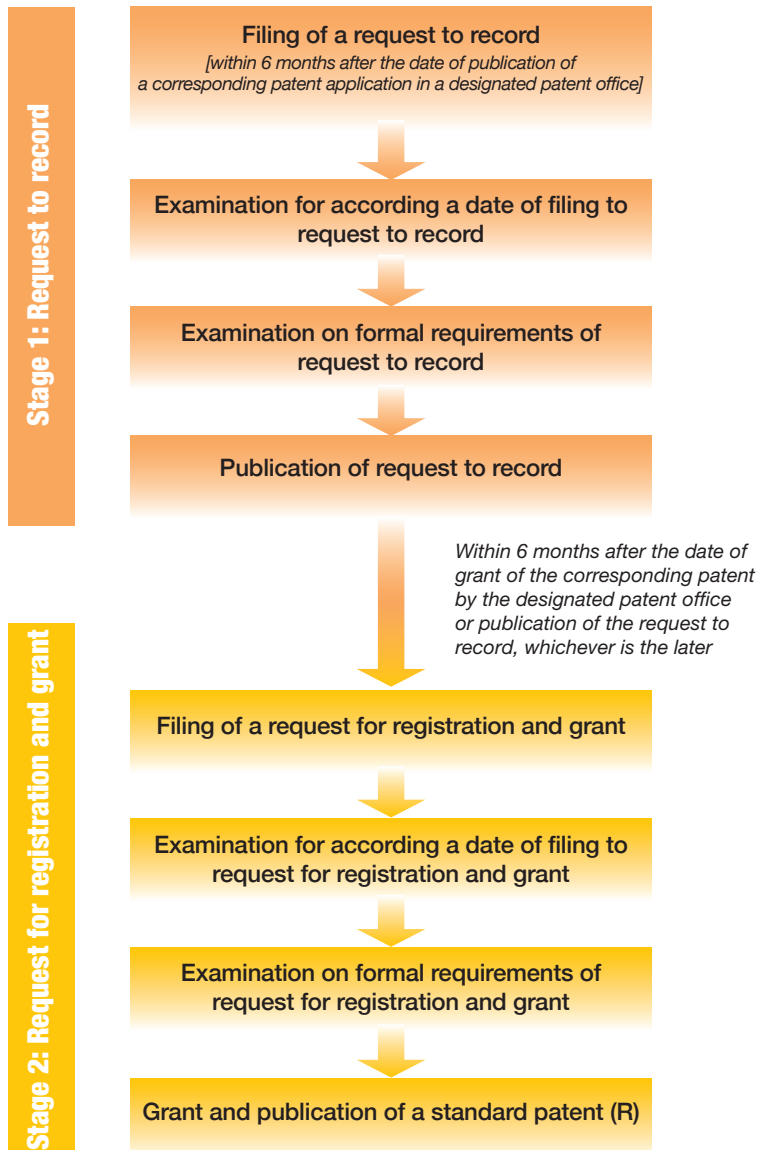
If the request is not in order, the Registrar will give a notice to the applicant to correct the deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the request unsuccessful.

Grant and publication of patent

If a request for registration and grant is considered by the Registrar to be in order, the Registrar will grant and publish a standard patent (R), advertise the fact of grant by notice in the Hong Kong Intellectual Property Journal (www.ipd.gov.hk/eng/ip_journal.htm), and issue a certificate of grant of the patent.



Flowchart: Applying for a standard patent (R) for an invention in the Hong Kong SAR





C. Short-term patent application

Examination of a short-term patent application comprises the following stages:

- (a) examination for according a date of filing to application
- (b) examination on formal requirements of application
- (c) grant and publication of patent

Examination for according a date of filing to application

The Registrar will accord a date of filing to a short-term patent application if the application contains:

- (a) an indication that a short-term patent is sought;
- (b) information identifying the applicant, such as the name and address of the applicant; and
- (c) a description of the invention for which the application is made (or alternatively, a reference to an earlier specified application together with a statement indicating that such earlier application completely contains the description and drawings (if any) of the invention).

The Registrar will give a notice to the applicant to correct any deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the short-term patent application unsuccessful.

Examination on formal requirements of application

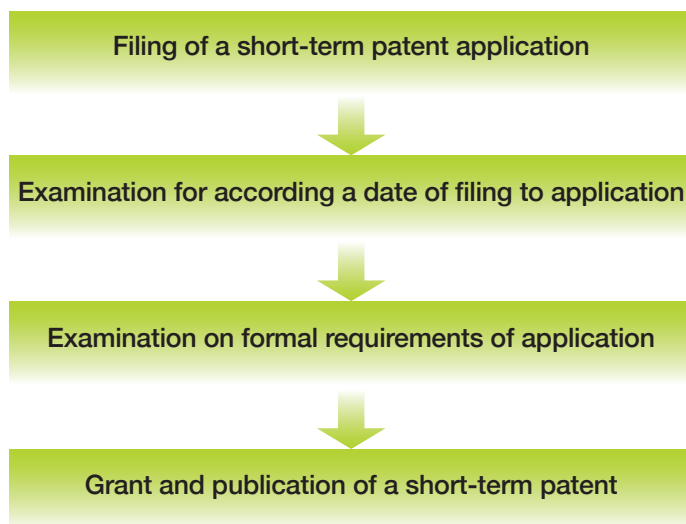
After according a date of filing to a short-term patent application, the Registrar will examine whether the application fulfils the formal requirements, namely it contains the supporting information and documents as required by the patent legislation (including a search report issued by an International Searching Authority under the Patent Cooperation Treaty or one of the three designated patent offices).

If the application is not in order, the Registrar will give a notice to the applicant to correct the deficiencies **within two months** after the date of the notice. Failure to correct any deficiency timely will render the application unsuccessful.

Grant and publication of patent

If a short-term patent application, upon examination, is considered by the Registrar to be in order, the Registrar will grant and publish the patent, advertise the fact of grant by notice in the Hong Kong Intellectual Property Journal (www.ipd.gov.hk/eng/ip_journal.htm), and issue a certificate of grant of the patent.

Flowchart: Applying for a short-term patent for an invention in the Hong Kong SAR



Post-grant substantive examination of short-term patent


Under the new patent system, a short-term patent owner or any person having reasonable grounds or legitimate business interests may request the Registrar to conduct substantive examination of the patent for determining the validity of the grant.

The substantive examination procedure of a short-term patent is similar to that of a standard patent (O) application.

- (a) During substantive examination of a short-term patent, the Registrar may issue the following office actions if the patent does not comply with the examination requirements: an **examination notice**, one or more **further examination notice(s)**, a **provisional notice** to revoke the patent; (if the patent owner files a **request to review** the aforesaid **provisional notice**) a **review opinion** and one or more **further review opinion(s)**.
- (b) Generally, the patent owner needs to respond to the aforesaid office actions issued by the Registrar **within two months** after the date of each office action.

A short-term patent owner may make a request to amend the specification of his patent at the time of requesting post-grant examination or for the purpose of addressing and overcoming an office action raised by the Registrar during post-grant substantive examination. Such request to amend is subject to opposition by a third party.

If the Registrar, having conducted substantive examination of a short-term patent and having considered the patent owner's response(s) to any office action(s) and any opposition by a third party to any request to amend the specification of the patent, is of the view that all examination requirements



have been complied with, the Registrar will issue a certificate of substantive examination and enter a record in the register accordingly.

On the other hand, if the Registrar, having considered the short-term patent owner's responses to all relevant office actions, is still of the view that the patent does not meet the examination requirements, he will issue a **final notice** to revoke the short-term patent. The decision of the Registrar is subject to the right of appeal to the Court of First Instance.


For further details about applying for a patent in the Hong Kong SAR, including application forms and fees, please visit www.ipd.gov.hk/eng/intellectual_property/patents/Applying_for_a_Patent.htm.

ENFORCEMENT

A patent owner can bring civil proceedings against infringement of his patent.

Where a person by circulars, advertisements or otherwise threatens another person with proceedings for infringement of a patent, a person aggrieved by the threats may bring court proceedings against the person making the threats for relief on the ground that the threats are groundless.

Where the owner of an unexamined short-term patent or any other person threatens another person with infringement proceedings in relation to such patent, he should, upon request by any person aggrieved by the threats, provide adequate information to identify the patent in question (i.e. the Hong Kong SAR patent number and a copy of any unpublished requested amendment to the specification of the patent). If he fails to do so, any person aggrieved by the threats may be entitled to claim relief on the basis of groundless threats. Further, before the owner of an unexamined short-



term patent commences legal proceedings for infringement, he must request the Registrar to conduct a post-grant substantive examination of the patent.

POINTS TO NOTE WHEN SEEKING PATENT PROTECTION

Right to apply for a patent


Generally speaking, the inventor or the owner of an invention is entitled to apply for grant of a patent for the invention. You may acquire ownership of an invention by commissioning its creation in accordance with an agreement, employing somebody under a contract to create the invention, or by an assignment of the ownership of the invention etc..

Claiming priority

The date of filing of a patent application is important to the patent filer because where there are competing patent applications for the same invention, the right to the patent will, in general, belong to the ‘first-to-file’. This means that the first filing of a patent application for an invention will have priority or is considered as having novelty over any subsequent application for the same invention.

In this connection, if you have first filed a patent application in or for a Paris Convention country or a member of the World Trade Organization³ (collectively “Convention country/WTO member”), such filing establishes a priority date

³ Hong Kong, China is a member of the WTO whereas the Paris Convention has been applied to the Hong Kong SAR.



for your subsequent filing of a corresponding patent application for the same invention in another Convention country/WTO member provided that the subsequent filing is within twelve months of the first filing.

In other words, if you have first filed a standard patent (O) or short-term patent application for an invention, you may generally claim priority based on such application in your corresponding application for the same invention that is subsequently and timely filed in any other Convention country/WTO member. Simply put, your subsequent application(s) would then have priority over other people's applications filed after the filing date of your first-filed standard patent (O) or short-term patent application.

Confidentiality

As only new inventions are patentable, you need to keep your own invention confidential until you have filed your patent application for it. Where there is any pre-filing disclosure of your invention, e.g. by publishing the invention in a catalogue or placing an order to manufacture the invented product, the validity of any patent for your invention may be subject to challenge on the ground that your invention was not new on the date of filing of the patent application.

It is only in limited circumstances that pre-filing disclosure does not destroy the novelty of an invention. Sections 11A, 37B and 109 of the Patents Ordinance provide for the specific circumstances of and requirements for non-prejudicial disclosure for the purpose of filing a standard patent (R), standard patent (O) and short-term patent application respectively. If you need to disclose details of your invention before filing an application, you should seek professional advice to ensure that the novelty of your invention would not be destroyed by your pre-filing disclosure.

Territorial protection of patents

If you wish to use or market your invention in both the Hong Kong SAR and the Mainland, you should apply for patents for the same invention separately in both places, as the Hong Kong SAR and the Mainland have separate systems of patent grant and protection. Registering your patent in the Mainland or elsewhere does not automatically give you protection in the Hong Kong SAR or vice versa.

Your legal rights as a patent owner

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 enforcement action against infringement of your patent.

Seeking independent advice

You should seek professional advice from an intellectual property lawyer or agent should you have any question about acquisition, protection, exploitation/commercialisation and enforcement of your intellectual property rights covering trademarks, copyright, registered designs and patents so as to safeguard your rights. You may first inquire into the credentials and the chargeable fees of an intellectual property service provider⁴ to see if they can meet your needs before formally engaging the services.

⁴ Before introduction of a full-fledged regulatory regime for persons providing patent agency services in the Hong Kong SAR in the long run, it is prohibited by law for anyone to use the following titles or descriptions relating to patent practice in the Hong Kong SAR –

1. “registered/certified patent agent”;
2. “registered/certified patent attorney”; and
3. any title or description which may cause anyone to believe that the person using the title/description holds a qualification that is specifically granted for approving him to provide patent agency services in the Hong Kong SAR, and such qualification is recognised by law or endorsed by the Government.

However, use of any title or description that solely relates to a person’s qualification for lawfully providing patent agency services in a place outside the Hong Kong SAR is permitted as long as the place is clearly specified.



ONLINE SERVICES

Online search

We provide a free online search service at esearch.ipd.gov.hk, through which you may check information about published patent applications and patents.

E-filing services

To file patent forms via our E-filing System, you may need to register as a user of our e-filing services first. Every registered user of our e-filing services must provide an address for service in Hong Kong. For information on our e-filing services, please visit efiling.ipd.gov.hk.

FURTHER INFORMATION

If you require help or more information, please contact –

The Patents Registry
Intellectual Property Department
24/F, Wu Chung House,
213 Queen's Road East,
Wanchai, Hong Kong
Telephone enquiry: (852) 2961 6901

Alternatively, you may email your enquiries to enquiry@ipd.gov.hk or visit www.ipd.gov.hk for information.

Intellectual Property Department
Government of the Hong Kong Special Administrative Region
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Important Notice

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

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