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The Government of the Hong Kong
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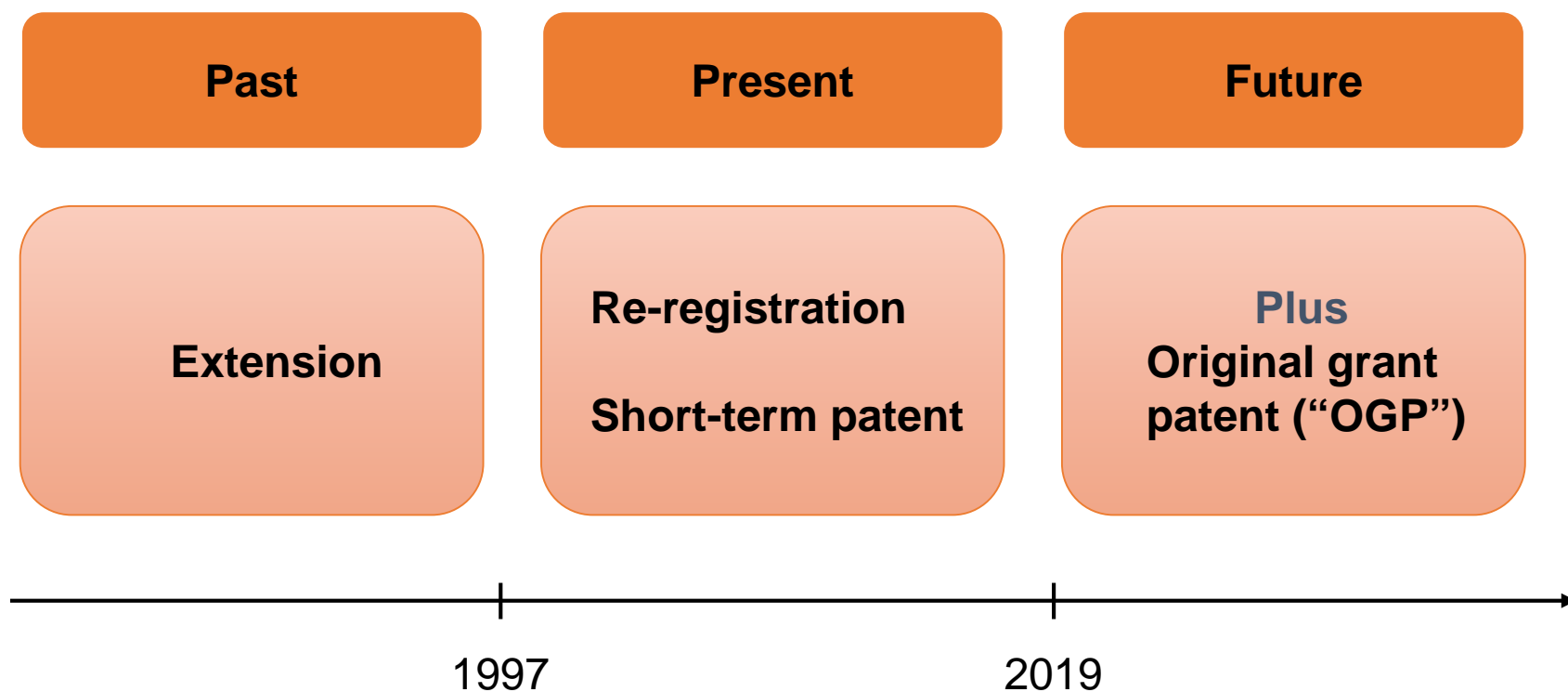
AN UPDATE OF THE HONG KONG PATENT SYSTEM

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3 August 2019



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HK Patent System – Past, Present & Future





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PAST



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Pre – 1997: Extension

UK Patent

HK
Patent

- Registration of Patents Ordinance (Cap. 42) (“RPO”)
- Registration of Patents Rules (Cap. 42A)
- Registration of Patents (Fees) Rules (Cap. 42B)
- Section 6 RPO: *“Such certificate of registration shall confer on the applicant privileges and rights ... as though the patent had been granted in the United Kingdom with an extension to Hong Kong.”*



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PRESENT



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Present: Re-registration

**Designated Patent Office
(CNIPA, UKIPO & EPO(UK))**

Application filed



Publication

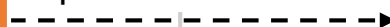


Substantive examination



Grant

Re-register within
6 months from
publication



HK Patents Registry

Request to record
designated application

Request for
registration and grant



Formality examination



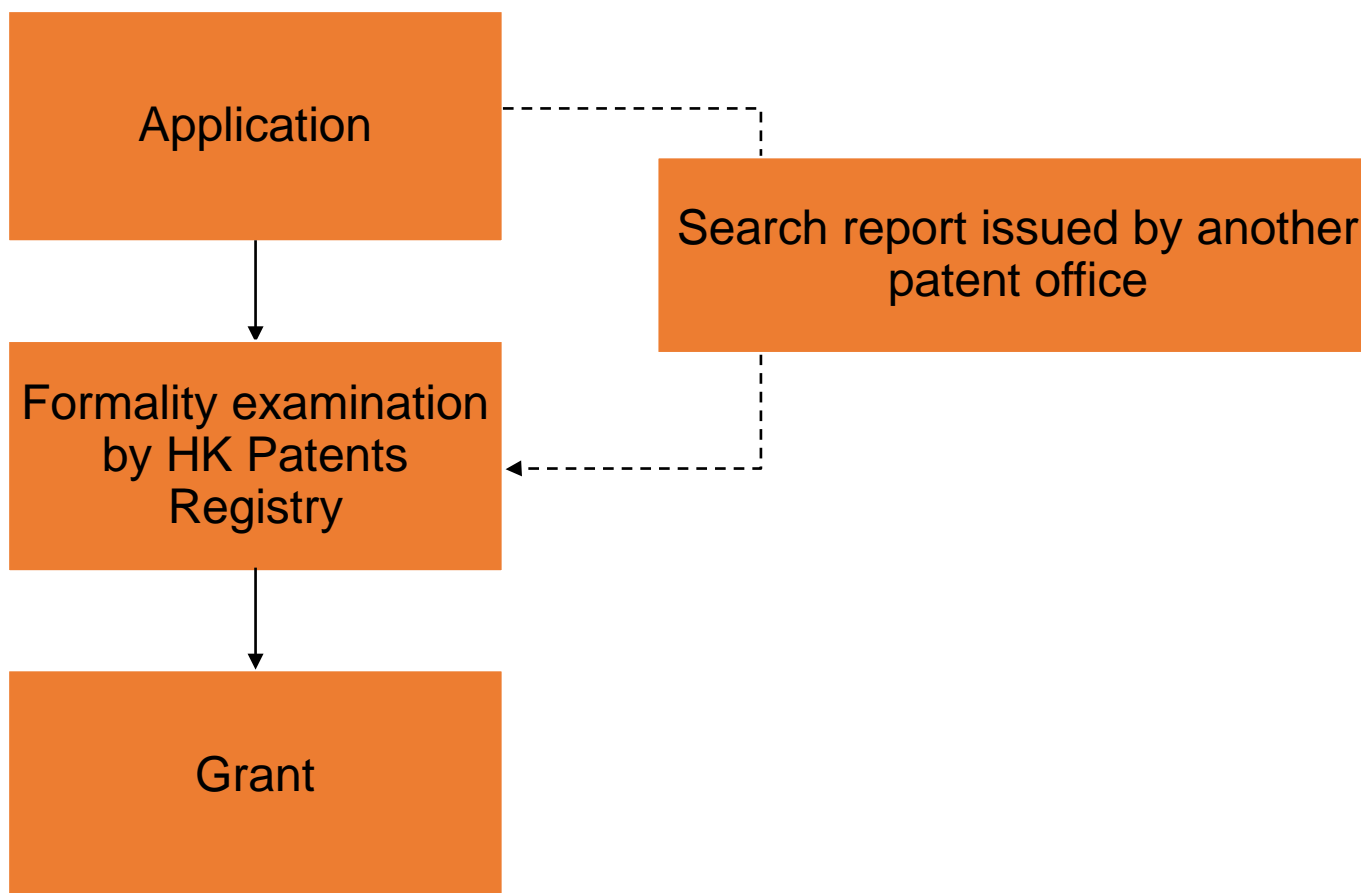
Grant

Re-register within
6 months from
grant





Present: Short-term Patent





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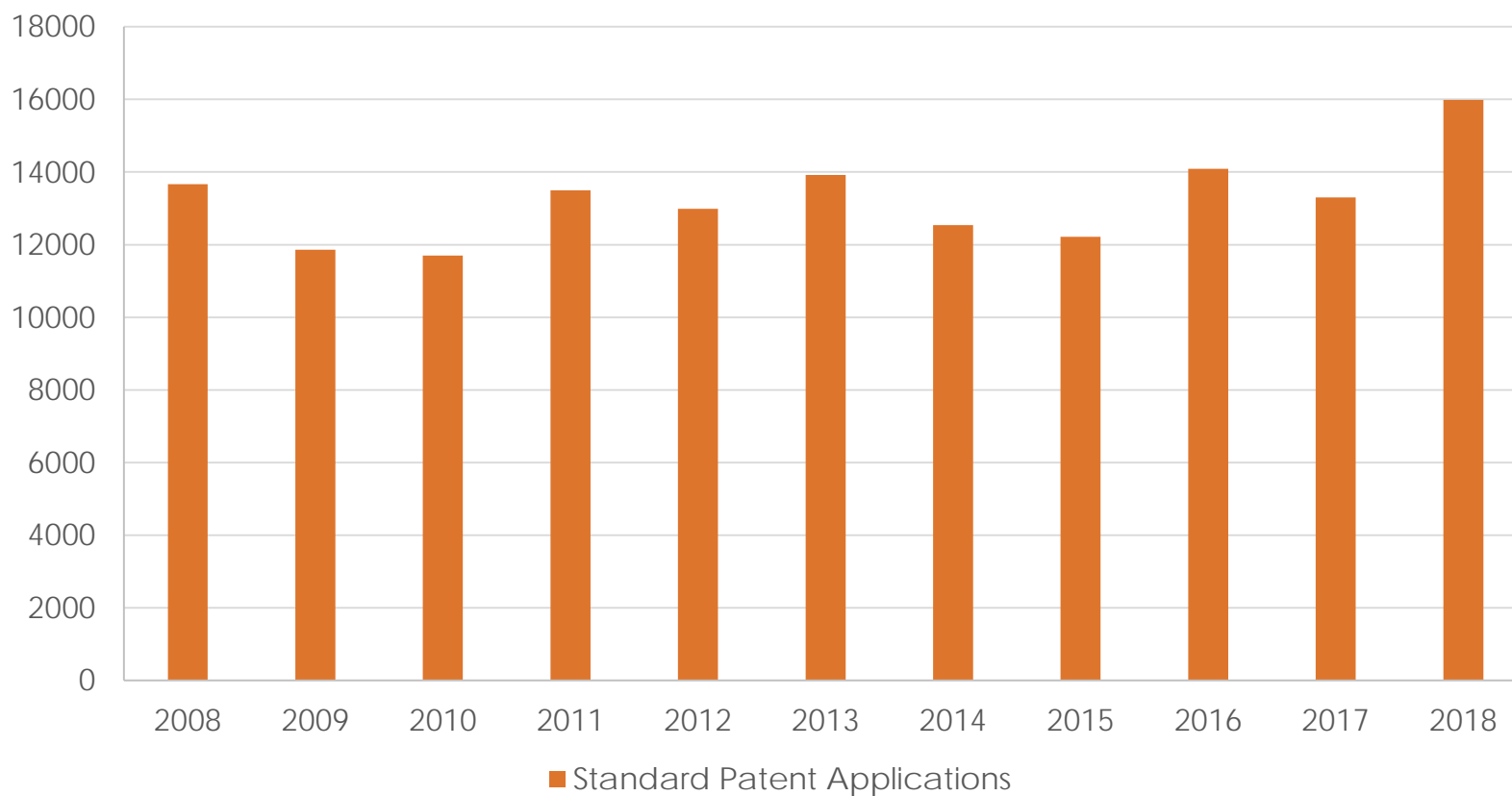
Comparison

	Standard Patent	Short-term Patent
Maximum Protection Term	20 years	8 years
Pre-application/ registration	First applied/registered in CNIPA / UKIPO / EPO(UK)	Not required
No. of Claims	Unrestricted	Restricted to 1 independent claim
Formality Examination	Conducted by HK Patents Registry	Conducted by HK Patents Registry
Substantive Examination	Conducted by designated patent office	Not required



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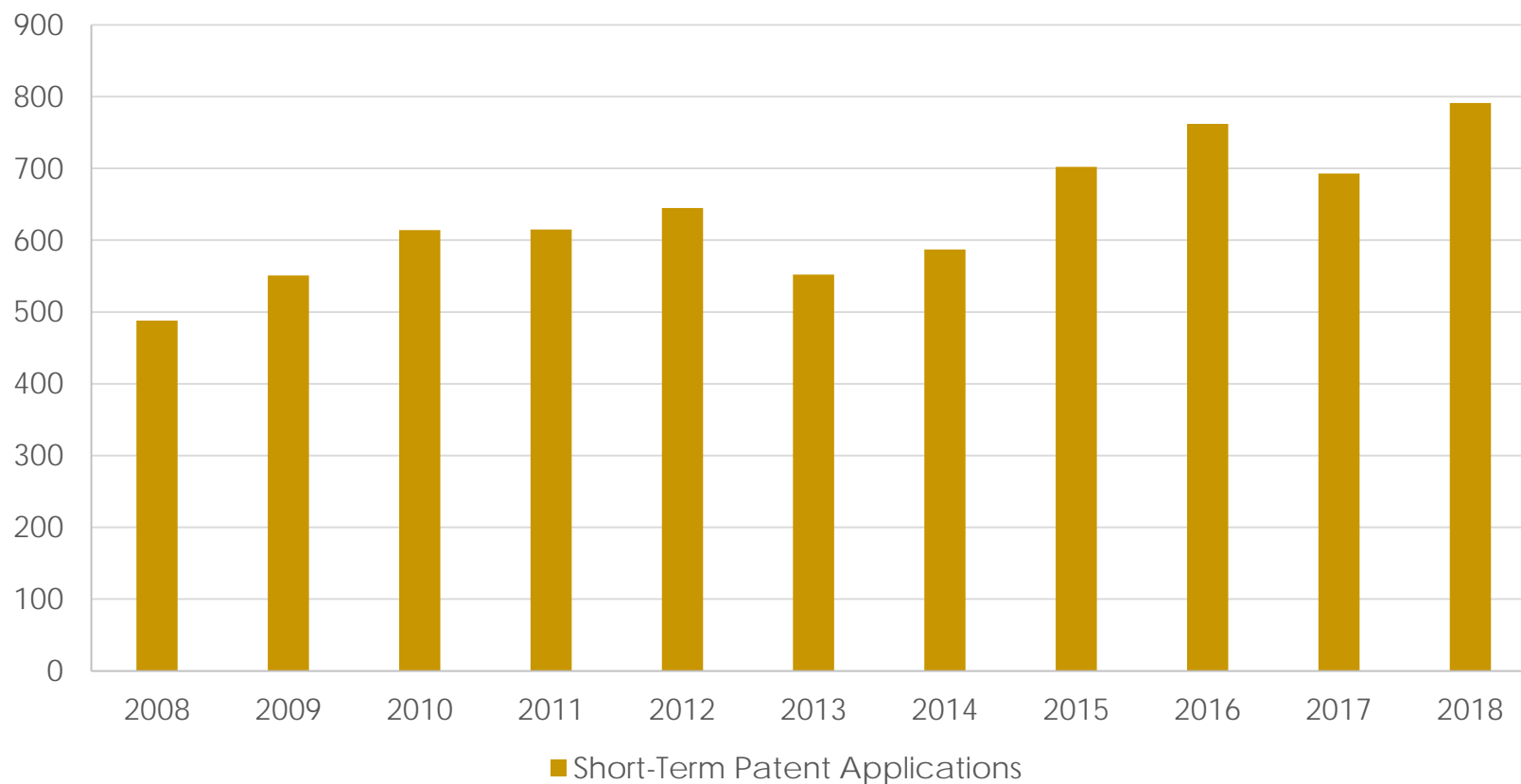
Volume of HK standard patent applications (Re-registration)





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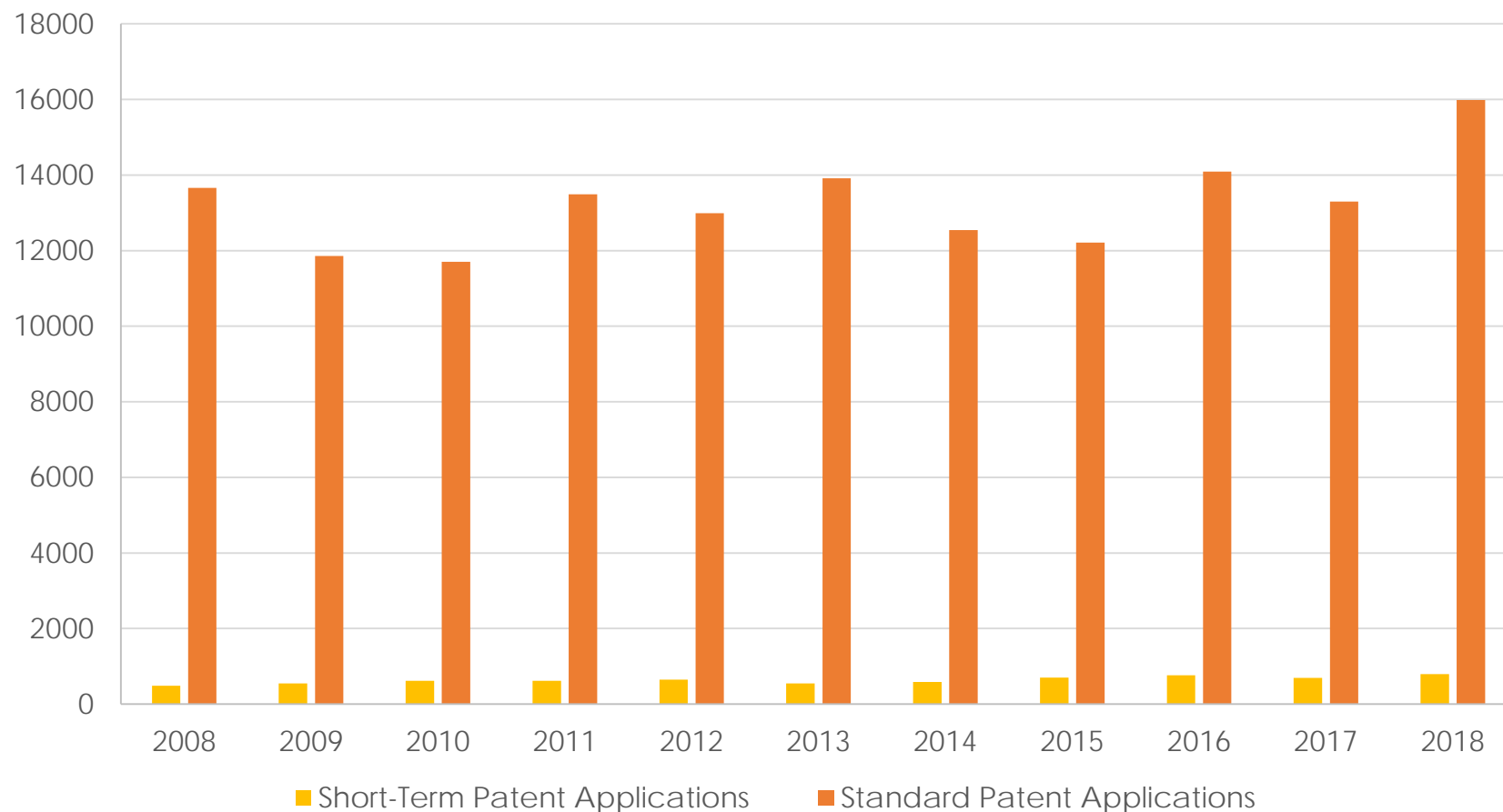
Volume of HK short-term patent applications





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Volume of the HK patent applications

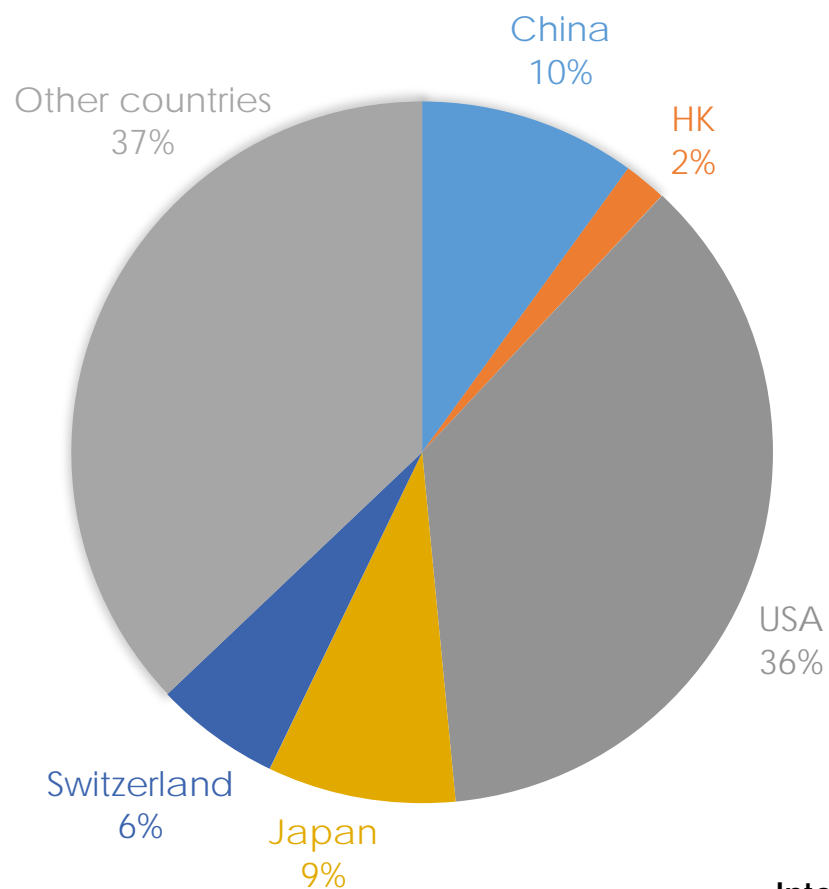




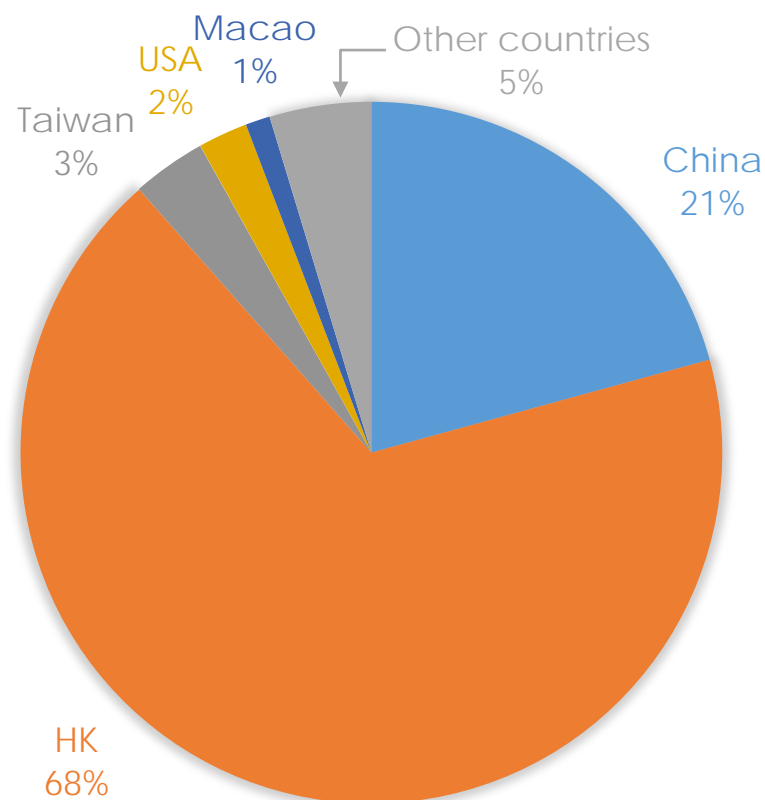
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Distribution of applicants

Standard Patent



Short-term Patent



Source : Statistics of 2018



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Major amendments on Patents Ordinance

27/06/1997	Patents Ordinance (Cap. 514) (“PO”) came into operation
01/04/2001	Intellectual Property (Miscellaneous Amendments) Ordinance 2000 <ul style="list-style-type: none">• <i>To clarify filing requirements of divisional short-term patent application</i>
01/06/2002	Intellectual Property (Miscellaneous Amendments) Ordinance 2001 <ul style="list-style-type: none">• <i>To substitute “Chinese Patent Office” with “State Intellectual Property Office”, etc.</i>
22/02/2008	Patents (Amendment) Ordinance 2007 <ul style="list-style-type: none">• <i>To add ss.72A – 72S PO on import and export compulsory licenses for patented pharmaceutical products</i>

Miscellaneous
Amendments

e.g. updating,
adapting and
editorial
amendments



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Major amendments on Patents (General) Rules

27/06/1997	Patents (General) Rules (Cap. 514C) came into operation
01/06/2002	Intellectual Property (Miscellaneous Amendments) Ordinance 2001
	<ul style="list-style-type: none">• <i>To substitute “Chinese Patent Office” with “State Intellectual Property Office”, etc.</i>
	Patents (General) (Amendment) Rules 2002
	<ul style="list-style-type: none">• <i>To provide for cases where the designated patent application concerned has no publication number or date of publication and amend requirements on specification of short-term patent</i>
20/12/2002	Patents (General) (Amendment) (No.2) Rules 2002
	<ul style="list-style-type: none">• <i>To clarify requirement to file sealed copy of court order for amendment of patent specification</i>
07/05/2004	Patents (General) (Amendment) Rules 2004
	<ul style="list-style-type: none">• <i>To facilitate electronic filing and processing of patent applications and streamline procedures</i>

Miscellaneous
Amendments

e.g. updating,
adapting and
editorial
amendments



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FROM PRESENT TO FUTURE



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Legislative Exercise for New Patent System

Oct – Dec 2011

Public consultation on review of patent system in HK

Oct 2011

Set up of Advisory Committee on Review of the Patent System in HK (“Advisory Committee”)

Dec 2012

Advisory Committee issued report on review of the patent system in HK (“Report”)

Feb 2013

Government accepted Advisory Committee’s recommendations in the Report



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Advisory Committee's Main Recommendations

Original grant patent
("OGP") system to be
introduced

Current re-registration
system retained

Refinements to short-
term patent system

Patent agency services to
be regulated



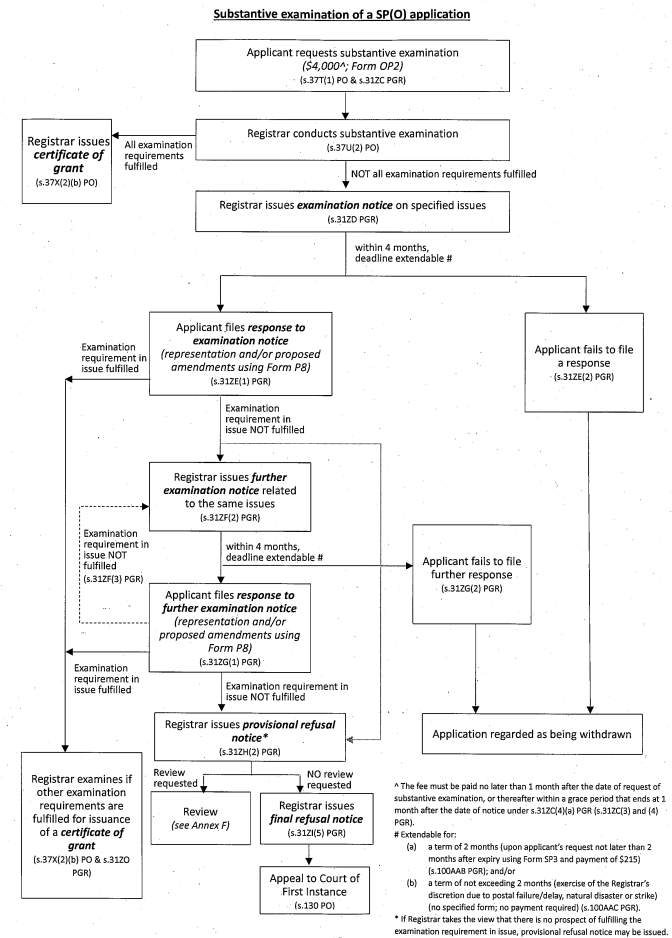
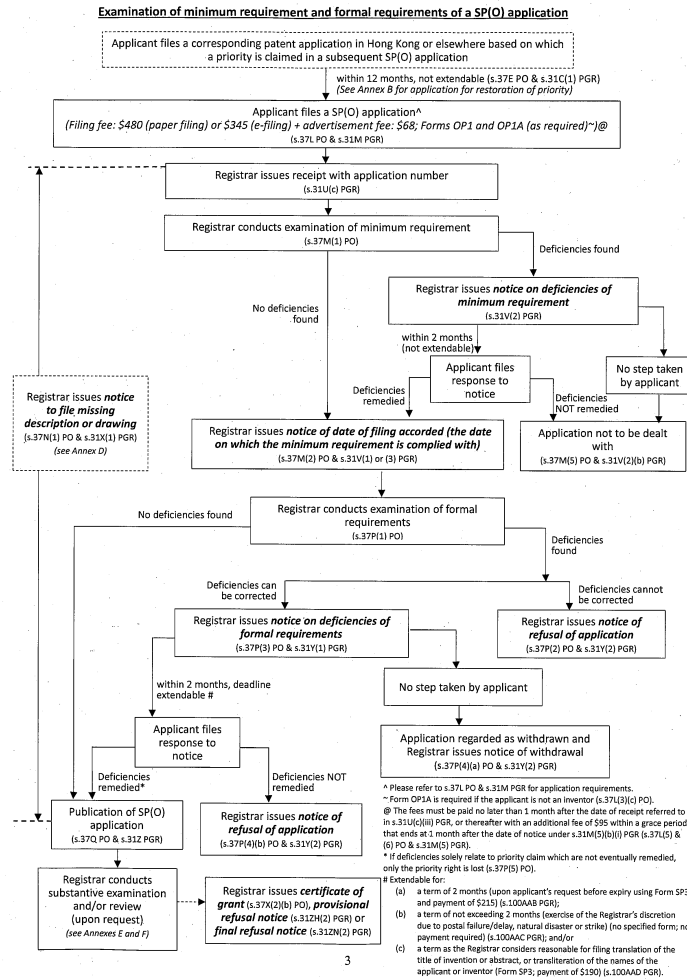
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Legislative Exercise for New Patent System

Dec 2013	Intellectual Property Department signed “Co-operation Arrangement in the Area of Patent” with Chinese National Intellectual Property Administration (“CNIPA”)
Jun 2016	Patents (Amendment) Ordinance 2016 was enacted by Legislative Council (“LegCo”) (not yet effective)
Jun 2017	Commerce & Economic Development Bureau signed “Co-operation Arrangement in the Area of Intellectual Property” with CNIPA
May 2019	LegCo completed scrutiny of Patents (General) (Amendment) Rules 2019 (not yet effective)
Late 2019?	Launch of new patent system

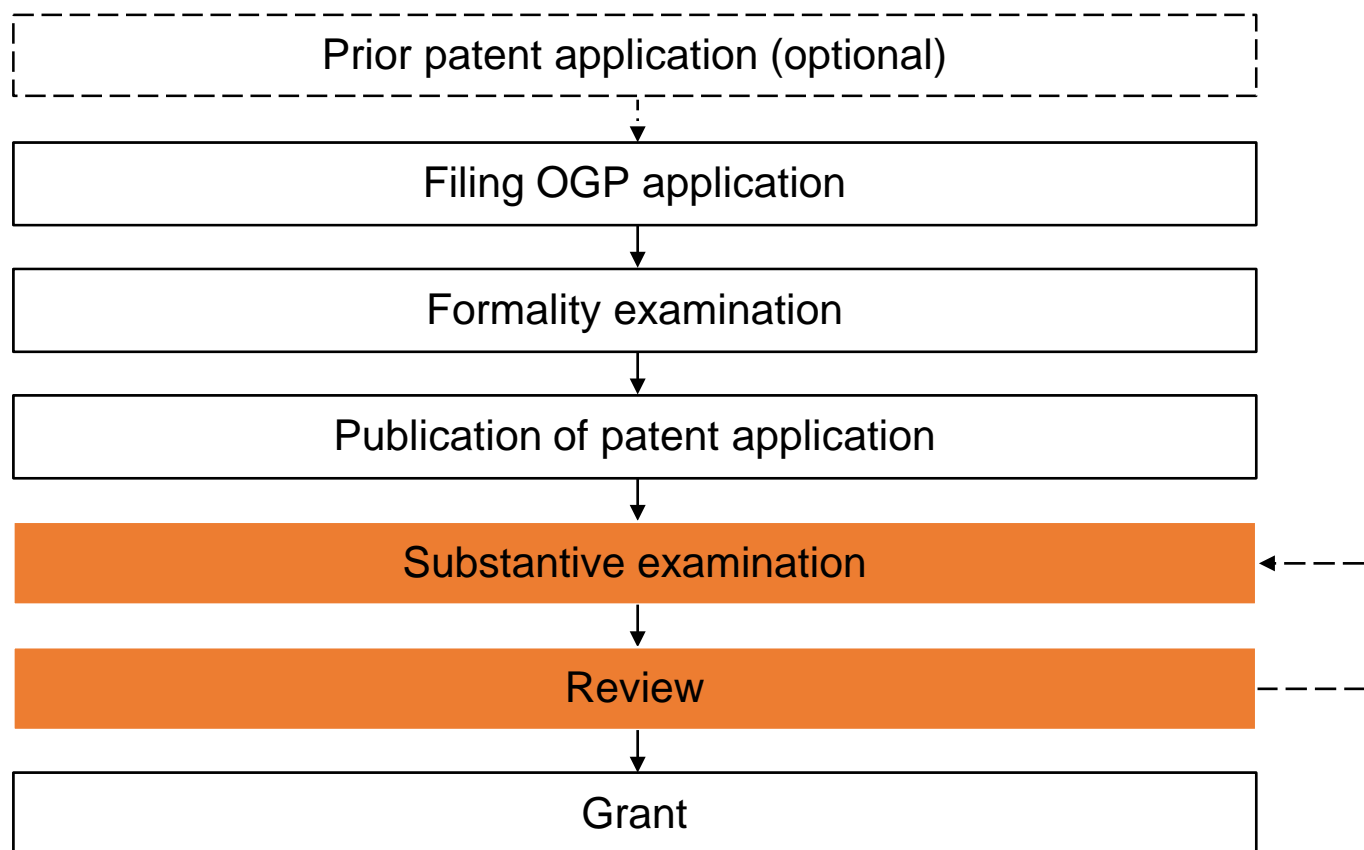


OGP system (full workflow)





OGP system (simplified workflow)





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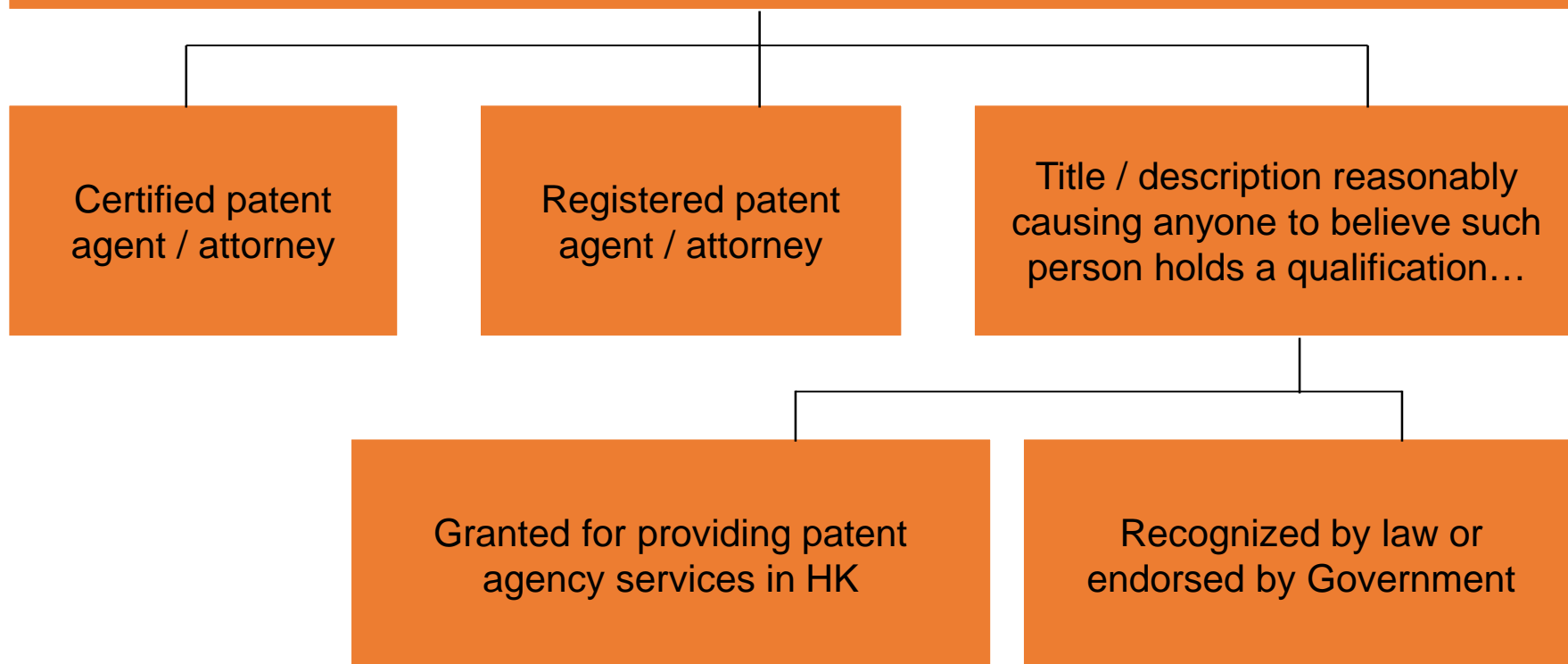
Short-term patent system (refinement)

- Maximum number of independent claims
 - Relaxing from 1 to 2
- Substantive examination
 - Available at HK Patents Registry
 - Prerequisite to commence enforcement action



Regulation of Patent Agency Services

Interim Measures – Prohibition on use of certain titles





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Regulation of Patent Agency Services

Exception

Title for providing patent
agency service in a
jurisdiction outside HK

Jurisdiction clearly
indicted in title

e.g. Registered Patent Attorney (Australia)



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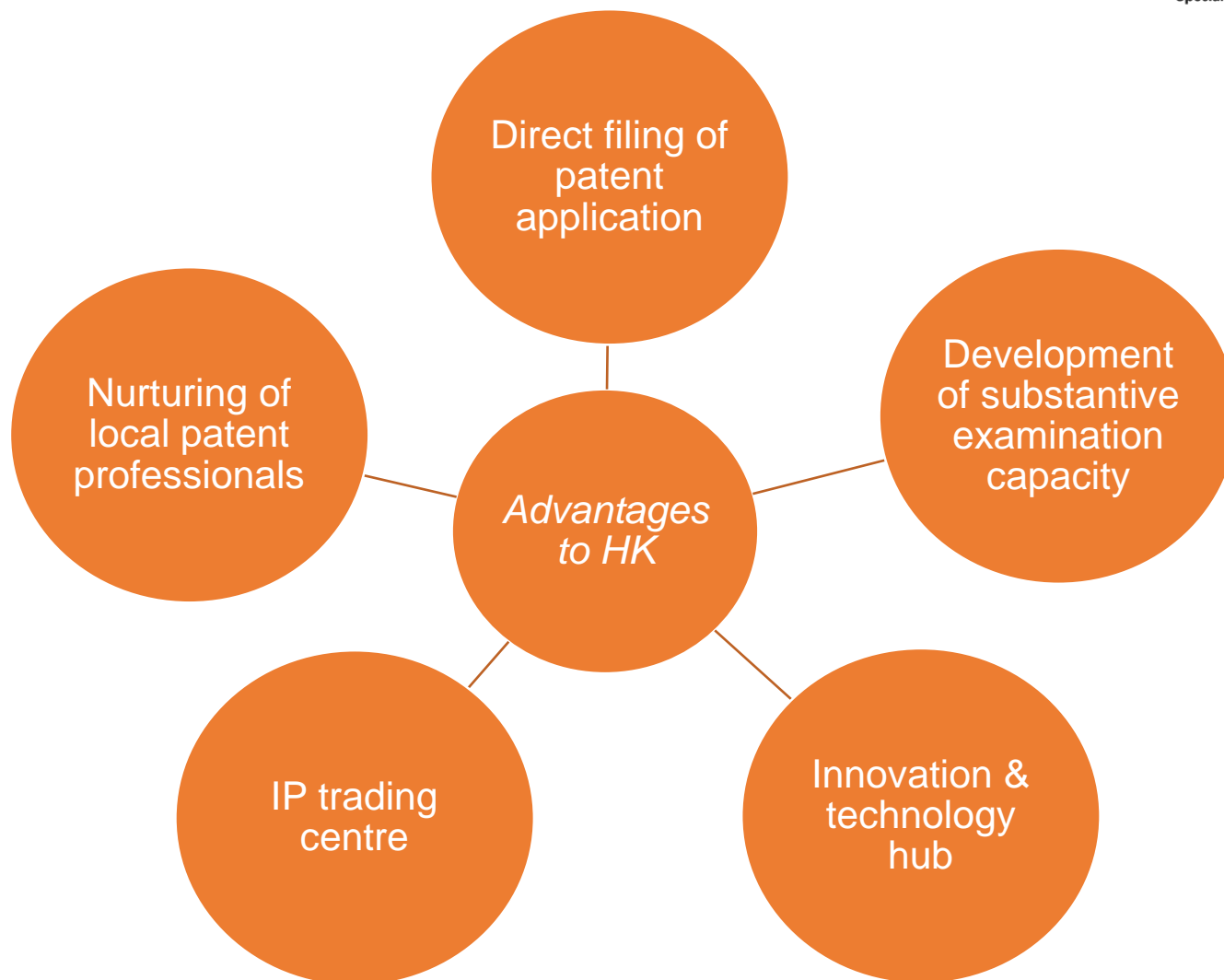
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No. of Claims	Unrestricted	Unrestricted	Restricted to 2 independent claims
Formality Examination	Conducted by HK Patents Registry	Conducted by HK Patents Registry	Conducted by HK Patents Registry
Substantive Examination	Conducted by designated patent office	Conducted by HK Patents Registry	Not required, except before commencing enforcement action



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Advantages of OGP to HK





On-going & future tasks



Before launch

After launch

- Completion of Examination Guidelines
- Completion & testing of new IT filing & processing system
- Public promotion

- Co-operation with other patent offices, e.g. PPH?
- PCT application?
- Regulation regime for patent services?



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THANK YOU