

By E-mail

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Intellectual Property Department  
Hong Kong

Dear Director of Intellectual Property

### **Consultation on Patent Reform**

I hereby set out my viewpoint regarding the consultation on patent reform as below.

#### **Standard Patent System**

- (a) What benefits will an OGP system bring to Hong Kong? Will an OGP system promote local innovation and enhance patent quality?

*An OGP system is beneficial to Hong Kong in many aspects:*

- i) *Higher legal certainty about the validity of a Hong Kong patent is provided comparing to existing short-term patent which does not involve substantive examination.*
- ii) *Less expensive and more convenient way for patent applicant to obtain a 20 year term Hong Kong patent, particularly when the applicant does not want to apply patent in China, Europe or UK.*
- iii) *The establishing of a local patent examination team in IPD for OGP would allow the IPD to provide opinions on patent infringement and patent validity issues, thus providing a cost effective route for the public to seek reliable opinions comparing to taking expensive legal actions before the court.*
- iv) *It can encourage development of the patent attorney profession, thereby improving the quality of local patent services such as patent drafting, patent prosecution, patent analysis and litigation support.*

*An OGP system can promote local innovation and enhance patent quality because:*

- i) *It encourages development of the patent attorney profession, which can provide strong support and consultation to local innovation industry*
- ii) *It also encourages the deployment of in-house patent specialist in Hong Kong R&D companies, research institutes and universities, which can play a key role in R&D decisions.*

- (b) Will there be sufficient demand to support an OGP system in Hong Kong? Will it be a cost-effective system?

*It would take time for local and overseas patent applicants to acquire confidence in the Hong Kong patent system, that it can provide sufficient legal protection for their inventions. However there will be sufficient demand to support an OGP system in the long run, as innovation and creativity is getting more and more important in Hong Kong industry. The initial cost for an OGP system may be minimized by out-sourcing part of the examination process e.g. patent searching, to overseas patent offices e.g. PRC State Intellectual Property Office. As the filing rate increases, the full implementation of OGP system within Hong Kong can be launched.*

- (c) Should we introduce an OGP system in Hong Kong with substantive examination outsourced to other patent office(s), and, if so, which office(s) and why?

*In case the Hong Kong Government finds it difficult to support the full implementation of the OGP system in one shot, outsourcing should be introduced as a transition stage for the full implementation of OGP system in the long term. PRC State Intellectual Property Office would be the perfect choice because the language capability, i.e.: to conduct patent search for patent applications in English or Chinese.*

*Alternatively, a patent prosecution highway (PPH) system can be adopted which has always been introduced between some major patent offices like USPTO, EPO, JPO.*

- (d) Irrespective of the answers to (c) above, should the current “re-registration” system be maintained, and, if so, should the system be modified as appropriate, including expansion to recognize the patents granted by other jurisdiction(s), and, if so, which jurisdiction(s)?

*As the costs for maintaining the current “re-registration” system is low, and it provides a convenient route for patent applicants to obtain Hong Kong patent as long as they have filed application in one of the three designated patent offices, the “re-registration” may be kept and run in parallel with the new OGP system.*

*In the meantime, the current “re-registration” system should be adjusted to allow grace period for late filing of the “Request to Record” and “Request for Registration*

*and Grant”, as in the practice like 2-month as of right extension for filing PCT national phase entry in China.*

### **Short-Term Patent System**

(e) What benefits does the short-term patent system bring to Hong Kong? Does it promote local innovations?

*In my viewpoint, the short-term patent system does bring benefits to Hong Kong, especially that it provides a route that is quick and non-expensive to obtain a patent as well as priority right, which is particularly important for SME or individual inventors. This would truly help nurture local innovations at its infant stage. Nevertheless, the public should be educated and the patent applicant should be clearly informed about the legal instability of a short-term patent because no substantive examination has been carried out.*

(f) Should we retain the current short-term patent system in its existing form, or should we introduce changes to the system? If the latter, what sort of changes should be introduced?

1. Should we introduce substantive examination? If so, when should it be carried out? Should it be a mandatory requirement or optional? Should it be a condition for commencement of infringement proceedings? Should the question of whether a substantive examination be carried out be left to the choice of the patent owner or a third party, and who should bear the costs?

*Substantive examination should not be introduced to short-term patent system, which will undermine the original meaning of the system.*

2. Should we extend the current term of protection? If so, how long should the term of protection be?

*It is recommended to extend the current term of protection to 10 years, such that it is in alignment with the PRC utility model which has a similar nature as short-term patent.*

3. Should we relax the present restriction on the number of claims that may be included in each patent application? If so, how many claims should be allowed in each patent application or should there be no restriction at all?

*The restriction on the number of claims should be removed but excess claims above a certain amount should be charged with extra fees to discourage abuse of patent claims.*

4. Should we lower the threshold for patentability for short-term patents? If so, what alternative threshold should be applied?

*It is not recommended to introduce a different threshold for patentability for short-term patents comparing to standard patent because it is difficult to give a clear definition of such threshold in practice and will cause further legal uncertainty to the validity of a short-term patent.*

5. What other changes are required?

*If OGP system is to be introduced, there should be a mechanism to allow a patent applicant to convert a short-term patent to an OGP patent to pursue a longer term of 20 years.*

- (g) Should we discontinue the short-term patent system altogether?

*The short-term patent system itself has a unique position and value in the whole Hong Kong patent system and should not be discontinued.*

## **Regulation of Patent Agency Services in Hong Kong**

- (h) Should Hong Kong have a regulatory regime for professionals providing patent agency services? Should the promulgation of a regulatory regime or otherwise be made dependent on whether an OGP system is to be implemented in Hong Kong?

*It is necessary to introduce a regulatory regime for professionals providing patent agency services. As the substantive part of patent agency services such as patent drafting, prosecuting patent application, validity analysis and infringement analysis, all involve sound understanding of the patent subject matter as well as the patent law, a qualification system for patent professionals must be established and continuous regulation is essential to make sure appropriate patent agency services are provided to the public. Without proper regulation, the public would be misled by the use of title “patent attorney”, “patent agent”, etc. by non-qualified persons and be suffered from poor patent services, resulting in serious tragedies that the whole legal validity or commercial value of the patent would be jeopardized. Such abuse use of title will also hinder the growth of patent and legal industry in Hong Kong.*

- (i) If a regulator regime is to be introduced for providers of patent agency services,
1. Should we restrict the provision of such services to persons meeting certain qualifications or requirements only? Or should we limit the use of particular titles only but allow the provision of such services by any person?

*The practice in PRC is recommended, that is, the provision of such services should be restrict to persons holding the patent attorney qualification only. Merely limiting the use of particular titles would have no meaning in stopping low quality patent services being provided to the public.*

2. should the regulation apply to all types of patent agency services or only to certain services e.g. the drafting and amendment of patent specifications under an OGP system?

*For reasons discussed in (h) , the regulation should apply to all types of patent agency services that require patent agency expertise and skills, e.g. patent drafting, patent prosecution, patent validity and infringement analysis.*

Best Regards

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