

REFORM OF THE PATENT SYSTEM IN HONG KONG

Patent protection

In Hong Kong, patents are granted to protect inventions. Inventions that are new, involve an inventive step, are industrially applicable and do not belong to the excluded classes (e.g. discoveries, scientific theories, and surgical methods for treatment of human) are patentable. An owner of a Hong Kong patent for an invention has to disclose the invention in exchange for the right to exclude others from using the invention within Hong Kong for a limited period.

New patent system [Effective 19 December 2019]

The new system enables applications for the following types of patents in Hong Kong:

- (a) **standard patents** with a maximum protection term of 20 years via:
 - (i) the new and direct local **original grant patent** (“OGP”) route; or
 - (ii) the existing “re-registration” route based on an earlier corresponding patent application filed with the patent office in Mainland China or the United Kingdom, or the European Patent Office (for patent applications designating the United Kingdom); and
- (b) **short-term patents** with a maximum protection term of 8 years via the existing direct local route.

New system features

A new and direct local OGP route for filing standard patent applications

A standard patent application can be filed directly in Hong Kong via the OGP route without the pre-condition

of filing an earlier corresponding patent application outside Hong Kong. An OGP application is subject to, in addition to formality examination, substantive examination by the Registrar of Patents for determining the patentability of the underlying invention.

Refinements to short-term patent system

- (a) A short-term patent application may contain up to 2 independent claims.
- (b) A short-term patent owner or a third party having reasonable grounds or legitimate business interests may request the Registrar of Patents to conduct substantive examination of the patent. Such request is a prerequisite to commencing an enforcement action.
- (c) A person who threatens another person with infringement proceedings relating to an unexamined short-term patent must, upon request by any party aggrieved by the threat, provide adequate information for identifying the patent in question, or else the aggrieved party may be entitled to relief on the basis of groundless threat of infringement proceedings.

Prohibiting use of certain titles and descriptions relating to patent practice

The use of confusing or misleading titles or descriptions (including “registered / certified patent agent” and “registered / certified patent attorney”) in Hong Kong is prohibited. On the other hand, it is permitted to use in Hong Kong any clearly indicated

title or description that solely relates to a person’s qualification for lawful provision of patent agency services in a jurisdiction outside Hong Kong.

Benefits of new patent system

Cost-effectiveness

The new OGP system helps reduce the patenting costs and time for obtaining standard patents in appropriate cases.

Promoting filing flexibility

Standard patent applicants may choose to use the OGP or the “re-registration” route according to their individual business needs. Hong Kong has a strong pool of professionals to offer patent applicants advice on their best patenting strategies.

Enhancing system integrity

The introduction of post-grant substantive examination safeguards against potential abuse of the short-term patent system while maintaining the overall cost-effectiveness of seeking short-term patent protection

Facilitating development of Hong Kong

The reform of the patent system promotes local innovation and attracts enterprises to set up R&D operations in Hong Kong, thereby facilitating the development of our innovation and technology sector.

Further information

The new patent system in Hong Kong

www.ipd.gov.hk/eng/intellectual_property/patents/New_Patent_System.htm

Patent application forms and fees

www.ipd.gov.hk/eng/forms_fees/patents.htm