

The Patents (Amendment) Ordinance 2016 is scheduled to be in force on 19 December 2019. This article is concerned with the new patent system to be launched under the Ordinance in Hong Kong.

Existing patent system

Two types of patent applications, namely standard and short-term patents are permitted in Hong Kong. Both are only subject to formality examination by the Patents Registry.

Introduction of an original grant patent (OGP) system

There will be a direct filing route for seeking standard patent protection in Hong Kong without the need to have a corresponding patent application for the same invention in Mainland China, the United Kingdom or the European Patent Office (for patent applications designating the United Kingdom).

Application for a standard patent under the OGP route will be subject to substantive examination by the Patents Registry for determining the patentability of their underlying inventions.

It is believed that the new OGP system can help reduce costs and time for obtaining standard patents by local inventors, and promote the development of local expertise for drafting and prosecuting patent applications.

Substantive examination for short-term patents

Under the existing patent system, only one independent claim is allowed in each application for a short-term patent. The new patent system will allow two independent claims in each application.

Post-grant substantive examination by the Patents Registry will be required under the new patent system upon request by the proprietor or a third party having reasonable grounds or legitimate business interests for determining its validity. Besides, the proprietor must file such a request before commencing legal proceedings to enforce the short-term patent at issue. In case the proprietor threatens another person with infringement proceedings relating to an unexamined short-term patent, he or she is also required to provide adequate information to identify the patent at issue upon request by the alleged infringer.

These amendments will give the applicants more flexibility by lifting the restriction of one independent claim in short-term patent applications under the existing patent system and safeguard potential abuse of short-term patent rights in litigation.

Regulation of titles/descriptions relating to patent practice

Use of confusing or misleading titles/descriptions such as “registered/certified patent agent, registered/certified patent attorney” will not be allowed in Hong Kong unless the jurisdiction where the titles or descriptions of any qualifications were lawfully obtained for patent practice are clearly stated.

The new patent system is expected to be a milestone leading Hong Kong to be a regional innovation and technology hub.

Please note that the comments herein are for general purpose and full professional advice should be sought on any specific patent-related matters.

