

## Patent Rights in Hong Kong and Their Enforcement

### 香港專利權及權力執行



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香港因其歷史背景，擁有獨特的專利制度。“專利條例”（第514章）連同其他有關規則（第514A至514C章）構成了香港專利法規的主要部分，基本上源於英國的普通法制度。在主權移交中國後，香港對其法律制度作了相應的調整。考慮到香港的經濟及科技發展規劃，專利法修正以及專利制度的改革正在進展當中。

### 香港專利的類型

香港專利制度有兩種專利權利，分別是標準專利和短期專利。此兩種專利的資料比較如下。

	標準專利	短期專利
申請性質	兩個階段的註冊 階段 1：在指定專利申請公開後 6 個月內請求記錄； 階段 2：在指定專利授權後請求註冊和批予	在香港直接提交申請
授權要求	指定專利授權	檢索報告的支持
專利年期	從指定專利的申請日起 20 年	從申請日起 8 年
實質審查	沒有。（指定的專利局會審查相應的專利申請）	沒有
授權所需時間	3 - 5 年，取決於指定專利的審查進度	5 - 18 月（平均約 6 個月）

香港的專利制度本身並沒有就專利申請的新穎性和創造性提供實質審查，而香港專利制度可以說是基於再註冊。標準專利註冊可基於來自三個指定專利局其中一個的專利申請，這三個指定專利局包括中國知識產權局（CNIPA）、歐洲專利局（EPO）和英國知識產權局（UKIPO）。這表示如果指定的專利局沒有相應的專利申請，標準專利則不能直接在香港提交。

相反，短期專利可以直接向香港知識產權署（HKIPD）的專利註冊處提交。短期專利可以要求在任何巴黎公約國或WTO成員國的專利申請優先權，反之亦然。短期專利適用於商業生命週期較短的產品，並且與標準專利相比，短期專利通常可以較早獲得授權。短期專利的審查效率可能與中國和德國的實用新型相當，但短期專利還包括非結構類發明，例如方法和工序，而實用新型則不包括。

### 專利權的執行

在香港，專利侵權不屬於刑事罪行，正如世界上許多地方，而大多數與專利有關的糾紛都是通過民事訴訟、仲裁或調解解決的。“仲裁（修訂）條例”已於2018年1


月1日生效，確認了知識產權糾紛可以通過仲裁解決。仲裁和調解為涉事各方在尋求權利時提供了更高自主性和靈活性。在民事訴訟中，專利權人可以向高等法院原訟法庭起指控訴侵權人。專利權人可以在專利訴訟中提出的請求包括：

- ▶ 要求作出強制令，以制止被告人作出侵犯行為；
- ▶ 要求作出命令，以規定被告人交出或銷毀任何專利產品；
- ▶ 要求侵權賠償；
- ▶ 要求被告人交出因侵權所獲得的利潤；
- ▶ 要求作出宣布，聲明專利有效並為被告人所侵犯。

對於專利，在任何強制執行情況中，專利所有人必須首先向法庭證明該專利是表面有效的。作為一般的訴訟策略，被告可以提出針對該專利的無效宣告請求，以應對專利所有人的專利侵權起訴。

在決定專利糾紛的解決方法之前，應該進行更多分析以評估可能的成果和風險。在香港，專利訴訟的成本通常在財政和時間方面都是巨大的，因此對一般專利所有人來說是過高的。此外，目前並沒有專門的法院或法官來處理專利案件，因此專利訴訟的結果往往是難以預測的。在另一方面，香港是一個國際貿易中心，稅率低且外匯管制較寬鬆。此外，香港是一個人口密集的城市，具有頗高的人均GDP。多項國際展覽及交易會在香港定期舉辦，這帶來了不少商機。因此，對於一些企業來說，香港仍是一個可觀的市場，民事訴訟仍可作為一種執行專利權的手段。

### 競爭條例和專利執行

競爭委員會的2018年度年報指出：競委會於2017年4月1日至2018年3月31日期間共收到789宗投訴／查詢。自“競爭條例”在2015年12月全面生效以來，至2018年3月期間累計投訴／查詢有2894宗。與專利執行有關的反競爭行為可能違反條例的第一行為守則（聯合各方之間的協議）或第二行為守則（濫用市場影響力）。這些違規行為包括違反第一行為守則的合謀行為、獨家交易，以及違反第二行為守則的搭售及捆綁銷售、拒絕交易和掠奪性定價。儘管如此，在確定與專利執行有關的反競爭行為時應考慮其他因素，因為在正常執行情況下，專利權的排他性質是固有且合法的。專利權與市場利益之間的平衡似乎要因個案而異，需要充分理解案件背景。在大多數情況下，條例不會影響正常的專利執行，除非該執行對香港的市場競爭造成相當程度的不利影響。



# Patent Rights in Hong Kong and Their Enforcement

Hong Kong has a unique patent system due to its historic background. The Patents Ordinance (Cap. 514) along with other related rules (Caps. 514A – 514C) forming the main part of the city’s patent laws, are basically derived from the UK common law system. After the transfer of sovereignty to China, Hong Kong has adopted some adjustments into its law system accordingly. In view of the economic and technological development plan of the city, amendment to the patent laws and the reform of the patent system is still in progress in Hong Kong.

## Types of Patents in Hong Kong

The patent system of Hong Kong consists of two types of patent rights, namely standard patent and short-term patent respectively. These two types of patent are discussed comparatively below.

	Standard Patent	Short-term Patent
Nature of application	2-stage Registration Stage 1: Request to record within 6 months after the publication of the designated patent application; Stage 2: Request for registration and grant within 6 months after the grant of the designated patent	Direct filing in Hong Kong
Requirement for grant	Grant of the designated patent	8 years from the filing date
Patent term	20 years from the filing date of designated patent	8 years from
Substantive examination	No. (There is examination for the corresponding patent application in designated patent office)	No
Time needed for grant	3 – 5 years depending on the progress of examination for the designated patent	5 – 18 months (about 6 months on average)

The patent system of Hong Kong itself does not provide substantive examinations on novelty and inventiveness of patent applications, and we can say Hong Kong patent system is based on re-registration. Standard patent registration can be done on the basis

of a patent application from one of the three designated patent offices, i.e. the China Intellectual Property Administration (CNIPA), the European Patent Office (EPO) and the United Kingdom Intellectual Property Office (UKIPO). It means that a standard patent cannot be filed directly in Hong Kong without having a corresponding patent application in one of the designated patent offices.

For a short-term patent, it can be filed directly with the Patent Registry of the Hong Kong Intellectual Property Department (HKIPD). The priority filing date of a patent application in any Paris Convention country or WTO member country can be claimed in a short term patent. Generally speaking, short-term patent is suitable for a product with shorter commercial life cycle and it can be granted earlier compared with standard patent. The examination efficiency of short-term patents may be comparable to utility models in China and Germany, but short-term patents also cover non-structural inventions such as methods and processes while utility models do not.

## Enforcement of Patent Rights

In Hong Kong, patent infringement is not a criminal offence. Like many parts of the world, most patent-related disputes in Hong Kong can be resolved by means of civil proceedings, arbitration or mediation. The Arbitration (Amendment) Ordinance, effective on 1 January 2018, confirms that IP disputes can be resolved by arbitration. Arbitration and mediation offer the parties involved with higher autonomy and flexibility in pursuit of their rights. In civil proceedings, the patent owner may file an action against the alleged infringer at the Court of First Instance of the High Court. The claims that can be made in a patent litigation by the patent owner include, without limitation, the following:

- ▶ an injunction restraining the defendant from the infringement act;
- ▶ an order requiring the defendant to deliver up or destroy any infringing product;
- ▶ damages in respect of the infringement;
- ▶ an account of the profits derived by the defendant from the infringement; and
- ▶ a declaration that the patent is valid and has been infringed by the defendant.

For patent, its owner being the plaintiff has the burden of proof that the patent itself is prima facie valid in any civil proceedings before the court. As one of the common strategies, the defendant may file an invalidation request against the patent in response to the allegations of patent infringement made by the patent owner.

There are a number of factors to be considered for a patent dispute. More analysis should be done to evaluate all possible outcomes and risks. Patent owners in Hong Kong are not keen to initiate legal proceedings for patent infringement because the time and costs involved are usually tremendous. Besides, there is no specific IP court or judge in Hong Kong. Outcomes of patent litigations would tend to be unpredictable. Nonetheless, Hong Kong is an international trading hub with low tax rate and less strict foreign exchange control. Besides, it is a highly populated city with a high GDP per capita. A number of international fairs and exhibitions are regularly hosted in Hong Kong every year, thereby bringing a lot of business opportunities. For these reasons, Hong Kong is still a considerable market for some enterprises, and civil proceedings are feasible for them as a means for enforcement of patent right.

## Competition Ordinance and Patent Enforcement

Competition Commission states in its annual report 2018 that a total of 789 enforcement contacts were received between 1 April 2017 and 31 March 2018, and the accumulated enforcement contacts were 2894 since full commencement of the Competition Ordinance in December 2015 to March 2018. Anti-competition acts related to patent enforcement may violate the First Conduct Rule (agreements of associated parties) or the Second Conduct Rule (abuse of market power) of the Ordinance. These violating behaviours include cartel conduct and exclusive dealing in contravention with the First Conduct Rule, as well as tying and bundling, refusal to deal and predation in contravention with the Second Conduct Rule. Having said that, other factors should be considered in determination of anti-competition acts associated with patent enforcement, as the exclusive nature of patent rights is intrinsic and legitimate under typical enforcement. It seems that the balance between patent rights and market benefits is to be determined case by case, and a full comprehension of each case context is needed. In most cases, the Ordinance should have no implication on patent enforcement unless substantial adverse effect on market competition occurs in Hong Kong. 