

## Intellectual Property & Technology

### New original grant patent system to be launched in Hong Kong

#### Introduction

A new patent system will be introduced by the Hong Kong Intellectual Property Department on 19 December 2019, which is to be effected by the commencement of operation of the Patents (Amendment) Ordinance 2016 and the Patents (General) (Amendment) Rules 2019. This article will explore the three notable features of the new patent system, namely: (i) introduction of a new and direct local original grant patent (“**OGP**”) route for filing standard patent applications; (ii) refinement of the existing short-term patent system; and (iii) regulation of the use of titles and descriptions relating to patent practice.

#### New and direct local OGP route for filing standard patent applications

##### Existing system

Standard patents are valid for a maximum term of 20 years. Under the existing patent system, a standard patent application must be timely filed in Hong Kong based on a corresponding patent application for the same invention in one of the three designated patent offices outside Hong Kong, namely (1) the State Intellectual Property Office of the People’s Republic of China (the “**SIPO**”), (2) the European Patent Office or (3) the United Kingdom Patent Office (the “**Re-registration Route**”). Patent applications under the Re-registration Route are only subject to formality examination by the Patents Registry, meaning that they are not subject to substantive examination for determining the patentability of the underlying inventions. The Patents Registry is only responsible for re-registering foreign-approved patents.

##### New system

Under the new OGP route, applicants may file patent applications directly in Hong Kong with the Patents Registry, independent of the three aforementioned designated patent offices outside Hong Kong, thereby dispensing with any prior filing of corresponding applications as required under the existing Re-registration Route. An OGP application will be subject to, in addition to formality examination, substantive examination by the Patents Registry for determining the patentability of the underlying invention. The new OGP route will run in parallel with the existing Re-registration Route. Applicants may choose either the existing Re-registration Route or the new OGP route for registering their patents based on their own business strategies.

Hong Kong currently lacks personnel with the required technical expertise and experience to conduct substantive examination on its own. Therefore, as an interim measure, the Hong Kong Intellectual Property Department will outsource aspects of the substantive examination to the SIPO. The SIPO will provide technical opinions as to the novelty and inventive step of the claimed invention, while the Patents Registry will prepare the examination notice based on the Patents Ordinance (Cap. 514) and the opinions of the SIPO.

## **Refinement of existing short-term patent system**

### Existing system

Short-term patents are valid for a maximum term of eight years. Under the existing patent system, a short-term patent application can be filed directly with the Patents Registry in Hong Kong and is only subject to formality examination. Only one independent claim is allowed for each application.

### New system

The refined short-term patent system will increase the number of independent claims allowed in an application from one to two independent claims, provided that the two claims are related to one single invention. Further, short-term patents may be subject to post-grant substantive examination by the Patents Registry, upon request by its owner or a third party having reasonable grounds or legitimate business interests, for determining their validity. Before commencing legal proceedings to enforce a short-term patent, the owner must file a request for substantive examination of the patent with the Patents Registry. Moreover, the owner of a short-term patent who threatens another person with infringement proceedings relating to an unexamined short-term patent must, upon request by the alleged infringer, provide him or her with adequate information to identify the patent.

## **Regulation of Use of Titles and Descriptions**

It will be prohibited by law for anyone to use the following titles or descriptions relating to patent practice in Hong Kong: (1) “registered/certified patent agent”; (2) “registered/certified patent attorney”; and/or (3) any title or description which may cause anyone to believe that the person using the title/description holds a qualification that is specifically granted for approving him to provide patent agency services in Hong Kong, and such qualification is recognised by law or endorsed by the Government. On the other hand, the use of any title or description that solely relates to a person’s qualification for lawfully providing patent agency services in a place outside Hong Kong is permitted as long as the place is clearly specified.

## **Conclusion**

The new patent system is expected to bring significant benefits to Hong Kong. By allowing companies to apply for standard patent protection directly in Hong Kong, the new patent

system would provide a cost-effective filing route for applicants, in particular local applicants, in appropriate cases. Applicants for standard patents may flexibly choose to use the new OGP route or the existing Re-registration Route according to their own protection strategies. For short-term patents, the introduction of post-grant substantive examination provides safeguards against potential abuse of the short-term patent system while maintaining the cost-effectiveness of the short-term patent regime. In sum, the new patent system is a major milestone in the development of Hong Kong's patent regime which is expected to contribute to the development of Hong Kong as an innovation and intellectual property trading hub in the long run.

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**Important:** The law and procedure on this subject are very specialised and complicated. This article is just a very general outline for reference and cannot be relied upon as legal advice in any individual case. If any advice or assistance is needed, please contact our solicitors.

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