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Hong Kong

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Patent enforcement proceedings

1 Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

In Hong Kong, patent rights are enforced only through civil proceedings at the courts, and the Court of First Instance has exclusive jurisdiction over patent infringement proceedings. There is no specialised court for enforcing patent rights in Hong Kong, nor are criminal or administrative proceedings available.

2 Trial format and timing

What is the format of a patent infringement trial?

Patent infringement trials are conducted at the Court of First Instance before a single judge. Both infringement and validity are dealt with by the same judge at trial where there is a counterclaim of invalidity.

A patent infringement case is begun by writ and the issues in dispute are defined well before the trial in pleadings, which include the statement of claim, the defence and the reply.

In advance of the trial, both parties are required to submit skeleton arguments as well as documentary evidence such as expert reports, prior art, affidavits and witness statements.

Facts required to be proved at the trial shall be proved by examination, cross-examination and re-examination of witnesses orally and in open court. There is no jury involvement at trial.

Experts are typically used by the parties to prove, for example, what constitutes state of the art or what skills or know-how would a person skilled in the art possess when inventiveness or obviousness are in issue. Where appropriate, a court may appoint a scientific adviser to assist as a court adviser.

A patent trial may last between a few days to a few weeks, depending on the complexity of the technology and the issues in dispute.

3 Proof requirements

What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The party who makes an assertion or allegation of infringement, invalidity or unenforceability of a patent is required to bear the burden of proof, and the standard of proof in a patent case is the standard of balance of probabilities in civil proceedings.

An exception to the above is the reversal of the burden of proof where the claim of a patent is in a process for obtaining a new product. In such a case, the defendant has the burden of proof that the new product is not produced by the patented process.

4 Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

A patent proprietor or an exclusive licensee of a patent may sue for patent infringement. Where an exclusive licensee brings a patent infringement suit, the patentee must be joined as either a co-plaintiff or a co-defendant pursuant to section 86 of the Patents Ordinance.

A person who is accused of patent infringement can apply for a declaration as to non-infringement under section 90 of the Patents Ordinance if the person has applied to the patent proprietor for an acknowledgement of non-infringement in writing and the patent proprietor failed or refused to provide such an acknowledgement.

Where a person is aggrieved by threats of proceedings for infringement of a patent infringement by circulars, advertisements or otherwise, the person may bring proceedings against the threatening party and seek a declaration of unjustifiable threats, an injunction against continuance of unjustifiable threats and damages under section 89 of the Patents Ordinance.

The unjustifiable threats provision has been increasingly used by patent infringers to take pre-emptive steps to put themselves into the role of a plaintiff of an unjustifiable threat claim and wait for counterclaim of infringement rather than becoming a defendant in a patent infringement suit.

5 Inducement, and contributory and multiple party infringement

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

A person who is alleged to have induced patent infringement can be joined as a co-defendant in patent infringement proceedings for being a joint tortfeasor by acting in common design if the person is closely involved with the infringement. This common law allegation is often used to obtain discovery of documents from the alleged inducer or to personally involve management members of the alleged infringer to press for early settlement.

Section 74 of the Patents Ordinance provides that a person can be held liable for indirect or contributory infringement of a patent if that person supplies or offers to supply in Hong Kong another person with means to induce that other person to commit patent infringement.

Where a person supplies a non-stable commercial product relating to an essential element of the invention for putting the invention into effect, the supply person can be held liable under section 74 for contributory infringement if the person knows, or ought to have known, that the means are suitable and intended for putting that invention into effect in Hong Kong.

As a product could be assembled from a plurality of patented components, it follows that multiple parties can be jointly liable for patent infringement.

Avent Limited et al v Prominent Wing Limited (HCA 480/2008) is an exemplary case of the finding of common design among the multiple defendants in a patent infringement case involving Hong Kong Patent No. HK1,033,804. In this case, the fourth defendant is the sole director of the third defendant, which is a dormant UK company.

The Patents Ordinance does not provide express guidance on cases where each one of a plurality of parties only practises one or some steps of a patented process. However, a product that is obtained directly from a patented process is an infringing product under section 73(c) of the Patents Ordinance. Accordingly, a person putting such an infringing product on the market would be an infringing party.

6 Joinder of multiple defendants

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing the same patents?

A lawsuit having multiple defendants is common, and parties can be included as joint defendants if they are joint tortfeasors, if they have a common design to infringe a patent or if a director is personally responsible in infringing a patent, among other reasons.

7 Infringement by foreign activities

To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

A Hong Kong patent is a statutory creation of the Patents Ordinance and has no effect outside Hong Kong. Therefore, activities that take place outside Hong Kong do not support a charge of patent infringement.

8 Infringement by equivalents

To what extent are 'equivalents' of the claimed subject matter liable for infringement?

The concept of equivalents for determining whether there is infringement of the claims of a patent is not a concept recognised by courts in Hong Kong. Specifically, the scope of a Hong Kong patent is determined by the claims as interpreted by the description and any drawings contained in that specification according to section 76 of the Patents Ordinance.

When interpreting patent claims, the Patents Ordinance has set out the following guidelines:

(a) in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims, on the one hand; or

(b) in the sense that the claims serve only as a guideline and that the actual protection conferred by a patent may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated, on the other hand, but rather is to be interpreted as defining a position between these extremes which combines a fair protection for the proprietor of the patent or the application for a patent with a reasonable degree of certainty for third parties.

The above guidelines are equivalent to those of UK Patents Act 1977 and article 69 of the European Patent Convention. When determining the scope of a patent claim, it is expected that courts in Hong Kong will continue to follow the purposive construction approach established in *Catnic Components Limited v Hill & Smith Limited* [1982] RPC 183 as used by the courts in England.

9 Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

A mechanism of evidence discovery is available to parties in proceedings for patent infringement under orders 24 and 103 of the Rules of the High Court at the case management summons stage.

The general principles governing discovery of documents in patent infringement cases were discussed in *Molnlycke AB v Procter and Gamble Limited* (No. 3) [1990] RPC 498 and are as follows:

- discovery must be necessary for fairly disposing of the proceedings or saving costs;
- specific discovery could be refused as being unduly oppressive after balancing value and burden;
- specific discovery orders must not cover irrelevant documents;
- discovery on obviousness was governed by the fact that obviousness was objective;
- on commercial success there could be discovery relating to processes used in the manufacture of the commercial article but not research and experimental work leading to the adoption of those processes;
- commercial success was an objective matter and it was only of relevance whether there had in fact been such success, and if there had been, whether a long-felt need had been fulfilled (discovery of patentee's internal documents relating to commercial success refused);
- documents relating to problems with prior art were relevant but not documents relating to acquisition of rights therein; and
- documents relating to experimental work up to the date of publication of the patent might be relevant to insufficiency.

For example, a plaintiff in patent infringement proceedings may seek discovery of documents against a defendant on issues raised in the particulars of infringements, but a defendant is normally not required to provide discovery of sales. Discovery of documents relating to why foreign patents have more restricted claims will also not be ordered.

10 Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

A patent infringement case is begun by writ followed by exchange of pleadings (statement of claim, defence and counterclaim, reply, etc) between parties, which would take about two to three months in total (including extension of time). A plaintiff must then take out a case management summons within one month from the deemed close of pleadings, and the following are matters usually dealt with in the case management summons:

- the service of further pleadings or particulars;
- the discovery of documents;
- the service of interrogatories and of answers thereto;
- the taking of expert evidence by affidavit;
- the service of particulars of experiments;
- experiments; and
- the hearing of preliminary issues.

In general, it may take 12 to 18 months for a patent infringement case to proceed to trial, and the trial may last a few days to a few weeks depending on the number of witnesses, oral examinations and experiments required.

11 Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal?

Costs for a patent infringement lawsuit in Hong Kong vary considerably and depend on the complexity of the case.

Many patent infringement cases are settled before trial or concluded by way of summary judgment, and the litigation costs would depend on the stage of proceedings when settlement is reached. For a patent case involving an invention that is not highly complicated, the costs for a patentee plaintiff could be in the region of HK$80,000 to HK$250,000 up to the case management summons stage. The costs for a defendant are likely to be more and could be in the region of HK$300,000 to HK$650,000, as the defendant would have the burden of conducting prior art searches as well as obtaining opinions on infringement and on the strength and weakness of the subject patent within a short time.

Costs between the case management summons stage and trial can vary considerably, and depend on the complexity of the invention, the extent of discovery, the number of witnesses such as expert witnesses required and the number and complexity of issues remaining in dispute. Costs during this stage could be in the region of HK$400,000 to HK$2 million.

Costs for trial could be expensive and depend on the number of days of trial and the seniority of counsel to be engaged. For a straightforward patent infringement case with no substantive challenge on validity, trial costs could be in the region of HK$800,000 to HK$2 million, and the losing party is usually ordered to reimburse all reasonable legal costs of the winning party.

12 Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit?

Decisions of the Court of First Instance are appealable to the Court of Appeal with permission of the trial judge. A further appeal to the Court of Final Appeal is allowable with permission of the Court of Appeal.

Appeals are not an avenue for a case to be reheard, but are available only if the decision of the lower court was wrong or was unjust due to procedural irregularity.

13 Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition or a business-related tort?

Enforcement of a patent would not generally expose the patent owner to liability for a competition violation or unfair competition since there is no competition or unfair competition law in force in Hong Kong yet (the Competition Ordinance, chapter 619 of the Laws of the HKSAR, was enacted in June 2012 but has not yet come into operation).

However, where a patent infringement suit is against a defendant who is licensee under the patent, and the licence contains tying-in provisions, the licence will be voided and it is a complete defence of non-infringement by the licensee.

Where a patent owner practises the patent in a way that is tortious in nature (for example, by selling or distributing a product bearing a trademark or copyright materials of the defendant), the patent owner could commit a business-related tort and may be sued by way of counterclaim.

14 Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Following the latest civil justice reform in Hong Kong, it is now stipulated in the civil procedural rules of Hong Kong that parties in litigation are encouraged to use an alternative dispute resolution procedure to resolve disputes. As a result, all parties to patent proceedings must, at the close of pleadings, file a mediation certificate stating whether that party is agreeable to mediation, and if not, the reason why. A party who unreasonably refuses to engage in mediation could be penalised by an adverse cost order.

Scope and ownership of patents

15 Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

An invention is patentable in Hong Kong if it is susceptible of industrial application, is new and involves an inventive step and not an excluded subject matter. The following are excluded subject matters that are not patentable:

- a discovery, scientific theory or mathematical method;
- an aesthetic creation;
- a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- the presentation of information;
- method for treatment of the human or animal body by surgery or therapy;
- a diagnostic method practised on the human or animal body;
- an invention the publication or working of which would be contrary to public order or morality; and
- a plant or animal variety or an essentially biological process for the production of plants or animals, other than a microbiological process or the products of such a process.

Medical procedures for practising on humans or animals are an excluded subject matter and therefore not patentable. Software or business methods do not fall within the excluded subject matter and are therefore patentable subject to meeting the patentability requirements above.

The patentability of Swiss-type claims in Hong Kong has been acknowledged in *Abbot GmbH v PharmaReg Consulting Co Ltd & Anor* [2009] 3 HKLRD 524.

16 Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor or multiple inventors? How is patent ownership officially recorded and transferred?

Basically, a patent on an invention belongs to the inventor unless the inventor is an employee.

Where the inventor is an employee, the issue of patent ownership will be determined by the law of the country or territory in which the employee was employed, as stipulated by sections 57 and 100 of the Patents Ordinance.

Where the employment is governed by Hong Kong law, the invention will belongs to the employer if:

- the invention was made in the course of the normal duties of the employee or in the course of duties falling outside his or her normal duties, but specifically assigned to him or her, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his or her duties; or

- the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his or her duties and the particular responsibilities arising from the nature of his or her duties, he or she had a special obligation to further the interests of the employer's undertaking.

Where the inventor employee is employed outside Hong Kong, the right to the patent shall be determined in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed or, if the identity of such country, territory or area cannot be determined, in accordance with the law of the country, territory or area in which the employer has his or her place of business to which the employee is attached.

Where there is more than one employee inventor and the employment of the employees is in different countries or territories, the patent will be co-owned and the ownership will depend on the employment of the relevant territories.

The Patents Ordinance does not expressly refer to the ownership of a patent to an invention made by an independent contractor. Therefore, in the absence of an agreement concerning ownership, the above principles also apply.

A patent is a personal property and can be transferred by assignment or mortgage. An assignment or mortgage of a patent or patent application must be in writing.

The patents register, which is maintained by the Intellectual Property Department, is charged with the responsibility of recording a change of ownership in patent.

Defences

17 Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

The validity of a patent can be challenged through proceedings at the Court of First Instance by filing an application to revoke or by way of counterclaim during infringement proceedings.

The grounds for invalidation are as follows:

- the invention is not a patentable invention;
- the patent was granted to a person not entitled to it;
- the patent specification does not disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art;
- the matter disclosed in the patent specification extends beyond that disclosed in the patent application as filed;
- the protection conferred by the patent has been extended by an invalid amendment of the patent application or specification;
- double patenting; and
- revocation of a corresponding designated patent.

Similarly to patent infringement proceedings, the Court of First Instance has exclusive jurisdiction on patent revocation proceedings.

18 Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

Absolute novelty is adopted in Hong Kong. The Patents Ordinance provides a grace period of six months on non-prejudicial disclosure exceptions to absolute novelty. The non-prejudicial disclosure exceptions include disclosure due to an evident abuse and display of the invention at a prescribed exhibition or meeting.

19 Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The Patents Ordinance provides that 'an invention shall be considered as involving an inventive step, if having regard to the state of the art, it is not obvious to a person skilled in the art'.

Whether a patent is or is not obvious to a person skilled in the art is the legal standard for determining whether a patent is inventive. This standard is not defined in the Patents Ordinance. In practice, the courts in Hong Kong have adapted the Windsurfing questions approach of the United Kingdom and the sequence of questions below is usually followed:

- identify the notional 'person skilled in the art';
- identify the relevant common general knowledge of that person;
- identify the inventive concept of the claim in question or, if that cannot readily be done, construe it (originally stated as 'identify the inventive concept embodied in the patent in suit' in the Windsurfing approach);
- identify what, if any, differences exist between the matter cited as forming part of the state of the art and the inventive concept of the claim or the claim as construed; and
- viewed without any knowledge of the alleged invention as claimed, decide whether those differences constitute steps that would have been obvious to the person skilled in the art or whether they require any degree of invention.

20 Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

There are no statutory grounds on which a Hong Kong patent can be deemed unenforceable. However, a patent can be deemed unenforceable to another party if the patentee or exclusive licensee makes misrepresentations to that other party and induces infringement.

21 Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

Prior user defence is available under section 83 of the Patents Ordinance. A person who, before the priority date either does in good faith an act that would constitute an infringement of a patent if it were in force, or makes in good faith effective and serious preparation to do such an act, has the right to continue the act and to transfer the rights to a third party.

Remedies

22 Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature?

A patentee can elect to seek damages or account of profit against a patent infringer. Damages are generally assessed on a tortious basis of what the plaintiff would have made if not for the infringement.
In addition, an infringer will be ordered by the court to pay the reasonable legal costs of the plaintiff.

23 Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

Interim injunctions to stop patent infringement before trial are available and will be ordered by the court where there is actual or implied threat of patent infringement, and provided the standards of a balance of convenience established in the American Cyanamid Guidelines are met.

An injunction is personal to the infringer and is therefore not directly effective against the infringers, suppliers or customers.

24 Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Importation of infringing goods can be blocked by order of the court, whether by way of interim or permanent injunctions. The Court of First Instance is the only forum to accomplish such blockage on patent matters.

25 Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

In general, the court will order the losing party to pay the reasonable legal costs of a successful litigant. Legal costs typically include both disbursements and attorneys' fees.

26 Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate?

There is no provision for awarding additional remedies for deliberate infringement.

27 Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

There is a six-year limitation period for seeking monetary remedy for patent infringement.

28 Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

It is not mandatory to mark a product as patented. However, the court may refuse to award damages to the patentee if the infringer can prove that he or she is not aware of the patent. Therefore, it is good practice to mark a product with a patent number such as 'HK Patent Number x,xxx,xxx'. False patent marking is a criminal offence in Hong Kong.

Licensing

29 Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

Parties are free to agree on contractual terms. However, a patent licence with tying-in provisions is void and unenforceable.

30 Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

Section 64(2) of the Patents Ordinance provides a mechanism to obtain a compulsory licence to a patent. The terms of such a licence are to be agreeable between the patentee and the applicant and shall be on reasonable commercial terms.

Patent office proceedings

31 Patenting timetable and costs

How long does it typically take, and how much does it typically cost, to obtain a patent?

Obtaining a Hong Kong standard patent will usually take two to three months after the grant of a corresponding designated patent, which could be a Chinese, EP(UK) or UK patent, provided that a Hong Kong standard patent application is made within six months of the 'A' publication date of the corresponding designated patent.

The total costs for obtaining a Hong Kong patent are in the region of HK$9,000 (excluding the costs of designated patent applications).

32. Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

Hong Kong adopts a two-tier patent system comprising 'standard patents' of a 20-year term and 'short-term patents' of an eight-year term. Since a standard patent is obtained by recordal of a patent application (designated patent application) and registration of a patent subsequently granted from that designated patent application in a two-stage recordal process, the time-to-issue is determined by, and dependent on, the processing speed of the examination authority of the designated patent application. On the other hand, a Hong Kong short term patent can be granted within several months of application and can therefore be used as a preliminary patent for enforcement prior to issue of a standard patent on the same subject matter.

33 Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The patent specification must be described in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art.

34 Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

There is no such disclosure obligation. In any event, the Patent Office does not undertake examination on substantive patentability.

35 Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

Yes, by filing a divisional designated patent application and then a Hong Kong standard patent application.

36 Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

Yes, Patent Office decisions are appealable to the Court of First Instance.

37 Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

No, the Patent Office only performs the function of a registrar and does not examine substantive patentability of an invention. In any event, the Court of First Instance is the only forum for opposition or revocation of a patent.

38 Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

No, Hong Kong adopts a first to file system. Accordingly, the applicant with the earlier filing or priority date will get the patent.

39 Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

The Patent Office does not provide such procedures. A patentee can request the Court of First Instance to allow amendments of a patent during a lawsuit, provided that no new matter is added and no broadening of claims results.

40 Patent duration

How is the duration of patent protection determined?

For a standard patent, 20 years from the date of filing of the designated patent application.

For a short-term patent, eight years from the date of filing.

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