

INFORMATION ON HONG KONG PATENT PROCUREMENT

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Legal basis

The "Patents Ordinance" (Originally 52 of 1997) was effectuated June 1997, L.N. 362 of 1997, 25 of 1998, L.N. 312 of 1998, L.N. 341 of 1998, 2 of 1999, 22 of 1999, 64 of 2000, 2 of 2001, L.N. 66 of 2002, L.N. 217 of 2005, L.N. 136 of 2007, 21 of 2007, 2 of 2009, L.N. 252 of 2009, L.N. 62 of 2013, E.R. 2 of 2014, L.N. 68 of 2014, L.N. 150 of 2014, L.N. 121 of 2015, 17 of 2016, L.N. 16 of 2017, E.R. 4 of 2020.

Language

An applicant can file an application in English or in Chinese, except title of the invention and abstract in both English and Chinese. Patent application forms are available in either language. According to the filing language, the Registrar will issue notices in English or Chinese accordingly and use it in any proceedings in the registry relating to this filing.

Patent type

There are two types of patents in Hong Kong SAR: standard and short-term.

Filing route

The applicant may file an application via a standard patent (O) application, a standard patent (R) application and/or a short-term patent application.

Patent protection term and annuity fee

Protection under standard patents is renewable annually after the end of the third year, for a maximum of 20 years. Protection under short-term patents is renewable, after four years from filing, for a maximum term of eight years.

Definition of invention

Invention refers to products, substances, or processes which are new and inventive.

Patents protect inventions.

Applying for a standard patent (O)

In general, there is no time limit for filing a standard patent application (O) in Hong Kong SAR. To claim priority under Paris Convention, the application should file a standard patent application (O) in Hong Kong SAR within 12 months of filing the first application. If any invention has been disclosed and the applicant claims that the disclosure does not prejudice the invention's novelty (section 109, Patents Ordinance), the applicant should file a standard patent application (O) within 6 months of the disclosure.

Applying for a standard patent (R)

The grant of a standard patent (R) in Hong Kong SAR is based on the registration of a patent granted by one of three patent offices, called 'designated patent offices':

- the National Intellectual Property Administration (formerly "State Intellectual Property Office"), People's Republic of China,
- the European Patent Office, in respect of a patent designating the United Kingdom,
- the United Kingdom Intellectual Property Office.

A standard patent (R) application in Hong Kong SAR is made in two stages by filing:

- a request to record the designated patent application within 6 months after the publication of Chinese, EP(UK) or UK patent application (stage 1),
- a request for registration and grant in Hong Kong SAR within 6 months after the publication of the Chinese, EP(UK) or UK granted patent (stage 2).

Applying for a short-term patent

In general, there is no time limit for filing a short-term patent application in Hong Kong SAR. To claim priority under Paris Convention, the applicant should file a short-term patent application in Hong Kong SAR within 12 months of filing the first application. If any invention has been disclosed and the applicant claims that the disclosure does not prejudice the invention's novelty (section 109, Patents Ordinance), the applicant should file a short-term patent application within 6 months of the disclosure.

The applicant may file a short-term patent application **within six months** after the international application has entered its national phase in China, **or within six months** after the date of issuance of an official notification by the National Intellectual Property Administration, People's Republic of China stating that the international application has entered the national phase in the office ("official notification").

The grant of a short-term patent in Hong Kong SAR is based on a search report from an international searching authority or one of three designated patent offices:

- the National Intellectual Property Administration, People's Republic of China,
- the European Patent Office, in respect of a patent designating the United Kingdom,
- the United Kingdom Intellectual Property Office.

Patentability

An invention is patentable if it is new; involves an inventive step; and is susceptible of

industrial application.

Subjects that cannot be granted patent rights

The following are not patentable: 1. a discovery, scientific theory or mathematical method; 2. an aesthetic creation; 3. a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; 4. a presentation of information; 5. a method for the treatment of the human or animal body by surgery or therapy, or a diagnostic method practiced on the human or animal body; 6. a plant or animal variety; and 7. an essentially biological process for the production of plants or animals (other than a microbiological process or its products).

Preservation of Micro-organisms

If an invention which is the subject of a patent application or patent requires for its performance the use of a microorganism, which is not available to the public at the date of filing of the application, and which cannot be described in the application or the specification of the patent in such a manner as to enable the invention to be performed by a person skilled in the art, the applicant should, not later than the date of filing of the application, deposit a culture of the micro-organism in a depositary institution which is able to furnish a sample of the micro-organism. For a short-term patent application, the name of the depositary institution, the date when the culture was deposited and the accession number of the deposit given in the specification of the application, shall be submitted together with the request for grant of a short-term patent. For a standard patent (O) application, the name of the depositary institution, the date when the culture was deposited and the accession number of the deposit given in the specification of the application, shall be submitted at the time the application is filed, otherwise it must be submitted before the earliest of (i) the expiry of 16 months after filing (ii) the expiry of 16 months after priority date if priority has been claimed; or (iii) the expiry of 1 month after the Registrar has informed the applicant for the required information

Either an international depositary authority or an institution that at all relevant times (i) performs the functions of receiving, accepting and storing micro-organism and furnishing samples of micro-organism, and (ii) conducts its affairs in so far as they relate to those functions in an objective and impartial manner, is competent.

Patent for inventions involving computer software

Computer software is protected under copyright law. But patent protection may be available for software related inventions that are not merely computer programs. For

example, in the European Patent Office and in the United Kingdom Intellectual Property Office, software is patentable if it is a computer-related invention that produces a 'further technical effect'. Essentially, software that merely automates a process that was previously done mentally or manually is not patentable. But if the software solves a technical problem, it is patentable.

Novelty

An invention is to be regarded as new if it does not form part of the state of the art. For a patent application for an invention (**subject application**), the state of the art comprises everything made available to the public (in Hong Kong SAR or elsewhere), whether by means of a written or oral description, by use or in any other way before the material date of the subject application.

Inventiveness

An invention is to be regarded 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.

Priority right

Where, within 12 months from the date on which the applicant first filed in or for any Paris Convention country or WTO member ("the priority application") for a patent application, he or it may thereafter, files in Hong Kong IP Registry an application for a standard patent or a short-term patent for the same subject matter, enjoy the right to priority.

Where, within 12 months from the date on which the applicant first filed in CNIPA or HK IP Registry ("the priority application") for a patent application, he or it may thereafter, files in Hong Kong IP Registry an application for a standard patent or a short-term patent for the same subject matter, enjoy the right to priority.

The priority can be restored subject to certain conditions.

Publication of request to record for a standard patent (R) application

After the Registry has given a request to record a filing date, the Registrar will examine the request and give the applicant a notice to correct any deficiencies on formal requirements within two months, if any. If there is no deficiency or the deficiencies are corrected, the Registrar will publish the request to record for a standard patent (R) application and advertise it in the Hong Kong Intellectual Property Journal.

Publication of a standard patent (O) application

Upon satisfying that a standard patent (O) application complies with the formal requirements, the Registrar will publish the application and advertise it in the Hong Kong Intellectual Property Journal, which normally takes place as soon as practicable upon expiry of 18 months after the date of filing, or the earliest priority date, if priority is claimed.

Substantive examination on a standard patent (O) application

The applicant should file a request with the Registrar of Patents for substantive examination of a standard patent (O) application within 3 years after its date of filing or the earliest date of priority claimed (if applicable), or else the application will be regarded as being withdrawn.

Substantive examination on a short-term patent application

If there is no formality deficiency or the formality deficiencies are corrected, the Registrar will grant a short-term patent for the invention. A request for substantive examination of a short-term patent may be filed with the Registry of Patents at any time after the patent grant.

The requirement of unity

The claims contained in the specification of a patent application or of a patent must relate to one invention or to a group of inventions that are so linked as to form a single inventive concept. The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category or in different categories. The specification of a short-term patent application provides for not more than 2 independent claims.

Submission of divisional application

A divisional application of a parent standard patent (O) application can be filed at any time when the earlier (parent) application is pending, but before preparations for publication of the specification of the parent patent are completed; or within 2 months (non-extendible) after the date of the refusal notice; or within 2 months (non-extendible) after the date of the final refusal notice; or within a period specified by the Registrar if an appeal to the court against the Registrar's final refusal notice is lodged. A divisional application of a parent short-term patent (O) application can be filed at any time when the earlier (parent) application is pending, but before preparations for publication of the specification of the parent patent are completed.

Voluntary amendments to application

The amendments to the patent application shall not go beyond the scope of disclosure contained in the initial specification and claims. An applicant of a standard patent (R) application may, at any time before the preparations for publication of the specification of the patent to be granted have been completed and of his own volition, make an application to the Registrar for amendment to the patent application based on the amendments of its designated patent application. The applicant can file voluntary amendments to a standard patent (O) application once before preparations for publication of the standard patent (O) application are completed; or when filing a request for substantive examination; and within 3 months (non-extendible) from the date of the Registrar's notice informing the applicant that the application has entered into the stage of substantive examination. An applicant of a short-term patent application may, at any time before the preparations for publication of the specification of the patent to be granted have been completed and of his own volition, make an application to the Registrar for amendment to the patent application.

Rejection and reexamination of a standard patent (O) application

If the Registrar is of the opinion that a standard patent (O) application does not comply with the examination requirement concerned, the Registrar will proceed with issuing a provisional refusal notice. The applicant may file with the Registrar a request to review the Registrar's provisional decision of refusal with 2 months (extendible once for 2 months with payment of the extension fee) after the date of the Registrar's provisional refusal notice.

Rejection and reexamination of a short-term patent application

If the Registrar is of the opinion that a short-term patent does not comply with the examination requirement concerned, the Registrar will proceed with issuing a provisional revocation notice. The patentee may file with the Registrar a request to review the Registrar's provisional decision of revocation within 2 months (extendible once for 1 month with payment of the extension fee) after the date of the Registrar's provisional revocation notice.

The scope of patent protection

An invention for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the patent, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent shall be determined accordingly.

Prevention of direct use of invention

A patent while it is in force shall confer on its proprietor the right to prevent all third parties not having his consent from doing in Hong Kong all or any of the following: (a) in relation to any product which is the subject-matter of the patent making, putting on the market, using or importing the product; or stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise; (b) in relation to any process which is the subject-matter of the patent, using the process or offering the process for use in Hong Kong when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent; (c) where the invention is a process, then in relation to any product obtained directly by means of that process, putting on the market, using or importing the product or stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise.

Prevention of indirect use of invention

A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply in Hong Kong a person, other than a party entitled to work the patented invention, with means (exclusive of staple commercial products), relating to an essential element of that invention, for putting it into effect, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect in Hong Kong.

Confidentiality examination of patent applications to be filed abroad

Not required.

Right to continue use begun before priority date

A person has the rights to do or continue to do the act, if the person, in Hong Kong and before the material date of a patent, does in good faith an act that would constitute an infringement of the patent if the patent were in force; or makes in good faith effective and serious preparations to do such an act. The act shall not amount to an infringement of the patent concerned.

Maintaining a standard patent (R) application

If an application cannot proceed to the second stage (request for registration and grant), the applicant may wish to maintain his application before the expiry of the

fifth or any succeeding year from the anniversary of the date of filing the corresponding designated patent application first occurring after the date of publication of the request to record. Failure to maintain an application will result in a patent application being deemed withdrawn.

Patent agent

The applicant or the agent of the applicant who has an address in Hong Kong, China for service of documents, can file a patent application in the Hong Kong SAR. If an agent is appointed, the agent is required to notify the Registrar of the address in Hong Kong where he resides or carries on his business activities. Because drafting patent documents is a technical skill, we recommend applicants to get professional advice.

Registration of transactions

If any right in or under a patent or an application for a patent is acquired by virtue of any of the following transactions, instruments and events, please file a request to update the Patents Registry's records.

- a. an assignment;
- b. a mortgage or the granting of security;
- c. the grant or assignment of a licence or sub-licence or mortgage of a licence or sub-licence;
- d. the vesting by an assent of personal representatives of a patent, an application for a patent or any such right;
- e. any order or directions of a court or other competent authority transferring a patent or an application for a patent or any such right.

Patent/Application mark

Any person who falsely represents that anything disposed of by him for value is a patented product commits an offence and is liable on summary conviction to a fine at level 3. For example, a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word “patent” or “patented” or “专利” or “享有专利” or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

Any person who represents that a patent has been applied for in respect of any article disposed of for value by him when in fact (a) no such application for a patent has been made; or (b) any such application has been refused, withdrawn or deemed

withdrawn, commits an offence and is liable on summary conviction to a fine at level 3. For example, a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words “patent applied for” or “patent pending” or “已申请专利” or “专利申请待决”, or anything expressing or implying that an application has been made for a patent in respect of the article, shall be taken to represent that an application for such a patent has been made.