

LCQ11: Patent registration system

Following is a written reply by the Secretary for Commerce and Economic Development, Mrs Rita Lau, to a question by the Hon Wong Ting-kwong at the Legislative Council meeting today (December 9):

Question:

At present, patents registered in Hong Kong are of two types, namely standard patents and short-term patents. The grant of a standard patent is based on a patent granted by one of the three designated patent offices located outside the boundary, and Hong Kong does not have an independent registration system for standard patents. Moreover, applicants of patent registration have relayed to me that Hong Kong lacks the talents for drafting patent specifications required for submission when applying for registration of standard patent. In this connection, will the Government inform this Council:

(a) of the numbers of applications for short-term patents and standard patents received in each of the past three years and the types of inventions involved and, among the applications, the numbers of those which were unsuccessful and the reasons for that;

(b) given that neighbouring places such as Singapore and Macao have already set up independent registration systems for standard patents, whether the authorities will study the setting up of an independent registration system for standard patents in Hong Kong; if they will, of the details; if not, the reasons for that; and

(c) whether it will consider training local talents for preparing patent specifications and setting up a system to recognise the relevant professional qualifications; if it will, of the details; if not, the reasons for that?

Reply:

President,

The Patents Ordinance (Cap. 514) provides for the relevant requirements under the patent registration system in Hong Kong. For the purpose of granting a patent, the Hong Kong Patents Registry will verify the documents and information submitted to ensure that the registration requirements are met. It does not conduct substantive examination, i.e. it does not assess whether the invention is novel, involves an inventive step and is susceptible to industrial applications.

Standard patents obtained in Hong Kong are based on a patent granted by one of three "designated patent offices". These "designated patent offices", which adopt the "original grant patent system", are the State Intellectual Property Office, the United Kingdom Patent Office and the European Patent Office. The application process involves two stages. At Stage 1, the applicant files a "request to record" in Hong Kong within the prescribed period (note 1) after the patent application has been published by a "designated patent office". At Stage 2, after the patent has been granted by the designated patent office, the applicant files a "request for registration and grant" within the prescribed period (note 2). The Hong Kong Patents Registry will normally grant the patent within a few months after receiving the relevant certifying document from the "designated patent office". A standard patent may remain in force for a maximum term of 20 years.

As for a short-term patent, the applicant files his application direct with the Hong Kong Patents Registry without having to go through a "designated patent office". The applicant will need to submit a search report prepared either by one of the "designated patent offices" or by any International Searching Authority appointed pursuant to Article 16 of the Patent Co-operation Treaty. The Hong Kong Patents Registry will grant the short-term patent after satisfying itself that the information required is fully furnished. Such a process normally takes a few months. A short-term patent may remain in force for a maximum term of eight years.

With regard to parts (a) to (c) of the question, our reply is as follows:

(a) The number of applications received for standard and short-term patents, the number of patents granted, the subject matters of the inventions, and the number of unsuccessful applications between January 2006 and October 2009 are set out at Annex.

Most of the unsuccessful applications were due to failure to file for registration or pay the specified fees within the prescribed time. Some other cases involved withdrawal by the applicants.

(b) Before establishing an "original grant patent system", a Patent Office would need to have a comprehensive technical information databank and a sizable pool of suitably qualified technical personnel. Such prerequisites are essential for the substantive examination of applications covering the main technical fields of inventions, including the capacity to assess whether an invention is patentable (i.e. whether the invention is novel, involves an inventive step and is susceptible to industrial application). The relevant set-up cost is enormous. Moreover, given the present relatively low volume of patent applications originating from Hong Kong

(approximately 1% of the total number of applications received for standard patents), establishing an "original grant patent system" may not be cost-effective. Hence, we have no plan to establish an "original grant patent system" in Hong Kong for the time being.

According to the information available to us, the patent systems of Singapore and Macao are not "original grant patent systems". Singapore has outsourced the substantive examination of patent applications to the Patent Offices of Australia, Austria, Denmark and Hungary while patent applications filed with the Macao Patent Office are entrusted to the State Intellectual Property Office for substantive examination. The relevant patents granted are valid only in the economy where the applications are made.

In Hong Kong, most applicants for patent registration will simultaneously seek patent protection in other economies (including our major trading partners, such as Europe or the Mainland). Not only does our existing patent registration system largely meet the business needs of the applicants, the process leading to registration is relatively straight-forward and inexpensive (entailing a fee of \$896 for filing an application). Hence, we have no plan to change the existing registration system for standard patents.

(c) Patent agents help clients prepare patent specifications. In general, the offices employing these practitioners (mainly law firms) would provide the relevant training in-house, and meet the manpower needs according to market demand.

As mentioned above, the existing patent registration system in Hong Kong is generally working well. It largely meets the business needs of the applicants and the process leading to registration is relatively straight-forward. Under the existing system, we do not see a need for regulating the qualifications of patent agents.

note 1: The standard patent application has to be filed in Hong Kong within 6 months after the date of publication of corresponding application in a designated patent office.

note 2: The request has to be filed in Hong Kong within 6 months after the date of grant of the designated patent by the designated patent office or publication of the request to record in Hong Kong, whichever is later.

Ends/Wednesday, December 9, 2009

Number of applications received and patents granted

		2006	2007	2008	2009 (as at October 31)
Standard Patents	Number of applications (note 1) received (request to record)	13,790	13,766	13,662	9,697
	Number of applications (note 1) received (request for registration and grant)	5,218	4,907	4,775	4,144
	Number of patents granted	5,147	4,839	4,001	4,449
Short-term Patents	Number of applications received	520	599	488	465
	Number of patents granted	436	492	435	373

Note 1: There is a time lag between “request to record” (i.e. Stage 1) and “request for registration and grant” (i.e. Stage 2). It varies from more than ten months to several years.