



"Martin Hui"

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Subject Fwd: Review of Hong Kong Patent System

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From: Martin Hui

Subject: Review of Hong Kong Patent System

Date: 29 December, 2011 6:33:28 PM GMT+08:00

To: patent_review@citb.gov.hk

Dear Sirs,

Please found attached my opinion related to the Hong Kong Patent System review.

My information are as follow:

HUI Wing Kin

You may disclose my name as part of the summary report for the consultation process.



Regards, Martin PatentReview.docx

Background:

I am an inventor since 2002. I have been supporting my invention out of my own resources and also a beneficiary of the patent application grant. I have more than 20 published patents and some of them are granted in China, US or Europe.

Standard Patents

(a) whether an OGP system should be introduced in Hong Kong;

I do not see the requirement to introduce OGP, as it will only introduce one more step in the application of patent.

Hong Kong is a small city and cannot support an innovative product solely on local demand. As a Hong Kong based company, we always look for opportunity to export our products, possible market can be China, US and / or Europe. This is always been true before or after the closer economic relationship with the Mainland China was established. For innovative products that I intend to rollout to other parts of the world, we will also apply patent for protection in China. In the current arrangement, I would have applied for patent protection in China and then have the registration done in Hong Kong. The current cost for re-registration is best with the current arrangement with reasonable cost for such registration process.

However, if OGP is introduced, that means I have to deal with another examination body. That creates addition cost, uncertainty and delay for inventor seeking patent protection in Hong Kong.

Further, it was noted that we don't have the expertise in performing patent examination locally and the consultative paper consider to outsource the examination function to other examination body. It only defeats the purpose of gaining the local expertise and also have the disadvantage of increase cost and time spent on getting a patent granted in Hong Kong. The question then became whether OGP will create long term benefit to Hong Kong. I would propose that this will not provide long term benefit for Hong Kong. Globally, I can see a trend to streamline the examination process, one good example is the introduction of single body to examine patent (European Patent Office) and trademark (Office of Harmonization of Internal Market) for Europe. This two organizations help business in reducing cost and time to get Intellectual Property protection within Europe. Creating OGP of our own only create a segmented markets between China and Hong Kong. When there is only one examination team based in Beijing, I do not see the requirement to set up another team in Hong Kong 14 or 15 years after we re-united with our motherland.

The cost analysis of OGP in the consultative paper, paragraph 1.34 clearly demonstrates that if a patent is applied in more than one jurisdiction, it will be more cost effective in using "foreign route" in Singapore.

Should OGP be introduced in Hong Kong with “re-registration” system still in force, I would foresee that cost for “re-registration” is way cheaper than OGP and I would choose the route to use re-registration after my patent is granted in China or other designated patent office.

- (b) Irrespective of the answer to (a) above, whether the current “re-registration” system should be maintained, and if so, whether the system should be expanded to recognize the patents granted by other jurisdictions;

I agree that we should take a look at the current system. Currently a patent that is granted in China or United Kingdom (directly or indirectly via European patent office) can apply for registration in Hong Kong if certain procedures are followed.

Considering the current trade relationships between Hong Kong and other countries, I would propose the extension to include US Patent and Trademark Office, European Patent Office and Australia Patent Office. We may also include Japan Patent Office and Korean Intellectual Property Office.

As a further step to position Hong Kong as a regional and international hub for technology exchange, we may consider to recognize any patents granted by any of the Authorities as International Searching and International Preliminary Examining Authorities under the PCT as currently listed in the web page:

http://www.wipo.int/pct/en/access/isa_ipea_agreements.html

With this expansion, it will greatly reduce cost for those patent applicants to register their patent in Hong Kong.

Hence, my opinion is to select Option 3 (page 15 of the consultative paper) that we should not introduce an OGP system and expand the number of designated patent offices in the current re-registration system.

Short-Terms Patents

- (c) whether the short-term patent system should be retained as a supplement to standard patents;

I would agree to abolish the short-term patent system. The number of applications of short-term patent as compared with standard patent as disclosed in annex 1 and annex 4 shows that only less than 5% of patent applications are short-term. It clearly demonstrates that this type of patent system is not widely used in Hong Kong. The low acceptance of short-term patent system is subject for interpretation without more careful study on the subject.

The low-barrier for short-term patent only invites inventions of lower 'inventive' and 'commercial' value application to apply for patent. The short-term patent system may encourage individual with lesser resources to apply for a short-term patent and use the time to seek for more resources from investor or consumer.

From my personal experience, short-term patent application comes with lower cost in patent application and not-so-professional prepared patent application. It may not create the best protection to the inventive idea. Requirement for substantive examination should actually improved the quality of registered patent.

Short-term patent only provides an alternative route for those inventor with less resources to get some form of protection.

- (d) Assuming that the short-term patent system is to be retained, whether and if so what measure should be introduced to enhance the efficacy of the system; and

However, if short-term patent system is to be retained, I would object to a mandatory requirement for substantive examination before grant of patent by Hong Kong Intellectual Property Department. Such requirement only 'kill' the short-term patent system as the cost and trouble to get a short-term patent would be comparable to that of getting a standard patent granted.

I would suggest that a mandatory substantive examination should be performed before a patent owner can start any legal action against 'infringement of one's patent right'. That is, the right of the patent owner to seek for legal remedies to protect one's patent right only after the short-term patent has passed the substantive examination.

In the case whereby the owner wants to start legal proceeding, the cost of substantive examination should be born by the patent owner.

In the case whereby third party wants to revoke a granted short-term patent, the cost of substantive examination should be born by the third party.

I do not agree to extend the maximum term of protection of short-term patent if substantive examination is not done before granting. The patent applicant should decide whether one want to use which route: standard patent vs. short-term patent at time of filing for application. This is a decision being made everyday by every other inventor. Short-term patent owner should not have the right to change mind after filing.

I do not agree to relax the number of independent claims.

I strongly object any suggestion to lower the patentability criteria. It will only invites more applications but will not improve quality and encourage innovation work. If a sub-standard innovation work is grant of patent protection, it will only create difficulty in real research work and encourage patent troll.

I would agree to discontinue the short-term patent system. No one can afford a home-base reach and development facility to create an invention. In working out an inventive idea, testing and tooling are needed, there is no benefit in hasty put out a short-term patent application and file it.

Regulation of Patent Agency Services

(e) whether the provision of patent agency services in Hong Kong should be regulated, and if so, what form the regulatory system should take.

If we are to keep the re-registration system whereby patent granted in Hong Kong relies on the granting of patent in other recognized jurisdiction, there is not need for the special types of patent attorney.

If we are to make use of the other patent authorities to perform patent examination for Hong Kong, and using these patent authorities' practices for examination of patent application, we are again leveraging on expertise in these markets. Currently, when I apply a patent in China, I have Chinese patent attorney for drafting and execution of the patent, and we only need someone who understand the patent registration system in Hong Kong to perform patent registration. With that, the current system of services provided by patent agent / law firm is sufficient to handle the task.

I further understand that in the current "re-registration" system, the process in getting a patent registered in Hong Kong is strictly procedural. We do not require a professional to draft a patent application and / or a draftsman to draw patent drawings.

I also noticed that there was an argument that a regulatory system with patent attorney will increase job opportunity for drafting of patent applications and patent drawings. However, this is applicable only if patent applicants are using the OGP route. Further I think this is not a logic to create jobs for patent professionals at the expense of increasing cost of innovation in Hong Kong.