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Subject RESPONSE TO THE CONSULTATION PAPER OF REVIEW OF THE PATENT SYSTEM IN HK

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Dear Sirs,

I would like to express my opinions for the consultation paper "Review of the Patent System in Hong Kong".

Issues of the consultation paper are as follows:

#### Standard Patents

1. whether an OGP system should be introduced in Hong Kong;
2. irrespective of the answer to (a) above, whether the current "re-registration" system should be maintained, if so, whether the system should be expanded to recognized the patents granted by other jurisdictions;

#### Short-Term Patents

3. whether the short-term patent system should be retained as a supplement to standard patents;
4. assuming that the short-term patent system is to be retained, whether and if so what measures should be introduced to enhance the efficacy of the system; and

#### Regulation of Patent Agency Services

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

### **A. My considerations**

My view is that the Hong Kong government really wants to develop or explore the industrial property opportunities in coming years or not. And I wish that our government consider the following factors which affect the demand of patent registrations:

- a. the current status of R & D activities and the government is required to forecast the future R & D activities taking place in Hong Kong;
- b. if our government has any long-term planning for the worldwide market of product exhibitions;
- c. the quality and quantity of patent practitioners in Hong Kong;
- d. if our government has any long-term or short-term planning on development of particular technology; and
- e. the consumer market in Hong Kong is very small compared with European Union, PRC and USA, the population of Hong Kong is about 7 million. Therefore, patent registrations in Hong Kong is not so demanding but it is a must, in my opinion, for the inventors who want to exhibit their invention in exhibition or conference taking place in Hong Kong.

## **B. Response to the above issues**

1. By studying the practices of regional patent offices with similar economic structure with Hong Kong SAR, like Singapore and Macau, it is not necessary to introduce OGP system in Hong Kong as the market size and population is not large enough and is not economical to set up a patent examination section in Hong Kong. Further, I believe that it has not many qualified patent examiners in different field of technologies in Hong Kong at this stage.
2. I totally reject the mechanism of "re-registration". My view is that this system will delay the time to grant the patentable inventions. It discourages the applicants who want to obtain the statutory protections through the "re-registration" because it takes a longer time for granting due to re-registrations. I accept to outsource the examination procedure to EPO or USPTO or SIPO. However, in relation to argument of office actions, I believe it may outsource the jobs to local patent firms.
3. I take KIPO as an example, it introduces examination to utility model registration. it would be good to against the applicants who abuse the non-examination characteristics of the utility model (short-term patent) registration. In Hong Kong, I do think the current procedure is quite safe by setting a barrier through submission of search reports for every short-term patent registration. The court may study the search reports for patent infringement cases. However, I suggest to simplify the procedure of revocation of utility model registration to avoid the abuse of registration of non-patentable invention.
4. I suggest to reconsider the revocation system of short-term patent registration and it requires to simplify the system.
5. In relation to patent agent services, a patent agent registration is compulsory. The registration system is normally applied for most common law jurisdictions. Unlike the registration of legal practitioners, the patent agent registration system is commonly regulated by regional governments, not by individual organizations. The applicant should be a citizen or a permanent resident of the country or territory in which he applied for. The patent agent is required to draft patent specifications, as such, engineering or science qualification is a must for a registered patent agent in order to fully understand the possible solutions to solve technical problems raised by the inventors. Therefore, I suggest a patent agent in Hong Kong is required to have science or engineering qualification with law degree (common law) as the patent agent is required to advise its client on the matter of patent law. It involves legal advice such that legal background is a must for registration as a patent agent. Preferably, the common law lawyer with engineering or science background is suitable to become a patent agent in Hong Kong as the jobs for the patent agent comprise providing patent advices and drafting technical patent specifications.

If you have any question about my opinions, please let me know via [danny@lkco.com.hk](mailto:danny@lkco.com.hk).

Regards,

**Danny Chan** BEng, LL.B, LL.M, GDLP

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