

Patent Protection in Hong Kong

Hong Kong (officially, Hong Kong Special Administrative Region of the People's Republic of China) lies at the eastern side of the Pearl River estuary and is the most densely populated area in the world, having around 7.5 million inhabitants. Hong Kong is the world's seventh largest trading entity, the world's second-largest container port and the world's busiest airport for international cargo. Many exports from Chinese companies in the Pearl River Delta pass through the port of Hong Kong.

Hong Kong does not currently have its own substantive patent examination procedure. To secure a patent in Hong Kong first of all an applicant needs to file one of the following patent applications:

- a Chinese national patent application; or
- a United Kingdom national patent publication; or
- a European Patent Convention patent application

This permits the filing of a Hong Kong patent application based on the Chinese, UK or European patent application.

After securing a granted patent in one of the above three designated patent offices, a Hong Kong patent can then be granted, which is effectively a "re-registration" of the UK, European or Chinese patent and has the same claims as the parent patent.

The Hong Kong patent office effectively avoids having to do the work of search and substantive examination by basing Hong Kong patents on patents which have already been granted by the state intellectual property office of the People's Republic of China (SIPO), the European patent office (EPO) or the United Kingdom patent office (UKIPO).

However under a new Hong Kong patent system which comes into effect in 2018, in parallel with the existing system of re-registration of the UK, Chinese or European patent, it will now be possible to obtain a Hong Kong patent directly through the Hong Kong patent office (Hong Kong Intellectual Property Department), and without the need to first have a UK, Chinese or European patent.

The claims of the directly filed Hong Kong patent do not need to correspond with the claims of a parent Chinese, UK or European patent and will be examined independently.

Procedurally, the Hong Kong system is likely to develop to be very similar to the Chinese patent system, with the criteria for patentability being similar to those in China. The Hong Kong Intellectual Property Department emphasises that Hong Kong is still under the “One country, two systems” administrative model.

On the other hand, the Hong Kong court system still operates under a UK Commonwealth jurisdiction, where existing local Hong Kong, UK and Australian case law is still considered by the Hong Kong courts when deciding on Hong Kong patent matters.

The Hong Kong Intellectual Property Department is also considering the patent prosecution Highway (PPH) system of the world intellectual property organisation (WIPO) whereby for participating national or regional patent offices, grant of a patent in one member office of the PPH permits accelerated patent prosecution based on the same claims in other PPH member patent offices.

Short term patents in Hong Kong

The normal term for a standard Hong Kong patent is 20 years from the date of filing - the same as for other countries.

However, under the new system, there is also a short-term patent in Hong Kong having a maximum duration of 8 years. The criteria for obtaining short-term patents are less rigorous than for the standard 20 year term patent. In particular, the criteria for inventive step and examination is lower when applied to a short-term patent compared to the UK, Chinese, European or Hong Kong standard 20 year term patent.

Prior to enforcement, the owner of a short-term Hong Kong patent can request the registrar of patents to conduct a post grant substantive examination and will issue a certificate of substantive examination to confirm the validity of the patent. Such a certificate of substantive examination will become a prerequisite before commencing enforcement proceedings in the Hong Kong courts using a Hong Kong short-term patent.

For more information on patents in Hong Kong, China or anywhere in Asia, please contact one of our Chartered or European patent attorneys.

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