

For Information

Legislative Council Panel on Commerce and Industry

Application of the Patent Co-operation Treaty to the Hong Kong Special Administrative Region

At the Panel meeting held on 15 March 2011, Hon Regina Ip sought information on the participation of the Hong Kong Special Administrative Region (HKSAR) in the Patent Co-operation Treaty (PCT) administered under the World Intellectual Property Organization (WIPO). This paper sets out the requested information.

Background

2. PCT is an international patent registration system administered by WIPO. Membership to PCT is confined to sovereign states. The Treaty enables the filing of one “international application” with a single patent office in one language and with a single set of forms (and fees) instead of filing numerous separate national¹ and/or regional patent applications. Such an application may be filed by anyone who is a national or resident² of a PCT contracting state with the national patent office of the relevant contracting state, or, at the applicant’s option, with the International Bureau of WIPO in Geneva.

3. An international application automatically has the effect of designating all PCT contracting states³ for the patent application⁴. If an applicant wishes to exclude certain PCT contracting state(s) from the all-inclusive designations, the applicant has to withdraw the designation concerned by filing a separate notice of withdrawal⁵ at any time prior to the

¹ Patent protection is territorial in nature. It requires the filing of individual patent applications for each territory in which protection is sought.

² Rule 18 of the Regulations under PCT provides, among other things, that possession of a real and effective industrial or commercial establishment in a contracting state shall be considered residence in that state and a legal entity constituted according to the national law of a contracting state shall be considered national in that state.

³ As at 1 December 2011, there are a total of 144 contracting parties, including the People’s Republic of China. See <http://www.wipo.int/treaties/en/registration/pct/>.

⁴ According to Rule 4.9(a) of the Regulations under PCT, the filing of a request shall constitute, among other things, the designation of all contracting states that are bound by the Treaty on the international filing date (<http://www.wipo.int/pct/en/texts/rules/r4.htm>).

⁵ The withdrawal of designation may save the costs during the “national phase” in the relevant contracting parties, e.g. the search fee charged by the national patent office.

expiration of 30 months from the priority date⁶ in accordance with the relevant rule⁷.

4. The PCT application procedure consists of two main phases, namely the “international phase” and the “national phase”. During the “international phase”, WIPO will centrally receive all applications. An international application has the effect, as of the international filing date, of a national application in all PCT contracting states in his application.

5. The international application is subject to an international search carried out by one of the major patent offices⁸. The relevant office would issue a search report. A preliminary and non-binding written opinion⁹ on whether the invention appears to meet the patentability criteria is also issued. The applicant may further request for an optional international preliminary examination.

6. To an applicant, the main benefit lies in the longer period of time offered by the “international phase” of PCT for him/her to assess the commercial viability of the invention or the validity of patent (having regard to the preliminary examination result) before incurring further costs associated with the “national phase” at the designated regions or countries. If the applicant decides to go beyond the “international phase” with a view to obtaining national (or regional) patents, he/she may, in relation to most contracting states, wait until the end of the 18 months from the filing date or 30 months from the priority date to commence the national procedure before each designated office.

7. Once the case enters the “national phase”, the International Bureau of WIPO will pass the forms to the national patent offices of the countries where patent protection is sought. At this juncture, the applicant has to pay to the relevant national (or regional) offices the required national (or regional)

⁶ Key patentability criteria include “novelty” and “involving an inventive step”. This being the case, claiming priority is important for any patent application as the subsequent examination will consider whether any “prior art” exists before the “priority date”. “Priority date” is usually the date of filing of the “first” patent application for a particular invention. In other words, an applicant may claim priority when applying for patent if he had previously applied for patent protection in another country for the same invention in accordance with the relevant patent law.

⁷ Rule 90bis.2 of the Regulations under PCT.

⁸ Major patent offices include the Patent Offices of Australia, Austria, Canada, China, Finland, Japan, the Republic of Korea, the Russian Federation, Spain, Sweden, USA, and the European Patent Office.

⁹ The written opinion will identify, among other things, whether or not the claimed invention appears to be novel, involve an inventive step (be non-obvious) and be industrially applicable.

fees¹⁰, furnish them with any translations that may be required and appoint a representative (patent agent) as necessary. The receiving country will independently assess the application concerned and grant or refuse the application based on its national laws.

Application of PCT to Hong Kong

8. The People's Republic of China applied PCT to the HKSAR on 1 July 1997 through PCT Notification No. 121¹¹. A Hong Kong resident may file the international application either with the State Intellectual Property Office of the People's Republic of China or the International Bureau of WIPO. The Hong Kong Patents Registry is not a receiving office for international applications under PCT.

Application for a standard patent in Hong Kong based on an international application

9. Under Hong Kong's standard patent system, a patent application may be based on an international application which has entered the "national phase" in a "designated patent office"¹². After the corresponding designated patent application has been published, the applicant may within a prescribed period file an application for a standard patent in Hong Kong.

Application for a short-term patent in Hong Kong based on an international application

10. Under the short-term patent system of Hong Kong, where an international application seeking a patent for a utility model and designating Mainland China has entered its "national phase" in Mainland China, the applicant in the international application may within a prescribed period file an application for a short-term patent in Hong Kong.

¹⁰ For some IP offices, for example, European Patent Office and Austrian Patent Office, the national fees include the filing fees (or fees for entry into the national phase), in addition to the substantive examination fee and search fee.

¹¹ PCT notification at http://www.wipo.int/treaties/en/notifications/pct/treaty_pct_121.html.

¹² "Designated patent office" means either the State Intellectual Property Office (in the Mainland), the United Kingdom Patent Office or the European Patent Office (for patents designating the UK).

Statistics

11. The table below shows the number of (a) standard patent applications based on international applications which have entered the “national phase” in one of the three “designated patent offices”; and (b) short-term patent applications based on international applications designating China received in Hong Kong for the last three years.

	Total number of standard patent applications received	Number of standard patent applications based on international applications	Total number of short-term patent applications received	Number of short-term patent applications based on international applications
Apr 08 to Mar 09	13,157	9,046	493	12
Apr 09 to Mar 10	12,101	8,709	566	2
Apr 10 to Mar 11	11,643	7,994	646	8

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