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Panel on Commerce and Industry

Meeting on 18 June 2012

Updated background brief on the patent registration system in Hong Kong

Purpose

This paper provides background information on the patent registration system in Hong Kong and a summary of views and concerns expressed by Members during previous discussions on the subject.

Background

2. Patents protect an invention by giving the patent owner a legal right to prevent others from manufacturing, using, selling or importing the patented invention. 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. The system is also referred to as a "re-registration" system. There are two types of patent in Hong Kong, namely standard patent and short-term patent.

3. 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 (OGP) 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 one, the applicant has to file a "request to record" in Hong Kong within six months after the date of publication of corresponding application in a "designated patent

office". At Stage two, the applicant has to file a "request for registration and grant" in Hong Kong within six 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. 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". The total application and publication fee for a standard patent is \$896. A standard patent may remain in force for a maximum term of 20 years.

4. As for short-term patent, the applicant files the 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. The total application and publication fee for a short-term patent is \$823. A short-term patent may remain in force for a maximum term of eight years.

5. According to the Administration, the statistics of patent applications in recent years are summarized as follows:

Year	Standard patent	Short-term patent
2005-2010		
Average no. of applications per year	around 12 000	around 530
Average no. of grants per year	around 5 200	around 460
2010		
No. of applications	11 702	614
No. of grants	5 353	522
2011		
No. of applications	13 493	615
No. of grants	5 050	517

Previous discussions

6. Members have discussed at various forums issues on the patent registration system in Hong Kong since 2009.

7. At the Council meetings on 9 December 2009 and 11 May 2011, Members raised questions on the patent registration in Hong Kong. Members urged the Administration to consider setting up an OGP system to dovetail with

the unique features of local industries and foster the development of creative industries in Hong Kong.

8. At the Panel meeting on 17 May 2011, members of the Panel on Commerce and Industry (the Panel) noted that there were 11 702 applications for standard patents but only 5 353 standard patents had been granted in 2010, the Panel expressed concern whether the low percentage of successful applications were due to the fact that sufficient resources had not been allocated for the timely processing of the patent applications. The Administration advised that many applications did not proceed to grant because applicants who failed to obtain the grant of a patent by the "designated patent office" would not file the "request for registration and grant" at Stage two. Some other cases involved withdrawal by the applicants.

9. At the Panel meeting on 15 November 2011, the Administration briefed the Panel on the key points of the consultation paper issued on 4 October 2011 on the review of the patent system in Hong Kong and the consultation arrangements. The key issues on which the Administration wished to seek views and comments in the consultation exercise included but were not limited to the following –

Standard patents

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

Short-term patents

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

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

10. The Panel opined that an OGP system should be introduced in Hong Kong, as it would complement the efforts being made to encourage more entrepreneurs to use Hong Kong as a launching pad for their research and development businesses. That might in turn help fortify the further development of Hong Kong as a regional innovation and technology hub. It might also stimulate the growth of patent agency business in Hong Kong, help build up local expertise in drafting and processing applications for patent, and offer added career opportunities for graduates with science and technical background. In the short to medium term, the Administration should outsource the substantive examination to other examination authorities, and explore the possibility of developing in-house substantive examination in the long run. In addition, the Administration should explore the possibilities of fostering mutual recognition of patents between Hong Kong and the Mainland, and sharing the work of substantive examination of patent applications between the two places, so as to help save costs for and facilitate the users.

11. Some Panel members noted that an OGP system might involve higher registration fees compared with the current "re-registration" system. They expressed concern whether it would increase the business operating cost and hence affect the competitiveness of Hong Kong enterprises. Some other members opined that the current "re-registration" system should be retained alongside the OGP system as the dual system would give users the added choice of applying for a standard patent in Hong Kong direct or through "re-registration" depending on their market and operation needs.

12. Some Panel members also noted that the drafting of claims and specifications for patent applications required specialized technical skills and knowledge. They opined that a regulatory regime for providers of patent agency services should be established in Hong Kong so as to benefit the parties seeking patent protection and enhance the credibility of the patent agency profession.

Latest position

13. The Administration will brief the Panel on 18 June 2012 on the results of the public consultation and the Administration's proposed way forward.

Relevant papers

Administration's replies to initial written questions raised by Finance Committee Members in examining the Estimates of Expenditure 2011-12: serial no. CEDB(CIT)134

http://www.legco.gov.hk/yr10-11/english/fc/fc/w_q/cedb-cit-e.pdf

Administration's written reply to a question by Hon WONG Ting-kwong at the Council meeting on 9 December 2009

<http://www.legco.gov.hk/yr09-10/english/counmtg/hansard/cm1209-translate-e.pdf>

Administration's reply to a question by Dr Hon PAN Pey-chyou at the Council meeting on 11 May 2011

<http://www.legco.gov.hk/yr10-11/english/counmtg/hansard/cm0511-translate-e.pdf>

Minutes of Commerce and Industry Panel meeting on 15 March 2011

<http://www.legco.gov.hk/yr10-11/english/panels/ci/minutes/ci20110315.pdf>

Administration's paper on review of the patent registration system in Hong Kong for the Commerce and Industry Panel meeting on 17 May 2011

<http://www.legco.gov.hk/yr10-11/english/panels/ci/papers/ci0517cb1-2147-4-e.pdf>

Background brief prepared by the Legislative Council Secretariat for the Commerce and Industry Panel meeting on 17 May 2011

<http://www.legco.gov.hk/yr10-11/english/panels/ci/papers/ci0517cb1-2147-5-e.pdf>

Minutes of Commerce and Industry Panel meeting on 17 May 2011

<http://www.legco.gov.hk/yr10-11/english/panels/ci/minutes/ci20110517.pdf>

Administration's paper on review of the patent system in Hong Kong for the Commerce and Industry Panel meeting on 15 November 2011

<http://www.legco.gov.hk/yr11-12/english/panels/ci/papers/ci1115cb1-277-5-e.pdf>

Updated background brief prepared by the Legislative Council Secretariat for the Commerce and Industry Panel meeting on 15 November 2011

<http://www.legco.gov.hk/yr11-12/english/panels/ci/papers/ci1115cb1-277-6-e.pdf>

Minutes of Commerce and Industry Panel meeting on 15 November 2011

<http://www.legco.gov.hk/yr11-12/english/panels/ci/minutes/ci20111115.pdf>