

30 December 2015

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Clerk to Bills Committee on Patents (Amendment) Bill 2015
[Attn.: Ms. May Leung]
Legislative Council
Hong Kong

Dear Sir/Madam,

Patents (Amendment) Bill 2015

I write in response to your invitation for comments on the Patents (Amendment) Bill 2015 (“**Bill**”).

I am a Registered UK Patent Attorney qualified in 1997, and have been engaged in the field of intellectual property work (including patents) here in Hong Kong since the late 1980s. In addition to being a fellow of the UK Chartered Institute of Patent Attorneys, I am also a member of the Asian Patent Attorneys Association and the Hong Kong Institute of Trade Mark Practitioners. The comments herein are entirely my personal opinion and do not represent those of my employers or the professional bodies or associations of which I am a member.

My comments mainly focus on the proposed amendments to section 44 (“**s. 44**”) of the Hong Kong Patents Ordinance [Cap. 514] (“**Ordinance**”), which relates to revocation of standard patent following opposition or revocation proceedings in the designated patent office. I note that only minor changes to s. 44 have been proposed. In this connection, I suggest that consideration be given to amending s. 44 to allow a patent proprietor to apply to the Registrar of Patents (“**Registrar**”) for revocation of his own Hong Kong standard patent, upon revocation of the corresponding designated patent following the centralized *ex parte* revocation procedures in the European Patent Office (“**EPO**”).

S. 44 of the Ordinance as it currently stands allows a patent proprietor to apply to the Registrar for revocation of his standard patent, upon revocation of the corresponding designated patent following prescribed opposition or revocation proceedings in the designated patent office. Applications under s. 44 are filed with the Registrar and generally involve relatively straightforward administrative actions on the part of the Registrar and a relatively modest cost to the patent proprietor.

Pursuant to section 3 of the Patents (Designation of Patent Offices) Notices, the designated patent offices are:

- State Intellectual Property Office (“**SIPO**”),
- European Patent Office (“**EPO**”), in respect of patents granted under the European

Patent Convention (“EPC”) designating the United Kingdom, and United Kingdom Patent Office (“UKPO”).

Thus, the prescribed opposition or revocation proceedings are:

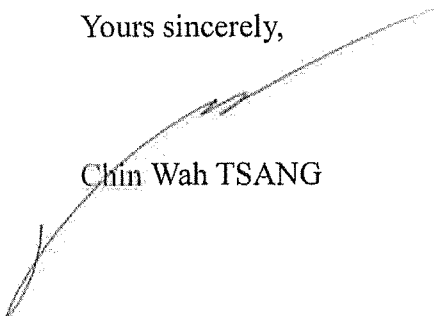
- post-grant invalidation proceedings before SIPO,
- post-grant opposition proceedings before EPO, and
- post-grant revocation proceedings before UKPO.

New Articles 105a to 105c of the EPC have since been promulgated (and come into effect) to provide post-grant centralized *ex parte* limitation/revocation procedures, through which a patent proprietor may apply to the EPO for amendment or revocation of his own granted European patent, to be effective for all designated states, thus the term “central limitation”.

It is suggested that s. 44 of the Ordinance be amended to include the central limitation/revocation procedures under the EPC as one of the prescribed proceedings following which a Hong Kong standard patent may, upon the application of the patent proprietor, be revoked by the Registrar. This would provide a straightforward and relatively inexpensive mechanism whereby a patent proprietor who has already revoked his own European patent through the *ex parte* central limitation/revocation procedures may also revoke the corresponding Hong Kong standard patent. This would encourage the patent proprietor to revoke the corresponding Hong Kong patent, thus removing from the Register of Patents (“Register”) patents which the proprietor is no longer interested in maintaining and enforcing.

If, on the other hand, such an amendment to s. 44 is not made, as post-grant centralized *ex parte* limitation/revocation procedures are not considered by the Registrar to constitute “prescribed opposition or revocation proceedings” in EPO for the purpose of s. 44 of the Ordinance, the patent proprietor would have to file a court action to have the corresponding Hong Kong standard patent revoked. The relatively high cost associated with such a court action is likely to discourage the patent proprietor from petitioning the court accordingly, with the result that the Register is littered with standard patents which the patent proprietors would, but for the cost, wish to revoke.

Yours sincerely,



Chin Wah TSANG