

Hong Kong Patent System Reform – Original Grant V. Re-registration

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The seminar will cover the history of the Patent System in Hong Kong and why there is a need to reform. The contents of the Advisory Committee Report (see below) will be covered in details. Dr. Luk will also present the proposals of HKIPA made to the government regarding the regulation of patent agency services and its current education and training programs.

On Oct 2011, a Consultation Paper entitled “Review of the Patent System in Hong Kong” was issued. At the same time, The Secretary for Commerce and Economic Development has appointed an Advisory Committee on Review of the Patent System in Hong Kong. On 7 Feb 2013, a Report of The Advisory Committee on Review of the Patent System in Hong Kong was issued. The key recommendations are as follows:

1) Standard Patents

An “original grant” patent (OGP) system should be established in Hong Kong with **substantive examination** outsourced to other patent office(s).

The current re-registration system should be retained.

2) Short-term Patents

The short-term patent system should be retained with the following refinements:

Substantive examination should be made a pre-requisite to commencement of infringement proceedings.

Appropriate legislative amendments should be considered to give effect to the above and to address the perceived inconsistency in the burden of proof of patent validity as contained in the existing section 89(2) of the Patent Ordinance.

Both the patentees and third parties having a legitimate concern or doubt about the **validity** of a short-term patent should have the right to apply to the Hong Kong Patent Registry for substantive examination.

The possibility of allowing one short-term patent application to have more than one independent claim for a product and one independent claim for a process, provided that they relate to one single invention should be further explored.

The current maximum protection period of 8 years should be maintained.

The current patentability criteria for short-term patents should be maintained.

3) Regulation of Patent Agency Services

A full-fledged regulatory regime on patent agency services (which involves regulating the provision of services and the use of professional titles) should be set as the ultimate goal in the long run, which will be achieved in stages, with possible interim measures.