GUIDE TO THE NEW PATENTS ORDINANCE



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The information contained herein is intended to provide a summary of the subjects covered. I does not purport to be comprehensive or to render legal advice and should not be relied on for such purpose. Legal advice should be sought in relation to specific problems.

PATENTS

Prior to the return of Hong Kong to

Chinese sovereignty patent protection in Hong Kong was obtained by reregistration in the territory of a UK, or European patent (designating the United Kingdom), within 5 years of grant.

These patents enjoyed the same privileges and rights in Hong Kong as they enjoyed in the UK, so long as they remained in force in the UK. Thus patent protection was totally dependant on the subsistence of the UK patent. If the UK patent was revoked, for whatever reason, then patent protection also lapsed in Hong Kong.

The new Patents Ordinance, which came into force on 27th June, 1997, empowered Hong Kong to grant its own independent patents for the first time in its history. The new patent law provides for the grant of two types of patents namely "Standard Patents" and "Short Term Patents". The legislation is modeled on the UK Patent Act 1977.

STANDARD PATENTS

Patents granted under the Ordinance are known as standard patents. Grant of a standard patent is based on registration in Hong Kong of patents which have been granted by certain designated patent offices.

The designated offices at this time are the UK Patent Office, the European Patent Office, for patents designating the UK and the Chinese Patent Office. There is power in the Ordinance to designate other patent Offices.

Once the patent has been granted in Hong Kong it is independent of the original patent granted by the designated office. The Patent is valid for 20 years and it can be rectified, amended, revoked, enforced and its validity can be tested in the Courts in Hong Kong, in accordance with Hong Kong law.

The grant of patent is a two stage process. The first stage requires the applicant to record in the register the patent application published by the designated office and the second stage requires the applicant to register the patent granted by the designated office.

The Hong Kong Patent Office only examines the application to ensure compliance with formalities, but does not carry out any substantive examination. It was considered that it would not be justified to establish a full examination in Hong Kong and thus a quasi registration system was adopted.

THE 1ST STAGE - APPLICATION TO RECORD

At any time within 6 months after the date of publication of a patent application in a designated patent office, an applicant may file an application to record the designated patent application in the register. The applicant must also file with the Registrar a photocopy of the designated patent application as published and pay a filing fee and an advertisement fee. The applicant must give an address in Hong Kong for service.

The language in which the application is filed will be used as the language in all subsequent proceedings. A translation of the designated patent application is not required, however an abstract must be provided in both English and Chinese.

Failure to make an application to record the designated application within the time period means that the application will not dealt with.

On receiving the application the Registrar

examines the application to ensure that all the documents have been filed and the fees have been paid. Once the Registrar is satisfied that everything is in order he will enter details of the application in the register and publish the request to record.

THE 2ND STAGE - REQUEST FOR REGISTRATION AND GRANT

Once the patent has been granted by the designated patent office an applicant can apply to the Registrar to register the designated patent and to grant a standard patent for the invention.

The request must be made within 6 months of the date of grant of the designated patent. The application must be accompanied by a copy of the specification of the designated patent, as published by the designated patent office, together with a filing fee and an advertising fee.

The Registry examines the documents to ensure they comply with the formalities. If the documents are in order the Registrar will publish the specification, issue a standard patent and advertise the grant of the patent.

EXCLUSIVE RIGHTS & INFRINGEMENT

A patentee has the exclusive right to make, market, use or import the patented product in Hong Kong and to stock the product in Hong Kong, whether for marketing in Hong Kong, or elsewhere.

In relation to processes the patentee has the exclusive right to use the process. Products derived from process patents can only be marketed, used, imported or stocked, whether for marketing in Hong Kong or elsewhere, by the patentee. Remedies for infringement include injunctions, delivery up, damages or an account of profits. A patentee can also seek a declaration of validity and infringement.

TERM

The term of the patent is for a period of 20 years from the date of filing of the application for the "designated" patent. The grant takes effect from the date on which notice of the grant is advertised in the Gazette.

RENEWAL

Renewal fees are payable from the end of the 3rd year of grant. Late payment attracts payment of an additional fee. If the renewal fee and additional fee are not paid within 6 months from the date of renewal the patent shall lapse. It is possible to apply to the Registrar for restoration at any time within 18 months after the expiry of the patent. The Registrar will advertise the application to restore in the Gazette.

COMPULSORY LICENCES

At any time after 3 years from the grant of the Standard Patent anyone may apply to the court for a compulsory licence on one or more of 5 different grounds which include demand for patented produce is not being met by the proprietor and that the invention is not being worked to the fullest extent in Hong Kong.

TRANSITIONAL PROVISIONS

As result of the enactment of the new Patents Ordinance the old Registration of Patent's Ordinance has been repealed. All patents registered under the former legislation are deemed to be standard patents and are subject to renewal fees. With pending applications made under the former legislation, once the application is registered, the patent is deemed to be a standard patent.

SHORT TERM PATENTS

ong Kong now also grants short term

patents for products or processes which are designed to protect inventions which have a short commercial life. These short term patents enjoy protection for a maximum period of 8 years and are available to any person.

Short term patents are granted with an examination only as to formalities and with no substantive search or examination before grant. An applicant must file a search report in relation to the invention made by an authorized searching authority. A short term patent will be granted once the formalities have been satisfied.

The validity of these short term patents can be tested through the courts and in any proceedings for the enforcement of a short term patent, the proprietor must establish the validity of the patent.

APPLICATIONS

An application for a short term patent is a single stage system. Applications need not be based on applications filed elsewhere, but there is provision for claiming priority arising from application for a patent or

other protection in respect of an invention in any Paris Convention country or a WTO member country.

Every application must provide a specification which contains:

- a description of the invention;
- one or more claims;
- drawings referred to in the description;
- an abstract; and
- a search report.

A filing fee and advertisement fee are payable at the time of the application.

The search report must be prepared by one of the designated offices, or the International Searching Authorities appointed under Article 16 of the Patent Cooperation Treaty. The aim of the search report is to give users information as to prior art and assist in assessing the validity of the patent.

GRANT OF A SHORT TERM PATENT

The Registrar merely examines the application to ensure it complies with the formalities. The Registrar does not examine the patentability of the invention, or whether the invention is properly disclosed in the Application.

Once the formalities have been complied with the Registrar will issue a certificate of grant, publish the specification of the patent and advertise the grant in the Gazette. It is possible to defer the grant of the patent for a period of 12 months from the date of filing of the application.

TERM

A short term patent takes effect from the Date on which the grant is advertised in the Gazette and remains in force for a period of 8 years from the date of filing of the Application.

RENEWAL

A renewal fee is are payable after the end of the 4th year to keep the short term patent valid for a further 4 years.

COURT PROCEEDINGS IN RELATION TO SHORT TERM PATENTS

In any proceedings to enforce the rights conferred by law in relation to a short term patent, it is for the proprietor of the patent to establish the validity of the patent. The court may in interlocutory proceedings order a speedy trial of the action.

THREATS ACTIONS

Groundless threats of infringement proceedings are actionable through civil Proceedings.

Any person aggrieved by threats of proceedings, whether or not he is the person to whom the threats are made, may issue proceedings against the person making the threats for a declaration that the threats are unjustifiable and an injunction against such threats. An aggrieved party may also be entitled to damages and costs.

The person making the threats may show that the patent is valid and infringed.

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