

Hong Kong

Patent Application

**Hong Kong Trademark & Design
Protection Agency Ltd.**

Introduction

Hong Kong has 2 types of patents (1) standard patent, or (2) short-term patent. Both are used for protecting new invention, utilities, functional features, structures, processes, improvements, etc. The longest period of protection for standard patent is 20 years (subject to annual renewal, 1st to 3rd year excepting). The maximum term of protection for short-term patent is 8 years (subject to renewal for the 2nd four years before the expiry of the 1st four years).

Patents do not protect the appearance of products, shape of design, pattern, decoration or visual aesthetics. To protect the exterior design features, application for registered design and the use of copyright will be needed.

In order to obtain a valid patent, the invention must be novel, possess inventive step and capable of mass productive application. New invention must be kept confidential and should only be disclosed to others (eg. prototype manufacturer) under a contract containing a confidentiality clause. If a new invention prior to its filing date or priority date claimed in its Hong Kong application is already part of existing technology or has been exposed, exhibited, published or otherwise disclosed to the public, then the invention may have lost its novelty. If a new invention is neither obvious to or foreseeable by a person skilled in the related technology after looking at the current state of the arts in that field, then that new invention can be seen as possessing inventive step.

Hong Kong examiners will only perform a formality examination, and he or she usually will not make any search for prior patents or prior arts. Hence, the grant and issuance of patent certificate is not in anyway a confirmation on the question of novelty or inventive step, especially in relation to short-term patent.

Upon filing, the invented product can start to be marketed. However, after such exposure to the public or after the publication of the patent application anywhere, most further filing in additional foreign countries must be made within 12 months of filing date of the first ever application with a claim for Paris Convention or WTO priority. The alternative is to organize the applications to be filed on the same date. Moreover, if the applicant wishes to bring forth the date of evaluating the novelty to the earliest filing date, then Convention priority should also be claimed.



Benefits of Patent

- Patent certificate is the best document for showing that you have claimed the invention.
- Patent enables lawful use of the notation "*HK Patent No. ...*" on the product and its packaging.
- Ownership of patents useful for your industry can bring royalty income and enables you to negotiate mutual licensing so as to have others' latest technology be incorporated in your products.
- Patent is a corporate asset which is essential when for attracting venture capital and for valuing your company in M&A or IPO situations.
- Showing patent certificate can be a sales technique for making potential customers have confidence in your patented products.
- Patent certificate is the necessary title document for making complaint to the Legal Adviser of TDC Fairs about patent infringement by another exhibitor.
- Obtaining grant in an important city and trading centre like Hong Kong is helpful for export or global marketing plans.

Standard Patent Timing & Fees

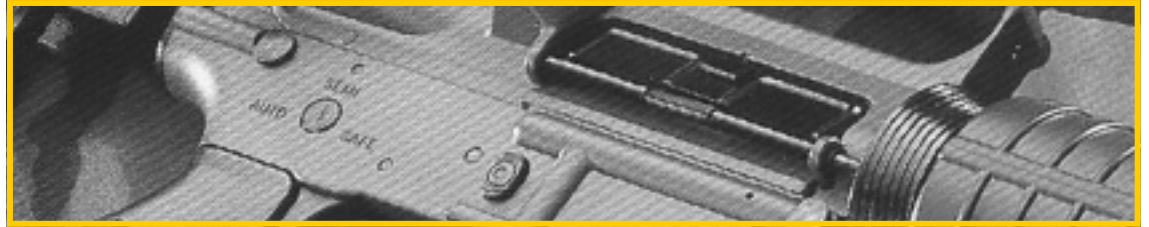
The Standard patent cannot be directly applied in Hong Kong, but need first to have an invention patent application filed in or extended to China, Europe or UK, and then within 6 months of first publication of the base application, file a request to record in Hong Kong. In addition, the applicant must also file a request for grant with 6 months of the publication of the grant of patent in the base application.

The request to record the base application is **HK\$3,600**, and the request for grant is another **HK\$3,600**. Claiming Convention priority is free-of-charge. In case the base application cannot mature in a grant within 5 years, a maintenance fee of HK\$1,500 per year is needed for the 6th year onwards.

The above fees are **inclusive of all** the official fees, the professional fee and disbursements. No other fee or expense is needed (since Hong Kong only has formality examination and no substantive prosecution).



standard patent timeframe & details required



Standard Patent : Details Required & Timeframe

The details required are (1) applicant's full name and address, (2) English and Chinese names of the new invention, (3) inventor's name, (4) copy of publication of the base application, and (5) English and Chinese translation of the abstract.

After filing of the stage 1 request to record, the examiner will first examine the minimum requirements and accord the actual filing date. Once the formalities are also examined, the examiner will prepare for the recoding and publication in Hong Kong of the base application. This whole stage 1 process usually completes at around 3 months with the records searchable at the official search website <http://ipsearch.ipd.gov.hk> .

Hong Kong standard patent application depends on the success or otherwise of the base application in China, Europe or UK. The time frame of Hong Kong standard patent application also depend on the grant of the base application.

The stage 2 request for grant in Hong Kong cannot be filed until the grant of the base application is published. Hong Kong standard patent is usually granted within 3 months of the request for grant. Thereafter, **1st to 3rd years need no annuity**. The annual renewal fee from the 4th year onwards to the 20th year is HK\$2,000 per year all-inclusive.



Short-term Patent & Fees

Short-term patent application can be directly filed in Hong Kong once the specification, claims and drawings are ready. This is so irrespective of whether the document is in the format of an invention patent or a utility model.

The fee for Hong Kong short-term patent application is **HK\$5,600**. A search report made by an international search authority (such as patent office of US, Europe, China, UK, Australia) is needed in addition.

If the applicant wishes us to arrange the search report from the China State Intellectual Property Organization, the fee is HK\$4,500 for Chinese or HK\$7,000 for English. If Convention priority need to be claimed, the fee is HK\$800 and the priority document need to be scanned and e-mailed to us with 2 months of filing.

The above fees are **inclusive of all** official fees, professional fee and disbursements. No other fee or expense is needed (since Hong Kong only has formality examination and no substantive prosecution).

short-term patent timeframe & details required

Short-term Patent : Details Required & Timeframe

The details required are (1) applicant's full name and address, (2) English and Chinese names of the new invention, (3) inventor's name and address, (4) patent or utility model specification, claims & drawings, (5) English and Chinese translation of the abstract, (6) search report, and (7) Convention priority documents (if claimed).

As Hong Kong examiners only perform a formality examination and do not concern themselves with any substantive examination of novelty and inventive step, Almost all short-term patent applications can successfully mature into grant and certificate at around 3 months after submission of all the needed documents.

Upon grant, the short-term is **initially valid for 4 years** (from the date of filing). The renewal for the next 4 years is HK\$4,300 all-inclusive.





Hong Kong Patent Search

Anyone from anywhere can use the free online search website

<http://ipsearch.ipd.gov.hk>

of the Intellectual Property Department of Hong Kong Government to find out whether any similar published patent exists in the register.



Convention Priority

Within twelve months of the first filing of the patent or utility model in a WTO member country or Paris Convention country, a priority can be claimed in the Hong Kong short-term patent application. This will synchronize the Hong Kong filing date with that of the first filing for the purpose of determining the novelty and inventive step of the patent.

For standard patent application, the Convention priority claim simply follows that claimed in the base application in China, Europe or UK, without need to furnish certified copy of the priority application (hence no fee for claiming priority).

For short-term patent application, certified copy of the priority application needs to be filed within 2 months of the application date (hence, need to add HK\$800 for claiming priority).



Hong Kong Trademark & Design Protection Agency Ltd.

Room 2802, 28/F, Lippo Centre Tower 2, 89 Queensway, Hong Kong

t : (852) 8101 8125

f : (852) 8208 2600

email : office@hktmd.com

web : www.hktmd.com