

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 other 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.

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.

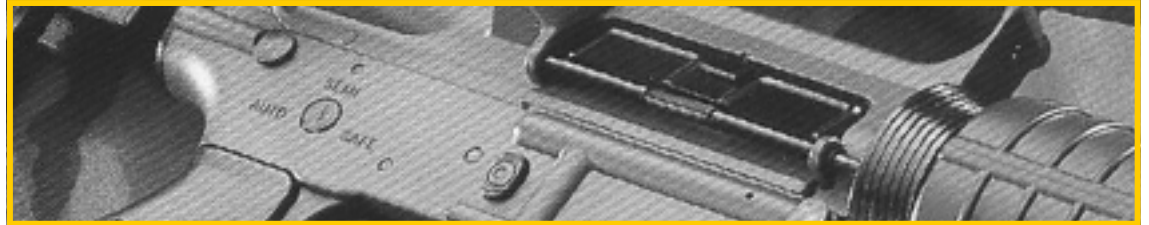
Standard Patent

Standard patent can be directly applied in Hong Kong, OR first filed in China, Europe or UK and then within strict time limits be extended to Hong Kong.

- (A) **Hong Kong Original Grant Application** : For applied directly in Hong Kong, our fee for filing the standard patent original grand **application and request for substantive examination** is **HK\$9,000**. Office action reply or amendment is HK\$2,000 each round. If the application is provisionally refused, request for review and request for hearing if needed will be separately quoted. Our Agency at present do not provide patent search nor drafting of patent specification, reply or amendment. We only act as the Hong Kong agent for the Chinese mainland and foreign intellectual property agents and law firms to file application and handle the procedural progress.

The success or failure of Hong Kong original grant application essentially depends on novelty and inventive step of the invention in context of its claims. The usual time needed is 2 to 5 years. 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) patent specification, (5) English and Chinese translation of the abstract, (6) Convention priority documents (if claimed), and (7) office action reply, amendment and review in substantive examination.

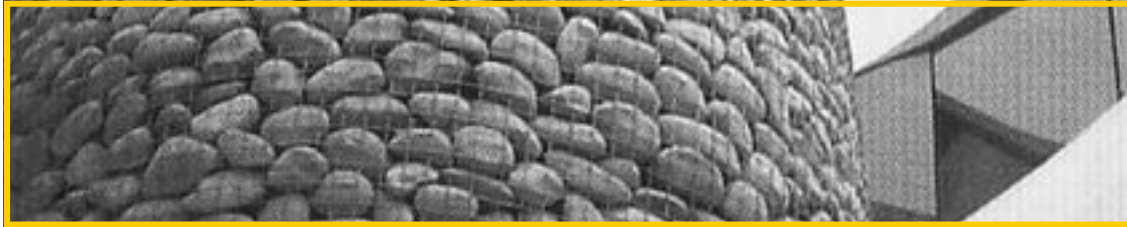




- (B) **Request to Record & Request to Grant** : If invention patent application has been filed in China, Europe or UK, then within 6 months of first publication of the base application, a request to record must be filed in Hong Kong. In addition, within 6 months of the publication of the grant of patent in the base application, a request for grant must also be filed in Hong Kong. Our fee for the **request to record** a patent application is **HK\$3,600**, and the **request for grant** is another **HK\$3,600**. 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.

Hong Kong request to record & request to grant application depend on the success or failure of the base application in China, Europe or UK. The time frame 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 around 6 months of the request for grant.

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.



Short-term Patent & Fees

Short-term patent application can be directly filed in Hong Kong. Our Agency at present do not provide patent search nor drafting of patent specification. We only act as the Hong Kong agent for the Chinese mainland and foreign intellectual property agents and law firms to handle their Hong Kong applications.

If an applicant already have a patent or utility model specification drafted in say China, Taiwan, USA, etc., the applicant may also instruct us to file Hong Kong short-term patent application.

Our fee for Hong Kong short-term patent application is **HK\$5,600**. A search report made by the patent office of China, Europe or UK is needed in addition. If the applicant wish 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.

short-term patent timeframe & details required

Short-term Patent : Details Required & Timeframe

As 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 within 6 months of submission of all the needed documents. Upon grant, the short-term is valid for the initial 4 years (from the date of filing). The renewal for the next 4 years is HK\$4,300 all-inclusive.

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 specification, claims & drawings, (5) English and Chinese translation of the abstract, and (6) Convention priority documents (if claimed).





Hong Kong Patent Search

Anyone from anywhere can use the free online search website

<https://esearch.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 original grant standard patent application and 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 request to record 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 original grant standard patent application and short-term patent application, certified copy of the priority application needs to be filed within 2 months of the application date.



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