

PATENT FILING IN HONG KONG

There are two types of patents in Hong Kong, namely (A) **Standard Patent** and (B) **Short-Term Patent**.

A. STANDARD PATENT

The grant of a **Standard Patent** in Hong Kong is based on the registration of a patent granted by one of the following three patents offices ("Designated Patents Offices"):

- (1) the State Intellectual Property Office, People's Republic of China;
- (2) the European Patents Office, in respect of a patent designating the United Kingdom;
- (3) the United Kingdom Patents Office.

A **Standard Patent** application is made in two stages, namely (i) by filing a request to record the designated patent application within six months after the publication of the designated patent application in the Designated Patents Office ("Stage One") and then (ii) by filing a request for registration and grant in Hong Kong within six months after publication of the request to record in Hong Kong or the grant of the designated patent by the Designated Patents Office whichever is later ("Stage Two").

Protection under **Standard Patents** is annually renewable for a maximum term of twenty (20) years.

Information and documents required for application for a **Standard Patent**:

Stage One

- (1) a copy of the published designated patent application.
- (2) the title of the invention in both English and Chinese.
- (3) an abstract in both English and Chinese.
- (4) the applicant's name and address.
- (5) if the **Standard Patent** applicant is not the applicant named in the designated patent application, a statement explaining the applicant's right to apply and the supporting documents (eg copy of assignment).
- (6) if the inventor is not named in the designated patent application, a statement identifying the person whom the applicant believes is the inventor.
- (7) if priority is claimed, a statement of priority stating the date of filing, the application number of any application and the country, territory or area in or for which the application was made.
- (8) if non-prejudicial disclosure is claimed, the name and place of the prescribed exhibition or meeting at which the invention was disclosed, the opening date of the exhibition or meeting, and the date of the first disclosure.
- (9) if applying for a **Standard Patent** through a PCT International Application designating China, you need to provide: -
 - (a) a copy of the international application as published by the International Bureau.
 - (b) a copy of any translation of the international application published by the State Intellectual Property Office, PRC ("**SIPO**").
 - (c) a copy of any publication of information in the SIPO concerning the international

application.

- (d) a copy of the national application notification, if the international application has been published by the International Bureau in Chinese.

Stage Two

- (1) a copy of the published specification of designated patent (the applicant needs to confirm that it is a true copy of the document issued by or kept at the relevant Designated Patents Office).

B. SHORT-TERM PATENT

The grant of a **Short-Term Patent** in Hong Kong is based on a search report from an international searching authority or one of the three Designated Patents Offices.

The grant of a **Short-Term Patent**, unlike **Standard Patent**, does not follow a substantive examination of its patentability. In such case, when it comes to enforcement of a **Short-Term Patent**, the grant alone is not sufficient to ensure that the patent right can be enforced. In fact, the **Short-Term Patent** owner has to prove that his or her **Short-Term Patent** is prima facie valid in any enforcement proceedings before the court.

Protection under **Short-Term Patents** is renewable after four (4) years from filing, for a maximum term of eight (8) years.

Information and documents required for application for a Short-Term Patent:

- (1) A specification (description, claim, abstract and drawings).
- (2) An abstract in both English and Chinese.
- (3) The title of invention in both English and Chinese.
- (4) The applicant's name and address.
- (5) The inventor's name and address.
- (6) A search report (from an international searching authority or one of the three Designated Patents Offices).
- (7) If the applicant is not the inventor, the applicant must make a statement indicating its entitlement to the **Short-Term Patent** eg by employment, by assignment etc.
- (8) If priority is claimed, a statement of priority stating the date of filing, the application number of any application and the country, territory or area in or for which the application was made.
- (9) If non-prejudicial disclosure is claimed, a statement and written evidence to support the claim.
- (10) If applying for a **Short-Term Patent** through a PCT International Application designating China, you need to provide: -
 - (a) a copy of the international application as published by the International Bureau.
 - (b) a copy of the international search report.
 - (c) the date of entry of the international application into the national phase in China.
 - (d) a copy of the translation of the international application (if any) published by the SIPO.
 - (e) a copy of any information published by SIPO concerning the international application.

- (f) a copy of the national application notification and date of issue of the notification, if applicable.

C. Time Frame

For a straightforward **Standard Patent** application, it usually takes around 3 months to complete the Stage One and another 3 months to complete the Stage Two procedure.

For a straightforward **Short-Term Patent** application, it usually takes around 3 to 4 months to become registered.

D. Costs

Should you be interested in obtaining a fee estimate of filing and completing a patent application in Hong Kong, please contact us at law@chloelee.hk

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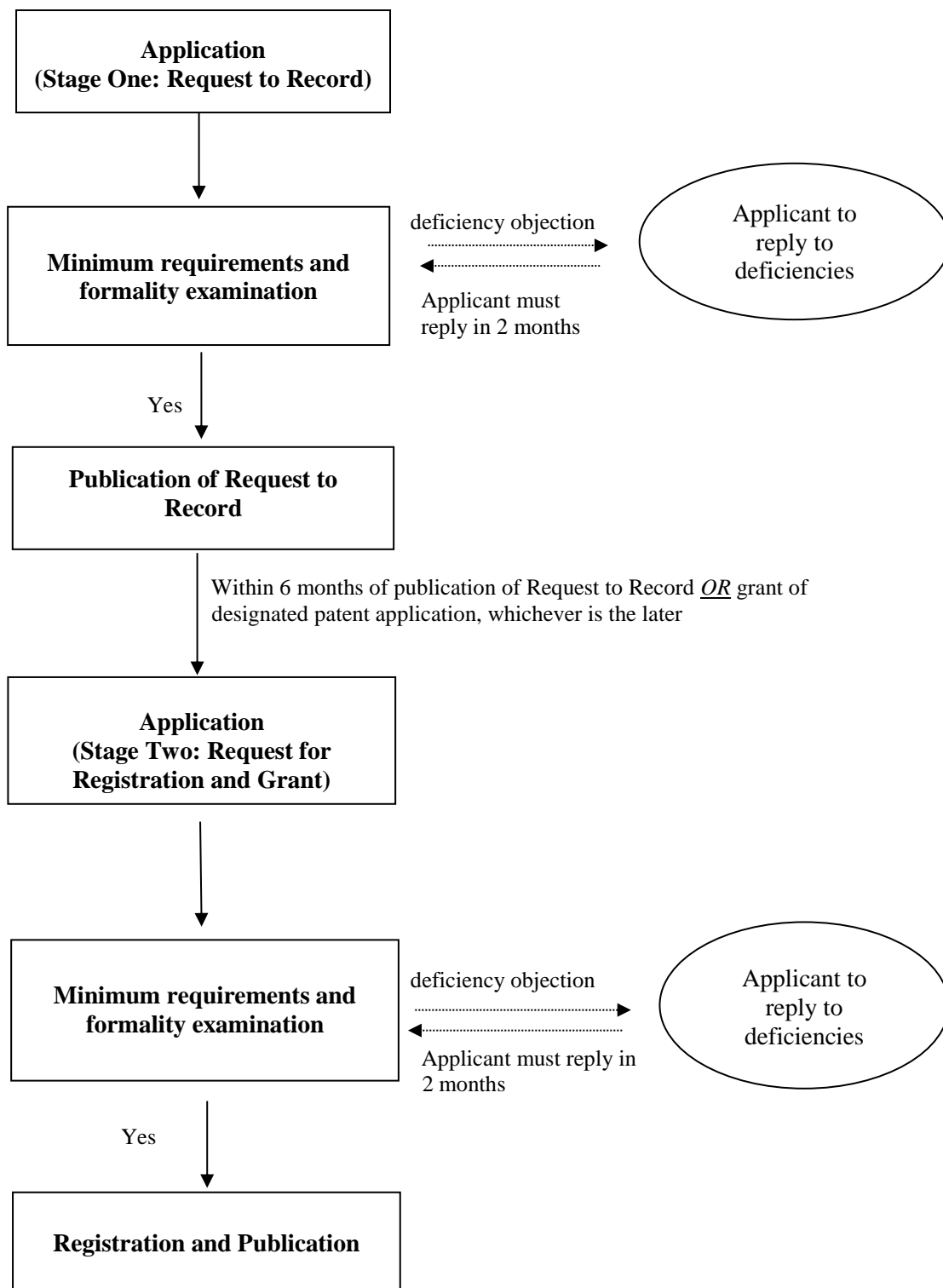


Photo by Mr Addie Lin, a good friend

If you would like to know more about what we do, please visit us at www.chloelee.hk or contact us at law@chloelee.hk

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Hong Kong Standard Patent Registration Procedure

Hong Kong Short-Term Patent Registration Procedure