

Hong Kong China's response to letter from
World Intellectual Property Organization dated 19 April 2013 (C. 8261)

Exceptions and limitations to patent rights

Please see the updated response to the questionnaire attached.

Quality of Patents

1. There is no work-sharing program between the Patents Registry of Hong Kong, China and other Member States or Regional Patent Offices for the following reasons:-

(a) There are two types of patent grants in Hong Kong, China, namely standard patents and short-term patents

(i) The grant of a standard patent in Hong Kong, China is based on the registration of a patent granted by one of the three patent offices i.e. the State Intellectual Property Office, People's Republic of China, the European Patent Office in respect of a patent designating the United Kingdom, or the United Kingdom Patent Office.

(ii) 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 aforesaid three designated patent offices to be provided by the applicant.

(b) The Patents Registry of Hong Kong, China conducts formality examination of a patent application. There is no substantive examination of a patent application (such as concerning novelty and inventiveness of the invention in question) and the Patents Registry does not search records of prior art. As such, there is no legal requirement for the Patents Registry to obtain any patent information from other patent offices for search or examination purposes.

2. Upon endorsing the recommendations made by the Advisory Committee of Review of the Patent System in Hong Kong, the Government of Hong Kong, China has decided to establish an "original grant" patent (OGP) system with substantive examination outsourced to other patent offices, and the proposed OGP system should be run in parallel to the current re-registration system. This policy decision takes into account the factor that building indigenous substantive patent examination

capacity will take time, and that outsourcing substantive examination to one or more reputable and authoritative patent office(s) will ensure the high quality of the patents granted under the new regime. The Government is working out the details in implementing the policy decision.

Confidentiality of communications between clients and their patent advisors

1. There is currently no regulatory regime for provision of patent agency services in Hong Kong, China. Any person, with or without the relevant technical and/ or legal expertise, may claim himself or herself to be a patent practitioner.
2. In Hong Kong, China, it is not uncommon that solicitors are retained as patent agents. In this connection, communications between clients and their patent advisors who are solicitors will qualify as confidential information.
 - (a) A solicitor owes the duty of confidence to his client during the subsistence of the solicitor-client relationship. This relationship comes to an end with the termination of the retainer. But the duty of confidentiality survives the termination to protect the confidentiality of the information imparted during the subsistence of that solicitor-client relationship: see *Prince Jefri Bolkiah and KPMG (a firm)* [1999] 2 AC 222 at 235C-F, per Lord Millett.
 - (b) Moreover, under paragraph 8.01 of The Hong Kong Solicitors' Guide to Professional Conduct, Vol. 1, it is stated that:

"8.01 A solicitor has a duty to hold in strict confidence all information concerning the business and affairs of his client acquired in the course of the professional relationship, and must not divulge such information unless disclosure is expressly or impliedly authorized by the client or required by law or unless the client has expressly or impliedly waived the duty."
 - (c) Further, legal professional privilege protects the confidentiality of *bona fide* communications between lawyer and client concerning matters of legal advice or in reference to litigation, be it on-going or in contemplation. The privilege conveys the right to resist the compulsory disclosure of those communications.
3. Upon endorsing the recommendations made by the Advisory Committee of Review

of the Patent System in Hong Kong, the Government of Hong Kong, China has decided to develop a full-fledged regulatory regime on patent agency services in the long run, which has to be achieved in stages, with possible interim measures.

Transfer of technology

As the Patents Registry of Hong Kong, China does not regulate or oversee any transfer of technology, we are not in a position to provide any information on examples or experience on patent-related incentives and impediments to transfer of technology.

Having said that, as far as we are aware, there is a local funding scheme titled "Patent Application Grant" (the "Grant") administered by the Innovation and Technology Commission with Hong Kong Productivity Council as the implementation agent with a view to assisting local companies and individuals to apply for patents of their own inventions. The Grant aims to encourage local companies and inventors to capitalise their intellectual work through patent registration.

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