Recent Changes to the Patent Laws in Singapore and Hong Kong

Autumn appears to be a popular time to amend patent rules/laws as a number of jurisdictions have done so. In addition to formality changes in Canada and India, Singapore and Hong Kong have introduced changes that may significantly impact filing strategies in these jurisdictions. In the November issue of the Global Patent Prosecution Newsletter, we highlight these upcoming changes in Singapore and Hong Kong.

Patent Law Amendments in Singapore - Closure of Reliance on the Foreign Examination Option

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New Patent System in Hong Kong - Original Grant Patent Route

In this issue, we cover:

- Patent Law Amendments in Singapore - Closure of Reliance on the Foreign Examination Option
- New Patent System in Hong Kong - Original Grant Patent Route

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NEW PATENT SYSTEM IN HONG KONG - ORIGINAL GRANT PATENT ROUTE

By: Paul A. Calvo, Ph.D.

On December 19, 2019, the Hong Kong Intellectual Property Department (HKIPD) will launch a new patent system as the result of the Patents (Amendment) Ordinance 2016 and the Patents (General) (Amendment) Rules 2019.[i] Under the new system, a direct patent filing route for standard Hong Kong prosecution (Original Grant Patent (OGP)) will be available in addition to the existing re-registration patent system.

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Technical Minds. Legal Muscle.
A recent change in Singapore has done away with the ability of an applicant to rely on a positive foreign examination result or the international preliminary report on patentability (IPRP) to request supplementary examination. This change will come into force on January 1, 2020. This change has the potential to significantly alter the way applicants pursue protection in Singapore because local search and examination will be the only route available going forward.

Examination options will be unchanged for patent applications pending on January 1, 2020 or PCT national phase entries on or after January 1, 2020 but have an international filing date earlier than January 1, 2020. These applications will still be eligible for the foreign examination option. Importantly, PCT national phase entries with an earlier international filing date of January 1, 2020 do not need to be completed prior to the January 1, 2020 deadline to retain the ability to pursue the foreign examination route.

Direct national applications, such as applications first filed in Singapore on or after January 1, 2020, will not be eligible for the foreign examination route. For these applications, filings should be made as soon as possible, and at the very least, prior to the January 1, 2020 deadline if the foreign examination route is desired.

However, divisional applications filed on or after January 1, 2020 will not be eligible for the foreign examination option, regardless of their priority date. Therefore, for divisional applications where applicant desires to retain the foreign examination option, the applicant should consider proactively filing divisionals before January 1, 2020 to retain all examination options in Singapore. Since the examination request deadline of a divisional application is calculated from the divisional’s filing date, applicants can expect to wait for 54 months from the divisional’s filing date to await the outcome of foreign prosecution.

One benefit that comes with above amendments to Singapore’s patent laws is a change to the grace period currently operating in Singapore. Currently, applicants have a 12-month grace period for disclosures originating from inventors only for those cases where the disclosure is derived from a breach of confidence, at a recognized international exhibition, or to a learned society only. With the change in the law, the grace period is broadened to include any disclosures derived from an inventor within 12 months. This now brings the grace period
provision in conformity with other countries, such as the United States, Australia, and Japan.

Applicants are strongly advised to review their portfolios to determine whether their cases are negatively impacted by these changes and to proactively file divisional applications where appropriate.

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On December 19, 2019, the Hong Kong Intellectual Property Department (HKIPD) will launch a new patent system as the result of the Patents (Amendment) Ordinance 2016 and the Patents (General) (Amendment) Rules 2019.[i] Under the new system, a direct patent filing route for standard Hong Kong prosecution (Original Grant Patent (OGP)) will be available in addition to the existing re-registration patent system. This change affects standard patents, which protect an invention for a maximum term of 20 years.

Under the OGP system, a patent specification for the standard patent application may be drafted in English or Chinese. A request for a substantive examination of the patent application must be filed within 3 years from the filing date or the earliest priority date of the standard patent application. The HKIPD will outsource aspects of the substantive examination of Hong Kong standard patent applications to the China National Intellectual Property Administration (CNIPA), as an interim arrangement. The examiners from the CNIPA will provide technical opinions relevant to the novelty and inventive step of the claimed invention, while the Patents Registry in Hong Kong will prepare the office action (examination notice) in view of CNIPA’s technical opinion and based on the Patents Ordinance in Hong Kong.

The Patents (Amendment) Ordinance 2016 also introduces changes in the existing short-term patent system. In Hong Kong, a short-term patent can be a cost effective alternative for obtaining limited patent protection for a maximum term of 8 years. Under the existing system, a short-term patent application can be filed directly at the Hong Kong Patents Registry and is only subject to formality examination. The new short-term patent system will increase the number of independent claims allowed from one to two independent claims, provided that the two independent claims are related to a single invention.

Short-term patents will also now be subject to post-grant substantive examination by the Patents Registrar under the following circumstances: (1) at the request of the short-term patent proprietor or any third party with a legitimate concern about the validity of the short-term patent; or (2) as a prerequisite to enforcement of an unexamined short-term patent by the short-term patent proprietor. If the short-term patent does not satisfy the examination requirements, the Patent Registrar will raise one or more objections, and the short-term patent proprietor will be given the opportunity to submit remarks and/or amendments to the short-term patent to address the Patent Registrar’s objections. If the short-term patent is not found to satisfy all substantive requirements, it will be revoked.
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