

Editorial

First thoughts on Hong Kong's new patent system; second thoughts on its further medical use claims

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Although Hong Kong is one of the most competitive economies in the world, it does not have an independent patent system.¹ This Special Administrative Region has been re-registering patents that were granted by China, the EPO and UK under the Patent Ordinance of 1997. It did not sit well for Hong Kong that, in regard to the dependence of its patent system, it was in the same league as jurisdictions such as Cambodia, Fiji and Seychelles.

While the Copyright (Amendment) Bill 2014 noisily failed in April 2016,² the Patent (Amendment) Bill 2015 was passed in complete silence, last June. The bill, which will probably come into effect in 2017, will give birth to an independent patent. Next to this 'Original Grant Patent' (OGP), one can still re-register Standard Patents that were substantively examined and granted by the State Intellectual Property Office (SIPO) of China, the EPO and UKIPO. However, since Hong Kong does not yet have the know-how needed to do substantive examinations, it pro-actively signed an agreement with SIPO in 2013 to train and support them until they can do these activities by themselves. The continuance of re-registration next to an independent patent will create a challenge to uphold a unified standard of quality. When Hong Kong registrars are able independently to conduct substantive examinations, one could imagine, in this time of regionalization and unifying patent systems, that China, the EPO or UK would also recognise Hong

Kong's patents by providing the possibility to re-register its patents after just a formal examination. The Patent (Amendment) Bill 2015 will also increase the standard for the Short Term Patent. Short Term Patent owners need to ask the Registrar for substantive examination after grant, or face revocation. In the same vein, under the new ordinance, these patentees can only sue a third party for infringement if they have requested substantive examination or already have a certificate of substantive examination.

Hong Kong will allow for first and further medical use claims.³ The legal fiction of non-susceptibility of industrial application for a diagnostic, therapeutic or surgical treatment under Hong Kong's patent ordinance is resolved if the claim is phrased as a purpose-limited product claim. Also, the ordinance resolves the problem that the known substance is not novel if it concerns a first but also further medical use. One can argue that allowing first medical use is a balanced policy decision: between protecting purpose-limited claims and accessibility to generics. However, with second and further medical use, the scales are tipped towards protection of extending originators' patent rights, despite a lack of novelty and marginal inventiveness.⁴ This might not be conducive for generics and the access to reasonably priced medicines. Then again it might be positive for efficacy studies.

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1 Hong Kong did already have a Short Term Patent that has a duration of 8 years. It can be applied directly with the Hong Kong Registrar. Under the Patent Ordinance 1997 one only need to support one's application with a search report.

2 The Copyright (Amendment) Bill 2014 was "murdered", according to Secretary for Commerce and Economic Development in a frenzy of political mistrust in April 2016. 'Copyright Bill opponents "murderers": Greg So', RTHK News, [http://news.rthk.hk/rthk/en/component/k2/1246244-](http://news.rthk.hk/rthk/en/component/k2/1246244-20160303.htm)

20160303.htm. The bill, that actually would have expanded internet users' rights, was framed as the Article 23 of the Internet, referring to the Basic Law provision, which gives Hong Kong the duty to implement a National Security law. This law was shelved in 2003 after a massive public outcry over concerns of a possible curbing of liberties.

3 Section 9B(5) new Patent Ordinance.

4 Greater efficacy by way of timing, frequency, dosage or sequence of the administration of the drug or in combination with a new compound, or for a new patient group, etc.

Hong Kong followed the UK,⁵ which followed the EPO in the adoption of the use of Swiss-type claims.⁶ The EPO and UK no longer allow this kind of convoluted claim. Instead, they permit first and further medical

use claims to be expressed via direct phrased claims. Hong Kong will allow both kinds of claim and continues to allow Swiss-type claims to allow for re-registering of Chinese patents with this sort of claim.

5 *Abbott GMBH & Another v Pharmareg Consulting Company Ltd & Another* [2009] 3 HKLRD 524 (HK Court of First Instance)

6 Swiss-type claim format: "Use of the known compound X in the manufacture of the medicament for the new therapeutic application Y."