

Patent Application Grant

Please note that this Q&A only provides a brief introduction to the Patent Application Grant. For the detailed eligibility criteria and the funding conditions of the Grant, please refer to the application form. Please contact the Hong Kong Productivity Council (Tel.: 2788 5958; Fax: 3187 4509) for any questions about this Q&A.

Q1: How to apply for the “Patent Application Grant”?

A1: Two copies of the duly completed application form should be submitted to the Hong Kong Productivity Council (HKPC) or Innovation and Technology Commission (ITC). The application form can be downloaded at <https://www.hkpc.org/en/support-resource/support-centres/319-support-centers/7848-intellectual-property-services-centre#patent-application-gant> or https://www.itc.gov.hk/en/fund_app/patent_app_grant.html.

For individual applicant, the application form should be submitted together with one photocopy of HKID card and address proof.

For applicant company, the application form should be submitted together with one photocopy each of the Certificate of Incorporation, Business Registration Certificate and Incorporation Form (Form NNC1) or Annual Return (Form NAR1) filed with the Companies Registry and address proof.

Q2: Who are eligible to apply?

A2: All local companies, Hong Kong permanent residents or Hong Kong residents permitted to remain in Hong Kong for not less than seven years who have never owned any patents before will be eligible.

For individual applicant, the applicant must be the sole inventor or one of the joint inventors of the invention.

For company applicant, the inventor(s) of the invention shall be a directly related party/parties to the applicant company, e.g. owner, shareholder, director, or staff.

The Patent Application Grant (PAG) is a funding scheme to encourage first-time patent seekers that have never owned any patents before and have not received any funding from the PAG, to apply for patent registration. Applicant companies are required to provide information on their shareholder(s) with 50% or more ownership (the major shareholder(s)). Funding support will not be provided if PAG has been granted to the related companies of the applicant company (i.e. companies having the same major shareholder(s)).

Q3: If I have already filed a patent application in a particular country, am I still eligible to apply for this Grant?

A3: You can still apply for the PAG if you do not have any patents granted by any countries or territories when you apply for the PAG. However, the funds can be used only after your application has been approved by the Innovation and Technology Commission and are only released to the implementation agent through which the patent application is administrated.

Q4: Which is the implementation agent?

A4: The Hong Kong Productivity Council is the implementation agent of the PAG.

Q5: Do I need to pay any fees after my application of the “Patent Application Grant” has been approved by the Innovation and Technology Commission?

A5: Yes. A grant of not more than HK\$250,000 or 90% of the total direct cost of the patent application(s) (including the direct cost for patent search-cum-technical assessment), whichever is lower, will be provided to each approved application. After the approval of PAG, you need to appoint a patent agent for handling the patent application(s) and pay HKPC the remaining direct cost in accordance with the amount on each quotation.

Please be reminded that the PAG may not be sufficient to cover the patent application expense, and you have to bear the remaining balance.

Q6: Does PAG only cover the costs for Hong Kong patent applications?

A6: No. The grant can be used in applying for patents in or outside Hong Kong. However, a grant of not more than HK\$250,000 or 90% of the total direct cost of patent application, whichever is lower, will only be provided to each approved application.

Q7: Does PAG only cover the filing costs for patent applications?

A7: No. PAG can be used to cover the direct expenses of patent registration, including filing fee, examination fee, issue fee etc. To ensure that sufficient funding is available for the completion of at least one patent registration, a portion of the PAG funding (\$70,000) will be reserved for covering expenses to be incurred in the procedures after the filing of the application(s) to patent office(s), i.e. the post-filing stage¹ of patent application.

Q8: What will be the chance for success for this “Patent Application Grant”?

A8: Generally, we will conduct patent searches and technical assessments for applicants but the chance of success depends on the quality of invention and the search and assessment results. Since the launching of the PAG in 1998, around half of the applications are successful.

Q9: What is the requirement for the invention to be funded by the PAG?

A9: Not all inventions will be funded by the PAG. Only inventions that ITC considers as containing technology elements and susceptible of industrial application would be supported by the PAG.

Q10: What is the requirement for the appointment of patent agent(s) under the PAG?

A10: If the application is approved, the applicant has to appoint a patent agent to handle the patent application. The Guide for Patent Agents was first issued in February 2019 and the latest version is available at the below link:

¹ Filing stage of patent application involves preparation of the patent specification and filing of the patent application(s) to patent office(s). Post-filing stage refers to all the procedures after the filing stage of patent application. The applicants may seek clarifications from the implementation agent in case of doubts.

<https://www.hkpc.org/en/support-resource/support-centres/319-support-centers/7848-intellectual-property-services-centre#patent-application-gant>

Referring to the Guide for Patent Agents, we would like to draw your attention that in the assessment period, if the search report result is unfavourable but the applicant would like to proceed with the application, the applicant has to appoint a patent agent to provide third party advice to confirm the patentability of the invention. To ensure the impartiality of patentability advice, the patent agent providing the patentability advice should have no direct or indirect relationship/association with the patent agent to be appointed to handle the patent application matters after approval of the PAG application.

For individual applicant, the applicant should have no direct or indirect financial, commercial, personal or other interests in, or have any association or connection with the owners, shareholders or management of the appointed patent agent(s) and the staff(s) responsible for handling the application.

For company applicant, the owners, shareholders or management of the company applicant should have no direct or indirect pecuniary or other personal interests in, or have any association or connection with the owners, shareholders or management of the appointed patent agent(s) and the staff(s) responsible for handling the application.

The applicant and patent agent shall observe the Prevention of Bribery Ordinance (Cap. 201) (“PBO”) in Hong Kong. The applicant and patent agent shall prohibit its directors, employees, agents, suppliers, consultants, contractors and other personnel who are involved in the PAG from offering, soliciting or accepting any advantages (as defined in the PBO) when prosecuting the patent applications under the PAG. If the applicant and patent agent or any of its directors, employees, agents, suppliers, consultants, contractors and other personnel who are involved in the PAG commits any offence under the PBO when prosecuting the patent applications under the PAG, HKPC and the Government shall be entitled to withhold, suspend and/or terminate the PAG immediately and hold the applicant and patent agent liable for any and all losses or damages HKPC and the Government may thereby sustain.

Q11: What are the details of the procedures of the application?

A11: All applications received will be treated in the strictest confidence by the implementation agent. The procedures are as follows:

1. Receive application form
2. Assess the accuracy of the information in the application form
3. Identify if the information is sufficient to start the patent search-cum-technical assessment
4. Determine if the invention has sufficient novelty
5. Conduct face-to-face interview with the inventor(s) in person in Hong Kong
6. Conduct patent search-cum-technical assessment
7. Obtain a search report. For the search report provided by the applicant, the applicant should provide original or certified true copy of the search report for checking.
8. Conduct assignee search
9. Recommend to the Innovation and Technology Commission to approve or reject the application (the decision of the Commission is final)

Q12: How much does patent search-cum-technical assessment cost?

A12: The cost of patent search-cum-technical assessment depends on the complexity of invention. According to our past experience, patent searches and technical assessments normally could be completed within the range of HK\$2,500 to HK\$6,000. The cost may be higher if third party advice (normally from a patent agent/attorney) is required to assess the patentability of the invention. The cost of a typical third party advice report is from HK\$4,500.

Q13: What is patent search-cum-technical assessment?

A13: The purpose of conducting the patent search-cum-technical assessment is to assess whether the invention is of novelty, inventiveness and industrial applicability, and to check from patent databases covering worldwide published patents or applications of more than 48 countries to identify any prior published patents or applications which are analogous to your invention so as to assess whether the invention has a reasonable chance to obtain an invention patent.

We will conduct the patent search-cum-technical assessment upon receipt of a duly completed application form from the applicant. A patent search will be done first

and then an assignee search will be conducted to identify if applicants are eligible to apply for the PAG (i.e. the applicant did not own any granted patents prior to submission of the PAG application form). The cost of the patent search-cum-technical assessment will depend on the complexity of the search and assessment and on whether a third party advice (normally from a patent agent/patent attorney) is required. Normally, the direct cost of patent search-cum-assessment without any third party advice will be in the range of HK\$2,500 to HK\$6,000.

If the result of patent search by a patent office indicates that the chance of the invention to obtain an invention patent is slight, the applicant may provide a written response to delineate the distinctive features of the invention from those disclosed in the prior art documents in the patent search report, so as to obtain the third party professional advice on whether the invention has a reasonable chance to obtain an invention patent based on the distinction provided. If the third party professional advice is in line with/similar to the result of the patent search report, i.e. the chance of the invention to obtain an invention patent is slight, the applicant may consider obtaining another and also the final professional advice from another patent agent/attorney on whether the subject invention has a reasonable chance to obtain an invention patent. Based on our experiences, the direct cost of a typical third party advice report is from HK\$4,500, and the total cost for patent search-cum-technical assessment may go up to around HK\$11,000.

The entire patent search-cum-technical assessment will only be continued after the applicant is informed and his consent is obtained. **The total direct cost of the patent search-cum-technical assessment shall be paid in advance by the applicant**, 90% of which will be reimbursed from the PAG grant if and after the application is approved. However, if such PAG application is not approved by ITC, the applicant has to bear the total direct cost of the patent search-cum-technical assessment.

To better assist a patent office to obtain accurate patent search result(s), the applicant should fully state the scope sought for patent protection in the “Intended scope of claims” under Part III Item 3 of the PAG application form. It should be drafted in such a manner that it defines clearly and concisely the matter for which protection is sought in terms of the technical features of the invention. Please refer to the links at footnotes² for reference.

Q14: How would it be if the information provided is insufficient?

A14: We will ask the applicant to provide further information. If the applicant fails to respond or provide relevant information within two months from the date of issue of the second reminder notification by the implementation agent, the application is deemed to be withdrawn.

Q15: How long is the processing time for the application?

A15: The processing time depends on a number of factors, including the complexity of the inventions, and whether all the necessary information has been provided for processing the case. According to our experience, upon receipt of all the required information from the applicant, it may take about on average 6-9 months to know the outcome of the application.

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中華人民共和國專利法實施細則 – 第二十一條” 中華人民共和國國家知識產權局 (2010)
[Link: http://www.sipo.gov.cn/zcfg/zcfgflfg/flfgzl/xzfg_zl/1063512.htm]

“實用新型申請撰寫示例 (說明書) 第四頁-權利要求書 (撰寫示例) ”中華人民共和國國家知識產權局 (2009)
[Link: <http://www.sipo.gov.cn/docs/20180206153157392351.doc>]

“Regulations under the PCT -Rule 6, The Claims, 6.3 (b)” World Intellectual Property Organization (2011)
[Link: http://www.wipo.int/pct/en/texts/rules/r6.htm#_6_3]

“PCT International Search and Preliminary Examination Guidelines, Chapter 5, Section 5.05 ” World Intellectual Property Organization (2019)
[Link: <http://www.wipo.int/pct/en/texts/gdlines.html>]

Q16: How long is the validity of the “Patent Application Grant”?

A16: The PAG grant is non-transferable and will be valid for **three** years from the date of approval of the application. ITC and/or the implementation agent may contact the applicant or any of the persons mentioned in Part I of the application form directly to enquire the progress/outcome of the registration of patent(s) funded by the PAG within two years after the expiry of the PAG.

Fees and Charges of HKPC for Patent Application Grant Scheme**(1) Charges on patent search and technical assessment prior to funding approval by ITC**

Activities	Fee(s) Charged by External Agents
Obtaining Search Report from patent office	Approximately RMB1,600 for obtaining a search report from SIPO based on invention written in Chinese, OR Approximately RMB4,100 for obtaining a search report from SIPO based on invention written in English.
Patentability Advice (This step may be required if the search report is not favourable)	From HK\$4,500 for preparing and writing the patentability advice by patent attorney/agent. The fee depends on the complexity of the subject invention, distinction of applicant's invention, and volume of relevant prior arts documents searched.

Based on the above table, the cost for conducting patent search and technical assessment is approximately in the range of HK\$2,500 to HK\$6,000 depending on the complexity of the search and assessment. A higher fee may incur if the search report is not favourable and patentability advice is required from a patent attorney to assess the patentability of the invention. As a reference, the cost of a typical patentability advice report is from HK\$4,500. In such case, the total cost for patent search-cum-technical assessment may go up to around HK\$11,000.

PAG Application Procedure

[Please replace with the final version in the application form.]

