

## **LEGISLATIVE COUNCIL BRIEF**

Patents Ordinance  
(Chapter 514)  
Registered Designs Ordinance  
(Chapter 522)

### **INTELLECTUAL PROPERTY (MISCELLANEOUS AMENDMENTS) BILL (NO. 2) 2000**

#### **INTRODUCTION**

At the meeting of the Executive Council on 5 December 2000, the Council ADVISED and the Chief Executive ORDERED that the Intellectual Property (Miscellaneous Amendments) (No. 2) Bill 2000, at Annex A, should be introduced into the Legislative Council to make miscellaneous amendments to the Patents Ordinance and the Registered Designs Ordinance.

#### **BACKGROUND AND ARGUMENT**

##### **General Background**

2. The Patents Ordinance and the Registered Designs Ordinance were enacted on 27 June 1997. They establish the intellectual property rights and registration system for patents and designs respectively. In the light of more than three years' operation of the two Ordinances, we propose some technical improvements to them.

3. The legislative proposals will achieve the following objectives –
- (a) to provide a legal basis for using electronic means of publishing notifications and advertisements for patents and designs;

- (b) to enhance and clarify provisions related to right of priority in patent and design applications;
- (c) to simplify patent application procedures;
- (d) to enhance the procedure for amending the schedule of Paris Convention countries and World Trade Organisation (WTO) members under the Patents Ordinance;
- (e) to align the wording in the Patents Ordinance with that in the relevant international agreement; and
- (f) to tie up some loose ends in the two Ordinances.

## **The Proposals**

### **(A) Legal Basis for Electronic Publication of Patents and Designs**

4. Many intellectual property authorities in the world, such as those in Japan, South Korea and the United States, offer the option of delivering services through electronic means. Hong Kong must keep pace with such global development which is consistent with growing public expectation. At present, both the Patents Ordinance and Registered Designs Ordinance stipulate the Government Gazette as the only publication in which notifications and advertisements for patents and designs can be made. We plan to allow for the electronic publication of patents and designs which should reduce costs and be more efficient. Our plan will be implemented in phases over the next three years.

5. DIP is both the Registrar of Patents and the Registrar of Designs. We **propose** to amend the Patents Ordinance and the Registered Designs Ordinance to empower DIP to specify publications other than the Government Gazette in which notifications and advertisements for patents and designs can be made. Such publications may include a publication in electronic form. The new Trade Marks Ordinance enacted in May 2000 has similar provisions for trademarks.

## **(B) Enhance and Clarify Priority Right Related to Patents and Designs**

6. We **propose** to enhance section 110 of the Patents Ordinance by providing that a right of priority arising as a result of the filing of a patent application, may be assigned or transmitted either together with the application or independently. This will allow, for example, the owner of an invention who has filed a patent application in a Paris Convention country but who does not wish to seek patent protection in Hong Kong, to assign his right of priority to another party for applying for a short-term patent in Hong Kong based on the same invention. The proposal will give greater flexibility to the owner to make economic use of his intellectual property right.

7. For designs, we **propose** to amend section 15(1) of the Registered Designs Ordinance to clarify the right of a person's successor in title. The proposed amendment makes it clear that where a person has filed an application to register a design in a Paris Convention or WTO member country, his/her successor in title may also enjoy a right of priority in registering the same design in Hong Kong within a prescribed period.

## **(C) Simplify Patent Application Procedures**

8. We **propose** to amend section 15(2)(e) and section 15(2)(f), and to repeal section 16(c) of the Patents Ordinance to remove the requirement that applicants must make a statement confirming that no claim to priority or non-prejudicial disclosure is made in the application. A statement will be required in the application only in cases where the applicant claims priority or non-prejudicial disclosure. This will simplify patent application procedures.

## **(D) Enhance the Procedure for Amending the Schedule of Paris Convention Countries or WTO Members**

9. Section 153 of the Patents Ordinance empowers the Chief Executive in Council to add to or delete from Schedule 1 of the Patents Ordinance the name of any country, territory or area which has acceded to or denounced the Paris Convention or the WTO Agreement. This provision, however, does not cover the situation where a country which is already a Paris Convention country or a WTO member changes its name but has not denounced the Paris Convention or the WTO Agreement.

10. We **propose** to amend section 153 of the Patents Ordinance to enable the Chief Executive in Council to amend Schedule 1 of the Patents Ordinance to cater for such changes. The proposed amendment will bring the wording of section 153 into line with corresponding provisions in the Trade Marks Ordinance and the Registered Designs Ordinance.

#### **(E) Align with an International Agreement**

11. We have an obligation to comply with the provisions of the WTO Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement) to protect intellectual property rights including patent rights. We **propose** to amend section 64(7)(b) of the Patents Ordinance to align its wording more closely with that of Article 31(1)(iii) of the TRIPS Agreement. Article 31(1)(iii) reads as follows - "the use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent".

#### **(F) Other Miscellaneous Amendments**

12. We **propose** to make some other minor technical amendments to the Patents Ordinance and the Registered Designs Ordinance so as to tie up loose ends and to repeal two obsolete rules.

### **THE BILL**

#### **Clauses 2(d), 10, 12, 17, 18 and 22 to 24 – Provide a Legal Basis for the Electronic Publication of Patents and Designs**

13. **Clauses 12, 17, 23 and 24** replace references to the word "Gazette" in the relevant provisions of the Patents Ordinance, the Patents (General) Rules, the Registered Designs Ordinance and the Registered Designs Rules by references to the "official journal". **Clauses 2(d), 10, 18 and 22** provide the Registrar of Patents and the Registrar of Designs (i.e. DIP) with the power to specify a publication, which may be in electronic form, as the "official journal". This provides the legal basis for electronic publication of notifications and advertisements for patents and designs.

### **Clauses 3 and 4 – Simplify Patent Application Procedures**

14. **Clauses 3 and 4** make it clear that where priority or non-prejudicial disclosure is not claimed in an application, the applicant is not required to state this fact. This will simplify patent application procedures.

### **Clause 6 – Align with an International Agreement**

15. **Clause 6** amends section 64(7)(b) of the Patents Ordinance to align its wording more closely with that of Article 31(1)(iii) of the TRIPS Agreement.

### **Clause 7 – Enhance Priority Right Related to a Patent**

16. **Clause 7** adds a new provision for the assignment and transmission of the right of priority under a patent either together with the application or independently.

### **Clause 11 – Enhance the Procedure for Amending the Schedule of Paris Convention Countries or WTO Members**

17. **Clause 11** amends section 153 of the Patents Ordinance to empower the Chief Executive in Council to amend Schedule 1 of the Patents Ordinance to cover the situation where a country which is already a Paris Convention country or a WTO member changes its name, but which has not denounced the Paris Convention or the WTO Agreement.

### **Clause 19 – Clarify Priority Right Related to a Design**

18. **Clause 19** makes it clear that where a person has filed an application to register a design in a Paris Convention or WTO member country, his/her successor in title may also enjoy a right of priority for the same design.

**Clauses 2(a)-(c), 5, 8, 9, 13 to 16, 20, 21 and 25 – Minor Amendments**

19. These clauses make minor technical amendments to the Patents Ordinance and the Registered Designs Ordinance, including in particular repealing the obsolete Registration of Patents Rules and the Registration of Patents (Fees) Rules made under the repealed Registration of Patents Ordinance, and to reflect the change in name of the Chinese Patent Office to State Intellectual Property Office in the Patents Ordinance.

20. The relevant provisions of the Patents Ordinance, the Patents (Designation of Patent Offices) Notice, the Patents (General) Rules, the Registered Designs Ordinance and the Registered Designs Rules to be amended by the Bill are at Annex B.

**LEGISLATIVE TIMETABLE**

21. The legislative timetable will be as follows -

Publication in the Gazette	8 December 2000
First Reading and commencement of Second Reading debate	20 December 2000
Resumption of Second Reading debate, committee stage and Third Reading	to be notified

**BASIC LAW IMPLICATIONS**

22. The Department of Justice advises that the Bill is consistent with the Basic Law.

**HUMAN RIGHTS IMPLICATIONS**

23. The Department of Justice advises that the Bill has no human rights implications.

## **BINDING EFFECT**

24. The amendments will not affect the current binding effect of the Patents Ordinance and the Registered Designs Ordinance.

## **FINANCIAL AND STAFFING IMPLICATION**

25. To allow for the electronic publication of patents and designs applications and information, the Intellectual Property Department (IPD) is required to develop new computer systems for patents registration and designs registration. The development and administration of such systems are covered in a capital item with commitment of \$122.63 million that has been created to meet the expenditure required for the outsourcing of non-core services of IPD. There are no financial or staffing implications for the other legislative proposals in the Bill.

## **ECONOMIC IMPLICATIONS**

26. The proposed amendments will enhance the protection of intellectual property rights. This is in line with our international obligations and is conducive to the proliferation of innovative ideas, which are critical to the long term economic growth in Hong Kong.

## **PUBLIC CONSULTATION**

27. We have received general support for the proposed amendments in a public consultation exercise. The Legislative Council Panel on Trade and Industry also supports the proposals.

## **PUBLICITY**

28. A Legislative Council brief will be issued on 6 December 2000. A spokesman will be available to handle media enquiries.

## **ENQUIRIES**

29. Enquiries on this brief could be referred to Mr Philip Chan, Principal Assistant Secretary for Commerce and Industry, on telephone number 2918 7480.

Commerce and Industry Bureau  
5 December 2000

# **LEGISLATIVE COUNCIL BRIEF**

Patents Ordinance  
(Chapter 514)  
Registered Designs Ordinance  
(Chapter 522)

## **INTELLECTUAL PROPERTY (MISCELLANEOUS AMENDMENTS) (NO.2) BILL 2000**

- Annex A Intellectual Property (Miscellaneous Amendments) (No. 2) Bill 2000
- Annex B Existing provisions of the Patents Ordinance, the Patents (Designation of Patent Offices) Notice, the Patents (General) Rules, the Registered Designs Ordinance and the Registered Designs Rules to be amended by the Bill.

**INTELLECTUAL PROPERTY (MISCELLANEOUS  
AMENDMENTS) (NO. 2) BILL 2000**

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## A BILL

To

Amend the Patents Ordinance and the Registered Designs Ordinance, and to provide for related matters.

Enacted by the Legislative Council.

### 1. Short title and commencement

(1) This Ordinance may be cited as the Intellectual Property (Miscellaneous Amendments) (No. 2) Ordinance 2000.

(2) This Ordinance shall come into operation on a day to be appointed by the Secretary for Commerce and Industry by notice published in the Gazette.

## PART I

### PATENTS ORDINANCE AND ITS SUBSIDIARY LEGISLATION

#### Patents Ordinance

### 2. Interpretation

Section 2(1) of the Patents Ordinance (Cap. 514) is amended -

- (a) in the definition of "Paris Convention", by adding ", as revised or amended from time to time" after "1883";
- (b) in the definition of "Patent Cooperation Treaty", by adding ", as revised or amended from time to time" after "1970";
- (c) in the definition of "World Trade Organisation Agreement", by adding ", as revised or amended from time to time" after "1994";
- (d) by adding -

""official journal"(官方公報) means the publication for the time being specified under section 150A as the official

journal of record;".

### **3. Filing of request to record**

Section 15(2) is amended -

- (a) in paragraph (e), by repealing everything before subparagraph (i) and substituting -

- "(e) where priority is claimed under section 98 in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application as mentioned in that section, a statement that indicates the details of -";

- (b) in paragraph (f) -

- (i) by repealing "a statement indicating whether or not" and substituting "where";

- (ii) by repealing everything after "non-prejudicial disclosure" and substituting ", a statement that indicates the prescribed details relating to the previous disclosure; and".

### **4. Designated patent application based on international application**

Section 16(c) is repealed.

### **5. Date of filing of request to record**

Section 17(1)(c)(ii) is amended -

- (a) by adding "(if any)" after "number";
- (b) by adding "(if any)" after "date".

### **6. Compulsory licenses for standard patents**

Section 64(7)(b) is amended by repealing "the licence on".

**7. Priority right**

Section 110 is amended by adding -

"(3A) A right of priority arising as a result of the filing in or for any Paris Convention country or WTO member country, territory or area of an application for a patent or other protection in respect of an invention, or an application for a short-term patent under this Part, may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the person's "successors in title" shall be construed accordingly."

**8. Short-term patent application based on international application**

Section 125 is amended -

- (a) in subsection (3)(d) and (e), by repealing "Chinese Patent Office" and substituting "State Intellectual Property Office";
- (b) in subsection (6), by repealing everything after "section," and substituting ""State Intellectual Property Office"(國家知識產權局) means the State Intellectual Property Office established under the laws of the People's Republic of china the functions of which include the granting of patents for inventions."

**9. Registrar may specify forms to be used**

Section 150 is amended by adding -

"(3) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1)."

**10. Section added**

The following is added -

**"150A. Power to specify official journal, etc.**

(1) The Registrar may from time to time, by notice published in the Gazette, specify a publication to be the official journal of record for the purposes of this Ordinance, with effect as of the date specified in the notice.

(2) Where a publication is specified under subsection (1), every notice, request, document or other matter required by this Ordinance or the rules to be published in the official journal shall, from the effective date specified in the notice, be published in the publication so specified, and any reference in this Ordinance or the rules to the official journal shall be construed accordingly.

(3) The Registrar may publish or cause to be published a journal in which there may be published such documents and information relating to a patent or an application for a patent as the Registrar thinks fit.

(4) For the avoidance of doubt, the Registrar may specify the Gazette or the journal referred to in subsection (3) to be the official journal of record.

(5) A publication specified under subsection (1) and the journal referred to in subsection (3) need not be in a documentary form.

(6) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1)."

**11. Amendment of Schedule 1**

Section 153 is amended -

(a) in paragraph (b)(ii), by repealing the full stop and substituting "; and";

(b) by adding -

"(c) otherwise amend Schedule 1."

## 12. "official journal" substituted for "Gazette"

Sections 20(1)(c), 27(3)(c), 29(3), 30(2), 34(2), 35(2), 39(1)(a), 40(3), 41(3), 43(3)(b), 44(3) and (6), 46(5), 48(3), 64(4), 66(2)(a), 118(2)(c), 126(1)(a), 148(1) and 150(1) are amended by repealing "Gazette" and substituting "official journal".

### Patents (Designation of Patent Offices) Notice

## 13. Interpretation

Section 2 of the Patents (Designation of Patent Offices) Notice (Cap. 514 sub. leg.) is amended -

- (a) by repealing the definition of "Chinese Patent Office";
- (b) by adding -

""State Intellectual Property Office"(國家知識產權局) means the State Intellectual Property Office established under the laws of the People's Republic of China the functions of which include the granting of patents for inventions;"

## 14. Designation of patent offices

Section 3 is amended by repealing "Chinese Patent Office" and substituting "State Intellectual Property Office".

### Patents (General) Rules

## 15. Interpretation

Section 2(1) of the Patents (General) Rules (Cap. 514 sub. leg.) is amended -

- (a) by repealing the definition of "Chinese Patent Office";
- (b) by adding -

""State Intellectual Property Office"(國家知識產權局) means

the State Intellectual Property Office established under the laws of the People's Republic of China the functions of which include the granting of patents for inventions;"

**16. "State Intellectual Property Office" substituted for "Chinese Patent Office"**

Sections 8(2)(d)(v), 15(1)(c) and (2)(a), 36(a), 54(a) and 78(1) are amended by repealing "Chinese Patent Office" wherever it appears and substituting "State Intellectual Property Office".

**17. "official journal" substituted for "Gazette"**

Sections 31(5), 34(4), 40(1), 48(3), 88(1)(c)(iii) and 93(2) and paragraph 2(4)(c) of Schedule 1 are amended by repealing "Gazette" and substituting "official journal".

PART II

REGISTERED DESIGNS ORDINANCE AND ITS SUBSIDIARY LEGISLATION

**Registered Designs Ordinance**

**18. Interpretation**

Section 2(1) of the Registered Designs Ordinance (Cap. 522) is amended by adding

-

"official journal"(官方公報) means the publication for the time being specified under section 84A as the official journal of record;"

**19. Priority right**

Section 15(1) is amended -

- (a) by repealing "or his successor in title";
- (b) by adding ", or his successor in title," after "member".

**20. Hours of business and business days**

Section 71 is amended -

- (a) in subsection (1), by adding "and the days that are business days for that purpose" after "Ordinance";
- (b) in subsection (2), by repealing "following" where it twice appears.

**21. Registrar may specify forms to be used**

Section 84 is amended by adding -

"(3) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1).".

**22. Section added**

The following is added before Part VIII -

**"84A. Power to specify official journal, etc.**

(1) The Registrar may from time to time, by notice published in the Gazette, specify a publication to be the official journal of record for the purposes of this Ordinance, with effect as of the date specified in the notice.

(2) Where a publication is specified under subsection (1), every notice, request, document or other matter required by this Ordinance or the rules to be published in the official journal shall, from the effective date specified in the notice, be published in the publication so specified, and any reference in this Ordinance or the rules to the official journal shall be construed accordingly.

(3) The Registrar may publish or cause to be published a journal in which there may be published such documents and information relating to a registered design or an application for registration as the Registrar thinks fit.

(4) For the avoidance of doubt, the Registrar may specify the Gazette or the journal referred to in subsection (3) to be the official journal of record.

(5) A publication specified under subsection (1) and the journal referred to in subsection (3) need not be in a documentary form.

(6) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1).".

**23. "official journal" substituted for "Gazette"**

Sections 25(d), 71(1) and 84(1) are amended by repealing "Gazette" and substituting "official journal".

**Registered Designs Rules**

**24. "official journal" substituted for "Gazette"**

(1) Sections 2(2)(a), 27(1), 30, 31(2), 32(5), 37(2)(b), 38(1), 46(2), 51(2) and (3), 56, 60(3) and 62(3) and (4) of the Registered Designs Rules (Cap. 522 sub. leg.) are amended by repealing "Gazette" and substituting "official journal".

(2) Fee No. 9 of the Schedule is amended, in column 2, by repealing "advertisement in the Gazette" and substituting "advertisement in the official journal".

**PART III**

**REPEAL OF OBSOLETE RULES**

**25. Repeal**

The Registration of Patents Rules (Cap. 42 sub. leg.) and the Registration of Patents (Fees) Rules (Cap. 42 sub. leg.) are repealed.

**Explanatory Memorandum**

This Bill makes miscellaneous amendments to the Patents Ordinance (Cap. 514) and the Registered Designs Ordinance (Cap. 522), and repeals 2 obsolete Rules.

2. The amendments -

(a) replace references to the Gazette by references to the official journal,

which may be published electronically (clauses 2(d), 10, 12, 17, 18, 22, 23 and 24);

- (b) reflect the change in name of the Chinese Patent Office to the State Intellectual Property Office (clauses 8, 13, 14, 15 and 16);
- (c) modify certain provisions for the purpose of ensuring consistency (clauses 11 and 20);
- (d) align the wordings of certain provisions more closely with international agreements (clauses 2(a) to (c) and 6);
- (e) clarify the meaning of certain provisions (clauses 3, 4, 5, 7 and 19);
- (f) repeal 2 obsolete Rules made under the repealed Registration of Patents Ordinance (Cap. 42) (clause 25).

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	25 of 1998 s. 2
Section:	2	Heading:	<b>Interpretation</b>	Version Date:	01/07/1997

Remarks:

Amendments retroactively made-see 25 of 1998 s. 2

- (1) In this Ordinance, unless the context otherwise requires-
- "application for a patent"(專利的申請) means an application for a standard patent or an application for a short-term patent;
- "court"(法院) means the Court of First Instance; (Amended 25 of 1998 s. 2)
- "date of filing"(提交日期)-
- (a) in relation to a request to record or a request for registration and grant, means the date which is the date of filing that request by virtue of section 17 or 24 respectively;
  - (b) in relation to an application for a standard patent has the meaning specified in relation to that term in section 3(ii);
  - (c) in relation to a designated patent application, means the date specified as such in the designated patent application;
- "employee"(僱員) means a person who works or (where the employment has ceased) worked under a contract of employment (whether with the Government or with any other person);
- "employer"(僱主), in relation to an employee, means the person by whom the employee is or was employed;
- "exclusive licence"(專用特許) means a licence from the proprietor or of applicant for a patent conferring on the licensee, or on him and persons authorized by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application for a patent relates, and "exclusive licensee"(專用特許持有人) and "non-exclusive licence"(非專用特許) shall be construed accordingly;
- "international application"(國際申請) means an international application for a patent made under the Patent Cooperation Treaty;
- "International Bureau"(國際局) means the International Bureau of Intellectual Property provided for under the Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967;
- "law of the designated patent office"(指定專利當局的法律) means-
- (a) in relation to a designated patent office established under the law of any country, territory or area other than Hong Kong, the law of that country, territory or area;
  - (b) in relation to a designated patent office established under an international agreement, the provisions of the international agreement;
- "mortgage"(按揭) when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;
- "non-prejudicial disclosure"(不具損害性的披露) means, in relation to an invention, a disclosure of the invention which is not to be taken into consideration for the purposes of determining whether or not the invention forms part of the state of the art;
- "opposition or revocation proceedings"(反對或撤銷專利的法律程序) means, in relation to a designated patent, proceedings under the law of the designated patent office providing for the revocation or amendment of the designated patent within a specified period after the grant;
- "Paris Convention"(《巴黎公約》) means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883;
- "Paris Convention country"(巴黎公約國) means-
- (a) any country for the time being specified in Schedule 1 as being a country which has

acceded to the Paris Convention;

(b) any territory or area subject to the authority or under the suzerainty of any country specified in Schedule 1 pursuant to paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;

"patent application"(專利申請) has the same meaning as an application for a patent;

"Patent Cooperation Treaty"(《專利合作條約》) means the treaty of that name done at Washington on 19 June 1970;

"patented invention"(專利發明) means an invention for which a standard patent or, as the case may be, a short-term patent is granted and "patented process"(專利方法) shall be construed accordingly;

"patented product"(專利產品) means-

(a) a product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;

(b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a product obtained directly by means of the process or to which the process has been applied;

"prescribed"(訂明) means prescribed or provided for by rules made under section 149;

"protected layout-design (topography)"(受保護的布圖設計(拓撲圖)) has the meaning assigned to that term by section 2(1) of the Layout-design (Topography) of Integrated Circuits Ordinance (Cap 445);

"register"(註冊紀錄冊、註冊)-

(a) as a noun, means the register of patents kept under section 51; and

(b) as a verb, means, in relation to any thing, to register or register particulars, or enter notice of that thing in the register and, in relation to a person, means to enter his name in the register,

and cognate expressions shall be construed accordingly;

"Registrar"(處長) means the Registrar of Patents;

"Registrar of Patents"(專利註冊處處長) means the person holding that office by virtue of the Director of Intellectual Property (Establishment) Ordinance (Cap 412);

"registry"(註冊處) means the Patents Registry administered by the Registrar;

"request for registration and grant"(註冊與批予請求) means a request under section 23 for the registration of a designated patent and the grant of a standard patent for the invention shown in the published specification of the designated patent;

"request to record"(記錄請求) means a request under section 15 to record a designated patent application;

"right"(權利), in relation to any patent or patent application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

"rules"(規則) means rules made by the Registrar under section 149;

"short-term patent"(短期專利) means a patent for an invention granted under Part XV;

"short-term patent application"(短期專利申請) means an application under Part XV for a short-term patent;

"specification"(說明書), in relation to an application for a patent under this Ordinance, a designated patent application or an international application, means the description, claims and drawings contained in the application;

"standard patent"(標準專利) means a patent for an invention granted under Part II;

"standard patent application"(標準專利申請) means an application under Part II for a standard patent;

"verified copy"(核實副本) means, in relation to a document, a copy verified in the prescribed manner;

"World Trade Organisation Agreement"(《世界貿易組織協議》) means the agreement of that name

done at Marrakesh in 1994;

"WTO member country, territory or area"(世界貿易組織成員國、地區或地方) means any country, territory or area for the time being specified in Schedule 1 as being a country, territory or area which has acceded to the World Trade Organisation Agreement.

(2) The expressions listed in the left-hand column below are defined in, or fall to be construed in accordance with, the provisions of this Ordinance listed in the right-hand column in relation to those expressions.

Expression	Relevant Provision
Application for a standard patent(標準專利的申請)	section 3
Corresponding designated patent(相應指定專利)	section 4
Corresponding designated patent application(相應指定專利申請)	section 4
Deemed date of filing(當作提交日期)	section 38
Designated patent(指定專利)	section 4
Designated patent application(指定專利申請)	section 4
Divisional designated patent application(指定專利的分開申請)	section 22(1)
Government use(政府徵用)	section 69(2)
Paris Convention country(巴黎公約國)	section 98(6)
Patent(專利)	section 6(1)
Published(發表)	section 5
Work(實施)	section 6(4)

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>15</b>	Heading:	<b>Filing of request to record</b>	Version Date:	30/06/1997

#### Request to record a designated patent application

(1) A person entitled under section 12(1) to apply for the grant of a standard patent for an invention may, at any time within 6 months after the date of publication of an application in a designated patent office for a patent for the invention, request the Registrar to enter a record of that designated patent application in the register (in this Ordinance referred to as a "request to record").

(2) Every such request shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain-

- (a) a photocopy of the designated patent application as published, that is to say, including any description, claims, drawings, search report or abstract published together with the designated patent application;
- (b) where the designated patent application does not contain the name of any person as being the inventor, a statement identifying the person or persons whom the applicant believes to be the inventor or inventors;
- (c) the name and address of the person making the request;
- (d) where the person filing the request is a person other than the person named as applicant in the designated patent application, a statement explaining his entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that

statement;

- (e) a statement indicating whether or not priority is claimed under section 98 in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application as mentioned in that section and, where the statement indicates that priority is so claimed, details of-
  - (i) the date of priority claimed;
  - (ii) the country in which the earlier application was filed;
- (f) a statement indicating whether or not at the time of filing the designated patent application a claim was made in accordance with the law of the designated patent office in respect of any previous disclosure of the invention that was, for the purposes of the law of the designated patent office, a non-prejudicial disclosure and, if the statement indicates that such a claim was made, prescribed details relating to such previous disclosure; and
- (g) an address in Hong Kong for service of documents.

(3) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.

(4) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the request to record, and if either fee is not paid within that period or within such further period as may be allowed under subsection (5) the application for a standard patent shall be deemed to be withdrawn.

(5) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (4) may still be validly paid.

(6) Subsection (1) shall not apply in respect of a designated patent application published before the date on which the designated patent office was designated under section 8.

(7) Nothing in this section shall preclude a request to record being initiated by documents complying with section 17.

[cf. EPC Art. 78; 1977 c. 37 s. 14 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	16	Heading:	<b>Designated patent application based on international application</b>	Version Date:	30/06/1997

Where a designated patent application is the national phase of an international application under the Patent Cooperation Treaty, then-

- (a) for the purposes of section 15(1), and notwithstanding section 5(2)(d)(ii), the date of publication of the designated patent application shall be-
  - (i) the date of such publication in the designated patent office as serves to indicate that the international application has validly entered its national phase in the designated patent office; or
  - (ii) such other date as may be prescribed in rules, being a date not earlier than the date on which the international application has validly entered its national phase in the designated patent office;
- (b) reference in section 15(2)(a) to a photocopy of the designated patent application shall be read as reference to-
  - (i) a photocopy of the international application as published by the International Bureau;
  - (ii) a photocopy of any translation of the international application published by the

- designated patent office; and
- (iii) a photocopy of any publication of information in the designated patent office concerning the international application;
- (c) the statement required for the purposes of section 15(2)(e) shall be a statement indicating whether or not priority is claimed under section 98, and if claimed whether so claimed on the basis of a right of priority claimed in the designated patent office, or claimed in the international application and accepted in the designated patent office, and mentioned in the corresponding designated patent application;
- (d) section 17(1)(c) shall have effect in such manner as may be specified in rules made for the purposes of this section.

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	17	Heading:	<b>Date of filing of request to record</b>	Version Date:	30/06/1997

- (1) Subject to subsection (2) and section 18(3), the date of filing a request to record shall be the earliest date on which documents filed by the applicant contain-
- (a) an indication that a request is made to record a designated patent application;
- (b) information identifying the applicant; and
- (c) a reference to the designated patent application, including-
- (i) the application number assigned to it by the designated patent office; and
- (ii) the publication number assigned to it by the designated patent office, and the date of its publication by the designated patent office.

(2) If the earliest filing with the Registrar of any part of a request to record occurs more than 6 months after the publication of the corresponding designated patent application the request shall not be dealt with as an application for a standard patent.

[cf. EPC Art.80]

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	64	Heading:	<b>Compulsory licences for standard patents</b>	Version Date:	30/06/1997

## PART VIII

### COMPULSORY LICENCES FOR STANDARD PATENTS

- (1) At any time after the expiration of 3 years from the date of grant of a standard patent any person may apply to the court on one or more of the grounds specified in subsection (2)-
- (a) for a licence under the patent;
- (b) where the applicant is the Government, for the grant of a licence under the patent to any person specified in the application.
- (2) The grounds referred to in subsection (1) are-

- (a) where the patented invention is capable of being commercially worked in Hong Kong, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;
  - (b) where the patented invention is a product, that a demand for the product in Hong Kong is not being met on reasonable terms;
  - (c) where the patented invention is capable of being commercially worked in Hong Kong by manufacture, that it is being prevented or hindered from being so worked-
    - (i) in the case of a product, by the importation of the product; or
    - (ii) in the case of a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
  - (d) that by reason of the refusal by the proprietor of the patent to grant a licence or licences on reasonable terms-
    - (i) the working or efficient working in Hong Kong of any other patented invention which involves an important technical advance of considerable economic significance in relation to the patent is prevented or hindered; or
    - (ii) the establishment or development of commercial or industrial activities in Hong Kong is unfairly prejudiced; or
  - (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent or the establishment or development of commercial or industrial activities in Hong Kong, is unfairly prejudiced.
- (3) The court may, if it is satisfied that any of those grounds are established, and subject to subsections (4) and (5), order the grant of a licence on such terms as it thinks fit-
- (a) to the applicant, where the application is made under subsection (1)(a); or
  - (b) to the person specified in the application, where the application is made under subsection (1)(b).
- (4) Where the application is made on the ground that the patented invention is not being commercially worked in Hong Kong or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the court that the time which has elapsed since the grant of the patent was advertised in the Gazette has for any reason been insufficient to enable the invention to be so worked, the court may adjourn the hearing for such period as will in the opinion of the court give sufficient time for the invention to be so worked.
- (5) No order shall be made under this section unless the court is satisfied that the applicant has made reasonable efforts to obtain authorization from the proprietor on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.
- (6) No order shall be made under this section in respect of a patent ("patent A") on the ground mentioned in subsection (2)(d)(i) unless the court is satisfied that the proprietor of the patent for the other invention ("patent B") is able and willing to grant to the proprietor of patent A and his licensees a licence under patent B on reasonable terms.
- (7) An order granting a licence under this section shall provide-
- (a) that the licence shall be non-exclusive; and
  - (b) that such licence shall be non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence, and in the case of a licence granted under subsection (6) the licence in respect of patent A shall only be assignable with the assignment of the licence on patent B,
- and shall specify the scope and duration of such licence.
- (8) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped from relying on any of the matters specified in subsection (2) because of any admission made by him, whether in such licence or otherwise or by reason of his having accepted such licence.

[cf. 1977 c. 37 s. 48 U.K.]

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	L.N. 367 of 1997
Section:	<b>125</b>	Heading:	<b>Short-term patent application based on international application</b>	Version Date:	01/07/1997

(1) Where an international application seeking a patent for a utility model and designating the People's Republic of China has entered its national phase in the People's Republic of China, the applicant in the international application may apply for a short-term patent for the invention (if any) disclosed in that application.

(2) An application for a short-term patent made pursuant to this section may be filed at any time before a date 6 months after the entry into the national phase of the international application in the People's Republic of China, or such other date as may be prescribed by rules.

(3) An application for a short-term patent made pursuant to this section shall contain-

- (a) a photocopy of the international application as published by the International Bureau under Article 21 of the Patent Cooperation Treaty;
- (b) a photocopy of the international search report in relation to the international application as published under Article 21(3) of the Patent Cooperation Treaty (whether contained in the international application as published or separately published);
- (c) the date of entry of the international application into the national phase in the People's Republic of China;
- (d) a photocopy of the translation of the international application (if any) published by the Chinese Patent Office; and
- (e) a photocopy of any information that may be published by the Chinese Patent Office concerning the international application.

(4) Section 113 applies in relation to an application for a short-term patent made pursuant to this section as if for subsection (1)(b) to (d) of that section there was substituted a reference to the documents specified in subsection (3)(a) to (e) of this section.

(5) Where an application made pursuant to this section results in the grant of a short-term patent, the application shall be deemed to have as its date of filing the international filing date accorded to the international application for the purposes of Article 11 of the Patent Cooperation Treaty and, in this Ordinance, reference to the date of filing of an application in relation to a short-term patent which has been granted pursuant to an application made as provided for in this section shall be construed accordingly.

(6) In this section, "Chinese Patent Office"(中國專利局) means the office established under the laws of the People's Republic of China for the granting of patents for inventions.

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	22 of 1999
Section:	<b>153</b>	Heading:	<b>Amendment of Schedule 1</b>	Version Date:	01/07/1997

Remarks:

The Chief Executive in Council may by order published in the Gazette- (Amended 22 of 1999 s. 3)

- (a) add to Schedule 1 the name of-
    - (i) any country which has acceded to the Paris Convention;
    - (ii) any country, territory or area which has acceded to the World Trade Organisation Agreement;
  - (b) delete from the Schedule 1 the name of-
    - (i) any country which has denounced the Paris Convention;
    - (ii) any country, territory or area which has denounced the World Trade Organisation Agreement.
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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>20</b>	Heading:	<b>Publication of request to record</b>	Version Date:	30/06/1997

(1) If on an examination under section 19(1) a request to record is found to have satisfied the requirements of section 15(2) and (3), or if on a subsequent examination by the Registrar the deficiencies noted under section 19(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to this section and section 37-

- (a) record the designated patent application in the register and enter particulars of the request to record in the register;
  - (b) publish the request to record in the prescribed manner;
  - (c) advertise the fact of such publication and entry by notice in the Gazette;
  - (d) inform the applicant of the publication of the request to record.
- (2) A request to record shall not be published if-
- (a) before the completion of preparations for publication, it has been finally refused or withdrawn or has been deemed to have been withdrawn; or
  - (b) the filing fee or advertisement fee has not been paid.
- (3) For the purposes of subsection (1)(b) the request to record shall include-
- (a) the designated patent application, including the description, the claims, any drawings and any search report or abstract published by the designated patent office and filed in the request to record;
  - (b) the names of the proprietor and (if different) the inventor.

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>27</b>	Heading:	<b>Registration of designated patent and grant of patent</b>	Version Date:	30/06/1997

(1) If on examination under section 26(1) a request for registration and grant is found to have satisfied the requirements of section 23(3) and (4) or if on a subsequent examination the deficiencies noted under section 26(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to section 37-

- (a) register the designated patent by making an appropriate entry in the register; and
  - (b) grant a standard patent for the invention shown in the published specification of the designated patent as filed under section 23(3)(a) and issue a certificate to that effect.
- (2) A patent shall not be granted under this section unless the filing fee and advertisement fee specified in section 23 and any other fees payable under the preceding provisions of this Part have been paid.
- (3) As soon as practicable after a standard patent has been granted under this section the Registrar shall-
- (a) publish in the prescribed manner the specification of the patent, the names of the proprietor and, if different, the inventor;
  - (b) send the certificate issued under subsection (1)(b) to the proprietor; and
  - (c) advertise the fact of such grant by notice in the Gazette.
- (4) In publishing under subsection (3)(a) any matters specified in that subsection, the Registrar may publish in addition such other matters constituting or relating to the patent which in his opinion it is

desirable to publish.

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>29</b>	Heading:	<b>Restoration of rights</b>	Version Date:	30/06/1997

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- (1) Subject to this section, where-
- (a) an applicant for a standard patent has failed to comply with a time limit under this Part (including any time limit set by the Registrar); and
  - (b) the Registrar is satisfied that the failure to comply with the time limit occurred in spite of the applicant having taken all reasonable care required by the circumstances,
- then upon application by the applicant to the Registrar under this section for restoration of his rights lost-
- (i) any refusal or deemed withdrawal of the application that occurred as a direct consequence of the failure to comply with the time limit shall be deemed to be of no effect and the application shall be treated for the purposes of proceedings under this Part as if there had been no such failure;
  - (ii) any right or means of redress lost by the applicant as a direct consequence of the failure to comply with the time limit shall be restored to the applicant.
- (2) An application under this section-
- (a) shall be in writing and shall be made not later than-
    - (i) 1 year after the expiry of the time limit referred to in subsection (1)(a); or
    - (ii) 2 months after the removal of the cause of non-compliance with the time limit, whichever is the earlier;
  - (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
  - (c) shall not be deemed to be made unless the omission which constituted the failure to comply with a time limit has been made good.
- (3) Where prior to the refusal or deemed withdrawal of the application mentioned in subsection (1)(i) the request to record had been published under section 20, the Registrar shall advertise in the Gazette notice of any application under subsection (1).
- (4) The Registrar may by regulation amend the periods specified in subsection (2)(a) within which a notice under this section shall be filed.
- (5) This section does not apply to any failure to comply with a time limit under section 15 (except as regards any time limit specified for the purposes of section 15(3)), 17(2), 18, 19, 22, 23(5), 24(2) or 25(3).  
[cf. EPC Art. 122]
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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>30</b>	Heading:	<b>Effect of restoration of rights under section 29</b>	Version Date:	30/06/1997

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- (1) The effect of a restoration under section 29 is as follows.
- (2) A person who, during the period between the loss of rights referred to in section 29(1) and the advertisement in the Gazette of notice of the application for restoration under section 29(3)-

- (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a standard patent if those rights had not been lost; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (3).

(3) The rights referred to in subsection (2) are-

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);
- (b) if such act was done or preparations had been made to do it in the course of a business-
  - (i) in the case of an individual-
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
  - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.

(4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).

(5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.

[cf. 1992 No. 1 s. 55(2) to (4) Eire]

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>34</b>	Heading:	<b>Restoring application for standard patent</b>	Version Date:	30/06/1997

(1) Where an application for a standard patent is deemed withdrawn under section 33 by reason only of the failure to pay any maintenance fee under that section within the period specified then the applicant may, within 12 months after the date on which the application was deemed withdrawn and on payment of the prescribed fee, apply to the Registrar in the prescribed manner for the restoration of the application for a standard patent.

(2) The Registrar shall advertise in the Gazette notice of any application under subsection (1).

(3) If on an application under subsection (1)-

- (a) the Registrar is satisfied that the failure to pay the maintenance fee within the specified period, or that fee and any additional fee under section 33(4) within 6 months after the end of the specified period, occurred in spite of the applicant having taken all reasonable care required by the circumstances; and
- (b) the requirements of subsection (4) are met,

the Registrar shall order that the request to record be restored on payment of any such unpaid maintenance fee and additional fee.

(4) An order for restoration shall not be made under subsection (3) unless it appears to the Registrar that at the date of the application for restoration-

- (a) the designated patent application is still valid and not withdrawn; and
- (b) a patent has not been granted in pursuance of that application or, if granted, the time for filing a request for registration and grant under section 23 has not expired.

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>35</b>	Heading:	<b>Effect of restoration order under section 34</b>	Version Date:	30/06/1997

- (1) The effect of a restoration under section 34(4) is as follows.
- (2) A person who, during the period between any deemed withdrawal such as is mentioned in section 34(1) and the advertisement in the Gazette of notice of the application for restoration under section 34(2)-
- (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a patent if those rights had not been lost; or
  - (b) makes in good faith effective and serious preparations to do such an act,
- has the rights specified in subsection (3).
- (3) The rights referred to in subsection (2) are-
- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);
  - (b) if such act was done or preparations had been made to do it in the course of a business-
    - (i) in the case of an individual-
      - (A) the right to assign the right to do it or to transmit such right on death; or
      - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
    - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,
- and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.
- (4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).
- (5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.
- (6) This section applies in relation to the Government use of an invention in respect of which an application has been made as it applies in relation to infringement of the rights conferred by publication of an application for a standard patent for the invention.

[cf. 1992 No. 1 s. 55(2) to (4) Eire]

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	22 of 1999
Section:	<b>39</b>	Heading:	<b>Term of standard patent</b>	Version Date:	01/07/1997

## Remarks:

Amendments retroactively made - see 22 of 1999 s. 3

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- (1) A standard patent granted under this Ordinance-
- (a) shall take effect from the date on which the fact of its grant is advertised in the Gazette; and
  - (b) subject to subsection (2), shall remain in force until the end of the period of 20 years beginning with the deemed date of filing of the application for the patent.
- (2) If it is desired to keep a standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subsection (3), the prescribed renewal fee shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid.
- (3) The date specified for the purpose of subsection (2) is the anniversary of the deemed date of filing of the standard patent first occurring after the date of grant of the patent.
- (4) If within 6 months after the end of the period specified in subsection (2) for payment of the renewal fee the renewal fee and any prescribed additional fee are paid, the standard patent shall be treated as if it had never expired, and accordingly-
- (a) anything done under or in relation to it during that further period shall be valid;
  - (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
  - (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.
- (5) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for payment of the prescribed renewal fee is determined.
- (6) The Chief Executive in Council may by regulation amend- (Amended 22 of 1999 s. 3)
- (a) the period specified in subsection (1)(b) as being the period for which a standard patent shall remain in force;
  - (b) the period specified in subsection (2) by reference to which a standard patent, if not renewed, shall cease to have effect.

[cf. 1977 c. 37 s. 25 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>40</b>	Heading:	<b>Restoration of lapsed standard patents</b>	Version Date:	30/06/1997

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- (1) Where a standard patent has ceased to have effect by reason of the failure to pay any renewal fee as provided in section 39, application may be made to the Registrar, at any time within 18 months after the date on which the patent ceased to have effect, for the restoration of the patent.
- (2) An application under this section may be made by the person who was the proprietor of the standard patent at the time it ceased to have effect or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was at that time held by 2 or more persons jointly the application may, with the leave of the Registrar, be made by one or more of them without joining the others.
- (3) The Registrar shall advertise in the Gazette notice of any application under this section.
- (4) If the Registrar is satisfied that the failure to pay any renewal fee as provided in section 39, or to pay that fee and any additional fee under that section within 6 months after the end of that period, occurred in spite of the applicant having taken all reasonable care required by the circumstances the Registrar shall by order restore the patent on payment of any such unpaid renewal fee and any prescribed

additional fee.

(5) An order under this section may be made subject to such terms and conditions as the Registrar thinks fit.

[cf. 1949 c. 87 s. 28 U.K.; 1977 c. 37 s. 28 U.K.; EPC Art. 122]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	41	Heading:	<b>Effect of order for restoration of standard patent</b>	Version Date:	30/06/1997

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(1) The effect of an order for the restoration of a standard patent is as follows.

(2) Anything done during the period between expiry and restoration which would have constituted an infringement if the patent had not expired shall be treated as an infringement-

- (a) if done at a time when it was possible for the patent to be renewed under section 39(4); or
- (b) if it was a continuation or repetition of an earlier infringing act.

(3) A person who in Hong Kong, after it was no longer possible for the patent to be so renewed and before advertisement in the Gazette of notice of an application for restoration under section 40-

- (a) began in good faith to do an act which would constitute an infringement of the patent if it were in force; or
- (b) made in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (4).

(4) The rights referred to in subsection (3) are-

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (3);
- (b) if such act was done or preparations had been made to do it in the course of a business-
  - (i) in the case of an individual-
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
  - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(5) The rights specified in subsection (4) shall not include the right to grant a licence to any person to do an act referred to in subsection (3).

(6) Where a patented product is disposed of to another in exercise of a right conferred by subsection (4), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

[cf. 1992 No. 1 s. 55(2) to (5) Eire]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
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(1) If the specification of the corresponding designated patent in respect of a standard patent granted under Part II has (whether before or after the grant of the standard patent) been amended in the designated patent office following prescribed opposition or revocation proceedings, the proprietor of the standard patent shall file with the Registrar in the prescribed manner and within the prescribed period a verified copy of the amended specification or the amending order or other prescribed documentation.

(2) The Registrar shall record the amendment to the specification of the designated patent by making an appropriate entry in the register and upon that recording the standard patent shall be treated as having been amended in a like manner.

(3) As soon as practicable after a standard patent has been amended under this section the Registrar shall-

- (a) publish the amendment;
- (b) advertise the fact of the amendment by notice in the Gazette.

(4) Any amendment of the specification of a standard patent under this section shall have effect from the date of grant of the patent.

(5) Any amendment of the specification of a standard patent under this section shall have effect subject to section 103.

[cf. EPC Art. 102]

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(1) This section applies to any standard patent of which the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.

(2) The proprietor of a patent to which this section applies shall after publication of the revocation by the designated patent office and in the prescribed manner file with the Registrar a verified copy of the order of revocation or other prescribed documentation.

(3) The Registrar shall record any filing under subsection (2) and shall advertise the fact of such filing by notice in the Gazette.

(4) A person other than the proprietor of a patent to which this section applies may apply to the Registrar in the prescribed manner for an order under this subsection, and where on such an application the Registrar is satisfied that the patent is one to which this section applies he shall, subject to subsection (5), order that the patent be revoked.

(5) The Registrar may, if he thinks fit, refer any application under subsection (4) to the court and the court shall have jurisdiction to make an order for the revocation of the patent.

(6) Upon the Registrar advertising the fact of a filing by the proprietor of a patent under subsection (2) in the Gazette, or upon the making of an order by the Registrar under subsection (4) or by the court under subsection (5) for the revocation of a patent, the patent shall be treated as never having had effect.

[cf. EPC Art. 102]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>46</b>	Heading:	<b>General power to amend specification after grant</b>	Version Date:	30/06/1997

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(1) Subject to section 103, the proprietor of a patent granted under this Ordinance may apply to the court to amend the specification of the patent and the court may by order allow any such amendment subject to such conditions as it thinks fit.

(2) No such amendment shall be allowed if there are pending before the court proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect as from the grant of the patent.

(4) Any person wishing to oppose an application under this section may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

(5) Upon receipt of the court order and supporting documents filed in the prescribed manner the Registrar shall record the amendments to the specification of the patent and shall publish this and advertise the fact by notice in the Gazette.

(6) The Registrar may, without any application being made to the court or to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark.

(7) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[cf. 1977 c. 37 s. 27 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>48</b>	Heading:	<b>Surrender of patents</b>	Version Date:	30/06/1997

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(1) The proprietor of a patent may at any time by written notice given to the Registrar offer to surrender his patent.

(2) Any person may give notice to the Registrar of his opposition to the surrender of a patent under this section, and if he does so the Registrar shall notify the proprietor of the patent and, subject to subsection (4), shall determine the question.

(3) If the Registrar is satisfied that the patent may properly be surrendered he may accept the offer and, as from the date on which notice of his acceptance is advertised in the Gazette, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any Government use of the patented invention before that date.

(4) The Registrar may if he thinks fit refer the matter to the court for determination.

[cf. 1977 c. 37 s. 29 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	64	Heading:	<b>Compulsory licences for standard patents</b>	Version Date:	30/06/1997

## PART VIII

### COMPULSORY LICENCES FOR STANDARD PATENTS

- (1) At any time after the expiration of 3 years from the date of grant of a standard patent any person may apply to the court on one or more of the grounds specified in subsection (2)-
- (a) for a licence under the patent;
  - (b) where the applicant is the Government, for the grant of a licence under the patent to any person specified in the application.
- (2) The grounds referred to in subsection (1) are-
- (a) where the patented invention is capable of being commercially worked in Hong Kong, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;
  - (b) where the patented invention is a product, that a demand for the product in Hong Kong is not being met on reasonable terms;
  - (c) where the patented invention is capable of being commercially worked in Hong Kong by manufacture, that it is being prevented or hindered from being so worked-
    - (i) in the case of a product, by the importation of the product; or
    - (ii) in the case of a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
  - (d) that by reason of the refusal by the proprietor of the patent to grant a licence or licences on reasonable terms-
    - (i) the working or efficient working in Hong Kong of any other patented invention which involves an important technical advance of considerable economic significance in relation to the patent is prevented or hindered; or
    - (ii) the establishment or development of commercial or industrial activities in Hong Kong is unfairly prejudiced; or
  - (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent or the establishment or development of commercial or industrial activities in Hong Kong, is unfairly prejudiced.
- (3) The court may, if it is satisfied that any of those grounds are established, and subject to subsections (4) and (5), order the grant of a licence on such terms as it thinks fit-
- (a) to the applicant, where the application is made under subsection (1)(a); or
  - (b) to the person specified in the application, where the application is made under subsection (1)(b).
- (4) Where the application is made on the ground that the patented invention is not being commercially worked in Hong Kong or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the court that the time which has elapsed since the grant of the patent was advertised in the Gazette has for any reason been insufficient to enable the invention to be so worked, the court may adjourn the hearing for such period as will in the opinion of the court give sufficient time for the invention to be so worked.
- (5) No order shall be made under this section unless the court is satisfied that the applicant has made reasonable efforts to obtain authorization from the proprietor on reasonable commercial terms and

conditions and that such efforts have not been successful within a reasonable period of time.

(6) No order shall be made under this section in respect of a patent ("patent A") on the ground mentioned in subsection (2)(d)(i) unless the court is satisfied that the proprietor of the patent for the other invention ("patent B") is able and willing to grant to the proprietor of patent A and his licensees a licence under patent B on reasonable terms.

(7) An order granting a licence under this section shall provide-

- (a) that the licence shall be non-exclusive; and
- (b) that such licence shall be non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence, and in the case of a licence granted under subsection (6) the licence in respect of patent A shall only be assignable with the assignment of the licence on patent B,

and shall specify the scope and duration of such licence.

(8) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped from relying on any of the matters specified in subsection (2) because of any admission made by him, whether in such licence or otherwise or by reason of his having accepted such licence.

[cf. 1977 c. 37 s. 48 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>66</b>	Heading:	<b>Exercise of powers on applications under section 64</b>	Version Date:	30/06/1997

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(1) The powers of the court on an application under section 64 in respect of a patent shall be exercised with a view to securing the following purposes-

- (a) that inventions which can be worked on a commercial scale in Hong Kong and which should in the public interest be so worked shall be worked there without undue delay and to the fullest extent that is reasonably practicable;
- (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;
- (c) that the interests of any person for the time being working or developing an invention in Hong Kong under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to subsection (1), the court shall, in determining whether to make an order in pursuance of such an application, take account of the following matters-

- (a) the nature of the invention, the time which has elapsed since the grant of the patent was advertised in the Gazette and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;
- (b) the ability of any person to whom a licence would be granted by the court to work the invention to the public advantage;
- (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but the court shall not be required to take account of any such matter occurring subsequent to the making of the application.

(3) Any person aggrieved by an order made under section 64 or 65 may apply to the court for an order for the variation or cancellation of the licence if the court in all the circumstances should think fit.

[cf. 1977 c. 37 s. 50 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>118</b>	Heading:	<b>Grant of short-term patent and publication</b>	Version Date:	30/06/1997

Procedure up to and including grant

(1) If on examination by the Registrar under section 115(1) an application for a short-term patent is found to have satisfied the requirements of that provision, or if on a subsequent examination the deficiencies noted by the Registrar under section 115(2) are found to have been corrected in accordance with the rules, then as soon as practicable after such examination, but subject to sections 119 and 124, the Registrar shall grant a short-term patent for the invention.

(2) As soon as practicable after a short-term patent has been granted under this section the Registrar shall-

- (a) publish in the prescribed manner the specification of the short-term patent, the names of the proprietor and, if different, the inventor;
- (b) issue a certificate of grant; and
- (c) advertise the fact of such grant by notice in the Gazette.

(3) The Registrar may in any publication under subsection (2)(a) publish in addition to the matters specified in that subsection any other matters constituting or relating to the patent which in the Registrar's opinion it is desirable to publish.

Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	22 of 1999
Section:	<b>126</b>	Heading:	<b>Term of short-term patent</b>	Version Date:	01/07/1997

Remarks:

Amendments retroactively made - see 22 of 1999 s. 3

Provisions as to short-term patents after grant

(1) A short-term patent granted under this Part-

- (a) shall take effect on the date on which the fact of its grant is advertised in the Gazette; and
- (b) subject to subsection (2) and (3), shall remain in force until the end of the period of 8 years beginning with the date of filing the application for the patent.

(2) If it is desired to keep a short-term patent in force for a further 4 years after the expiry of the 4th year from the date of filing of the application for that patent, the prescribed renewal fee shall be paid within the 3 months ending with the expiry of that 4th year, and a short-term patent shall cease to have effect at the expiry of that 4th year if the renewal fee is not so paid.

(3) Despite subsection (2), where the date of grant of a short-term patent occurs after the expiry of the 4th year from the date of filing of the application for that patent then-

- (a) the prescribed renewal fee may be paid at any time before the expiry of 3 months beginning from the date of grant and in the event of such payment the patent shall remain in force for the balance of the period of 4 years specified in subsection (2);

(b) the patent shall cease to have effect under this section if, and only if, the prescribed renewal fee is not paid as provided in paragraph (a).

(4) The Registrar may by regulation amend the period specified in subsection (2) as being the period ending with the expiry of the 4th year from the date of filing of the short-term patent application.

(5) If within 6 months after the end of the period specified in subsection (2) or (3), as the case may be, the renewal fee and any prescribed additional fee is paid, the short-term patent shall be treated as if it had never expired, and accordingly-

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.

(6) The Chief Executive in Council may by regulation amend- (Amended 22 of 1999 s. 3)

- (a) the period specified in subsection (1)(b) as being the period for which a short-term patent shall remain in force;
- (b) the period specified in subsection (2) or (3) by reference to which a short-term patent, if not renewed, shall cease to have effect.

[cf. 1977 c. 37 s. 25 U.K.]

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>148</b>	Heading:	<b>Hours of business and excluded days</b>	Version Date:	30/06/1997

(1) The Registrar may, by notice published in the Gazette, give directions specifying the hours of business of the registry for the purpose of the transaction by the public of business under this Ordinance, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions made under this section may make different provision for different classes of business.

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Chapter:	514	Title:	PATENTS ORDINANCE	Gazette Number:	
Section:	<b>150</b>	Heading:	<b>Registrar may specify forms to be used</b>	Version Date:	30/06/1997

(1) The Registrar may require the use of such forms as he may, by notice published in the Gazette, specify in connection with the granting of a patent or any other proceeding before him under this Ordinance.

(2) A notice under subsection (1) may contain any direction of the Registrar with respect to the use of a form specified in the notice.

Chapter:	514A	Title:	PATENTS (DESIGNATION OF PATENT OFFICES) NOTICE	Gazette Number:	
Section:	<b>2</b>	Heading:	<b>Interpretation</b>	Version Date:	30/06/1997

In this Notice-

"Chinese Patent Office" (中國專利局) means the office established under the laws of the People's Republic of China for the granting of patents for inventions;

"European Patent Convention" (《歐洲專利公約》) means the Convention on the Grant of European Patents done at Munich on 5 October 1973;

"European Patent Office" (歐洲專利局) means the office of that name of the European Patent Organisation established by the European Patent Convention;

"United Kingdom Patent Office" (聯合王國專利局) means the office established under the laws of the United Kingdom for the granting of patents for inventions.

Chapter:	514A	Title:	PATENTS (DESIGNATION OF PATENT OFFICES) NOTICE	Gazette Number:	
Section:	<b>3</b>	Heading:	<b>Designation of patent offices</b>	Version Date:	30/06/1997

The following patent offices are designated under section 8 of the Ordinance-

Chinese Patent Office

European Patent Office, in respect of patents granted under the European Patent Convention designating the United Kingdom

United Kingdom Patent Office

Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>2</b>	Heading:	<b>Interpretation</b>	Version Date:	30/06/1997

(1) In these Rules, unless the context otherwise requires-

"application number" (申請編號) means-

- (a) in relation to an application for a designated patent or a patent granted in pursuance of such an application, the number assigned by the designated patent office upon the filing of that application;
- (b) in relation to an application for a patent under the Ordinance or a patent granted in pursuance of such an application, the number assigned by Registrar upon the filing of that application;

"Chinese Patent Office" (中國專利局) means the office established under the laws of the People's

Republic of China for the granting of patents for inventions;

"European Patent Office" (歐洲專利局) means the office of that name of the European Patent Organization established by the Convention on the Grant of European Patents done at Munich on 5 October 1973;

"International Patent Classification" (國際專利分類法) means the system of common classification for patents for inventions provided for under the Agreement concerning the International Patent Classification done at Strasbourg on 24 March 1971;

"publication number" (發表編號) means-

- (a) in relation to a document published under the Ordinance, the number assigned to the document by the Registrar upon its publication;
- (b) in relation to a document published under the laws of a patent office outside Hong Kong or under any international convention, the number assigned to the document upon its publication by that patent office or under that convention;

"send" (送交) includes give;

"United Kingdom Patent Office" (聯合王國專利局) means the office established under the laws of the United Kingdom for the granting of patents for inventions.

(2) In these Rules-

- (a) reference to something being filed at a place or with a person is to be construed as reference to-
  - (i) its being sent to that place or person;
  - (ii) its being made or left at that place or given or made to or left with that person; or
  - (iii) that person being furnished with it;
- (b) reference to the filing of anything without an indication of the place at which or person with whom it is to be filed is to be construed as reference to its being filed with or sent or delivered to the Registrar at the registry;
- (c) reference to a document in any proceedings before the Registrar being in the specified form is to be construed as a reference to the document being in such form, if any, as may be specified by the Registrar under section 150 of the Ordinance in connection with those proceedings.

Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	8	Heading:	<b>Request to record a designated patent application under section 15 of the Ordinance</b>	Version Date:	30/06/1997

Request to record a designated patent application

(1) A request to record a designated patent application under section 15 of the Ordinance (or, in the case of a designated patent application that is the national phase of an international application under the Patent Cooperation Treaty, under that section as applied by section 16 of the Ordinance) shall be in the specified form.

(2) Further to section 15(2) of the Ordinance (including that section as applied by section 16 of the Ordinance)-

- (a) the documents required under paragraph (a) of that subsection-

- (i) shall be filed in duplicate, and one of those duplicate copies shall be in loose leaf form in accordance with section 12 of these Rules;
- (ii) shall be exempted from any requirement under section 104(1) of the Ordinance to be filed in one of the official languages;
- (b) the documents prescribed for the purposes of paragraph (d) of that subsection are those mentioned in section 9 of these Rules;
- (c) the following particulars shall be set out in the request-
  - (i) the date of filing of the designated patent application;
  - (ii) the title of the invention;
  - (iii) the application number of the designated patent application;
  - (iv) the publication number, and date of publication, of the designated patent application;
- (d) if the designated patent application is the national phase of an international application, the following particulars shall be set out on the request-
  - (i) the application number of the international application;
  - (ii) the filing date of the international application;
  - (iii) the date of publication of the international application by the International Bureau and its publication number;
  - (iv) the date of publication of the international application in the designated patent office indicating that the application has validly entered its national phase;
  - (v) in the case of an international application designating the Chinese Patent Office as published by the International Bureau in the Chinese language, the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the Chinese Patent Office;
- (e) in the case of a request to record a divisional designated patent application as provided for in section 22 of the Ordinance or a request to record in a new application made pursuant to an order under section 55(4) of the Ordinance, the following particulars in relation to the earlier application for a standard patent shall be set out in the request to record-
  - (i) the application number of the earlier application;
  - (ii) the filing date of the earlier application;
  - (iii) the date of publication of the request to record of the earlier application;
- (f) the request shall contain such translations of documents and transliteration of names as may be required under section 56 of these Rules;
- (g) the request shall contain a list of the documents comprising the request to record and an indication of the number of sheets of each such document.

Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	15	Heading:	<b>Date of publication of the designated patent application based on an international application under section 16 of the Ordinance</b>	Version Date:	30/06/1997

(1) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance, the date of publication of the designated patent application based on an international

application under section 16 of the Ordinance shall be-

- (a) in the case of an international application designating the European Patent Office, the date of publication by the European Patent Office in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the European Patent Office;
  - (b) in the case of an international application designating the United Kingdom Patent Office, the date of publication by the United Kingdom Patent Office in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the United Kingdom Patent Office;
  - (c) in the case of an international application designating the Chinese Patent Office as published by the International Bureau other than in the Chinese language, the date of publication by the Chinese Patent Office in its Patent Gazette of the relevant bibliographical data showing that the international application has entered the national phase in the Chinese Patent Office.
- (2) (a) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance, the other date as referred to in section 16(a)(ii) of the Ordinance which is applicable to the case of an international application designating the Chinese Patent Office as published by the International Bureau in the Chinese language is any date within 6 months after the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the Chinese Patent Office.
- (b) An application made within the date as set out in paragraph (a) shall be accompanied by a copy of the National Application Notification (國家申請號通知書).

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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	36	Heading:	<b>Opposition or revocation proceedings in the designated patent office for the purposes of sections 43 and 44 of the Ordinance</b>	Version Date:	30/06/1997

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The following opposition or revocation proceedings are prescribed for the purposes of sections 43 and 44 of the Ordinance-

- (a) in the Chinese Patent Office, any post-grant revocation proceedings under or in accordance with Articles 41 to 44 of the Patent Law of the People's Republic of China and Rules 55 to 63 of the Implementing Regulations of the Patent Law of the People's Republic of China;
  - (b) in European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.
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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
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Section: **54**      Heading: **Opposition or revocation proceedings in the designated patent office for the purposes of section 91(1)(i) of the Ordinance**      Version Date: 30/06/1997

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## PART VII

### REVOCATION OF PATENTS

The following opposition or revocation proceedings are prescribed for the purposes of section 91(1)(i) of the Ordinance-

- (a) in the Chinese Patent Office, any post-grant revocation proceedings under or in accordance with Articles 41 to 44 of the Patent Law of the People's Republic of China and Rules 55 to 63 of the Implementing Regulations of the Patent Law of the People's Republic of China;
  - (b) in the European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.
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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>78</b>	Heading:	<b>Short-term patent application based on international application under section 125 of the Ordinance</b>	Version Date:	30/06/1997

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(1) The other date as referred to in section 125(2) of the Ordinance is any date within 6 months after the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the Chinese Patent Office.

(2) An application made within the date specified in subsection (1) shall be accompanied by the copy of the National Application Notification (國家申請號通知書).

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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>31</b>	Heading:	<b>Restoration of application for standard patent under section 34 of the Ordinance</b>	Version Date:	30/06/1997

(1) An application to restore an application for a standard patent under section 34 of the Ordinance shall be in the specified form and be signed by the applicant.

(2) The restoration application shall contain statements by the applicant in relation to matters relevant to the restoration of the application for a standard patent including, but without limiting those matters, statements indicating whether at the date of the restoration application-

- (a) the designated patent application is still valid or has been withdrawn; and
- (b) a patent has been granted in pursuance of that designated patent application and, if granted, the time for filing a request to register the designated patent and grant a patent under section 23 of the Ordinance has expired.

(3) If, upon consideration of the statements, the Registrar is not satisfied that a case for an order under section 34 of the Ordinance has been made out, he shall notify the applicant accordingly and, unless within 1 month the applicant requests to be heard in the matter, the Registrar shall refuse the application.

(4) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

(5) If the Registrar decides to allow the application, he shall notify the applicant accordingly and require him, within 2 months after the date on which the notification is sent to him, to file an application in the form specified for the purposes of section 33(2) of the Ordinance, duly completed, accompanied by any unpaid maintenance fee and any additional fee prescribed for the purposes of section 33(4) of the Ordinance, upon receipt of which the Registrar shall order the restoration of the application for standard patent and shall advertise the fact of such order in the Gazette.

Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>34</b>	Heading:	<b>Restoration of lapsed standard patents under section 40 of the Ordinance</b>	Version Date:	30/06/1997

(1) An application under section 40 of the Ordinance for the restoration of a standard patent which has ceased to have effect by reason of a failure to pay any renewal fee-

- (a) shall be in the specified form;
- (b) shall be signed by the applicant;
- (c) shall be supported by evidence of the statements made in it; and
- (d) shall be accompanied by the fee prescribed for the purposes of that section.

(2) If, upon consideration of the evidence provided in support of an application, the Registrar is not satisfied that a case for an order under section 40 of the Ordinance has been made out, he shall notify the applicant accordingly and, unless within 1 month the applicant requests to be heard in the matter, the Registrar shall refuse the application.

(3) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

(4) If the Registrar decides to allow the application, he shall notify the applicant accordingly and require him, within 2 months from the date on which the notification is sent to him, to file a request for renewal in the specified form, duly completed, accompanied by any unpaid renewal fee and any additional fee prescribed for the purposes of section 40(4) of the Ordinance, upon receipt of which the Registrar shall order the restoration of the standard patent and shall advertise the fact of such order in the Gazette.

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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>40</b>	Heading:	<b>Surrender of patents</b>	Version Date:	30/06/1997

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(1) A notice of an offer by a proprietor of a patent under section 48 of the Ordinance to surrender his patent shall be in the specified form and details of any such notice given to the Registrar shall be advertised by the Registrar in the Gazette.

(2) Notice of opposition under section 48(2) of the Ordinance to the surrender of a patent may be given at any time within 2 months from the date of the advertisement.

(3) Such notice shall-

- (a) be in the specified form and be filed in duplicate;
- (b) be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks; and
- (c) be accompanied by the prescribed fee,

and the Registrar shall send a copy of the notice and of the statement to the proprietor of the patent.

(4) Within 3 months from the date on which the copies are sent to him, the proprietor of the patent shall, if he wishes to continue with the surrender, file a counter-statement which shall-

- (a) be in the specified form and be filed in duplicate;
- (b) set out fully the grounds of objection to the surrender being opposed; and
- (c) be accompanied by the prescribed fee,

and the Registrar shall send a copy of the counter-statement to the opponent.

(5) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>48</b>	Heading:	<b>Correction of errors in patents and applications under section 146 of the Ordinance</b>	Version Date:	30/06/1997

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(1) Except where section 45(3) has effect, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall-

- (a) be in the specified form;

- (b) clearly identify the proposed correction; and
- (c) be accompanied by the prescribed fee,

and the Registrar may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.

(2) Where such a request relates to a specification, no correction shall be made in the specification unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

(3) Where the Registrar requires notice of the proposed correction to be advertised, he shall advertise the request and the nature of the proposed correction in the Gazette.

(4) At any time within 2 months after the date of the advertisement, any person may give notice to the Registrar of opposition to the request.

(5) Such notice shall be in the specified form and be filed in duplicate, shall be supported by a statement setting out fully the facts on which the opponent relies and the relief which he seeks and shall be accompanied by the prescribed fee.

(6) The Registrar shall send a copy of the notice and the statement to the person making the request who, if he desires to proceed with the request, shall within 3 months from the date of the sending of the copies to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the opposition and pay the prescribed fee, and the Registrar shall send a copy of the counter-statement to the opponent.

(7) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:	
Section:	<b>88</b>	Heading:	<b>Request for information under section 147 of the Ordinance</b>	Version Date:	30/06/1997

### PART XIII

#### INFORMATION AND INSPECTION

- (1) A request under section 147 of the Ordinance-
  - (a) for information relating to any standard patent or standard patent application, may be made as to-
    - (i) when a request to record has been published;
    - (ii) when a standard patent has been granted;
    - (iii) in the case of an application for a standard patent which has been published, when an application has been withdrawn, is deemed to have been withdrawn or has been refused;
    - (iv) whether a maintenance fee has not been paid within the period specified in section 33(2) of the Ordinance;
    - (v) when a maintenance fee has been paid within the further period specified in section 33(4) of the Ordinance;
    - (vi) whether a renewal fee has not been paid within the period specified in section 39(2) of the Ordinance;
    - (vii) when a renewal fee has been paid within the further period specified in section

- 39(4) of the Ordinance;
- (b) for information relating to the grant of any short-term patent, may be made as to-
- (i) when a short-term patent has been granted;
  - (ii) whether a renewal fee has not been paid within the period specified in section 126(2) or (3) of the Ordinance;
  - (iii) when a renewal fee has been paid within the further period specified in section 126(5) of the Ordinance;
- (c) for information relating to any patent or patent application, may be made as to-
- (i) when a patent has ceased to have effect or when an application for restoration of a patent has been filed, or both;
  - (ii) when an entry has been made in the register or an application has been made for the making of such entry;
  - (iii) when any application or request is made or action taken involving an entry in the register or advertisement in the Gazette, if the nature of the application, request or action is specified in the request; and
  - (iv) when any document may be inspected in accordance with section 89 or 90.
- (2) Any such request shall be in the specified form and shall be accompanied by the prescribed fee.
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Chapter:	514C	Title:	PATENTS (GENERAL) RULES)	Gazette Number:
Section:	<b>93</b>	Heading:	<b>Service of documents</b>	Version Date: 30/06/1997

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#### PART XIV

#### MISCELLANEOUS

(1) Any notice, application or other document authorized or required by the Ordinance or these Rules to be filed with any person or filed at any place, or sent to any person or place, may be sent through the post, and the service and filing shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document, and, unless the contrary is proved, shall be deemed to have been effected at the time at which the letter would be delivered in the ordinary course of post.

(2) The Registrar may at his discretion permit, as an alternative to the sending by post or delivery, the filing or sending of a notice, application or other document in legible form by electronic means subject to such terms or conditions as he may specify either generally by notice published in the Gazette or in any particular case by written notice to the person desiring to file any the document by such means.

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Chapter:	514C	Title:	PATENTS (GENERAL) RULES	Gazette Number:
Section:	<b>1</b>	Heading:	<b>MICRO-ORGANISMS</b>	Version Date: 30/06/1997

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## 1. Application

(1) If an invention which is the subject of an application for a short-term patent, or a short-term patent, requires for its performance the use of a micro-organism-

- (a) which is not available to the public at the date of filing of the application; and
- (b) which cannot be described in the application or the specification of the patent in such a manner as to enable the invention to be performed by a person skilled in the art,

the invention shall only be regarded as being disclosed for the purposes of section 77 of the Ordinance if the conditions set out in subparagraph (2) are satisfied.

(2) The conditions referred to in subparagraph (1) are that-

- (a) not later than the date of filing of the application, a culture of the micro-organism has been deposited in a depositary institution which is able to furnish a sample of the micro-organism;
- (b) the name of the depositary institution, the date when the culture was deposited and the accession number of the deposit are given in the specification of the application;
- (c) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and
- (d) where a new deposit is made under paragraph 3, the applicant or proprietor makes a new deposit in accordance with that paragraph.

(3) The information specified in subparagraph (2)(b) shall be submitted-

- (a) together with the request for grant of a short-term patent; or
- (b) within 1 month after the Registrar has communicated to the applicant that a right for information and inspection of documents under section 147(5) of the Ordinance exists,

whichever is the earlier.

(4) The giving of the information specified in subparagraph (2)(b) shall constitute the unreserved and irrevocable consent of the applicant to the deposited culture (including a deposited culture which is to be treated as having always been available by virtue of paragraph 3(2)) being made available in accordance with this Schedule to any person as from the date of grant of the short-term patent or prior to that date to any person having the right to information and inspection of documents under section 147(5) of the Ordinance subject to-

- (a) the production of the Registrar's notice of confirmation regarding the release to the person who is named in the notice of confirmation as a person to whom the culture may be made available; and
- (b) the making of a valid request, to the depositary institution with which the culture is deposited, for the culture to be made available.

## 2. Availability of cultures

(1) A request to the Registrar for the issue of a notice of confirmation regarding the release of a deposited culture shall be in the specified form and shall be filed in quadruplicate.

(2) The Registrar shall send copies of the forms lodged with him under subparagraph (1) and of his notice of confirmation regarding the release of the sample-

- (a) to the applicant for, or proprietor of, the patent;
- (b) to the depositary institution; and
- (c) to the person making the request.

(3) A request under subparagraph (1) shall comprise, on the part of the person making the request, undertakings for the benefit of the applicant for, or proprietor of, the patent-

- (a) not to make the culture, or any culture derived from it, available to any other person; and
- (b) not to use the culture, or any culture derived from it, otherwise than for experimental

purposes relating to the subject-matter of the invention,  
and, in this subparagraph, references to a culture derived from a deposited culture of a micro-organism are references to a culture so derived which exhibits those characteristics of the deposited culture essential for the performance of the invention.

(4) Further to subparagraph (3)-

- (a) and subject to sub-subparagraph (c), both undertakings shall have effect during any period before the application for a patent has been withdrawn, is deemed to have been withdrawn or has been refused (including any further period allowed under section 94 or 100 of these Rules but excluding, where an application is reinstated under either of those sections, the period before it is reinstated);
- (b) if a patent is granted on the application, the undertaking set out in subparagraph (3)(a) shall also have effect during any period for which the patent is in force and during the further period of 6 months referred to in section 126(5) of the Ordinance; and
- (c) the undertaking set out in subparagraph (3)(b) shall not have effect after the date of publication in the Gazette of a notice advertising that the patent has been granted.

(5) For the purpose of enabling any Government use specified in section 69 of the Ordinance in relation to the culture, the undertakings specified in subparagraph (3)-

- (a) shall not be required from any Government department or person authorized in writing by a Government department for the purposes of this paragraph; and
- (b) shall not have effect in relation to any such person who has already given the undertakings.

(6) An undertaking given pursuant to subparagraph (3) may be varied by way of derogation by agreement between the applicant or proprietor and the person by whom it is given.

(7) Where, in respect of a patent to which the undertaking set out in subparagraph 3(a) has effect, a compulsory licence is granted under section 64 of the Ordinance, that undertaking shall not have effect to the extent necessary for effect to be given to any such licence.

### 3. New deposits

(1) Where the depositary institution with which a deposit or a new deposit of a culture has been made under this Schedule-

- (a) notifies the applicant or proprietor that it-
  - (i) cannot satisfy a request made in accordance with paragraph 2(1); or
  - (ii) is not able lawfully, to satisfy such a request, for the culture to be made available;
- (b) ceases temporarily or permanently to carry out the functions of a depositary institution; or
- (c) ceases for any reason to conduct its activities as a depositary institution in an objective and impartial manner,

then subject to subparagraph (3), the applicant or proprietor may, unless the culture has been transferred to another depositary institution which is able to make it available, make a new deposit of a culture of that micro-organism.

(2) For the purposes of paragraph 1 and of this paragraph, the deposit shall be treated as always having been available if, within 3 months of the receipt of such notification or of the depositary institution ceasing to perform the functions of a depositary institution or to conduct its activities as such an institution in an objective and impartial manner, the applicant or proprietor,-

- (a) in a case where the deposit has not already been transferred, makes the new deposit;
- (b) furnishes to the depositary institution with which the new deposit is made a declaration that the culture so deposited is of the same micro-organism as was the culture originally deposited; and
- (c) requests amendment of the specification under section 46 or 120 of the Ordinance, as the case may be, so as to indicate the accession number of the transferred or new deposit and, where applicable, the name of the depositary institution with which the deposit has been

made.

- (3) The new deposit referred to in subparagraph (1)-
  - (a) shall, except as provided in sub-subparagraph (b), be made with the same depositary institution as was the original deposit; or
  - (b) in the cases referred to in subparagraph (1)(a)(ii), (b) and (c), shall be made with another depositary institution which is able to satisfy the request.

#### 4. Interpretation of Schedule

- (1) In this Schedule-

"the Budapest Treaty" (《布達佩斯條約》) means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest in 1977; and

"international depositary authority" (國際寄存主管當局) means a depositary institution which has acquired the status of international depositary authority as provided in Article 7 of the Budapest Treaty.

- (2) For the purposes of this Schedule a "depositary institution" is an institution which, at all relevant times-

- (a) carries out the functions of receiving, accepting and storing micro-organism and the furnishing of samples thereof; and
  - (b) conducts its affairs in so far as they relate to the carrying out of those functions in an objective and impartial manner.
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Chapter:	522	Title:	REGISTERED DESIGNS ORDINANCE	Gazette Number:	
Section:	<b>15</b>	Heading:	<b>Priority right</b>	Version Date:	30/06/1997

(1) A person or his successor in title who has duly filed an application for registration of a design in, or in respect of, a Paris Convention country or WTO member shall enjoy, for the purpose of registering the same design under this Ordinance in respect of any or all of the same articles, a right of priority for the period of 6 months after the filing date of the first application, subject to compliance with any prescribed conditions.

(2) Any filing of an application for registration of a design in, or in respect of, a Paris Convention country or WTO member which is equivalent to a regular national filing under the law of that Paris Convention country or WTO member, or under any bilateral or multilateral agreement to which it is a party, shall be recognized as giving rise to a right of priority.

(3) A subsequent application for the registration of a design that was the subject of a previous application, and that is filed in or in respect of the same Paris Convention country or WTO member, shall be considered as the first application for the purpose of determining priority if, and only if, on the filing date of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.

(4) In this section, "regular national filing"(正規國家提交) means any filing of an application for registration of a design in, or in respect of, a Paris Convention country or WTO member that establishes the date on which the application was filed, whatever the outcome of the application may be.

Chapter:	522	Title:	REGISTERED DESIGNS ORDINANCE	Gazette Number:	
Section:	<b>71</b>	Heading:	<b>Business hours of Registry</b>	Version Date:	30/06/1997

(1) The Registrar may by notice published in the Gazette give directions specifying the hours of business of the Registry for the purpose of the transaction of business under this Ordinance.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next following business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next following business day.

(3) Directions made under this section may make different provision for different classes of business.

Chapter:	522	Title:	REGISTERED DESIGNS ORDINANCE	Gazette Number:	
Section:	<b>25</b>	Heading:	<b>Registration and publication</b>	Version Date:	30/06/1997

Remarks:

If on an examination by the Registrar under section 24 an application for registration of a design is found to have satisfied the formal requirements, then as soon as practicable after such examination, but subject to section 26, the Registrar shall-

- (a) register the design by entering the prescribed particulars in the Register;
- (b) enter the name of the applicant, or the successor in title to the application, in the Register as the owner of the design;
- (c) issue a certificate of registration to the person who is the registered owner of the design at the time the design is registered; and
- (d) advertise the fact of such registration and publish a representation of the design by notice in the Gazette.

Chapter:	522	Title:	REGISTERED DESIGNS ORDINANCE	Gazette Number:	
Section:	<b>71</b>	Heading:	<b>Business hours of Registry</b>	Version Date:	30/06/1997

(1) The Registrar may by notice published in the Gazette give directions specifying the hours of business of the Registry for the purpose of the transaction of business under this Ordinance.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next following business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next following business day.

(3) Directions made under this section may make different provision for different classes of business.

Chapter:	522	Title:	REGISTERED DESIGNS ORDINANCE	Gazette Number:	
Section:	<b>84</b>	Heading:	<b>Registrar may specify forms to be used</b>	Version Date:	30/06/1997

(1) The Registrar may require the use of such forms as he may, by notice published in the Gazette, specify in connection with the registration of a design or any other proceeding before him under this Ordinance.

(2) A notice under subsection (1) may contain any direction of the Registrar with respect to the use of a form specified in the notice.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	2	Heading:	<b>Interpretation</b>	Version Date:	30/06/1997

Remarks:

(1) In these Rules-

"Locarno Agreement"(《洛迦諾協議》) means the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as amended from time to time;

"send"(送交) includes give;

"statement of novelty"(新穎性陳述) means a statement in accordance with section 8;

"textile article"(紡織品) means textile and plastics piece goods, handkerchiefs, shawls and such other classes of articles of a similar character as the Registrar may from time to time decide, for which the protection under the Ordinance is limited to features of pattern and ornament only.

(2) Any reference in these Rules-

- (a) to a specified form shall be construed as a reference to the relevant form specified by the Registrar by notice published in the Gazette;
- (b) to an applicable fee shall be construed as a reference to the fee applicable in accordance with section 74 and the Schedule; or
- (c) to the filing of a document shall be construed as a reference to the filing of the document with the Registrar.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	27	Heading:	<b>Advertisement of registration</b>	Version Date:	30/06/1997

(1) The advertisement of the registration of a design published in the Gazette under section 25(d) of the Ordinance shall contain-

- (a) the date of registration;
- (b) if applicable, the priority date and the name of the relevant Paris Convention country or WTO member;
- (c) the registration number;
- (d) the name and address of the registered owner;
- (e) any address for service;
- (f) a reproduction of the representation of the design included with the application;
- (g) particulars as to the article or articles in respect of which the design is registered; and
- (h) the number of the class and subclass of the Locarno classification of the article or articles in respect of which the design is registered.

(2) If a design is registered in accordance with section 11 of the Ordinance in association with a design which has been previously registered, the advertisement shall also contain the number or numbers of the previous registration or registrations and the number or numbers of the previous application or applications for registration.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>30</b>	Heading:	<b>Notice of failure to apply for renewal</b>	Version Date:	30/06/1997

If, at the end of the current period of registration of a design, an application is not filed or the applicable fees are not paid in accordance with section 29(1), the Registrar shall publish notice of that fact in the Gazette.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>31</b>	Heading:	<b>Removal of registration</b>	Version Date:	30/06/1997

(1) If an application is not filed or the applicable fees are not paid in accordance with section 29(1) or (2), the Registrar shall remove the design from the Register.

(2) Notice of the removal of the registration of a design from the Register shall be published in the Gazette.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>32</b>	Heading:	<b>Surrender of registration</b>	Version Date:	30/06/1997

(1) The registered owner of a design may surrender the registration of the design under section 30 of the Ordinance by filing a notice of surrender in the specified form.

(2) A notice filed under this section shall not be valid unless the registered owner in the notice-

(a) states that the registration is to be surrendered in respect of either-

(i) all of the articles for which the design is registered; or

(ii) articles specified in the notice;

(b) gives the name and address of each other person having a registered interest in the design; and

(c) certifies, in respect of every such person, that the person-

(i) has been sent not less than 3 months' notice of his intention to surrender the registration; or

(ii) is not affected by the surrender or, if affected, consents to the surrender.

(3) The surrender takes effect upon receipt by the Registrar of a notice which complies with subsection (2).

(4) A surrender of the registration of a design has the same effect in respect of the articles for which the design is surrendered as the registration of the design ceasing to have effect in respect of those

articles.

(5) The Registrar shall, upon the surrender taking effect, make the appropriate entry in the Register and publish notice of the surrender in the Gazette.

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Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>37</b>	Heading:	<b>Reference</b>	Version Date:	30/06/1997

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LEGAL PROCEEDINGS  
(SECTIONS 44, 45, 46 AND 63 OF ORDINANCE)

References to Registrar

- (1) A reference to the Registrar under section 44 of the Ordinance of the question of whether, having regard to section 7 of the Ordinance, a design is a registrable design shall be made by filing in duplicate-
- (a) an application in the specified form; and
  - (b) a statement setting out fully the reference sought and the facts on which the applicant relies.
- (2) The Registrar shall-
- (a) send the duplicates of the application and statement to the registered owner of the design; and
  - (b) enter a notice of the application in the Register and advertise the fact of the application in the Gazette.
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Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>38</b>	Heading:	<b>Notice of opposition</b>	Version Date:	30/06/1997

Expanded Cross Reference:  
39, 40, 41, 42, 43, 44

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- (1) If any person (including the registered owner) wishes to oppose an application under section 37, he shall, within 2 months from the date of the advertisement in the Gazette, file in duplicate a notice of opposition in the specified form setting out fully the grounds on which the opponent objects to the application and the facts on which he relies.
- (2) If a person files a notice of opposition under subsection (1), the Registrar shall forthwith send the duplicate to the applicant.
- (3) This section and sections 39 to 44 do not apply in any case where the Registrar refers the question to the court for determination in accordance with section 46. <\*Note-Exp. x-Ref: Sections 39, 40, 41, 42, 43, 44\*>

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>46</b>	Heading:	<b>Reference to court</b>	Version Date:	30/06/1997

(1) Where the Registrar receives an application under section 37 and decides to refer the question to the court for determination, he shall forthwith serve a certified copy of the reference to the court on the applicant and the registered owner of the design.

(2) The Registrar shall enter a notice of the reference to the court in the Register and advertise the fact of the reference in the Gazette.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>51</b>	Heading:	<b>Correction of errors in Register</b>	Version Date:	30/06/1997

(1) A request for the correction of an error in the Register under section 67 of the Ordinance shall be made on the specified form and shall clearly identify the proposed correction.

(2) The Registrar shall advertise the fact of the request and the nature of the proposed correction in the Gazette.

(3) If any person wishes to oppose the request, he shall, within 2 months from the date of the advertisement in the Gazette, file in duplicate a notice of opposition in the specified form setting out fully the grounds on which the opponent objects to the request and the facts on which he relies.

(4) If a person files a notice of opposition under subsection (3), the Registrar shall forthwith send the duplicate to the person making the request.

(5) Within 3 months from the date of the sending of the duplicate of the notice of opposition under subsection (4), the person making the request shall file a counter-statement in the specified form setting out the grounds on which he relies as supporting his request and the facts, if any, alleged in the notice of opposition which he admits.

(6) The counter-statement shall be filed together with a duplicate which the Registrar shall send to the opponent.

(7) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
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Any directions given by the Registrar under section 71 of the Ordinance specifying the hours of business of the Registry and business days of the Registry shall be posted in the Registry and published in the Gazette.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>60</b>	Heading:	<b>Service of documents on Registrar</b>	Version Date:	30/06/1997

(1) Any application, notice, form, evidence or other document required or authorized to be filed with the Registrar under the Ordinance or by these Rules must be filed by hand or by post.

(2) Filing by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document, and, unless the contrary is proved, shall be deemed to have been effected at the time at which the letter would be delivered in the ordinary course of post.

(3) The Registrar may at his discretion permit, as an alternative to the filing by hand or by post, the filing of a document by electronic means subject to such terms as he may specify either generally by notice published in the Gazette or in any particular case by written notice to the person wishing to file the document by such means.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Section:	<b>62</b>	Heading:	<b>Correction of errors in filed documents</b>	Version Date:	30/06/1997

(1) A request for the correction of any error of translation or transcription or of any clerical error or mistake in any document referred to in section 76(1) of the Ordinance (other than an address or address for service) shall be made on the specified form and shall clearly identify the proposed correction.

(2) The Registrar may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.

(3) The Registrar shall advertise the request and the nature of the proposed correction in the Gazette.

(4) If any person wishes to oppose the request, he shall, within 2 months from the date of the advertisement in the Gazette, file in duplicate a notice of opposition in the specified form setting out fully the grounds on which the opponent objects to the request and the facts on which he relies.

(5) If a person files a notice of opposition under subsection (4), the Registrar shall forthwith send the duplicate to the person making the request.

(6) Within 3 months from the date of the sending of the duplicate of the notice of opposition under subsection (5), the person making the request shall file a counter-statement in the specified form setting out the grounds on which he relies as supporting his request and the facts, if any, alleged in the

notice of opposition which he admits.

(7) The counter-statement shall be filed together with a duplicate which the Registrar shall send to the opponent.

(8) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

Chapter:	522A	Title:	REGISTERED DESIGNS RULES	Gazette Number:	
Schedule:		Heading:	<b>SCHEDULE</b>	Version Date:	30/06/1997

[sections 2(2) & 74]

FEES

Fee No.	Matter or proceeding	Amount	When payable
1	Application for registration of a design under section 12 of the Ordinance and section 6-1 design for articles not forming a set of articles	\$1600 for each article to which the design is to be applied	On filing application
2	Application for registration of a design under section 12 of the Ordinance and section 6-1 design for 1 set of articles	\$3200	On filing application
3	Application for registration of a design under sections 12 and 13 of the Ordinance and sections 6 and 16-2 or more designs for articles not forming a set of articles	\$1600 for the first article to which the first design is to be applied and \$1200 for each other article to which any of the designs is to be applied	On filing application
4	Application for registration of a design under sections 12 and 13 of the Ordinance and sections 6 and 16-2 or more designs for articles forming a set of articles	\$3200 for the first design and \$2400 for each other design	On filing application
5	Request to amend an application for registration of a design under section 21 of the Ordinance and section 19	\$350	On filing request

6	Request to correct an error in the Register under section 67 of the Ordinance and section 51	\$350	On filing request
7	Request to correct an error of translation or transcription or of any clerical error or mistake in any document under section 76 of the Ordinance and section 62	\$350	On filing request
8	Notice requesting reinstatement of an application for registration of a design under section 20 of the Ordinance and section 18	\$500	On filing notice
9	For advertisement in the Gazette of the registration of a design	Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette	On filing application under section 12 of the Ordinance and section 6
10	For a certified copy of an entry in the Register or a certified extract from the Register under section 69 of the Ordinance and section 54	\$350	On filing application for copy
11	For a certified copy of document kept by the Registry, not otherwise charged	\$350	On filing application for copy
12	For an uncertified copy of an entry in the Register or an uncertified extract from the Register under section 69 of the Ordinance and section 54	\$6 per page	On filing application for copy
13	For an uncertified copy of a document kept by the Registry, not otherwise charged	\$6 per page	On filing application for copy
14	For renewal of the period of registration under section 28(3) or (5) of the Ordinance and section 29-1st 5-year extension	\$2500	On filing application for renewal
15	For renewal of the period of registration under section 28(3) or (5) of the Ordinance and section 29-2nd 5-year extension	\$3800	On filing application for renewal
16	For renewal of the period of registration under section 28(3) or (5) of the Ordinance and section 29-3rd 5-year extension	\$5600	On filing application for renewal

17	For renewal of the period of registration under section 28(3) or (5) of the Ordinance and section 29-4th 5-year extension	\$8500	On filing application for renewal
18	For renewal of the period of registration under section 92(2) of the Ordinance and section 75	\$2500	On filing application for renewal
19	Additional fee for the renewal of the period of registration under section 28(5) of the Ordinance and section 29	\$1000	On filing application for renewal
20	Notice of particulars concerning any transaction, instrument or event under section 20	\$1200	On filing notice
21	Application to register particulars of any transaction, instrument or event under section 33 or 34	\$1200	On filing application
22	Reference to Registrar under section 44 of the Ordinance and section 37	\$700	On filing application under section 37
23	Counter-statement or notice of opposition under section 38, 39, 51 or 62	\$1200	On filing counter-statement or notice of opposition
24	For certificate of Registrar under section 65(2) of the Ordinance and section 54	\$350	On filing application for certificate
25	Request for information or permission to inspect documents under section 70 of the Ordinance and section 55	\$100	On filing request
26	For inspecting or making a search of the Register	\$100 for each 30 minutes	Before inspection or search
27	For extending a period of time under section 73	\$800	On filing application for extension

Chapter:	42A	Title:	(Ceased to be in force)	Gazette Number:	
		Heading:		Version Date:	30/06/1997

Chapter:	42B	Title:	(Ceased to be in force)	Gazette Number:	
		Heading:		Version Date:	30/06/1998