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PATENTS (GENERAL) (AMENDMENT) RULES 2004

(Made under section 149 of the Patents Ordinance (Cap. 514) with the consent of the Financial Secretary)

1. Commencement

These Rules shall come into operation on the day appointed for the commencement of sections 2(*d*), 12 and 14 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Interpretation

(1) Section 2(1) of the Patents (General) Rules (Cap. 514 sub. leg. C) is amended, in the definition of “International Patent Classification”, by adding “, as revised or amended from time to time” after “1971”.

(2) Section 2(1) is amended, in the definition of “send”, by adding “, and cognate expressions are to be construed accordingly” after “give”.

(3) Section 2(1) is amended by adding—

““digital signature” (數碼簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic record” (電子紀錄) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic signature” (電子簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“information system” (資訊系統) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);”.

(4) Section 2(2)(*a*) is repealed.

(5) Section 2(2)(*b*) is repealed and the following substituted—

“(b) reference to the filing of a document or other thing with the Registrar, or reference to the filing of a document or other thing without an indication of the place at which or person with whom it is to be filed, shall be construed as a reference to the filing of the document or thing with the Registrar in accordance with sections 93, 93A, 93B and 93C;”.

3. Section added

The following is added immediately after section 2—

“2A. Specified forms

A requirement to use a specified form is satisfied by the use of either—

- (a) a replica of the specified form; or
- (b) a form acceptable to the Registrar,

that contains the information required by the specified form and complies with any directions of the Registrar as to the use of the specified form or replicas of it.”.

4. Sections substituted

Sections 3 and 4 are repealed and the following substituted—

“3. References to the Registrar under section 13(1)(a) or (b) of the Ordinance

(1) A reference to the Registrar under section 13(1)(a) or (b) of the Ordinance shall—

- (a) be in the specified form;
- (b) be accompanied by a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or relief sought; and
- (c) be accompanied by the prescribed fee.

(2) In the case of a reference under section 13(1)(a) of the Ordinance, the person making the reference shall, at the same time as he files it, send a copy of the reference and statement to each of the following persons (not being a party to the reference)—

- (a) each person who is alleged in the reference to be entitled to apply for the grant of a standard patent for the invention that is the subject of the reference;
- (b) each person whom the person making the reference believes to be the inventor or joint inventor of that invention; and
- (c) if an application for a standard patent for that invention has been published before the reference is filed, each person who is shown in the register as having a right in or under that application.

(3) In the case of a reference under section 13(1)(b) of the Ordinance, the person making the reference shall, at the same time as he files it, send a copy of the reference and statement—

- (a) to each joint proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order or the granting of the relief sought;

- (b) to each of the following persons (not being a party to the reference)—
 - (i) each person to whom it is alleged in the reference any right in or under the application should be transferred or granted; and
 - (ii) each person whom the person making the reference believes to be the inventor or joint inventor of the invention that is the subject of the reference; and
- (c) if an application for a standard patent for that invention has been published before the reference is filed, to each person who is shown in the register as having a right in or under that application.

(4) The person making the reference shall attach to each copy of the reference and statement he sends under subsection (2) or (3), as the case may be, a notice containing the names and addresses of all persons to whom a copy of the reference and statement is being sent under that subsection, and he shall notify the Registrar of the names and addresses of those persons.

(5) In addition, if an application for a standard patent for the invention that is the subject of a reference under section 13(1)(a) or (b) of the Ordinance has been filed but the application has not been published before the reference is filed, the Registrar shall send a copy of the reference and statement to each of the following persons (not being a party to the reference or a person to whom copies have been sent under subsection (2) or (3), as the case may be)—

- (a) each person who is an applicant for the standard patent; and
- (b) each person who has given notice to the Registrar under section 46 of a transaction, instrument or event in relation to that application.

(6) The Registrar shall send a notice containing the names and addresses of all persons to whom copies of the reference and statement have been sent under subsection (5) to—

- (a) each person to whom copies have been sent under that subsection;
- (b) the person making the reference; and
- (c) each person whose name and address has been notified to the Registrar under subsection (4).

(7) Any person who is sent a copy of the reference and statement under subsection (2), (3) or (5) and who wishes to oppose the making of the order or the granting of the relief sought (“the opponent”) shall, within 3 months from the date on which the copies are sent to him, file a counter-statement which shall be in the specified form, shall set out fully the grounds of opposition and shall be accompanied by the prescribed fee.

(8) The opponent shall, at the same time as he files the counter-statement, send a copy of it to each of the following persons (not being a party to the counter-statement)—

- (a) the person making the reference;
- (b) each person whose name and address has been notified to him under subsection (4); and
- (c) each person whose name and address has been notified to him under subsection (6).

(9) The person making the reference and any other person to whom a copy of the counter-statement is sent under subsection (8) may, within 3 months from the date on which it is sent to him, file evidence in support of his case and, if he files such evidence, he shall send a copy of it—

- (a) to the opponent; and
- (b) where the evidence is filed by such other person, to the person making the reference.

(10) Within 3 months from the date on which a copy of evidence is sent to the opponent under subsection (9) or, if no such evidence is filed under that subsection, within 3 months from the expiry of the time within which evidence might have been filed, the opponent may file evidence in support of his case and, if he files such evidence, he shall send a copy of it to—

- (a) the person making the reference; and
- (b) any other person who has filed the evidence under subsection (9).

(11) The person making the reference and any other person to whom a copy of the opponent's evidence is sent under subsection (10) may, within 3 months from the date on which the copy is sent to him, file further evidence confined to matters strictly in reply to the opponent's evidence and, if he files such further evidence, he shall send a copy of it—

- (a) to the opponent; and
- (b) where the further evidence is filed by such other person, to the person making the reference.

(12) No further evidence shall be filed except by leave or direction of the Registrar.

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

5. Authorization under section 13(5) of the Ordinance

- (1) Section 6(1)(a) is amended by repealing “and be filed in duplicate”.
- (2) Section 6(1)(b) is amended by repealing “in duplicate”.

(3) Section 6(2) is amended by repealing “The Registrar shall” and substituting “The applicant shall, at the same time as he files the application,”.

6. Reference to the Registrar under section 14(5) of the Ordinance

(1) Section 7(1)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 7(1)(b) is amended by repealing “in duplicate”.

(3) Section 7(2) is amended by repealing “The Registrar shall” and substituting “The person making the reference shall, at the same time as he files the reference,”.

(4) Section 7(4)(a) is amended by repealing “, shall be filed in duplicate”.

(5) Section 7(4)(b) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “The recipient shall, at the same time as he files the counter-statement, send a copy of it”.

7. Request to record a designated patent application under section 15 of the Ordinance

Section 8(2)(a)(i) is amended by repealing “in duplicate, and one of those duplicate copies shall be in loose leaf form”.

8. Documents supporting statement of derivation of entitlement to apply

Section 9(a)(i) is amended by repealing “certified”.

9. Size and presentation of documents

(1) Section 12(1)(a) is amended—

(a) by repealing “direct”;

(b) by adding “and” at the end.

(2) Section 12(5) and (6) is repealed.

(3) Section 12(7) is amended by repealing “; and such numbering shall be placed at the top of the sheet, in the middle, but not in the top margin”.

(4) Section 12(8) is repealed.

10. Request for registration of designated patent and grant of patent under section 23(1) of the Ordinance

Section 19(2)(a) is amended by repealing “loose leaf form” and substituting “accordance with section 12 of these Rules”.

11. Maintenance of application for standard patent under section 33 of the Ordinance

(1) Section 28(1) is amended by repealing “and be signed by the applicant”.

(2) Section 28(3) is amended by adding “供送達文件的” after “紀錄冊的”.

12. Amendment of standard patent under section 43 of the Ordinance

(1) Section 35(1) is amended by repealing “3 months” and substituting “6 months”.

(2) Section 35(2) is repealed and the following substituted—

“(2) A filing of documents with the Registrar for the purposes of section 43(1) of the Ordinance shall be made by filing—

(a) a verified copy of—

- (i) the amended specification; or
- (ii) the amending order;

(b) a notice of the amendment in the specified form; and

(c) such translations of the documents filed under paragraph (a) as may be required under section 56 of these Rules.”.

13. Revocation of standard patent under section 44 of the Ordinance

(1) Section 37(2)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 37(4) is repealed and the following substituted—

“(4) A person who files an application under section 44(4) of the Ordinance shall, at the same time, send a copy of the application and any evidence and translation accompanying the application to every person registered as proprietor of the patent and to every other person who is shown in the register as having a right in or under the patent.”.

(3) Section 37(5) is amended by repealing “in duplicate”.

(4) Section 37(6) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “The recipient shall, at the same time as he files the counter-statement, send a copy of it”.

14. Mention of inventor under section 45 of the Ordinance

(1) Section 38(2)(b) is amended by repealing “in duplicate”.

(2) Section 38(3) is repealed and the following substituted—

“(3) A person who files an application under subsection (1) or a request under section 45(2) of the Ordinance shall, at the same time, send a copy of the application or request and any statement accompanying it to—

- (a) every person registered as proprietor of the patent other than the applicant or person making the request;
- (b) every person who has been identified in the patent as the inventor or a joint inventor of the invention;
- (c) every person who has been identified in the statement referred to in subsection (2)(b) as the inventor or a joint inventor of the invention; and
- (d) every other person who is shown in the register as having a right in or under the patent.”.

(3) Section 38(5)(a) is amended by repealing “, shall be filed in duplicate”.

(4) Section 38(5)(b) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “A person who files a counter-statement shall, at the same time, send a copy of it”.

15. Amendment of specification after grant

Section 39 is repealed.

16. Surrender of patents

(1) Section 40(3)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 40(3)(b) is amended by repealing “in duplicate”.

(3) Section 40(3) is amended by repealing “Registrar shall” and substituting “opponent shall, at the same time as he files the notice,”.

(4) Section 40(4)(a) is amended by repealing “and be filed in duplicate”.

(5) Section 40(4) is amended by repealing “Registrar” and substituting “proprietor”.

17. Registrar’s power to revoke patent on grounds of “ordre public” or morality under section 49 of the Ordinance

(1) Section 41(1)(a) is amended by repealing “and be filed in duplicate”.

- (2) Section 41(1)(b) is amended by repealing “in duplicate”.
- (3) Section 41(2) is amended by repealing “The Registrar shall” and substituting “The applicant shall, at the same time as he files the reference,”.
- (4) Section 41(3)(a) is amended by repealing “and be filed in duplicate”.
- (5) Section 41(3) is amended by repealing “Registrar” and substituting “proprietor”.

18. Section substituted

Section 42 is repealed and the following substituted—

“42. Address for service in respect of patents

- (1) Every person concerned in any proceedings before the Registrar shall file an address for service.
- (2) The address for service must be a residential or business address in Hong Kong.
- (3) A person may file an address for service—
 - (a) where the person files any specified form that requires the person who completes it to provide an address for service, by filing the specified form with the address for service stated on it; or
 - (b) in any other case, by notifying the Registrar in writing.
- (4) Where a specified form referred to in subsection (3)(a) is filed in the name of 2 or more persons, the address for service stated on that form shall be treated as the address for service of each of those persons.
- (5) An applicant for a patent or the proprietor of a patent may use only one address for service for the purposes of all proceedings before the Registrar concerning that application or patent.
- (6) Subject to any filing to the contrary under this section, on the grant of an application for a patent, the address for service of the applicant shall be treated as the address for service of the proprietor of the patent for the purposes of all proceedings before the Registrar concerning that patent.
- (7) Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings.
- (8) Where, after a person has become a party to proceedings before the Registrar, the person appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file an address for service.

(9) No act required or authorized by the Ordinance or these Rules to be done by or to a person referred to in subsection (8) in connection with the proceedings in question may be done by or to the newly appointed agent before the date on which he files an address for service.

(10) Any person may withdraw his address for service by notifying the Registrar in writing.

42A. Failure to file address for service

(1) Where an address for service is not filed as required by section 42, or where the Registrar is satisfied that the address for service of the proprietor of a patent or a party to any proceedings before the Registrar is no longer valid, the Registrar may send to the person concerned, at any of the addresses referred to in subsection (2), a notice to file an address for service.

(2) For the purposes of subsection (1), the addresses are—

- (a) any previously filed address for service of the person;
- (b) any address of the person in Hong Kong that is shown in the register;
- (c) any residential or business address of the person in Hong Kong; and
- (d) any other address of the person that is known to the Registrar.

(3) If any person to whom a notice is sent under subsection (1) fails to file an address for service within 2 months after the date of the notice—

- (a) any application (other than an application for a patent), notice or request filed by that person shall be treated as abandoned or withdrawn; and
- (b) the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party (other than as an applicant for a patent).

(4) This section is without prejudice to the operation of sections 17 and 68.”.

19. Alteration of name or address

Section 45(3) is amended by repealing “in the specified form” and substituting “made in the specified form or by notice in writing”.

20. Registration of transactions, etc., in relation to patents and patent applications

Section 46(2)(a) is amended by adding “or on behalf of” before “the assignor”.

21. Correction of errors in patents and applications under section 146 of the Ordinance

(1) Section 48(5) is amended by repealing “and be filed in duplicate”.

(2) Section 48(6) is repealed and the following substituted—

“(6) The opponent shall, at the same time as he files the notice, send a copy of the notice and the statement to the person making the request.

(6A) If the person making the request desires to proceed with the request, he shall, within 3 months from the date of the sending of the copies to him—

- (a) file a counter-statement in the specified form setting out fully the grounds on which he contests the opposition;
- (b) pay the prescribed fee; and
- (c) send a copy of the counter-statement to the opponent.”.

22. Request as to payment of renewal fee

Section 49 is repealed.

23. Sections amended

Sections 51(3) and 90(2) are amended by repealing “rule” and substituting “section”.

24. Section substituted

Section 52 is repealed and the following substituted—

“52. Order or direction by court

(1) Where the court makes any order or gives any direction under any provision of the Ordinance except section 46 or 102 of the Ordinance, the person in whose favour the order or direction is made or given shall file a sealed copy of the order or direction with the Registrar.

(2) Where the court makes any order under section 46 or 102 of the Ordinance, the person in whose favour the order is made shall file with the Registrar a copy of any documents referred to in the order that show the amendments to be made, together with such translations of those documents as may be required under section 56 of these Rules.

(3) The documents and translations referred to in subsection (2) shall be filed at such time as a copy of the order is filed with the Registrar in accordance with the order or direction made by the court or rules of court.”.

25. The language of proceedings before the Registrar

(1) Section 56(1) is amended by repealing “such translation to be certified to the satisfaction of the Registrar as corresponding to the original text” and substituting “and such translation shall state the name of the translator and his official capacity, if any”.

(2) Section 56(2)(c) is amended by adding “or in Chinese characters” after “if not in the Roman alphabet”.

26. Applications for the grant of short-term patents under section 113 of the Ordinance

(1) Section 58(5)(b) is repealed.

(2) Section 58(5)(c) is amended by repealing “verified”.

27. Size and presentation of documents

(1) Section 62(1)(a) is amended by repealing “direct”.

(2) Section 62(5) and (6) is repealed.

(3) Section 62(7) is amended by repealing “and such numbering shall be placed at the top of the sheet, in the middle, but not in the top margin”.

(4) Section 62(8) is repealed.

(5) Section 62(15) is amended by repealing “rule” and substituting “section”.

28. Procedure where applicant is not the inventor or sole inventor

Section 65(b) is repealed and the following substituted—

“(b) the Registrar shall send a copy of the statement to each inventor who is not one of the applicants.”.

29. Rectification of deficiencies in short-term patent applications

Section 68(1) is amended by repealing “verified”.

30. Claiming priority under section 111 of the Ordinance

(1) Section 69(3) is repealed and the following substituted—

“(3) The copy of the previous application as referred to in section 111(1) of the Ordinance shall be accompanied by a copy of a certificate issued by the authority that received the application and that states the date of filing of the application.”.

(2) Section 69(5) is amended by repealing “, instead of filing a verified copy of the previous application,”.

31. Agents

Section 85(4) and (5) is repealed and the following substituted—

“(4) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, which notice shall be given in the specified form or in writing.

(5) If a person who has given notice under subsection (4) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing.

(6) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subsection (4).

(7) The Registrar may refuse to recognize as an agent in respect of any business under the Ordinance or these Rules—

- (a) a person who has been convicted of a criminal offence;
- (b) a person whose name has been struck off the roll of barristers or roll of solicitors kept under and in accordance with the Legal Practitioners Ordinance (Cap. 159) or any person who has been suspended from acting as a barrister or solicitor;
- (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognize as an agent under paragraph (a) or (b);
- (d) a person against whom a disqualification order has been made under section 168E, 168F, 168G, 168H, 168J or 168L of the Companies Ordinance (Cap. 32);
- (e) a person against whom an order has been made under section 23(1)(a) or 24(1) of the repealed Securities (Insider Dealing) Ordinance (Cap. 395); or

(f) a person against whom an order has been made under section 214(2)(d), 257(1)(a), 258(1) or 303(2)(a) of the Securities and Futures Ordinance (Cap. 571).

Note: Section 140(4) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.”.

32. Request for information under section 147 of the Ordinance

Section 88(2) is amended by repealing “and shall be accompanied by the prescribed fee”.

33. Restriction on inspection of documents under section 147 of the Ordinance

Section 89(1) is amended—

- (a) in paragraph (d), by repealing “49, 50(2), 51(2) or 88” and substituting “50(2), 51(2) or 88 of these Rules”;
- (b) in paragraph (e), by repealing “and” at the end;
- (c) in paragraph (f), by repealing the full stop and substituting “; and”;
- (d) by adding—
 - “(g) subject to the restrictions prescribed in paragraphs (a) to (f), only documents kept by the registry shall be open to inspection.”.

34. Bibliographic information for purposes of section 147(3) of the Ordinance

Section 91 is amended by adding—

- “(ca) the address for service relating to the application;
- (cb) if the application has been filed by an agent, the name of the agent and the address in Hong Kong where he resides or carries on his business activities;
- (cc) the name and address of any person whose name and address the Registrar is required to communicate to any other person under section 3;”.

35. Section substituted

Section 93 is repealed and the following substituted—

“93. Filing of documents with the Registrar

(1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered by hand to the Registrar at the registry during the normal business hours of the registry or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the registry.

(3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the registry and is recorded as received.

93A. Electronic filing

(1) The Registrar may at his discretion permit, as an alternative to the filing of a document or other thing with the Registrar in a paper or other physical form, the filing of an electronic record of that document or thing.

(2) The Registrar may at his discretion permit, as an alternative to delivering or sending a document or other thing to the Registrar in the manner provided by section 93, the sending of an electronic record of that document or thing by electronic means to an information system designated by the Registrar.

(3) The filing of an electronic record, and the sending of an electronic record by electronic means to the information system designated under subsection (2), shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person desiring to file an electronic record or to send an electronic record to the Registrar by electronic means.

(4) Where, in accordance with this section, a document or other thing in the form of an electronic record is sent by electronic means to the information system designated under subsection (2), the filing of that document or thing shall be deemed to be effected at such time as that electronic record is accepted by the designated information system.

93B. Terms for electronic filing

(1) Without limiting the generality of section 93A(3), the Registrar may specify terms under that section—

- (a) providing for the approval by the Registrar of the process that must be used to make or send an electronic record;
- (b) providing for the approval by the Registrar of the format or media in which an electronic record must be recorded or stored;
- (c) respecting the manner of authenticating an electronic record in circumstances where the document or other thing in question is required to be signed or sealed or authenticated in any manner;
- (d) requiring any document or other thing sent to the Registrar in the form of an electronic record to include or be accompanied by the electronic signature or digital signature of the person who sends it; and
- (e) respecting the manner of filing a document or other thing in cases where there is an interruption in the operation of the information system designated under section 93A(2).

(2) Without limiting the generality of section 93A(3), the Registrar may refuse to accept or to register any document or other thing that is in the form of an electronic record if—

- (a) the information contained in the electronic record is not capable of being displayed in a legible form;
- (b) the electronic record is not capable of being stored in the information system designated under section 93A(2);
- (c) the electronic record appears to the Registrar to be altered, damaged or incomplete;
- (d) any electronic signature or digital signature or other kind of authentication accompanying or included with the electronic record appears to the Registrar to be altered or incomplete; or
- (e) any term specified by the Registrar under that section has been breached.

93C. Designation of electronic mail box

(1) On the request of any person, the Registrar may designate an electronic mail box within an information system designated by the Registrar which may be used by that person to communicate with the Registrar.

(2) The use by any person of an electronic mail box within the designated information system shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person for whom the electronic mail box is designated.

(3) Where the Registrar designates an electronic mail box for a person under this section, any document or other thing required or authorized by the Ordinance or these Rules to be sent by the Registrar to that person shall be deemed to be properly sent if it is sent in the form of an electronic record to that person's designated electronic mail box.

(4) Sending to a designated electronic mail box shall be deemed to be effected at such time as the electronic record is accepted by the designated information system.

(5) An electronic record sent to a designated electronic mail box shall be deemed to be received by the addressee at such time as the electronic record is accepted and recorded by that electronic mail box.

93D. Service of documents

(1) Except as provided by sections 93, 93A, 93B and 93C, where any document or other thing is required or authorized by the Ordinance or these Rules to be sent to any person—

- (a) the document or other thing may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document or other thing may be sent by post to his last known address.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the address for service of the person or, if he does not have an address for service, at his last known address, and unless the contrary is shown, the document or thing shall be deemed to have been received by that person at the time when the letter would be delivered in the ordinary course of post.

93E. Form in which the records of the registry are kept, etc.

(1) The Registrar shall determine the form in which the records of the registry are constituted and kept and may determine the period for which such records, or any document or other thing kept by the registry, shall be kept and the circumstances in which they may be destroyed or otherwise disposed of.

(2) Where the Registrar keeps a record of a document or other thing in a form that differs from that in which the document or thing was originally filed with, or originally generated by, the Registrar, the record of that document or thing shall be presumed, unless the contrary is shown, to accurately represent the information contained in the document or thing as originally filed or generated.”.

36. Alteration of time limits

Section 100(2) is amended by repealing “39(1),”.

37. Section added

The following is added—

“100A. Extension of time limits in the case of an interruption in the registry’s operations

(1) Where on any day there is an event or circumstances causing an interruption in the normal operation of the registry, the Registrar may notify the day as being one on which there is an interruption in the operations of the registry.

(2) Where any period of time specified in the Ordinance or these Rules, or as extended under these Rules, for the filing of any document or other thing with the Registrar expires on a day so notified, the period shall be extended to the first day next following (not being an excluded day) that is not so notified.

(3) Any notification given by the Registrar under this section shall be posted in the registry.

(4) In this section, “excluded day” (非辦公日) means a day that is not a business day of the registry.”.

38. Section substituted

Section 102 is repealed and the following substituted—

“102. Verification of documents

For the purposes of the Ordinance and these Rules, a filed copy of a document shall be treated as a verified copy if the person filing it confirms in writing to the Registrar that it is a true copy of a document issued by or kept at the relevant designated patent office.”.

39. Application under section 13(4) of the Transitional Rules

(1) Section 108(1) is amended by repealing “and shall be filed in duplicate”.

(2) Section 108(2) is amended by repealing “The Registrar shall send a copy of the application” and substituting “The applicant shall, at the same time as he files the application, send a copy of it”.

(3) Section 108(3) is amended by repealing “Registrar” and substituting “opponent”.

(4) Section 108(4) is amended by repealing “, shall be filed in duplicate”.

40. Section added

The following is added—

“113. Transitional provision relating to the Patents (General) (Amendment) Rules 2004

The amendments to sections 3, 4, 6, 7, 35, 37, 38, 40, 41, 48 and 108 of these Rules effected by sections 4, 5, 6, 12, 13, 14, 16, 17, 21 and 39 of the Patents (General) (Amendment) Rules 2004 (L.N. 37 of 2004) do not apply to proceedings pending before the Registrar on the commencement of those sections, which proceedings shall continue as if those amendments had not been made.”.

41. Micro-organisms

(1) Schedule 1 is amended, in paragraph 2(1), by repealing “and shall be filed in quadruplicate”.

(2) Schedule 1 is amended, in paragraph 2(2), by repealing “copies of the forms” and substituting “a copy of the form”.

42. Fees

Schedule 2 is amended—

(a) in Fee No. 1, in the third column, by repealing “700” and substituting “190”;

(b) in Fee No. 2—

(i) in the second column, by repealing “3(4), 4(4)” and substituting “3(7)”;

(ii) in the second column, by repealing “48(5) or (6)” and substituting “48(5) or (6A)”;

(iii) in the third column, by repealing “1,200” and substituting “325”;

(c) in Fee No. 3, in the third column, by repealing “700” and substituting “190”;

- (d) in Fee Nos. 4 and 5, in the third column, by repealing “1,400” and substituting “380”;
- (e) in Fee No. 6, in the third column, by repealing “2,800” and substituting “755”;
- (f) in Fee No. 7—
 - (i) in the second column, by adding “, under section 15 or 23 of the Ordinance” after “grant”;
 - (ii) in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette.” and substituting “68”;
- (g) in Fee No. 8—
 - (i) in the second column, by adding “under section 113 of the Ordinance” after “patent”;
 - (ii) in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette.” and substituting “68”;
- (h) in Fee No. 9—
 - (i) in the second column, by adding “, under section 11 or 21” after “grant”;
 - (ii) in the third column, by repealing “350” and substituting “95”;
- (i) in Fee No. 10—
 - (i) in the second column, by adding “under section 68(6)” after “patent”;
 - (ii) in the third column, by repealing “350” and substituting “95”;
- (j) in Fee No. 11—
 - (i) in the second column, by adding “under section 33 of the Ordinance” after “patent application”;
 - (ii) in the third column, by repealing “1,000” where it twice appears and substituting “270”;
- (k) in Fee No. 12, in the third column, by repealing “350” and substituting “95”;
- (l) in Fee No. 13—
 - (i) in the second column, by adding “under section 39 of the Ordinance” after “patent”;
 - (ii) in the third column, by repealing “2,000” where it twice appears and substituting “540”;
- (m) in Fee No. 14, in the third column, by repealing “1,000” and substituting “270”;
- (n) in Fee No. 15—

- (i) in the second column, by adding “under section 126 of the Ordinance” after “patent”;
- (ii) in the third column, by repealing “4,000” and substituting “1,080”;
- (o) in Fee No. 16, in the third column, by repealing “1,000” and substituting “270”;
- (p) in Fee Nos. 17 and 18, in the third column, by repealing “1,500” wherever it appears and substituting “405”;
- (q) in Fee No. 19, in the third column, by repealing “500” and substituting “135”;
- (r) in Fee No. 20, in the third column, by repealing “700” where it twice appears and substituting “190”;
- (s) in Fee No. 21, in the third column, by repealing “1,200” and substituting “325”;
- (t) in Fee No. 22, in the third column, by repealing “500” and substituting “135”;
- (u) by repealing Fee Nos. 23 and 24;
- (v) in Fee No. 25, in the third column, by repealing “800” and substituting “215”;
- (w) in Fee Nos. 26 and 27, in the third column, by repealing “700” and substituting “190”;
- (x) in Fee Nos. 28 and 29, in the third column, by repealing “350” wherever it appears and substituting “95”.

S. R. SELBY
Registrar of Patents

6 March 2004

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg. C) (“the principal Rules”) to facilitate the electronic filing and processing of patent applications, to streamline the procedures in the Patents Registry (“the registry”), to reduce the fees payable on the filing of documents with the registry and to delete obsolete provisions. The amendments relating to electronic filing and processing are in furtherance of the amendments made to the Patents Ordinance (Cap. 514) (“the Ordinance”) by the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Section 2(1) and (2) makes technical amendments to the definitions of “International Patent Classification” and “send” in section 2(1) of the principal Rules. Section 2(3) adds the new definitions of “digital signature”, “electronic record”, “electronic signature” and “information system”. The terms are used in the new sections 93A, 93B and 93C which are added by section 35 of these Rules. Section 2(4) and (5) repeals section 2(2)(a) and amends section 2(2)(b) of the principal Rules in consequence of the addition of the new sections 93A, 93B and 93C.
3. Section 3 adds the new section 2A to the principal Rules which will enable the Registrar of Patents (“the Registrar”) to accept electronic forms.
4. Section 4 replaces sections 3 and 4 of the principal Rules with a new section that consolidates the provisions of the two existing sections, with revisions. The new section 3 omits the requirement for certain documents to be filed in duplicate and requires the party initiating the proceedings, instead of the Registrar, to serve certain documents on interested parties.
5. Sections 5, 6, 13, 14, 16, 17, 21 and 39 amend sections 6, 7, 37, 38, 40, 41, 48 and 108 of the principal Rules to delete the requirements for certain documents to be filed in duplicate and to require the party initiating the proceedings, instead of the Registrar, to serve certain documents on interested parties.
6. Section 7 amends section 8(2)(a)(i) of the principal Rules to delete the requirement for the documents required under section 15(2)(a) of the Ordinance to be filed in duplicate.
7. Sections 8, 9, 10 and 27 amend sections 9, 12, 19 and 62 of the principal Rules to delete obsolete provisions relating to the form of documents.
8. Section 11(1) amends section 28(1) of the principal Rules to delete the requirement for a maintenance application to be signed by the applicant. Section 11(2) makes a technical amendment to the Chinese text of section 28(3) of the principal Rules.
9. Section 12(1) changes the time limit in section 35(1) of the principal Rules from 3 months to 6 months. Section 12(2) amends section 35(2) of the principal Rules. The amended section consolidates the requirements under section 43(1) of the Ordinance and adds a new requirement that the documents filed under that section be accompanied by a specified form and with such translations as may be required under section 56 of the principal Rules.
10. Section 15 repeals section 39 of the principal Rules. Section 36 makes a related consequential amendment to section 100(2) of the principal Rules.

11. Section 18 replaces section 42 of the principal Rules with two new provisions relating to addresses for service. The new section 42 requires a person who is concerned in any proceedings before the Registrar to file an address for service, which must be a residential or business address in Hong Kong, and provides for the manner of filing or withdrawing an address for service and for related matters. The new section 42A deals with the failure to file an address for service.
12. Section 19 amends section 45(3) of the principal Rules to allow the person making the request the option of filing a notice in writing instead of a specified form.
13. Section 20 amends section 46(2)(a) of the principal Rules to allow the application or notice for registration to be signed by a person on behalf of the assignor.
14. Section 22 repeals section 49 of the principal Rules.
15. Section 23 makes a technical amendment to sections 51(3) and 90(2) of the principal Rules.
16. Section 24 replaces section 52 of the principal Rules with a new provision that requires a person in whose favour any order or direction has been made or given by the court under any provision of the Ordinance (except section 46 or 102 of the Ordinance) to file a sealed copy of the order or direction with the Registrar and, in the case of an order made under section 46 or 102 of the Ordinance, a copy of other specified documents.
17. Section 25(1) amends section 56(1) of the principal Rules to delete the requirement for the translation to be certified and to require that the name and official capacity of the translator be given instead. Section 25(2) amends section 56(2)(c) of the principal Rules to delete the requirement for a transliteration of the name of the applicant if that name is in Chinese characters.
18. Section 26(1) repeals section 58(5)(b) of the principal Rules which requires an application for the grant of a short-term patent to contain the designation of the classification of the invention. Section 26(2) amends section 58(5)(c) of the principal Rules to delete the requirement for a verified copy of the previous application.
19. Sections 28 and 41 amend section 65(b) and paragraph 2 of Schedule 1 of the principal Rules, respectively, to delete the requirement for additional copies of the specified form.
20. Section 29 amends section 68(1) of the principal Rules to delete the requirement for a verified copy of the document.

21. Section 30 amends section 69(3) and (5) of the principal Rules to allow a copy of the certificate to be filed instead of the original and to delete the requirement for a verified copy of the previous application.
22. Section 31 amends section 85 of the principal Rules to require an agent to notify the Registrar of the address in Hong Kong where he resides or carries on his business activities and to revise the list of persons whom the Registrar may refuse to recognize as an agent.
23. Section 32 deletes the reference to the prescribed fee in section 88(2) of the principal Rules.
24. Section 33 adds section 89(1)(g) to the principal Rules to make clear that only documents that are kept by the registry are open to inspection. It also amends section 89(1)(d) in consequence of the repeal of section 49 of the principal Rules (see section 22 of these Rules).
25. Section 34 amends section 91 of the principal Rules to allow the Registrar to disclose under section 147(3) of the Ordinance the address for service and other specified bibliographic information relating to an unpublished application for a standard patent or short-term patent.
26. Section 35 replaces section 93 of the principal Rules with new provisions governing the filing and service of documents and the keeping of records by the Registrar. The new section 93 provides for documents to be delivered by hand or sent by post to the Registrar. The new sections 93A and 93B provide for the electronic filing of documents and enable the Registrar to specify the terms for electronic filing in the official journal. The new section 93C enables the Registrar to designate an electronic mail box which may be used by the person for whom it is designated to communicate with the Registrar. The new section 93D specifies the manner in which documents shall be served. The new section 93E allows the Registrar to determine the form and content of the registry's records and the circumstances in which records and documents may be disposed of.
27. Section 37 adds the new section 100A to the principal Rules which provides that if a deadline expires on the day on which there is an interruption in the normal operations of the registry, it shall be extended to the next business day.
28. Section 38 revises section 102 of the principal Rules to allow the person filing the document to confirm in writing to the Registrar that it is a true copy of a document issued by or kept at the relevant designated patent office.
29. Section 40 adds the new section 113 to the principal Rules which provides that the amendments to sections 3, 4, 6, 7, 35, 37, 38, 40, 41, 48 and 108 do not apply to proceedings pending on the commencement of those amendments.

30. Section 42 reduces certain fees set out in Schedule 2 to the principal Rules and makes technical amendments to some of the fee descriptions.