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A RE MERCK SHARP & DOHME LTD (AMENDMENT OF PATENT)

COURT OF FIRST INSTANCE
MISCELLANEOUS PROCEEDINGS NO 1626 OF 2001
KWAN J

B 6, 26 FEBRUARY, 1 MARCH 2002

COURT OF APPEAL
CIVIL APPEAL NO 186 OF 2002
ROGERS VP, LE PICHON AND CHEUNG JJA
7, 15 MAY 2002

C

Civil Procedure – Extension of time – Order to amend patent specification – One month to file notice of amendment with Registrar of Patents under statute – Whether court having jurisdiction to extend time – Whether Rules of High Court applicable so as to give jurisdiction to extend time – Rules of the High Court O 3 r 5 – Patents (General) Rules r 39(1)

D

Intellectual Property – Patents – Order to amend patent specification – One month to file notice of amendment with Registrar of Patents under statute – Whether court having jurisdiction to extend time – Points of principle concerning amendment of patent specifications – Rules of the High Court O 3 r 5 – Patents (General) Rules r 39(1)

E

民事訴訟程序 – 延展期限 – 下令修訂專利規格 – 根據法規而需要在一個月內將修訂通知書送交專利註冊處處長存檔 – 法庭是否享有司法管轄權延展期限 – 〈高等法院規則〉是否適用，以賦與司法管轄權延展期限 – 〈高等法院規則〉第3令第5條 – 〈專利(一般)規則〉第39(1)條

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知識產權 – 專利 – 下令修訂專利規格 – 根據法規而需要在一個月內將修訂通知書送交專利註冊處處長存檔 – 法庭是否享有司法管轄權延展期限 – 關乎專利規格修訂原則問題 – 〈高等法院規則〉第3令第5條 – 〈專利(一般)規則〉第39(1)條

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H The appellant applied for a European patent on 3 August 1990. A designated UK patent was granted in 1995 and a Hong Kong registration was registered in January 1997. An opposition to the European patent was filed and as a result the European patent was substantially amended in about 1999. Only in March 2001 did the applicant seek under s 46(1) of the Patents Ordinance (Cap 514) to amend the specification of its patent so that it would correspond with amendments made to the European (UK) patent. On 10 October 2001 Yuen J ordered that the Registrar of Patents should amend the specification of the patent in the manner provided in the order. Under r 39 of the Patents (General) Rules, the applicant had one month after the court order to file with the Registrar notice of the amendment. The court order was not sealed until 29 October and then there were

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postage delays as agents responsible for instructing the Hong Kong solicitors were in the Channel Islands so the necessary documentation was not filed until two days out of time. By this application, an extension of time under O 3 r 5 of the Rules of the High Court was sought to enable the applicant to file the documents, or alternatively under the inherent jurisdiction of the court. Kwan J held that the court did not have jurisdiction to extend time under the rules of court. The applicants appealed to the Court of Appeal.

Held, by the Court of First Instance, refusing the extension:

(1) The requirement and obligation to file the necessary documentation with the Register of Patents was imposed by r 39(1) of the Patents (General) Rules, not by an order of the court. Order 3 r 5 of the Rules of the High Court did not give the court jurisdiction to extend time in these circumstances (at 479F-480B).

(2) If the time limit were imposed by the court, not by statute, the court would have inherent jurisdiction to extend time in an appropriate case. But the time limit was imposed by r 39(1) of the Patents (General) Rules. There was nothing in the Patents Ordinance (Cap 514) or the subsidiary legislation to give the court power to extend time (at 480B-D).

(3) In a normal situation, where a time limit was laid down by statute and no power was given to extend it, the time limit should be strictly observed without being dispensed with, unless the substantive requirement itself could be dispensed with altogether. While it was desirable and in the public interest that the specification of the Hong Kong patent should be amended, the requirement and the time limit for giving effect to the court order as laid down by statute must be complied with. *Petch v Gurney (Inspector of Taxes)* [1994] 3 All ER 731 and *R v Weir* [2001] 2 All ER 216 applied (at 481F-482H).

On appeal to the Court of Appeal, held, dismissing the appeal:

(1) Save for the powers to extend time granted to the Register under the Patents (General) Rules, the time provided under r 39(1) of the Rules with which this case was concerned could not be extended. It was no accident that an extension of time was not permitted by statute. Prompt attention to amendments of patent specification had always been a feature of patent law. There was delay in approving the draft order and sealing the order. There was further unexplained delay in the postal system. The short answer was that time had expired and the High Court had no power to extend the time laid down in r 39(1) of the Patents (General) Rules (at 485D-486C).

Obiter

(2) One of the important factors taken into account in considering whether amendments to a patent specification should be allowed in common law jurisdictions, particularly the UK, was the conduct of the patentee. Delay was often an important factor in the exercise of the discretion. One factor which must be taken into account in Hong Kong was the failure of the patentee to seek a corresponding amendment promptly when an amendment had been made to the specification of the designated patent (at 484D-F).

(3) The matter was not argued on appeal, but it would be surprising if without considerable and detailed explanation, amendments were permitted by the Hong

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A Kong court in circumstances where the designated patent had been amended a long time previously as part of the application process. The patentee had not sought to explain the need for amendment. Prior art had not been shown, nor had evidence been provided to support the application. *Re Chevron Research Co's Patent* [1970] RPC 480 considered (at 484G-485A).

B (4) The Registrar of Patents did not appear, nor was he represented at the initial application to amend. He had the right of audience under s 131 of the Patents Ordinance. Applications to amend patent specifications were important. In this case, there might have been an important point of principle, namely whether the patentee should be permitted to amend in view of the very substantial delay before the application was made. These matters should have been brought to the attention of the court and the right of audience by and on behalf of the Registrar could have been exercised. It was not always sufficient for the Registrar to take a neutral stand in relation to such matters as amendment (at 485B-C).

Cases referred to

D *Chevron Research Co's Patent, Re* [1970] RPC 480, [1970] FSR 357
Petch v Gurney (Inspector of Taxes) [1994] 3 All ER 731, [1994] STC 689, [1994] 27 LS Gaz R 37 (CA)
R v Bloomsbury & Marylebone County Court, ex p Villerwest Ltd [1976] 1 All ER 897, [1976] 1 WLR 362, 120 Sol Jo 48 (CA)
R v Weir [2001] 2 All ER 216, [2001] 1 WLR 421 (HL)
 E *Smith v Peters* (1875) LR 20 Eq 511

Legislation referred to

F Patents (General) Rules (Cap 514C) rr 39(1), (2) 100(1)
 Patents Ordinance (Cap 514) ss 43, 46, 131, 132
 Rules of the High Court (Cap 4A) O 3 r 5

Other sources referred to

G *Supreme Court Practice 1999* Vol 1 para 29/1A/10
 Terrell *Law of Patents* (14th Ed) para 7.26

G [Editorial note: (i) the abbreviations 'r' and 's' for the word 'rule' or 'section' concerning the provisions of the Patent (General) Rules are used interchangeably in this report and as provided in the judgments; (ii) for an in-depth commentary on patent law in Hong Kong, see Pendleton, Garland & Margolis *The Law of Intellectual and Industrial Property in Hong Kong* (Butterworths) Vol 1, Division V; for amendment of patents and applications, see V[852] et seq.]

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Application and Appeal

I The applicant patent holder applied before Kwan J for an extension of time under O 3 r 5 of the Rules of the High Court, or alternatively under the inherent jurisdiction of the court, for filing with the Patents Registry an order made by I Yuen J on 10 October 2001 that the applicant's patent be amended to specifications provided in the order. The application was unsuccessful. The applicant appealed to the Court of Appeal. Both judgments at first instance and

on appeal are reproduced herebelow as one consolidated report. The facts appear sufficiently in the following judgments.

Paul Stephenson (Horvath & Giles) for the applicant/appellant.

Kwan J: 1. The applicant Merck Sharp & Dohme Ltd seeks an extension of time under O 3 r 5 of the Rules of the High Court, alternatively under the inherent jurisdiction of the court, that the time for filing all necessary documentation at the Patents Registry to give effect to the order of the court made on 10 October 2001 be extended up to and including 12 November 2001, so that r 39(1) of the Patents (General) Rules (Cap 514C) shall be deemed to have been complied with in all respects.

2. At the first hearing of this application, I raised with Mr Paul Stephenson, who appeared for the applicant, whether I have jurisdiction to extend time in this instance. As jurisdiction is an important matter, I have adjourned the application for Mr Stephenson to make further submissions after research.

3. The background of the application may be given as follows. By an originating motion issued on 23 March 2001, the applicant sought an order under s 46(1) of the Patents Ordinance (Cap 514), to amend the specification of its Patent No 81 of 1997 so that the Hong Kong patent shall correspond with the amendments made to the European (UK) Patent No 0 411 668 arising as a result of opposition proceedings filed against the European patent.

4. The relevant provisions of s 46 in Cap 514 read as follows:

(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.

...

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

...

(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.

5. Notice of application by the originating motion was given in the Gazette on 6 April 2001 and the notice was re-advertised on 14 September 2001 when the proposed amendment sought in the originating motion was amended. On 10 October 2001, Yuen J ordered that the Registrar of Patents shall amend the specification of Patent No 81 of 1997 in the manner as provided in the order. The order of the court was sealed on 29 October 2001.

6. Under r 39 of the Patents (General) Rules, it is provided *inter alia* as follows:

(1) The proprietor of a patent in respect of which the specification has been amended by court order under section 46 of the Ordinance shall, *within one month of the making of such a court order*, file with the Registrar notice of such amendment.

(2) A notice under subsection (1) shall be in the specified form and shall be accompanied by a verified copy of the court order together with any supporting documents. (emphasis supplied)

7. Because the sealed order was obtained on 29 October 2001, and there were delays in postage as the agents responsible for instructing the solicitors in Hong Kong are in the Channel Islands, the necessary documentation was not filed with the Registrar of Patents until 12 November 2001, when the applicant was two days out of time.

8. If it were within the jurisdiction of the court to extend time, I would have exercised my power to extend time in this instance, having regard to the reasons for delay and the short period of the delay. The question is whether I have jurisdiction to do so.

9. The first basis for counsel's submission that the court does have jurisdiction is O 3 r 5 of the Rules of the High Court and this provides as follows:

(1) The Court may, on such terms as it thinks just, by order extend or abridge the period within which a person is required or authorised by these rules, or by any judgment, order or direction, to do any act in any proceedings.

10. The time within which the applicant is required to file the necessary documentation with the Registrar of Patents is not fixed by the Rules of the High Court but by the Patents (General) Rules. Mr Stephenson submitted that the applicant is still within the scope of O 3 r 5 because the relevant words are:

The court may ... by order extend ... the period within which a person is required or authorised by ... any ... order ... to do any act in any proceedings.

11. He submitted that the time limit within which the applicant should file the necessary documentation with the Registrar is triggered by the order of the court made on 10 October 2001. I have no quarrel with that. I do not, however, accept the submission that the time limit in r 39(1) of the Patents (General) Rules is effectively imported by statute into the court order so that the time within which the documents must be filed could be regarded as a time limit ordered or required by the court. The fact remains that it is not part of the order of the court on 10 October 2001 that the applicant was required to file the necessary documentation with the Registrar within one month of the making of the order. The requirement

and obligation to do so was imposed by statute, not by an order of the court.

12. For the above reasons, I do not accept that O 3 r 5 would have given the court jurisdiction to extend time in this instance. I turn to consider the alternative basis for the court's jurisdiction, being the inherent jurisdiction of the court.

13. If the time limit to file the necessary documents were ordered by the court, and not imposed by statute, it is clear that the court would have jurisdiction to extend time in an appropriate case (see *R v Bloomsbury & Marylebone County Court, ex p Villerwest Ltd* [1976] 1 WLR 362). Here, the period within which that obligation is to be performed is imposed by r 39(1) of the Patents (General) Rules. There is nothing in the Patents Ordinance or the subsidiary legislation to give the court the power to extend time in this situation, notwithstanding that it is provided in s 149(2)(g) of the Ordinance that rules may make provision:

prescribing time limits for doing anything required to be done in connection with any such proceeding by this Ordinance or the rules and *providing for the alteration of any period of time specified in this Ordinance or the rules.* (emphasis supplied)

14. Mr Stephenson submitted that there are two alternative ways of approaching the question whether the court should have inherent jurisdiction to extend time. The first approach is that the court can extend time unless it is expressly prohibited by legislation from doing so. The alternative approach is that the court can only extend time if it is especially authorised by statute to do so. He has urged me to adopt the first approach. He also referred me to a passage in the *Supreme Court Practice 1999*, Vol 1, para 29/1A/10 on inherent jurisdiction in interlocutory injunctions containing the dictum of Jessel MR in *Smith v Peters* (1875) LR 20 Eq 511 in which his lordship stated at 513:

I have no hesitation in saying that there is no limit to the practice of the Court with regard to interlocutory applications so far as they are necessary and reasonable applications ancillary to the due performance of its functions, namely the administration of justice at the hearing of the cause.

15. I do not consider the above dictum to be of assistance in the present situation. Further, I do not think it is a matter of no significance that there is no provision in the Patents (General) Rules empowering the court to extend time in this instance, notwithstanding that it is specifically envisaged in s 149(2)(g) that rules may make provision for the alteration of any period of time specified in the Rules.

16. It is also pertinent to note r 100(1) of the Patents (General) Rules which relates to the alteration of time limit and is as follows:

(1) The times or periods prescribed by these Rules for doing any act or taking any proceeding under the Rules, *other than times or periods prescribed in*

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A *the provisions mentioned in subsection (2), may be extended by the Registrar [of Patents] if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted even though the time or period for doing such act or taking such proceeding has expired.* (emphasis supplied)

B 17. Rule 39(1) is one of the provisions referred to in r 100(2) and is thus not within the power of the Registrar of Patents to extend the time limit. Mr Stephenson submitted that r 100 should not affect the court's power to extend time and that it is unnecessary to specially provide for the power of the court to extend time because of the provisions of O 3 r 5 in the Rules of the High Court and the court's inherent powers. I do not accept his submission here.

18. I have also noted the provision in s 132 of the Ordinance which reads as follows:

132. General powers of the court

D (1) The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Ordinance, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

E 19. In view of r 100, the effect of which is that the Registrar is not empowered to extend time under r 39(1), I have grave reservations whether the court, in the exercise of its original jurisdiction under the Ordinance, may make an order to extend time, which is something that the Registrar of Patents is not empowered to do.

F 20. In view of the statutory provisions referred to above, what would be the basis for saying that the court should have power to dispense with the time limit provided in the statute? Mr Stephenson submitted that the statutory provisions should be interpreted purposively not restrictively because it is desirable for the Hong Kong patent to be amended in this instance so that it should fall in line with the European patent and that it is in the public interest that the public should not be misled as to the scope of the Hong Kong patent. I accept that it is desirable and it is in the public interest that the specification of the Hong Kong patent should be amended, that is why an order for amendment of the specification was made by the court on 10 October 2001. Nevertheless, the requirement and the time limit for giving effect to that court order as laid down by statute must be complied with. As stated by Millett LJ in *Petch v Gurney (Inspector of Taxes)* [1994] 3 All ER 731 at 738,

I Where statute requires an act to be done in a particular manner, it may be possible to regard the requirement that the act be done as mandatory but the requirement that it be done in a particular manner as merely directory. In such a case the statutory requirement can be treated as substantially complied with if the act is done in a manner which is not less satisfactory having regard to the

purpose of the legislature in imposing the requirement. But that is not the case with a stipulation as to time. If the only time limit which is prescribed is not obligatory, there is no time limit at all. Doing an act late is not the equivalent of doing it in time. That is why Grove J said in *Barker v Palmer* (1881) 8 QBD 9 at 10 — 'provisions with respect to time are always obligatory, unless a power of extending the time is given to the court'. This probably cannot be laid down as a universal rule, but in my judgment it must be the normal one. Unless the court is given a power to extend the time, or some other and final mandatory time limit can be spelt out of the statute, a time limit cannot be relaxed without being dispensed with altogether, and it cannot be dispensed with altogether unless the substantive requirement itself can be dispensed with.

21. The above dicta were approved and adopted by the House of Lords in *R v Weir* [2001] 2 All ER 216 and Lord Bingham had this to say at 222:

Where a time limit is laid down and no power is given to extend it, the ordinary rule is that the time limit must be strictly observed.

22. The statutory time limit with which the English Court of Appeal was concerned with in *Petch v Gurney* was the time limit within which a taxpayer was required to transmit the case stated by the special commissioner to the High Court in the context of a taxpayer's appeal against the commissioner's decision. The time limit that the House of Lords was concerned with in *Weir* was in the context of the Director of Public Prosecutions' application for leave to appeal to the House of Lords. These statutory provisions are of course very different. Nevertheless, it seems to me that the general observations in those two cases are applicable to the present situation. The court is not laying down a universal rule but in the normal situation, where a time limit is laid down by statute and no power is given to extend it, the time limit should be strictly observed without being dispensed with, unless the substantive requirement itself can be dispensed with altogether. If there is harshness in the statutory regime which gives no discretionary jurisdiction to the court to extend a time limit under any circumstances, the redress lies in amendment of legislation.

23. As I am not persuaded that it is within the inherent jurisdiction of the court to extend time in this situation, I must dismiss this application. I make an order *nisi* that there be no order as to costs.

[**Appeal:** The applicants appealed. The following is the judgment of the Court of Appeal.]

Rogers VP: 1. This was an appeal from a decision of Madam Justice Kwan handed down on 1 March 2002. The application before the judge was an application under O 3 r 5 of the Rules of the High Court, alternatively under the inherent jurisdiction, to extend time for filing an order at the Patents Registry. The order had been made by Madam Justice

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A Yuen (as she then was), ordering the Registrar of Patents to amend a patent specification. At the hearing of this appeal, the appeal was dismissed and this court indicated that it would give its reasons in writing which we now do.

B 2. The appellant, Merck Sharp & Dohme Ltd, originally applied for a European patent designated 0411668 on 3 August 1990. A designated UK patent was granted on 1 March 1995 and a Hong Kong registration HK0970081 was registered on 16 January 1997. The particulars which were available to this court showed that there was a filing date of the Hong Kong application of 17 December 1996.

C 3. An affidavit of Mark R Daniel, a United States patent counsel, who represents the appellant, indicated that an opposition to the European patent had been filed by Rotta Research Laboratium SpA. The result of the opposition was that the European patent was amended by deleting all the existing claims and inserting a new claim 1. It is unnecessary to set out the new claim for the purposes of these proceedings. It is sufficient to say that the amendment appears substantial. Mr Daniel's affidavit does not specify the date of amendment but the date of 11 November 1998 is given as the date of 'publication and mention of the opposition decision' in the copy of the patent specification which was exhibited to Mr Daniel's affidavit.

F 4. The rules relating to amendments are, in my view, important. Hong Kong does not have an examination office. In order to secure procedure in respect of patents which would be regarded as internationally acceptable in terms of examination and opposition, United Kingdom patents have for many years been registrable in Hong Kong. When the European Patent Office opened, European patents with United Kingdom designations became registrable in Hong Kong. The European system provides for early publication of patent applications. Opposition to patent applications can be made in circumstances where the final outcome may be delayed.

G 5. Under the patent regime as it existed in Hong Kong prior to July 1997, the registration of a patent in Hong Kong was dependent upon the patent in the United Kingdom because it was the rights and privileges granted in the United Kingdom which were extended to Hong Kong. Since June 1997, Hong Kong patents, once granted, have a life, independent of the designated United Kingdom patent. It can also be noted that once a European patent has been granted and opposition proceedings have been concluded, the United Kingdom patent itself is subject to United Kingdom patent law and any question of infringement, validity or amendment is decided in accordance with United Kingdom law. Likewise, once a patent has been granted in Hong Kong any question of infringement, validity or amendment is decided in accordance with Hong Kong patent law.

6. Since the hearing of this appeal, the appellant has submitted correspondence which would indicate that on 25 (or possibly 15) February 1999 a form P8, 'Request to make an Amendment' was submitted. Apparently this was intended to be in reliance upon s 43 of the Patents Ordinance. The Registrar of Patents informed the appellant's agent by letter of 3 March 1999 that s 43 did not apply to the present patent and that application for amendment should be made to court. It could also be observed that the P8 form was apparently dated more than three months after the publication and mention of the opposition decision.

7. Despite that, the present application was not launched until 23 March 2001. It was then that an originating motion was issued seeking to amend the specification of the Hong Kong patent. That application was made under s 46 of the Patents Ordinance. Section 46(1) gives the court a discretionary power to amend a specification patent. It reads as follows:

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.

8. One of the important factors which is taken into account in considering whether amendments should be allowed in common law jurisdictions, particularly the United Kingdom, is the conduct of the patentee: see, for example, para 7.26 *Terrell on the Law of Patents* (14th Ed). Delay by a patentee in seeking an amendment is often an important factor in the exercise of the discretion. Over and above that, one factor which must obviously be taken into account in Hong Kong is the failure of the patentee to seek a corresponding amendment promptly when an amendment has been made to the specification of the designated patent as part of the process of the grant of that patent.

9. Since the matter has not been argued on this appeal I do not propose to say more than that it would be surprising if, without considerable and detailed explanation, amendments were permitted by the court in circumstances where the designated patent had been amended a long time previously as part of the application process. This point is not without its significance, because the patentee has not sought to justify or explain the need for amendment, other than on the basis that there was an amendment to the designated patent. The court has not been shown the prior art and evidence has not been provided to support the application. In *Re Chevron Research Company's Patent* [1970] RPC 480, Graham J said at 586:

It is essential that those seeking amendment should realise that they have a heavy onus to discharge and can only expect to do so if they have full evidence to prove their case and put the whole story before the court.

It would appear that no relevant facts other than the fact of the amendment were drawn to the attention of Yuen J, at any rate in the documents

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A founding the application to amend, when the judge heard the matter on 10 October 2001.

10. In this respect I should draw attention to one further matter that, as also in this court, the Registrar of Patents did not appear and was not represented on that application. Under s 131 of the Patents Ordinance, the Registrar is given the right of audience in respect of any application which will affect the register. Applications to amend patent specifications are highly important. Often they involve technical matters. In the case of this application, there may have been an important point of principle, namely, whether the patentee should be permitted to amend in view of the very substantial delay before the application was made. These matters should have been brought to the court's attention and the right of audience by and on behalf of the Registrar could clearly have been exercised. It is clearly not always sufficient for the Registrar to take a neutral stand in relation to such matters as amendment.

D 11. The point of this appeal arises because under r 39 of the Patents (General) Rules:

- (1) The proprietor of a patent in respect of which the specification has been amended by court order under section 46 of the Ordinance shall, within 1 month of the making of such a court order, file with the Registrar notice of such amendment.
- (2) A notice under subsection (1) shall be in the specified form and shall be accompanied by a verified copy of the court order together with any supporting documents.

F 12. The patentee was two days late in filing the order of the court. Although s 100 of the Patents (General) Rules permits the Registrar to extend time under the Rules, the time provided under s 39(1) of the Rules may not be extended. It is no accident that an extension of time is not permitted. Prompt attention to amendments of patent specifications has always been a feature of patent law. The history of the events following the hearing on 10 October was that, according to the note on the court record, the draft order was not approved until 22 October. That delay in itself is regrettable, but as explained during the course of the hearing, it frequently happens that when an order is required urgently, draft orders can be approved and the order sealed in a matter of hours if not minutes. H For some unexplained reason, even when the draft order had been approved, the order was not sealed until 29 October. Thereafter, apparently, the order was sent by post to patent agents in Jersey whereupon it was returned with the documentation necessary for filing in the Patents Registry. It was said that there was a delay in the postal system. Even in respect of that, the position has not been fully or properly explained. Neither the date of posting from Hong Kong nor that from Jersey was set out in the evidence. Nor was it explained why a courier

service was not used, nor why the appellants' solicitors could not themselves have been authorised to sign the form P8.

13. The short answer to this appeal is that time had expired and the High Court has no power to extend the time laid down in s 39(1) of the Patents (General) Rules. The judgment of Kwan J has dealt with the matter more than adequately and fully and I do not propose to repeat what is stated therein. In addition to the matters dealt with by Kwan J, it was said that the court should treat the order of Yuen J as having been made on 29 October, being the date of sealing. That is, quite simply, wrong. The date of the order is the date upon which it was pronounced, namely, 10 October 2001. In the circumstances, the patentee will be unable to register the amendment permitted by the court.

Le Pichon JA: 14. I agree.

Cheung JA: 15. I agree.

Reported by Lindy Course

A HARBOUR FIT INDUSTRIAL LTD v TAN KWAI GARDEN SEAFOOD RESTAURANT LTD

COURT OF FIRST INSTANCE

ACTION NO 4535 OF 2001

B DEPUTY JUDGE SAUNDERS

16-17, 22 MAY 2002

C Intellectual Property – Passing off – Interlocutory injunction – Territoriality – Defendant restaurant in Hong Kong traded under same name as that of plaintiff in Shenzhen – Whether plaintiff's business physically present in Hong Kong necessary – Balance of convenience – Damages not adequate remedy in 'use of name' cases – Summary judgment effect considered – Delay of four months in seeking injunction – Whether application should be refused

D 知識產權 – 假冒 – 非正審強制令 – 領域性 – 被告人在香港經營的食肆的名稱與原告人在深圳的食肆的名稱相同 – 原告人是否需要在香港經營業務 – 相對方便的衡量 – 在「使用名稱」的案件中，損害賠償並不是足夠的補救方式 – 考慮簡易判決的效果 – 尋求強制令的申請延遲四個月 – 申請應否被拒絕

E This was an application by the plaintiff for an interlocutory injunction to stop the defendant using the name 'Tan Gwai Hin' for its restaurant until the main action for passing off was concluded. The plaintiff had operated three very successful restaurants in Shenzhen under the name 'Tan Gwai Hin' since 1995.

F The defendant was incorporated in Hong Kong in May 2001 and registered a restaurant business at Whampoa Garden. The first three characters of the defendant's name and the name under which it primarily styled itself as a restaurant were identical to that of the plaintiff's three restaurants. The plaintiff became aware of the alleged passing off soon after 11 June 2001. On 30 June 2001 the plaintiff issued a letter before action requiring the defendant to stop using the name 'Tan Gwai Hin' and make appropriate changes to its get-up within seven days. The defendant's director did not respond. On 24 July 2001 a second letter was sent repeating the plaintiff's demand and on 6 August a third letter was sent. The writ was not issued until 18 October 2001, about four months from the time the plaintiff became aware of the situation. There was a further delay of four months from the return day of the summons for interlocutory injunction before a hearing date for the summons was sought. It was not disputed for the purposes of this application that there was a serious issue to be tried. The court was concerned with whether damages would be a sufficient remedy to the plaintiff and the balance of convenience. The defendant contended that the plaintiff had been dilatory in conducting the action to the extent that the

I injunction should be denied.

Held, refusing the injunction:

IN THE COURT OF FINAL APPEAL OF THE
 HONG KONG SPECIAL ADMINISTRATIVE REGION
 MISCELLANEOUS PROCEEDINGS NO. 18 OF 2002 (CIVIL)
 (ON APPLICATION FOR LEAVE TO APPEAL FROM
 CACV NO. 186 OF 2002)

IN THE MATTER of the Patents Ordinance (Cap. 514) Section 46
 and in the matter Patent No. 81 of 1997

AND

IN THE MATTER of an application by Merck Sharp & Dohme
 Limited to amend the specification of Patent No. 81 of 1997 and to
 rectify the Register of Patents in respect thereof

Appeal Committee: Mr Justice Chan Atg CJ, Mr Justice Bokhary PJ and Mr Justice Ribeiro PJ

Date of Hearing: 20 September 2002

Date of Determination: 20 September 2002

DETERMINATION

Mr Justice Ribeiro PJ:

1. On 10 October 2001, on an application made by the present applicant, Yuen J made an order under s46 of the Patents Ordinance, requiring the Registrar of Patents to amend a Hong Kong patent of which the applicant is the proprietor.
2. However, the Registrar declined to enter that order on the register and so declined to effect any amendment. He did so on the ground that the order had been tendered out of time and that he lacked power to extend time. The applicant's challenge to the Registrar's position failed in the courts below for the reasons that are set out in the judgments of Kwan J and the Court of Appeal (both reported at [2002]2 HKC 475).
3. The applicant then sought leave to appeal to the Court of Final Appeal with a view to arguing that the Registrar was wrong to decline registration and that, contrary to his view, the Registrar has power to extend time for such registration by virtue of O3 r5 of the Rules of the High Court or the court's inherent jurisdiction.
4. After the papers applying for leave were lodged, the Registrar of Patents applied to a single judge of this Court for leave to intervene and, should leave be granted, to proceed as a party in the appeal. That application was referred to the Appeal Committee to be dealt with today.
5. Having considered the written submissions submitted, the Appeal Committee caused the Registrar of the Court to write to the parties prior to the hearing, informing them that the Appeal Committee wished to hear argument as to whether a point of great general or public importance arises in relation to the question whether s39(1) of the Patents (General) Rules and that part of s100(2) of those Rules as relates

to s3.) are *ultra vires*.

6. We are grateful to counsel for their submissions on this and the other issues. Mr Liao who appears for the Registrar has helpfully accepted that the question of *vires* is one of great general or public importance.

7. In the result, we grant the applicant leave to appeal subject to the usual conditions. We also grant leave to the Registrar of Patents to intervene and to participate in this appeal as a respondent.

(Patrick Chan)
Atg Chief Justice

(Kemal Bokhary)
Permanent Judge

(R A V Ribeiro)
Permanent Judge

Representation:

Mr Paul Stephenson (instructed by Messrs Horvath & Giles) for the applicant

Mr Martin Liao (instructed by the Department of Justice) for the Registrar of Patents