

**PATENTS (GENERAL) (AMENDMENT) NO.2 RULES 2002**

**Comments of The Hong Kong Institute of Trade Mark Practitioners (prepared by the Patents Sub-Committee) on the draft amendment**

1. The Institute fully supports the proposed amendment.
2. Although not mentioned in the papers that we have seen, one of the problems with the current Rule 39(1) is that while the one month deadline runs from the date of the Court order, the patentee is required to file within that period a verified copy of the order. In practice this has meant filing a sealed copy of the order and in some cases of which the Institute is aware the Court has only issued the sealed order close to the one month deadline (in one particular case only 3 days before the expiry of the one month deadline).
3. The proposed amendment to Rule 39 will solve the problem. Furthermore, it will cause no disadvantage to third parties as in practice there is no reason why a patentee should wish to delay filing the copy of the Court order. Having gone to the expense and trouble of obtaining permission from the Court to amend, it will always be in the best interest of the patentee to file the copy of the amendment at the Patents Registry as soon as possible.
4. However, although the Institute supports the proposed amendment, the Institute is disappointed that no further amendments are being proposed since Rule 39 is not the only problematic rule concerning post-grant patent amendments. Rule 35 in particular requires amendment.
5. Rule 35 concerns applications to amend under Section 43 of the Patents Ordinance where the designated patent has been amended following opposition proceedings in the designated patent office. The purpose of Section 43 is to require the

patentee to make an amendment in Hong Kong corresponding to any amendments made during the opposition proceedings. The Institute has no objection to the rationale behind Section 43, but the manner in which it is implemented in Rule 35 is unnecessarily harsh.

6. Rule 35 requires that an application to amend under S.43 be made within three months of the date of amendment in the designated patent office. Furthermore all necessary documentation (in particular a verified copy of the designated patent as amended) must be lodged within that three month period.
7. It is debatable whether it is necessary for any fixed period to be specified at all. S.43 requires that the patentee “shall” make the amendment in Hong Kong and if the patentee were not to do so it seems unlikely that the patentee would be able to enforce the Hong Kong patent. There is therefore a clear advantage for the patentee to do so.
8. If a fixed time period is thought to be beneficial (and we acknowledge that S.43 does refer to a “prescribed period”), then we would submit that the three month period is too short, especially given that all the formal documentation has to be completed within that period. In comparison the time limits allowed for filing a request to record (S.15(1) of the Patents Ordinance) and a request for registration and grant (S.23(2) of the Patents Ordinance) are both six months from the relevant date concerning the designated patent application. Furthermore it should be noted that the time limits of Ss.15(1) and 23(2) can both be met by providing minimum information only and all supporting documentation can follow later (see S.17 & S.24 of the Patents Ordinance).
9. Ideally we would like to see the removal of any fixed period for amending under S.43. However, we recognize that that may require amendment of the Ordinance

itself. In the short term a very significant benefit to patentees (without in any way harming the interests of third parties) could be obtained by amending Rule 35(1) to increase the prescribed period to at least six months.

10. We therefore recommend that this opportunity be taken to amend Rule 35(1) by replacing “the period of 3 months” with “the period of 6 months”.
11. A further practical difficulty that practitioners have faced is the finality of the six month deadline in S.23(2) of the Patents Ordinance. To our certain knowledge this deadline has often been missed by error either by the patent applicant or his representative leading to an unintentional loss of rights.
12. The Institute recognizes that to deal with this problem would require an amendment to the principal legislation and therefore could not be included in the present proceedings. However we would urge the Government to look at this problem urgently. One possible solution, for example, would be to remove the exclusion of S.24(2) from the restoration of rights provisions of S.29 of the Patents Ordinance (see S.29(5)). We would ask the Government to consider this possibility as soon as possible.