

**Submission of the Asian Patent Attorneys Association Hong Kong Group on Patents Ordinance (Cap. 514) Patents (General) (Amendment) (No. 2) Rules 2002 to the Legislative Council Subcommittee on Patents (General) (Amendment) (No. 2) Rules 2002**

**A. Rule 39**

1. (a) Our members welcome and support the removal of the one-month limit under section 39 of the Patents (General Rules) (“Rule 39”) for filing the notice of court order under Section 46 of the Patents Ordinance (“Section 46”) for amendment of patent specification.
  - (b) It will do away with the unnecessary hardship imposed on patentees, many of whom are overseas multi-national corporations. Decisions made by their legal or patent departments are often executed through external lawyers or patent lawyers attorneys overseas who in turn instruct Hong Kong lawyers or patent agents to process the application. Thus the taking, issuance and receipt of instructions have to go through several sets of people handling a matter and this takes time even with the availability of modern means of communication.
  - (c) Furthermore, the presence of a court order amending a patent specification, the notice of which cannot be filed with the Registrar for being out of time creates an unnecessary uncertainty on the effect of such court order and a self-imposed blockade preventing the general public from knowing the existence of such court order. This may affect prospective users of the patented invention or apparatus including competitors in the trade, prospective licensees and the general public who may need to ascertain the existence of relevant prior arts for research purposes.
2. One may ask what if the patentee neglects or refuses to register such court order. Section 81(5) of the Patents Ordinance provides :-

“(5) Without limiting the effect of subsection (4), where an order has been made by the court under section 46(1) allowing an amendment of the specification of a patent, no damages shall be awarded in any proceedings for an infringement of the patent committed after the date on which the order is made and before a copy of the order is filed with the Registrar for the purposes of section 46(5).”<sup>1 2</sup>

Any delay will be at the patentee’s own jeopardy. In the circumstances, it is in the vested interest of the patentee to have the court order registered as soon as possible and not to leave it unregistered.

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<sup>1</sup> Sections 46(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.”

<sup>2</sup> Section 46(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”

## **B. The Bigger Picture**

3. The general background leading to the present proposal for amendment lies in the short time frame laid down in the Patents (General) Rules for making amendments in Hong Kong corresponding to those effected to the parent at the designated patent office and the lack of jurisdiction for the Registry to extend time. While the present proposal for amendment should not be delayed, the overall system for processing amendment should be reviewed.
4. The procedure for amendments under the present system is that :-
  - (a) where the amendment does not result from an amendment in the designated patent office following opposition or revocation proceedings, an application to court under section 46 is required;
  - (b) where an amendment is consequential upon opposition or revocation proceedings in the designated patent office, the patentee may apply for amendment under section 43 of the Patents Ordinance by filing a verified copy of the amended specification provided that it be done within 3 months from the date of the amendment in the designated patent office [Rule 35(1) of the Patents (General) Rules].
5. Reality shows that many patentees were unable to make use of the procedure under section 43 because the 3 months' time limit imposed under Rule 35(1) was too short [see *Sumitomo Electronic Industries Limited [2000] 2HKC 293*] and *Re Merck Sharp & Dohme Limited [2001] HKEC 1246*] and Rule 100 of the Patents (General) Rules excludes the power of the Registrar to extend the time under Rule 35(1).
6. As a result, the expensive procedure of applying to Court under section 46 which deals with situations outside of section 43 including situations (a) where the Hong Kong amendment is not the result of amendments following opposition proceedings in the designated patent office and (b) where the patentee is out of time under section 43. Such procedure involves at least the appearance of counsel in open court on two occasions. This represents a waste of court's time as well as patentee's costs usually for no good reason as the cases reported so far have shown that they have been uncontested.
7.
  - (a) A practical approach which is cost and time efficient would be to have all the applications for amendments be dealt with by the Patents Registry in the first instance and only where the application is contested, the application be then referred to the Court. This, we believe, will take care of 99% of the cases.
  - (b) The above approach is suitable for Hong Kong. This is because in reality when dealing with standard patents, the Hong Kong Patents Registry is practically merely re-registering a patent which has been examined and processed in one of the designated patent offices. If an amendment has been duly examined and processed by such designated patent office, there is no reason why the corresponding amendment should not be made in Hong Kong following a set of prescribed procedures without going through a further examination process where it is uncontested.

- (c) The rationale for the different treatments under section 43 and section 46 is questioned and is proposed to be abolished.
  - (d) The approach remains consistent with the principle that a Hong Kong patent once granted has a life of its own under our new patent regime which came into force on the 27<sup>th</sup> June 1997 so that questions of amendment, validity and infringement are governed by Hong Kong law.
8. Pending the complete review and overhaul of the amendment procedures, perhaps a stop gap measure is to change the period of 3 months under section 43 for filing the amendment to 6 months. This will give practitioners enough time to make use of the procedure under section 43 at least for dealing with amendments consequential upon opposition or revocation proceeding in the designated patent offices. It should be noted that the obtaining of originals of the necessary patent documents from the relevant Designated Patent Office can take up time as normally there is only one file kept at such office which may be asked for by people from different sections eg. opposition, revocation, amendment, renewal sections.

**C. Another Vacuum**

9. One other aspect arising from section 46 is that vacuum in the legislation has been left opened since the 27<sup>th</sup> June 1997. While section 46(4) and 46(7) refer to rules of court in relation to the notice of opposition by any person and the notification of section 46 application to the Patents Registry, there are in fact no rules of the High Court in such connection which could be found. This has caused difficulty to practitioners and must be addressed as quickly as possible.
10. The Ruling of Hon. Chu. J. in *Re Wing Yick Bamboo Scaffolders Limited [2002] 1 HKC 395 or Re Wui Loong Scaffolding Works Company Limited [2002] 1 HKLRD 166* highlights the fact that our Order 103 which has not been updated or amended, cannot be used to work with the new provisions under our New Patents Ordinance.

I am instructed that the Law Society endorses and also adopts the above submissions.

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President  
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