

Comments of the Hong Kong Bar Association's  
'ad hoc' Committee on the Patents Bill

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Further to our meeting with the Administration on 29 February 1996 during which various technical aspects of the Bill were discussed, we would like to comment further on the following aspects of the Bill.

Amendment of standard patent following opposition or revocation proceedings in the designated patent office (Clause 43)

We remain of the view that there should be imposed on the patentee an obligation to amend the standard patent in Hong Kong within a prescribed period following the amendment of the corresponding designated patent in the designated patent office. This is because any such amendment should be promptly made by the patentee in the public interest. It would be wrong to allow the patentee to abuse the patent system by maintaining and even asserting against the public a monopoly which to his knowledge needs to be re-defined in its scope. The delay to amend is culpable because competitors and the general public are entitled to be promptly informed of any change in the ambit of a patent monopoly in order to plan their activities accordingly.

The Administration raises the concern that there may be no effective sanction to compel the patentee to amend within a prescribed period. In our view, this will not be so. If the patentee fails to amend within the prescribed period, he would have to apply to the Court to amend under Clause 46 (General power to amend specification after grant) or Clause 102 (Amendment of patent in infringement or revocation proceedings). Whereas the Registrar is bound to record an amendment under Clause 43, the Court has a discretion as to whether an amendment should be allowed under Clauses 46 and 102. In exercising its discretion, the

Court will take into account the patentee's conduct and in particular his delay in making the application to amend. The patentee will have to show reasonable grounds for his delay. If he sought to obtain an unfair advantage from a patent which he knew or should have known required amendment, the Court would not, in the exercise of its discretion, allow the amendment: Smith Kline & French Laboratories Limited v. Evans Medical Limited [1989] FSR 561. Further, conditions may be imposed by the Court when granting leave to amend (e.g., preventing suing for infringements committed prior to the application to amend). The Court's discretion to refuse amendment or to allow amendment subject to conditions would therefore serve as an effective sanction against the patentee as his patent without the amendment may stand invalid and is liable to be revoked or conditions may be imposed restricting his right to sue for past infringements.

43. 在指定專利當局進行反對或撤銷專利的  
法律程序後修訂標準專利

(1) 如在訂明的反對或撤銷專利的法律程序後，關乎根據第 II 部獲批予的標準專利的相應指定專利的說明書（不論在批予該標準專利之前或之後）已在指定專利當局修訂，則該標準專利的所有人須以訂明方式並在訂明期間內向處長提交一份經修訂的說明書或作出修訂的命令或其他訂明文件的核實副本。

(2) 處長須藉在註冊紀錄冊內記入適當的記項而將該項對指定專利的說明書所作的修訂記錄，而此項記錄一經作出，標準專利須視為已以同樣方式修訂。

(3) 處長須在標準專利根據本條修訂後在切實可行範圍內盡快——

(a) 發表該項修訂；

(b) 在憲報刊登該項修訂的事實的公告。

(4) 根據本條對標準專利的說明書作出的任何修訂，須自批予該專利的日期起具有效力。

(5) 根據本條對標準專利的說明書作出的任何修訂，須在不抵觸第 103 條的規定下具有效力。

[比照 EPC Art. 102]

43. Amendment of standard patent following opposition or  
revocation proceedings in the designated patent office

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

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

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

(a) publish the amendment;

(b) advertise the fact of the amendment by notice in the Gazette.

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

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

[cf. EPC Art. 102]