

HONG KONG BAR ASSOCIATION'S
COMMENTS ON
PATENTS (GENERAL) (AMENDMENT) (No.2) RULES 2002

1. Although an amendment to a patent specification is important as it affects public interest and ought to be registered as soon as possible, the proposed removal of the one-month time limit in *Section 39(1) of the Patents (General) Rules* is desirable. The bar to recovery of infringement damages in *Section 81(5) of the Patents Ordinance* seems adequate to deter any attempt not to register an amendment after a court order allowing the amendment is granted. If the time limit is not removed and a court order is not filed within time, there will exist a valid but unregistered court order for amendment in respect of which the Registrar cannot act. The unamended patent specification will continue to appear on the Register of Patents and will become misleading to the public. This state of affairs will likely be perpetuated. Hence we take the view that the time limit ought to be taken out, regardless of whether it is ultra vires.

2. An extension of time will not address the problem. A grant of time extension is always a matter of discretion and there will always be cases where a time extension is not granted. In the latter scenario, the same problem will be encountered. It would appear that the proper way to deal with the matter satisfactorily is to remove the time limit in *Section 39(1)* altogether.

Date prepared: 29th November 2002