

Bills Committee on the Patents (Amendment) Bill 2015

**Follow-up on the Bills Committee Meeting of 11 April 2016
Committee Stage Amendments proposed by the Government**

Purpose

At the meeting on 11 April 2016, Members considered a set of Committee Stage Amendments (CSAs) proposed by the Government (LC Paper No. CB(1)757/15-16(05). This paper takes stock of a few remaining issues, and provides an updated set of CSAs to be introduced by the Government (**Annex A**) and the corresponding mark-up version of the Patents Ordinance (**Annex B**) for Members' reference.

Remaining Issues

(A) Proposed section 89A(2) under clause 78 of the Bill

2. The proposed new section 89A introduces a requirement for the proprietor of an unexamined short-term patent who threatens infringement proceedings against another person to provide certain patent documents to any aggrieved party on request. This proposal seeks to facilitate the aggrieved party to make an informed decision on whether and how to respond to the threats.

3. At the meeting on 11 April 2016, the Government was requested to take into account the comments from deputations and consider possible refinements such as the proposed timeframe for responding to a request by the aggrieved party, bearing in mind that the party threatening enforcement proceedings should be well-prepared to substantiate its claim.

4. Taking into account the comments of the deputations and Members' views, the new section 89A(2) will be refined -

(a) Since the primary patent information is readily available free of charge from the online register of patents, we suggest confining the patent information to be provided to the aggrieved party to –

- (i) the patent number for identifying the patent; and
- (ii) any requested amendment to the specification of the patent that has been filed but has not yet been published.

- (b) The written request is to be accompanied by a copy of the proposed new section 89A so as to alert the patentee of the relevant statutory requirements for defending a claim on groundless threats, including the need to comply with the request for patent information.
- (c) The period for provision of patent information is extended from 7 days to within 14 days from the date of delivery of the written request or any longer period agreed to by the requestor of such information.

(B) Proposed section 127B

5. At the meeting of 11 April 2016, the Government was requested to consider revising its CSA to the proposed section 127B (under clause 120 of the Bill). It is suggested that the Chinese term “爭議” should be changed to “抗辯” to align with the relevant expression used in section 84 of the Patents Ordinance (Cap. 514).

6. The Chinese term “抗辯” means that a claim or accusation is resisted. It connotes a defensive concept. On the other hand, the Chinese term “爭議” refers generally to the process of accusing and defending. Having carefully considered the meaning of these terms, we take the view that “爭議” is more appropriate to refer to “the validity of the patent” (“專利的有效性”) being contested in legal proceedings in the context of the relevant section.

(C) CSAs proposed by Hon WONG Yuk-man

7. We appreciate Hon WONG’s efforts to improve the drafting of the Bill, we would provide detailed responses separately.

Presentation

8. Members are invited to note the information above.

**Commerce and Economic Development Bureau
Intellectual Property Department
April 2016**

Patents (Amendment) Bill 2015

Committee Stage

Amendments to be moved by the Secretary for Commerce and Economic Development

<u>Clause</u>	<u>Amendment Proposed</u>
5	By deleting subclause (8) and substituting— “(8) Section 2(2)— Repeal “standard patent (標準專利的申請)” Substitute “standard patent (R) (轉錄標準專利的申請) and standard patent (R) application (轉錄標準專利申請)”.”.
9(2)	In the Chinese text, by deleting “內或在任何原授標準專利申請內” and substituting “或原授標準專利申請內，”.
13	By adding— “(3) Section 10, paragraph (a)— Repeal everything after “designated patent office” Substitute a semicolon. (4) Section 10, paragraph (c)— Repeal everything after “designated patent application” Substitute “; and”.”.

- 24 In the English text, by deleting subclause (1) and substituting—
- “(1) Section 19(1)—
- Repeal**
everything after “the Registrar”
- Substitute**
“must examine the request to ascertain whether the requirements of section 15(2) and (3) (*formal requirements*) have been satisfied.”.”.
- 26 By adding—
- “(2A) Section 22(1)(b)—
- Repeal**
““a divisional corresponding designated patent application””
- Substitute**
“*divisional designated patent application*”.”.
- 31 In the English text, by deleting subclause (1) and substituting—
- “(1) Section 26(1)—
- Repeal**
everything after “the Registrar”
- Substitute**
“must examine the request to ascertain whether the requirements of section 23(3) and (4) (*formal requirements*) have been satisfied.”.”.
- 35 By adding—
- “(6A) Section 29(4)—
- Repeal**
“a notice”
- Substitute**
“an application”.

45 In the Chinese text, in the proposed Part 3, in the heading, by deleting
“原案授予的” and substituting “原授”.

45 In the proposed section 37A, in the definition of *non-Hong Kong application*, by adding “, other than a patent application under this Ordinance” after “or area”.

45 In the proposed section 37M(6), in the definition of *specified application*, in paragraph (a), by adding “, other than a patent application under this Ordinance” after “or area”.

78 In the proposed section 89A(2), by deleting paragraphs (a), (b) and (c) and substituting—

- “(a) the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent;
- (b) the patent is valid in the relevant respect; and
- (c) the defendant has complied with any access request for patent information made by the plaintiff before commencing the relief proceedings.”.

78 In the proposed section 89A, by adding—

- “(2A) For subsection (2)(c)—
 - (a) a request is taken to be an access request only if it is made in writing and is accompanied by a copy of this section;
 - (b) the defendant is taken to have complied with an access request only if the defendant provides the patent information as at the request date to the plaintiff, without charge, within 14 days from the request date or any longer period agreed to by

the plaintiff; and

- (c) the defendant is taken to have complied with an access request in relation to any patent information that the defendant has already provided to the plaintiff on or before the request date.”.

78 In the proposed section 89A(5), by deleting the definition of *patent documents* and substituting—

“*patent information* (專利資料), for a short-term patent, means—

- (a) the number assigned by the Registrar to the certificate of grant issued in respect of the patent under section 118(2)(b); and
- (b) a copy of any requested amendment to the specification of the patent that has been filed with the Registrar or the court, but not yet been published;”.

78 In the proposed section 89A(5), by adding—

“*request date* (請求日期) means the date of delivery of a request;”.

96 In the proposed section 108A, in the definition of *non-Hong Kong application*, by adding “, other than a patent application under this Ordinance” after “or area”.

106 In the proposed section 114(7), in the definition of *specified application*, in paragraph (a), by adding “, other than a patent application under this Ordinance” after “or area”.

120 In the proposed section 127B, by adding—

“(3A) No request for substantive examination of a short-term

patent may be made if—

- (a) a previous request for substantive examination of the patent has been made, and—
 - (i) the outcome of the substantive examination is still pending; or
 - (ii) that request has resulted in the issue of a certificate of substantive examination of the patent or in the revocation of the patent; or
- (b) the patent has been found by the court to be wholly valid in any proceedings in which the validity of the patent is contested.”.

120 In the English text, in the proposed section 127E(4), by deleting “are allowed” and substituting “is allowed”.

123 By deleting subclauses (3) and (4) and substituting—

“(3) Section 129—

Repeal subsection (2)

Substitute

“(2) In any enforcement proceedings—

- (a) it is for the proprietor of the short-term patent to establish the validity of the patent or a relevant respect of the patent (as the case requires) and the fact that the patent has been granted is of no account in that regard; and
- (b) in the absence of evidence to the contrary, any of the following is sufficient proof of the validity of the patent or a relevant respect of the patent—
 - (i) the certificate of substantive examination of the patent;
 - (ii) a certificate referred to in subsection (1)(c);
 - (iii) any evidence which is sufficient to

establish prima facie the validity of the patent or that respect of the patent (as the case requires).”.”.

123 By deleting subclause (5) and substituting—

“(5) After section 129(2)—

Add

“(3) In any enforcement proceedings, an application by the proprietor of the short-term patent for an injunction under section 80(1)(a) in interlocutory proceedings must be accompanied by a certificate or evidence referred to in subsection (2)(b)(i), (ii) or (iii).”.”.

129 By deleting the proposed section 144A(2)(e) and substituting—

“(e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—

(i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and

(ii) that is recognized by law or endorsed by the Government.”.

129 By deleting the proposed section 144A(4) and (6).

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	2	Interpretation	L.N. 234 of 2007	22/02/2008

(1) In this Ordinance, unless the context otherwise requires-

~~"application for a patent" (專利的申請) means an application for a standard patent or an application for a short term patent;~~

~~application for a patent (專利的申請) and patent application (專利申請) mean—~~

- ~~(a) an application for a standard patent (R);~~
- ~~(b) an application for a standard patent (O); or~~
- ~~(c) an application for a short-term patent;~~

~~application for a patent or other protection (專利或其他保護的申請) means an application for any of the following—~~

- ~~(a) a patent;~~
- ~~(b) the registration of a utility model;~~
- ~~(c) a utility certificate;~~
- ~~(d) an inventor's certificate;~~

~~application for a short-term patent (短期專利的申請) and short-term patent application (短期專利申請) mean an application under Part 15 for a short-term patent;~~

~~application for a standard patent (標準專利的申請) and standard patent application (標準專利申請) mean—~~

- ~~(a) an application for a standard patent (R); or~~
- ~~(b) an application for a standard patent (O);~~

~~application for a standard patent (O) (原授標準專利的申請) and standard patent (O) application (原授標準專利申請) mean an application under Part 3 for a standard patent (O);~~

~~certificate of substantive examination (實質審查證明書) means a certificate issued by the Registrar under section 127F in respect of a short-term patent;~~

"court" (法院) means the Court of First Instance; (Amended 25 of 1998 s. 2)

"date of filing" (提交日期)-

- (a) in relation to a request to record or a request for registration and grant, means the date which is the date of filing that request by virtue of section 17 or 24 respectively;
- (b) in relation to an application for a standard patent (R) has the meaning specified in relation to that term in section 3(ii);
- (c) in relation to a designated patent application, means the date specified as such in the designated patent application;
- (d) in relation to an application for a standard patent (O), means the date of filing accorded in accordance with section 37M;
- (e) in relation to an application for a short-term patent, means the date of filing accorded in accordance with section 114;

"Doha Declaration" (《多哈宣言》) means the Declaration on the TRIPS Agreement and Public Health adopted on 14 November 2001 by the Fourth WTO Ministerial Conference at Doha, Qatar; (Added 21 of 2007 s. 3)

"eligible importing member" (合資格進口成員地) means-

- (a) a WTO member country, territory or area recognized by the United Nations as being a least-developed country; or
- (b) any other WTO member country, territory or area that has given notice in writing to the TRIPS Council that it intends to import pharmaceutical products in accordance with the General Council Decision or the Protocol; (Added 21 of 2007 s. 3)

"employee" (僱員) means a person who works or (where the employment has ceased) worked under a contract of employment (whether with the Government or with any other person);

"employer" (僱主), in relation to an employee, means the person by whom the employee is or was employed;

"exclusive licence" (專用特許) means a licence from the proprietor of or applicant for a patent conferring on the

licensee, or on him and persons authorized by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application for a patent relates, and "exclusive licensee" (專用特許持有人) and "non-exclusive licence" (非專用特許) shall be construed accordingly;

"exporting member" (出口成員地) means a WTO member country, territory or area that makes a patented pharmaceutical product for export to an eligible importing member in accordance with the General Council Decision or the Protocol; (Added 21 of 2007 s. 3)

"General Council Decision" (《總理事會決定》) means the Decision adopted by the General Council of the WTO on 30 August 2003 on the Implementation of Paragraph 6 of the Doha Declaration; (Added 21 of 2007 s. 3)

"international application" (國際申請) means an international application for a patent made under the Patent Cooperation Treaty;

"International Bureau" (國際局) means the International Bureau of Intellectual Property provided for under the Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967;

"law of the designated patent office" (指定專利當局的法律) means-

- (a) in relation to a designated patent office established under the law of any country, territory or area other than Hong Kong, the law of that country, territory or area;
- (b) in relation to a designated patent office established under an international agreement, the provisions of the international agreement;

material date (關鍵日期) means—

- (a) for a standard patent (R) application, the date of filing of the corresponding designated patent application or, if priority is claimed, the date of priority;
- (b) for a standard patent (R), the deemed date of filing of the application for the patent or, if priority is claimed, the date of priority;
- (c) for a standard patent (O) application, the date of filing of the application or, if priority is claimed, the date of priority;
- (d) for a standard patent (O), the date of filing of the application for the patent or, if priority is claimed, the date of priority;
- (e) for a short-term patent application, the date of filing of the application or, if priority is claimed, the date of priority;
- (f) for a short-term patent, the date of filing of the application for the patent or, if priority is claimed, the date of priority;

"mortgage" (按揭) when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

"non-prejudicial disclosure" (不具損害性的披露) means, in relation to an invention, a disclosure of the invention which is not to be taken into consideration for the purposes of determining whether or not the invention forms part of the state of the art;

"official journal" (官方公報) means the publication for the time being specified under section 150A as the official journal of record; (Added 2 of 2001 s. 2)

"opposition or revocation proceedings" (反對或撤銷專利的法律程序) means, in relation to a designated patent, proceedings under the law of the designated patent office providing for the revocation or amendment of the designated patent within a specified period after the grant;

"Paris Convention" (《巴黎公約》) means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883, as revised or amended from time to time; (Amended 2 of 2001 s. 2)

"Paris Convention country" (巴黎公約國) means-

- (a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;
- (b) any territory or area subject to the authority or under the suzerainty of any country specified in Schedule

1 pursuant to paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;

~~"patent application" (專利申請) has the same meaning as an application for a patent;~~

"Patent Cooperation Treaty" (《專利合作條約》) means the treaty of that name done at Washington on 19 June 1970, as revised or amended from time to time; (Amended 2 of 2001 s. 2)

"patented invention" (專利發明) means an invention for which a standard patent or, as the case may be, a short-term patent is granted and "patented process" (專利方法) shall be construed accordingly;

"patented pharmaceutical product" (專利藥劑製品) means-

- (a) a pharmaceutical product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;
- (b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a pharmaceutical product obtained directly by means of the process or to which the process has been applied; (Added 21 of 2007 s. 3)

"patented product" (專利產品) means-

- (a) a product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;
- (b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a product obtained directly by means of the process or to which the process has been applied;

"pharmaceutical product" (藥劑製品) means-

- (a) a pharmaceutical product within the meaning of section 2(1) of the Pharmacy and Poisons Ordinance (Cap 138);
- (b) an active ingredient that is needed for making of a pharmaceutical product mentioned in paragraph (a); or
- (c) a diagnostic kit that is needed for the use of a pharmaceutical product mentioned in paragraph (a); (Added 21 of 2007 s. 3)

"prescribed" (訂明) means prescribed or provided for by rules made under section 149;

"protected layout-design (topography)" (受保護的布圖設計(拓撲圖)) has the meaning assigned to that term by section 2(1) of the Layout-design (Topography) of Integrated Circuits Ordinance (Cap 445);

"Protocol" (《日內瓦議定書》) means the Protocol Amending the TRIPS Agreement adopted by the General Council of the WTO at Geneva on 6 December 2005, the Annex to the Protocol Amending the TRIPS Agreement, the Annex to the TRIPS Agreement and the Appendix to the Annex to the TRIPS Agreement; (Added 21 of 2007 s. 3)

"register" (註冊紀錄冊、註冊)-

- (a) as a noun, means the register of patents kept under section 51; and
- (b) as a verb, means, in relation to any thing, to register or register particulars, or enter notice of that thing in the register and, in relation to a person, means to enter his name in the register,

and cognate expressions shall be construed accordingly;

"Registrar" (處長) means the Registrar of Patents;

"Registrar of Patents" (專利註冊處處長) means the person holding that office by virtue of the Director of Intellectual Property (Establishment) Ordinance (Cap 412);

"registry" (註冊處) means the Patents Registry administered by the Registrar;

"relevant instrument or legislation" (有關文書或法例) means-

- (a) the General Council Decision;
- (b) the Protocol; or
- (c) legislation made by the exporting member or the eligible importing member, as the case may be, pursuant

- to or for the purpose of implementing-
- (i) the General Council Decision; or
 - (ii) the Protocol; (Added 21 of 2007 s. 3)

"request for registration and grant" (註冊與批予請求) means a request under section 23 for the registration of a designated patent and the grant of a standard patent (R) for the invention shown in the published specification of the designated patent;

"request to record" (記錄請求) means a request under section 15 to record a designated patent application;

"right" (權利), in relation to any patent or patent application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

"rules" (規則) means rules made by the Registrar under section 149;

"short-term patent" (短期專利) means a patent for an invention granted under Part ~~XV~~15;

~~"short term patent application" (短期專利申請) means an application under Part XV for a short term patent;~~

"specification" (說明書), in relation to an application for a patent under this Ordinance, a designated patent application or an international application, means the description, claims and drawings contained in the application;

"standard patent" (標準專利) means ~~a patent for an invention granted under Part II—~~

- (a) a standard patent (R); or
- (b) a standard patent (O);

~~"standard patent application" (標準專利申請) means an application under Part II for a standard patent;~~

~~standard patent (O) (原授標準專利) means a patent for an invention granted under Part 3;~~

~~standard patent (R) (轉錄標準專利) means a patent for an invention granted under Part 2;~~

~~substantive examination (實質審查) means—~~

- (a) for a standard patent (O) application, an examination of the application under Division 5 of Part 3;
- (b) for a short-term patent, an examination of the patent under Division 5 of Part 15;

"TRIPS Agreement" (《知識產權協議》) means the Agreement on Trade-Related Aspects of Intellectual Property Rights, being Annex 1C of the World Trade Organisation Agreement; (Added 21 of 2007 s. 3)

"TRIPS Council" (知識產權理事會) means the Council for Trade-Related Aspects of Intellectual Property Rights referred to in Article 68 of the TRIPS Agreement; (Added 21 of 2007 s. 3)

"verified copy" (核實副本) means, in relation to a document, a copy verified in the prescribed manner;

"World Trade Organisation Agreement" (《世界貿易組織協議》) means the agreement of that name done at Marrakesh in 1994, as revised or amended from time to time; (Amended 2 of 2001 s. 2)

"WTO" (世界貿易組織) means the World Trade Organisation established in Geneva on 1 January 1995 under the World Trade Organisation Agreement; (Added 21 of 2007 s. 3)

"WTO member country, territory or area" (世界貿易組織成員國、地區或地方) means any country, territory or area for the time being specified in Schedule 1 as being a country, territory or area which has acceded to the World Trade Organisation Agreement.

(2) The expressions listed in the left-hand column below are defined in, or fall to be construed in accordance with, the provisions of this Ordinance listed in the right-hand column in relation to those expressions.

Expression	Relevant Provision
Application for a standard patent (R) (轉錄標準專利的申請) <u>standard patent (R) (轉錄標準專利的申請)</u> and <u>standard patent (R) application (轉錄標準專利申請)</u>	section 3
Corresponding designated patent (相應指定專利)	section 4

Corresponding designated patent application (相應指定專利申請)	section 4
Deemed date of filing (當作提交日期)	section 38
Designated patent (指定專利)	section 4
Designated patent application (指定專利申請)	section 4
Divisional designated patent application (指定專利的分開申請)	section 22(1)
Government use (政府徵用)	section 69(2)
Paris Convention country (巴黎公約國)	section 98(6)
Patent (專利)	section 6(1)
Published (發表)	section 5
Work (實施)	section 6(4)

Section:	10	General provision regarding applications for standard patents_		30/06/1997
		<u>(R)</u>		

Expanded Cross Reference:

15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27

Introduction

This Part shall be construed as providing for the grant of a standard patent (R) for an invention in the following circumstances, and only in those circumstances, namely where-

- (a) an application for a patent for that invention has been filed in and published by a designated patent office ~~(and in this Ordinance a patent application so filed and published is referred to as a "designated patent application");~~
- (b) as the first stage of an application for a standard patent (R), the designated patent application has been recorded in the register and published in Hong Kong in accordance with sections 15 to 22; < * Note-Exp. x-Ref: Sections 15, 16, 17, 18, 19, 20, 21, 22 * >
- (c) a patent has been granted in the designated patent office in pursuance of the designated patent application ~~(and in this Ordinance such a patent is referred to as a "designated patent"); and; and~~
- (d) as the second stage of the application for a standard patent (R), the designated patent has been registered in accordance with sections 23 to 27. < * Note-Exp. x-Ref: Sections 23, 24, 25, 26, 27 * >

Section:	19	Examination as to formal requirements of request to record		30/06/1997
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(1) If a request to record has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 15(4), the Registrar ~~shall must examine the request to ascertain whether the requirements of section 15(2) and (3) ("the formal requirements") have been satisfied;~~ must examine the request to ascertain whether the requirements of section 15(2) and (3) (formal requirements) have been satisfied.

(1A) If there are deficiencies in the request as regards the formal requirements that cannot be corrected, the standard patent (R) application must be refused.

~~(2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.~~

~~(3) If-~~

~~(a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a standard patent shall be refused;~~

~~(b) any deficiencies as regards the formal requirements noted in the examination are not corrected in~~

~~accordance with the rules then, except as provided in subsection (4), the application for a standard patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.~~

(2) If there are deficiencies in the request as regards the formal requirements that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.

(3) If any deficiencies referred to in subsection (2) are not corrected in accordance with the rules, then except as provided in subsection (4)—

(a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn;
or

(b) in any other case, the application must be refused.

(4) If a deficiency relating solely to a claim to any right of priority is not duly corrected, ~~such right shall be then~~ only the right is lost for the application.

[cf. EPC Art. 91]

Section:	22	Provision for request to record in the event of a divisional designated patent application		30/06/1997
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(1) Where in an application for a standard patent (R)-

(a) a request to record has been published under section 20 and has not been refused, withdrawn or deemed to be withdrawn; and

(b) the applicant for the corresponding designated patent application or his successor in title has filed in the designated patent office a divisional patent application ("~~a divisional corresponding designated patent application~~ divisional designated patent application"), that is to say, an application for a patent which-

(i) is in respect of the same subject-matter and does not extend beyond the contents of the corresponding designated patent application as filed in the designated patent office;

(ii) has as its date of filing the date of filing of the corresponding designated patent application; and

(iii) enjoys the same benefit of any right of priority as the corresponding designated patent application,

the applicant may within 6 months after the date of publication of the divisional designated patent application or publication of the request to record under this Ordinance, whichever is the later, request the Registrar to enter a record of that divisional designated patent application in the register.

(2) Subject to section 103(1), wWhere a request to record a divisional designated patent application is filed under this section-

(a) it shall be deemed to have been filed on the date of filing of the earlier request to record and the application for a standard patent (R) shall have the benefit of any right of priority;

(b) subject to paragraph (a), the provisions of this Ordinance shall apply to such a request as they apply to a request to record filed under section 15(1).

(3) For the purpose of the application of the other provisions of this Ordinance to this section-

(a) any reference in those other provisions to a corresponding designated patent application shall be read as a reference to the divisional designated patent application mentioned in subsection (1)(b);

(b) any reference in those other provisions to a corresponding designated patent shall be read as a reference to the designated patent granted in pursuance of the divisional designated patent application.

[cf. EPC Art. 76; 1992 No. 1 s. 24 Eire; 1977 c. 37 s. 15 U.K.]

Section:	26	Examination as to formal requirements of the request for registration and grant		30/06/1997
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(1) If a request for registration and grant has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 23(5), the Registrar ~~shall examine~~ must examine the request to ascertain whether the requirements of section 23(3) and (4) ("the formal requirements") have been satisfied. ~~must examine the request to ascertain whether the requirements of section 23(3) and (4) (formal requirements) have been satisfied.~~

(1A) If there are deficiencies in the request as regards the formal requirements that cannot be corrected, the standard patent (R) application must be refused.

~~(2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be~~

~~corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.~~

~~(3) If~~

~~(a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a standard patent shall be refused;~~

~~(b) any deficiencies as regards the formal requirements noted in the examination are not corrected in accordance with the rules then, except as provided in subsection (4), the application for a standard patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.~~

(2) If there are deficiencies in the request as regards the formal requirements that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.

(3) If any deficiencies referred to in subsection (2) are not corrected in accordance with the rules, then except as provided in subsection (4)—

(a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn;
or

(b) in any other case, the application must be refused.

(4) If a deficiency relating solely to a claim to any right of priority is not duly corrected ~~then such right shall be,~~ then only the right is lost for the application.

[cf. EPC Art. 91]

Section:	29	Restoration of rights	L.N. 40 of 2004	07/05/2004
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(1) Subject to this section, where-

(a) an applicant for a standard patent (R) has failed to comply with a time limit under this Part (including any time limit set by the Registrar); and

(b) the Registrar is satisfied that the failure to comply with the time limit occurred in spite of the applicant having taken all reasonable care required by the circumstances,

then upon application by the applicant to the Registrar under this section for restoration of his rights lost-

(i) ~~any refusal or deemed withdrawal of the application that occurred if the standard patent (R) application is refused, or is deemed to be or regarded as being withdrawn,~~ as a direct consequence of the failure to comply with the time limit ~~shall be deemed to be,~~ the refusal or withdrawal is of no effect and the application ~~shall be treated is to be regarded~~ for the purposes of proceedings under this Part as if there had been no such failure;

(ii) any right or means of redress lost by the applicant as a direct consequence of the failure to comply with the time limit ~~shall be~~ is to be restored to the applicant.

(2) An application under this section-

(a) shall be in writing and shall be made not later than-

(i) 1 year after the expiry of the time limit referred to in subsection (1)(a); or

(ii) 2 months after the removal of the cause of non-compliance with the time limit, whichever is the earlier;

(b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and

(c) shall not be deemed to be made unless the omission which constituted the failure to comply with a time limit has been made good.

(3) Where prior to the refusal or ~~deemed~~ withdrawal of the application mentioned in subsection (1)(i) the request to record had been published under section 20, the Registrar shall advertise in the official journal notice of any application under subsection (1). (Amended 2 of 2001 s. 14)

(4) The Registrar may by regulation amend the periods specified in subsection (2)(a) within which ~~a notice~~ an application under this section shall be filed.

(5) This section does not apply to any failure to comply with a time limit under section 15 (except as regards any time limit specified for the purposes of section 15(3)), 17(2), 18, 19, 22, 23(5), 24(2) ~~or 25(3), 25(4), 31(1), 32(1) or 33(2) or (4).~~

[cf. EPC Art. 122]

37A. Interpretation of Division 1 of Part 3

In this Division—

Hong Kong application (香港申請) means a standard patent (O) application or a short-term patent application;

non-Hong Kong application (非香港申請) means an application for a patent or other protection in or for a Paris Convention country or a WTO member country, territory or area, [other than a patent application under this Ordinance](#).

37M. Date of filing of standard patent (O) application

(1) For the purpose of according a date of filing to a standard patent (O) application, the Registrar must examine the application to ascertain—

(a) whether it complies with the requirement specified in subsection (3) (**minimum requirement**); and

(b) whether the prescribed filing fee and advertisement fee have been paid within the prescribed time.

(2) Subject to section 37N(3), the date of filing of a standard patent (O) application is the earliest date on which the application complies with the minimum requirement.

(3) The requirement specified for subsection (1)(a) is that the documents filed for the standard patent (O) application contain—

(a) an indication that a standard patent (O) is sought;

(b) information identifying the applicant; and

(c) either one of the following—

(i) something that appears to be a description of an invention;

(ii) a reference to an earlier specified application made by the applicant or the applicant's predecessor in title, together with a statement indicating that a description and the drawings (if any) of the invention, which is the subject of the standard patent (O) application, are completely contained in the specified application.

(4) If a date of filing cannot be accorded to a standard patent (O) application because of deficiencies in the application as regards the minimum requirement, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.

(5) If any deficiencies referred to in subsection (4) are not corrected within the prescribed time, the application must not be dealt with as an application for a standard patent (O).

(6) In subsection (3)(c)(ii)—

specified application (指明申請) means—

(a) an application for a patent or other protection in or for a Paris Convention country or a WTO member country, territory or area, [other than a patent application under this Ordinance](#);

(b) a standard patent (O) application; or

(c) a short-term patent application.

89A. Circumstances under which plaintiff not entitled to relief claimed

(1) Where a threat alleged an infringement of a standard patent, the plaintiff in the relief proceedings is not entitled to the relief claimed if—

(a) the defendant proves that the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent; and

(b) the plaintiff fails to prove that the patent is invalid in the relevant respect.

(2) Where a threat alleged an infringement of a short-term patent in respect of which a certificate of substantive examination has not been issued, the plaintiff in the relief proceedings is not entitled to the relief claimed if the defendant proves that—

(a) the defendant has, on request by the plaintiff before the commencement of the relief proceedings, provided to the plaintiff within 7 days after receiving the request—

(i) copies of all the patent documents without charge; or

(ii) a channel through which the plaintiff may obtain those copies without charge;

(b) the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent; and

(c) the patent is valid in the relevant respect.

(a) the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent;

(b) the patent is valid in the relevant respect; and

(c) the defendant has complied with any access request for patent information made by the plaintiff before commencing the relief proceedings.

(2A) For subsection (2)(c)—

(a) a request is taken to be an access request only if it is made in writing and is accompanied by a copy of this section;

(b) the defendant is taken to have complied with an access request only if the defendant provides the patent information as at the request date to the plaintiff, without charge, within 14 days from the request date or any longer period agreed to by the plaintiff; and

(c) the defendant is taken to have complied with an access request in relation to any patent information that the defendant has already provided to the plaintiff on or before the request date.

(3) Where a threat alleged an infringement of a short-term patent in respect of which a certificate of substantive examination has been issued, the plaintiff in the relief proceedings is not entitled to the relief claimed if—

(a) the defendant proves that the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent; and

(b) the plaintiff fails to prove that the patent is invalid in the relevant respect.

(4) This section only applies to relief proceedings brought in respect of a threat that is made on or after the commencement date of the Patents (Amendment) Ordinance 2015 (of 2015).

(5) In this section—

patent documents (專利文件), for a short term patent, means—

(a) the certificate of grant issued in respect of the patent under section 118(2)(b);

(b) the search report in relation to the invention, which is the subject of the patent, as referred to in section 113(1A)(d); and

(c) the specification of the patent as filed and as amended, together with any requested amendment to the specification that has been filed with the Registrar or the court (whether or not the amendment has been published);

patent information (專利資料), for a short-term patent, means—

(a) the number assigned by the Registrar to the certificate of grant issued in respect of the patent under section 118(2)(b); and

(b) a copy of any requested amendment to the specification of the patent that has been filed with the Registrar or the court, but not yet been published;

relief proceedings (濟助法律程序) means any proceedings brought by a person under section 89(1) in respect of a threat;

request date (請求日期) means the date of delivery of a request;

threat (威脅) means a threat referred to in section 89(1) to bring proceedings for an infringement of a patent.

108A. Interpretation of Division 1 of Part 15

In this Division—

Hong Kong application (香港申請) means a standard patent (O) application or short-term patent application;

non-Hong Kong application (非香港申請) means an application for a patent or other protection in or for a Paris Convention country or a WTO member country, territory or area, other than a patent application under this Ordinance.

Section:	114	Examination on filing	30/06/1997
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~~(1) The Registrar shall examine whether~~

~~(a) the short term patent application satisfies the requirements specified in subsection (2) for the accordance of a date of filing ("minimum requirements");~~

~~(b) the prescribed filing fee and advertisement fee has been paid in due time.~~

~~(2) The date of filing of a short term patent application shall be the earliest date on which documents filed by the applicant contain—~~

~~(a) an indication that a short term patent is sought;~~

~~(b) information identifying the applicant;~~

~~(c) a part which on the face of it appears to be a description of an invention.~~

~~(3) If a date of filing cannot be accorded because of deficiencies as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.~~

~~(4) If the deficiencies are not corrected within the time prescribed in the rules, the application shall not be dealt with as an application for a short term patent.~~

[cf. EPC Art. 80 & 90]

114. Date of filing of short-term patent application

(1) For the purpose of according a date of filing to a short-term patent application, the Registrar must examine the application to ascertain—

(a) whether it complies with the requirement specified in subsection (3) (*minimum requirement*); and

(b) whether the prescribed filing fee and advertisement fee have been paid in due time.

(2) Subject to section 114A(3), the date of filing of a short-term patent application is the earliest date on which the application complies with the minimum requirement.

(3) The requirement specified for subsection (1)(a) is that the documents filed for the short-term patent application contain—

(a) an indication that a short-term patent is sought;

(b) information identifying the applicant; and

(c) either one of the following—

(i) something that appears to be a description of an invention;

- (ii) a reference to an earlier specified application made by the applicant or the applicant's predecessor in title, together with a statement indicating that a description and the drawings (if any) of the invention, which is the subject of the short-term patent application, are completely contained in the specified application.
- (4) If a date of filing cannot be accorded to a short-term patent application because of deficiencies in the application as regards the minimum requirement, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.
- (5) If any deficiencies referred to in subsection (4) are not corrected within the prescribed time, the application must not be dealt with as a short-term patent application.
- (6) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 (of 2015), continues to apply to a short-term patent application filed with the Registrar before that date.
- (7) In subsection (3)(c)(ii)—
specified application (指明申請) means—
 - (a) an application for a patent or other protection in or for a Paris Convention country or a WTO member country, territory or area, other than a patent application under this Ordinance;
 - (b) a standard patent (O) application; or
 - (c) a short-term patent application.

127B. Request for substantive examination of short-term patents

- (1) The proprietor of a short-term patent may—
 - (a) request the Registrar to carry out a substantive examination of the patent; and
 - (b) subject to section 103(3), file a request to amend the specification of the patent at the same time.
- (2) Any other person may also request the Registrar to carry out a substantive examination of the patent if the person satisfies the Registrar that—
 - (a) there are reasonable grounds to suspect that the invention, which is the subject of the patent—
 - (i) is not new;
 - (ii) lacks an inventive step; or
 - (iii) is not susceptible of industrial application; or
 - (b) because of the person's legitimate business interests, it would be reasonable for the examination to be carried out.
- (3) A request for substantive examination of a short-term patent must—
 - (a) be made in the prescribed manner; and
 - (b) be accompanied by the prescribed fee.
- (3A) No request for substantive examination of a short-term patent may be made if—
 - (a) a previous request for substantive examination of the patent has been made, and—
 - (i) the outcome of the substantive examination is still pending; or
 - (ii) that request has resulted in the issue of a certificate of substantive examination of the patent or in the revocation of the patent; or
 - (b) the patent has been found by the court to be wholly valid in any proceedings in which the validity of the patent is contested.
- (4) A request for substantive examination of a short-term patent may not be withdrawn.

127E. Registrar must consider representations and requests for amendment, etc.

- (1) The Registrar must, in accordance with the rules—
 - (a) consider and decide—
 - (i) whether a representation filed under section 127D(3)(a) establishes that a short-term patent complies with an unfulfilled requirement; and
 - (ii) whether a requested amendment filed under section 127D(3)(b), if allowed, would enable the patent to comply with an unfulfilled requirement; and
 - (b) review the Registrar’s opinion on a request filed under section 127D(3)(c).
- (2) If the Registrar is of the opinion that a requested amendment filed under section 127B(1)(b) or 127D(3)(b), if allowed, would enable the patent to comply with an unfulfilled requirement, the Registrar must, in accordance with the rules—
 - (a) publish the requested amendment;
 - (b) consider any opposition to the amendment filed by third parties; and
 - (c) decide whether to allow the amendment.
- (3) If the Registrar thinks fit, the Registrar may refer the opposition proceedings to the court, and the court may allow the amendment by order, subject to any conditions that it thinks fit.
- (4) If the requested amendment filed under section 127B(1)(b) or 127D(3)(b) ~~are allowed~~ is allowed by the Registrar or the court, the Registrar must, in accordance with the rules—
 - (a) record and publish the amendment; and
 - (b) advertise the fact of the publication by notice in the official journal.
- (5) An amendment to the specification of a patent allowed under this section has effect as from the grant of the patent.

Section:	129	Court proceedings in relation to short-term patents	30/06/1997
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- (1) The proprietor of a short-term patent may only commence proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to the patent (**enforcement proceedings**) if—
 - (a) a certificate of substantive examination has been issued in respect of the patent;
 - (b) a request for substantive examination of the patent has been made under section 127B and the examination has not been terminated by a court order under section 101A(4)(b); or
 - (c) a certificate has been granted by a court under section 84(1), certifying the court’s finding that—
 - (i) the patent is wholly valid; or
 - (ii) if the enforcement proceedings relate to a relevant respect of the patent, the patent is valid in that respect.
- ~~(12) In any proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to a short term patent enforcement proceedings—~~
 - ~~(a) it is for the proprietor of the short term patent to establish the validity of the patent, and the fact that the patent has been granted under this Part shall be of no account in that regard;~~
 - ~~(b) evidence by the proprietor which is sufficient to establish prima facie the validity of the patent shall in the absence of evidence to the contrary be sufficient proof of such validity.~~
- (2) In any enforcement proceedings—
 - (a) it is for the proprietor of the short-term patent to establish the validity of the patent or a relevant respect of the patent (as the case requires) and the fact that the patent has been granted is of no account in that regard; and

(b) in the absence of evidence to the contrary, any of the following is sufficient proof of the validity of the patent or a relevant respect of the patent—

(i) the certificate of substantive examination of the patent;

(ii) a certificate referred to in subsection (1)(c);

(iii) any evidence which is sufficient to establish prima facie the validity of the patent or that respect of the patent (as the case requires).

~~(3) In any enforcement proceedings commenced under subsection (1)(b), an application by the proprietor of a short term patent for an injunction under section 80(1)(a) in interlocutory proceedings must be accompanied by—~~

~~(a) if a certificate of substantive examination has been issued in respect of the patent by the time of the application, the certificate of substantive examination;~~

~~(b) if a certificate, as referred to in subsection (1)(c), has been granted by the court by the time of the application, the certificate; or~~

~~(c) other evidence which is sufficient to establish prima facie the validity of the patent.~~

(3) In any enforcement proceedings, an application by the proprietor of the short-term patent for an injunction under section 80(1)(a) in interlocutory proceedings must be accompanied by a certificate or evidence referred to in subsection (2)(b)(i), (ii) or (iii).

~~(42) If in proceedings before the court under this Ordinance in relation to a short term patent, in enforcement proceedings, an order is made in interlocutory proceedings granting or refusing an application for an injunction under section 80(1)(a) or an order under section 80(1)(b), any party may apply to the court for an order that the matter proceed to early trial and, subject to compliance by that party with rules of court, the court shall so order unless it considers that the interests of justice would not be served by the making of such an order.~~

~~(53) A court making an order for an early trial under subsection (42)-~~

~~(a) may also make such order as respects the period before trial as the justice of the case requires;~~

~~(b) shall by the order determine the mode of trial.~~

~~(6) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 (of 2015), continues to apply to enforcement proceedings commenced before that date.~~

144A. Prohibition on use of certain titles and descriptions

~~(1) A person must not, in the course of or in connection with the person's business, trade or profession in Hong Kong, knowingly use or permit the use of a title or description specified in subsection (2).~~

~~(2) The title or description is—~~

~~(a) certified patent agent;~~

~~(b) registered patent agent;~~

~~(c) certified patent attorney;~~

~~(d) registered patent attorney; or~~

~~(e) a title or description that would be likely to give the impression that the person holds a qualification recognized by law or endorsed by the Government, for providing patent agency services in Hong Kong.~~

(e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—

(i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and

(ii) that is recognized by law or endorsed by the Government.

~~(3) Subsection (1) does not prohibit a person from using, or from permitting the use of, a title or description that—~~

~~(a) solely relates to the person's qualification for lawfully providing patent agency services in a jurisdiction outside Hong Kong; and~~

~~(b) clearly indicates the jurisdiction.~~

~~(4) Subsection (1) does not prohibit a qualified person from using, or from permitting the use of, the title solicitor, barrister, foreign lawyer, lawyer or counsel (as the case may be) in the course of or in connection with providing patent agency services in Hong Kong.~~

~~(5) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine of \$500,000.~~

~~(6) In subsection (4)—~~

~~**qualified person** (合資格人士) means a solicitor, barrister or foreign lawyer as defined by section 2 of the Legal Practitioners Ordinance (Cap. 159).~~