

## **Legislative Council Brief**

Patents Ordinance  
(Chapter 514)

### **PATENTS (AMENDMENT) BILL 2015**

#### **INTRODUCTION**

A At the meeting of the Executive Council on 20 October 2015, the Council ADVISED and the Chief Executive ORDERED that the Patents (Amendment) Bill 2015 (“the Bill”), at **Annex A**, should be introduced into the Legislative Council (“LegCo”) to provide for the legislative framework for –

- (a) establishing an “original grant” patent (“OGP”) system;
- (b) refining the existing short-term patent system; and
- (c) introducing an interim measure for regulating local patent practitioners.

#### **JUSTIFICATIONS**

##### ***Review of the local patent system***

2. To ensure that the local patent system would continue to meet present-day circumstances and that its further evolution would facilitate the development of Hong Kong into a regional innovation and technology hub, the Government commenced a review of the local patent system in October 2011. A three-month public consultation exercise was launched and the Advisory Committee on Review of the Patent System in Hong Kong (“Advisory Committee”) was set up.<sup>1</sup>

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<sup>1</sup> The Advisory Committee was tasked to advise the Government on –

- (a) how the Government should position Hong Kong’s patent system, having regard to the issues outlined in the public consultation paper of October 2011 and the responses received; and
- (b) how best to implement changes to the patent system, in the light of decisions made by the Government on the way forward.

The Hon Andrew LIAO is the Chairman. Members comprise government officials and non-official members from the patent-related fields, including legal professionals, patent practitioners, as well as members of the academic, R&D and industrial sectors.

3. Having carefully examined the views received in the public consultation exercise and the relevant circumstances, the Advisory Committee submitted a report to the Government in December 2012 with the following key recommendations –

- (a) introducing an OGP system for standard patents, with substantive examination outsourced to other patent office(s) as the starting point, whilst retaining the current re-registration system for grant of standard patents;
- (b) retaining the short-term patent system with suitable refinements; and
- (c) developing a full-fledged regulatory regime on patent agency services in the long run, which has to be achieved in stages, with possible interim measures.

4. The Government accepted the report and briefed the Panel on Commerce and Industry accordingly in February 2013 (vide LC Paper No. CB(1)534/12-13(05)). With Members' support, the Government has been following up with the implementation work, including the following tasks -

- (a) studying the patent systems, practices and procedures generally established in the international community;
- (b) engaging an external consultant to study important legislative and technical issues in the course of formulating the framework of the OGP system;
- (c) researching into and formulating the legislative proposals, and drafting the necessary provisions;
- (d) discussing with the State Intellectual Property Office in Mainland China ("SIPO") matters relating to substantive examination of patent applications and the training of personnel;
- (e) working with the Advisory Committee on implementation issues, notably the development of a full-fledged regulatory regime on patent agency services in the long run and suitable interim measures meanwhile; and
- (f) planning the electronic system in support.

5. The Bill provides for the legal framework for implementing the new patent system. In formulating the legislative proposals, we have taken into account the patent systems, practices and procedures generally established in the international community, including Australia, the Mainland, Singapore and the United Kingdom (“UK”), as well as several major regional and international patent treaties, such as the European Patent Convention and its Implementing Regulations, the Patent Co-operation Treaty and the Patent Law Treaty.

6. Other implementation tasks are also underway, including preparing proposals for subsidiary legislation to be made under the Bill, drawing up examination guidelines, designing workflows, and planning for the setting up of a new electronic system in support. Subject to the progress of the legislative exercise (paragraph 20 below) and other implementation tasks, we plan to implement the new patent system in 2017 at the earliest.

### ***Key proposals of the Bill***

#### *(A) Introducing an OGP route for granting standard patents*

7. The Bill introduces new provisions into the Patents Ordinance (Cap. 514) (“the Ordinance”) to allow an applicant to apply for a standard patent under a new OGP route along the procedures set out in the following paragraphs. From the users’ perspective, the main difference between this new OGP system and the existing “re-registration” system<sup>2</sup> for standard patents (which will be retained) is that the OGP system would enable applicants to file applications for a standard patent directly in Hong Kong without first obtaining a patent from a designated patent office outside Hong Kong.

8. Upon receipt of an OGP application, the Registrar of Patents (“Registrar”) would conduct formality examination to ensure that the application is in order for publication. If the application fulfils the minimum filing requirements<sup>3</sup>, the Registrar would accord the date of filing. The Registrar would then examine whether the application has also satisfied other

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<sup>2</sup> See paragraph 26 for background.

<sup>3</sup> To fulfill the minimum filing requirements, the application should contain –

- (a) an indication that a standard patent under the OGP route is sought;
- (b) information identifying the applicant; and
- (c) a document that appears to be a description of an invention, or a reference to a previously filed application of the invention.

formal requirements<sup>4</sup>. In the process, the Registrar would, if necessary, issue a deficiency notice to the applicant for rectifying any deficiency. Upon passing the formality examination, the application would generally be published by the Registrar after expiry of certain prescribed time.

9. Following publication of the application, the Registrar, upon request by the applicant, would proceed with substantive examination to determine whether the application has satisfied the prescribed requirements<sup>5</sup> (“examination requirement”) for a patent grant. If a third party files observations with respect to an application within a prescribed period, the observations would also be considered by the Registrar during substantive examination. The Registrar may raise objection if the application does not fulfill any examination requirement. The applicant may file submissions or propose amendments to the specification and claims to address the objection. The applicant may also request the Registrar to review the objection. The Registrar must, in accordance with the prescribed procedures, consider whether the filed submissions and proposed amendments have overcome the objection, and review the objection (where applicable). If the application, upon substantive examination, is found to satisfy all the examination requirements, the Registrar would grant the standard patent and publish the grant accordingly. If not, the application will be refused.

10. As Hong Kong has yet to develop indigenous capacity for conducting substantive examination for which it has no practical experience, the Intellectual Property Department (“IPD”) entered into a cooperative arrangement with SIPO in December 2013 under which SIPO agreed to provide technical assistance and support to IPD in conducting substantive examination of patent applications and manpower training under the new patent system. Depending on the users’ acceptance of the new patent system and their filing demands, IPD plans to develop in incremental stages in-house capacity in conducting indigenous substantive examination in the medium to long term, starting with the niche areas where Hong Kong has acquired considerable expertise or where Hong Kong is well placed to enhance its research and development capabilities.

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<sup>4</sup> To fulfill the formal requirements, the application should contain among others –

- (a) the name and address of the applicant(s) and the inventor(s);
- (b) a statement indicating the derivation of the applicant’s entitlement if any applicant is not an inventor;
- (c) an address in Hong Kong for service of documents;
- (d) a specification that provides for –
  - (i) a description of the invention;
  - (ii) at least one claim;
  - (iii) any drawing referred to in the description or the claim;
- (e) an abstract;
- (f) where applicable, documents for claiming priority and non-prejudicial disclosure.

<sup>5</sup> Including the patentability requirements, see footnote 13 below.

*(B) Refining the short-term patent system*

11. We have accepted the Advisory Committee's recommendations on refining the system in the following manner -

- (a) substantive examination of a short-term patent should be made a prerequisite to commencement of enforcement action;
- (b) the proprietor of a short-term patent or a third party having a legitimate concern or doubt about the validity of the patent should have the right to apply to the Registry for substantive examination of the patent;
- (c) the proprietor of a short-term patent, when making a threat of infringement proceedings, should furnish with the person to whom the threat was made full particulars about the short-term patent in question, failing which the threat of proceedings may be regarded as groundless and a party aggrieved by the threat will be entitled to seek relief; and
- (d) the possibility of allowing more than one independent claim<sup>6</sup> should be further explored.

12. Accordingly the Bill introduces new provisions into the Ordinance for implementing appropriate measures. The provisions will lay down the procedural framework for substantive examination of short-term patents, such as who may apply for substantive examination, the legal and procedural requirements for making such applications and for conducting the substantive examination, and the amendment of the short-term patents granted. The provisions will also set out the prerequisites for a short-term patent owner to commence enforcement action<sup>7</sup>. The existing provisions on groundless threats

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<sup>6</sup> A claim in a patent application in essence identifies the specific elements of the underlying invention for which the patent applicant claims rights and seeks protection. An independent claim, as opposed to a dependent claim, refers to a claim that does not rely upon or refer to any other claims. Currently, only one independent claim may be included in each short-term patent application.

<sup>7</sup> The Bill will provide that, if a short-term patent has not yet been issued with a certificate of substantive examination by the Registrar, or a certificate certifying the patent's validity by the court, the patent owner may only commence enforcement proceedings if a request for substantive examination of the patent has been made. The Bill will also provide the following safeguards against potential abuse of such proceedings –

- (a) once a request for substantive examination is made by the owner of a short-term patent, such request cannot be withdrawn;
- (b) the court may stay any enforcement proceedings in which validity of a short-term patent is put in issue pending the outcome of the substantive examination of the short-term patent concerned; and
- (c) a short-term patent owner may only apply for an interlocutory injunction in enforcement proceedings if the application is accompanied by evidence sufficient to establish prima facie the validity of the patent.

The proposal has taken into account views of some of the major local professional bodies that if completion

of proceedings and the onus of proof of validity or invalidity of short-term patents in such proceedings will also be refined in view of the proposed inclusion of substantive examination as a new feature of the short-term patent system.

13. In addition, having explored the possibility of relaxing the number of independent claims in a short-term patent application, we propose to allow a short-term patent application to contain up to two independent claims, provided that both claims relate to one invention or a group of inventions forming a single inventive concept. The proposed relaxation seeks to strike a reasonable balance between having a short-term patent system mainly to cater for relatively simple inventions with a limited commercial life span on the one hand, and allowing for some flexibility for users to acquire a short-term patent with not more than two independent claims without restricting the types or classes of such claim at a reduced cost on the other.<sup>8</sup>

*(C) Implementing an interim measure for regulating local patent practitioners pending establishment of a full-fledged regulatory regime*

14. A prime objective to regulate local patent practitioners is to nurture a strong patent profession as a complementary component of the new patent system. This would require the development of a full-fledged regulatory regime covering aspects such as the establishment of a professional regulatory body, accreditation, use of titles, professional discipline, training, service monopoly, and statutory backing. The Advisory Committee has been deliberating on these long-term issues and engaging stakeholders. Further work needs to be done.

15. Meanwhile, the Advisory Committee, having focused on what interim measures should be included into the current package of legislative proposals for implementation in tandem with the new patent system, has recommended that regulation on the use of certain titles should be put in place as an interim measure so as to prevent misuses of attractive titles which may not only confuse service users before an accreditation system is set up under the future full-fledged regulatory regime, but also pre-empt the outcome of such a future regime in the long run.

16. Accordingly, the Bill contains new provisions to reserve certain specific titles which may likely be conferred on qualified patent practitioners

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of substantive examination was made a prerequisite to enforcement, that could cause significant delay in enforcement thereby undermining the main benefit of the short-term patent system, having regard to the relatively short eight-year protection term.

<sup>8</sup> Reference has been made to the respective lesser patent systems (akin to the local short-term patent system) in several overseas jurisdictions including Australia, the Mainland China, Germany, Denmark and Japan.

exclusively under the future regulatory regime. An interim regulatory measure is introduced to make it an offence to use these titles<sup>9</sup>, as well as any other title or description that would likely give the impression that a person's qualification for providing patent agency services in Hong Kong is endorsed by the Government or recognized by law. Appropriate exemption would be introduced to cater for the legitimate and reasonable use in Hong Kong of professional titles that have been lawfully acquired outside Hong Kong.<sup>10</sup>

*(D) Other technical amendments*

17. We propose amendments to the Ordinance to clarify the policy intent that inventions relating to second or further medical uses could be regarded as new and thus patentable.<sup>11</sup> The Bill also include other technical and miscellaneous amendments.

## THE BILL

18. The main provisions of the Bill are as set out below -

- (a) **Clause 11** adds a new Part 1A on patentability, right to patent and mention of inventor. The new Part is based on existing sections 45, 93, 94, 96, 97 and 100, which will be repealed (by Clauses 52 and 83). The new Part adds, amongst others, a new section 9B to address novelty of inventions, including those relating to second or further medical uses (see paragraph 17 above);

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<sup>9</sup> Having considered the views of the Advisory Committee, we intend to prohibit the use of the following specific titles: "registered patent agent", "registered patent attorney", "certified patent agent" and "certified patent attorney".

<sup>10</sup> The Bill also contains provisions to make it clear that the use of the title "solicitor", "barrister" or "foreign lawyer" by qualified legal practitioners in Hong Kong in providing patent agency services will not be caught by the new regulatory provisions.

<sup>11</sup> An invention relating to second medical use generally refers to subsequent discovery of use of a known substance or composition (which has already been used for medical treatment or diagnosis of certain disease or condition, i.e. first medical use) for medical treatment or diagnosis of another disease or condition, and such second medical use was previously unknown. One of the patentability requirements under the Patents Ordinance is that an invention must be new. Section 94(4) specifically addresses the novelty requirement concerning the patenting of a known substance or composition for first medical use and provides that an invention consisting of such substance or composition is still regarded as new if such substance or composition has not been known before for any medical use. While the existing statutory provisions on novelty does not expressly cover inventions relating to second medical uses, the local court (Court of First Instance) has recognised that such inventions may be patentable through the use of an indirect drafting approach known as the "Swiss-type claim". We see merits in updating the law to make clear the policy intention and to enable patent applicants to seek protection of inventions relating to second medical uses in Hong Kong through a simpler and more direct form of claim drafting.

- (b) **Clause 45** adds a new Part 3 (new sections 37A to 37ZD) to provide for the legal and procedural framework for the application, examination and grant of OGP (see paragraphs 8 and 9 above);
- (c) **Clause 78** adds a new section 89A to provide, among other things, the matters that a defendant is required to prove in relief proceedings brought by a person in respect of a threat of infringement proceedings made by the defendant. If the defendant fails to do so, the person would be entitled to the relief claimed (see paragraph 11(c) above);
- (d) **Clauses 120** adds new sections 127A – 127G to provide for the legal and procedural framework for substantive examination of short-term patents (see paragraphs 11(b) and 12 above);
- (e) **Clause 123** amends section 129 to provide that in certain cases, a request for substantive examination of a short-term patent is a prerequisite for commencing enforcement proceedings in relation to the patent (see paragraph 11(a) and 12 above);
- (f) **Clause 129** adds a new section 144A to prohibit the use of certain titles and descriptions as the interim regulatory measures for local patent practitioners (see paragraphs 15 and 16 above).

19. An extract of the provisions of the Ordinance that are being amended by the Bill is attached at **Annex B**.

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## LEGISLATIVE TIMETABLE

20. The legislative timetable is as follows –

Publication in the Gazette	30 October 2015
First Reading and commencement of Second Reading debate	11 November 2015
Resumption of Second Reading debate, committee stage and Third Reading	To be notified



## IMPLICATIONS OF THE PROPOSAL

C 21. The proposal has economic, financial, civil service and sustainability implications as set out in Annex C. Our proposal has no competition, environmental, family, gender and productivity implications. It is in conformity with the Basic Law, including the provisions concerning human rights. It will not affect the current binding effect of the Patents Ordinance.

## PUBLIC CONSULTATION

22. In formulating the legislative proposals described above, we have benefited from further input of the Advisory Committee. In addition, IPD has set up a focus group comprising representatives of the major local professional bodies and reached out to others for soliciting their views as appropriate. Notably, on the regulation of patent practitioners, a round of stakeholders' consultation was conducted from March to May 2013. Having considered the stakeholders' submissions, the Advisory Committee has further set up a dedicated working group<sup>12</sup> to engage the major local professional bodies for their views on the interim regulatory measures for the profession. The current proposal has taken into account views of the Working Group and the Advisory Committee.

23. We briefed the Panel on Commerce and Industry on the legislative proposals at its meeting on 21 April 2015. Members generally supported our proposals and urged the Government to implement the new patent system as early as possible. At the same time, legislators asked about the level of application fees under the new patent system, which would be determined under the government-wide "user pays" principle. The Government was also asked to further explore cooperation with other patent offices, including SIPO, to expedite patent applications or facilitate patent protection in order to make the new patent system more attractive to potential applicants.

## PUBLICITY

24. A press release will be issued today (28 October 2015). A spokesman will be available to answer enquiries.

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<sup>12</sup> The Working Group comprises representatives of the following bodies –

- (a) Asian Patent Attorneys Association Hong Kong Group
- (b) Hong Kong Bar Association
- (c) Hong Kong Institute of Patent Attorneys
- (d) Hong Kong Institute of Patent Practitioners
- (e) The Hong Kong Institute of Trade Mark Practitioners, and
- (f) The Law Society of Hong Kong.

## BACKGROUND

### *The current patent system in Hong Kong*

25. An invention which is new, involves an inventive step and is susceptible of industrial application can be patented in Hong Kong provided that it does not belong to the excluded classes.<sup>13</sup> A patent system encourages new technological innovations by granting patent owners the exclusive right to prevent others from manufacturing, using, selling or importing their patented inventions. Currently, two types of patents may be granted in Hong Kong under the Ordinance, namely standard patents and short-term patents.

#### *Standard patents*

26. Standard patents have a maximum term of 20 years. Under the patent regimes of many advanced overseas economies, standard patents are granted by their individual patent offices after “substantive examination” of the applications to ensure that the inventions meet the patentability requirements under their respective local laws. In Hong Kong, standard patents are currently granted based on a “re-registration” system, under which a patent will be granted if prior grant has been obtained in one of three “designated patent offices”, namely SIPO, the UK Patent Office and the European Patent Office for patents designating the UK. The Hong Kong Patents Registry (“Registry”) only conducts “formality examination” by verifying the information and documents filed in support of the applications.<sup>14</sup> It will not conduct substantive examination as to whether the invention underlying a standard patent application fulfills the patentability requirements under our law.

#### *Short-term patents*

27. Short-term patents have a maximum term of eight years. They offer a quicker and cheaper way to protect inventions with a shorter commercial life cycle. Currently, short-term patents are granted by the Registry upon formality examination of the applications. An applicant needs to file, amongst others, a

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<sup>13</sup> Section 93 of the Ordinance sets out the patentability requirements of an invention and the excluded classes. Examples of non-patentable subject matters include discoveries, scientific theories or mathematical methods; aesthetic creations; surgical or therapeutic methods for treatment of the human or animal body; and inventions the publication or working of which is contrary to public order or morality. The Bill will repeal section 93 and re-enact it as the new section 9A. See paragraph 18(a) above.

<sup>14</sup> An application for a standard patent in Hong Kong is made in two stages: a request to record (filed within 6 months after the date of the publication of the corresponding patent application in a designated patent office); and subsequently a request for registration and grant (filed within 6 months after the date of grant of the patent by the designated patent office or publication of the request to record in Hong Kong, whichever is later).

search report<sup>15</sup> in support of the application. No substantive examination is conducted in respect of the underlying invention. Because of the lack of substantive examination, some have raised concerns that short-term patents have been obtained for inventions which do not actually meet the patentability requirements.

### *Regulation of patent practitioners*

28. Currently, subject to limited regulations imposed by the Ordinance and its subsidiary legislation concerning agents for acts done in connection with a patent or patent application under the Ordinance,<sup>16</sup> there is generally no regulation of local patent practitioners. In this connection, a person is generally free to provide any patent agency service in Hong Kong, and use the title of “patent agent”, “patent attorney” or the like.

## **ENQUIRIES**

29. Any enquiries on this brief may be addressed to Ms Fabia Tam, Principal Assistant Secretary for Commerce and Economic Development (Commerce and Industry) at telephone number 2810 2862.

Commerce, Industry and Tourism Branch  
Commerce and Economic Development Bureau  
28 October 2015

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<sup>15</sup> A search report has to be issued by an international search authority (such as the patent offices of Australia, Canada, Korea, Japan and the US) or one of the three designated patent offices.

<sup>16</sup> For example –

- (a) the Registrar of Patents shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong (section 140(4) of the Ordinance);
- (b) the Registrar may refuse to recognize a person as an agent in respect of any business under the Ordinance or the Rules in certain circumstances, such as where the person has been convicted of a criminal offence, or where the person has been struck off the roll of barristers or solicitors (section 85(7) of the Patents (General) Rules).

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# A BILL To

Amend the Patents Ordinance to provide for standard patents by original grant; to provide for substantive examination of short-term patents; to prohibit the use of certain titles and descriptions in providing patent agency services; to make technical and miscellaneous amendments to improve the operation and presentation of the Ordinance; and to provide for related and transitional matters.

Enacted by the Legislative Council.

## 1. Short title and commencement

- (1) This Ordinance may be cited as the Patents (Amendment) Ordinance 2015.
- (2) This Ordinance comes into operation on a day to be appointed by the Secretary for Commerce and Economic Development by notice published in the Gazette.

## 2. Patents Ordinance amended

The Patents Ordinance (Cap. 514) is amended as set out in sections 3 to 134.

## 3. Long title amended

- (1) The long title—  
**Repeal**  
“new provision”  
**Substitute**  
“provisions”.

- (2) The long title—

**Repeal**

“in substitution for the Registration of Patents Ordinance”.

**4. Part I heading substituted**

Part I, heading—

**Repeal the heading**

**Substitute**

**“Part 1**

**Preliminary”.**

**5. Section 2 amended (interpretation)**

- (1) Section 2(1), definition of *date of filing*, paragraph (b), after “standard patent”—

**Add**

“(R),”.

- (2) Section 2(1), definition of *date of filing*, after paragraph (c)—

**Add**

“(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;”.

- (3) Section 2(1), definition of *request for registration and grant*, after “standard patent”—

**Add**

“(R)”.

- (4) Section 2(1), definition of *short-term patent*—

**Repeal**

“Part XV”

**Substitute**

“Part 15”.

- (5) Section 2(1), definition of *standard patent*—

**Repeal**

everything after “means”

**Substitute**

“—

(a) a standard patent (R); or

(b) a standard patent (O);”.

- (6) Section 2(1)—

(a) definition of *application for a patent*;

(b) definition of *patent application*;

(c) definition of *short-term patent application*;

(d) definition of *standard patent application*—

**Repeal the definitions.**

- (7) Section 2(1)—

**Add in alphabetical order**

“*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;

**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;

**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;".

(8) Section 2(2)—

**Repeal**

“standard patent (標準)”

**Substitute**

“standard patent (R) (轉錄標準)”.

(9) Section 2(2)—

**Repeal**

“Paris Convention country (巴黎公約國) section 98(6)”.

**6. Section 3 amended (meaning of *application for a standard patent*)**

(1) Section 3, heading—

**Repeal**

““application for a standard patent””

**Substitute**

“*application for a standard patent (R) and standard patent (R) application*”.

(2) Section 3, after “application for a standard patent” (wherever appearing)—

**Add**

“(R) or a standard patent (R) application”.

(3) Section 3—

**Repeal**

“Part II”

**Substitute**

“Part 2”.

(4) Section 3(b), after “grant of a standard patent”—

**Add**

“(R)”.

(5) Section 3, after “grant of the standard patent”—

**Add**

“(R)”.

**7. Section 4 amended (meaning of *designated patent*, etc.)**

Section 4(2), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

**8. Section 5 amended (meaning of *published*)**

(1) Section 5(2)(a), after “standard patent”—

**Add**

“(R)”.

(2) After section 5(2)(d)—

**Add**

“(da) to a standard patent (O) application being published is a reference to its being published under section 37Q;

(db) to the grant of a standard patent (O) being published is a reference to its being published under section 37X;”.

**9. Section 6 amended (other references)**

(1) Section 6(5), English text, after “Ordinance”—

**Add**

“, a”.

(2) Section 6(5), after “patent application”—

**Add**

“or standard patent (O) application,”.

(3) Section 6(5), English text, after “a designated patent”—

**Add a comma.**

**10. Section 9 amended (special provision regarding invention covered by 2 or more patents)**

(1) Section 9—

**Repeal**

**“Part VIII”**

**Substitute**

**“Part 8”.**

(2) Section 9—

**Repeal**

**“Part IX”**

**Substitute**

**“Part 9”.**

(3) Section 9—

**Repeal**

**“Part IXA”**

**Substitute**

**“Part 9A”.**

(4) Section 9—

**Repeal**

**“Part IXB”**

**Substitute**

**“Part 9B”.**

**11. Part 1A added**

After Part 1—

**Add**

## **“Part 1A**

### **Patentability, Right to Patent and Mention of Inventor**

#### **Division 1—Patentability**

##### **9A. Patentable inventions**

- (1) An invention is patentable if it—
  - (a) is new;
  - (b) involves an inventive step; and
  - (c) is susceptible of industrial application.
- (2) The following are not to be regarded as an invention for the purposes of subsection (1)—
  - (a) a discovery, scientific theory or mathematical method;
  - (b) an aesthetic creation;
  - (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; and
  - (d) a presentation of information.
- (3) Subsection (2) excludes the patentability of the subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to the subject-matter or activities as such.
- (4) A method for the treatment of the human or animal body by surgery or therapy, or a diagnostic method practised on the human or animal body, is not to be regarded as an invention that is susceptible of industrial application for the purposes of subsection (1). However, this subsection



does not apply to a product, and in particular a substance or composition, for use in any such method.

- (5) An invention the publication or working of which would be contrary to public order (“ordre public”) or morality is not a patentable invention. However, the working of an invention is not to be regarded as so contrary only because it is prohibited by any law in force in Hong Kong.
- (6) The following are not patentable—
  - (a) a plant or animal variety; and
  - (b) an essentially biological process for the production of plants or animals (other than a microbiological process or its products).

#### 9B. Novelty

- (1) An invention is to be regarded as new if it does not form part of the state of the art.
- (2) For a patent application for an invention (*subject application*), the state of the art comprises everything made available to the public (in Hong Kong or elsewhere), whether by means of a written or oral description, by use or in any other way before the material date of the subject application.
- (3) For the subject application, the state of the art also comprises the contents of the following applications for an invention—
  - (a) a standard patent (R) application as filed—
    - (i) the material date of which is before the material date of the subject application; and
    - (ii) the corresponding designated patent application of which was published by the

designated patent office on or after the material date of the subject application;

- (b) a designated patent application as filed in a designated patent office—
  - (i) the date of filing of which or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office, is before the material date of the subject application; and
  - (ii) which was published by the designated patent office on or after the material date of the subject application;
- (c) a standard patent (O) application, as filed and as published—
  - (i) the material date of which is before the material date of the subject application; and
  - (ii) which was published under section 37Q on or after the material date of the subject application; and
- (d) a short-term patent application—
  - (i) the material date of which is before the material date of the subject application; and
  - (ii) because of which a short-term patent was published under section 118 on or after the material date of the subject application.
- (4) For an invention consisting of a substance or composition for use in a method referred to in section 9A(4), if the use of the substance or composition in any such method does not form part of the state of the art, then the fact that the substance or composition forms

part of the state of the art does not prevent the invention from being regarded as new.

- (5) For an invention consisting of a substance or composition for a specific use in a method referred to in section 9A(4), if the specific use of the substance or composition in any such method does not form part of the state of the art, then the fact that the substance or composition, and any other use of the substance or composition in any such method, form part of the state of the art does not prevent the invention from being regarded as new.
- (6) For the purpose of any validity proceedings commenced before the commencement date in relation to a pre-existing patent, section 94 as in force immediately before that date continues to apply to the invention, which is the subject of the patent, as if that section had not been repealed.
- (7) For the purpose of any validity proceedings commenced on or after the commencement date in relation to a pre-existing patent, this section applies to the invention, which is the subject of the patent, as if the patent was granted on or after the commencement date.
- (8) In this section—

**commencement date** (生效日期) means the date on which the Patents (Amendment) Ordinance 2015 ( of 2015) comes into operation;

**pre-existing patent** (既有專利) means a standard patent or short-term patent granted before the commencement date;

**validity proceedings** (有效性法律程序) means any proceedings in which the validity of a patent is put in issue under section 101(1).

### 9C. Inventive step

- (1) An invention is to be regarded as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.
- (2) For the purposes of subsection (1), if the state of the art also comprises the contents of the applications falling within section 9B(3), those applications are not to be considered in deciding whether there has been an inventive step.

### 9D. Industrial application

An invention is to be regarded as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

## Division 2—Right to Patent and Mention of Inventor

### 9E. Right to patent belongs to inventor

- (1) Subject to subsections (2) and (3), the right to a patent belongs to the inventor or the inventor's successor in title.
- (2) If the inventor is an employee, the right to the patent is to be determined—
  - (a) in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed; or
  - (b) if the identity of the country, territory or area cannot be determined, in accordance with the law of the country, territory or area where the employer's place of business to which the employee is attached is located.

- (3) If 2 or more persons have made an invention independently of each other, the right to a patent for the invention belongs to the person whose patent application has the earlier or earliest material date (as the case requires).
- (4) Subsection (3) does not apply to a standard patent application that has not been published under section 20 or 37Q.

**9F. Mention of inventor**

- (1) The inventor or joint inventors of an invention have a right to be mentioned as such in—
  - (a) any published patent application for the invention; and
  - (b) any patent granted for the invention.
- (2) If a person has been mentioned as the sole inventor or a joint inventor of an invention because of this section, any other person who alleges that the person ought not to have been so mentioned may request the Registrar to make a finding to that effect.
- (3) If the Registrar makes such a finding, the Registrar—
  - (a) must accordingly amend the register;
  - (b) must advertise the fact of the amendment by notice in the official journal; and
  - (c) may issue a certificate of the finding to the person who made the request.”

**12. Headings before section 10 substituted**

Headings before section 10—

**Repeal the headings**

**Substitute**

**“Part 2**

**Standard Patents by Re-registration**

**Division 1—General”.**

**13. Section 10 amended (general provision regarding applications for standard patents)**

- (1) Section 10, heading, after “standard patents”—  
**Add**  
“(R)”.
- (2) Section 10, after “standard patent” (wherever appearing)—  
**Add**  
“(R)”.

**14. Section 11 amended (formality examination of applications for standard patent)**

- (1) Section 11, heading, after “standard patent”—  
**Add**  
“(R)”.
- (2) Section 11, after “standard patent”—  
**Add**  
“(R)”.
- (3) Section 11(d)—  
**Repeal**  
“45”  
**Substitute**

“9A, 9B, 9C, 9D, 9E, 9F, 11A, 11B, 11C”.

(4) Section 11(d)—

**Repeal**

“, 79, 93, 94, 95, 96, 97, 98, 99 or 100”

**Substitute**

“or 79”.

**15. Part 2, Division 2 added**

After section 11—

**Add**

**“Division 2—Novelty and Priority**

**11A. Non-prejudicial disclosure**

- (1) For the purposes of section 9B, if the conditions specified in subsection (2) are satisfied, a disclosure of an invention that is the subject of a standard patent (R) application is not to be taken into consideration in determining whether the invention forms part of the state of the art.
- (2) The conditions are—
  - (a) the disclosure occurred no earlier than 6 months before the deemed date of filing of the standard patent (R) application; and
  - (b) the disclosure was due to, or in consequence of—
    - (i) an evident abuse in relation to the applicant or a proprietor of the invention for the time being; or
    - (ii) the fact that the applicant or a proprietor of the invention for the time being had displayed

the invention at a prescribed exhibition or meeting.

(3) Subsection (2)(b)(ii) applies only if—

- (a) at the time of filing the corresponding designated patent application, the applicant stated, in accordance with the law of the designated patent office relating to non-prejudicial disclosure, that the invention had been so displayed; and
- (b) the request to record the designated patent application contains a statement that indicates the prescribed details relating to the disclosure, as required under section 15(2)(f).

**11B. Priority right**

- (1) Subsection (3) applies if the proprietor of a designated patent application for an invention, on the basis of an earlier application for a patent or other protection for the same invention filed in or for a Paris Convention country, enjoys in the designated patent office a right of priority for the period of 12 months after the date of filing of the earlier application (*priority period*) under the law of the office.
- (2) Subsection (3) also applies if the proprietor, on the basis of an earlier application for a patent or other protection for the same invention filed in or for a country, territory or area that is not a Paris Convention country, enjoys in the designated patent office a right of priority for the priority period consequent on an international agreement—
  - (a) that applies to Hong Kong because either Hong Kong is a party to it or it is applied to Hong Kong

- by the Central People's Government of the People's Republic of China; and
- (b) that provides for the grant of such priority on the basis of a first filing made in or for that country, territory or area and subject to conditions equivalent to those laid down in the Paris Convention.
- (3) The proprietor or the proprietor's successor in title enjoys, for the purpose of filing a standard patent (R) application for the invention, which is the subject of the designated patent application, the same right of priority as the person enjoys in respect of the designated patent application in the designated patent office.
- (4) The right conferred by subsection (3) is subject to sections 15(2)(e) and 23(3)(c).
- (5) In this section, a reference to the law of a designated patent office includes the law of the office dealing with the circumstances under which—
- (a) a filing made in or for a Paris Convention country that is equivalent to a regular national filing under the domestic legislation of that country, or under bilateral or multilateral agreements, gives rise to a right of priority;
- (b) a subsequent application for a patent for the same subject-matter as in a previous first application and filed in or for the same Paris Convention country is to be considered as the first application for the purpose of determining priority; and
- (c) multiple priorities may be claimed in respect of a designated patent application.
- (6) In this section—

**Paris Convention country** (巴黎公約國) means a country or territory other than Hong Kong which is a party to the Paris Convention or a dependent territory of any such country to which that Convention has been extended;

**regular national filing** (正規國家提交) means a filing that establishes the date on which an application was filed, whatever the outcome of the application may be.

#### 11C. Effect of priority right

- (1) The right of priority conferred by section 11B has the effect that the date of priority enjoyed in the designated patent office is to be regarded as the date of priority of the standard patent (R) application for the purposes of this Ordinance.
- (2) A standard patent (R) granted because of a standard patent (R) application in respect of which the proprietor enjoys a right of priority as provided in section 11B is not to be invalidated only because any subject-matter disclosed in the earlier application (that is to say, the application on the basis of which the right of priority is enjoyed in the designated patent office) was made available to the public at any time after the date of filing of the earlier application.”.

#### 16. Heading before section 12 substituted

Heading before section 12—

**Repeal the heading**

**Substitute**

**“Division 3—Who may Apply for Standard Patent (R)”.**

**17. Section 12 amended (who may apply)**

Section 12, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

**18. Section 13 amended (determination before grant of questions as to who may apply)**

(1) Section 13(1), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(2) Section 13(1)(b)—

**Repeal**

“a patent”

**Substitute**

“a standard patent (R)”.

(3) Section 13(3), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(4) Section 13—

**Repeal subsection (6)**

**Substitute**

“(6) No order may be made under subsection (3) unless notice of the reference is given in the prescribed manner to each person who, not being a party to the reference, is—

(a) an applicant named in the standard patent (R) application; or

(b) a person alleged in the reference to have the right to apply for the grant of a standard patent (R) for the invention, whether alone or jointly with any other person, because of any transaction, instrument or event relating to—

(i) the invention; or

(ii) the standard patent (R) application.

(6A) A person who receives a notice under subsection (6) may oppose the making of the order, which is sought in the reference.”.

**19. Section 14 amended (effect of transfer of application under section 13)**

(1) Section 14, Chinese text, heading—

**Repeal**

“效力”

**Substitute**

“影響”.

(2) Section 14, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(3) Section 14(2), English text—

**Repeal**

“a patent”

**Substitute**

“a standard patent (R)”.

**20. Heading before section 15 substituted**

Heading before section 15—

**Repeal the heading**

**Substitute**

**“Division 4—Request to Record Designated Patent Application”.**

**21. Section 15 amended (filing of request to record)**

(1) Section 15, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(2) Section 15(2)(e)—

**Repeal**

“section 98”

**Substitute**

“section 11B”.

**22. Section 17 amended (date of filing of request to record)**

Section 17(2), after “standard patent”—

**Add**

“(R)”.

**23. Section 18 amended (examination on filing of request to record)**

(1) Section 18(1)(a)—

**Repeal**

“(the “minimum requirements”)”

**Substitute**

**“(minimum requirements)”.**

(2) Section 18(2), after “because of deficiencies”—

**Add**

“in the request”.

(3) Section 18(3), after “standard patent”—

**Add**

“(R)”.

**24. Section 19 amended (examination as to formal requirements of request to record)**

(1) Section 19(1)—

**Repeal**

“shall examine”

**Substitute**

“must examine the request to ascertain”.

(2) After section 19(1)—

**Add**

“(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.”.

(3) Section 19—

**Repeal subsections (2) and (3)**

**Substitute**

“(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) Section 19(4)—

**Repeal**

“such right shall be”

**Substitute**

“then only the right is”.

**25. Section 20 amended (publication of request to record)**

Section 20(1)—

**Repeal**

“deficiencies noted”

**Substitute**

“deficiencies”.

**26. Section 22 amended (provision for request to record in the event of a divisional designated patent application)**

(1) Section 22, Chinese text, heading—

**Repeal**

“公”

**Substitute**

“分”.

(2) Section 22, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(3) Section 22(2)—

**Repeal**

“Where”

**Substitute**

“Subject to section 103(1), where”.

**27. Heading before section 23 substituted**

Heading before section 23—

**Repeal the heading**

**Substitute**

**“Division 5—Request for Registration and Grant”.**

**28. Section 23 amended (filing of request for registration and grant)**

(1) Section 23, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(2) Section 23(1)(a)—

**Repeal**

“(whether under this Part or Part III)”.

(3) Section 23(5)—

**Repeal**

“a patent”

**Substitute**

“a standard patent (R)”.



**29. Section 24 amended (date of filing request for registration and grant)**

(1) Section 24(1)—

**Repeal**

“section 25(3)”

**Substitute**

“section 25(2) and (4)”.

(2) Section 24(1)(a), after “standard patent”—

**Add**

“(R)”.

**30. Section 25 amended (examination on filing of request for registration and grant)**

Section 25—

**Repeal subsections (2) and (3)**

**Substitute**

“(2) If there are deficiencies in the request as regards the requirements of section 24(1) that cannot be corrected, the standard patent (R) application must be refused.

(3) Subject to section 24(2), if there are deficiencies in the request as regards the requirements of section 24(1) that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.

(4) If any deficiencies referred to in subsection (3) are not corrected in accordance with the rules—

(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.”.

**31. Section 26 amended (examination as to formal requirements of the request for registration and grant)**

(1) Section 26(1)—

**Repeal**

“shall examine”

**Substitute**

“must examine the request to ascertain”.

(2) After section 26(1)—

**Add**

“(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.”.

(3) Section 26—

**Repeal subsections (2) and (3)**

**Substitute**

“(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) Section 26(4)—

**Repeal**

“then such right shall be”

**Substitute**

“, then only the right is”.

**32. Section 27 amended (registration of designated patent and grant of patent)**

(1) Section 27, heading—

**Repeal**

“grant of patent”

**Substitute**

“grant of standard patent (R)”.

(2) Section 27(1)—

**Repeal**

“deficiencies noted”

**Substitute**

“deficiencies”.

(3) Section 27, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(4) Section 27—

**Repeal**

“certificate” (wherever appearing)

**Substitute**

“certificate of grant”.

(5) Section 27(2)—

**Repeal**

“A patent”

**Substitute**

“A standard patent (R)”.

**33. Heading before section 28 substituted**

Heading before section 28—

**Repeal the heading**

**Substitute**

**“Division 6—Further Processing and Restoration of Rights”.**

**34. Section 28 amended (further processing of application for standard patent)**

(1) Section 28, heading, after “standard patent”—

**Add**

“(R)”.

(2) Section 28(1)(a), after “standard patent”—

**Add**

“(R)”.

(3) Section 28(1)(a), after “is deemed”—

**Add**

“to be or regarded as being”.

(4) Section 28(2)(a)—

**Repeal**

“deemed”.

(5) Section 28—

**Repeal subsection (3)**

**Substitute**

- “(3) This section does not apply to an application that—
- (a) is refused under section 25(2) or (4)(b); or
  - (b) is deemed to be or regarded as being withdrawn under section 15(4), 23(5), 24(2), 25(4)(a) or 33(2).”.

**35. Section 29 amended (restoration of rights)**

- (1) Section 29(1)(a), after “standard patent”—  
**Add**  
“(R)”.
- (2) Section 29(1)(i)—  
**Repeal**  
everything before “as a direct consequence”  
**Substitute**  
“(i) if the standard patent (R) application is refused, or is deemed to be or regarded as being withdrawn,”.
- (3) Section 29(1)(i)—  
**Repeal**  
“shall be deemed to be”  
**Substitute**  
“, the refusal or withdrawal is”.
- (4) Section 29(1)(i)—  
**Repeal**  
“shall be treated”  
**Substitute**  
“is to be regarded”.

- (5) Section 29(1)(ii), English text—

**Repeal**

“shall be”

**Substitute**

“is to be”.

- (6) Section 29(3)—

**Repeal**

“deemed”.

- (7) Section 29(5)—

**Repeal**

“or 25(3)”

**Substitute**

“, 25(4), 31(1), 32(1) or 33(2) or (4)”.

**36. Section 30 amended (effect of restoration of rights under section 29)**

- (1) Section 30(2)(a), after “standard patent”—  
**Add**  
“(R)”.
- (2) Section 30(3)—  
**Repeal**  
“patent”  
**Substitute**  
“standard patent (R)”.
- (3) Section 30(5)—  
**Repeal**  
“patent”

**Substitute**

“standard patent (R)”.

**37. Heading before section 31 substituted**

Heading before section 31—

**Repeal the heading**

**Substitute**

**“Division 7—Provisions on Standard Patent (R)  
Applications before Grant”.**

**38. Section 31 amended (amendment of application for standard patent)**

(1) Section 31, heading, after “standard patent”—

**Add**

“(R)”.

(2) Section 31(1)—

**Repeal**

“103”

**Substitute**

“103(2)”.

(3) Section 31(1), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

**39. Section 32 amended (withdrawal of application)**

(1) Section 32(1), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(2) Section 32(2)—

**Repeal**

“patent application”

**Substitute**

“standard patent (R) application”.

(3) Section 32(2), after “is deemed”—

**Add**

“or regarded”.

(4) Section 32(2)(a)—

**Repeal**

“section 94(3)”

**Substitute**

“section 9B(3)”.

(5) Section 32(2)(b)—

**Repeal**

“section 98”

**Substitute**

“section 11B”.

**40. Section 33 amended (maintaining application for standard patent)**

(1) Section 33, heading, after “standard patent”—

**Add**

“(R)”.

(2) Section 33, after “standard patent” (wherever appearing)—

**Add**

- “(R)”.
- (3) Section 33(2)—  
**Repeal**  
 “a patent application” (wherever appearing)  
**Substitute**  
 “a standard patent (R) application”.
- (4) Section 33(4)—  
**Repeal**  
 “patent application”  
**Substitute**  
 “standard patent (R) application”.
- (5) Section 33(5)—  
**Repeal**  
 “application for a patent”  
**Substitute**  
 “standard patent (R) application”.
- (6) Section 33(6)—  
**Repeal**  
 “patent application”  
**Substitute**  
 “standard patent (R) application”.
- (7) Section 33(9)—  
**Repeal**  
 “application for a patent”  
**Substitute**  
 “standard patent (R) application”.

41. **Section 34 amended (restoring application for standard patent)**  
 (1) Section 34, heading, after “standard patent”—  
**Add**  
 “(R)”.
- (2) Section 34(1), after “standard patent” (wherever appearing)—  
**Add**  
 “(R)”.
42. **Section 35 amended (effect of restoration order under section 34)**  
 (1) Section 35(2)(a) and (3)—  
**Repeal**  
 “for a patent”  
**Substitute**  
 “for a standard patent (R)”.
- (2) Section 35(5)—  
**Repeal**  
 “in the patent”  
**Substitute**  
 “of the standard patent (R)”.
- (3) Section 35(6), after “standard patent”—  
**Add**  
 “(R)”.
43. **Section 36 amended (limitation on withdrawal, amendment, etc. of application)**  
 Section 36, after “standard patent”—  
**Add**

“(R)”.

**44. Section 37 amended (Registrar may refuse to record under section 20 or to register and grant under section 27)**

(1) Section 37(1), after “standard patent”—

**Add**

“(R)”.

(2) Section 37(1)—

**Repeal**

“section 93(5)”

**Substitute**

“section 9A(5)”.

**45. Part 3 added**

After section 37—

**Add**

**“Part 3**

**Standard Patents by Original Grant**

**Division 1—Novelty and Priority**

**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 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 WTO member country, territory or area.

**37B. Non-prejudicial disclosure**

(1) For the purposes of section 9B, if the conditions specified in subsection (2) are satisfied, a disclosure of an invention that is the subject of a standard patent (O) application is not to be taken into consideration in determining whether the invention forms part of the state of the art.

(2) The conditions are—

(a) the disclosure occurred no earlier than 6 months before the date of filing of the standard patent (O) application; and

(b) the disclosure was due to, or in consequence of—

(i) an evident abuse in relation to the applicant or a proprietor of the invention for the time being; or

(ii) the fact that the applicant or a proprietor of the invention for the time being had displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928, as applied to Hong Kong.

(3) Subsection (2)(b)(ii) applies only if the standard patent (O) application as filed contains—

(a) a statement to the effect that the invention had been so displayed; and

(b) the prescribed written evidence in support of the statement.

**37C. Priority right**

- (1) Subsection (2) applies if a person has filed—
  - (a) a non-Hong Kong application for an invention; or
  - (b) a Hong Kong application for an invention.
- (2) The person or the person's successor in title enjoys, for the purpose of filing a subsequent standard patent (O) application for the same invention, a right of priority for the period of 12 months after the date of filing of the first non-Hong Kong application or Hong Kong application, subject to compliance with the prescribed conditions.
- (3) For the purposes of subsection (2)—
  - (a) every filing of a non-Hong Kong application that is equivalent to a regular national filing under the domestic legislation of the place in or for which the application is filed, or under bilateral or multilateral agreements, is to be recognized as giving rise to a right of priority;
  - (b) a subsequent non-Hong Kong application for the same subject-matter as in a previous first non-Hong Kong application and filed in or for the same place is to be considered as the first application for the purpose of determining priority only if, on the date of filing the subsequent application, the previous application—
    - (i) has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding; and
    - (ii) has not served as a basis for claiming a right of priority; and

- (c) if, because of paragraph (b), a subsequent non-Hong Kong application is considered as the first application, the previous non-Hong Kong application may not later serve as a basis for claiming a right of priority.
  - (4) For the purposes of subsection (2)—
    - (a) every regular filing of a Hong Kong application is to be recognized as giving rise to a right of priority;
    - (b) a subsequent Hong Kong application for the same subject-matter as in a previous first Hong Kong application is to be considered as the first application for the purpose of determining priority only if, on the date of filing the subsequent application, the previous application—
      - (i) has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding; and
      - (ii) has not served as a basis for claiming a right of priority; and
    - (c) if, because of paragraph (b), a subsequent Hong Kong application is considered as the first application, the previous Hong Kong application may not later serve as a basis for claiming a right of priority.
  - (5) A right of priority that arises as a result of a non-Hong Kong application or Hong Kong application for an invention may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (2) to a person's successor in title is to be construed accordingly.
  - (6) In this section—

**regular filing of a Hong Kong application** (香港申請的正規提交) means a filing of a Hong Kong application that establishes the date on which the application was filed, whatever the outcome of the application may be;

**regular national filing** (正規國家提交) means a filing that establishes the date on which an application was filed, whatever the outcome of the application may be.

### 37D. Restoration of priority right

- (1) This section applies if—
  - (a) a person files a non-Hong Kong application or Hong Kong application for an invention; and
  - (b) the person or the person's successor in title files a subsequent standard patent (O) application for the same invention within 2 months after the expiry of the 12-month period referred to in section 37C(2).
- (2) The applicant of the subsequent standard patent (O) application may apply to the Registrar for restoring the priority right of the patent application.
- (3) The application for restoring the priority right (**restoration application**) must be made in the prescribed manner before the earlier of the following—
  - (a) the end of 2 months after the expiry of the 12-month period;
  - (b) the date on which preparations for publication under section 37Q of the subsequent standard patent (O) application are completed.
- (4) A restoration application is to be regarded as being made only if the prescribed fee for the application is paid.
- (5) The Registrar may approve a restoration application if the Registrar is satisfied that the applicant failed to file

the subsequent standard patent (O) application within the 12-month period even though the applicant had taken all reasonable care required by the circumstances.

### 37E. Claiming priority

- (1) An applicant for a standard patent (O) desiring to take advantage of the priority of a previous application must file, in the prescribed manner and within the prescribed time, a statement of priority and a copy of the previous application.
- (2) Multiple priorities, whether or not they originated in different countries, may be claimed—
  - (a) in respect of a standard patent (O) application; and
  - (b) if appropriate, for any one claim in the application.
- (3) If multiple priorities are claimed, a time limit that runs from the date of priority is to run from the earliest date of priority.
- (4) If one or more priorities are claimed in respect of a standard patent (O) application, the right of priority is to cover only those elements of the application that are included in the previous application or applications the priority of which is claimed.
- (5) Although certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may still be granted if the documents of the previous application as a whole specifically disclosed the elements.

### 37F. Effect of priority right

- (1) The right of priority conferred by section 37C has the effect that the date of priority of a previous application claimed under section 37E is to be regarded as the date



of priority of the standard patent (O) application for the purposes of this Ordinance.

(2) If—

- (a) a standard patent (O) application is filed; and
- (b) the priority of a previous application is claimed under section 37E,

then despite anything contained in this Ordinance, the standard patent (O) application, and the standard patent (O) granted because of it, are not to be invalidated only because any subject-matter disclosed in the previous application was made available to the public at any time after the date of filing of the previous application.

## **Division 2—Who may Apply for Standard Patent (O)**

### **37G. Application may be made alone or jointly**

- (1) An application for a standard patent (O) for an invention may be made by a person alone or jointly with any other person.
- (2) Subject to any determination under section 37H, for the purpose of proceedings before the Registrar, the applicant is to be regarded as being entitled to apply for a standard patent (O) for the invention.

### **37H. Determination before grant of questions as to who may apply**

- (1) At any time before a standard patent (O) has been granted for an invention—
  - (a) whether or not a standard patent (O) application for the invention has been filed, a person may refer to the Registrar or the court the question whether the

person is entitled, whether alone or jointly with any other person, to apply for a standard patent (O) for the invention; or

- (b) if such an application has been filed, any of the joint proprietors of the application may refer to the Registrar or the court the question whether any right in or under the application should be transferred or granted to any other person.
- (2) The Registrar or the court may make an order that the Registrar or the court thinks fit to give effect to a determination on the question referred.

### **37I. Powers of Registrar and court if standard patent (O) application has been filed**

- (1) Without limiting section 37H(2), if a question is referred to the Registrar or the court under section 37H(1) after a standard patent (O) application has been filed—
  - (a) the Registrar or the court may order that the application must proceed in the name of the person who makes the reference, or in joint names of that person and any other person;
  - (b) the Registrar or the court may order that, because of the reference, the standard patent (O) must not be granted;
  - (c) the Registrar or the court may order the application to be amended, subject to section 103(2), so as to exclude any matter to which the question relates; or
  - (d) the Registrar or the court may—
    - (i) make an order transferring or granting a licence or other right in or under the application; and

- (ii) give directions to any person for carrying out the provisions of the order.
- (2) No order may be made under subsection (1) unless notice of the reference is given in the prescribed manner to each person who, not being a party to the reference, is—
  - (a) an applicant named in the standard patent (O) application; or
  - (b) a person alleged in the reference to have the right to apply for a standard patent (O) for the invention, whether alone or jointly with any other person, because of any transaction, instrument or event relating to—
    - (i) the invention; or
    - (ii) the standard patent (O) application.
- (3) A person who receives a notice under subsection (2) may oppose the making of the order, which is sought in the reference.
- (4) If a person (*person A*) to whom directions have been given under subsection (1)(d)(ii) fails to do anything necessary for carrying out the directions within 14 days after the date of the directions, the Registrar or the court may, on application by a person (*person B*) in whose favour or on whose reference the directions have been given, authorize person B to do the thing on behalf of person A.
- (5) No direction is to be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

**37J. Registrar and court may order new standard patent (O) application under certain circumstances**

- (1) This section applies if—
  - (a) a question is referred to the Registrar or the court under section 37H(1)(a) after a standard patent (O) application (*earlier application*) has been filed; and
  - (b) the earlier application—
    - (i) is refused according to an order under section 37I(1)(b);
    - (ii) is amended according to an order under section 37I(1)(c); or
    - (iii) is refused under any other provision of this Ordinance, or is withdrawn, before the Registrar or the court has disposed of the reference.
- (2) The Registrar or the court may make an order providing—
  - (a) that a person who made the reference may, within the time specified in the order and subject to section 103(1), make a new standard patent (O) application for—
    - (i) all or any of the matters comprised in the earlier application; or
    - (ii) if applicable, all or any of the matters excluded from the earlier application;
  - (b) that the date of filing of the earlier application is to be regarded as the date of filing of the new application; and
  - (c) that the new application enjoys the benefit of any right of priority.

**37K. Effect of transfer of application on licences and other rights in or under application etc.**

- (1) If an order is made under section 37I that a standard patent (O) application must proceed in the name of any original applicant (whether or not the application is also to proceed in the name of some other person), a licence or other right in or under the application is, subject to the order and any directions under section 37I(1)(d)(ii)—
  - (a) to continue in force; and
  - (b) to be treated as granted by the person in whose name the application is to proceed.
- (2) If an order is made under section 37I that a standard patent (O) application must not proceed in the name of any original applicant, but must proceed in the name of another person (on the ground that the original applicant was not entitled to apply for the patent), a licence or other right in or under the application is, subject to the order and any directions under section 37I(1)(d)(ii), to lapse—
  - (a) on the registration of the other person as the new applicant; or
  - (b) if the application has not been published, on the making of the order.
- (3) If an order referred to in subsection (2) is made, an original applicant of the standard patent (O) application or a licensee of the applicant who meets the conditions specified in subsection (5) is entitled to be granted a licence by the new applicant to continue working or to work, as the case may be, the invention which is the subject of the application.

- (4) If a new standard patent (O) application is made in accordance with an order under section 37J(2), an applicant of the earlier application or a licensee of the applicant who meets the conditions specified in subsection (5) is entitled to be granted a licence by the applicant of the new application to continue working or to work, as the case may be, the invention, so far as it is the subject of the new application.
- (5) The conditions are—
  - (a) the applicant or licensee, acting in good faith before the reference that results in the making of the order—
    - (i) worked the invention in Hong Kong; or
    - (ii) made effective and serious preparations to do so; and
  - (b) the applicant or licensee makes a request for licence to the new applicant or applicant of the new application, as the case may be, within the prescribed time.
- (6) A licence granted under subsection (3) or (4)—
  - (a) is a non-exclusive licence; and
  - (b) must be granted for a reasonable period and on reasonable terms.
- (7) A person to whom a request for licence is made, or a person claiming to be entitled to be granted a licence, may refer to the Registrar or the court the question—
  - (a) whether the latter is so entitled; and

- (b) whether the period or terms of the licence are reasonable.
- (8) On a reference under subsection (7), the Registrar or the court—
  - (a) must determine the question; and
  - (b) may make an order that the Registrar or the court thinks fit to give effect to the determination, including an order for the grant of a licence.

### **Division 3—Applications for Standard Patents (O)**

#### **37L. Requirements of standard patent (O) application**

- (1) A standard patent (O) application must—
  - (a) be signed by the applicant; and
  - (b) be filed with the Registrar in the prescribed manner.
- (2) A standard patent (O) application must contain—
  - (a) a request for the grant of a standard patent (O);
  - (b) a specification that provides for—
    - (i) a description of the invention which is the subject of the application;
    - (ii) at least one claim; and
    - (iii) any drawing referred to in the description or the claim or claims;
  - (c) an abstract;
  - (d) if the applicant desires to claim non-prejudicial disclosure of the invention under section 37B(2)(b)(ii), the statement and evidence required under section 37B(3);

- (e) if the applicant desires to take advantage of the priority of a previous application, a statement of priority and a copy of the previous application required under section 37E(1); and
- (f) if the invention requires for its performance the use of a micro-organism, information on the availability of samples of the micro-organism to the public (if any).
- (3) A standard patent (O) application—
  - (a) must state the name and address of the applicant;
  - (b) must—
    - (i) identify each inventor of the invention; and
    - (ii) specify the last known address of each inventor (unless the inventor is also the applicant);
  - (c) if the applicant is not an inventor, must contain a statement in the specified form indicating how the applicant becomes entitled to apply for a standard patent (O) for the invention; and
  - (d) must specify an address in Hong Kong for service of documents.
- (4) A standard patent (O) application must also comply with the requirements of this Ordinance on providing information in, or translating documents into, one or both official languages.
- (5) A filing fee and an advertisement fee are payable within the prescribed time.
- (6) If any of the fees is not paid within the prescribed time or the grace period provided in the rules, the application is to be regarded as being withdrawn.

- (7) The rules may—
- (a) provide that a standard patent (O) application must or may contain a title of the invention and a designation of the classification of the invention; and
  - (b) provide for the requirements of a standard patent (O) application for an invention that involves nucleotide and amino acid sequences.
- (8) This section does not prevent a standard patent (O) application from being initiated by documents complying with section 37M(3).

**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 WTO member country, territory or area;
  - (b) a standard patent (O) application; or
  - (c) a short-term patent application.

**37N. Filing of missing description or missing drawing**

- (1) The Registrar may, by written notice, require the applicant of a standard patent (O) application to file a

missing description or missing drawing in the prescribed manner and within the prescribed time.

- (2) The applicant may also, on the applicant's own initiative, file a missing description or missing drawing in the prescribed manner and within the prescribed time.
- (3) If the standard patent (O) application has been accorded a date of filing in accordance with section 37M(2), then on the filing of a missing description or missing drawing, the date of filing is to be changed to the date on which the description or drawing is filed.
- (4) The Registrar must, by written notice, inform the applicant of the change of the date of filing.
- (5) Subsection (3) does not apply if—
  - (a) the applicant has claimed priority of a previous application under section 37E;
  - (b) the missing description or missing drawing is completely contained in the previous application;
  - (c) when filing the description or drawing, the applicant makes, in accordance with the rules, a request that the date of filing accorded in accordance with section 37M(2) remains unchanged; and
  - (d) the applicant files within the prescribed time—
    - (i) a copy of the previous application;
    - (ii) if the previous application is not in one of the official languages, its translation in one of the official languages; and
    - (iii) a statement indicating the location of the description or drawing in the previous

application and, if applicable, in its translation.

(6) In this section—

**missing description** (欠交説明) means a part of the description of an invention referred to in section 37L(2)(b)(i), that has not been filed in a standard patent (O) application;

**missing drawing** (欠交繪圖) means a drawing referred to in section 37L(2)(b)(iii), that has not been filed in a standard patent (O) application.

**37O. Missing description or missing drawing not filed or withdrawn**

- (1) If any missing description or missing drawing as defined by section 37N(6) is not filed within the prescribed time under section 37N(1) or (2), any reference to the description or drawing in the specification contained in the standard patent (O) application under section 37L(2)(b) is to be regarded as being deleted.
- (2) If a notice of change of the date of filing is issued under section 37N(4), the applicant of the standard patent (O) application may, within 1 month after the date of the notice, withdraw the missing description or missing drawing that has been filed.
- (3) On the withdrawal of the description or drawing—
  - (a) any reference to the description or drawing in the specification contained in the patent application under section 37L(2)(b) is to be regarded as being deleted;
  - (b) the description or drawing is to be regarded as not having been filed; and

- (c) the original date of filing of the patent application accorded in accordance with section 37M(2) is to remain unchanged.

### **Division 4—Examination on Formal Requirements and Publication of Standard Patent (O) Application**

#### **37P. Examination on formal requirements**

- (1) If a standard patent (O) application has been accorded a date of filing and is not regarded as being withdrawn under section 37L(6), the Registrar must examine the application to ascertain whether the requirements of that section (*formal requirements*) have been complied with.
- (2) If there are deficiencies in the application as regards the formal requirements that cannot be corrected, the application must be refused.
- (3) If there are deficiencies in the application 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.
- (4) If any deficiencies referred to in subsection (3) are not corrected in accordance with the rules, then except as provided in subsection (5)—
  - (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.
- (5) If a deficiency relating solely to a claim to any right of priority is not duly corrected, then only the right is lost for the application.

#### **37Q. Publication of application**

- (1) If a standard patent (O) application has been accorded a date of filing, and the Registrar is satisfied that the application complies with the formal requirements under section 37P, the Registrar must—
  - (a) publish the application as filed, together with any subsequent amendment, as soon as practicable on the expiry of the prescribed time, unless the application is withdrawn or refused before preparations for its publication are completed by the Registrar; and
  - (b) advertise the fact of the publication by notice in the official journal.
- (2) The Registrar may publish the application within the prescribed time referred to in subsection (1)(a), if so requested by the applicant.
- (3) In publishing the application, the Registrar may omit from the specification contained in the application any matter—
  - (a) that, in the Registrar's opinion, disparages any person in a way likely to damage the person; or
  - (b) the publication or working of which, in the Registrar's opinion, would—
    - (i) be contrary to public order ("ordre public") or morality; or
    - (ii) be likely to encourage offensive, immoral or anti-social behaviour.
- (4) In subsection (1)(a)—
 

*subsequent amendment* (其後修訂), for a standard patent (O) application, includes any amendment to the claims in,

and any new claim added to, the application as filed, before preparations for publication of the application are completed by the Registrar.

**37R. Observations by third parties on patentability of invention**

- (1) After a standard patent (O) application for an invention has been published, any person may file with the Registrar a written notice of the person's observations on the patentability of the invention.
- (2) The notice must—
  - (a) set out the observations and the grounds for the observations; and
  - (b) be filed in the prescribed manner and within the prescribed time.
- (3) The Registrar must, as soon as practicable after receiving a notice under subsection (1), send a copy of the notice to the applicant.
- (4) The Registrar must consider the observations when carrying out a substantive examination of the patent application.
- (5) A person does not become a party to any proceedings under this Ordinance only because the person files a notice under subsection (1).

**Division 5—Substantive Examination of Standard Patent (O) Applications and Grant of Standard Patents (O)**

**37S. Interpretation of Division 5 of Part 3**

In this Division—

*examination requirement* (審查規定) means a requirement specified in section 37U(3);

*unfulfilled requirement* (不獲符合的規定), for a standard patent (O) application, means an examination requirement that—

- (a) in the Registrar's opinion, is not complied with by the application; and
- (b) is set out in the notice to the applicant under section 37V(2).

**37T. Request for substantive examination of standard patent (O) application**

- (1) The applicant of a standard patent (O) application must, in accordance with the rules, request the Registrar to carry out a substantive examination of the application.
- (2) The application is to be regarded as being withdrawn if—
  - (a) no request for substantive examination is made within the prescribed time; or
  - (b) where a request has been made, the prescribed fee for the examination is not paid within the prescribed time or the grace period provided in the rules.

**37U. Substantive examination by Registrar**

- (1) On receiving a request for substantive examination of a standard patent (O) application and the prescribed fee, the Registrar must, by written notice, inform the applicant that the application has entered into the stage of substantive examination.



- (2) The Registrar must examine the application to determine whether the application complies with all the requirements specified in subsection (3).
- (3) The requirements are—
  - (a) the invention, which is the subject of the application, is patentable under section 9A;
  - (b) the specification contained in the application discloses the invention in accordance with section 77;
  - (c) all the claims contained in the specification comply with the requirements of section 78(1);
  - (d) the matter disclosed in the specification contained in the application does not extend beyond that disclosed in—
    - (i) the application as filed; and
    - (ii) if the application is a specified new application, the earlier standard patent (O) application as filed;
  - (e) the application is not one of 2 relevant patent applications that—
    - (i) are filed for the same invention made by the same inventor; and
    - (ii) have the same material date.
- (4) In examining a standard patent (O) application to determine whether the application complies with the requirement specified in subsection (3)(a), the Registrar must have regard to—
  - (a) if a claim for priority of a previous application has been made in respect of the application under

section 37E, whether the applicant is entitled to the priority claimed; and

- (b) if a missing description or missing drawing as defined by section 37N(6) has been filed, whether the date of filing of the application remains unchanged.
- (5) The Registrar must carry out the examination in accordance with the rules.
- (6) In subsection (3)—
 

**relevant patent application** (有關專利申請) means—

  - (a) a patent application which is pending; or
  - (b) a patent application because of which a patent, being one that is in force, was granted;

**specified new application** (指明新申請) means—

  - (a) a new standard patent (O) application made in accordance with an order under section 37J(2);
  - (b) a new standard patent (O) application referred to in section 37Z; or
  - (c) a new standard patent (O) application made in accordance with an order under section 55(4).

**37V. Applicant may file representations and requests for amendment, etc.**

- (1) If the Registrar is of the opinion that a standard patent (O) application does not comply with any examination requirement, the Registrar must, by written notice, inform the applicant of the opinion.
- (2) The notice must set out each examination requirement that, in the Registrar's opinion, is not complied with by the application.

- (3) The applicant may respond to the notice by filing, in accordance with the rules, any or all of the following—
  - (a) a representation to establish that the application complies with an unfulfilled requirement;
  - (b) subject to section 103(2), a request to amend the application to enable the application to comply with an unfulfilled requirement;
  - (c) a request to review the Registrar's opinion.

**37W. Registrar must consider representations and requests for amendment, etc.**

The Registrar must, in accordance with the rules—

- (a) consider and decide—
  - (i) whether a representation filed under section 37V(3)(a) establishes that a standard patent (O) application complies with an unfulfilled requirement; and
  - (ii) whether a requested amendment filed under section 37V(3)(b) would enable the application to comply with an unfulfilled requirement; and
- (b) review the Registrar's opinion on a request filed under section 37V(3)(c).

**37X. Grant of standard patent (O)**

- (1) The Registrar must grant a standard patent (O) for an invention, if the Registrar—
  - (a) has examined the standard patent (O) application;
  - (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 37W (where applicable); and

- (c) is of the opinion that the application, together with any requested amendment, complies with all the examination requirements.
- (2) As soon as practicable after the standard patent (O) is granted, the Registrar must—
  - (a) publish in the prescribed manner—
    - (i) the specification of the patent;
    - (ii) the name of the applicant; and
    - (iii) the name of the inventor;
  - (b) issue a certificate of grant in respect of the patent to the applicant; and
  - (c) advertise the fact of the grant by notice in the official journal.
- (3) The Registrar may, in addition to the matters specified in subsection (2)(a), publish any other matters constituting or relating to the patent that the Registrar considers it desirable to publish.

**37Y. Refusal to grant standard patent (O)**

The Registrar must refuse to grant a standard patent (O) for an invention, if the Registrar—

- (a) has examined the standard patent (O) application;
- (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 37W (where applicable); and
- (c) is of the opinion that the application, together with any requested amendment, does not comply with all the examination requirements.

## Division 6—Provisions on Standard Patent (O) Applications before Grant

### 37Z. Divisional standard patent (O) application

- (1) Subsection (2) applies if—
  - (a) a standard patent (O) application (*earlier application*) has been filed; and
  - (b) the applicant or the applicant's successor in title files a new standard patent (O) application that meets the conditions specified in subsection (3).
- (2) Subject to section 103(1)—
  - (a) the date of filing of the earlier application is regarded as the date of filing of the new application; and
  - (b) the new application enjoys the benefit of any right of priority.
- (3) The conditions are—
  - (a) the new application is filed—
    - (i) before the earlier application is withdrawn;
    - (ii) before the earlier application is regarded as being withdrawn;
    - (iii) if a standard patent (O) has been granted because of the earlier application, before preparations for publication under section 37X(2)(a) of the specification of the patent are completed; or
    - (iv) within the prescribed time after the earlier application is refused by the Registrar; and
  - (b) the new application—

- (i) is made in respect of any part of the subject-matter contained in the earlier application; and
- (ii) complies with the prescribed requirements.

### 37ZA. Amendment of standard patent (O) application before grant

- (1) Subject to section 103(2), the applicant of a standard patent (O) application may amend the application in accordance with the rules within the prescribed time.
- (2) The Registrar may, on the Registrar's initiative, amend the specification and abstract contained in a standard patent (O) application so as to acknowledge a registered trade mark.

### 37ZB. Withdrawal of standard patent (O) application

- (1) An applicant may, by written notice, withdraw a standard patent (O) application at any time before preparations for publication under section 37X(2)(a) of the specification of the standard patent (O) are completed.
- (2) A notice of withdrawal is irrevocable.

### 37ZC. Effect of withdrawal and refusal of standard patent (O) application

If a standard patent (O) application is withdrawn, is regarded as being withdrawn, or is refused, under this Ordinance—

- (a) section 9B(3) continues to apply as regards the application if the application has been published;
- (b) the applicant continues to enjoy, on the basis of the application, a right of priority under section 37C or

- 110 for filing a subsequent standard patent (O) application or short-term patent application; and
- (c) no other right may be claimed under this Ordinance in relation to the application.

**37ZD. Further processing of, and restoration of rights in respect of, standard patent (O) application**

- (1) Sections 28(1) and (2), 29(1), (2) and (3) and 30 apply, subject to the necessary modifications, to an application for a standard patent (O) as if—
- (a) a reference in those sections to an application or an applicant for a standard patent (R) were a reference to an application or an applicant for a standard patent (O);
- (b) a reference in those sections to Part 2 were a reference to this Part; and
- (c) the words “the request to record had been published under section 20” in section 29(3) were substituted by the words “the application had been published under section 37Q”.
- (2) Section 28(1) and (2), as applied by subsection (1), does not apply to—
- (a) a standard patent (O) application that is regarded as being withdrawn under section 37L(6) or 37T(2)(b); or
- (b) a standard patent (O) application that is refused under section 37Y because the applicant fails to comply with a time limit under the rules made for the purposes of section 37V or 37W.

- (3) Section 29(1) and (2), as applied by subsection (1), does not apply to a failure to comply with a time limit under section 37D, 37E, 37N, 37O, 37Z, 37ZA or 37ZB.”.

**46. Headings before section 38 substituted**

Headings before section 38—

**Repeal the headings**

**Substitute**

**“Part 4**

**Provisions on Patents after Grant**

**Division 1—Standard Patents”.**

**47. Section 38 amended (deemed date of filing where standard patent has been granted)**

- (1) Section 38, heading, after “standard patent”—

**Add**

**“(R)”.**

- (2) Section 38, after “standard patent” (wherever appearing)—

**Add**

**“(R)”.**

**48. Section 39 amended (term of standard patent)**

- (1) Section 39(1)(b)—

**Repeal**

everything after “beginning with”

**Substitute**

“—

- (i) for a standard patent (R), the deemed date of filing of the application for the patent;
- (ii) for a standard patent (O), the date of filing of the application for the patent.”.

(2) Section 39(3)—

**Repeal**

everything after “subsection (2)”

**Substitute**

“is—

- (a) for a standard patent (R), the anniversary of the deemed date of filing of the application for the patent first occurring after the date of grant of the patent;
- (b) for a standard patent (O), the anniversary of the date of filing of the application for the patent first occurring after the date of grant of the patent.”.

49. **Section 42 amended (determination after grant of questions referred before grant)**

Section 42—

**Repeal**

“section 13” (wherever appearing)

**Substitute**

“section 13 or 37H”.

50. **Section 43 amended (amendment of standard patent following opposition or revocation proceedings in the designated patent office)**

(1) Section 43, heading, after “standard patent”—

**Add**

“(R)”.

(2) Section 43, after “standard patent” (wherever appearing)—

**Add**

“(R)”.

(3) Section 43(1)—

**Repeal**

“Part II”

**Substitute**

“Part 2”.

(4) Section 43(5)—

**Repeal**

“103”

**Substitute**

“103(3)”.

51. **Section 44 amended (revocation of standard patent following opposition or revocation proceedings in the designated patent office)**

(1) Section 44, heading, after “standard patent”—

**Add**

“(R)”.

(2) Section 44(1), after “standard patent”—

**Add**

“(R)”.

- (3) Section 44(2) and (4)—

**Repeal**

“a patent”

**Substitute**

“a standard patent (R)”.

- (4) Section 44(6)—

**Repeal**

“a patent under”

**Substitute**

“a standard patent (R) under”.

- (5) Section 44(6)—

**Repeal**

“a patent,”

**Substitute**

“a standard patent (R),”.

**52. Section 45 and cross-heading before it repealed**

- (1) Cross-heading before section 45—

**Repeal the cross-heading.**

- (2) Section 45—

**Repeal the section.**

**53. Part 4, Division 2 heading added**

Before section 46—

**Add**

**“Division 2—Patents Generally”.**

**54. Section 46 substituted**

Section 46—

**Repeal the section**

**Substitute**

**“46. Application to amend specification after grant**

- (1) Subject to section 103(3), the proprietor of a patent may apply to amend the specification of the patent.
- (2) An application under subsection (1) must be made—
  - (a) for a standard patent (R), to the court;
  - (b) for a standard patent (O), to the Registrar or the court;
  - (c) for a short-term patent in respect of which a certificate of substantive examination has been issued, to the Registrar or the court.
- (3) The Registrar or the court (as the case requires) must, in accordance with the rules made by the Registrar or the court—
  - (a) publish an application to amend the specification of a patent;
  - (b) advertise the fact of the publication by notice in the official journal; and
  - (c) consider any opposition to the application filed within the prescribed time.
- (4) Despite subsection (3), the Registrar may decide not to publish the application or a part of the application if, in the Registrar’s opinion, the amendment proposed in the application or the part—

- (a) would cause the specification of the patent to contravene section 77 or 78;
  - (b) contains any matter that disparages any person in a way likely to damage the person;
  - (c) contains any matter the publication or working of which would—
    - (i) be contrary to public order (“ordre public”) or morality; or
    - (ii) be likely to encourage offensive, immoral or anti-social behaviour; or
  - (d) is invalid under section 103(3).
- (5) The Registrar or the court may by order—
- (a) allow an amendment to the specification of a patent; and
  - (b) attach conditions to the amendment that the Registrar or the court thinks fit.
- (6) No amendment may be allowed under subsection (5) if there are pending before the court proceedings in which the validity of the patent may be put in issue.
- (7) If an amendment to the specification of a patent is allowed by the Registrar or the court under subsection (5), 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.
- (8) The Registrar may, on the Registrar’s initiative, amend the specification of a patent so as to acknowledge a registered trade mark.
- (9) An amendment to the specification of a patent under this section has effect as from the grant of the patent.

- (10) The rules of court may provide for—
- (a) the manner in which an application under this section is to be made to the court;
  - (b) the notification of the application to the Registrar and the Registrar’s appearance in proceedings;
  - (c) the filing of opposition to the application; and
  - (d) the procedures for determining the application.
- (11) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 ( of 2015), continues to apply to an application that is filed with the court before that date to amend the specification of a patent.”.

**55. Section 49 amended (Registrar’s power to revoke patent on grounds of “ordre public” or morality)**

- (1) Section 49(1) and (3)—

**Repeal**

“section 93(5)”

**Substitute**

“section 9A(5)”.

- (2) Section 49(4)—

**Repeal**

“subsection (2)”

**Substitute**

“subsection (1)”.

**56. Part V heading substituted**

Part V, heading—

**Repeal the heading**

**Substitute**

**“Part 5**

**Property in Patents and Applications;  
Registration”.**

**57. Section 54 amended (co-ownership of patents and applications for patents)**

**(1) Section 54(3)—**

**Repeal**

“Subject to sections 13”

**Substitute**

“Subject to sections 13, 37H, 37I, 37J”.

**(2) Section 54(3)—**

**Repeal**

everything after “others”

**Substitute**

“—

(a) make an application for amending the specification of the patent or for revoking the patent; or

(b) grant a licence under the patent, or assign or mortgage a share in the patent.”.

**(3) Section 54(4), Chinese text—**

**Repeal**

“在符合該等條文的規定下”

**Substitute**

“除該等條文另有規定外”.

**58. Section 55 amended (determination of right to patent after grant)**

**(1) Section 55(4)—**

**Repeal**

“103”

**Substitute**

“103(1)”.

**(2) Section 55(4), Chinese text—**

**Repeal**

“事宜” (wherever appearing)

**Substitute**

“事項”.

**(3) Section 55(5)(a)—**

**Repeal**

“and”.

**(4) Section 55(5)(b), after “standard patent”—**

**Add**

“(R)”.

**(5) Section 55(5)(b)—**

**Repeal the full stop**

**Substitute**

“; and”.

**(6) After section 55(5)(b)—**

**Add**

“(c) as having the benefit of any right of priority enjoyed by the patent, which is the subject of the unconditional or conditional revocation (as the case may be).”.



(7) Section 55(6), after “standard patent”—

**Add**

“(R)”.

**59. Section 56 amended (effect of transfer of patent under section 55)**

(1) Section 56, Chinese text, heading—

**Repeal**

“效力”

**Substitute**

“影響”.

(2) Section 56—

**Repeal subsection (3)**

**Substitute**

“(3) If an order referred to in subsection (2) is made, an old proprietor or a licensee of the patent who meets the conditions specified in subsection (3B) is entitled to be granted a licence (but not an exclusive licence) by the new proprietor or proprietors of the patent to continue working or to work, as the case may be, the invention which is the subject of the patent.

(3A) If a new application for a patent is made in accordance with an order under section 55(4), an old proprietor or a licensee of the original patent who meets the conditions specified in subsection (3B) is entitled to be granted a licence (but not an exclusive licence) by the applicant of the new application to continue working or to work, as the case may be, the invention for which the original patent was granted, so far as it is the subject of the new application.

(3B) The conditions are—

(a) the old proprietor or licensee, acting in good faith before the reference that results in the making of the order—

(i) worked the invention in Hong Kong; or

(ii) made effective and serious preparations to do so; and

(b) the old proprietor or licensee makes a request for licence to the new proprietor or proprietors of the patent, or the applicant of the new application, as the case may be, within the prescribed time.”.

(3) Section 56(5), after “patent”—

**Add**

“, or the applicant of the new application, as the case may be,”.

**60. Part VI heading substituted**

Part VI, heading—

**Repeal the heading**

**Substitute**

**“Part 6**

**Employees’ Inventions”.**

**61. Part VII heading substituted**

Part VII, heading—

**Repeal the heading**

**Substitute**

## **“Part 7**

### **Contracts as to Patented Products etc.”.**

#### **62. Part VIII heading substituted**

Part VIII, heading—

**Repeal the heading**

**Substitute**

## **“Part 8**

### **Compulsory Licences for Standard Patents”.**

#### **63. Part IX heading substituted**

Part IX, heading—

**Repeal the heading**

**Substitute**

## **“Part 9**

### **Government Use of Patented Inventions”.**

#### **64. Section 69 amended (Government use of patents during a period of extreme urgency)**

Section 69(4)(b)—

**Repeal**

everything after “otherwise than”

**Substitute**

“in confidence after the material date of the patent application or of the patent for the invention.”.

#### **65. Part IXA heading substituted**

Part IXA, heading—

**Repeal the heading**

**Substitute**

## **“Part 9A**

### **Import Compulsory Licences for Patented Pharmaceutical Products”.**

#### **66. Section 72A heading amended (interpretation of Part IXA)**

Section 72A, heading—

**Repeal**

**“Part IXA”**

**Substitute**

**“Part 9A”.**

#### **67. Part IXB heading substituted**

Part IXB, heading—

**Repeal the heading**

**Substitute**

## **“Part 9B**

### **Export Compulsory Licences for Patented Pharmaceutical Products”.**

#### **68. Section 72K amended (interpretation of Part IXB)**

(1) Section 72K, heading—

**Repeal**

**“Part IXB”**

**Substitute**

**“Part 9B”.**

- (2) Section 72K, definition of *Hong Kong patent number*, paragraph (a)—

**Repeal**

“certificate”

**Substitute**

“certificate of grant”.

- (3) Section 72K, definition of *Hong Kong patent number*, after paragraph (a)—

**Add**

“(ab) a number assigned by the Registrar to a certificate of grant issued in respect of the patent under section 37X(2)(b);”.

**69. Part X heading substituted**

Part X, heading—

**Repeal the heading**

**Substitute**

**“Part 10**

**Effects of Patent and Patent Application”.**

**70. Section 78 substituted**

Section 78—

**Repeal the section**

**Substitute**

**“78. Claims**

- (1) The claims contained in the specification of a patent application or of a patent must—
- (a) define the matter for which protection is sought or given;
  - (b) be clear and concise;
  - (c) be supported by the description in the specification; and
  - (d) relate to 1 invention or to a group of inventions that are so linked as to form a single inventive concept.
- (2) The rules may provide for the circumstances under which a group of inventions are to be regarded as being so linked as to form a single inventive concept.
- (3) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 ( of 2015), continues to apply to a patent application filed, or a patent the application for which is filed, before that date.”.

**71. Section 79 amended (the abstract)**

Section 79—

**Repeal**

“section 94(3)”

**Substitute**

“section 9B(3)”.

**72. Part XI heading substituted**

Part XI, heading—

**Repeal the heading**

**Substitute**

**“Part 11**

**Infringement”.**

**73. Section 80 amended (proceedings for infringement of patent)**

Section 80(1), after “this Part”—

**Add**

“and section 129(1)”.

**74. Section 81 amended (restrictions on recovery of damages for infringement)**

(1) Section 81(3)—

**Repeal**

“during any”

**Substitute**

“during the”.

(2) Section 81(3)—

**Repeal**

“specified under”

**Substitute**

“specified in”.

(3) Section 81(5)—

**Repeal**

“section 46(1)”

**Substitute**

“section 46(5)”.

(4) Section 81(5)—

**Repeal**

“of section 46(5)”

**Substitute**

“of section 46(7)”.

**75. Section 83 amended (right to continue use begun before priority date)**

Section 83—

**Repeal subsection (1)**

**Substitute**

“(1) A person has the rights specified in subsection (2) if the person, in Hong Kong and before the material date of a patent—

(a) does in good faith an act that would constitute an infringement of the patent if the patent were in force; or

(b) makes in good faith effective and serious preparations to do such an act.”.

**76. Section 88 amended (infringement of rights conferred by publication of application for standard patent)**

(1) Section 88(2)(b), after “purpose”—

**Add**

“, for a standard patent (R),”.

(2) Section 88(3)(b)—

**Repeal**

“date of publication of the request to record”

**Substitute**

“publication date of the request to record (for a standard patent (R)) or the publication date of the patent application (for a standard patent (O))”.

- (3) Section 88(3)(b), before the full stop—

**Add**

“or published application”.

**77. Section 89 amended (remedy for groundless threats of infringement proceedings)**

- (1) Section 89(2)—

**Repeal**

“In”

**Substitute**

“Subject to section 89A, in”.

- (2) Section 89(2)—

**Repeal**

everything after “relief claimed”

**Substitute a full stop.**

- (3) After section 89(5)—

**Add**

“(6) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 ( of 2015), continues to apply to proceedings brought under subsection (1) in respect of a threat that is made before that date.”.

**78. Section 89A added**

After section 89—

**Add**

**“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.
- (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);

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

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

## 79. Part XII heading substituted

Part XII, heading—

**Repeal the heading**

**Substitute**

**“Part 12**

**Revocation of Patents”.**

## 80. Cross-heading before section 91 repealed

Cross-heading before section 91—

**Repeal the cross-heading.**

## 81. Section 91 amended (power to revoke patents on application)

- (1) Section 91(1)(d)—

**Repeal**

“section 22 or 116”

**Substitute**

“section 22, 37Z or 116”.

- (2) Section 91(1)(d), Chinese text—

**Repeal**

“事宜” (wherever appearing)

**Substitute**

“事項”.

- (3) Section 91(1)—

**Repeal paragraph (f)**

**Substitute**

“(f) that the patent is one of 2 patents that—

- (i) are granted for the same invention made by the same inventor; and
- (ii) have the same material date;”.
- (4) Section 91(1)—  
**Repeal paragraphs (g) and (h).**
- (5) Section 91(1)(i), after “standard patent”—  
**Add**  
“(R)”.
- (6) Section 91(2)(b)—  
**Repeal**  
“subsection (1)(a) to (h)”  
**Substitute**  
“subsection (1)(a), (b), (c), (d), (e) and (f)”.
- (7) Section 91—  
**Repeal subsection (3).**
- (8) At the end of section 91—  
**Add**  
“(4) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 ( of 2015), continues to apply to a patent the application for which is filed before that date.”.

**82. Section 92 amended (application for revocation)**

- (1) Section 92(1)(a), Chinese text—  
**Repeal**  
“事宜”  
**Substitute**

- “事項”.
- (2) Section 92(2)—  
**Repeal**  
“(g) or (h),”.
- (3) Section 92(2)—  
**Repeal**  
“same invention” (wherever appearing)  
**Substitute**  
“same invention made by the same inventor”.
- (4) After section 92(2)—  
**Add**  
“(3) This section, as in force immediately before the commencement date of the Patents (Amendment) Ordinance 2015 ( of 2015), continues to apply to a patent the application for which is filed before that date.”.

**83. Sections 93 to 100 and cross-headings repealed**

- (1) Cross-heading before section 93—  
**Repeal the cross-heading.**
- (2) Sections 93, 94, 95, 96 and 97—  
**Repeal the sections.**
- (3) Cross-heading before section 98—  
**Repeal the cross-heading.**
- (4) Sections 98 and 99—  
**Repeal the sections.**
- (5) Cross-heading before section 100—

**Repeal the cross-heading.**

(6) Section 100—

**Repeal the section.**

**84. Cross-heading before section 101 repealed**

Cross-heading before section 101—

**Repeal the cross-heading.**

**85. Section 101 amended (proceedings in which validity of patent may be put in issue)**

(1) Section 101(1)(e)—

**Repeal the full stop**

**Substitute**

“; and”.

(2) After section 101(1)(e)—

**Add**

“(f) in proceedings commenced under section 129(1)(b).”.

**86. Section 101A added**

After section 101—

**Add**

**“101A. Powers of court in validity proceedings in relation to short-term patents**

(1) Without limiting section 101, the court may, in any validity proceedings in relation to a short-term patent, exercise any of its powers under this section.

(2) If the short-term patent has not been subjected to a substantive examination, the court may—

(a) direct the proprietor of the patent to request the Registrar to carry out the examination; and

(b) stay the proceedings pending the outcome of the examination.

(3) If the short-term patent is being subjected to a substantive examination, the court may—

(a) direct the examination to be suspended; or

(b) stay the proceedings pending the outcome of the examination.

(4) If the substantive examination of a short-term patent has been suspended under subsection (3)(a), the court may, after the validity proceedings have been disposed of, order—

(a) the examination to be resumed, on the conditions that the court thinks fit; or

(b) the examination to be terminated.

(5) In this section—

***validity proceedings*** (有效性法律程序) means any proceedings in which the validity of a patent is put in issue under section 101(1).”.

**87. Part XIII heading substituted**

Part XIII, heading—

**Repeal the heading**

**Substitute**



### **“Part 13**

#### **General Provisions on Amendment of Patents and Patent Applications”.**

**88. Section 102 amended (amendment of patent in infringement or revocation proceedings)**

Section 102(1)—

**Repeal**

“103”

**Substitute**

“103(3)”.

**89. Section 103 amended (amendments of applications and patents not to include added matter)**

(1) Section 103(1)(b), English text—

**Repeal**

“, as filed” (wherever appearing)

**Substitute**

“as filed”.

(2) Section 103(1)—

**Repeal**

“may be filed under section 55(4), or as mentioned in section 22 or 116 (as may be appropriate), but shall be”

**Substitute**

“is”.

(3) Section 103(1)—

**Repeal**

“the application as filed”

**Substitute**

“the earlier application as filed, or the application for the patent as filed”.

(4) Section 103(2)—

**Repeal**

“a standard patent filed under section 31 shall be”

**Substitute**

“a patent is”.

(5) Section 103(3)—

**Repeal**

“a patent filed under section 46(1) or 102, or of the specification of a standard patent filed under section 43 shall be”

**Substitute**

“a patent is”.

**90. Part XIV heading substituted**

Part XIV, heading—

**Repeal the heading**

**Substitute**

### **“Part 14**

#### **Language of Proceedings and Authentic Text”.**

**91. Section 104 amended (language of proceedings before Registrar)**

Section 104(3), after “standard patent”—

Clause 92

92

**Add**

“(R)”.

**92. Section 106 amended (authentic text of standard patent and standard patent application)**

(1) Section 106, heading—

**Repeal**

“standard patent” (wherever appearing)

**Substitute**

“standard patent (R)”.

(2) Section 106(1), (2) and (3), after “standard patent” (wherever appearing)—

**Add**

“(R)”.

**93. Part XV heading substituted**

Part XV, heading—

**Repeal the heading**

**Substitute**

**“Part 15**

**Short-term Patents”.**

**94. Section 108 and cross-heading before it repealed**

(1) Cross-heading before section 108—

**Repeal the cross-heading.**

(2) Section 108—

**Repeal the section.**

Clause 95

93

**95. Cross-heading before section 109 repealed**

Cross-heading before section 109—

**Repeal the cross-heading.**

**96. Part 15, Division 1 heading and section 108A added**

Before section 109—

**Add**

**“Division 1—Novelty and Priority**

**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 WTO member country, territory or area.”.

**97. Section 109 amended (non-prejudicial disclosure)**

(1) Section 109—

**Repeal**

“section 94, a disclosure of the”

**Substitute**

“section 9B, a disclosure of an”.

(2) Section 109(a)—

**Repeal**

“any proprietor”

**Substitute**

“a proprietor”.

(3) Section 109(b)—

**Repeal**

“his legal predecessor has”

**Substitute**

“a proprietor of the invention for the time being had”.

(4) Section 109—

**Repeal**

everything after “that the invention”

**Substitute**

“had been so displayed and contains the prescribed written evidence in support of the statement.”.

**98. Cross-heading before section 110 repealed**

Cross-heading before section 110—

**Repeal the cross-heading.**

**99. Section 110 amended (priority right)**

(1) Section 110—

**Repeal subsection (1)**

**Substitute**

“(1) Subsection (1A) applies if a person has filed—

- (a) a non-Hong Kong application for an invention; or
- (b) a Hong Kong application for an invention.

(1A) The person or the person’s successor in title enjoys, for the purpose of filing a subsequent short-term patent application for the same invention, a right of priority for the period of 12 months after the date of filing of the

first non-Hong Kong application or Hong Kong application, subject to compliance with the prescribed conditions.”.

(2) Section 110(2)—

**Repeal**

“subsection (1) as it applies in the case of a filing specified in paragraph (a) of that subsection”

**Substitute**

“subsection (1A)”.

(3) Section 110(2)(a)—

**Repeal**

everything before “recognized as”

**Substitute**

“(a) every filing of a non-Hong Kong application that is equivalent to a regular national filing under the domestic legislation of the place in or for which the application is filed, or under bilateral or multilateral agreements, is to be”.

(4) Section 110(2)(b)—

**Repeal**

everything before “be considered”

**Substitute**

“(b) a subsequent non-Hong Kong application for the same subject-matter as in a previous first non-Hong Kong application and filed in or for the same place is to”.

(5) Section 110(2)(b), after the semicolon—

**Add**

“and”.

- (6) Section 110(2)(c)—

**Repeal**

“application for a patent or other protection”

**Substitute**

“non-Hong Kong application”.

- (7) Section 110(2)(c)—

**Repeal**

“application may not thereafter”

**Substitute**

“non-Hong Kong application may not later”.

- (8) Section 110(3)—

**Repeal**

“subsection (1) as it applies in the case of a filing specified in paragraph (b) of that subsection”

**Substitute**

“subsection (1A)”.

- (9) Section 110(3)(a)—

**Repeal**

“an application for a short-term patent under this Part shall be”

**Substitute**

“a Hong Kong application is to be”.

- (10) Section 110(3)(b)—

**Repeal**

everything before “be considered”

**Substitute**

“(b) a subsequent Hong Kong application for the same subject-matter as in a previous first Hong Kong application is to”.

- (11) Section 110(3)(b), after the semicolon—

**Add**

“and”.

- (12) Section 110(3)(c)—

**Repeal**

“application for a short-term patent” (wherever appearing)

**Substitute**

“Hong Kong application”.

- (13) Section 110(3)(c), English text—

**Repeal**

“thereafter”

**Substitute**

“later”.

- (14) Section 110(3)—

**Repeal**

““regular filing of an application for a short-term patent” (短期專利申請的正規提交)”

**Substitute**

“*regular filing of a Hong Kong application* (香港申請的正規提交)”.

- (15) Section 110(3)—

**Repeal**

“application for the short-term patent”

**Substitute**

“Hong Kong application”.

(16) Section 110(3A)—

**Repeal**

everything before “may be assigned”

**Substitute**

“(3A) A right of priority that arises as a result of a non-Hong Kong application or Hong Kong application for an invention”.

(17) Section 110(3A)—

**Repeal**

“subsection (1) to the person’s “successors in title””

**Substitute**

“subsection (1A) to a person’s successor in title”.

(18) Section 110—

**Repeal subsection (4).**

**100. Section 110A added**

After section 110—

**Add**

**“110A. Restoration of priority right**

(1) This section applies if—

- (a) a person files a non-Hong Kong application or Hong Kong application for an invention; and
- (b) the person or the person’s successor in title files a subsequent short-term patent application for the same invention within 2 months after the expiry of the 12-month period referred to in section 110(1A).

(2) The applicant of the subsequent short-term patent application may apply to the Registrar for restoring the priority right of the patent application.

(3) The application for restoring the priority right (*restoration application*) must be made in the prescribed manner before the earlier of the following—

- (a) the end of 2 months after the expiry of the 12-month period;
- (b) the date on which preparations for publication under section 118(2) of the short-term patent granted because of the subsequent short-term patent application are completed.

(4) A restoration application is to be regarded as being made only if the prescribed fee for the application is paid.

(5) The Registrar may approve a restoration application if the Registrar is satisfied that the applicant failed to file the subsequent short-term patent application within the 12-month period even though the applicant had taken all reasonable care required by the circumstances.”.

**101. Section 111 amended (claiming priority)**

(1) Section 111(1)—

**Repeal**

“shall file in the prescribed manner”

**Substitute**

“must file, in the prescribed manner and within the prescribed time,”.

(2) Section 111(6)—

**Repeal**

“Where”

**Substitute**

“Subject to section 127C(3)(a), where”.

**102. Section 112 amended (effect of priority right)**

Section 112(1)—

**Repeal**

“section 94(2) and (3) as it applies to this Part”

**Substitute**

“this Ordinance”.

**103. Part 15, Division 2 heading and section 112A added**

After section 112—

**Add**

**“Division 2—Applications for Short-term Patents**

**112A. Application may be made alone or jointly**

- (1) An application for a short-term patent for an invention may be made by a person alone or jointly with any other person.
- (2) For the purpose of proceedings before the Registrar, the applicant is to be regarded as being entitled to exercise the right to the short-term patent.”.

**104. Cross-heading before section 113 repealed**

Cross-heading before section 113—

**Repeal the cross-heading.**

**105. Section 113 amended (requirements of short-term patent application)**

**(1) Section 113—**

**Repeal subsection (1)**

**Substitute**

- “(1) A short-term patent application must—
- (a) be signed by the applicant; and
  - (b) be filed with the Registrar in the prescribed manner.
- (1A) A short-term patent application must contain—
- (a) a request for the grant of a short-term patent;
  - (b) a specification that provides for—
    - (i) a description of the invention which is the subject of the application;
    - (ii) one or more claims but not exceeding 2 independent claims; and
    - (iii) any drawing referred to in the description or the claim or claims;
  - (c) an abstract;
  - (d) a search report in relation to the invention;
  - (e) if the applicant desires to claim non-prejudicial disclosure of the invention under section 109(b), the statement and evidence required under section 109;
  - (f) if the applicant desires to take advantage of the priority of a previous application, a statement of priority and a copy of the previous application required under section 111(1);

- (g) if applicable, a request for deferring the grant of a short-term patent under section 119; and
  - (h) if the invention requires for its performance the use of a micro-organism, information on the availability of samples of the micro-organism to the public (if any).”.
- (2) Section 113—
- Repeal subsection (2)**
- Substitute**
- “(2) A short-term patent application—
- (a) must state the name and address of the applicant;
  - (b) must—
    - (i) identify each inventor of the invention; and
    - (ii) specify the last known address of each inventor (unless the inventor is also the applicant);
  - (c) if the applicant is not an inventor, must contain a statement in the specified form indicating how the applicant becomes entitled to apply for a short-term patent for the invention; and
  - (d) must specify an address in Hong Kong for service of documents.”.
- (3) Section 113(3), Chinese text—
- Repeal**
- “其中” (wherever appearing).
- (4) Section 113(4)—
- Repeal**
- “provide”.

- (5) Section 113(4)(a), before “that a short-term patent”—
- Add**
- “provide”.
- (6) Section 113(4)(a), after the semicolon—
- Add**
- “and”.
- (7) Section 113(4)—
- Repeal paragraph (b)**
- Substitute**
- “(b) provide for the requirements of a short-term patent application for an invention that involves nucleotide and amino acid sequences.”.
- (8) Section 113(5)—
- Repeal**
- everything after “within that period or”
- Substitute**
- “the grace period provided in the rules, the application is to be regarded as being withdrawn.”.
- (9) Section 113—
- Repeal subsection (6).**
- (10) Section 113(7)—
- Repeal**
- “section 114(2)”
- Substitute**
- “section 114(3)”.
- (11) After section 113(7)—
- Add**

“(7A) 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.”.

**106. Section 114 substituted**

Section 114—

**Repeal the section**

**Substitute**

**“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 WTO member country, territory or area;
  - (b) a standard patent (O) application; or
  - (c) a short-term patent application.”.

**107. Sections 114A and 114B added**

After section 114—



**Add**

**“114A. Filing of missing description or missing drawing**

- (1) The Registrar may, by written notice, require the applicant of a short-term patent application to file a missing description or missing drawing in the prescribed manner and within the prescribed time.
- (2) The applicant may also, on the applicant's own initiative, file a missing description or missing drawing in the prescribed manner and within the prescribed time.
- (3) If the short-term patent application has been accorded a date of filing in accordance with section 114(2), then on the filing of a missing description or missing drawing, the date of filing is to be changed to the date on which the description or drawing is filed.
- (4) The Registrar must, by written notice, inform the applicant of the change of the date of filing.
- (5) Subsection (3) does not apply if—
  - (a) the applicant has claimed priority of a previous application under section 111;
  - (b) the missing description or missing drawing is completely contained in the previous application;
  - (c) when filing the description or drawing, the applicant makes, in accordance with the rules, a request that the date of filing accorded in accordance with section 114(2) remains unchanged; and
  - (d) the applicant files within the prescribed time—
    - (i) a copy of the previous application;

- (ii) if the previous application is not in one of the official languages, its translation in one of the official languages; and
- (iii) a statement indicating the location of the description or drawing in the previous application and, if applicable, in its translation.

(6) In this section—

**missing description** (欠交説明) means a part of the description of an invention referred to in section 113(1A)(b)(i), that has not been filed in a short-term patent application;

**missing drawing** (欠交繪圖) means a drawing referred to in section 113(1A)(b)(iii), that has not been filed in a short-term patent application.

**114B. Missing description or missing drawing not filed or withdrawn**

- (1) If any missing description or missing drawing as defined by section 114A(6) is not filed within the prescribed time under section 114A(1) or (2), any reference to the description or drawing in the specification contained in the short-term patent application under section 113(1A)(b) is to be regarded as being deleted.
- (2) If a notice of change of the date of filing is issued under section 114A(4), the applicant of the short-term patent application may, within 1 month after the date of the notice, withdraw the missing description or missing drawing that has been filed.
- (3) On the withdrawal of the description or drawing—

- (a) any reference to the description or drawing in the specification contained in the patent application under section 113(1A)(b) is to be regarded as being deleted;
- (b) the description or drawing is to be regarded as not having been filed; and
- (c) the original date of filing of the patent application accorded in accordance with section 114(2) is to remain unchanged.”.

**108. Section 115 amended (examination as to formal requirements)**

- (1) Section 115(1)—

**Repeal**

everything after “is not”

**Substitute**

“regarded as being withdrawn under section 113(5), the Registrar must examine the application to ascertain whether the requirements of section 113 and of any rules made for the purposes of that section (*formal requirements*) have been complied with.”.

- (2) After section 115(1)—

**Add**

“(1A) If there are deficiencies in the application as regards the formal requirements that cannot be corrected, the application must be refused.”.

- (3) Section 115—

**Repeal subsections (2) and (3)**

**Substitute**

“(2) If there are deficiencies in the application 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) Section 115(4)—

**Repeal**

“duly corrected then such right shall be”

**Substitute**

“duly corrected, then only the right is”.

**109. Section 116 amended (divisional short-term patent application)**

Section 116(c)—

**Repeal**

“103”

**Substitute**

“103(1)”.

**110. Section 117 amended (formality examination only)**

Section 117—

**Repeal paragraph (d)**

**Substitute**

“(d) any matter specified in section 9A, 9B, 9C, 9D, 9E, 9F, 77, 78, 79, 103, 109, 110, 111(2), (3), (4), (5) or (6) or 113(1A)(b)(ii).”.

**111. Heading before section 118 substituted**

Heading before section 118—

**Repeal the heading**

**Substitute**

**“Division 3—Procedures up to and Including Grant”.**

**112. Section 118 amended (grant of short-term patent and publication)**

(1) Section 118(1)—

**Repeal**

“deficiencies noted by the Registrar”

**Substitute**

“deficiencies”.

(2) Section 118(2)(a), Chinese text—

**Repeal**

“或名稱；”

**Substitute a semicolon.**

**113. Section 120 amended (amendment of application for short-term patent before grant)**

(1) Section 120(1)—

**Repeal**

“103”

**Substitute**

“103(2)”.

(2) Section 120—

**Repeal subsection (2).**

**114. Section 121 amended (withdrawal of application)**

(1) Section 121(2)—

**Repeal**

“deemed”

**Substitute**

“regarded”.

(2) Section 121(2)(a)—

**Repeal**

everything after “continue to enjoy”

**Substitute**

“, on the basis of the application, a right of priority under section 37C or 110 for filing a subsequent standard patent (O) application or short-term patent application;”.

**115. Section 123 amended (further processing of, and restoration of rights in respect of, short-term patent applications)**

(1) Section 123(1)—

**Repeal**

“, 29(1) and (2) and 30 shall apply”

**Substitute**

“and 29(1) and (2) apply”.

(2) Section 123(1), after “sections to an application”—

**Add**

“or an applicant”.

(3) Section 123(1), after “standard patent”—

**Add**

“(R)”.

- (4) Section 123(1)—  
**Repeal**  
 “Part II”  
**Substitute**  
 “Part 2”.
- (5) Section 123(1), after “reference to an application”—  
**Add**  
 “or an applicant”.
- (6) Section 123(2)—  
**Repeal**  
 everything after “does not apply”  
**Substitute**  
 “to a short-term patent application that is regarded as being withdrawn under section 113(5).”.
- (7) Section 123(3)—  
**Repeal**  
 “section 113, 114 or 115”  
**Substitute**  
 “section 110A, 111, 113, 114, 114A, 114B, 115, 116, 120 or 121”.
- (8) After section 123(3)—  
**Add**  
 “(4) 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.”.

- 116. Section 124 amended (Registrar may refuse to grant short-term patent)**  
 Section 124—  
**Repeal**  
 “section 93(5)”  
**Substitute**  
 “section 9A(5)”.
- 117. Section 125 amended (short-term patent application based on international application)**  
 (1) Section 125(1), after “a patent for”—  
**Add**  
 “invention or a patent for”.  
 (2) Section 125(4)—  
**Repeal**  
 “subsection (1)(b)”  
**Substitute**  
 “subsection (1A)(b)”.
- (3) Section 125(6), after “inventions”—  
**Add**  
 “and patents for utility models”.
- 118. Heading before section 126 substituted**  
 Heading before section 126—  
**Repeal the heading**  
**Substitute**

**“Division 4—Provisions on Short-term Patents after Grant”.**

**119. Section 126A added**

After section 126—

**Add**

**“126A. Observations by third parties on patentability of short-term patents**

- (1) After a short-term patent for an invention has been granted, any person may file with the Registrar a written notice of the person’s observations on the patentability of the invention.
- (2) The notice must—
  - (a) set out the observations and the grounds for the observations; and
  - (b) be filed in the prescribed manner and within the prescribed time.
- (3) The Registrar must, as soon as practicable after receiving a notice under subsection (1), send a copy of the notice to the proprietor of the short-term patent.
- (4) If the short-term patent is being subjected to a substantive examination, the Registrar must consider the observations when deciding whether to issue a certificate of substantive examination in respect of the patent.
- (5) A person does not become a party to any proceedings under this Ordinance only because the person files a notice under subsection (1).”.

**120. Part 15, Division 5 added**

After section 127—

**Add**

**“Division 5—Substantive Examination of Short-term Patents**

**127A. Interpretation of Division 5 of Part 15**

In this Division—

*examination requirement* (審查規定) means a requirement specified in section 127C(2);

*unfulfilled requirement* (不獲符合的規定), for a short-term patent, means an examination requirement that—

- (a) in the Registrar’s opinion, is not complied with by the patent; and
- (b) is set out in the notice to the proprietor of the patent under section 127D(2).

**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.
- (4) A request for substantive examination of a short-term patent may not be withdrawn.

**127C. Substantive examination by Registrar**

- (1) On receiving a request for substantive examination of a short-term patent, the Registrar must examine the patent and consider any requested amendment filed under section 127B(1)(b) to determine whether the patent, together with the amendment (if allowed), complies with all the requirements specified in subsection (2).
- (2) The requirements are—
  - (a) the invention, which is the subject of the patent, is patentable under section 9A;
  - (b) the specification of the patent discloses the invention in accordance with section 77;
  - (c) the specification provides for not more than 2 independent claims, as required under section 113(1A)(b)(ii);
  - (d) all the claims contained in the specification comply with the requirements of section 78(1);
  - (e) the matter disclosed in the specification of the patent does not extend beyond that disclosed in—
    - (i) the patent application as filed; and

- (ii) if the patent was granted because of a specified new application, the earlier short-term patent application as filed;
- (f) the protection conferred by the patent has not been extended by an amendment to its specification;
- (g) the patent is not one of 2 patents that—
  - (i) are granted for the same invention made by the same inventor; and
  - (ii) have the same material date.
- (3) In examining a short-term patent to determine whether the patent complies with the requirement specified in subsection (2)(a), the Registrar must have regard to—
  - (a) if a claim for priority of a previous application has been made in respect of the patent application under section 111, whether the applicant is entitled to the priority claimed; and
  - (b) if a missing description or missing drawing as defined by section 114A(6) has been filed, whether the date of filing of the patent application remains unchanged.
- (4) The Registrar must carry out the examination in accordance with the rules.
- (5) In subsection (2)(e)(ii)—
 

***specified new application*** (指明新申請) means—

  - (a) a new short-term patent application made in accordance with an order under section 55(4); or
  - (b) a new short-term patent application referred to in section 116.

**127D. Proprietor may file representations and requests for amendment, etc.**

- (1) If the Registrar is of the opinion that a short-term patent, together with any requested amendment under section 127B(1)(b) (if allowed), does not comply with any examination requirement, the Registrar must, by written notice, inform the proprietor of the patent of the opinion.
- (2) The notice must set out each examination requirement that, in the Registrar's opinion, is not complied with by the patent.
- (3) The proprietor may respond to the notice by filing, in accordance with the rules, any or all of the following—
  - (a) a representation to establish that the patent complies with an unfulfilled requirement;
  - (b) subject to section 103(3), a request to amend the specification of the patent to enable the patent to comply with an unfulfilled requirement;
  - (c) a request to review the Registrar's opinion.

**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 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.

**127F. Certificate of substantive examination**

- (1) The Registrar must issue a certificate of substantive examination in respect of a short-term patent, if the Registrar—

- (a) has examined the patent and considered any requested amendment filed under section 127B(1)(b);
  - (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 127E(1) (where applicable); and
  - (c) is of the opinion that the patent, together with any amendment allowed under section 127E, complies with all the examination requirements.
- (2) As soon as practicable after the certificate is issued, the Registrar must—
- (a) inform the following persons by written notice that the certificate has been issued—
    - (i) the proprietor of the patent; and
    - (ii) the person who has requested the substantive examination (if that person is not the proprietor);
  - (b) send the certificate to the proprietor; and
  - (c) enter a record of the issue of the certificate in the register.

**127G. Revocation of short-term patents**

- (1) The Registrar must revoke a short-term patent if the Registrar—
- (a) has examined the patent and considered any requested amendment filed under section 127B(1)(b);
  - (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 127E(1) (where applicable); and

- (c) is of the opinion that the patent, together with any amendment allowed under section 127E, does not comply with all the examination requirements.
- (2) As soon as practicable after the patent is revoked, the Registrar must—
- (a) inform the following persons by written notice that the patent has been revoked—
    - (i) the proprietor of the patent; and
    - (ii) the person who has requested the substantive examination (if that person is not the proprietor);
  - (b) advertise the fact of the revocation by notice in the official journal; and
  - (c) enter a record of the revocation in the register.”.

**121. Heading before section 128 substituted**

Heading before section 128—

**Repeal the heading**

**Substitute**

**“Division 6—Miscellaneous”.**

**122. Section 128 repealed (disclosure of invention by specification; availability of samples of micro-organisms)**

Section 128—

**Repeal the section.**

**123. Section 129 amended (court proceedings in relation to short-term patents)**

- (1) Section 129—



**Renumber subsections (1), (2) and (3) as subsections (2), (4) and (5) respectively.**

(2) Before section 129(2)—

**Add**

“(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.”.

(3) Section 129(2)—

**Repeal**

“proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to a short-term patent”

**Substitute**

“enforcement proceedings”.

(4) Section 129(2)(a)—

**Repeal**

“patent to”

**Substitute**

“short-term patent to”.

(5) After section 129(2)—

**Add**

“(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.”.

(6) Section 129(4)—

**Repeal**

“in proceedings before the court under this Ordinance in relation to a short-term patent”

**Substitute**

“, in enforcement proceedings,”.

(7) Section 129(5)—

**Repeal**

“subsection (2)”

**Substitute**

“subsection (4)”.

(8) After section 129(5)—

**Add**

“(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.”.

**124. Part XVI heading substituted**

Part XVI, heading—

**Repeal the heading**

**Substitute**

**“Part 16**

**Miscellaneous”.**

**125. Section 138 amended (licences granted by order of the court or Registrar or by Director of Health)**

Section 138(1), after “section 14,”—

**Add**

“37K,”.

**126. Section 139A amended (protection of Government and public officers)**

Section 139A(2)—

**Repeal**

“Part IX, IXA or IXB”

**Substitute**

“Part 9, 9A or 9B”.

**127. Part XVII heading substituted**

Part XVII, heading—

**Repeal the heading**

**Substitute**

**“Part 17**

**Offences”.**

**128. Section 143 amended (unauthorized claim that patent has been applied for)**

(1) Section 143(1)(b), after “has been”—

**Add**

“refused,”.

(2) Section 143(2), after “begins with the”—

**Add**

“refusal,”.

**129. Section 144A added**

After section 144—

**Add**

**“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.
- (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)."

**130. Part XVIII heading substituted**

Part XVIII, heading—

**Repeal the heading**

**Substitute**

**“Part 18**

**Administrative Provisions”.**

**131. Section 147 amended (information about patent applications and patents, and inspection of documents)**

- (1) Section 147(1), after “section 20”—

**Add**

“or 37Q”.

- (2) Section 147(4), after “section 20”—

**Add**

“or 37Q (as the case requires)”.

- (3) Section 147(6), after “section 13”—

**Add**

“or 37J”.

**132. Section 149 amended (rules)**

- (1) Section 149(2)—

**Repeal**

“prejudice to the generality of”

**Substitute**

“limiting”.

- (2) After section 149(2)—

**Add**

“(2A) Without limiting subsection (1), the rules may, in relation to an invention that requires for its performance the use of a micro-organism—

- (a) provide for the manner in which information on the availability of samples of the micro-organism to the public (if any) is to be contained in a standard patent (O) application or a short-term patent application for the invention;
- (b) provide for the circumstances under which the patent application or the specification of the patent granted is to be regarded as having disclosed the invention in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art;
- (c) require the applicant for or proprietor of the patent—
  - (i) to take specified steps to make the samples available to the public; and
  - (ii) not to impose or maintain restrictions on the use of the samples, unless expressly provided otherwise; and
- (d) provide for the circumstances under which the samples need only be made available to a person or a description of persons.”.

**133. Part XIX heading substituted**

Part XIX, heading—

**Repeal the heading**

**Substitute**

**“Part 19**

**Repeals and Transitional Arrangements”.**

**134. Section 159 heading amended (interpretation (Part XIX))**

Section 159, heading—

**Repeal**

**“(Part XIX)”**

**Substitute**

**“(Part 19)”.**

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### Explanatory Memorandum

The object of this Bill is to amend the Patents Ordinance (Cap. 514) (*Ordinance*) for the purposes set out in the long title.

2. Clause 1 sets out the short title and provides for commencement.
3. Clause 3 amends the long title of the Ordinance to repeal the reference to the Registration of Patents Ordinance. That Ordinance was repealed in June 1997.
4. Clause 5 deals with the definitions of terms used in the Ordinance. In particular, a new definition of *standard patent (O)* is added. It refers to a patent granted under the new original grant standard patent system provided in the new Part 3 of the Ordinance. Other new definitions added include *certificate of substantive examination*, *material date* and *substantive examination*. Clause 6 amends section 3 of the Ordinance to provide that an application for a standard patent under Part 2 of the Ordinance is to be named as an application for a standard patent (R) or a standard patent (R) application.
5. Clause 11 adds a new Part 1A (sections 9A to 9F) which deals with the patentability of inventions, the right to patents and the right to be mentioned as inventors. Provisions dealing with those matters are currently set out in sections 45, 93, 94, 96, 97 and 100 of the Ordinance. Due to their significance in the patent regime, those provisions are moved to the beginning of the Ordinance. Section 9B also introduces new provisions which deal with novelty of inventions consisting of substances or compositions for specific use in methods for treating or diagnosing human or animal bodies.
6. Part 2 of the Ordinance deals with standard patents by re-registration. With the introduction of the original grant standard patent system, patents granted under that Part are renamed as standard patents (R). Consequential and related amendments are

made to various provisions in that Part. Current sections 95, 98 and 99 of the Ordinance, which deal with non-prejudicial disclosure, priority right and the effect of priority right relating to standard patents (R) and standard patent (R) applications, are moved to new sections 11A, 11B and 11C.

7. Clause 45 adds a new Part 3 (sections 37A to 37ZD) to provide for a new system for original grant of standard patents. Patents granted under that Part are named as standard patents (O). That Part is divided into 6 Divisions.
8. Division 1 contains provisions on novelty and priority. They are based on the corresponding provisions on short-term patents in Part 15 of the Ordinance. Section 37B provides for the circumstances under which a disclosure of an invention that is the subject of a standard patent (O) application (*subject invention*) is regarded as a non-prejudicial disclosure. Section 37C provides that an applicant for a standard patent (O), based on an earlier patent application (whether in or outside Hong Kong) for the same invention, enjoys priority right. Sections 37D, 37E and 37F provide for related matters on restoring and claiming priority, and on the effect of priority right.
9. Division 2 contains provisions on who may apply for standard patents (O). Some of them are based on the corresponding provisions on standard patents (R) in Part 2 of the Ordinance. Section 37G provides that a standard patent (O) application may be made by a person alone or jointly with any other person. Section 37H provides that at any time before a standard patent (O) has been granted for the subject invention, questions as to whether a person is entitled to apply for the patent and whether any right in or under the application should be transferred or granted to any other person may be referred to the Registrar of Patents (*Registrar*) or the Court of First Instance (*court*) for determination. Section 37K provides that, among other things, if the Registrar or the court orders that an

application is to proceed in the name of a person who is not an original applicant, a licence or other right in or under the application will lapse. The original applicant or licensee, however, may make a request to the new applicant for a licence to continue working or to work the subject invention.

10. Division 3 provides for standard patent (O) applications. Section 37L sets out the application requirements (*formal requirements*). Section 37M sets out the minimum requirement that an application must comply with before it can be accorded a date of filing. Section 37N provides that an applicant may file a part of a description, or a drawing, relating to the subject invention that has not yet been filed. The date of filing of the application, however, may be changed on filing the description or drawing. Section 37O provides for, among other things, the withdrawal of the description or drawing filed under section 37N.
11. Division 4 provides for examination on the formal requirements and publication of standard patent (O) applications. Sections 37P, 37Q and 37R provide that the Registrar must, after a standard patent (O) application has been accorded a date of filing, examine the application to ascertain whether it complies with the formal requirements. If the Registrar is satisfied that the requirements are complied with, the application must be published. Any person may file observations on the patentability of the subject invention, and the Registrar must consider the observations when carrying out a substantive examination of the application.
12. Division 5 provides for substantive examination of standard patent (O) applications. Section 37T provides that an application is regarded as being withdrawn if no request for substantive examination is made, or the prescribed fee is not paid, within the prescribed time. The requirements that the application has to comply with (*examination requirements*) are set out in section 37U. Sections 37V and 37W provide that if the Registrar is of the

opinion that the application does not comply with an examination requirement, the Registrar must inform the applicant of the opinion by written notice. The applicant may respond by filing representations and requests for amending the application, and requesting the Registrar to review the opinion. The Registrar must consider the representations and requested amendments filed, and review the opinion if requested. Under section 37X, the Registrar must grant a standard patent (O) for the subject invention if the Registrar is of the opinion that the application, together with any requested amendment, complies with all the examination requirements. Otherwise, the Registrar must refuse to grant the patent under section 37Y.

13. Division 6 contains general provisions on standard patent (O) applications before grant. They are based on the corresponding provisions on short-term patents in Part 15 of the Ordinance. The provisions in that Division include those on divisional applications, amendment and withdrawal of applications, the effect of withdrawal and refusal of applications, and further processing of and restoration of rights in respect of applications.
14. Under section 46 of the Ordinance, an application for amending the specification of a patent must be made to the court. Clause 54 repeals and substitutes that section to provide that for a standard patent (O) and short-term patent, the amendment application must be made to the Registrar or the court. The substituted section also expressly provides that the Registrar or the court must publish the application and consider any opposition to the application. The Registrar, however, may decide not to publish an application or a part of it under certain circumstances.
15. Section 78 of the Ordinance sets out the requirements regarding the claims contained in the specification of a patent application or of a patent. Clause 70 repeals and substitutes that section to add a new requirement that the claims must relate to 1 invention or to a group

of inventions that are so linked as to form a single inventive concept. The new requirement, however, does not affect a patent application filed, or a patent the application for which is filed, before the commencement date of the Bill.

16. Section 89 of the Ordinance provides that if a person is aggrieved by a threat made by another person for bringing proceedings for infringement of a patent, the person (*plaintiff*) may bring proceedings against that other person (*defendant*) for relief (*relief proceedings*). Clause 78 adds a new section 89A to provide for, in relief proceedings relating to a threat alleging an infringement of a short-term patent, the matters that the defendant is required to prove, failing which the plaintiff would be entitled to the relief claimed. In particular, if the short-term patent has not been issued with a certificate of substantive examination, the defendant must prove that the defendant has, on request, provided copies of specified documents containing particulars of the patent. The new section, however, does not affect relief proceedings brought in respect of a threat made before the commencement date of the Bill.
17. Section 91 of the Ordinance provides for the grounds on which the court may, on application, revoke a patent. Clause 81 amends that section to provide that the court may revoke a patent on the ground that the patent is one of 2 patents that are granted for the same invention made by the same inventor and have the same material date. The amendment, however, does not affect a patent the application for which is filed before the commencement date of the Bill.
18. Clause 86 adds a new section 101A to provide for further powers of the court in proceedings in which the validity of a short-term patent is put in issue. Those powers include the powers to direct the patent to be subjected to a substantive examination and stay the proceedings pending the outcome of the examination.

19. Clauses 94 to 123 amend current provisions on short-term patents in Part 15 of the Ordinance. A new section 110A is added to allow an applicant for a short-term patent, who has lost the priority right of an earlier patent application, to restore the right. Section 113 of the Ordinance is amended to allow a short-term patent application to contain not more than 2 independent claims.
20. Section 114 of the Ordinance sets out the minimum requirements that a short-term patent application must comply with before it can be accorded a date of filing. For greater flexibility, that section is repealed and substituted to allow an applicant to provide, in replacement of a description of an invention, a reference to an earlier patent application, 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 (*relevant invention*), are completely contained in that earlier patent application.
21. A new section 114A is added to provide that an applicant of a short-term patent application may file a part of a description, or a drawing, relating to the relevant invention that has not yet been filed. The date of filing of the application, however, may be changed on filing the description or drawing. A new section 114B is added to provide for, among other things, the withdrawal of the description or drawing filed under section 114A.
22. A new section 126A is added to provide that any person may file with the Registrar the person's observations on the patentability of the relevant invention, and that the Registrar must consider the observations when deciding whether to issue a certificate of substantive examination in respect of the short-term patent.
23. A new Division 5 is added to Part 15 of the Ordinance to provide for substantive examination of short-term patents. A request for substantive examination may be made by the proprietor of a short-term patent, or by any other person who satisfies the Registrar that there are reasonable grounds to suspect that the relevant invention

is not patentable, or that it would be reasonable to carry out the examination because of the person's legitimate business interests.

24. The requirements that a short-term patent has to comply with for it to be issued with a certificate of substantive examination (*examination requirements*) are set out in a new section 127C. New sections 127D and 127E provide that if the Registrar is of the opinion that a short-term patent, together with any requested amendment (if allowed), does not comply with an examination requirement, the Registrar must inform the proprietor of the patent of the opinion by written notice. The proprietor may respond by filing representations and requests for amending the specification of the patent, and requesting the Registrar to review the opinion. The Registrar must consider the representations and requested amendments filed, and review the opinion if requested. If the Registrar is of the opinion that a requested amendment, if allowed, would enable the patent to comply with the requirement, the Registrar must publish the requested amendment, consider any opposition to the amendment filed by third parties, and decide whether to allow the amendment. Under a new section 127F, the Registrar must issue a certificate of substantive examination if the Registrar is of the opinion that the patent, together with all the requested amendments which are allowed, complies with all the examination requirements. Otherwise, the Registrar must revoke the patent under a new section 127G.
25. Clause 123 amends section 129 of the Ordinance to provide for the circumstances under which the proprietor of a short-term patent may commence proceedings for the enforcement of rights conferred under the Ordinance (*enforcement proceedings*). The amendments also provide that an application for injunction by the proprietor in interlocutory proceedings must be accompanied by evidence which is sufficient to establish prima facie the validity of the patent. Those amendments, however, do not affect enforcement proceedings commenced before the commencement date of the Bill.

26. Clause 129 adds a new section 144A to prohibit any person from using, or from permitting the use of, certain titles and descriptions in the course of or in connection with the person's business, trade or profession. Exemptions are provided for the use of a title or description that solely relates to a person's qualification for lawfully providing patent agency services outside Hong Kong, and for the use of the titles solicitor, barrister, foreign lawyer, lawyer and counsel.
27. The Bill introduces other amendments to the Ordinance which are incidental to the introduction of the original grant standard patent system and the amendments to the short-term patent system. The Bill also amends the presentation of some provisions of the Ordinance to bring it in line with the latest drafting conventions.



Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
		Long title		30/06/1997

An Ordinance to make new provision in respect of patents and related matters in substitution for the Registration of Patents Ordinance.

[The Ordinance, other than  
 section 125 } 27 June 1997  
 Section 125 } 1 July 1997 *L.N. 367 of 1997*]

(Originally 52 of 1997)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	I	PRELIMINARY		30/06/1997

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;

"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 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;

"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;

"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 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;

"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;

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

"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 (標準專利的申請)	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)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	3	Meaning of "application for a standard patent"		30/06/1997

Expanded Cross Reference:

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

In this Ordinance, unless the context otherwise requires, reference to an application for a standard patent is a reference to proceedings under Part II-

- (a) under sections 15 to 22 to record a designated patent application; and <\* Note-Exp. x-Ref: Sections 15, 16, 17, 18, 19, 20, 21, 22 \*>
- (b) under sections 23 to 27 for the registration of a designated patent and the grant of a standard patent for the invention shown in the published specification of the designated patent, <\* Note-Exp. x-Ref: Sections 23, 24, 25, 26, 27 \*>

up to but not including the grant of the standard patent, and cognate expressions shall be construed accordingly; and reference to-

- (i) the filing of an application for a standard patent is a reference to the filing of a request to record;
- (ii) the date of filing an application for a standard patent is a reference to the date of filing a request to record;
- (iii) an application for a standard patent as filed is a reference to a request to record as filed;
- (iv) the publication of an application for a standard patent is a reference to the publication of a request to record;
- (v) an invention which is the subject of an application for a standard patent, or an invention in respect of which an application for a standard patent has been made, is a reference to the invention disclosed in the specification of the corresponding designated patent or, if no request for registration and grant has been filed in the application, of the designated patent application;
- (vi) the specification of an application for a standard patent is a reference to the specification of the corresponding designated patent application.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	4	Meaning of "designated patent", etc.		30/06/1997
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- (1) In this Ordinance, unless the context otherwise requires-
- "designated patent" (指定專利) means a patent granted by a designated patent office;
- "designated patent application" (指定專利申請) means-
- (a) an application in a designated patent office for a patent, which application has been published under the law of the designated patent office;
  - (b) an international application which has been published and which has validly entered its national phase in a designated patent office;
- "designated patent office" (指定專利當局) means a patent office designated for the purpose of this Ordinance under section 8.
- (2) In this Ordinance, unless the context otherwise requires, a reference-
- (a) to a "corresponding designated patent" in relation to a standard patent, is a reference to the designated patent which was registered under section 27 in an application for the grant of the standard patent;
  - (b) to a "corresponding designated patent application"-
    - (i) in relation to an application for a standard patent for an invention, is a reference to the designated patent application in respect of that invention;
    - (ii) in relation to a standard patent, is a reference to the designated patent application in pursuance of which the corresponding designated patent was granted.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	5	Meaning of "published"		30/06/1997
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- (1) In this Ordinance, unless the context otherwise requires-
- (a) "published" (發表) means made available to the public (whether in Hong Kong or elsewhere); and
  - (b) a document shall be taken to be published under any provision of this Ordinance if it can be inspected as of right at any place in Hong Kong by members of the public, whether on payment of a fee or not.
- (2) Without prejudice to subsection (1), and unless the context otherwise requires, a reference in this Ordinance-
- (a) to the grant of a standard patent being published is a reference to its being published under section 27;
  - (b) to a request to record being published is a reference to its being published under section 20;
  - (c) to a designated patent being published is a reference to its being published by the designated patent office by which the patent was granted for the purposes of the law of that office relating to applications for and the granting of patents;
  - (d) to a designated patent application being published is a reference-
    - (i) except as provided in subparagraph (ii), to its being published by the designated patent office in which the application was made;
    - (ii) in the case of a designated patent application based on an international application, to the international application being published by the International Bureau under the Patent Cooperation Treaty, or by the designated patent office in which the application was made, whichever is the earlier;
  - (e) to a short-term patent being published is a reference to its being published under section 118.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	6	Other references		30/06/1997
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- (1) Unless the context otherwise requires, a reference in this Ordinance to a patent is a reference to a standard patent or a short-term patent granted under this Ordinance.
- (2) Unless the context otherwise requires, a reference in this Ordinance to an international agreement is a

reference to-

- (a) the agreement, or any other international agreement replacing it, as may from time to time be amended or supplemented by or in accordance with any international agreement (including any protocol or annex);
- (b) any instrument made under any such agreement to provide for amendment to or supplementation of the agreement.

(3) Unless the context otherwise requires, a reference in this Ordinance to an enactment or law of a country, territory or area other than Hong Kong shall be construed as a reference to that enactment or law as it may from time to time be amended or extended by or under any other enactment or law of the country, territory or area.

(4) Unless the context otherwise requires, a reference in this Ordinance to an invention being worked in Hong Kong includes a reference to the invention being worked by importation into Hong Kong for the purpose of putting the patented product on the market or stocking it for that purpose.

(5) For the purposes of this Ordinance matter shall be taken to have been disclosed in any designated patent application or in the specification of a patent or a designated patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in any such application or specification.

[cf. 1977 c. 37 s. 130(3) U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	9	Special provision regarding invention covered by 2 or more patents	L.N. 234 of 2007	22/02/2008

Where there are in effect 2 or more patents for the same invention, any use of the invention which does not constitute an infringement of any one such patent (whether by virtue of consent given by the proprietor, a compulsory licence having effect under Part VIII, the provisions of Part IX relating to Government use, an import compulsory licence having effect under Part IXA or an export compulsory licence having effect under Part IXB) shall not constitute an infringement of the other such patent.

(Amended 21 of 2007 s. 4)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	II	APPLICATIONS FOR STANDARD PATENTS		30/06/1997

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	10	General provision regarding applications for standard patents		30/06/1997

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 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, 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
- (d) as the second stage of the application for a standard patent, the designated patent has been registered in accordance with sections 23 to 27. <\* Note-Exp. x-Ref: Sections 23, 24, 25, 26, 27 \*>

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	11	Formality examination of applications for standard patent		30/06/1997
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Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a standard patent for an invention shall be construed as imposing upon the Registrar any obligation to consider or to have regard to, for the purpose of such examination, any question as to-

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) whether any requirement under sections 45, 77, 78, 79, 93, 94, 95, 96, 97, 98, 99 or 100 has been complied with.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	12	Who may apply		30/06/1997
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#### Right to apply

- (1) The person who may apply for the grant of a standard patent for an invention is-
  - (a) the person named as applicant in a designated patent application for a patent for the invention, or his successor in title to the rights under the designated patent application in Hong Kong; or
  - (b) in preference to the person mentioned in paragraph (a), the person who is entitled to the property in the invention in Hong Kong.

(2) Subject to any determination under section 13, the applicant for a standard patent for an invention in proceedings before the Registrar shall for the purpose of those proceedings be deemed to be the person entitled to apply for the grant of a patent for that invention under subsection (1).

[cf. 1977 c. 37 s. 7 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	13	Determination before grant of questions as to who may apply		30/06/1997
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(1) At any time before a standard patent has been granted for an invention (whether or not an application has been made for a standard patent for the invention)-

- (a) any person may refer to the Registrar or the court the question of whether he is entitled under section 12 (alone or with other persons) to apply for the grant of a standard patent for the invention; or
- (b) any of 2 or more joint proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person.

(2) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under this section.

(3) Where a question is referred to the Registrar or the court under this section after an application for a standard patent has been filed but before a standard patent is granted in pursuance of the application then the Registrar or the court may, unless the application is withdrawn before the reference is disposed of by the Registrar or the court-

- (a) order that the application for a standard patent shall proceed in the name of that person, either solely or

jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;

- (b) where the reference was made by 2 or more persons, order that the application shall proceed in all their names jointly; or
- (c) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

(4) Where a person refers a question under subsection (1)(b) relating to an application, any order under subsection (2) may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (3)(c) or (4) fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the Registrar or the court may on application made to him or it by any person in whose favour or on whose reference the directions were given authorize him to do that thing on behalf of the person to whom the directions were given.

(6) No order shall be made under subsection (3) unless notice of such reference is given in the prescribed manner to-

- (a) the applicant for the standard patent (not being a party to the reference); or
- (b) any other person (not being a party to the reference) who it is alleged in the reference has the right, by virtue of any transaction, instrument or event relating to the invention or the application, to apply for the grant of the standard patent whether alone or with any other person,

and any person receiving such notice may oppose the reference.

(7) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

[cf. 1977 c. 37 s. 8 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	14	Effect of transfer of application under section 13		30/06/1997

(1) Where an order is made or directions are given under section 13 that an application for a standard patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the order and any directions under that section, continue in force and be treated as granted by the persons in whose name the application is to proceed.

(2) Where an order is made or directions are given under section 13 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to apply under section 12 for the grant of the patent), any licences or other rights in or under the application for a standard patent shall, subject to the order and any directions under that section and subject to subsection (3), lapse on the registration of that person or those persons as the applicant or applicants or, where the application for a standard patent has not been published, on the making of the order.

(3) If before a reference to the Registrar or the court under section 13 resulting in the making of any order mentioned in subsection (2)-

- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in Hong Kong or made effective and serious preparations to do so; or
- (b) a licensee of the applicant, acting in good faith, worked the invention in Hong Kong or made effective and serious preparations to do so,

that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2), the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the Registrar or the court the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the Registrar or the court, as appropriate, shall determine the question and may, if he or it considers it appropriate, order the grant of such a licence.

(6) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under



subsection (5).

[cf. 1977 c. 37 s. 11 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	15	Filing of request to record	L.N. 47 of 2002	01/06/2002

#### Request to record a designated patent application

(1) A person entitled under section 12(1) to apply for the grant of a standard patent for an invention may, at any time within 6 months after the date of publication of an application in a designated patent office for a patent for the invention, request the Registrar to enter a record of that designated patent application in the register (in this Ordinance referred to as a "request to record").

(2) Every such request shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain-

- (a) a photocopy of the designated patent application as published, that is to say, including any description, claims, drawings, search report or abstract published together with the designated patent application;
- (b) where the designated patent application does not contain the name of any person as being the inventor, a statement identifying the person or persons whom the applicant believes to be the inventor or inventors;
- (c) the name and address of the person making the request;
- (d) where the person filing the request is a person other than the person named as applicant in the designated patent application, a statement explaining his entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that statement;
- (e) where priority is claimed under section 98 in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application as mentioned in that section, a statement that indicates the details of- (Amended 2 of 2001 s. 3)
  - (i) the date of priority claimed;
  - (ii) the country in which the earlier application was filed;
- (f) where at the time of filing the designated patent application a claim was made in accordance with the law of the designated patent office in respect of any previous disclosure of the invention that was, for the purposes of the law of the designated patent office, a non-prejudicial disclosure, a statement that indicates the prescribed details relating to the previous disclosure; and (Amended 2 of 2001 s. 3)
- (g) an address in Hong Kong for service of documents.

(3) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.

(4) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the request to record, and if either fee is not paid within that period or within such further period as may be allowed under subsection (5) the application for a standard patent shall be deemed to be withdrawn.

(5) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (4) may still be validly paid.

(6) Subsection (1) shall not apply in respect of a designated patent application published before the date on which the designated patent office was designated under section 8.

(7) Nothing in this section shall preclude a request to record being initiated by documents complying with section 17.

[cf. EPC Art. 78; 1977 c. 37 s. 14 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	17	Date of filing of request to record	L.N. 47 of 2002	01/06/2002

(1) Subject to subsection (2) and section 18(3), the date of filing a request to record shall be the earliest date on

which documents filed by the applicant contain-

- (a) an indication that a request is made to record a designated patent application;
- (b) information identifying the applicant; and
- (c) a reference to the designated patent application, including-
  - (i) the application number assigned to it by the designated patent office; and
  - (ii) the publication number (if any) assigned to it by the designated patent office, and the date (if any) of its publication by the designated patent office. (Amended 2 of 2001 s. 5)

(2) If the earliest filing with the Registrar of any part of a request to record occurs more than 6 months after the publication of the corresponding designated patent application the request shall not be dealt with as an application for a standard patent.

[cf. EPC Art. 80]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	18	Examination on filing of request to record		30/06/1997
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(1) The Registrar shall examine whether-

- (a) the request to record satisfies the requirements of section 17(1) for the accordance of a date of filing (the "minimum requirements");
- (b) the filing fee and advertisement fee have been paid in due time.

(2) Subject to section 17(2), 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.

(3) If such deficiencies are not corrected within the prescribed time, the request shall not be dealt with as an application for a standard patent.

[cf. EPC Art. 90]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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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 examine whether the requirements of section 15(2) and (3) ("the formal requirements") have been satisfied.

(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.

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

[cf. EPC Art. 91]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	20	Publication of request to record	L.N. 40 of 2004	07/05/2004
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(1) If on an examination under section 19(1) a request to record is found to have satisfied the requirements of section 15(2) and (3), or if on a subsequent examination by the Registrar the deficiencies noted under section 19(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to this section and section 37-

- (a) record the designated patent application in the register and enter particulars of the request to record in the register;
  - (b) publish the request to record in the prescribed manner;
  - (c) advertise the fact of such publication and entry by notice in the official journal; and (Amended 2 of 2001 s. 6; 2 of 2001 s. 14)
  - (d) inform the applicant of the publication of the request to record.
- (2) A request to record shall not be published if-
- (a) before the completion of preparations for publication, it has been finally refused or withdrawn or has been deemed to have been withdrawn; or
  - (b) the filing fee or advertisement fee has not been paid.
- (3) For the purposes of subsection (1)(b) the request to record shall include-
- (a) the designated patent application, including the description, the claims, any drawings and any search report or abstract published by the designated patent office and filed in the request to record;
  - (b) the names of the proprietor and (if different) the inventor.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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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-
- (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"), 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) Where 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 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.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	23	Filing of request for registration and grant		30/06/1997

#### Request for registration and grant

- (1) Where in an application for a standard patent-
  - (a) a designated patent application has been recorded in the register and a request to record has been published and the request to record is not refused or deemed withdrawn or abandoned (whether under this Part or Part III); and
  - (b) a patent has been granted in the designated patent office in pursuance of the designated patent application,
 the applicant or his successor in title may, subject to subsection (2), request the Registrar to register the designated patent so granted and to grant a standard patent for the invention shown in the published specification of the designated patent (in this Ordinance referred to as a "request for registration and grant").
- (2) A request for registration and grant under subsection (1) shall be made within 6 months after the date of grant of the designated patent by the designated patent office or publication of the request to record, whichever is the later.
- (3) Every such request shall be filed with the Registrar in the prescribed manner and shall contain-
  - (a) a verified copy of the published specification of the designated patent, including the description, the claims and any drawings published by the designated patent office;
  - (b) if the person filing the request is a person other than the person named in the register as the applicant for a standard patent for the invention, a statement explaining the first-mentioned person's entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that statement;
  - (c) where the request to record contains a statement under section 15(2)(e) to the effect that priority is claimed on the basis of a right of priority claimed in the designated patent office, such copies as may be prescribed of the documents filed in the designated patent office claiming and supporting such right of priority.
- (4) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.
- (5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing of a part of the request for registration and grant, and if either fee is not paid within that period or within such further period as may be allowed under subsection (6) the application for a patent shall be deemed to be withdrawn.
- (6) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (5) may still be validly paid.
- (7) Nothing in this section shall preclude a request for registration and grant being initiated in accordance with section 24.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	24	Date of filing request for registration and grant		30/06/1997

- (1) Subject to subsection (2) and section 25(3), the date of filing of a request for registration and grant shall be the earliest date on which documents filed by the applicant contain-
  - (a) an indication that a request is made for the registration of a designated patent and the grant of a standard patent;
  - (b) information identifying the applicant;
  - (c) the publication number assigned to the designated patent by the designated patent office, and the date of its publication; and
  - (d) the publication number assigned to the request to record by the Registrar.
- (2) If the earliest filing with the Registrar of any part of a request for registration and grant occurred more than 6 months after the later of-

- (a) the date of grant of the designated patent; and
  - (b) publication of the request to record in accordance with section 20,
- then the application shall be deemed to be withdrawn.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	25	Examination on filing of request for registration and grant		30/06/1997
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- (1) The Registrar shall examine whether-
  - (a) the request for registration and grant satisfies the requirements of section 24(1) for the accordance of a date of filing; and
  - (b) the filing fee and advertisement fee have been paid in due time.
- (2) Subject to section 24(2), if on examination under subsection (1)(a) a date of filing cannot be accorded because of deficiencies as regards the requirements mentioned in subsection (1)(a), the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.
- (3) If-
  - (a) there are deficiencies as regards the requirements specified in section 24(1) which cannot be corrected the application for a standard patent shall be refused;
  - (b) any deficiencies as regards those requirements noted in the examination under subsection (1) are not corrected in accordance with the rules, 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.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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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 whether the requirements of section 23(3) and (4) ("the formal requirements") have been satisfied.
- (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.
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected then such right shall be lost for the application.

[cf. EPC Art. 91]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	27	Registration of designated patent and grant of patent	L.N. 40 of 2004	07/05/2004
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- (1) If on examination under section 26(1) a request for registration and grant is found to have satisfied the requirements of section 23(3) and (4) or if on a subsequent examination the deficiencies noted under section 26(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to section 37-

- (a) register the designated patent by making an appropriate entry in the register; and
- (b) grant a standard patent for the invention shown in the published specification of the designated patent as filed under section 23(3)(a) and issue a certificate to that effect.
- (2) A patent shall not be granted under this section unless the filing fee and advertisement fee specified in section 23 and any other fees payable under the preceding provisions of this Part have been paid.
- (3) As soon as practicable after a standard patent has been granted under this section the Registrar shall-
  - (a) publish in the prescribed manner the specification of the patent, the names of the proprietor and, if different, the inventor;
  - (b) send the certificate issued under subsection (1)(b) to the proprietor; and
  - (c) advertise the fact of such grant by notice in the official journal. (Amended 2 of 2001 s. 14)
- (4) In publishing under subsection (3)(a) any matters specified in that subsection, the Registrar may publish in addition such other matters constituting or relating to the patent which in his opinion it is desirable to publish.

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Section:	28	Further processing of application for standard patent		30/06/1997
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#### Further processing; restoration of rights

- (1) Subject to this section, where-
  - (a) an application for a standard patent, or any part of an application, is refused or is deemed withdrawn following the applicant's failure to comply with a time limit under this Part (including any time limit set by the Registrar); and
  - (b) the applicant has by notice filed with the Registrar requested reinstatement of the application or part of the application,
 then the legal consequence of the failure to comply with the time limit, as provided under the Ordinance, shall not ensue or, if it has already ensued, shall be retracted.
- (2) A notice under this section-
  - (a) shall be in writing and shall be filed within 2 months after such refusal or deemed withdrawal;
  - (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
  - (c) shall not be deemed to be filed unless the omission which constituted the failure to comply with a time limit has been made good.
- (3) This section does not apply in the case of the refusal or deemed withdrawal of an application under section 15(4), 23(5), 24(2) or 25(3).
- (4) The Registrar may by regulation amend the period specified in subsection (2)(a) within which a notice under this section shall be filed.

[cf. EPC Art. 121]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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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 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 as a direct consequence of the failure to comply with the time limit shall be deemed to be of no effect and the application shall be treated 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 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 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).

[cf. EPC Art. 122]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	30	Effect of restoration of rights under section 29	L.N. 40 of 2004	07/05/2004

(1) The effect of a restoration under section 29 is as follows.

(2) A person who, during the period between the loss of rights referred to in section 29(1) and the advertisement in the official journal of notice of the application for restoration under section 29(3)- (Amended 2 of 2001 s. 14)

(a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a standard patent if those rights had not been lost; or

(b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (3).

(3) The rights referred to in subsection (2) are-

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);

(b) if such act was done or preparations had been made to do it in the course of a business-

(i) in the case of an individual-

(A) the right to assign the right to do it or to transmit such right on death; or

(B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.

(4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).

(5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.

[cf. 1992 No. 1 s. 55(2) to (4) Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	III	PROVISIONS AS TO APPLICATIONS FOR STANDARD PATENTS BEFORE GRANT		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	31	Amendment of application for standard patent		30/06/1997
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(1) Subject to this section and sections 36 and 103, an applicant for a standard patent may at any time before a standard patent is granted pursuant to the application, in accordance with the prescribed conditions, amend the application of his own volition.

(2) No amendment may be made under subsection (1) to the title of the invention, the abstract, a priority claim or any claim, description or drawing unless-

- (a) the application has been published; and
- (b) the amendment is an amendment that has been made to the corresponding designated patent application.

(3) Upon receipt of particulars of an amendment filed in accordance with subsections (1) and (2) the Registrar shall record the amendment.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	32	Withdrawal of application		30/06/1997
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(1) Subject to section 36, an applicant for a standard patent may at any time before a standard patent is granted pursuant to the application withdraw in writing his application and any such withdrawal may not be revoked.

(2) Where a patent application is withdrawn under this section, or is deemed under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, then-

- (a) if the application has been published, section 94(3) shall continue to apply as regards the application;
- (b) the applicant shall continue to enjoy the right of priority under section 98 which he enjoyed immediately before such withdrawal or refusal;
- (c) no other right may be claimed under this Ordinance in relation to the application

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	33	Maintaining application for standard patent	22 of 1999	01/07/1997
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Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

(1) This section applies to an application for a standard patent which has been published but in which no request has been made for registration and grant under section 23.

(2) If it is desired to maintain a patent application to which this section applies for a further year after the expiry of the 5th or any succeeding year from the date specified in subsection (3), the applicant shall, before the expiry of that 5th or succeeding year (as the case may be), but not earlier than a date 3 months before that expiry, apply to the Registrar in the prescribed manner for the maintenance of the patent application ("maintenance application") and pay the prescribed fee ("maintenance fee") and a patent application to which this section applies shall be deemed to be withdrawn and abandoned at the expiry of that 5th or succeeding year if the maintenance application is not so made or the maintenance fee is not so paid.

(3) The date specified for the purpose of subsection (2) is the anniversary of the date of filing the corresponding designated patent application first occurring after the date of publishing the request to record.

(4) If, within 6 months after the end of the period specified in subsection (2) for the making of a maintenance application, an application is made under subsection (2) and the maintenance fee and any prescribed additional fee are



paid in the prescribed manner then the patent application shall be treated as if it had not been withdrawn or abandoned.

(5) If statements contained in the maintenance application indicate-

- (a) that as at a date specified in the application, being a date not earlier than 1 month before the date of making the application-
  - (i) the designated patent application has not been withdrawn or abandoned for the purposes of the law of the designated patent office; and
  - (ii) there has been no final refusal by the designated patent office to grant a patent pursuant to the designated patent application; and
- (b) that-
  - (i) as at the date specified for the purposes of paragraph (a) a patent had not been granted pursuant to the designated patent application; or
  - (ii) a patent has been granted pursuant to the designated patent application, and the date of such grant is a date within 6 months before the date of the application,

the Registrar shall, subject to subsection (9), maintain the application for a patent.

(6) Where a statement contained in a maintenance application indicates that a designated patent has been granted on a date within the 6 months before the date of the maintenance application, any maintenance of the patent application by virtue of subsection (5) shall have effect for a term ending 6 months after the date of such grant.

(7) If there are deficiencies in the maintenance application that may be corrected the Registrar shall give the applicant an opportunity to correct them in accordance with the rules.

(8) If the Registrar is not satisfied as to the veracity of a statement in the maintenance application, he shall notify the applicant accordingly giving reasons and shall allow the applicant an opportunity to make further statements or adduce material for the purpose of so satisfying him.

(9) If in an application under this section-

- (a) statements contained in the application indicate that-
  - (i) the designated patent application has been withdrawn or abandoned pursuant to the law of the designated patent office;
  - (ii) the designated patent office has finally refused the grant of a patent in pursuance of the designated patent application; or
  - (iii) a designated patent has been granted in pursuance of the designated patent application, and the date of such grant was a date more than 6 months before the date of the application;
- (b) deficiencies as noted by the Registrar are not corrected in accordance with the rules; or
- (c) the applicant has failed to satisfy the Registrar as to the veracity of a statement in respect of which notice has been given under subsection (8),

the Registrar shall refuse to maintain the application for a patent and upon such refusal that application shall be deemed to be withdrawn or abandoned.

(10) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for making a maintenance application under that subsection is determined.

(11) The Chief Executive in Council may by regulation amend the period specified in subsection (2) as being the period after which a standard patent application not maintained shall be deemed to be withdrawn and abandoned. (Amended 22 of 1999 s. 3)

[cf. EPC Art. 86]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	34	Restoring application for standard patent	L.N. 40 of 2004	07/05/2004

(1) Where an application for a standard patent is deemed withdrawn under section 33 by reason only of the failure to pay any maintenance fee under that section within the period specified then the applicant may, within 12 months after the date on which the application was deemed withdrawn and on payment of the prescribed fee, apply to the Registrar in the prescribed manner for the restoration of the application for a standard patent.

(2) The Registrar shall advertise in the official journal notice of any application under subsection (1). (Amended 2 of 2001 s. 14)

(3) If on an application under subsection (1)-

- (a) the Registrar is satisfied that the failure to pay the maintenance fee within the specified period, or that

fee and any additional fee under section 33(4) within 6 months after the end of the specified period, occurred in spite of the applicant having taken all reasonable care required by the circumstances; and

(b) the requirements of subsection (4) are met,

the Registrar shall order that the request to record be restored on payment of any such unpaid maintenance fee and additional fee.

(4) An order for restoration shall not be made under subsection (3) unless it appears to the Registrar that at the date of the application for restoration-

(a) the designated patent application is still valid and not withdrawn; and

(b) a patent has not been granted in pursuance of that application or, if granted, the time for filing a request for registration and grant under section 23 has not expired.

[cf. EPC Art. 122]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	35	Effect of restoration order under section 34	L.N. 40 of 2004	07/05/2004
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(1) The effect of a restoration under section 34(4) is as follows.

(2) A person who, during the period between any deemed withdrawal such as is mentioned in section 34(1) and the advertisement in the official journal of notice of the application for restoration under section 34(2)- (Amended 2 of 2001 s. 14)

(a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a patent if those rights had not been lost; or

(b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (3).

(3) The rights referred to in subsection (2) are-

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);

(b) if such act was done or preparations had been made to do it in the course of a business-

(i) in the case of an individual-

(A) the right to assign the right to do it or to transmit such right on death; or

(B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a patent concerned.

(4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).

(5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the patent application.

(6) This section applies in relation to the Government use of an invention in respect of which an application has been made as it applies in relation to infringement of the rights conferred by publication of an application for a standard patent for the invention.

[cf. 1992 No. 1 s. 55(2) to (4) Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	36	Limitation on withdrawal, amendment, etc. of application		30/06/1997
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No withdrawal of an application under section 32, no request to enter a record of a divisional application under section 22(1) nor any amendment under section 31 shall be allowed after the date on which preparations for publication under section 27(3) of the specification of a standard patent to be granted in pursuance of the application

have been completed.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	37	Registrar may refuse to record under section 20 or to register and grant under section 27		30/06/1997
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(1) The Registrar may refuse to record a designated patent application under section 20(1) or to register a designated patent under section 27 if he considers that the invention the subject of the application for the standard patent is not a patentable invention by reason of any of the matters specified in section 93(5).

(2) The Registrar shall give notice in writing to the applicant of any such refusal.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	IV	PROVISIONS AS TO PATENTS AFTER GRANT		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	38	Deemed date of filing where standard patent has been granted		30/06/1997
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#### Standard patents

Where a standard patent is granted, the application for the standard patent shall be deemed to have as its date of filing the date of filing of the corresponding designated patent application, and in this Ordinance "deemed date of filing" (當作提交日期) in relation to an application for a standard patent shall be construed accordingly.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	39	Term of standard patent	L.N. 40 of 2004	07/05/2004
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(1) A standard patent granted under this Ordinance-

- (a) shall take effect from the date on which the fact of its grant is advertised in the official journal; and (Amended 2 of 2001 s. 14)
- (b) subject to subsection (2), shall remain in force until the end of the period of 20 years beginning with the deemed date of filing of the application for the patent.

(2) If it is desired to keep a standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subsection (3), the prescribed renewal fee shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid.

(3) The date specified for the purpose of subsection (2) is the anniversary of the deemed date of filing of the standard patent first occurring after the date of grant of the patent.

(4) If within 6 months after the end of the period specified in subsection (2) for payment of the renewal fee the renewal fee and any prescribed additional fee are paid, the standard patent shall be treated as if it had never expired, and accordingly-

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.

(5) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the

earliest date for payment of the prescribed renewal fee is determined.

(6) The Chief Executive in Council may by regulation amend- (Amended 22 of 1999 s. 3)

- (a) the period specified in subsection (1)(b) as being the period for which a standard patent shall remain in force;
- (b) the period specified in subsection (2) by reference to which a standard patent, if not renewed, shall cease to have effect.

[cf. 1977 c. 37 s. 25 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	42	Determination after grant of questions referred before grant		30/06/1997

(1) If a question with respect to a standard patent or application for a standard patent is referred by any person to the Registrar or the court under section 13, whether before or after the making of an application for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a standard patent, but on its grant that person shall be treated as having referred to the Registrar or the court under section 55 any question mentioned in that section which the Registrar or the court thinks appropriate.

(2) In determining any such question under section 55 the Registrar shall exercise only the powers that are available to him for the purposes of determining the same question referred to him under section 13.

[cf. 1977 c. 37 s. 9 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	43	Amendment of standard patent following opposition or revocation proceedings in the designated patent office	L.N. 40 of 2004	07/05/2004

(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 official journal. (Amended 2 of 2001 s. 14)

(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]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	44	Revocation of standard patent following opposition or revocation proceedings in the designated patent office	L.N. 40 of 2004	07/05/2004

(1) This section applies to any standard patent of which the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.

(2) The proprietor of a patent to which this section applies shall after publication of the revocation by the designated patent office and in the prescribed manner file with the Registrar a verified copy of the order of revocation or other prescribed documentation.

(3) The Registrar shall record any filing under subsection (2) and shall advertise the fact of such filing by notice in the official journal. (Amended 2 of 2001 s. 14)

(4) A person other than the proprietor of a patent to which this section applies may apply to the Registrar in the prescribed manner for an order under this subsection, and where on such an application the Registrar is satisfied that the patent is one to which this section applies he shall, subject to subsection (5), order that the patent be revoked.

(5) The Registrar may, if he thinks fit, refer any application under subsection (4) to the court and the court shall have jurisdiction to make an order for the revocation of the patent.

(6) Upon the Registrar advertising the fact of a filing by the proprietor of a patent under subsection (2) in the official journal, or upon the making of an order by the Registrar under subsection (4) or by the court under subsection (5) for the revocation of a patent, the patent shall be treated as never having had effect. (Amended 2 of 2001 s. 14)

[cf. EPC Art. 102]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	45	Mention of inventor		30/06/1997

#### Patents generally

(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention.

(2) Where a person has been mentioned in a patent as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time after the grant of the patent request the Registrar to make a finding to that effect; and if the Registrar makes such a finding he shall accordingly amend the register and any undistributed copies of the patent, and may issue a certificate to the effect of his finding.

[cf. 1977 c. 37 s. 13 U.K.; 1992 No. 1 s. 17 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	46	General power to amend specification after grant	L.N. 40 of 2004	07/05/2004

(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.

(2) No such amendment shall be allowed if there are pending before the court proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect as from the grant of the patent.

(4) Any person wishing to oppose an application under this section may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

(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 official journal. (Amended 2 of 2001 s. 14)

(6) The Registrar may, without any application being made to the court or to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark.

(7) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[cf. 1977 c. 37 s. 27 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	49	Registrar's power to revoke patent on grounds of "ordre public" or morality		30/06/1997

(1) Any person may at any time after a patent has been granted for an invention under this Ordinance refer to the Registrar the question of whether, having regard to any of the matters specified in section 93(5), the invention is a patentable invention.

(2) Where a question is so referred-

(a) subject to paragraph (b), the Registrar shall determine the question;

(b) the Registrar may if he thinks fit refer the question to be determined by the court and, without prejudice to the court's jurisdiction apart from this paragraph to determine any such question, the court shall have jurisdiction to do so.

(3) If the Registrar or the court determines that the invention is not a patentable invention by reason of any of the matters specified in section 93(5) he or it shall order that the patent shall be revoked and upon the making of such an order the patent shall be treated as never having had effect.

(4) Any person may oppose a reference under subsection (2).

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	V	PROPERTY IN PATENTS AND APPLICATIONS; REGISTRATION		30/06/1997

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	54	Co-ownership of patents and applications for patents		30/06/1997

(1) Where a patent is granted to 2 or more persons each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Where 2 or more persons are proprietors of a patent, then, subject to this section and to any agreement to the contrary, each of them shall be entitled, by himself or his agent, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and sections 68 and 69 amount to an infringement of the patent concerned; and any such act shall not amount to an infringement of the patent concerned.

(3) Subject to sections 13 and 55 and to any agreement for the time being in force, where 2 or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to those sections, where 2 or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) Where a patented product is disposed of by any of 2 or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) This section shall have effect in relation to an application for a patent as filed as it has effect in relation to a patent and-

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) to a patented product shall be construed accordingly.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	55	Determination of right to patent after grant		30/06/1997

(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the court the question-

- (a) who is or are the true proprietor or proprietors of the patent;
- (b) whether the patent should have been granted to the person or persons to whom it was granted; or
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons,

and the court shall determine the question and make such order as it thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1), an order under that subsection may contain provision-

- (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
- (c) granting any licence or other right in or under the patent;
- (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom directions have been given under subsection (2)(d) fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the court may, on application made to it by any person in whose favour or on whose reference the order containing the directions was made, authorize him to do that thing on behalf of the person to whom the directions were given.

(4) Where the court finds on a reference under this section that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 91 makes an order on that ground for the conditional or unconditional revocation of the patent, the court may order that the person by whom the application was made or his successor in title may, subject to section 103, make a new application for a patent-

- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
- (b) in the case of conditional revocation, for the matter which in the opinion of the court should be excluded from that specification by amendment under section 102.

(5) Where a new application for a patent is made under subsection (4), it shall be treated-

- (a) as having been filed on the date of filing the application to which the reference relates; and
- (b) as having the same date of filing and, where the reference under this section is in respect of a standard patent, as having the same deemed date of filing, as the application to which the reference relates.

(6) Where the reference under this section is in respect of a standard patent, the court may order in respect of any new application under subsection (4)-

- (a) that all or any of the requirements of section 15(2) or (3) or 23(3) or (4) be dispensed with; and
- (b) that the person making the new application shall for the purposes of that application be deemed to have filed a request to record having the same date of filing as the request to record in the application for the patent to which the reference relates.

(7) On any such reference as is mentioned in subsection (4) no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) on that ground, if the reference was made after the end of 2 years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

(8) Where a question is referred to the court under this section an order shall not be made by virtue of subsection (2) or under subsection (4) on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent except those who are parties to the reference.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	56	Effect of transfer of patent under section 55		30/06/1997
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(1) Where an order is made under section 55 that a patent shall be transferred from any person or persons (the old proprietor or proprietors) to one or more persons (whether or not including an old proprietor), then, except in a case falling within subsection (2), any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 50 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the new proprietor or proprietors).

(2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor (on the ground that the patent was granted to a person not entitled to be granted the patent), any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3), lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.

(3) Where an order is so made that a patent shall be transferred as mentioned in subsection (2) or that a person other than an old proprietor may make a new application for a patent and before the reference of the question under section 55 resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith, worked the invention in question in Hong Kong or made effective and serious preparations to do so, the old proprietor or proprietors or the licensee shall on making a request to the new proprietor or proprietors within the prescribed period be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) The new proprietor or proprietors of the patent or any person claiming that he is entitled to be granted any such licence may refer to the court the question whether that person is so entitled and whether any such period is or terms are reasonable, and the court shall determine the question and may, if it considers it appropriate, order the grant of such a licence.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	VI	EMPLOYEES' INVENTIONS		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	VII	CONTRACTS AS TO PATENTED PRODUCTS, ETC.		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	VIII	COMPULSORY LICENCES FOR STANDARD PATENTS		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	IX	GOVERNMENT USE OF PATENTED INVENTIONS		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	69	Government use of patents during a period of extreme urgency	22 of 1999	01/07/1997
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Expanded Cross Reference:  
70, 71, 72

Remarks:

Adaptation amendments retroactively made - see 22 of 1999 s. 3

(1) During a period of declared extreme urgency a public officer authorized in writing by the Chief Executive or any person authorized in writing by such public officer may in relation to- (Amended 22 of 1999 s. 3)

- (a) a patented invention, without the consent of the proprietor of the patent; or
- (b) an invention in respect of which an application for a patent has been filed, without the consent of the applicant,

do any act in Hong Kong in relation to the invention as appears to the public officer or person authorized to be necessary or expedient in connection with the urgency giving rise to the declaration under section 68.

(2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use, or Government use, of the invention; and "use" (徵用), in relation to an invention, in section 70 to 72 shall be construed accordingly. <\* Note - Exp. X-Ref.: Sections 70, 71, 72 \*>

(3) Government use may include any act which would, apart from this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 88 to bring proceedings in respect of the application for a standard patent.

(4) Any Government use of the invention made at any time either-

- (a) after the publication of an application for a standard patent or the grant of a short-term patent for the invention; or
- (b) without prejudice to paragraph (a), in consequence of a relevant communication made otherwise than in confidence-
  - (i) after the deemed date of filing of the application for the standard patent for the invention or the date of filing of the application of the short-term patent for the invention, as the case may be; or
  - (ii) where priority was claimed, after the date of priority,

shall be made on such terms as may be agreed, either before or after the use, by the Government and the proprietor of the patent or as may in default of agreement be determined by the court on a reference under section 72.

(5) Where an invention is used by virtue of this section at any time after publication of an application for a standard patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only-

- (a) after such a patent is granted; and
- (b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application as published.

(6) The authority of a public officer in respect of an invention may be given under this section either before or after the patent is granted, and may be given to any person whether or not he is authorized directly or indirectly by the proprietor of the patent to do anything in relation to the invention.

(7) Where any Government use of an invention is made by or with the authority of a public officer under this section, then the public officer shall notify the proprietor of the patent as soon as practicable, and furnish him with such information as to the extent of the use as he may from time to time require.

(8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Government.

(9) Any reference in this section to a patented invention, in relation to any time, is a reference to an invention to which a patent has before that time been, or is subsequently, granted.

(10) In this section "relevant communication" (有關通訊), in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.

(11) Subsection (4) is without prejudice to any rule of law relating to the confidentiality of information.

[cf. 1977 c. 37 ss. 55 & 56 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	IXA	IMPORT COMPULSORY LICENCES FOR PATENTED PHARMACEUTICAL PRODUCTS	L.N. 234 of 2007	22/02/2008

(Part IXA added 21 of 2007 s. 5)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	72A	Interpretation of Part IXA	L.N. 234 of 2007	22/02/2008

In this Part, unless the context otherwise requires—

“Director” (署長) means the Director of Health;

“import compulsory licence” (進口強制性特許) means a compulsory licence granted under section 72C;

“import compulsory licensee” (進口強制性特許持有人) means the holder of an import compulsory licence;

“proprietor” (所有人), in relation to a patent, means the proprietor of the patent that is granted in Hong Kong.

(Part IXA added 21 of 2007 s. 5)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	IXB	EXPORT COMPULSORY LICENCES FOR PATENTED PHARMACEUTICAL PRODUCTS	L.N. 234 of 2007	22/02/2008

(Part IXB added 21 of 2007 s. 5)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	72K	Interpretation of Part IXB	L.N. 234 of 2007	22/02/2008

In this Part, unless the context otherwise requires—

“Director” (署長) means the Director of Health;

“export compulsory licence” (出口強制性特許) means a compulsory licence granted under section 72M;

“export compulsory licensee” (出口強制性特許持有人) means the holder of an export compulsory licence;

“Hong Kong patent number” (香港專利編號), in relation to a patent, means—

- (a) a number assigned by the Registrar to a certificate issued in respect of the patent under section 27(1)(b);
- (b) a number assigned by the Registrar to a certificate of grant issued in respect of the patent under section 118(2)(b); or
- (c) a number assigned by the Registrar to a certificate of registration issued in respect of the patent under the Registration of Patents Ordinance (Cap 42) which has been repealed under section 154(1);

“proprietor” (所有人), in relation to a patent, means the proprietor of the patent that is granted in Hong Kong.

(Part IXB added 21 of 2007 s. 5)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	X	EFFECTS OF PATENT AND PATENT APPLICATION		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	78	The claims		30/06/1997
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The claims shall define the matter for which protection is given or sought, be clear and concise and be supported by the description.

[cf. EPC Art. 84; 1992 No. 1 s. 20 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	79	The abstract		30/06/1997
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The abstract shall only serve for use as technical information; it may not be taken into account for any other purpose and in particular it may be used neither for the purpose of interpreting the scope of the protection given nor for the purpose of applying section 94(3).

[cf. EPC Art. 85; 1992 No. 1 s. 22(1) Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	XI	INFRINGEMENT		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	80	Proceedings for infringement of patent		30/06/1997
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Expanded Cross Reference:

73, 74, 75

(1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act of infringement which he alleges he is entitled under sections 73 to 75 to prevent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made- <\* Note-Exp. x-Ref: Sections 73, 74, 75 \*>

- (a) for an injunction restraining the defendant from any apprehended act of such infringement;
- (b) for an order requiring the defendant to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which the product is inextricably comprised;
- (c) for damages in respect of the infringement;
- (d) for an account of the profits derived by the defendant from the infringement;
- (e) for a declaration that the patent is valid and has been infringed by the defendant.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

(3) Subject to this Part, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court shall apply the principles applied by the court in relation to that kind of relief immediately before the commencement of this Part.

[cf. 1977 c. 37 s. 61 U.K; 1992 No. 1 s. 47 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	81	Restrictions on recovery of damages for infringement		30/06/1997
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(1) In proceedings for the infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.

(2) For the purposes of subsection (1) a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word "patent" or "patented" or "專利" or "取得專利", or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

(3) In proceedings for infringement of a patent the court may, if it thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified under section 39(4) or 126(5), as the case may be, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

(4) Where an amendment of the specification of a patent has been allowed under this Ordinance, no damages shall be awarded in any proceedings for an infringement of the patent committed before the date of the decision to allow the amendment or of the recording of the amendment pursuant to section 43(2), as the case may be, unless the court is satisfied that the specification of the patent as originally published was framed in good faith and with reasonable skill and knowledge.

(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).

[cf. 1977 c. 37 s. 62 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	83	Right to continue use begun before priority date		30/06/1997
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(1) Where a patent is granted for an invention, a person who in Hong Kong before the deemed date of filing of the application for the standard patent or the date of filing of the application for the short-term patent (as the case may be) or, if priority was claimed, before the date of priority-

- (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (2).

(2) The rights referred to in subsection (1) are-

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (1);
- (b) if such act was done or preparations had been made to do it in the course of a business-
  - (i) in the case of an individual-
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
  - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

(4) Where a patented product is disposed of to another in exercise of a right conferred by subsection (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

[cf. 1992 No. 1 s. 55 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	88	Infringement of rights conferred by publication of application for standard patent		30/06/1997
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Expanded Cross Reference:  
85, 86, 87

(1) Subject to this section, where an application for a standard patent is published the applicant shall have, as from the date of publication and until the grant of the standard patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court for damages in respect of any act which would have infringed the patent.

(2) Further to subsection (1), references in sections 73, 74, 75, 80, 81 and 85 to 87- <\* Note-Exp. x-Ref: Sections 85, 86, 87 \*>

- (a) to a patent and the proprietor of a patent, as they relate to a standard patent, shall be respectively construed as including references to the application for the standard patent and the applicant; and
- (b) to a patent being in force, being granted, being valid or existing, as they relate to a standard patent, shall be construed accordingly, and for this purpose the reference in section 81(3) to section 39(4) shall be read as a reference to section 33(4).

(3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only-

- (a) after the standard patent has been granted; and
- (b) if the act would, if the patent had been granted on the date of publication of the request to record, have infringed not only the standard patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the published request to record.

(4) Section 81(4) shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application for a standard patent as published that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court finds that it would not have been reasonable, it shall reduce the damages to such an amount as it thinks just.

(5) An applicant shall be deemed never to have had the rights set out in subsection (1) if the application for a standard patent is refused or withdrawn or is deemed to be withdrawn.

[cf. 1977 c. 37 s. 69 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	89	Remedy for groundless threats of infringement proceedings		30/06/1997
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(1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats for any such relief as is mentioned in subsection (3).

(2) In any such proceedings the plaintiff shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless-

- (a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and
- (b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is-

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as have been sustained by the plaintiff by reason of the threats.

(4) Proceedings may not be brought under this section as regards a threat to bring proceedings for an

infringement alleged to consist of making a product for putting on the market or of using a process.

(5) For the purposes of this section a notification of the existence of a patent does not of itself constitute a threat of proceedings.

[cf. 1977 c. 37 s. 70 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	XII	REVOCATION OF PATENTS		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	91	Power to revoke patents on application		30/06/1997
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#### General provisions

(1) Subject to this Ordinance, the court may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say-

- (a) that the invention is not a patentable invention;
- (b) that the patent was granted to a person who was not entitled to be granted that patent;
- (c) that the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art;
- (d) that the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application filed under section 55(4) or as mentioned in section 22 or 116, in the earlier application for a patent as filed;
- (e) that the protection conferred by the patent has been extended by an amendment of the application for the patent or the specification of the patent which is invalid;
- (f) that the patent is one of 2 standard patents for the same invention, the applications for which were filed by the same person and have the same deemed date of filing;
- (g) that the patent is one of 2 short-term patents for the same invention, the applications for which were filed by the same person and have the same date of filing;
- (h) that-
  - (i) the patent is one of 2 patents for the same invention, one such patent being a standard patent and the other being a short-term patent, the applications for which were filed by the same person and have the same deemed date of filing or date of filing; and
  - (ii) the 2 patents are not under the proprietorship of the same person;
- (i) in the case of a standard patent, that the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.

(2) An order under this section may be-

- (a) an order for the unconditional revocation of the patent; or
- (b) where the court determines that one of the grounds mentioned in subsection (1)(a) to (h) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 102 to the satisfaction of the court.

(3) In subsection (1)(f), (g) and (h)-

- (a) reference to the date of filing or deemed date of filing of an application for a patent shall be read as a reference to that date or, if priority was claimed in respect of the application, to the date of priority of the application;
- (b) reference to the applications for 2 patents being filed by the same person shall be read as a reference to that case or to the case where-
  - (i) the person filing one of the applications is the successor in title to the person filing the other application; or
  - (ii) the persons filing the applications are both successors in title to the same former proprietor of the

invention.

[cf. 1977 c. 37 s. 72 U.K.; EPC Art. 138]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	92	Application for revocation		30/06/1997
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- (1) An application for the revocation of a patent on the ground mentioned in section 91(1)(b)-
  - (a) may be made only by a person found by the court in an action for a declaration or on a reference under section 55 to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked, or in case more than one person is found to be so entitled, by all those persons; and
  - (b) notwithstanding paragraph (a), may not be made if the action for a declaration was commenced or the reference under section 55 was made after the end of the period of 2 years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(2) On an application for the revocation of a patent on the ground mentioned in section 91(1)(f), (g) or (h), the court shall not make an order for revocation unless the proprietor of each patent has been allowed an opportunity of making observations and of amending the specification of the patent, and if the proprietors fail to satisfy the court that there are not 2 patents in respect of the same invention, or to amend one or both specifications so as to prevent there being 2 patents in respect of the same invention, the court shall revoke the patent having the shorter remaining period in force under section 39(1) or 126(1) (as may be appropriate) or, if both patents have the same remaining period in force, shall revoke any one of the patents.

[cf. 1977 c. 37 s. 72 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	93	Patentable inventions		30/06/1997
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#### Patentable inventions

- (1) An invention is patentable if it is susceptible of industrial application, is new and involves an inventive step.
- (2) The following in particular shall not be regarded as inventions within the meaning of subsection (1)-
  - (a) a discovery, scientific theory or mathematical method;
  - (b) an aesthetic creation;
  - (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
  - (d) the presentation of information.
- (3) Subsection (2) shall exclude patentability of subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to such subject-matter or activities as such.
- (4) A method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body shall not be regarded as an invention which is susceptible of industrial application for the purposes of subsection (1), but this subsection shall not apply to a product, and in particular a substance or composition, for use in any such method.
- (5) An invention the publication or working of which would be contrary to public order ("ordre public") or morality shall not be a patentable invention; however, the working of an invention shall not be deemed to be so contrary merely because it is prohibited by any law in force in Hong Kong.
- (6) A plant or animal variety or an essentially biological process for the production of plants or animals, other than a microbiological process or the products of such a process, shall not be patentable.

[cf. EPC Art. 52 & 53; 1977 c. 37 ss. 1 & 4 U.K.; 1992 No. 1 ss. 9 & 10 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	94	Novelty		30/06/1997

- (1) An invention shall be considered to be new if it does not form part of the state of the art.
- (2) The state of the art shall be held to comprise everything made available to the public (whether in Hong Kong or elsewhere) by means of a written or oral description, by use, or in any other way-
- (a) before the deemed date of filing of an application for a standard patent for the invention or, if priority was claimed, before the date of priority; or
  - (b) before the date of filing of an application for a short-term patent for the invention or, if priority was claimed, before the date of priority,
- whichever is the earlier.
- (3) Additionally, the state of the art shall be considered as comprising the content of-
- (a) any application for a standard patent as filed, of which-
    - (i) the deemed date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and
    - (ii) the corresponding designated patent application was published in the designated patent office on or after the date referred to in subsection (2);
  - (b) any designated patent application as filed in a designated patent office-
    - (i) of which the date of filing or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office is before the date referred to in subsection (2); and
    - (ii) which was published by the designated patent office on or after the date referred to in subsection (2); or
  - (c) any application for a short-term patent-
    - (i) of which the date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and
    - (ii) pursuant to which a short-term patent was published under this Ordinance on or after the date referred to in subsection (2).
- (4) Subsections (1) to (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 93(4) where its use for any method referred to in that subsection is not comprised in the state of the art.

[cf. EPC Art. 54; 1977 c. 37 s. 2 U.K.; 1992 No. 1 s. 11 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	95	Non-prejudicial disclosure in case of standard patent application		30/06/1997

- (1) For the application of section 94 in the case of a standard patent application, but subject to section 15(2)(f), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the deemed date of filing of the application and if it was due to, or in consequence of-
- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
  - (b) the fact that the applicant or any proprietor of the invention for the time being has displayed the invention at a prescribed exhibition or meeting.
- (2) Subsection (1)(b) shall only have effect if, at the time of filing the corresponding designated patent application, the applicant stated in accordance with the law of the designated patent office relating to non-prejudicial disclosure that the invention had been so displayed.

[cf. EPC Art. 55]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	96	Inventive step		30/06/1997
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(1) An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

(2) For the purpose of subsection (1), if the state of the art also includes documents within the meaning of section 94(3), these documents are not to be considered in deciding whether there has been an inventive step.

[cf. EPC Art. 56]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	97	Industrial application		30/06/1997
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An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

[cf. EPC Art. 57]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	98	Priority right		30/06/1997
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#### Priority for standard patent application

(1) This section applies to the proprietor of a designated patent application for an invention who, on the basis of an earlier application in a Paris Convention country for a patent or other protection for the same invention, enjoys under the law of the designated patent office a right of priority for the period of 12 months after the date of filing the earlier application.

(2) Such person or his successor in title shall enjoy, for the purposes of filing an application for a standard patent for the invention which is the subject of the designated patent application, the same right of priority as he enjoys in respect of the designated patent application under the law of the designated patent office.

(3) Subsections (1) and (2) also apply where-

- (a) the earlier application was filed in a country, territory or area which is not a Paris Convention country; and
- (b) the right of priority enjoyed in the designated patent office is granted consequent upon an international agreement to which Hong Kong is a party or which is otherwise applied to Hong Kong by a party to the agreement, which agreement provides for the grant of such priority on the basis of a first filing made in or for that country, territory or area and subject to conditions equivalent to those laid down in the Paris Convention.

(4) Reference in this section to the law of a designated patent office includes reference to the law of the designated patent office dealing with the circumstances under which-

- (a) a filing in a Paris Convention country that is equivalent to a regular national filing under the domestic legislation of that country or under bilateral or multilateral agreements gives rise to a right of priority;
- (b) a subsequent application for a patent for the same subject-matter as a previous first application and filed in or in respect of the same Paris Convention country is to be considered as the first application for the purposes of determining priority;
- (c) multiple priorities may be claimed in respect of a designated patent application.

(5) The rights conferred by this section are subject to sections 15(2)(e) and 23(3)(c).

(6) In this section, "Paris Convention country" (巴黎公約國) means a country or territory other than Hong Kong which is a party to the Paris Convention or a dependent territory of any such country to which that Convention has been extended.

[cf. EPC Art. 87 & 88; 1992 No. 1 ss. 25 & 26 Eire; 1977 c. 37 s. 5 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	99	Effect of priority right		30/06/1997

(1) The right of priority conferred under section 98 shall have the effect that the date of priority enjoyed in the designated patent office shall be regarded as being the date of priority of the standard patent application for the purposes of this Ordinance.

(2) A patent granted pursuant to a standard patent application in respect of which the proprietor enjoys a right of priority as provided in section 98 shall not be invalidated by reason only of the fact that any subject-matter disclosed in the earlier application (that is to say, the application on the basis of which the right of priority is enjoyed in the designated patent office) was made available to the public at any time after the date of filing of the earlier application.

[cf. EPC Art. 89; 1992 No. 1 s. 27 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	100	Right to a patent to belong to inventor		30/06/1997

#### Right to a patent

(1) Except as provided in subsection (2), the right to a patent shall belong to the inventor or his successor in title.

(2) If the inventor is an employee, the right to the patent shall be determined in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed or, if the identity of such country, territory or area cannot be determined, in accordance with the law of the country, territory or area in which the employer has his place of business to which the employee is attached.

(3) If 2 or more persons have made an invention independently of each other, the right to the patent shall belong-

- (a) as between persons who have applied for or been granted a standard patent for the invention, to the person in respect of whose application for the standard patent the date of filing of the corresponding designated patent application or, if priority was claimed, the date of priority, is the earlier or earliest; or
- (b) as between persons who have applied for or been granted a short-term patent for the invention, to the person in respect of whose application for a short-term patent the date of filing or, if priority was claimed, the date of priority, is the earlier or earliest; or
- (c) where one or more of the persons has applied for or been granted a standard patent and one or more of the persons has been granted a short-term patent, to the person in respect of whose application the date specified in paragraphs (a) and (b) (as may be appropriate) is the earlier or earliest,

but in the application of paragraphs (a) and (c) regard shall only be had to an application for a standard patent that has been published under this Ordinance.

[cf. EPC Art. 60; 1992 No. 1 s. 16 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	101	Proceedings in which validity of patent may be put in issue		30/06/1997

#### Putting validity in issue

(1) Subject to the following provisions of this section, the validity of a patent may be put in issue-

- (a) by way of defence, in proceedings for infringement of the patent under section 80 or, in the case of a standard patent, in proceedings under section 88 for infringement of rights conferred by the publication of an application;

- (b) in proceedings under section 89;
- (c) in proceedings in which a declaration in relation to the patent is sought under section 90;
- (d) in proceedings before the court under section 91 for the revocation of the patent;
- (e) in proceedings under section 72.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Ordinance or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 91 or otherwise) are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground mentioned in section 91(1)(b) unless-

- (a) it has been determined-
  - (i) in entitlement proceedings commenced by that person; or
  - (ii) in the proceedings in which the validity of the patent is in issue, that the patent should have been granted to him and not some other person; and
- (b) except in the case at paragraph (a)(i)-
  - (i) the proceedings in which the validity of the patent is in issue are commenced before the end of 2 years beginning with the date of the grant of the patent; or
  - (ii) it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence or counterclaim the court shall, if it thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a).

(6) In subsection (4) "entitlement proceedings" (享有權法律程序), in relation to a patent, means a reference under section 55(1) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted.

[cf. 1977 c. 37 s. 74 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	XIII	GENERAL PROVISIONS AS TO AMENDMENT OF PATENTS AND PATENT APPLICATIONS		30/06/1997

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	102	Amendment of patent in infringement or revocation proceedings		30/06/1997

(1) In any proceedings before the court in which the validity of a patent is put in issue the court may, subject to section 103, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court thinks fit.

(2) A person may give notice to the court of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[cf. 1977 c. 37 s. 75 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	103	Amendments of applications and patents not to include added matter		30/06/1997
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- (1) An application for a patent-
  - (a) which is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and
  - (b) which discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed,
 may be filed under section 55(4), or as mentioned in section 22 or 116 (as may be appropriate), but shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.
- (2) Any amendment of an application for a standard patent filed under section 31 shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.
- (3) Any amendment of the specification of a patent filed under section 46(1) or 102, or of the specification of a standard patent filed under section 43 shall be invalid to the extent that it-
  - (a) extends the subject-matter disclosed in the application as filed; or
  - (b) extends the protection conferred by the patent.

[cf. 1977 c. 37 s. 76 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Part:	XIV	LANGUAGE OF PROCEEDINGS; AUTHENTIC TEXT		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	104	Language of proceedings before Registrar		30/06/1997
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- (1) An application for a patent must be filed in one of the official languages.
- (2) Except as otherwise provided in rules made for the purposes of this section, and notwithstanding section 5 of the Official Languages Ordinance (Cap 5), the official language in which an application for a patent is filed shall be used as the language of the proceedings in all proceedings before the Registrar concerning the application or the resulting patent.
- (3) Where a designated patent application in respect of an invention is in one of the official languages, nothing in this section shall be construed as requiring an application for a standard patent in respect of that invention to be filed in the same official language.
- (4) Rules may be made-
  - (a) requiring, in respect of any document filed or to be filed with the Registrar in proceedings under this Ordinance, the filing of a translation of the document into the language of the proceeding or into one or both official languages;
  - (b) providing for the use by any person in oral proceedings before the Registrar, of a language other than the language of the proceedings;
  - (c) in respect of documents to be used for the purpose of evidence in proceedings before the Registrar and which are in a language other than the language of the proceedings, providing for the filing of the document in that other language and the filing of a translation of the document into the language of the proceedings or into one of the official languages;
  - (d) in respect of information provided or to be provided to the Registrar and which is to be entered in the register, requiring the provision of that information in both official languages;
  - (e) specifying, in cases of entries which are made in the register in both official languages, which entry is to be authentic.
- (5) Rules made for the purposes of subsection (4)(a) or (d)-
  - (a) may specify periods within which translations of documents into the language of the proceedings or into the official languages are to be filed or within which information in the official languages is to be provided;

- (b) may provide for extensions, upon application by a party to the proceedings, of such periods, and may require that applications for such extension shall be subject to the payment of a penalty fee.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	106	Authentic text of standard patent and standard patent application		30/06/1997

(1) Subject to subsection (2), the text of the specification of a corresponding designated patent or corresponding designated patent application in the language of the proceedings before the designated patent office shall be the authentic text of the specification of the standard patent or standard patent application respectively for the purposes of any proceedings under this Ordinance relating to the standard patent or standard patent application before the Registrar or a court.

(2) If-

- (a) the language of the proceedings before the designated patent office is other than one of the official languages; and
- (b) the corresponding designated patent or designated patent application as translated into one of the official languages confers protection which is narrower than that conferred by it in the language of the proceedings before the designated patent office,

then a translation into one of the official languages of the specification of the corresponding designated patent or of the claims of the corresponding designated patent application shall be treated as the authentic text of the specification of the standard patent or of the claims of the standard patent application respectively for the purpose of any proceedings under this Ordinance, other than proceedings for the revocation of the patent.

(3) If any translation such as is mentioned in subsection (2) results in a designated patent or designated patent application conferring the narrower protection, the proprietor of or applicant for the standard patent may file a corrected translation with the Registrar and, if he pays the prescribed fee within the prescribed period, the Registrar shall publish it, but-

- (a) any payment for any use of the invention which (apart from section 69) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section;
- (b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent has been granted,

unless before that use or the doing of the act the corrected translation has been published by the Registrar or the proprietor or applicant has sent the corrected translation by post or delivered it to the public officer who made use or authorized the use of the invention or, as the case may be, to the person alleged to have done that act.

(4) Where a correction of a translation is published under subsection (3) and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 69) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by section 41(4) and (5), and section 41(6) shall apply accordingly.

(5) In this section "language of the proceedings before the designated patent office" (在指定專利當局進行的法律程序的語文), in relation to a corresponding designated patent or corresponding designated patent application, means the language in which proceedings relating to that patent or application are to be conducted before the designated patent office.

[cf. 1977 c. 37 s. 80 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Part:	XV	SHORT-TERM PATENTS		30/06/1997

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	108	Right to apply for a short-term patent		30/06/1997
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#### Right to short-term patent

(1) An application for a short-term patent to be granted under section 118 may be made by any person either alone or jointly with another.

(2) For the purposes of proceedings before the Registrar the applicant shall be deemed to be entitled to exercise the right to the short-term patent.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	109	Non-prejudicial disclosure		30/06/1997
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#### Patentability

For the purposes of section 94, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the filing of the short-term patent application and if it was due to, or in consequence of-

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
- (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong,

but paragraph (b) shall apply only if the short-term patent application as filed contains a statement to the effect that the invention has been so displayed and contains written evidence in support of the statement complying with any prescribed conditions.

[cf. EPC Art. 55]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	110	Priority right	L.N. 47 of 2002	01/06/2002
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#### Priority

(1) A person who has filed-

- (a) in or for any Paris Convention country or WTO member country, territory or area, an application for a patent or other protection in respect of an invention; or
  - (b) in Hong Kong, an application for a short-term patent under this Part in respect of an invention,
- or his successors in title, shall enjoy, for the purpose of filing a subsequent application for a short-term patent under this Part in respect of the same invention, a right of priority for the period of 12 months after the date of filing of the first application, subject to compliance with any prescribed conditions.

(2) For the purposes of subsection (1) as it applies in the case of a filing specified in paragraph (a) of that subsection-

- (a) every filing which in a Paris Convention country or WTO member country, territory or area is equivalent to a regular national filing under its domestic legislation or under bilateral or multilateral agreements shall be recognized as giving rise to a right of priority;
- (b) a subsequent application for a patent or other protection for the same subject-matter as a previous first application and filed in or for the same Paris Convention country or WTO member country, territory or area shall be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn,

abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority;

- (c) where pursuant to paragraph (b) a subsequent application for a patent or other protection is considered as a first application, the previous application may not thereafter serve as a basis for claiming a right of priority,

and in this subsection, "regular national filing" (正規國家提交) means any filing that establishes the date on which the application was filed, whatever may be the outcome of the application.

(3) For the purposes of subsection (1) as it applies in the case of a filing specified in paragraph (b) of that subsection-

- (a) every regular filing of an application for a short-term patent under this Part shall be recognized as giving rise to a right of priority in relation to other applications under this Part;
- (b) a subsequent application for a short-term patent under this Part for the same subject-matter as a previous first application for a short-term patent shall be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority;
- (c) where pursuant to paragraph (b) a subsequent application for a short-term patent is considered as a first application, the previous application for a short-term patent may not thereafter serve as a basis for claiming a right of priority,

and in this subsection "regular filing of an application for a short-term patent" (短期專利申請的正規提交) means any filing that establishes the date on which the application for the short-term patent was filed, whatever may be the outcome of the application.

(3A) A right of priority arising as a result of the filing in or for any Paris Convention country or WTO member country, territory or area of an application for a patent or other protection in respect of an invention, or an application for a short-term patent under this Part, may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the person's "successors in title" shall be construed accordingly. (Added 2 of 2001 s. 8)

(4) In this section, "application for a patent or other protection" (專利或其他保護的申請) means an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate filed in or for any Paris Convention country or WTO member country, territory or area.

[cf. EPC Art. 87; 1992 No. 1 s. 25 Eire]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	111	Claiming priority		30/06/1997

(1) An applicant for a short-term patent desiring to take advantage of the priority of a previous application shall file in the prescribed manner a statement of priority and a copy of the previous application.

(2) Multiple priorities may be claimed in respect of a short-term patent application, notwithstanding the fact that they originated in different countries, and where appropriate, multiple priorities may be claimed for any one claim.

(3) Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

(4) If one or more priorities are claimed in respect of a short-term patent application, the right of priority shall cover only those elements of the short-term patent application which are included in the application or applications whose priority is claimed.

(5) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted if the documents of the previous application as a whole specifically disclosed such elements.

(6) Where a statement of priority is filed in accordance with this section, the applicant shall for the purpose of proceedings before the Registrar be deemed to be entitled to enjoy the right of priority shown in the statement.

[cf. EPC Art. 88]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	112	Effect of priority right		30/06/1997

(1) The right of priority shall have the effect that the date of priority of the previous application claimed under section 111 shall be regarded as being the date of priority of the short-term patent application for the purposes of section 94(2) and (3) as it applies to this Part.

(2) Where a short-term patent application is filed and the priority of a previous application is claimed under section 111, then, notwithstanding anything contained in this Ordinance, the short-term patent application and any short-term patent granted in pursuance of it shall not be invalidated by reason only of the fact that any subject-matter disclosed in the previous application was made available to the public at any time after the date of filing of the previous application.

[cf. EPC Art. 89]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	113	Requirements of short-term patent application		30/06/1997

### Applications

(1) Every application for a short-term patent shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain-

- (a) a request for the grant of a short-term patent;
- (b) a specification which provides on the face of it for-
  - (i) a description of the invention to which the application relates;
  - (ii) one or more claims but not exceeding one independent claim;
  - (iii) any drawings referred to in the description or the claim or claims;
- (c) an abstract; and
- (d) a search report in relation to the invention.

(2) An application for a short-term patent-

- (a) shall state the name and address of the applicant;
- (b) shall identify the person or persons whom the applicant believes to be the inventor or inventors and shall specify the last known address of that person or persons;
- (c) where the applicant is not the sole inventor or the applicants are not the joint inventors, shall contain a statement indicating the derivation of his or their entitlement to exercise the right to the short-term patent; and
- (d) shall specify an address in Hong Kong for service of documents.

(3) Every such application shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.

(4) Rules may provide-

- (a) that a short-term patent application shall or may contain a title of the invention and a designation of the classification of the invention;
- (b) for the manner in which the following matters shall or may be contained in a short-term patent application-
  - (i) any statement in accordance with subsection (2) relating to the inventor or the derivation of the applicant's right to grant;
  - (ii) any claim to the priority of an earlier patent application and supporting priority documents in accordance with section 111;
  - (iii) any request for deferral of the grant of a patent in accordance with section 119;
  - (iv) any claim regarding non-prejudicial disclosure in accordance with section 109;
  - (v) in relation to any invention which requires for its performance the use of a micro-organism,



information concerning the availability to the public of samples of the micro-organism.

(5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the application, and if either fee is not paid within that period or within such further period of grace as may have been allowed under subsection (6) the application shall be deemed to be withdrawn.

(6) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (5) may still be validly paid.

(7) The foregoing provisions shall not prevent any application being initiated by documents complying with section 114(2).

(8) In this section "search report" (查檢報告) means a report-

- (a) by a prescribed searching authority of a search undertaken by that authority as to the prior art in relation to the invention, based on the claims and having due regard to the description and drawings (if any); and
- (b) which contains the prescribed information.

[cf. 1992 No. 1 s. 18 Eire; EPC Art. 78]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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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]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	115	Examination as to formal requirements		30/06/1997
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(1) If a short-term patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of section 113(5), the Registrar shall examine whether the requirements of section 113 and of any rules made for the purposes of that section (the "formal requirements") have been satisfied.

(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 short-term patent shall be refused; or
- (b) any deficiencies as regards the formal requirements noted in the examination under subsection (1) are not corrected in accordance with the rules, then except as provided in subsection (4), the application for a short-term patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.

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

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	116	Divisional short-term patent application	L.N. 46 of 2001	01/04/2001
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Where, after an application for a short-term patent has been filed and before the date under section 122 on which preparation for publication of the specification of the patent has been completed, a new application for a short-term patent is filed by the original applicant or his successor in title in accordance with the rules to be prescribed, being an application- (Amended 64 of 2000 s. 37)

- (a) which is in respect of any part of the subject-matter contained in the earlier short-term patent application;
- (b) which complies with the relevant requirements including procedures and time limits specified in the rules; and
- (c) which does not contravene section 103,

then such new application shall be treated as having, as its date of filing, the date of filing of the earlier short-term application and shall have the benefit of any right of priority.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	117	Formality examination only		30/06/1997
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Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a short-term patent for an invention shall be construed as imposing any obligation upon the Registrar to consider or to have regard to, for the purpose of such examination, any question as to-

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) any matter specified in section 45, 77, 78, 79, 93, 94, 96, 97, 100, 109, 110, 111(2) to (6) or 120(2).

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	118	Grant of short-term patent and publication	L.N. 40 of 2004	07/05/2004
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#### Procedure up to and including grant

(1) If on examination by the Registrar under section 115(1) an application for a short-term patent is found to have satisfied the requirements of that provision, or if on a subsequent examination the deficiencies noted by the Registrar under section 115(2) are found to have been corrected in accordance with the rules, then as soon as practicable after such examination, but subject to sections 119 and 124, the Registrar shall grant a short-term patent for the invention.

- (2) As soon as practicable after a short-term patent has been granted under this section the Registrar shall-
  - (a) publish in the prescribed manner the specification of the short-term patent, the names of the proprietor and, if different, the inventor;
  - (b) issue a certificate of grant; and
  - (c) advertise the fact of such grant by notice in the official journal. (Amended 2 of 2001 s. 14)

(3) The Registrar may in any publication under subsection (2)(a) publish in addition to the matters specified in that subsection any other matters constituting or relating to the patent which in the Registrar's opinion it is desirable to publish.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	120	Amendment of application for short-term patent before grant		30/06/1997
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(1) Subject to this section and sections 122 and 103, at any time before a patent is granted under this Part an applicant may, in accordance with the prescribed conditions, amend the application of his own volition.

(2) Any amendment made under this section shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(3) The Registrar may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a short-term patent so as to acknowledge a registered trade mark.

[cf. 1977 c. 37 s. 19 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	121	Withdrawal of application		30/06/1997
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(1) At any time before a short-term patent is granted the applicant may, subject to section 122, withdraw in writing his application and any such withdrawal may not be revoked.

(2) Where a short-term patent application is withdrawn under this section, or is deemed under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, the following provisions shall apply-

(a) the applicant shall continue to enjoy the right of priority under section 112 which he enjoyed immediately before such withdrawal or refusal;

(b) no other right may be claimed under this Ordinance in relation to the application.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	123	Further processing of, and restoration of rights in respect of, short-term patent applications		30/06/1997
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(1) Sections 28(1) and (2), 29(1) and (2) and 30 shall apply, subject to necessary modification, to an application for a short-term patent as if a reference in those sections to an application for a standard patent and to Part II were a reference to an application for a short-term patent and to this Part respectively.

(2) Section 28 as applied by subsection (1) does not apply in the case of a deemed withdrawal of an application under section 113(5).

(3) Section 29 as applied by subsection (1) does not apply in the case of a failure to comply with a time limit under section 113, 114 or 115.

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Section:	124	Registrar may refuse to grant short-term patent		30/06/1997
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The Registrar may refuse to grant a short-term patent for an invention if he considers that the invention is not a patentable invention by reason of any of the matters specified in section 93(5), and the Registrar shall give notice of any such refusal to the applicant.

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	125	Short-term patent application based on international application	L.N. 47 of 2002	01/06/2002
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(1) Where an international application seeking a patent for a utility model and designating the People's Republic of China has entered its national phase in the People's Republic of China, the applicant in the international application may apply for a short-term patent for the invention (if any) disclosed in that application.

(2) An application for a short-term patent made pursuant to this section may be filed at any time before a date 6 months after the entry into the national phase of the international application in the People's Republic of China, or such other date as may be prescribed by rules.

(3) An application for a short-term patent made pursuant to this section shall contain-

- (a) a photocopy of the international application as published by the International Bureau under Article 21 of the Patent Cooperation Treaty;
- (b) a photocopy of the international search report in relation to the international application as published under Article 21(3) of the Patent Cooperation Treaty (whether contained in the international application as published or separately published);
- (c) the date of entry of the international application into the national phase in the People's Republic of China;
- (d) a photocopy of the translation of the international application (if any) published by the State Intellectual Property Office; and (Amended 2 of 2001 s. 9)
- (e) a photocopy of any information that may be published by the State Intellectual Property Office concerning the international application. (Amended 2 of 2001 s. 9)

(4) Section 113 applies in relation to an application for a short-term patent made pursuant to this section as if for subsection (1)(b) to (d) of that section there was substituted a reference to the documents specified in subsection (3)(a) to (e) of this section.

(5) Where an application made pursuant to this section results in the grant of a short-term patent, the application shall be deemed to have as its date of filing the international filing date accorded to the international application for the purposes of Article 11 of the Patent Cooperation Treaty and, in this Ordinance, reference to the date of filing of an application in relation to a short-term patent which has been granted pursuant to an application made as provided for in this section shall be construed accordingly.

(6) In this section, "State Intellectual Property Office" (國家知識產權局) means the State Intellectual Property Office established under the laws of the People's Republic of China the functions of which include the granting of patents for inventions. (Amended 2 of 2001 s. 9)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	126	Term of short-term patent	L.N. 40 of 2004	07/05/2004
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#### Provisions as to short-term patents after grant

(1) A short-term patent granted under this Part-

- (a) shall take effect on the date on which the fact of its grant is advertised in the official journal; and (Amended 2 of 2001 s. 14)
- (b) subject to subsection (2) and (3), shall remain in force until the end of the period of 8 years beginning with the date of filing the application for the patent.

(2) If it is desired to keep a short-term patent in force for a further 4 years after the expiry of the 4th year from the date of filing of the application for that patent, the prescribed renewal fee shall be paid within the 3 months ending with the expiry of that 4th year, and a short-term patent shall cease to have effect at the expiry of that 4th year if the renewal fee is not so paid.

(3) Despite subsection (2), where the date of grant of a short-term patent occurs after the expiry of the 4th year from the date of filing of the application for that patent then-

- (a) the prescribed renewal fee may be paid at any time before the expiry of 3 months beginning from the date of grant and in the event of such payment the patent shall remain in force for the balance of the period of 4 years specified in subsection (2);
- (b) the patent shall cease to have effect under this section if, and only if, the prescribed renewal fee is not paid as provided in paragraph (a).

(4) The Registrar may by regulation amend the period specified in subsection (2) as being the period ending

with the expiry of the 4th year from the date of filing of the short-term patent application.

(5) If within 6 months after the end of the period specified in subsection (2) or (3), as the case may be, the renewal fee and any prescribed additional fee is paid, the short-term patent shall be treated as if it had never expired, and accordingly-

- (a) anything done under or in relation to it during that further period shall be valid;
  - (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
  - (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.
- (6) The Chief Executive in Council may by regulation amend- (Amended 22 of 1999 s. 3)
- (a) the period specified in subsection (1)(b) as being the period for which a short-term patent shall remain in force;
  - (b) the period specified in subsection (2) or (3) by reference to which a short-term patent, if not renewed, shall cease to have effect.

[cf. 1977 c. 37 s. 25 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	128	Disclosure of invention by specification; availability of samples of micro-organisms		30/06/1997

#### Miscellaneous

(1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a short-term patent, or of a short-term patent, for an invention which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art.

(2) The rules may in particular require the applicant or proprietor-

- (a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism; and
- (b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the Registrar has given his certificate as to any matter.

(4) An application for revocation of the short-term patent under section 91(1)(c) may be made if any of the requirements of the rules cease to be complied with.

[cf. 1977 c. 37 s. 125A U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	129	Court proceedings in relation to short-term patents		30/06/1997

(1) In any proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to a short-term patent-

- (a) it is for the proprietor of the 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) If in proceedings before the court under this Ordinance in relation to a short-term patent 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.

- (3) A court making an order for an early trial under subsection (2)-
- (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.

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Part:	XVI	MISCELLANEOUS		30/06/1997
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Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	138	Licences granted by order of the court or Registrar or by Director of Health*	L.N. 234 of 2007	22/02/2008
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(1) Any order for the grant of a licence under section 14, 56, 64 or 65 shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the standard patent and all other necessary parties, granting a licence in accordance with the order. (Amended 21 of 2007 s. 6)

(2) Without prejudice to any other method of enforcement, any import compulsory licence or export compulsory licence granted under section 72C or 72M (as the case may be) has effect as if it were a deed, executed by the proprietor of the standard patent or the short-term patent (as the case may be) and all other necessary parties. (Added 21 of 2007 s. 6)

[cf. 1977 c. 37 s. 108 U.K.]

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\* (Amended 21 of 2007 s. 6)

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
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Section:	139A	Protection of Government and public officers	L.N. 234 of 2007	22/02/2008
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(1) No liability shall rest on the Government or any public officer by reason of the fact that—

- (a) any authority is given under section 69; or
- (b) any import compulsory licence or export compulsory licence is granted under section 72C or 72M (as the case may be).

(2) A public officer is not personally liable in respect of any act or omission of his if it was done or made by him in the honest belief that it was required or authorized in the exercise of any function, duty or power of his under Part IX, IXA or IXB (as the case may be).

(3) The protection conferred on public officers by subsection (2) in respect of any act or omission does not affect any liability of the Government in tort for that act or omission.

(Added 21 of 2007 s. 7)

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Section:	143	Unauthorized claim that patent has been applied for		30/06/1997
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(1) Subject to this section, a person who represents that a patent has been applied for in respect of any article disposed of for value by him when in fact-

(a) no such application for a patent has been made; or

(b) any such application has been withdrawn or deemed withdrawn,

commits an offence and is liable on summary conviction to a fine at level 3.

(2) Subsection (1)(b) does not apply where the representation is made (or continues to be made) before the expiry of a period which begins with the withdrawal or deemed withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words "patent applied for" or "patent pending" or "已申請專利" or "專利申請待決", or anything expressing or implying that an application has been made for a patent in respect of the article, shall be taken to represent that an application for such a patent has been made.

(4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

[cf. 1977 c. 37 s. 111 U.K.]

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Part:	XVIII	ADMINISTRATIVE PROVISIONS		30/06/1997
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Section:	147	Information about patent applications and patents, and inspection of documents		30/06/1997
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(1) After publication of an application for a standard patent in accordance with section 20 or the grant of a short-term patent the Registrar shall upon the filing of a written request in the prescribed manner give the person making the request such information, and permit him to inspect such documents, relating to the application or any patent granted in pursuance of the application or to the short-term patent as may be specified in the request, subject, however, to any prescribed restrictions.

(2) Subject to this section, until an application for a standard patent is so published or a short-term patent is granted documents or information constituting or relating to the application for the standard patent or the short-term patent shall not, without the consent of the proprietor or the applicant (as the case may be), be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent the Registrar from publishing or communicating to others any prescribed bibliographic information about an unpublished application for a standard patent or an application for a short-term patent.

(4) Where a person is notified that an application for a standard patent has been made, but not published in accordance with section 20, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

(5) Where a person is notified that an application for a short-term patent has been made and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification, that person may make a request under subsection (1) and that subsection shall apply accordingly.

(6) Where an application for a standard patent is filed, but not published, and a new application for a standard patent is filed in respect of any part of the subject-matter of the earlier application (either in accordance with the rules or in pursuance of an order under section 13) and is published, any person may make a request under subsection (1) in the prescribed manner relating to the earlier application and the Registrar shall give him such information and permit him to inspect such documents as could have been given or inspected if the earlier application had been published.

[cf. 1977 c. 37 s. 118 U.K.]

Chapter:	514	PATENTS ORDINANCE	Gazette Number	Version Date
Section:	149	Rules		30/06/1997

- (1) The Registrar may make rules-
  - (a) for the purposes of any provision of this Ordinance authorizing the making of rules (other than rules of court) with respect to any matter; and
  - (b) for prescribing anything authorized or required by an provision of this Ordinance to be prescribed, and generally for regulating practice and procedure under this Ordinance.
- (2) Without prejudice to the generality of subsection (1), rules may make provision-
  - (a) in connection with applications for patents and other documents which may be filed with the Registrar-
    - (i) prescribing the form and contents of any such documents;
    - (ii) requiring copies of such documents to be furnished;
    - (iii) prescribing the manner of filing of such documents;
  - (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or in the registry and authorizing the rectification of irregularities of procedure;
  - (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the registry and providing for the remission of fees in the prescribed circumstances;
  - (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
  - (e) requiring the Registrar to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;
  - (f) providing for the appointment of advisers to assist the Registrar in any proceedings before him;
  - (g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Ordinance or the rules and providing for the alteration of any period of time specified in this Ordinance or the rules;
  - (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
  - (i) without prejudice to any other provision of this Ordinance, requiring and regulating the translation of documents in connection with a patent or an application for a patent into the language of the proceedings or into one or both official languages and the filing and verification of any such translations;
  - (j) providing for the publication and sale of documents by the registry and of information about such documents;
  - (k) prescribing opposition or revocation proceedings in designated patent offices for the purposes of sections 43 and 44.
- (3) Rules may make different provision for different cases.
- (4) Rules made under this section-
  - (a) authorizing the rectification of irregularities of procedure; or
  - (b) providing for the alteration of any period of time,
 may authorize the extension or further extension of any period of time notwithstanding that the period has already expired.
- (5) Rules prescribing fees, including any penalty fee under section 104(5)(b), shall not be made except with the consent of the Financial Secretary.
- (6) Any rules made under subsection (2)(c) may-
  - (a) prescribe fees fixed at; or
  - (b) provide for fees to be fixed at,
 levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function.
- (7) Rules may provide for arrangements to be made by the Registrar for the publication of reports of cases relating to patents decided by the Registrar and of cases relating to patents (whether under this Ordinance or otherwise) decided by any court or body (whether in Hong Kong or elsewhere).



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Part:	XIX	REPEALS AND TRANSITIONAL ARRANGEMENTS		30/06/1997
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Section:	159	Interpretation (Part XIX)		30/06/1997
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(1) In this Part, unless the context otherwise requires-

"1949 Act" (《1949年法令》) means the Patents Act 1949 (1949 c. 87 U.K.), and "1949 Act patent" (1949年法令專利) means a patent granted under that Act or under the 1977 Act pursuant to an application under the 1949 Act;

"1977 Act" (《1977年法令》) means the Patents Act 1977 (1977 c. 37 U.K.), and "1977 Act patent" (1977年法令專利) means a patent granted under that Act pursuant to an application made before the commencement date and means also a European patent (UK) that has effect in the United Kingdom pursuant to section 77 of the 1977 Act;

"commencement date" (生效日期) means the date appointed under section 1(2) as being the date on which this Ordinance comes into operation;

"European patent (UK)" (歐洲專利(聯合王國)) means a patent granted under the Convention on the Grant of European Patents (European Patent Convention) and designating the United Kingdom;

"existing 1949 Act or 1977 Act patent" (現有的1949年法令或1977年法令專利) means a 1949 Act or 1977 Act patent-

- (a) granted before the commencement date and capable as at that date of registration under the repealed Ordinance; and
- (b) for which as at the commencement date no valid application for registration under the repealed Ordinance had been made;

"existing application for a 1949 Act patent" (1949年法令專利的現有申請) means an application for a patent made under the 1949 Act, in respect of which as at the commencement date a patent had not been granted;

"existing registered patent" (現有註冊專利) means a 1949 Act or 1977 Act patent which-

- (a) was registered under the repealed Ordinance before the commencement date; and
- (b) at the commencement date-
  - (i) was still in force in the United Kingdom;
  - (ii) had ceased to have effect in the United Kingdom, but subsequently is treated for the purposes of the 1977 Act as having never expired; or
  - (iii) had ceased to have effect in the United Kingdom but subsequently is restored by an order made under the 1977 Act;

"pending application for registration of a patent under the repealed Ordinance" (待決的將專利根據已廢除條例註冊的申請) means an application made before the commencement date for registration of a 1949 Act or 1977 Act patent under section 3 of the repealed Ordinance, but not as at that date registered under the repealed Ordinance;

"published application for a 1977 Act patent" (已發表的1977年法令專利的申請) means an application for a patent-

- (a) pursuant to which there could be granted a 1977 Act patent; and
- (b) published before the commencement date,

and in the case of an international application reference in paragraph (b) to publication shall be read as a reference to such publication of the application by a designated patent office as serves to indicate that the international application has validly entered its national phase;

"the repealed Ordinance" (已廢除條例) means the Registration of Patents Ordinance (Cap 42).

(2) In this Part, unless the context otherwise requires-

- (a) a reference to the registration of a patent under the repealed Ordinance is a reference to the issue of a certificate of registration under section 5 of that Ordinance in respect of that patent;
- (b) a reference to the repealed Ordinance is a reference to that Ordinance as it applied immediately before the commencement date;
- (c) a reference to a patent granted under this Ordinance pursuant to this Part includes a reference to a patent treated as so granted.

## **IMPLICATIONS OF THE PROPOSAL**

### **Economic Implications**

The proposed OGP route provides an alternative to the existing “re-registration” system for applicants to file applications for standard patent directly in Hong Kong without first obtaining a patent in a designated patent office, which could help overcome the difficulties SMEs may face in making overseas patent applications. However, considerable costs will inevitably be incurred in setting up and operating an OGP system, part of which will ultimately be passed onto users based on the Government’s “user pays” principle in setting fees. This could reduce the attractiveness of OGP vis-à-vis the existing “re-registration” system, and hence the number of OGP applications may turn out to be rather modest initially.

2. Nonetheless, from the long-term perspective, the establishment of an OGP system and the proposed refinements to the short-term patent system could enhance our IP protection infrastructure and are important building blocks for the future development of Hong Kong’s IP regime. These will also demonstrate our commitment to maintaining a patent system on par with the advanced economies to the effect of attracting international IP trading and management activities to Hong Kong, thereby helping Hong Kong build a firmer foothold as an innovation and IP trading hub over the longer term.

3. Regarding the interim measure for regulating local patent practitioners, this could help prevent misuses of titles which may confuse service users, and pave the way for the future full-fledged regulatory regime which will further ensure the high standard and quality of service provided by local patent practitioners. Although the operation costs of agents for hiring qualified persons under a full-fledged regulatory regime may increase, and this may in turn translate into higher fees for service users in the short run, there would also be benefits in terms of the increasing availability of high service quality and the reduction of unregulated practitioners in the longer term.

### **Financial and Staffing Implications**

4. The implementation of a new patent system carries financial and staffing implications. At present, a supernumerary post of Assistant Director of Intellectual Property (ADIP) (DL2) created in IPD in 2014-15 (for a period of three years), underpinned by a dedicated team (comprising six permanent and two three-year time limited non-directorate posts), is taking forward the

preparation work for establishing the new patent system, and dealing with legal issues relating to the incremental establishment of a full-fledged regulatory regime for patent practitioners.

5. The full implementation of the new patent system is expected to take considerable years. At the initial stage, IPD considers that it will likely require additional manpower resources to process applications under the new OGP and the refined short-term patent system<sup>1</sup>. In addition, IPD will need to set up a new module in its IT system for administering and operating the new patent system, at an estimated capital cost of around \$7 million. In the medium and long term, IPD will have to develop its own in-house capability in conducting substantive examination independently<sup>2</sup>, and to deal with other ongoing matters, including developing in incremental stages a full-fledge regulatory regime for patent professionals, and building cooperative network with other patent offices to facilitate patent applications and examination.

6. IPD is assessing the financial and manpower resources required in detail. CEDB/IPD will endeavor to absorb the requirements as far as practicable and may seek any additional resources required through the established mechanism if necessary. In line with the “user pays” principle, full cost of providing the services would be recovered from the fees received by the Registry.

## **Sustainability Implications**

7. As far as sustainability implications are concerned, the proposal helps enhance patent protection in the long run. This would to some extent contribute to the vibrancy of Hong Kong’s economy by facilitating the development of technology and innovation industries, and Hong Kong as an IP trading hub in the region.

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<sup>1</sup> Although initially SIPO will provide technical assistance to IPD to conduct substantive examination, the statutory obligations for the grant and review of patents under the Ordinance rest on the Registrar, and hearings will be conducted by IPD officers.

<sup>2</sup> The preliminarily assessment is that the new patent system calls for setting up at the Registry examination units comprising examiners with advanced science background. We note that other patent offices such as Singapore also have similar setup.