

L.N. 90 of 2025

Patents (General) (Amendment) Rules 2025

Contents

Section	Page
1. Commencement	B3417
2. Patents (General) Rules amended	B3417
3. Section 2 amended (interpretation).....	B3417
4. Section 3 amended (references to the Registrar under section 13(1)(a) or (b) of the Ordinance).....	B3417
5. Sections 12 and 13 substituted.....	B3419
12. Size and presentation of documents	B3419
13. Form of statements, counter-statements and evidence.....	B3421
6. Section 18 amended (request to record divisional designated patent application under section 22 of the Ordinance)	B3423
7. Section 19 amended (request for registration of designated patent and grant of patent under section 23(1) of the Ordinance)	B3423
8. Section 22 amended (issue of receipt by Registrar)	B3423
9. Section 31F amended (reference).....	B3425

Section	Page
10. Section 31M amended (standard patent (O) application under section 37L of Ordinance).....	B3425
11. Section 31N amended (description)	B3427
12. Section 31O amended (drawings referred to in description)	B3429
13. Section 31P amended (abstract).....	B3431
14. Section 31Q amended (size and presentation of documents).....	B3431
15. Section 31R amended (form of statements, counter-statements and evidence).....	B3433
16. Section 31S amended (claims).....	B3435
17. Section 31V amended (notice after examination of minimum requirement under section 37M of Ordinance)	B3437
18. Section 31W amended (requirements for making reference to earlier specified application referred to in section 37M(3)(c)(ii) of Ordinance)	B3437
19. Section 31X amended (filing for purposes of section 37N of Ordinance)	B3439
20. Section 31ZA amended (observations by third parties)	B3439
21. Section 31ZB amended (interpretation)	B3439
22. Section 31ZC amended (request for substantive examination)	B3439
23. Section 31ZI amended (request to review).....	B3441

Section	Page
24. Section 31ZK amended (response to review opinion).....	B3441
25. Section 31ZM amended (response to further review opinion)	B3441
26. Section 31ZN amended (final refusal notice).....	B3441
27. Section 31ZP amended (grant and publication of standard patent (O))	B3443
28. Section 31ZS amended (divisional standard patent (O) application under section 37Z of Ordinance)	B3443
29. Section 31ZT amended (request to amend standard patent (O) application before grant under section 37ZA(1) of Ordinance).....	B3445
30. Section 35 amended (amendment of standard patent (R) under section 43 of the Ordinance)	B3445
31. Section 37 amended (revocation of standard patent (R) under section 44 of the Ordinance)	B3445
32. Section 37A added.....	B3445
37A. References to court under section 44(5) of Ordinance.....	B3447
33. Section 38A amended (application to amend specification after grant).....	B3449
34. Section 38F amended (publication of amendment under section 46(3)(a) or (7)(a) of Ordinance).....	B3449
35. Section 40 amended (surrender of patents)	B3451

Section	Page
36.	Section 40A added.....B3451
40A.	References to court under section 48(4) of Ordinance.....B3451
37.	Section 41 substituted.....B3453
41.	References to Registrar under section 49(1) of Ordinance.....B3455
38.	Sections 41AA to 41AAI addedB3457
41AA.	Notice of intention to oppose by person other than proprietor of patentB3457
41AAB.	Notice of opposition by person other than proprietor of patentB3459
41AAC.	Notice of opposition by proprietor of patentB3465
41AAD.	Evidence in support of referenceB3467
41AAE.	Evidence in support of opposition.....B3469
41AAF.	Additional evidence in reply to oppositionB3471
41AAG.	Filing of evidence that requires leave of Registrar.....B3473
41AAH.	Directions by RegistrarB3475
41AAI.	References to court under section 49(2)(b) of Ordinance.....B3475
39.	Section 42A amended (failure to file address for service)B3477
40.	Section 44 amended (entries relating to section 13(1) or 37H(1) of the Ordinance)B3477

Section	Page
41. Section 47 amended (request for correction of error in the register or in any document filed in connection with registration).....	B3479
42. Section 48 amended (correction of errors in patents and applications under section 146 of the Ordinance).....	B3479
43. Section 50 amended (inspection of register)	B3479
44. Section 51 amended (certificates and copies supplied by Registrar)	B3481
45. Section 52 substituted	B3481
52. Filing of court orders, declarations, directions or certificates	B3481
46. Section 56B amended (language requirements for sections 37E(1), 37M(3)(c)(ii), 111(1) and 114(3)(c)(ii) of Ordinance)	B3483
47. Section 57 amended (filing of corrected translation under section 106(3) of the Ordinance)	B3483
48. Section 58 amended (applications for the grant of short-term patents under section 113 of the Ordinance).....	B3485
49. Section 59 amended (description)	B3487
50. Sections 60 to 64 substituted	B3489
60. Drawings referred to in description or claim	B3489
61. Abstract	B3497
62. Size and presentation of documents	B3499

Section	Page
63. Form of statements, counter-statements and evidence.....	B3505
64. Claims	B3505
51. Section 67 amended (notice after examination of minimum requirement under section 114 of Ordinance)	B3509
52. Section 67A amended (requirements for making reference to earlier specified application referred to in section 114(3)(c)(ii) of Ordinance).....	B3511
53. Section 67B amended (filing for purposes of section 114A of Ordinance).....	B3511
54. Section 72 amended (contents of the search report).....	B3511
55. Section 74 amended (divisional short-term patent application under section 116 of the Ordinance).....	B3513
56. Section 75 amended (request to amend short-term patent application before grant under section 120(1) of Ordinance)	B3513
57. Section 79A amended (observations by third parties).....	B3513
58. Section 81 amended (restoration of lapsed short-term patents under section 127 of the Ordinance)	B3515
59. Section 81A amended (interpretation)	B3515
60. Section 81B amended (request for substantive examination)	B3515
61. Section 81I amended (request to review)	B3515

Section	Page
62. Section 81K amended (response to review opinion)	B3517
63. Section 81M amended (response to further review opinion)	B3517
64. Section 81N amended (final revocation notice)	B3517
65. Section 81P amended (request to amend specification of short-term patent after grant under section 127B(1)(b) or 127D(3)(b) of Ordinance).....	B3517
66. Section 81TA added.....	B3519
81TA. Order by court under section 127E(3) of Ordinance.....	B3519
67. Section 81U amended (publication of amendment under section 127E(2)(a) or (4)(a) of Ordinance)	B3521
68. Section 81V amended (Registrar to follow procedure in Part 9, Division 5 of these Rules)	B3521
69. Section 81W added	B3523
81W. References to court of opposition proceedings under section 127E(3) of Ordinance	B3523
70. Section 85 amended (agents).....	B3525
71. Section 87A added	B3529
87A. Taxation of costs.....	B3529
72. Section 88 amended (request for information under section 147 of the Ordinance).....	B3529

Section	Page
73.	Section 89 amended (restriction on inspection of documents under section 147 of the Ordinance)B3529
74.	Section 91 amended (bibliographic information for purposes of section 147(3) of the Ordinance).....B3531
75.	Section 91A added.....B3531
91A.	Registrar may communicate to others bibliographic information about unpublished patent applications under section 147(3) of Ordinance.....B3531
76.	Part 13, Division 1A addedB3535
Division 1A—References to Court by Registrar under Section 133(1)(b) of Ordinance	
92A.	References to court under section 133(1)(b) of Ordinance of questions referred to Registrar under section 13(1), 14(5), 37H(1) or 37K(7) of Ordinance.....B3535
92B.	References to court under section 133(1)(b) of Ordinance of applications to amend specification after grant under section 46(2)(b) or (c) of OrdinanceB3539
77.	Section 93A amended (electronic filing).....B3543
78.	Section 93B amended (terms for electronic filing)B3543
79.	Section 93D amended (service of documents)B3543
80.	Section 94 amended (correction of irregularities).....B3543

Section	Page
81. Section 97 amended (statutory declarations and affidavits)	B3545
82. Section 100AA amended (extension of time—general provision)	B3545
83. Section 100AAB amended (grant of extended period on request)	B3545
84. Part 13, Division 8 heading amended (fees).....	B3545
85. Section 104 amended (fees).....	B3547
86. Section 104A added	B3549
104A. Stay of proceedings	B3549
87. Section 115 added	B3549
115. Transitional provisions relating to Patents (General) (Amendment) Rules 2025.....	B3549
88. Schedule 1 amended (micro-organisms).....	B3551
89. Schedule 2 amended (fees)	B3551
90. “Ordinance” substituted for “the Ordinance”	B3555

Patents (General) (Amendment) Rules 2025

(Made by the Registrar of Patents under section 149 of the Patents Ordinance (Cap. 514))

1. Commencement

These Rules come into operation on 1 October 2025.

2. Patents (General) Rules amended

The Patents (General) Rules (Cap. 514 sub. leg. C) are amended as set out in sections 3 to 90.

3. Section 2 amended (interpretation)

Section 2(2)(b), after “93C”—

Add

“of these Rules”.

4. Section 3 amended (references to the Registrar under section 13(1)(a) or (b) of the Ordinance)

(1) Section 3, English text, heading—

Repeal

“the Registrar under section 13(1)(a) or (b) of the”

Substitute

“Registrar under section 13(1)(a) or (b) of”.

(2) Section 3(5), Chinese text—

Repeal

“的轉錄標準專利的申請是根據本條例第 13(1)(a) 或 (b) 條作出的轉介的標的並已提交，但在提交該項轉介之前”

Substitute

“屬根據本條例第 13(1)(a) 或 (b) 條作出的轉介的標的，而已有人就該項發明提交轉錄標準專利的申請，但在該項轉介提交之前，”。

(3) Section 3(5)(b)—

Repeal

everything after “who has”

Substitute

“a right in or under the patent application as shown in an application to register, or a notice, that is mentioned in section 46(1) of these Rules.”.

5. Sections 12 and 13 substituted

Sections 12 and 13—

Repeal the sections

Substitute

“12. Size and presentation of documents

- (1) This section applies to the documents comprising a request to record to be filed under section 15(2) of the Ordinance.
- (2) Each of the documents must be presented in a manner that it may be—
 - (a) reproduced in an unlimited number of copies by photography, photocopying processes, photo offset and microfilming; and
 - (b) scanned by a device capable of capturing an image of the document and converting the image into a form suitable for storage on, and retrieval by, a computer.
- (3) Each of the documents must—

Section 5

- (a) be free from cracks, creases and folds;
- (b) be single-sided;
- (c) be on A4 papers (29.7 cm × 21 cm) that are pliable, strong, white, smooth, matt and durable;
- (d) not share a sheet with another document; and
- (e) if the document has more than one sheet, comprise sheets that are—
 - (i) connected in a way that the sheets can easily be turned over, separated and combined again; and
 - (ii) numbered in consecutive Arabic numerals.
- (4) All documents must be—
 - (a) legible; and
 - (b) reasonably free from deletions and other alterations, overwritings and interlineations.
- (5) The Registrar may exempt a document from any requirement under this section if—
 - (a) the authenticity of the content of the document is not in question and the requirements for good reproduction are not in jeopardy; or
 - (b) the Registrar considers that there are other circumstances that justify the exemption.

13. Form of statements, counter-statements and evidence

Subject to the Registrar's direction, any statement, counter-statement or evidence to be filed with the Registrar must comply with the requirements under section 12(2) and (3)(c) of these Rules as if those requirements applied to the statement, counter-statement or evidence.”.

Section 6

6. Section 18 amended (request to record divisional designated patent application under section 22 of the Ordinance)

(1) Section 18, English text, heading—

Repeal

“the”.

(2) Section 18(3), after “17”—

Add

“of these Rules”.

7. Section 19 amended (request for registration of designated patent and grant of patent under section 23(1) of the Ordinance)

(1) Section 19, English text, heading—

Repeal

“the”.

(2) Section 19(2)(b)—

Repeal

“paragraph (b) of that subsection”

Substitute

“section 23(3)(b) of the Ordinance”.

(3) Section 19(3), after “12”—

Add

“of these Rules”.

8. Section 22 amended (issue of receipt by Registrar)

Section 22(b), after “14(b)”—

Add

“of these Rules”.

Section 9

9. Section 31F amended (reference)

Section 31F(5)(c)(ii), English text—

Repeal

“shown on”

Substitute

“shown in”.

10. Section 31M amended (standard patent (O) application under section 37L of Ordinance)

(1) Section 31M(4)(f)—

Repeal

“; and”

Substitute a semicolon.

(2) Section 31M(4)—

Repeal paragraph (g)

Substitute

“(g) for the purposes of a reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance—the documents required under section 31W(3) of these Rules and the documents required by application of section 31W(5) of these Rules, as the case requires; and

(h) in the case of a new application for a patent made in compliance with an order under section 55(4) of the Ordinance—the number of the patent that has been conditionally or unconditionally revoked by the court.”.

Section 11

11. Section 31N amended (description)

(1) Section 31N(2)—

Repeal

“must”.

(2) Section 31N(2)(a)—

Repeal

“specify”

Substitute

“must specify”.

(3) Section 31N(2)—

Repeal paragraph (b)

Substitute

“(b) must indicate the background art that, as far as known to the applicant, can be regarded as useful for understanding the invention and may cite the documents reflecting the background art;”.

(4) Section 31N(2)—

Repeal paragraph (c).

(5) Section 31N(2)(d)—

Repeal

“disclose”

Substitute

“must disclose”.

(6) Section 31N(2)(e)—

Repeal

“state”

Substitute

Section 12

“must state”.

- (7) Section 31N(2)—

Repeal paragraph (f)

Substitute

“(f) must briefly describe the figures in the drawings, if any, referred to in—

- (i) the description; or
- (ii) the claim or claims contained in the specification of the application;”.

- (8) Section 31N(2)(g)—

Repeal

“describe”

Substitute

“must describe”.

- (9) Section 31N(2)(h)—

Repeal

“indicate”

Substitute

“must indicate”.

12. Section 31O amended (drawings referred to in description)

- (1) Section 31O, heading, after “**description**”—

Add

“**or claim**”.

- (2) Section 31O(1), after “description”—

Add

“or the claim or claims”.

Section 13

- (3) Section 31O(2)(a)(i), English text—

Repeal

“an usable”

Substitute

“a usable”.

- (4) Section 31O(2)(b)(xvii)—

Repeal

“31Q(3)(d)(ii)”

Substitute

“31Q(3)(e)(ii)”.

13. Section 31P amended (abstract)

- (1) Section 31P(2)—

Repeal paragraph (a).

- (2) Section 31P(4)(b), English text—

Repeal

“characterizes”

Substitute

“characterize”.

14. Section 31Q amended (size and presentation of documents)

- (1) Section 31Q(2)(a), English text—

Repeal

“micro-filming”

Substitute

“microfilming”.

- (2) Section 31Q(3)(c)—

Section 15

Repeal

“; and”

Substitute a semicolon.

- (3) Section 31Q(3)(d)—

Repeal

everything after “another document”

Substitute

“; and”.

- (4) After section 31Q(3)(d)—

Add

“(e) if the document has more than one sheet, comprise sheets that are—

- (i) connected in a way that the sheets can easily be turned over, separated and combined again; and
- (ii) numbered in consecutive Arabic numerals.”.

- (5) Section 31Q(13), English text—

Repeal

“any document”

Substitute

“a document”.

15. Section 31R amended (form of statements, counter-statements and evidence)

Section 31R, after “Rules”—

Add

“as if those requirements applied to the statement, counter-statement or evidence”.

16. Section 31S amended (claims)

(1) Section 31S(3)—

Repeal paragraph (a)

Substitute

“(a) a statement indicating—

- (i) the designation of the subject matter of the invention; and
- (ii) the technical features that are necessary for the definition of the claimed subject matter and, in combination, are part of the prior art; and”.

(2) Section 31S(3)(b)—

Repeal

“paragraph (a)”

Substitute

“paragraph (a)(ii)”.

(3) Section 31S(3)(b), Chinese text—

Repeal

“冠以“characterized in that”或“characterized by”的詞句或(如屬適當)相等意思的中文字或詞句，以描述特徵的部分”

Substitute

“描述特徵的部分(冠以“characterized in that”或“characterized by”的詞句或(如屬適當)相等意思的中文字或詞句)”.

(4) Section 31S(3)(b), Chinese text—

Repeal

“欲獲得該項權利要求”

Substitute

Section 17

“由該項權利要求尋求”.

- (5) Section 31S(5)(b), Chinese text—

Repeal

“欲”

Substitute

“尋求”.

- (6) Section 31S(10)—

Repeal

“must preferably”

Substitute

“may”.

- 17. Section 31V amended (notice after examination of minimum requirement under section 37M of Ordinance)**

Section 31V(1) and (3)—

Repeal

“the date”

Substitute

“the earliest date”.

- 18. Section 31W amended (requirements for making reference to earlier specified application referred to in section 37M(3)(c)(ii) of Ordinance)**

Section 31W(3)—

Repeal

“the date”

Substitute

“the earliest date”.

19. Section 31X amended (filing for purposes of section 37N of Ordinance)

Section 31X(2)(a)—

Repeal

“the date”

Substitute

“the earliest date”.

20. Section 31ZA amended (observations by third parties)

Section 31ZA(2)(b)—

Repeal subparagraph (ii)

Substitute

“(ii) the date on which the Registrar gives a notice in relation to the standard patent (O) application under section 31ZI(5), 31ZK(4), 31ZM(4) or 31ZN(2) of these Rules;”.

21. Section 31ZB amended (interpretation)

Section 31ZB—

Repeal the definition of *final refusal notice*.

22. Section 31ZC amended (request for substantive examination)

Section 31ZC(5)—

Repeal the definition of *fulfilment date*

Substitute

“***fulfilment date*** (符合日期) means the date—

- (a) that is the earliest date on which the minimum requirement under section 37M(3) of the Ordinance is complied with; and

- (b) that is the date as notified to the applicant by a notice under section 31V(1) or (3) of these Rules;”.

23. Section 31ZI amended (request to review)

Section 31ZI(5)—

Repeal paragraph (b)

Substitute

- “(b) by notice given to the applicant, notify the applicant of the decision.”.

24. Section 31ZK amended (response to review opinion)

Section 31ZK(4)—

Repeal paragraph (b)

Substitute

- “(b) by notice given to the applicant, notify the applicant of the decision.”.

25. Section 31ZM amended (response to further review opinion)

Section 31ZM(4)—

Repeal paragraph (b)

Substitute

- “(b) by notice given to the applicant, notify the applicant of the decision.”.

26. Section 31ZN amended (final refusal notice)

- (1) Section 31ZN, heading—

Repeal

“refusal notice”

Section 27

Substitute

“**decision of refusal**”.

(2) Section 31ZN(2)—

Repeal

“(final refusal notice)”.

27. Section 31ZP amended (grant and publication of standard patent (O))

Section 31ZP(1)—

Repeal

“granting a standard patent (O)”

Substitute

“being satisfied that a standard patent (O) can be granted”.

28. Section 31ZS amended (divisional standard patent (O) application under section 37Z of Ordinance)

(1) Section 31ZS(2)—

Repeal

“final refusal notice under section”

Substitute

“notice under section 31ZI(5), 31ZK(4), 31ZM(4) or”.

(2) Section 31ZS(4)—

Repeal

“the date”

Substitute

“the earliest date”.

Section 29

29. Section 31ZT amended (request to amend standard patent (O) application before grant under section 37ZA(1) of Ordinance)

Section 31ZT(5)—

Repeal

“31Q(1)”

Substitute

“31Q(2)”.

30. Section 35 amended (amendment of standard patent (R) under section 43 of the Ordinance)

(1) Section 35, English text, heading—

Repeal

“the”.

(2) Section 35(3)(b), after “section 12”—

Add

“of these Rules”.

31. Section 37 amended (revocation of standard patent (R) under section 44 of the Ordinance)

(1) Section 37, English text, heading—

Repeal

“the”.

(2) Section 37(1) and (2)(b), after “section 56”—

Add

“of these Rules”.

32. Section 37A added

Part 4, Division 1, after section 37—

Add

“37A. References to court under section 44(5) of Ordinance

- (1) This section applies if the Registrar decides to refer an application to the court for determination under section 44(5) of the Ordinance (*reference to court*).
- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the application known to the Registrar at the time of making the decision; and
 - (b) the Registrar of the High Court.
- (3) If the person who made the application (*applicant*) wishes to commence proceedings before the court in relation to the application, the applicant must commence the proceedings within 1 month after the date of the written notice given under subsection (2).
- (4) If the applicant fails to commence proceedings in relation to the application under subsection (3), the applicant is to be treated as having abandoned the application.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the application are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the application with the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to court; and

Section 33

(b) advertise the fact of the reference to court by notice in the official journal.

(7) Section 37(5) and (6) of these Rules does not apply after the Registrar has given written notice under subsection (2).”.

33. Section 38A amended (application to amend specification after grant)

(1) Section 38A(3)(a)—

Repeal

“31Q(1)”

Substitute

“31Q(2)”.

(2) Section 38A(3)(b)—

Repeal

“62(1) to (13)”

Substitute

“62(2) to (12)”.

34. Section 38F amended (publication of amendment under section 46(3)(a) or (7)(a) of Ordinance)

(1) Section 38F(3)(a)—

Repeal

“31Q(1)”

Substitute

“31Q(2)”.

(2) Section 38F(3)(b)—

Repeal

Section 35

“62(1) to (13)”

Substitute

“62(2) to (12)”.

35. Section 40 amended (surrender of patents)

After section 40(1)—

Add

“(1A) The proprietor of the patent who files the notice mentioned in subsection (1) must, at the same time as the notice is filed, send a copy of the notice to every other person who is shown in the register as having a right in or under the patent.”.

36. Section 40A added

After section 40—

Add

“40A. References to court under section 48(4) of Ordinance

- (1) This section applies if the Registrar decides to refer a matter to the court for determination under section 48(4) of the Ordinance (*reference to court*).
- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the matter known to the Registrar at the time of making the decision; and
 - (b) the Registrar of the High Court.

Section 37

- (3) If the proprietor of the patent wishes to commence proceedings before the court in relation to the matter, the proprietor must commence the proceedings within 1 month after the date of the written notice given under subsection (2).
- (4) If the proprietor of the patent fails to commence proceedings in relation to the matter under subsection (3), the proprietor is to be treated as having abandoned the offer to surrender the patent.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the matter are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the matter with the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to court; and
 - (b) advertise the fact of the reference to court by notice in the official journal.
- (7) Section 40(2), (3) and (4) of these Rules does not apply after the Registrar has given written notice under subsection (2).”.

37. Section 41 substituted

Section 41—

Repeal the section

Substitute

“41. References to Registrar under section 49(1) of Ordinance

- (1) A reference to the Registrar under section 49(1) of the Ordinance of the question mentioned in that section (which is, whether, having regard to any of the matters specified in section 9A(5) of the Ordinance, an invention is a patentable invention) must be made by filing in accordance with this section an application in the specified form (*reference application*).
- (2) The reference application must be filed with the Registrar and accompanied by—
 - (a) a statement setting out—
 - (i) the question on which the applicant intends to seek the determination of the Registrar;
 - (ii) the determination and order that the applicant intends to seek in relation to the question; and
 - (iii) the full particulars of the grounds and facts on which the applicant relies; and
 - (b) the prescribed fee.
- (3) The applicant must—
 - (a) at the same time as the reference application is filed with the Registrar, send a copy of the reference application and of the accompanying statement to the proprietor of the patent; and
 - (b) within 3 days after the date of filing the reference application, notify the Registrar in writing that the applicant has complied with the requirements of paragraph (a).

- (4) The reference application is to be treated as not having been filed in accordance with this section if the applicant fails to comply with subsection (3).
- (5) The Registrar must, as soon as practicable after the applicant has complied with subsection (3)—
 - (a) enter in the register a notice of the reference application; and
 - (b) advertise the fact of the filing of the reference application by notice in the official journal.”.

38. Sections 41AA to 41AAI added

After section 41—

Add

“41AA. Notice of intention to oppose by person other than proprietor of patent

- (1) If a reference is made by an application filed in accordance with section 41 of these Rules (*reference application*), any person (other than the proprietor of the patent) who intends to oppose the reference under section 49(4) of the Ordinance may file in accordance with this section a notice indicating the person’s intention to oppose the reference in the specified form (*notice of intention to oppose*).
- (2) The notice of intention to oppose must be filed with the Registrar within 28 days after the date on which the filing of the reference application is advertised in the official journal under section 41(5) of these Rules (*filing period*).
- (3) A person who files with the Registrar a notice of intention to oppose (*intending opponent*) must—

Section 38

- (a) at the same time as the notice is filed, send a copy of the notice to—
 - (i) the person who filed the reference application (***applicant***); and
 - (ii) the proprietor of the patent; and
 - (b) within 3 days after the date of filing the notice, notify the Registrar in writing that the intending opponent has complied with the requirements of paragraph (a).
- (4) The notice of intention to oppose is to be treated as not having been filed in accordance with this section if the intending opponent fails to comply with subsection (3).
- (5) On receiving a copy of a notice of intention to oppose sent by an intending opponent under subsection (3)(a)(i), the applicant must, within 14 days after the expiry of the filing period—
 - (a) send a copy of the reference application and of the accompanying statement filed under section 41 of these Rules to the intending opponent; and
 - (b) notify the Registrar in writing that the applicant has complied with the requirements of paragraph (a).
- (6) The applicant is to be treated as having abandoned the reference if the applicant fails to comply with subsection (5).

41AAB. Notice of opposition by person other than proprietor of patent

- (1) If—

- (a) a reference is made by an application filed in accordance with section 41 of these Rules (*reference application*);
- (b) a person (*intending opponent*) has filed a notice of intention to oppose in accordance with section 41AA of these Rules; and
- (c) a copy of the reference application and of the accompanying statement has been sent to the intending opponent under section 41AA(5) of these Rules,

the intending opponent may, within 2 months after the expiry of the 14-day period specified in section 41AA(5) of these Rules, oppose the reference under section 49(4) of the Ordinance by filing with the Registrar a notice of opposition in the specified form.

(2) The notice of opposition must—

- (a) set out—
 - (i) the grounds on which the intending opponent relies in support of the opposition;
 - (ii) the facts alleged in the reference application that the intending opponent admits, denies or is unable to admit or deny; and
 - (iii) if the intending opponent denies a fact alleged in the reference application, the reasons for the denial; and
- (b) be accompanied by the prescribed fee.

(3) The intending opponent must—

- (a) at the same time as the notice of opposition is filed with the Registrar, send a copy of the notice to—
 - (i) the person who filed the reference application (***applicant***); and
 - (ii) the proprietor of the patent; and
 - (b) within 3 days after the date of filing the notice of opposition, notify the Registrar in writing that the intending opponent has complied with the requirements of paragraph (a).
- (4) The intending opponent is to be treated as having abandoned the intention to oppose the reference if the intending opponent—
 - (a) does not file a notice of opposition under subsection (1); or
 - (b) fails to comply with subsection (3).
- (5) If the applicant receives from more than one intending opponent a copy of the notice of opposition sent under subsection (3) (***received copy***), the applicant must, within 3 days after the expiry of the 2-month period specified in subsection (1)—
 - (a) send a copy of the received copy that the applicant received from each intending opponent to the other intending opponents; and
 - (b) notify the Registrar in writing that the applicant has complied with the requirements of paragraph (a).
- (6) The applicant is to be treated as having abandoned the reference if the applicant fails to comply with subsection (5).

41AAC. Notice of opposition by proprietor of patent

- (1) If a reference is made by an application filed in accordance with section 41 of these Rules (*reference application*), the proprietor of the patent may oppose the reference under section 49(4) of the Ordinance by filing with the Registrar a notice of opposition in the specified form—
 - (a) if a notice of intention to oppose is filed in accordance with section 41AA of these Rules in respect of the reference—within 2 months after the expiry of the 14-day period specified in section 41AA(5) of these Rules; or
 - (b) if no notice of intention to oppose is filed in accordance with section 41AA of these Rules in respect of the reference within the 28-day period specified in section 41AA(2) of these Rules—within 2 months after the expiry of that period.
- (2) The notice of opposition must—
 - (a) set out—
 - (i) the grounds on which the proprietor of the patent relies in support of the opposition;
 - (ii) the facts alleged in the reference application that the proprietor admits, denies or is unable to admit or deny; and
 - (iii) if the proprietor denies a fact alleged in the reference application, the reasons for the denial; and
 - (b) be accompanied by the prescribed fee.
- (3) The proprietor of the patent must—

- (a) at the same time as the notice of opposition is filed with the Registrar, send a copy of the notice to—
 - (i) the person who filed the reference application; and
 - (ii) if a notice of intention to oppose is filed in accordance with section 41AA of these Rules in respect of the reference, the person who filed the notice of intention to oppose; and
 - (b) within 3 days after the date of filing the notice of opposition, notify the Registrar in writing that the proprietor has complied with the requirements of paragraph (a).
- (4) The reference is to be treated as unopposed by the proprietor of the patent if the proprietor—
 - (a) does not file a notice of opposition under subsection (1); or
 - (b) fails to comply with subsection (3).

41AAD. Evidence in support of reference

- (1) A person who makes a reference by an application filed in accordance with section 41 of these Rules (*applicant*) must file evidence in support of the reference with the Registrar within 3 months after the expiry of the 2-month period specified in section 41AAB(1) or 41AAC(1)(a) or (b) of these Rules, whichever is applicable.
- (2) The applicant must—
 - (a) at the same time as the evidence is filed under subsection (1), send a copy of the evidence to—

- (i) the proprietor of the patent; and
 - (ii) if a notice of opposition is filed under section 41AAB(1) of these Rules in respect of the reference, the person who filed the notice; and
- (b) within 3 days after the date of filing the evidence, notify the Registrar in writing that the applicant has complied with the requirements of paragraph (a).
- (3) The applicant is to be treated as having abandoned the reference if the applicant fails to comply with subsection (1) or (2).

41AAE. Evidence in support of opposition

- (1) This section applies if—
 - (a) a notice of opposition is filed by a person (*opponent*) under section 41AAB(1) or 41AAC(1) of these Rules in respect of a reference made by an application filed in accordance with section 41 of these Rules (*reference application*); and
 - (b) evidence in support of the reference is filed under section 41AAD(1) of these Rules by the person who filed the reference application (*applicant*).
- (2) The opponent may, within 3 months after the date of the applicant's filing of evidence under section 41AAD(1) of these Rules, file with the Registrar—
 - (a) evidence in support of the opposition; or
 - (b) a statement to the effect that the opponent does not intend to file evidence.

- (3) The opponent must—
 - (a) at the same time as the evidence or statement is filed under subsection (2), send a copy of the evidence or statement to—
 - (i) the applicant;
 - (ii) any other person who has filed a notice of opposition under section 41AAB(1) of these Rules in respect of the reference; and
 - (iii) if the opponent is not the proprietor of the patent, the proprietor of the patent; and
 - (b) within 3 days after the date of filing the evidence or statement, notify the Registrar in writing that the opponent has complied with the requirements of paragraph (a).
- (4) The evidence or statement is to be treated as not having been filed under subsection (2) if the opponent fails to comply with subsection (3).

41AAF. Additional evidence in reply to opposition

- (1) This section applies if evidence is filed by an opponent under section 41AAE(2) of these Rules in support of the opponent's opposition to a reference made by an application filed in accordance with section 41 of these Rules (*reference application*).
- (2) The person who filed the reference application (*applicant*) may, within 3 months after the expiry of the 3-month period specified in section 41AAE(2) of these Rules, file with the Registrar—
 - (a) additional evidence in support of the reference; or

- (b) a statement to the effect that the applicant does not intend to file additional evidence.
 - (3) The additional evidence filed under subsection (2) must be confined to matters strictly in reply to the evidence filed under section 41AAE(2) of these Rules.
 - (4) The applicant must—
 - (a) at the same time as the additional evidence or statement is filed under subsection (2), send a copy of the additional evidence or statement to—
 - (i) the proprietor of the patent; and
 - (ii) if a notice of opposition is filed under section 41AAB(1) of these Rules in respect of the reference, the person who filed the notice; and
 - (b) within 3 days after the date of filing the additional evidence or statement, notify the Registrar in writing that the applicant has complied with the requirements of paragraph (a).
 - (5) The additional evidence or statement is to be treated as not having been filed under subsection (2) if the applicant fails to comply with subsection (4).

41AAG. Filing of evidence that requires leave of Registrar

Except as provided in section 41AAD, 41AAE or 41AAF of these Rules, no evidence or further evidence may be filed by a party to the proceedings without the leave of the Registrar.

41AAH. Directions by Registrar

In the proceedings concerning a reference application mentioned in section 41(1) of these Rules, the Registrar may, either on the initiative of the Registrar or on request of a party to the proceedings, give any directions that the Registrar considers appropriate to regulate any part of the procedure including the subsequent procedure to be followed.

41AAI. References to court under section 49(2)(b) of Ordinance

- (1) This section applies if—
 - (a) a person (*applicant*) has filed a reference application in accordance with section 41 of these Rules seeking the Registrar's determination on a question mentioned in that section (*original reference*); and
 - (b) the Registrar decides to refer the question to the court for determination under section 49(2)(b) of the Ordinance (*reference to court*).
- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the original reference known to the Registrar at the time of making the decision; and
 - (b) the Registrar of the High Court.
- (3) If the applicant wishes to commence proceedings before the court in relation to the original reference, the applicant must commence the proceedings within 1 month after the date of the written notice given under subsection (2).

- (4) If the applicant fails to commence proceedings in relation to the original reference under subsection (3), the applicant is to be treated as having abandoned the original reference.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the original reference are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the original reference with the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to court; and
 - (b) advertise the fact of the reference to court by notice in the official journal.
- (7) Sections 41AA, 41AAB, 41AAC, 41AAD, 41AAE and 41AAF of these Rules do not apply after the Registrar has given written notice under subsection (2).”.

39. Section 42A amended (failure to file address for service)

Section 42A(1), after “section 42”—

Add

“of these Rules”.

40. Section 44 amended (entries relating to section 13(1) or 37H(1) of the Ordinance)

- (1) Section 44, English text, heading—

Repeal

“the”.

Section 41

- (2) Section 44, after “section 43(1)”—

Add

“of these Rules”.

41. Section 47 amended (request for correction of error in the register or in any document filed in connection with registration)

- (1) Section 47, English text, heading—

Repeal

“the”.

- (2) Section 47(1), after “section 45(3)”—

Add

“of these Rules”.

42. Section 48 amended (correction of errors in patents and applications under section 146 of the Ordinance)

- (1) Section 48, English text, heading—

Repeal

“the”.

- (2) Section 48(1), after “section 45(3)”—

Add

“of these Rules”.

43. Section 50 amended (inspection of register)

- Section 50(2), after “section 51”—

Add

“of these Rules”.

44. Section 51 amended (certificates and copies supplied by Registrar)

(1) Section 51(3), after “section 89(1)” (wherever appearing)—
Add

“of these Rules”.

(2) Section 51(3), after “section 89(2)” —
Add

“of these Rules”.

45. Section 52 substituted

Section 52—

Repeal the section

Substitute

“52. Filing of court orders, declarations, directions or certificates

(1) If the court has made an order, declaration or direction, or has granted a certificate, under the Ordinance (except under section 46 or 102 of the Ordinance) in favour of a person, the person or, if there is more than one such person, the person directed by the court, must file a sealed copy of the order, declaration, direction or certificate with the Registrar.

(2) If the court makes any order under section 46 or 102 of the Ordinance in favour of a person, the person or, if there is more than one such person, the person directed by the court, must file with the Registrar—

(a) a copy of any documents referred to in the order that show the amendments to be made; and

Section 46

(b) the translations of those documents as may be required under section 56 of these Rules.

(3) The documents and translations referred to in subsection (2) must be filed at the time when a copy of the order is filed with the Registrar in accordance with a provision of the order under section 46 or 102 of the Ordinance or a direction made by the court or rules of court.”.

46. Section 56B amended (language requirements for sections 37E(1), 37M(3)(c)(ii), 111(1) and 114(3)(c)(ii) of Ordinance)

(1) Section 56B(3)—

Repeal

“the date”

Substitute

“the earliest date”.

(2) Section 56B(3)—

Repeal paragraph (b)

Substitute

“(b) if any description or drawing that is a translation of the description or drawing of the earlier specified application has been filed under section 37L(2)(b)(i) or (iii) or 113(1A)(b)(i) or (iii) of the Ordinance—a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate.”.

47. Section 57 amended (filing of corrected translation under section 106(3) of the Ordinance)

(1) Section 57, English text, heading—

Section 48

Repeal

“the”.

- (2) Section 57(1), after “Section 12”—

Add

“of these Rules”.

48. Section 58 amended (applications for the grant of short-term patents under section 113 of the Ordinance)

- (1) Section 58, English text, heading—

Repeal

“the grant of short-term patents under section 113 of the”

Substitute

“grant of short-term patents under section 113 of”.

- (2) Section 58(5)(a), after “section 72”—

Add

“of these Rules”.

- (3) Section 58(5)(c), after “section 69”—

Add

“of these Rules”.

- (4) Section 58(5)(i)—

Repeal

“; and”

Substitute a semicolon.

- (5) Section 58(5)(j)—

Repeal the full stop

Substitute

“; and”.

(6) After section 58(5)(j)—

Add

“(k) in the case of a new application for a patent made in compliance with an order under section 55(4) of the Ordinance—the number of the patent that has been conditionally or unconditionally revoked by the court.”.

49. Section 59 amended (description)

Section 59—

Repeal subsections (1) and (2)

Substitute

“(1) This section applies to a description referred to in section 113(1A)(b)(i) of the Ordinance of an invention that is the subject of a short-term patent application.

(2) The description—

- (a) must specify the technical field to which the invention relates;
- (b) must indicate the background art that, as far as known to the applicant, can be regarded as useful for understanding the invention and may cite the documents reflecting the background art;
- (c) must disclose the invention in a way that the following can be understood—
 - (i) the technical problem to which the invention relates (even if not so expressly stated); and
 - (ii) the solution to the problem;

- (d) must state any advantageous effects of the invention with reference to the background art;
 - (e) must briefly describe the figures in the drawings, if any, referred to in—
 - (i) the description; or
 - (ii) the claim or claims contained in the specification of the application;
 - (f) must describe in detail at least one way of carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
 - (g) must indicate the way in which the invention is industrially applicable, if it is not obvious from the description or nature of the invention.
- (3) The description must be presented in the manner and order specified in subsection (2) unless not doing so is conducive to a better understanding of the invention because of its nature and a more economical presentation.”.

50. Sections 60 to 64 substituted

Sections 60, 61, 62, 63 and 64—

Repeal the sections

Substitute

“60. Drawings referred to in description or claim

- (1) This section applies to the drawings referred to in the description or the claim or claims under section 113(1A)(b)(iii) of the Ordinance of an invention that is the subject of a short-term patent application.
- (2) The drawings—

-
- (a) must be on sheets each of which—
 - (i) has a usable surface area not exceeding 26.2 cm × 17 cm;
 - (ii) does not contain frames round the usable or used surface; and
 - (iii) has the following minimum margins—
 - (A) from the top—2.5 cm;
 - (B) from the left—2.5 cm;
 - (C) from the right—1.5 cm; and
 - (D) from the bottom—1 cm; and
 - (b) must be executed in the following manner—
 - (i) executed without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
 - (ii) the cross-sections, if any, contained in the drawings must be indicated by hatching that does not impede the clear reading of the reference signs and leading lines;
 - (iii) the scale and distinctness of graphical execution must enable all details of the drawings to be distinguished without difficulty in a photographic reproduction of the drawings with a linear reduction in size to two-thirds of the drawings;
 - (iv) if, as an exception, a scale is given, the scale must be represented graphically;
 - (v) all numbers, letters and reference signs must be simple and clear;

- (vi) brackets, circles and inverted commas must not be used in association with numbers, letters and characters;
- (vii) all lines must ordinarily be drawn with the aid of drafting instruments;
- (viii) elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;
- (ix) the height of the numbers, letters and characters must not be less than 0.32 cm;
- (x) the lettering must be in—
 - (A) Latin alphabets; and
 - (B) if customary—Greek alphabets or Chinese characters, as appropriate;
- (xi) if the same sheet of drawings contains several figures, the figures must be—
 - (A) arranged without wasting space and clearly separated from one another; and
 - (B) numbered consecutively in Arabic numerals, independently of the numbering of the sheets;
- (xii) if the figures drawn on 2 or more sheets are intended to form one whole figure, the figures on the sheets must be so arranged that the whole figure can be assembled without concealing any part of the partial figures;
- (xiii) reference signs not mentioned in the description and claims must not appear;

- (xiv) reference signs not mentioned in the drawings must not appear in the description and claims;
- (xv) the same features, when denoted by reference signs, must be denoted by the same signs throughout the application;
- (xvi) the drawings must not contain any textual matter, except—

- (A) if required for a clear understanding of the drawings—the textual matter is a single word or words or the equivalent Chinese characters, as appropriate; and

Example—

Examples of the single word or words are “water”, “steam”, “open”, “close” and “section on AA”.

- (B) for electric circuits and block schematic or flow sheet diagrams, the textual matter is—

- (I) a few short catchwords or the equivalent Chinese characters, as appropriate, that are required for a clear understanding of the drawings; and

- (II) placed in a way that it can, if required, be replaced by its translations without interfering with any lines; and

- (xvii) the sheets of the drawings must be numbered in accordance with section 62(3)(e)(ii) of these Rules.

(3) In this section—

drawing (繪圖) includes a flow sheet and a diagram.

Note—

Section 62(13) of these Rules provides for exemption from this section.

61. Abstract

(1) This section applies to an abstract referred to in section 113(1A)(c) of the Ordinance of an invention that is the subject of a short-term patent application.

(2) The abstract must—

(a) contain a concise summary of the matters contained in the specification referred to in section 113(1A)(b) of the Ordinance;

(b) normally, not contain more than 150 words or 200 Chinese characters, as appropriate;

(c) if appropriate, contain the chemical formula that, among those chemical formulae contained in the specification, best characterizes the invention; and

(d) not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The summary referred to in subsection (2)(a) must—

(a) specify the technical field to which the invention relates; and

(b) be written in a way that allows a clear understanding of—

(i) the technical problem to which the invention relates;

- (ii) the gist of the solution to the problem through the invention; and
 - (iii) the principal use or uses of the invention.
- (4) If the specification provides for drawings—
 - (a) the applicant must indicate in the abstract any figure or, exceptionally, figures in the drawings that the applicant suggests should accompany the abstract when it is published;
 - (b) if the Registrar considers that any other figure or figures better characterize the invention—the Registrar may decide to publish the other figure or figures; and
 - (c) each main feature of the invention stated in the abstract and illustrated by a drawing must be followed by the reference sign relating to the feature used in that drawing, placed between parentheses.

62. Size and presentation of documents

- (1) This section applies to the documents comprising a short-term patent application to be filed under section 113(1)(b) of the Ordinance.
- (2) Each of the documents must be presented in a manner that it may be—
 - (a) reproduced in an unlimited number of copies by photography, photocopying processes, photo offset and microfilming; and
 - (b) scanned by a device capable of capturing an image of the document and converting the image into a form suitable for storage on, and retrieval by, a computer.

- (3) Each of the documents must—
 - (a) be free from cracks, creases and folds;
 - (b) be single-sided;
 - (c) be on A4 papers (29.7 cm × 21 cm) that are pliable, strong, white, smooth, matt and durable;
 - (d) not share a sheet with another document; and
 - (e) if the document has more than one sheet, comprise sheets that are—
 - (i) connected in a way that the sheets can easily be turned over, separated and combined again; and
 - (ii) numbered in consecutive Arabic numerals.
- (4) The description, claims and abstract—
 - (a) must not contain drawings;
 - (b) may contain chemical or mathematical formulae;
 - (c) subject to subsection (5)—may contain tables; and
 - (d) subject to subsection (6)—must be typed or printed.
- (5) The claims may contain tables only if their subject matter makes the use of tables desirable.
- (6) If necessary, graphic symbols and chemical or mathematical formulae may be drawn or written by hand.
- (7) All textual matters in the description, claims and abstract must be in black and indelible.
- (8) The tables and chemical or mathematical formulae—

- (a) subject to paragraph (b)—must be presented in an upright position on a sheet; and
 - (b) if they cannot be presented satisfactorily in an upright position on a sheet—may be presented sideways on the sheet in a way that the top of the tables or formulae are at the left side of the sheet.
 - (9) In the documents—
 - (a) weights and measures must be expressed in metric units, whether or not they are also expressed in other units;
 - (b) other physical values must be expressed in the units recognized in international practice;
 - (c) chemical or mathematical formulae must be stated by employing the symbols, atomic weights and molecular formulae in general use; and
 - (d) technical terms, signs and symbols generally accepted in the field in question must generally be used.
 - (10) If a formula or symbol is used in the specification, a copy of the specification, prepared in the same manner as drawings, must be furnished if the Registrar so directs.
 - (11) Terminology and signs must be consistent throughout the application.
 - (12) All documents must be—
 - (a) legible; and
 - (b) reasonably free from deletions and other alterations, overwritings and interlineations.

- (13) The Registrar may exempt a document from any requirement under this section and section 60 of these Rules if—
 - (a) the authenticity of the content of the document is not in question and the requirements for good reproduction are not in jeopardy; or
 - (b) the Registrar considers that there are other circumstances that justify the exemption.
- (14) Regardless of any exemption granted under subsection (13), in the case of an application for a short-term patent based on an international application under section 125 of the Ordinance, the documents comprising the international application are taken as complying with this section.

63. Form of statements, counter-statements and evidence

Subject to the Registrar's direction, any statement, counter-statement or evidence to be filed with the Registrar must comply with the requirements under section 62(2) and (3)(c) of these Rules as if those requirements applied to the statement, counter-statement or evidence.

64. Claims

- (1) This section applies to the claims referred to in section 113(1A)(b)(ii) of the Ordinance of an invention that is the subject of a short-term patent application.
- (2) The claims must define the matter for which protection is sought in terms of the technical features of the invention.
- (3) If appropriate, an independent claim must contain—

- (a) a statement indicating—
 - (i) the designation of the subject matter of the invention; and
 - (ii) the technical features that are necessary for the definition of the claimed subject matter and, in combination, are part of the prior art; and
 - (b) a characterizing portion, preceded by the expression “characterized in that” or “characterized by” or the equivalent Chinese characters, as appropriate, stating the technical features that, in combination with the technical features referred to in paragraph (a)(ii), the claim seeks to protect.
- (4) An independent claim stating the essential features of an invention may be followed by one or more dependent claims concerning particular embodiments of the invention (*dependent claim*).
- (5) A dependent claim that includes all the features of any other claim—
 - (a) must contain a reference to that other claim, at the beginning if possible;
 - (b) must state the additional features that the dependent claim seeks to protect; and
 - (c) is admissible even if it directly refers to another claim that is also a dependent claim.
- (6) Dependent claims referring to a single or several previous claims must be grouped together according to the previous claims in the most appropriate way.
- (7) The number of the claims must, having regard to the nature of the invention claimed, be reasonable.

- (8) If there are 2 or more claims, the claims must be numbered consecutively in Arabic numerals.
- (9) A claim must not rely—
 - (a) on references to the description or drawings in respect of the technical features of the invention unless it is absolutely necessary; and
 - (b) in particular, on the following references or references similar to the following references—
 - (i) “as described in part ... of the description”;
 - (ii) “as illustrated in figure ... of the drawings”;
 - (iii) “如說明第……部分所描述”; or
 - (iv) “如繪圖的附圖……所示”.
- (10) For an application that contains drawings, the technical features stated in the claims may be followed by the reference signs relating to the features used in the drawings, if doing so makes the claims easier to understand.
- (11) The reference signs—
 - (a) must be placed between parentheses; and
 - (b) are not to be construed as limiting the claims.”.

51. Section 67 amended (notice after examination of minimum requirement under section 114 of Ordinance)

Section 67(1) and (3)—

Repeal

“the date”

Substitute

“the earliest date”.

52. Section 67A amended (requirements for making reference to earlier specified application referred to in section 114(3)(c)(ii) of Ordinance)

Section 67A(3)—

Repeal

“the date”

Substitute

“the earliest date”.

53. Section 67B amended (filing for purposes of section 114A of Ordinance)

Section 67B(2)(a)—

Repeal

“the date”

Substitute

“the earliest date”.

54. Section 72 amended (contents of the search report)

(1) Section 72, English text, heading—

Repeal

“the”.

(2) Section 72(d)—

Repeal the semicolon

Substitute

“; and”.

(3) Section 72(e)—

Repeal the semicolon

Substitute a full stop.

(4) Section 72—

Repeal paragraph (f).

55. Section 74 amended (divisional short-term patent application under section 116 of the Ordinance)

(1) Section 74, English text, heading—

Repeal

“the”.

(2) Section 74(3)—

Repeal

“the date”

Substitute

“the earliest date”.

56. Section 75 amended (request to amend short-term patent application before grant under section 120(1) of Ordinance)

Section 75(4)—

Repeal

“62(1) to (13)”

Substitute

“62(2) to (12)”.

57. Section 79A amended (observations by third parties)

Section 79A(2)(b)—

Repeal subparagraph (ii)

Substitute

“(ii) the date on which the Registrar gives a notice in relation to the short-term patent under section 81I(5), 81K(4), 81M(4) or 81N(2) of these Rules;”.

58. Section 81 amended (restoration of lapsed short-term patents under section 127 of the Ordinance)

(1) Section 81, English text, heading—

Repeal

“the”.

(2) Section 81, after “Section 34”—

Add

“of these Rules”.

59. Section 81A amended (interpretation)

Section 81A—

Repeal the definition of *final revocation notice*.

60. Section 81B amended (request for substantive examination)

After section 81B(3)—

Add

“(4) The requester must, at the time of filing a request for substantive examination under subsection (3)(d), send a copy of the request to the proprietor of the short-term patent.”.

61. Section 81I amended (request to review)

Section 81I(5)—

Repeal paragraph (b)

Substitute

“(b) by notice given to the proprietor and the requester, if any, notify them of the decision.”.

Section 62

62. Section 81K amended (response to review opinion)

Section 81K(4)—

Repeal paragraph (b)

Substitute

“(b) by notice given to the proprietor and the requester, if any, notify them of the decision.”.

63. Section 81M amended (response to further review opinion)

Section 81M(4)—

Repeal paragraph (b)

Substitute

“(b) by notice given to the proprietor and the requester, if any, notify them of the decision.”.

64. Section 81N amended (final revocation notice)

(1) Section 81N, heading—

Repeal

“revocation notice”

Substitute

“decision of revocation”.

(2) Section 81N(2)—

Repeal

“(final revocation notice)”.

65. Section 81P amended (request to amend specification of short-term patent after grant under section 127B(1)(b) or 127D(3)(b) of Ordinance)

Section 81P(3)—

Repeal

“62(1) to (13)”

Substitute

“62(2) to (12)”.

66. Section 81TA added

After section 81T—

Add

“81TA. Order by court under section 127E(3) of Ordinance

- (1) This section applies if the Registrar refers the opposition proceedings to the court under section 127E(3) of the Ordinance for an order as to whether the allowable amendment should be allowed or not.
- (2) If the court allows the allowable amendment in whole or in part as an allowed amendment by an order under section 127E(3) of the Ordinance, the Registrar must, in addition to complying with section 127E(4)(a) and (b) of the Ordinance, consider whether the patent with the allowed amendment would achieve compliance with the examination requirements under section 127C(2) of the Ordinance.
- (3) If the court makes an order to not allow the allowable amendment, the Registrar must advertise the order by notice in the official journal.
- (4) The Registrar must comply with subsection (2) or (3) on receiving the order.
- (5) To avoid doubt, the order of the court to not allow any allowable amendment does not in itself affect the duty of the Registrar to—

- (a) examine the patent to determine whether the patent complies with the examination requirements under section 127C(2) of the Ordinance; and
- (b) make a consideration and decision or review under section 127E(1)(a)(i) or (b) of the Ordinance.
- (6) In this section—
 - allowable amendment*** (可容許修訂) means a requested amendment—
 - (a) accepted in whole or in part as an allowable amendment under section 81P(4)(a) of these Rules; and
 - (b) published under section 127E(2)(a) of the Ordinance.”.

67. Section 81U amended (publication of amendment under section 127E(2)(a) or (4)(a) of Ordinance)

Section 81U(3)—

Repeal

“62(1) to (13)”

Substitute

“62(2) to (12)”.

68. Section 81V amended (Registrar to follow procedure in Part 9, Division 5 of these Rules)

Section 81V(5)—

Repeal the definition of *relevant amendment*

Substitute

“**relevant amendment** (有關修訂) means an allowed amendment referred to in section 81T(1)(b)(i) or (2) or 81TA(2) of these Rules;”.

69. Section 81W added

Part 9, Division 6, after section 81V—

Add

“81W. References to court of opposition proceedings under section 127E(3) of Ordinance

- (1) This section applies if—
 - (a) a request to amend the specification of a short-term patent has been filed under section 127B(1)(b) or 127D(3)(b) of the Ordinance;
 - (b) an opposition notice has been filed by a person (**opponent**) under section 81Q(1) of these Rules; and
 - (c) the Registrar decides to refer the opposition proceedings to the court under section 127E(3) of the Ordinance after the expiry of the period for filing the opposition notice under section 81Q(2) of these Rules (**reference to court**).
- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the opposition proceedings known to the Registrar at the time of making the decision; and
 - (b) the Registrar of the High Court.

Section 70

- (3) If the opponent wishes to commence proceedings before the court in relation to the opposition proceedings, the opponent must commence the proceedings within 1 month after the date of the written notice given under subsection (2).
- (4) If the opponent fails to commence proceedings in relation to the opposition proceedings under subsection (3), the opponent is to be treated as having abandoned the opposition proceedings.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the opposition proceedings are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the opposition proceedings with the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to court; and
 - (b) advertise the fact of the reference to court by notice in the official journal.
- (7) Section 81R of these Rules does not apply after the Registrar has given written notice under subsection (2).”.

70. Section 85 amended (agents)

- (1) Section 85(1)—

Repeal

“, any act required or permitted to be done under the Ordinance or these rules”

Substitute

Section 70

“of these Rules, any act required or permitted to be done under the Ordinance or these Rules”.

- (2) Section 85(4), after “address”—

Add

“of the premises”.

- (3) Section 85(4)—

Repeal

“, which notice shall be given in the specified form or in writing”.

- (4) Section 85(5), after “address”—

Add

“of the premises”.

- (5) Section 85(5)—

Repeal

“, which notice shall be given in the specified form or in writing”.

- (6) After section 85(5)—

Add

“(5A) A notice under subsection (4) or (5) must—

- (a) be given in the specified form or in writing; and
- (b) contain a declaration by the person giving the notice that the person resides or carries on the person’s business activities on the premises specified in the notice.

- (5B) The Registrar may require a person who gives notice under subsection (4) or (5) to, within the time specified by the Registrar, produce evidence that the person resides or carries on the person’s business activities on the premises specified in the notice.”.

Section 71

71. Section 87A added

Part 12, after section 87—

Add

“87A. Taxation of costs

The Registrar may tax any costs awarded by the Registrar in any proceedings before the Registrar.”.

72. Section 88 amended (request for information under section 147 of the Ordinance)

(1) Section 88, English text, heading—

Repeal

“the”.

(2) Section 88(1)(a)(i), Chinese text—

Repeal

“記錄或原授標準專利申請請求”

Substitute

“記錄請求或原授標準專利申請”.

(3) Section 88(1)(c)(iv), after “90”—

Add

“of these Rules”.

73. Section 89 amended (restriction on inspection of documents under section 147 of the Ordinance)

(1) Section 89, English text, heading—

Repeal

“the”.

(2) Section 89(1)(e), after “section 90”—

Add

“of these Rules”.

74. Section 91 amended (bibliographic information for purposes of section 147(3) of the Ordinance)

- (1) Section 91, English text, heading—

Repeal

“the”.

- (2) Section 91(cc)—

Repeal

everything after “required”

Substitute

“or is requested to communicate to any other person under section 3(6), 31F(4)(b) or 91A(1) of these Rules;”.

- (3) Section 91(f), after “section 45”—

Add

“of these Rules”.

75. Section 91A added

After section 91—

Add

“91A. Registrar may communicate to others bibliographic information about unpublished patent applications under section 147(3) of Ordinance

- (1) A person (*requester*) may request the Registrar to communicate to the requester the following bibliographic information under section 147(3) of the Ordinance—

- (a) the name and address for service of each applicant in an unpublished application for a standard patent;
 - (b) the name and address of any person who has a right in or under the patent application as shown in an application, or a notice, that is mentioned in section 46(1) of these Rules.
- (2) A request under subsection (1) must be made in writing and accompanied by a statutory declaration made by the requester stating—
 - (a) that the requester intends to commence proceedings to refer to the court a question relating to an unpublished application for a standard patent for an invention under section 13(1) or 37H(1) of the Ordinance;
 - (b) that the bibliographic information sought by the requester will only be used for the purpose of commencing the proceedings; and
 - (c) any of the following information—
 - (i) the application number assigned by the Registrar on the filing of the application for a standard patent (O) or a standard patent (R) (*assigned number*);
 - (ii) if the application is for a standard patent (R) and the assigned number is not known to the requester—the application number assigned by a designated patent office on the filing of the application for a designated patent for the invention.

- (3) The Registrar may, on receiving a request under subsection (1) and on being satisfied that the statutory declaration complies with subsection (2), communicate to the requester the bibliographic information under section 147(3) of the Ordinance.”.

76. Part 13, Division 1A added

Part 13, after Division 1—

Add

**“Division 1A—References to Court by Registrar
under Section 133(1)(b) of Ordinance**

92A. References to court under section 133(1)(b) of Ordinance of questions referred to Registrar under section 13(1), 14(5), 37H(1) or 37K(7) of Ordinance

- (1) This section applies if—
 - (a) a person (*applicant*) refers a question to the Registrar under section 13(1), 14(5), 37H(1) or 37K(7) of the Ordinance (*original reference*); and
 - (b) the Registrar decides to refer the question to the court for determination under section 133(1)(b) of the Ordinance (*reference to court*).
- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the original reference known to the Registrar at the time of making the decision;

- (b) if a patent application for the invention concerned has been filed—the proprietor of the application (if not already a party to the original reference); and
 - (c) the Registrar of the High Court.
- (3) If the applicant wishes to commence proceedings before the court in relation to the original reference, the applicant must commence the proceedings within 1 month after the date of the written notice given under subsection (2).
- (4) If the applicant fails to commence proceedings in relation to the original reference under subsection (3), the applicant is to be treated as having abandoned the original reference.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the original reference are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the original reference with the Registrar.
- (6) If the original reference relates to a patent application published under section 20(1) or 37Q(1) of the Ordinance on or before the date of the written notice given under subsection (2), the Registrar must also—
 - (a) enter in the register a notice of the reference to court; and
 - (b) advertise the fact of the reference to court by notice in the official journal.

- (7) The following provisions do not apply after the Registrar has given written notice under subsection (2)—
 - (a) if the question mentioned in subsection (1)(a) relates to an application for a standard patent (R)—sections 3(7), (8), (9), (10) and (11) and 7(3) and (4) of these Rules;
 - (b) if the question mentioned in subsection (1)(a) relates to an application for a standard patent (O)—sections 31G, 31H(1), (2), (3), (4), (5), (6), (7), (8) and (9) and 31L(1), (2), (3) and (4) of these Rules.

92B. References to court under section 133(1)(b) of Ordinance of applications to amend specification after grant under section 46(2)(b) or (c) of Ordinance

- (1) This section applies if—
 - (a) an application (*application*) has been made by the proprietor of a patent to amend—
 - (i) the specification of a standard patent (O) under section 46(2)(b) of the Ordinance; or
 - (ii) the specification of a short-term patent in respect of which a certificate of substantive examination has been issued under section 46(2)(c) of the Ordinance; and
 - (b) the Registrar decides to refer the application to the court under section 133(1)(b) of the Ordinance after the expiry of the period for filing an opposition notice under section 38B(2) of these Rules (*reference to court*).

- (2) The Registrar must, as soon as practicable after deciding to make the reference to court, give written notice of the decision to—
 - (a) every party to the application known to the Registrar at the time of making the decision; and
 - (b) the Registrar of the High Court.
- (3) If the proprietor of the patent wishes to commence proceedings before the court in relation to the application, the proprietor must commence the proceedings within 1 month after the date of the written notice given under subsection (2).
- (4) If the proprietor of the patent fails to commence proceedings in relation to the application under subsection (3), the proprietor is to be treated as having abandoned the application.
- (5) As soon as practicable after being served with a copy of the originating summons by which proceedings in relation to the application are commenced under subsection (3), the Registrar must file with the court any document or other thing that was filed for the purpose of the application with the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to court; and
 - (b) advertise the fact of the reference to court by notice in the official journal.
- (7) Section 38C of these Rules does not apply after the Registrar has given written notice under subsection (2).”.

Section 77

77. Section 93A amended (electronic filing)

Section 93A(2), after “section 93”—

Add

“of these Rules”.

78. Section 93B amended (terms for electronic filing)

(1) Section 93B(1), after “section 93A(3)” —

Add

“of these Rules”.

(2) Section 93B(1)(e), after “section 93A(2)” —

Add

“of these Rules”.

(3) Section 93B(2), after “section 93A(3)” —

Add

“of these Rules”.

(4) Section 93B(2)(b), after “section 93A(2)” —

Add

“of these Rules”.

79. Section 93D amended (service of documents)

Section 93D(1), after “93C”—

Add

“of these Rules”.

80. Section 94 amended (correction of irregularities)

Section 94(2)(a), after “prescribed in”—

Add

“the Ordinance or”.

81. Section 97 amended (statutory declarations and affidavits)

Section 97(2), after “section 84”—

Add

“of these Rules”.

82. Section 100AA amended (extension of time—general provision)

After section 100AA(1)—

Add

“(1A) If a request for the grant of an extended period is made under subsection (1) in inter partes proceedings, the requester must send a copy of the request to every other party to the proceedings.”.

83. Section 100AAB amended (grant of extended period on request)

After section 100AAB(1)—

Add

“(1A) If a request for the grant of an extended period is made under subsection (1), the requester must send a copy of the request to every other party to the proceedings.”.

84. Part 13, Division 8 heading amended (fees)

Part 13, Division 8, heading—

Repeal

“Fees”

Substitute

“Miscellaneous”.

85. Section 104 amended (fees)

- (1) Section 104(1), after “Ordinance”—

Add

“or these Rules”.

- (2) Section 104(2)—

Repeal

“Fees shall be paid by such means”

Substitute

“Subject to subsection (3), fees must be paid by such time”.

- (3) After section 104(2)—

Add

- “(3) If a fee is required to be paid in relation to a matter or proceeding for which a specified form is required to be used—

(a) subsection (2) does not apply; and

(b) subject to sections 11, 21, 31M(5) and 68A(2) of these Rules, the fee must be paid when the specified form is filed.

- (4) If the Registrar is required or authorized by any provision of the Ordinance or these Rules to do any act or thing in relation to a matter or proceeding for which a fee is required to be paid, the Registrar may, despite that provision, refuse to do that act or thing until such time as the fee is paid.

- (5) If a fee is paid in error or in excess of the amount specified in Schedule 2, the Registrar must refund the amount paid in error or the excess amount accordingly.”.

86. Section 104A added

Part 13, Division 8, after section 104—

Add

“104A. Stay of proceedings

- (1) The Registrar may, if the Registrar considers it appropriate to do so, stay any proceedings before the Registrar involving 2 or more parties on any term that the Registrar considers appropriate.
- (2) The Registrar may do so either on the initiative of the Registrar or on request of a party to those proceedings.”.

87. Section 115 added

After section 114—

Add

“115. Transitional provisions relating to Patents (General) (Amendment) Rules 2025

- (1) Subject to subsection (2), the amendments to these Rules effected by the Amendment Rules (*amendments*) do not apply to proceedings that are pending before the Registrar on the commencement date (*pending proceedings*), and the pending proceedings are to continue as if the amendments had not been made.
- (2) If, on or after the commencement date, the Registrar—
 - (a) decides to refer any pending proceedings to the court for determination under section 44(5), 48(4), 49(2)(b), 127E(3) or 133(1)(b) of the Ordinance; and

(b) gives written notice of the decision under section 37A(2), 40A(2), 41AAI(2), 81W(2), 92A(2) or 92B(2) of these Rules,

the amendments apply to the pending proceedings after the date of the notice.

(3) In this section—

Amendment Rules (《修訂規則》) means the Patents (General) (Amendment) Rules 2025;

commencement date (生效日期) means the date on which the Amendment Rules come into operation.”.

88. Schedule 1 amended (micro-organisms)

(1) Schedule 1, paragraph 1(4)—

Repeal

“before”

Substitute

“on or before”.

(2) Schedule 1, paragraph 3(2)(c)—

Repeal

“section 37ZA, 46 or 120 of the Ordinance, as the case may be,”

Substitute

“the Ordinance”.

89. Schedule 2 amended (fees)

(1) Schedule 2, item 2—

Repeal

“41(3)”

Substitute

“41AAB(1), 41AAC(1)”.

- (2) Schedule 2, item 13, after “9th year”—

Add

“from the date specified in section 39(1)(b) of the Ordinance”.

- (3) Schedule 2, item 13, after “14th year”—

Add

“from the date specified in section 39(1)(b) of the Ordinance”.

- (4) Schedule 2, item 13, after “19th year”—

Add

“from the date specified in section 39(1)(b) of the Ordinance”.

- (5) Schedule 2, item 20—

Repeal

“49 of the Ordinance”

Substitute

“49(1) of the Ordinance and section 41(1) of these Rules”.

90. “Ordinance” substituted for “the Ordinance”

The following provisions, English text—

- (a) section 5, heading;
- (b) section 6, heading;
- (c) section 7, heading;
- (d) section 8, heading;
- (e) section 23, heading;
- (f) section 25, heading;
- (g) section 26, heading;
- (h) section 27, heading;
- (i) section 28, heading;
- (j) section 31, heading;
- (k) section 34, heading;
- (l) section 53, heading;
- (m) section 70, heading;
- (n) section 76, heading;
- (o) section 77, heading;
- (p) section 86, heading;
- (q) section 92, heading;
- (r) section 110, heading—

Repeal

“the Ordinance” (wherever appearing)

Substitute

“Ordinance”.

David WONG Fuk-loi
Registrar of Patents

6 May 2025

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg. C) (*principal Rules*) to provide for the legal proceedings—

- (a) for referring a question to the Registrar of Patents under section 49 of the Patents Ordinance (Cap. 514) (*Ordinance*);
- (b) for referring an application, matter or question to the Court of First Instance under section 44(5), 48(4), 49(2)(b) or 133(1)(b) of the Ordinance;
- (c) for referring the opposition proceedings to the Court of First Instance under section 127E(3) of the Ordinance; and
- (d) concerning surrender of patents under section 48 of the Ordinance.

2. These Rules also—

- (a) add a new section 91A to the principal Rules to empower the Registrar of Patents to communicate to others bibliographic information about unpublished patent applications under section 147(3) of the Ordinance;
- (b) add a new section 104A to the principal Rules to empower the Registrar of Patents to stay proceedings;
- (c) add a new section 115 to the principal Rules to provide for transitional arrangements;
- (d) make minor technical amendments to various provisions of the principal Rules; and

- (e) make textual and consequential amendments to various provisions of, and Schedules 1 and 2 to, the principal Rules.