

Patents (Amendment) Bill 2015

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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 (欠交說明) 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 section 37L and of any rules made for the purposes 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”—

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.

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)”.

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.