

Patents (General) Rules

(L.N. 150 of 2014)

(Cap. 514, section 149)

(Enacting provision omitted—E.R. 3 of 2015)

[27 June 1997]

L.N. 367 of 1997

(Format changes—E.R. 3 of 2015)

Part 1 Preliminary

(L.N. 150 of 2014)

1. (Omitted as spent—E.R. 3 of 2015)

2. Interpretation

(1) In these Rules, unless the context otherwise requires—

application number (申請編號) means—

- (a) in relation to an application for a designated patent or a patent granted in pursuance of such an application, the number assigned by the designated patent office upon the filing of that application;
- (b) in relation to an application for a patent under the Ordinance or a patent granted in pursuance of such an application, the number assigned by Registrar upon the filing of that application;

digital signature (數碼簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

electronic record (電子紀錄) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

electronic signature (電子簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

European Patent Office (歐洲專利局) means the office of that name of the European Patent Organization established by the Convention on the Grant of European Patents done at Munich on 5 October 1973;

information system (資訊系統) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

International Patent Classification (國際專利分類法) means the system of common classification for patents for inventions provided for under the Agreement concerning the International Patent Classification done at Strasbourg on 24 March 1971, as revised or amended from time to time; (L.N. 37 of 2004)

publication number (發表編號) means—

- (a) in relation to a document published under the Ordinance, the number assigned to the document by the Registrar upon its publication;
- (b) in relation to a document published under the laws of a patent office outside Hong Kong or under any international convention, the number assigned to the document upon its publication by that patent office or under that convention;

send (送交) includes give, and cognate expressions are to be construed accordingly; (L.N. 37 of 2004)

State Intellectual Property Office (國家知識產權局) means the State Intellectual Property Office established under the laws of the People's Republic of China the functions of which include the granting of patents for inventions; (2 of 2001 s. 17)

United Kingdom Patent Office (聯合王國專利局) means the office established under the laws of the United Kingdom for the granting of patents for inventions.

(2) In these Rules—

(a) (Repealed L.N. 37 of 2004)

- (b) reference to the filing of a document or other thing with the Registrar, or reference to the filing of a document or other thing without an indication of the place at which or person with whom it is to be filed, shall be construed as a reference to the filing of the document or thing with the Registrar in accordance with sections 93, 93A, 93B and 93C; (L.N. 37 of 2004)

- (c) reference to a document in any proceedings before the Registrar being in the specified form is to be construed as a reference to the document being in such form, if any, as may be specified by the Registrar under section 150 of the Ordinance in connection with those proceedings.

(2 of 2001 s. 17)

2A. Specified forms

A requirement to use a specified form is satisfied by the use of either—

- (a) a replica of the specified form; or
- (b) a form acceptable to the Registrar,

that contains the information required by the specified form and complies with any directions of the Registrar as to the use of the specified form or replicas of it.

(L.N. 37 of 2004)

Part 1A **Mention of Inventor**

2B. Request

- (1) A person (*requester*) may make a request to the Registrar in relation to section 9F(1) or (2) of the Ordinance (*request*) that—
- (a) for a request to make a finding in relation to section 9F(1) of the Ordinance—the requester has a right to be mentioned as the inventor or a joint inventor of an invention in—
 - (i) any published patent application for the invention; or
 - (ii) any patent granted for the invention; or
 - (b) for a request to make a finding in relation to section 9F(2) of the Ordinance—a person ought not to have been mentioned as the sole inventor or a joint inventor of an invention in—
 - (i) any published patent application for the invention; or
 - (ii) any patent granted for the invention.
- (2) The request must be—
- (a) in the specified form;
 - (b) accompanied by—
 - (i) a statement setting out—
 - (A) the facts on which the requester relies; and
 - (B) the finding sought; and
 - (ii) the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (3) A requester who files a request must, at the same time—
- (a) send a copy of the request and statement to each person who meets the conditions specified in subsection (4);
 - (b) attach to each copy of the request and statement a list of the names and addresses of all those persons; and
 - (c) notify the Registrar in writing of those names and addresses.
- (4) The conditions are that—
- (a) the person is not the requester; and
 - (b) the person falls within any of the following descriptions—
 - (i) the person is registered as a proprietor of the patent;
 - (ii) the person is an applicant for the patent;
 - (iii) the person has been identified in the patent application or the patent as the inventor or a joint inventor of the invention;
 - (iv) the person has been identified in the statement as the inventor or a joint inventor of the invention;
 - (v) the person is shown in the register as having a right in or under the patent application or the patent.

2C. Counter-statement

- (1) A person who receives a copy of a request and statement under section 2B(3)(a) of these Rules and intends to oppose the request (*opponent*) may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 3 months after the date on which the copy of the request and statement is received by the opponent.
- (3) The counter-statement must—
 - (a) be in the specified form;
 - (b) set out the grounds of opposition; and
 - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) An opponent who files a counter-statement must, at the same time, send a copy of it to—
 - (a) the person making the request; and
 - (b) all other persons to whom a copy of the request and statement is sent.
- (5) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

Part 2
Applications for Standard Patents

(L.N. 150 of 2014)

Part 2
Standard Patents by Re-registration

Division 1A—Novelty

2D. Exhibition and meeting under section 11A of Ordinance

The following exhibitions and meeting are prescribed for the purposes of section 11A(2)(b)(ii) of the Ordinance—

- (a) an official, or officially recognized, international exhibition within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong;
- (b) an international exhibition sponsored or recognized by the Central People's Government;
- (c) an academic or technological meeting organized by—
 - (i) a competent agency of the Central People's Government; or
 - (ii) a national academic or technological association recognized by the Central People's Government.

Division 1
Right to Apply

(L.N. 150 of 2014)

Division 1—Who may Apply for Standard Patent (R)

3. References to the Registrar under section 13(1)(a) or (b) of the Ordinance

- (1) A reference to the Registrar under section 13(1)(a) or (b) of the Ordinance shall—
 - (a) be in the specified form;
 - (b) be accompanied by a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or relief sought; and
 - (c) be accompanied by the prescribed fee.
- (2) In the case of a reference under section 13(1)(a) of the Ordinance, the person making the reference shall, at the same time as he files it, send a copy of the reference and statement to each of the following persons (not being a party to the reference)—
 - (a) each person who is alleged in the reference to be entitled to apply for the grant of a ~~standard patent~~**standard patent (R)** for the invention that is the subject of the reference;

- (b) each person whom the person making the reference believes to be the inventor or joint inventor of that invention; and
 - (c) if an application for a ~~standard patent~~ standard patent (R) for that invention has been published before the reference is filed, each person who is shown in the register as having a right in or under that application.
- (3) In the case of a reference under section 13(1)(b) of the Ordinance, the person making the reference shall, at the same time as he files it, send a copy of the reference and statement—
- (a) to each joint proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order or the granting of the relief sought;
 - (b) to each of the following persons (not being a party to the reference)—
 - (i) each person to whom it is alleged in the reference any right in or under the application should be transferred or granted; and
 - (ii) each person whom the person making the reference believes to be the inventor or joint inventor of the invention that is the subject of the reference; and
 - (c) if an application for a ~~standard patent~~ standard patent (R) for that invention has been published before the reference is filed, to each person who is not a party to the reference and is shown in the register as having a right in or under that application.
- (4) The person making the reference shall attach to each copy of the reference and statement he sends under subsection (2) or (3), as the case may be, a notice containing the names and addresses of all persons to whom a copy of the reference and statement is being sent under that subsection, and he shall notify the Registrar in writing of the names and addresses of those persons.
- (5) In addition, if an application for a ~~standard patent~~ standard patent (R) for the invention that is the subject of a reference under section 13(1)(a) or (b) of the Ordinance has been filed but the application has not been published before the reference is filed, the Registrar shall send a copy of the reference and statement to each of the following persons (not being a party to the reference or a person to whom copies have been sent under subsection (2) or (3), as the case may be)—
- (a) each person who is an applicant for the ~~standard patent~~ standard patent (R); and
 - (b) each person who has given notice to the Registrar under section 46 of a transaction, instrument or event in relation to that application.
- (6) The Registrar shall send a notice containing the names and addresses of all persons to whom copies of the reference and statement have been sent under subsection (5) to—
- (a) each person to whom copies have been sent under that subsection;
 - (b) the person making the reference; and
 - (c) each person whose name and address has been notified to the Registrar under subsection (4).
- (7) Any person who ~~is sent~~ receives a copy of the reference and statement under subsection (2), (3) or (5) and who wishes to oppose the making of the order or the granting of the relief sought (*the opponent*) shall, within 3 months from the date on which the copies are ~~sent to him~~ received by the person, file a counter-statement which shall be in the specified form, shall set out fully the grounds of opposition and shall be accompanied by the prescribed fee.
- (8) The opponent shall, at the same time as he files the counter-statement, send a copy of it to each of the following persons (not being a party to the counter-statement)—
- (a) the person making the reference;
 - (b) each person whose name and address has been notified to him under subsection (4); and
 - (c) each person whose name and address has been notified to him under subsection (6).
- ~~(9) The person making the reference and any other person to whom a copy of the counter-statement is sent under subsection (8) may, within 3 months from the date on which it is sent to him, file evidence in support of his case and, if he files such evidence, he shall send a copy of it—~~
- ~~(a) to the opponent; and~~
 - ~~(b) where the evidence is filed by such other person, to the person making the reference.~~
- (9) A person referred to in subsection (8)(a), (b) or (c)—
- (a) may, within 3 months after the date on which the copy of the counter-statement is received by the person, file evidence in support of the case of the person making the reference; and
 - (b) if the person files the evidence—must send a copy of it to—
 - (i) the opponent; and
 - (ii) if the evidence is not filed by the person making the reference—the person making the reference.

- (9A) On filing evidence under subsection (9), a person referred to in subsection (8)(b) or (c) joins as a party to the reference.
- (10) ~~Within 3 months from the date on which a copy of evidence is sent to the opponent under subsection (9) or, if no such evidence is filed under that subsection, within 3 months from the expiry of the time within which evidence might have been filed, the opponent may file evidence in support of his case and, if he files such evidence, he shall send a copy of it to—~~
~~(a) the person making the reference; and~~
~~(b) any other person who has filed the evidence under subsection (9).~~
received by the opponent under subsection (9) or, if no evidence is filed under that subsection, within 3 months after the expiry of the time within which the evidence might have been filed, the opponent—
(a) may file evidence in support of the opponent's case; and
(b) if the opponent files the evidence—must send a copy of it to—
(i) the person making the reference; and
(ii) any other person who has filed the evidence under subsection (9).
- (11) ~~The person making the reference and any other person to whom a copy of the opponent's evidence is sent under subsection (10) may, within 3 months from the date on which the copy is sent to him, file further evidence confined to matters strictly in reply to the opponent's evidence and, if he files such further evidence, he shall send a copy of it—~~
~~(a) to the opponent; and~~
~~(b) where the further evidence is filed by such other person, to the person making the reference.~~
received by the person, file further evidence confined to matters strictly in reply to the opponent's evidence and, if the person files the further evidence, the person must send a copy of it to—
(a) the opponent; and
(b) if further evidence is filed by that other person—the person making the reference.
- (12) No further evidence shall be filed except by leave or direction of the Registrar.
- ~~(13) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.~~
- (13) The Registrar may, on the initiative of the Registrar or on application of a party to the reference, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

(L.N. 37 of 2004)

4. *(Repealed L.N. 37 of 2004)*

5. Orders under section 13 of the Ordinance

- (1) Where an order is made as is mentioned in section 14(2) of the Ordinance, the Registrar shall notify all original applicants and their licensees of whom he is aware of the making of the order.
- (2) A request under section 14(3) of the Ordinance shall be made—
 (a) in the case of a request by the original applicant or any of the original applicants, within 2 months from the date ~~on which a notification is sent to him~~of the notification under subsection (1); or
 (b) in the case of a request by a licensee, within 4 months from the date ~~on which a notification is sent to him~~of the notification under subsection (1).

6. Authorization under section 13(5) of the Ordinance

- (1) An application under subsection (5) of section 13 of the Ordinance for authority to do anything on behalf of a person to whom directions have been given under subsection (3)(c) or (4) of that section shall—
 (a) be in the specified form;
 (b) be accompanied by a statement setting out fully the facts upon which the applicant relies and the nature of the authorization sought; and
 (c) be accompanied by the prescribed fee.
- (2) The applicant shall, at the same time as he files the application, send a copy of the application and statement to the person alleged to have failed to comply with the directions.

- (3) The Registrar may give ~~such directions as he may think fit with regard to the subsequent procedure.~~directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

(L.N. 37 of 2004)

7. Reference to the Registrar under section 14(5) of the Ordinance

- (1) Where, following the making of an order as is mentioned in subsection (2) of section 14 of the Ordinance, a question is referred to the Registrar under subsection (5) of that section as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall—
- (a) be in the specified form;
 - (b) be accompanied by a statement setting out fully the facts upon which the person making the reference relies and the period and terms of the licence which he is prepared to accept or grant; and
 - (c) be accompanied by the prescribed fee.
- (2) The person making the reference shall, at the same time as he files the reference, send a copy of the reference and statement to every person in whose name the application is to proceed or, as the case may be, every person claiming to be entitled to be granted a licence, in either case not being a person who makes the reference.
- (3) If any recipient of the reference and statement does not agree to grant or accept the licence for such period and upon such terms as are set out in the statement, ~~he shall~~the recipient must, within 3 months from the date on which the copies are ~~sent to him~~received by the recipient, file a counter-statement setting out fully the grounds of ~~his~~the recipient's objection.
- (4) (a) The counter-statement shall be in the specified form and shall be accompanied by the prescribed fee.
(b) The recipient shall, at the same time as he files the counter-statement, send a copy of it to the person making the reference.
- (5) The Registrar may give ~~such directions as he may think fit with regard to the subsequent procedure.~~directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

(L.N. 37 of 2004)

~~Division 2~~ Request to Record a Designated Patent Application

(L.N. 150 of 2014)

Division 2—Request to Record Designated Patent Application

8. Request to record a designated patent application under section 15 of the Ordinance

- (1) A request to record a designated patent application under section 15 of the Ordinance (or, in the case of a designated patent application that is the national phase of an international application under the Patent Cooperation Treaty, under that section as applied by section 16 of the Ordinance) shall be in the specified form.
- (2) Further to section 15(2) of the Ordinance (including that section as applied by section 16 of the Ordinance)—
- (a) the documents required under paragraph (a) of that subsection—
 - (i) shall be filed in accordance with section 12 of these Rules; *(L.N. 37 of 2004)*
 - (ii) shall be exempted from any requirement under section 104(1) of the Ordinance to be filed in one of the official languages;
 - (b) the documents prescribed for the purposes of paragraph (d) of that subsection are those mentioned in section 9 of these Rules;
 - (c) the following particulars shall be set out in the request—
 - (i) the date of filing of the designated patent application;
 - (ii) the title of the invention;
 - (iii) the application number of the designated patent application;
 - (iv) the publication number (if any) assigned to the designated patent application by the designated patent office, and the date (if any) of its publication by the designated patent office; *(L.N. 48 of 2002)*

- (d) if the designated patent application is the national phase of an international application, the following particulars shall be set out on the request—
- (i) the application number of the international application;
 - (ii) the filing date of the international application;
 - (iii) the date of publication of the international application by the International Bureau and its publication number;
 - ~~(iv) the date of publication of the international application in the designated patent office indicating that the application has validly entered its national phase;~~
 - (iv) the following date—
 - (A) if the designated patent application is based on the international application referred to in section 15(1)(a)(i), (ii) or (iii) of these Rules, as the case requires—the date of publication of the international application by the designated patent office showing that the international application has entered the national phase in the designated patent office; or
 - (B) the date of issuance of an official notification referred to in section 15(1)(b) of these Rules, if applicable;
 - ~~(v) in the case of an international application designating the State Intellectual Property Office as published by the International Bureau in the Chinese language, the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the State Intellectual Property Office; (2 of 2001 s. 18)~~
- (e) in the case of a request to record a divisional designated patent application as provided for in section 22 of the Ordinance or a request to record in a new application made pursuant to an order under section 55(4) of the Ordinance, the following particulars in relation to the earlier application for a ~~standard patent~~standard patent (R) shall be set out in the request to record—
- (i) the application number of the earlier application;
 - (ii) the filing date of the earlier application;
 - (iii) the date of publication of the request to record of the earlier application;
- (f) the request shall contain such translations of documents and transliteration of names as may be required under section 56 of these Rules;
- (g) the request shall contain a list of the documents comprising the request to record and an indication of the number of sheets of each such document.

9. Documents supporting statement of derivation of entitlement to apply

For the purposes of section 15(2)(d) of the Ordinance, the following documents are prescribed in relation to an applicant's statement explaining his entitlement to apply for the grant of a patent—

- (a) where the statement under that section indicates that the applicant for a ~~standard patent~~standard patent (R) is the successor in title to the person named in the designated patent application as applicant—
 - (i) copies of such documents as establish the transfer, assignment or mortgage of the rights under the designated patent application in Hong Kong from that person to the applicant for a ~~standard patent~~standard patent (R); or (*L.N. 37 of 2004*)
 - (ii) in the absence of any such document in relation to a particular transfer, assignment or mortgage, a statement signed by the transferor, assignor or mortgagor confirming the fact of the transfer or assignment or mortgage;
- (b) where the statement indicates that the applicant for a ~~standard patent~~standard patent (R), not being a person specified in paragraph (a), is the inventor of the invention who is entitled to the property in the invention in Hong Kong, such documents as establish that entitlement;
- (c) where the statement indicates that the applicant for a ~~standard patent~~standard patent (R) is the successor in title to the person specified in paragraph (b), the documents specified in that paragraph and, in addition—
 - (i) such documents as evidence the transfer or assignment or mortgage (whether by a single such transaction or by a number of such transactions) of the property in the invention in Hong Kong from the inventor of the invention to the applicant;
 - (ii) in the absence of any such document in relation to a particular transfer, assignment or mortgage, a statement signed by the transferor, assignor or mortgagor confirming the fact of the transfer, assignment or mortgage.

10. Details relating to the previous disclosure of the invention

For the purposes of the statement required under section 15(2)(f) of the Ordinance, the following details relating to the previous disclosure of the invention are prescribed—

- (a) the name and place of the exhibition or meeting referred to in section ~~552D~~ of these Rules at which the invention was first disclosed;
- (b) the opening date of such exhibition or meeting;
- (c) if the first disclosure of the invention did not take place on the opening date of such exhibition or meeting, the date of such first disclosure.

11. Grace period

If a filing fee or an advertisement fee payable under section 15(4) of the Ordinance is not paid within the time limit specified in that section, it is to be regarded as having been paid within the time limit if it is paid, with an additional fee, within a grace period—

- (a) that is allowed by the Registrar by a notice given to the applicant; and
- (b) that—
 - (i) begins on the date of expiry of the time limit; and
 - (ii) ends at the expiry of 1 month after the date of the notice.

~~11. Period of grace~~

~~If the filing fee or advertisement fee payable under section 15(4) of the Ordinance has not been paid within the time provided for in that subsection, it may still be validly paid within a period of grace of 1 month after the sending by the Registrar to the applicant of a communication pointing out the failure to observe the time limit if, and only if, within this period an additional prescribed fee is paid.~~

12. Size and presentation of documents

- (1) All documents making up a request to record shall be so presented as to permit of—
 - (a) reproduction by photography, photocopying, photo offset and micro-filming, in an unlimited number of copies; and (*L.N. 37 of 2004*)
 - (b) the scanning of the document by a device capable of capturing an image of the document and converting that image into a form suitable for storing on and retrieval by a computer.
- (2) All sheets of the documents making up a request to record shall be free from cracks, creases and folds; and only one side of the sheet shall be used.
- (3) All documents shall be on A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable.
- (4) Each of the documents shall commence on a new sheet; and the sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.
- (5)-(6) (*Repealed L.N. 37 of 2004*)
- (7) All the sheets contained in the documents shall be numbered in consecutive Arabic numerals. (*L.N. 37 of 2004*)
- (8) (*Repealed L.N. 37 of 2004*)
- (9) All documents shall be reasonably free from deletions and other alterations, overwritings and interlineations and shall, in any event, be legible.
- (10) The Registrar may exempt any document from compliance with any of the provisions of this section, if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy or in such other circumstances as he may think fit.

13. Form of statements, counter-statements and evidence

Any statement, counter-statement or evidence filed shall, unless the Registrar otherwise directs, comply with the requirements of section 12(1) and (3), except that both sides of the sheet may be used in the case of statutory declarations and evidence.

14. Issue of receipt by Registrar

On first receipt of any of the documents comprising a request to record the Registrar shall—

- (a) mark the documents with the date of their receipt by him and assign a number to the proceedings; and
- (b) issue to the applicant a receipt which shows the number so assigned, the nature and number of the documents received and the date of their receipt.

15. Date of publication of designated patent application based on international application under section 16 of Ordinance

- (1) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance—
 - (a) the reference to the date of publication of the designated patent application based on an international application under section 16(a)(i) of the Ordinance is to be construed as—
 - (i) for an international application designating the European Patent Office—the date of publication by the European Patent Office in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the European Patent Office;
 - (ii) for an international application designating the United Kingdom Patent Office—the date of publication by the United Kingdom Patent Office in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the United Kingdom Patent Office; or
 - (iii) for an international application designating the State Intellectual Property Office—the date of publication by the State Intellectual Property Office in its Patent Gazette of the relevant bibliographical data showing that the international application has entered the national phase in the State Intellectual Property Office; and
 - (b) the reference to the other date referred to in section 16(a)(ii) of the Ordinance as applicable to an international application designating the State Intellectual Property Office published by the International Bureau in the Chinese language is to be construed as the date of issuance of an official notification by the State Intellectual Property Office stating that the international application has entered the national phase in the State Intellectual Property Office.
- (2) An application to which section 16(a)(ii) of the Ordinance applies must be accompanied by a copy of the official notification issued by the State Intellectual Property Office.

16. Notice following examination under section 18 of Ordinance

- (1) If a request to record does not comply with any of the requirements under section 17(1) of the Ordinance, the Registrar must, by notice given to the applicant, notify the applicant that unless the applicant corrects the deficiencies within 1 month after the date of the notice, the request is not to be dealt with as a standard patent (R) application.
- (2) If the applicant corrects the deficiencies within the time limit, the Registrar must inform the applicant of the date of filing accorded to the request to record.

17. Correction of deficiencies in request to record

If an examination of a request to record under section 19(1) of the Ordinance reveals deficiencies in the request that may be corrected, the Registrar must, by notice given to the applicant, require the applicant to correct the deficiencies within 2 months after the date of the notice.

15.—Date of publication of the designated patent application based on an international application under section 16 of the Ordinance

- ~~(1) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance, the date of publication of the designated patent application based on an international application under section 16 of the Ordinance shall be—~~
- ~~(a) in the case of an international application designating the European Patent Office, the date of publication by the European Patent Office in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the European Patent Office;~~
 - ~~(b) in the case of an international application designating the United Kingdom Patent Office, the date of publication by the United Kingdom Patent Office in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the United Kingdom Patent Office;~~
 - ~~(c) in the case of an international application designating the State Intellectual Property Office as published by the International Bureau other than in the Chinese language, the date of publication by the State Intellectual Property Office in its Patent Gazette of the relevant bibliographical data showing that the international application has entered the national phase in the State Intellectual Property Office.~~
- ~~(2) (a) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance, the other date as referred to in section 16(a)(ii) of the Ordinance which is applicable to the case of an international application designating the State Intellectual Property Office as published by the International Bureau in the Chinese language is any date within 6 months after the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the State Intellectual Property Office.~~
- ~~(b) An application made within the date as set out in paragraph (a) shall be accompanied by a copy of the National Application Notification (國家申請號通知書).~~

(2 of 2001 s. 18)

16. Communication following examination on filing under section 17 of the Ordinance

- ~~(1) If a request to record fails to meet any of the requirements laid down in section 17 of the Ordinance, the Registrar shall communicate the disclosed deficiencies to the applicant and inform him that the request to record will not be dealt with as an application for a standard patent unless he remedies the disclosed deficiencies within 1 month of the date of the communication.~~
- ~~(2) If the applicant remedies the disclosed deficiencies within that period he shall be informed of the date of filing accorded to the request to record.~~

17. Rectification of deficiencies in request documents

- ~~(1) If on examination of a request to record under section 19(1) of the Ordinance he notes that there are deficiencies in the request which may be corrected, the Registrar shall inform the applicant by notice accordingly and shall invite him to remedy the deficiencies within a period of 2 months from the date of such notice.~~
- ~~(2) The Registrar may, upon request by the applicant presented before the expiry of such period and payment of the prescribed fee, grant an extension of that period for a further 2 months.~~
- ~~(3) If in any particular case the Registrar is satisfied that the applicant's failure to remedy the deficiencies within the period allowed under subsection (1) or (2) was wholly or mainly attributable to—~~
- ~~(a) a failure or undue delay in the postal services in Hong Kong or in the country, territory or area of the designated patent office; or~~
 - ~~(b) any natural disaster or strike in Hong Kong or in the country, territory or area of the designated patent office, the Registrar may grant such further extension of that period, not exceeding 2 months, as he considers reasonable.~~
- ~~(4) If the only deficiency in the request to record after the expiry of the periods specified in subsections (1), (2) and (3) (as may be applicable) is the failure to file a translation of the title of invention or abstract as referred to in section 56(2)(a) and (b) or a transliteration of the names of the applicant or inventor as referred to in section 56(2)(c), the Registrar may, on the request of the applicant, allow for a specified period within which the applicant may make good that deficiency on the payment of a penalty fee.~~

18. Request to record divisional designated patent application under section 22 of the Ordinance

- (1) A request to record a divisional designated patent application (*new request to record*) under section 22(1) of the Ordinance shall, except as mentioned below, be filed in accordance with section 15(2) of the Ordinance.
- (2) The relevant provisions of the Ordinance or these Rules concerning the filing date and compliance with the formalities shall be considered on the basis of the actual date of filing of the new request to record and not on the basis of the date of filing of the earlier request to record.
- (3) The provisions of sections 8 to 17 shall apply as if references in those sections to a designated patent application are references to a divisional designated patent application.
- (4) Where possible, the description and drawings of the earlier request to record and the new request to record shall respectively relate only to the matter for which protection is sought by that request to record; however where it is necessary for a request to record to describe the matter for which protection is sought by reference to another request to record, such reference shall include the application number assigned to that other request to record and shall indicate the matter for which protection is claimed in the other request to record.

Division 3

Request for Registration and Grant

(L.N. 150 of 2014)

19. Request for registration of designated patent and grant of patent under section 23(1) of the Ordinance

- (1) A request to register a designated patent and grant a patent for the invention shown in the specification of the designated patent under section 23(1) of the Ordinance ~~shall be in the specified form and be signed by the applicant, must be in the specified form.~~
- (2) Further to section 23(3) of the Ordinance—
 - (a) a copy of the document required under section 23(3)(a) of the Ordinance shall be filed in accordance with section 12 of these Rules; *(L.N. 37 of 2004)*
 - (b) the documents prescribed for the purposes of paragraph (b) of that subsection are those mentioned in section 20 of these Rules;
 - (c) the request shall also state—
 - (i) the publication number, application number and date of publication of the request to record;
 - (ii) the title of the invention;
 - (iii) the date of grant and publication number of the designated patent;
 - (d) the request shall contain such translation of documents and transliteration of names as may be required under section 56 of these Rules;
 - (e) the request shall contain a list of the documents comprising the request to register and an indication of the number of sheets of each such document.
- (3) The provisions of section 12 apply in relation to a request to register a designated patent and the grant of a patent under this section as they apply in relation to a request to record a designated patent application.

20. Documents supporting statement of derivation of entitlement to apply

For the purposes of section 23(3)(b) of the Ordinance, the documents to be filed in support of an applicant's statement explaining his entitlement to apply for the grant of a patent are such documents as suffice to establish that entitlement as set out in the statement.

21. Grace period

If a filing fee or an advertisement fee payable under section 23(5) of the Ordinance is not paid within the time limit specified in that section, it is to be regarded as having been paid within the time limit if it is paid, with an additional fee, within a grace period—

- (a) that is allowed by the Registrar by a notice given to the applicant; and
- (b) that—
 - (i) begins on the date of expiry of the time limit; and
 - (ii) ends at the expiry of 1 month after the date of the notice.

~~21. Period of grace~~

~~If the filing fee or advertisement fee payable under section 23(5) of the Ordinance has not been paid within the time provided for in that subsection, it may still be validly paid within a period of grace of 1 month after the sending by the Registrar to the applicant of a communication pointing out the failure to observe the time limit if, and only if, within this period an additional prescribed fee is paid.~~

22. Issue of receipt by Registrar

On first receipt of any of the documents comprising a request for registration and grant, the Registrar shall—

- (a) mark the documents with the date of their receipt by him; and
- (b) issue to the applicant a receipt which shows the application number assigned to the matter under section 14(b), the nature and number of the documents received and the date of receipt.

23. Communication following examination ~~on filing~~ under section 25(1) of the Ordinance

- (1) If a request for registration and grant fails to meet any of the requirements laid down in section 24(1) of the Ordinance, the Registrar shall communicate the disclosed deficiencies to the applicant and inform him of the consequences provided under section ~~25(3)(b)~~25(4) of the Ordinance in the event of a failure to remedy those deficiencies within 1 month of the date of the communication.
- (2) If the applicant remedies the disclosed deficiencies within that period, he shall be informed of the date of filing accorded to the request for registration and grant.

24. Correction of deficiencies in request for registration and grant

If an examination of a request for registration and grant under section 26(1) of the Ordinance reveals deficiencies in the request that may be corrected, the Registrar must, by notice given to the applicant, require the applicant to correct the deficiencies within 2 months after the date of the notice.

~~24. Rectification of deficiencies in request documents~~

- ~~(1) If on examination of a request for registration and grant under section 26(1) of the Ordinance he notes that there are deficiencies in the request which may be corrected, the Registrar shall inform the applicant by notice accordingly and shall invite him to remedy the deficiencies within a period of 2 months from the date of such notice.~~
- ~~(2) The Registrar may, upon request by the applicant presented before the expiry of such period and payment of the prescribed fee, grant an extension of that period for a further 2 months.~~
- ~~(3) If in any particular case the Registrar is satisfied that the applicant's failure to remedy the deficiencies within the period allowed under subsection (1) or (2) was wholly or mainly attributable to—
 - ~~(a) a failure or undue delay in the postal services in Hong Kong or in the country, territory or area of the designated patent office; or~~
 - ~~(b) any natural disaster or strike in Hong Kong or in the country, territory or area of the designated patent office, the Registrar may grant such further extension of that period, not exceeding 2 months, as he considers reasonable.~~~~
- ~~(4) If the only deficiency in the request for registration and grant after the expiry of the periods specified in subsections (1), (2) and (3) (as may be applicable) is the failure to file a translation of the title of invention as referred to in section 56(2)(a) and (b) or a transliteration of the names of the applicant or inventor as referred to in section 56(2)(c), the Registrar may, on the request of the applicant, allow for a specified period within which the applicant may make good that deficiency on the payment of a penalty fee.~~

25. Notice requesting reinstatement of an application under section 28 of the Ordinance

A notice under section 28 of the Ordinance requesting reinstatement of an application for a ~~standard patent~~standard patent (R) shall be in the specified form and shall be accompanied by the additional prescribed fee.

26. Application for restoration of rights under section 29 of the Ordinance

An application under section 29 of the Ordinance for restoration of rights lost in relation to an application for a ~~standard patent~~standard patent (R) shall be in the specified form and shall be accompanied by the additional prescribed fee.

Part 3

Provisions as to Applications for Standard Patents before Grant

(L.N. 150 of 2014)

Division 4—Provisions on Standard Patent (R) Applications before Grant

27. Amendment of application for ~~standard patent~~standard patent (R) under section 31 of the Ordinance

- (1) Any amendment under section 31 of the Ordinance to an application for a ~~standard patent~~standard patent (R) shall be made by way of application to the Registrar in the specified form.
- (2) An application for amendment—
 - (a) shall clearly identify the proposed amendment and state the reasons for it; or
 - (b) in the case of amendment to which section 31(2) of the Ordinance applies, shall be accompanied by a verified copy of the amendment made to the corresponding designated patent application and, where appropriate, a prescribed translation of that amendment.

28. Maintenance of application for ~~standard patent~~standard patent (R) under section 33 of the Ordinance

- (1) An application to maintain an application for a ~~standard patent~~standard patent (R) under section 33 of the Ordinance shall be in the specified form. *(L.N. 37 of 2004)*
- (2) Where the period specified in section 33(2) of the Ordinance for the making of a maintenance application in respect of a ~~patent~~standard patent (R) application has expired, the Registrar shall, not later than 6 weeks after the last date for making the maintenance application under that subsection and if the maintenance fee specified in that subsection remains unpaid, send to the applicant of the ~~patent~~standard patent (R) application a notice informing him that the period for making a maintenance application has expired and of the consequences of not making such an application and paying the fees specified in section 33(4) of the Ordinance.
- (3) Notice under subsection (2) shall be directed to—
 - (a) the address specified by the applicant of the maintenance application on payment of the last maintenance fee; or
 - (b) where another address has been notified to him for that purpose by the applicant of the maintenance application since the last maintenance, that address,or, in any other case, the address for service entered in the register.

29. ~~Rectification~~Correction of deficiencies and removal of doubts in maintenance documents

- ~~(1) If the Registrar—
 - (a) notes deficiencies in a maintenance application under section 33(2) of the Ordinance; or
 - (b) has reason to doubt the veracity of any statement in the maintenance application, he shall communicate those deficiencies or doubts to the applicant and inform him that the maintenance application shall be refused unless the applicant remedies the deficiencies or removes the doubts within a period of 2 months from the date of such communication.~~
- ~~(2) The Registrar may, upon request by the applicant presented before the expiry of such period and payment of the prescribed fee, grant an extension of that period for a further 2 months.~~
- (1) Subsection (2) applies if the Registrar—
 - (a) notes deficiencies in a maintenance application under section 33(2) of the Ordinance; or
 - (b) has reason to doubt the veracity of any statement in the application.

- ~~(2) The Registrar must, by notice given to the applicant, notify the applicant that unless the applicant corrects the deficiencies or removes the doubt, as the case requires, within 2 months after the date of the notice, the maintenance application is to be refused.~~
- ~~(3) If in any particular case the Registrar is satisfied that the applicant's failure to remedy the deficiencies or remove the doubts within the period allowed under subsection (1) or (2) was wholly or mainly attributable to—~~
- ~~(a) a failure or undue delay in the postal services in Hong Kong or in the country, territory or area of the designated patent office; or~~
- ~~(b) any natural disaster or strike in Hong Kong or in the country, territory or area of the designated patent office, the Registrar may grant such further extension of that period, not exceeding 2 months, as he considers reasonable.~~
- (4) If, upon consideration of the statements contained in a maintenance application, the Registrar is not satisfied that a case for maintenance under section 33 of the Ordinance has been made out, he shall notify the applicant accordingly and, unless within 1 month the applicant requests to be heard in the matter, the Registrar shall refuse the application.
- (5) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the maintenance application shall be allowed or refused.

30. Notification of deemed withdrawn application for ~~standard patent~~standard patent (R)

Where—

- (a) an application for a ~~standard patent~~standard patent (R) has been deemed to be withdrawn and abandoned because a maintenance fee has not been paid within the period specified in section 33(2) and (3) of the Ordinance; and
- (b) the extended period specified in section 33(4) of the Ordinance has expired without the maintenance fee and prescribed additional fee having been paid,

the Registrar shall, within 6 weeks after the expiration of the extended period, notify the applicant of the ~~standard patent~~standard patent (R) of the fact and draw his attention to the provisions of section 34 of the Ordinance.

31. Restoration of application for ~~standard patent~~standard patent (R) under section 34 of the Ordinance

- (1) An application to restore an application for a ~~standard patent~~standard patent (R) under section 34 of the Ordinance ~~shall be in the specified form and be signed by the applicant~~must be in the specified form.
- (2) The restoration application shall contain statements by the applicant in relation to matters relevant to the restoration of the application for a ~~standard patent~~standard patent (R) ~~including, but without limiting those matters, statements~~ indicating whether at the date of the restoration application—
- (a) the designated patent application is still valid or has been withdrawn; and
- (b) a patent has been granted in pursuance of that designated patent application and, if granted, the time for filing a request to register the designated patent and grant a patent under section 23 of the Ordinance has expired.

~~(2A) The applicant must file evidence with the Registrar to satisfy, for the purposes of section 34(3)(a) of the Ordinance, the Registrar that the applicant has taken all reasonable care required by the circumstances of the case.~~

~~(2B) If the application is not accompanied by the evidence required by subsection (2A), the Registrar must specify a period within which the evidence must be filed with the Registrar.~~

- (3) If, upon consideration of the statements and the evidence (if any) the Registrar is not satisfied that a case for an order under section 34 of the Ordinance has been made out, he shall notify the applicant accordingly and, unless within 1 month the applicant requests to be heard in the matter, the Registrar shall refuse the application.
- (4) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.
- ~~(5) If the Registrar decides to allow the application, he shall notify the applicant accordingly and require him, within 2 months after the date on which the notification is sent to him, to file an application in the form specified for the purposes of section 33(2) of the Ordinance, duly completed, accompanied by any unpaid maintenance fee and any additional fee prescribed for the purposes of section 33(4) of the Ordinance, upon receipt of which the Registrar shall order the restoration of the application for standard patent and shall advertise the fact of such order in the official journal. (2 of 2001 s. 19)~~

- (5) If the Registrar decides to allow the application, the Registrar must, by notice given to the applicant, require the applicant to file an application specified for the purposes of section 33(2) of the Ordinance within 2 months after the date of the notice.
- (6) The application must be—
 - (a) in the specified form; and
 - (b) accompanied by any unpaid maintenance fee and any additional fee prescribed for the purposes of section 33(4) of the Ordinance.
- (7) On receiving the application, the Registrar must—
 - (a) order the restoration of the standard patent (R) application; and
 - (b) advertise the fact of the order by notice in the official journal.

Part 3A Standard Patents by Original Grant

Division 1—Novelty and Priority

31A. Non-prejudicial disclosure under section 37B of Ordinance

The following constitute the written evidence prescribed for the purposes of section 37B(2)(b)(ii) of the Ordinance—

- (a) a certificate, issued by the authority responsible for holding the international exhibition referred to in that section, stating—
 - (i) that the invention was displayed at the exhibition; and
 - (ii) the date of the first disclosure of the invention at the exhibition; and
- (b) an identification of the invention duly authenticated by the authority.

31B. Restoration of priority right under section 37D of Ordinance

- (1) This section applies to a restoration application under section 37D of the Ordinance in relation to the priority right of a subsequent standard patent (O) application referred to in section 37D(1)(b) of the Ordinance.
- (2) A restoration application must be—
 - (a) in the specified form;
 - (b) accompanied by—
 - (i) a statement of priority referred to in section 37E(1) of the Ordinance;
 - (ii) evidence—
 - (A) to establish why the subsequent standard patent (O) application was not filed before the expiry of the period of 12 months referred to in section 37C(2) of the Ordinance; and
 - (B) to satisfy the Registrar that all reasonable care required by the circumstances of the case has been taken for the purposes of section 37D(5) of the Ordinance; and
 - (iii) the prescribed fee for the restoration application; and
 - (c) filed with the Registrar.
- (3) If the restoration application is not accompanied by the evidence required by subsection (2)(b)(ii), the Registrar must specify a period within which the evidence must be filed with the Registrar.
- (4) If there is any deficiency in the statement of priority filed, the Registrar must specify a period within which the deficiency must be corrected.
- (5) The restoration application is to be regarded as being withdrawn if—
 - (a) the evidence is not filed within the period specified under subsection (3); or
 - (b) the deficiency is not corrected within the period specified under subsection (4).
- (6) If the Registrar approves the restoration application, the following documents must be filed with the Registrar within a period specified by the Registrar—
 - (a) a copy of the patent application on the basis of which the priority right is restored (previous application); and
 - (b) a copy of the certificate (*certificate*) that—
 - (i) is issued by the authority that received the previous application; and

- (ii) states the date of filing of the previous application.
- (7) If the previous application is a Hong Kong application as defined by section 37A of the Ordinance, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time.
- (8) If the previous application or the certificate is in neither English nor Chinese—
- (a) sections 56(1) and 56A of these Rules apply to it; and
 - (b) the Registrar may make a requirement under section 56B(5) of these Rules in relation to it.
- (9) If a copy of the previous application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(5) of these Rules as applied by subsection (8) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.

31C. Claiming priority under section 37E of Ordinance

- (1) Subject to section 31D of these Rules, this section applies if—
- (a) an applicant of a standard patent (O) application (subsequent application) claims priority of a non-Hong Kong application or Hong Kong application (previous application) under section 37E of the Ordinance; and
 - (b) the date of filing of the subsequent application is within 12 months after the date of filing of the previous application.
- (2) The applicant must file with the Registrar—
- (a) a statement of priority; and
 - (b) the documents referred to in subsection (7).
- (3) A statement of priority must be filed with the Registrar in the specified form together with the subsequent application.
- (4) Despite subsection (3), if the conditions specified in subsection (5) are met, the statement of priority may be filed within 16 months after the earliest date of priority claimed.
- (5) The conditions are that—
- (a) the statement of priority is accompanied by the prescribed fee; and
 - (b) either one of the following—
 - (i) the applicant has not made a request under section 37Q(2) of the Ordinance for publication of the subsequent application;
 - (ii) if the applicant has made the request—the request is withdrawn before preparations for publication of the subsequent application are completed.
- (6) The statement of priority must state the following particulars of the previous application—
- (a) the date of filing;
 - (b) the application number;
 - (c) the country, territory or area in or for which the previous application was made.
- (7) The following documents must be filed with the Registrar within 16 months after the earliest date of priority claimed—
- (a) a copy of the previous application; and
 - (b) a copy of the certificate (certificate) that—
 - (i) is issued by the authority that received the previous application; and
 - (ii) states the date of filing of the previous application.
- (8) If the previous application is a Hong Kong application, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time.
- (9) If the previous application or the certificate is in neither English nor Chinese—
- (a) sections 56(1) and 56A of these Rules apply to it; and
 - (b) the Registrar may make a requirement under section 56B(5) of these Rules in relation to it.
- (10) If a copy of the previous application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(5) of these Rules as applied by subsection (9) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.
- (11) In this section—
- Hong Kong application** (香港申請) has the meaning given by section 37A of the Ordinance;
- non-Hong Kong application** (非香港申請) has the meaning given by section 37A of the Ordinance.

31D. Claiming priority for divisional standard patent (O) application

- (1) This section applies if—
- (a) an earlier standard patent (O) application referred to in section 37Z(1)(a) of the Ordinance has been filed;
and
 - (b) the applicant or the applicant’s successor in title files a new application referred to in section 37Z(1)(b) of the Ordinance that meets the conditions specified in section 37Z(3) of the Ordinance.
- (2) A right of priority that has not been claimed for the earlier standard patent (O) application may not be claimed for the new application.

Division 2—Right to Apply

Subdivision 1—Reference to Registrar on Question as to who may Apply

31E. Interpretation

In this Subdivision—

additional recipient (額外收件人)—see section 31F(4)(a) of these Rules;

counter-statement (反陳述)—see section 31G(1) of these Rules;

opponent (反對人)—see section 31G(1) of these Rules;

recipient (收件人)—see section 31F(2)(a) of these Rules;

reference (轉介) means the reference of a question to the Registrar under section 37H(1)(a) or (b) of the Ordinance;

referrer (轉介人) means a person who makes a reference;

statement (陳述書)—see section 31F(1)(b)(i) of these Rules.

31F. Reference

- (1) A reference must be—
- (a) in the specified form;
 - (b) accompanied by—
 - (i) a statement setting out—
 - (A) the nature of the question being referred;
 - (B) the facts on which the referrer relies; and
 - (C) the order or relief sought; and
 - (ii) the prescribed fee for the reference; and
 - (c) filed with the Registrar.
- (2) A referrer who files a reference must, at the same time—
- (a) send a copy of the reference and statement to each person who meets the conditions specified in subsection (3) (recipient);
 - (b) attach to each copy of the reference and statement a list of the names and addresses of all recipients; and
 - (c) notify the Registrar in writing of those names and addresses.
- (3) The conditions are that—
- (a) the person is not a party to the reference;
 - (b) for a reference under section 37H(1)(a) of the Ordinance, the person is—
 - (i) alleged in the reference to be entitled to apply for the grant of a standard patent (O) for the invention that is the subject of the reference; or
 - (ii) believed by the referrer to be the inventor or a joint inventor of the invention;
 - (c) for a reference under section 37H(1)(b) of the Ordinance, the person is—
 - (i) a joint proprietor of the application who has not otherwise indicated the joint proprietor’s consent to the making of the order, or the granting of the relief, sought in the reference; or
 - (ii) a person—
 - (A) to whom it is alleged in the reference that any right in or under the application should be transferred or granted; or
 - (B) whom the referrer believes to be the inventor or a joint inventor of the invention; and
 - (d) for a reference filed after the application has been published, the person is shown in the register as having a right in or under the application.

- (4) If the reference is filed before the standard patent (O) application has been published, the Registrar must—
- (a) send a copy of the reference and statement to each person who meets the conditions specified in subsection (5) (*additional recipient*); and
 - (b) send a list of the names and addresses of all recipients and additional recipients to—
 - (i) the referrer;
 - (ii) each recipient; and
 - (iii) each additional recipient.
- (5) The conditions are that—
- (a) the person is not a party to the reference;
 - (b) the person is not a recipient; and
 - (c) the person—
 - (i) is an applicant of the standard patent (O) application; or
 - (ii) has a right in or under the application as shown on an application to register, or a notice of, a transaction, instrument or event in relation to the application referred to in section 46(1) of these Rules.

31G. Counter-statement

- (1) A recipient or an additional recipient who receives a copy of a reference and statement under section 31F(2) or (4) of these Rules and intends to oppose the making of the order, or granting of the relief, sought in the reference (*opponent*) may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 3 months after the date on which the copy of the reference is received by the opponent.
- (3) The counter-statement must—
- (a) be in the specified form;
 - (b) set out the grounds of opposition; and
 - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) An opponent who files a counter-statement must, at the same time, send a copy of it to—
- (a) the referrer;
 - (b) the recipient—
 - (i) who is not the opponent; and
 - (ii) whose name and address appear in the list mentioned in section 31F(2)(b) or (4)(b) of these Rules; and
 - (c) the additional recipient—
 - (i) who is not the opponent; and
 - (ii) whose name and address appear in the list mentioned in section 31F(4)(b) of these Rules.

31H. Evidence

- (1) A person referred to in section 31G(4)(a), (b) or (c) of these Rules may file evidence in support of the referrer's case.
- (2) On filing evidence under subsection (1), a person referred to in section 31G(4)(b) or (c) of these Rules joins as a party to the reference.
- (3) The evidence must be filed with the Registrar within 3 months after the date on which the last copy of the counter-statement is received by the person.
- (4) A person who files evidence under subsection (1) must, at the same time, send a copy of it to—
- (a) the opponent; and
 - (b) if the person is not the referrer—the referrer.
- (5) The opponent may file evidence in support of the opponent's case.
- (6) The opponent's evidence must be filed with the Registrar—
- (a) if a copy of evidence has been sent under subsection (4)(a)—within 3 months after the date on which the last copy of the evidence is received by the opponent under that subsection; or
 - (b) if no copy of evidence has been sent under subsection (4)(a)—within 3 months after the time when a copy of evidence is required to be sent under that subsection.
- (7) An opponent who files evidence under subsection (5) must, at the same time, send a copy of it to—
- (a) the referrer; and
 - (b) any other person who has filed evidence under subsection (1).

- (8) Subject to subsection (10), the referrer and the other person may file further evidence in reply to the opponent's evidence filed under subsection (5) within 3 months after the date on which the last copy of the opponent's evidence is received by the referrer and the other person under subsection (7).
- (9) A person who files further evidence under subsection (8) must, at the same time, send a copy of it to—
- (a) the opponent; and
 - (b) if the person is not the referrer—the referrer.
- (10) No further evidence may be filed except with the leave granted by, or at the direction of, the Registrar.
- (11) The Registrar may, on the initiative of the Registrar or on application of a party to the reference, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

Subdivision 2—Application to Registrar in relation to Directions Given by Registrar or Court

31I. Application to Registrar under section 37I(4) of Ordinance

- (1) This section applies to an application made by person B under section 37I(4) of the Ordinance in relation to the directions given to person A under section 37I(1)(d)(ii) of the Ordinance.
- (2) The application must be—
- (a) in the specified form;
 - (b) accompanied by—
 - (i) a statement setting out—
 - (A) the facts on which the applicant relies; and
 - (B) the nature of the authorization sought; and
 - (ii) the prescribed fee for the application; and
 - (c) filed with the Registrar.
- (3) Person B must, when the application is filed, send a copy of the application and statement to person A.
- (4) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.
- (5) In this section—
- person A (後者) has the meaning given by section 37I(4) of the Ordinance;
- person B (前者) has the meaning given by section 37I(4) of the Ordinance.

Subdivision 3—New Standard Patent (O) Application under Section 37J(2) of Ordinance and Existing Standard Patent (O) Application Referred to in Section 37K(2) of Ordinance

31J. Registrar's notice to applicant and licensee of order under section 37J(2) of Ordinance or referred to in section 37K(2) of Ordinance and request for licence under section 37K(5)(b) of Ordinance

- (1) If a specified order is made in relation to a standard patent (O) application, the Registrar must, by notice given to each of the persons specified in subsection (2), notify the persons of the order.
- (2) The persons are—
- (a) the applicant of the earlier application referred to in section 37J(1)(a) of the Ordinance;
 - (b) the original applicant referred to in section 37K(2) of the Ordinance; and
 - (c) the licensee of the applicant referred to in paragraph (a) or (b) whom the Registrar is aware of when the notice is given.
- (3) A request for licence under section 37K(5)(b) of the Ordinance may be made—
- (a) by the applicant of the earlier application within 2 months after the date of the notice given to the applicant;
 - (b) by the original applicant within 2 months after the date of the notice given to the original applicant; or
 - (c) by the licensee within 4 months after the date of the notice given to the licensee.
- (4) In subsection (1)—

specified order (指明命令) means—

(a) an order made under section 37J(2) of the Ordinance; or

(b) an order referred to in section 37K(2) of the Ordinance.

Subdivision 4—Reference to Registrar in relation to Licence to Continue Working or to Work on Invention

31K. Reference

(1) A person (referrer) may make a reference to the Registrar under section 37K(7) of the Ordinance in relation to a licence (reference) after the making of—

(a) an order under section 37J(2) of the Ordinance; or

(b) an order referred to in section 37K(2) of the Ordinance.

(2) A licence for the purposes of subsection (1) is a licence under section 37K(3) or (4) of the Ordinance to continue working or to work, as the case requires, the invention that is the subject of—

(a) a new standard patent (O) application made in accordance with the order referred to in subsection (1)(a); or

(b) a standard patent (O) application that is to proceed in accordance with the order referred to in subsection (1)(b).

(3) A reference must be—

(a) in the specified form;

(b) accompanied by—

(i) a statement setting out—

(A) the facts on which the referrer relies; and

(B) the period and terms of the licence that the referrer is prepared to grant or accept; and

(ii) the prescribed fee for the reference; and

(c) filed with the Registrar.

(4) A referrer who files a reference must, at the same time, send a copy of the reference and statement to each person who meets the conditions specified in subsection (5).

(5) The conditions are that—

(a) the person is not the referrer; and

(b) the person—

(i) is the one in whose name the new standard patent (O) application is made or the standard patent (O) application is to proceed; or

(ii) claims to be entitled to be granted a licence.

31L. Counter-statement

(1) A person who receives a copy of a reference under section 31K(4) of these Rules and does not agree to grant or accept the licence for the period or on the terms set out in the statement (opponent) may file a counter-statement with the Registrar.

(2) The counter-statement must be filed within 3 months after the date on which the copy of the reference is received by the opponent.

(3) The counter-statement must—

(a) be in the specified form;

(b) set out the grounds of disagreement; and

(c) be accompanied by the prescribed fee for the counter-statement.

(4) An opponent who files a counter-statement must, at the same time, send a copy of it to the referrer referred to in section 31K(1) of these Rules.

(5) The Registrar may, on the initiative of the Registrar or on application of a party to the reference, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

Division 3—Applications for Standard Patents (O)

31M. Standard patent (O) application under section 37L of Ordinance

- (1) A standard patent (O) application under section 37L of the Ordinance must be in the specified form.
- (2) The specification referred to in section 37L(2)(b) of the Ordinance must—
 - (a) state the title of the invention that is the subject of the application; and
 - (b) include—
 - (i) a description of the invention;
 - (ii) at least one claim; and
 - (iii) drawings referred to in the description or the claim or claims, if any.
- (3) The title of the invention must be short and indicate the matter to which the invention relates.
- (4) A standard patent (O) application under section 37L of the Ordinance must contain—
 - (a) the name and address of the inventor or inventors;
 - (b) a list of the documents comprising the application;
 - (c) an indication of the number of sheets of each of the documents;
 - (d) the translation of documents and transliteration of names required by the Registrar under sections 56, 56A and 56B(3) of these Rules;
 - (e) for the purposes of a claim regarding a disclosure that was due to, or in consequence of, the condition referred to in section 37B(2)(b)(ii) of the Ordinance—
 - (i) a statement referred to in section 37B(3)(a) of the Ordinance; and
 - (ii) the prescribed written evidence referred to in section 31A of these Rules in support of the statement;
 - (f) for the purposes of a claim for priority of a previous application under section 37E of the Ordinance—the documents required under section 31C(2) of these Rules and the documents required by application of section 31C(9) of these Rules, as the case requires; and
 - (g) for the purposes of a reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance for compliance with section 37L(2)(b) of the Ordinance—the documents required under section 31W(3) of these Rules and the documents required by application of section 31W(5) of these Rules, as the case requires.
- (5) For section 37L(5) and (6) of the Ordinance, the filing fee and advertisement fee must be paid to the Registrar—
 - (a) no later than 1 month after the date of receipt referred to in section 31U(c)(iii) of these Rules; or
 - (b) if the fee is not paid within the time limit specified in paragraph (a)—with an additional fee within a grace period—
 - (i) that is allowed by the Registrar by a notice given to the applicant; and
 - (ii) that—
 - (A) begins on the date of expiry of the time limit; and
 - (B) ends at the expiry of 1 month after the date of the notice.

31N. Description

- (1) This section applies to a description referred to in section 37L(2)(b)(i) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The description must—
 - (a) specify the technical field to which the invention relates;
 - (b) indicate the background art that, as far as known to the applicant, can be regarded as useful for understanding the invention;
 - (c) preferably, cite the documents reflecting the background art;
 - (d) disclose the invention in a way that the following can be understood—
 - (i) the technical problem to which the invention relates (even if not so expressly stated); and
 - (ii) the solution to the problem;
 - (e) state any advantageous effects of the invention with reference to the background art;
 - (f) briefly describe the figures in the drawings referred to in the description, if any;
 - (g) describe in detail at least one way of carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
 - (h) indicate the way in which the invention is industrially applicable, if it is not obvious from the description or nature of the invention.

(3) The description must be presented in the manner and order specified in subsection (2) unless not doing so is conducive to a better understanding of the invention because of its nature and a more economical presentation.

310. Drawings referred to in description

(1) This section applies to the drawings referred to in the description under section 37L(2)(b)(iii) of the Ordinance of an invention that is the subject of a standard patent (O) application.

(2) The drawings—

(a) must be on sheets each of which—

(i) has an usable surface area not exceeding 26.2 cm × 17 cm;

(ii) does not contain frames round the usable or used surface; and

(iii) has the following minimum margins—

(A) from the top—2.5 cm;

(B) from the left—2.5 cm;

(C) from the right—1.5 cm; and

(D) from the bottom—1 cm; and

(b) must be executed in the following manner—

(i) executed without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;

(ii) the cross-sections, if any, contained in the drawings must be indicated by hatching that does not impede the clear reading of the reference signs and leading lines;

(iii) the scale and distinctness of graphical execution must enable all details of the drawings to be distinguished without difficulty in a photographic reproduction of the drawings with a linear reduction in size to two-thirds of the drawings;

(iv) if, as an exception, a scale is given, the scale must be represented graphically;

(v) all numbers, letters and reference signs must be simple and clear;

(vi) brackets, circles and inverted commas must not be used in association with numbers, letters and characters;

(vii) all lines must ordinarily be drawn with the aid of drafting instruments;

(viii) elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;

(ix) the height of the numbers, letters and characters must not be less than 0.32 cm;

(x) the lettering must be in—

(A) Latin alphabets; and

(B) if customary—Greek alphabets or Chinese characters, as appropriate;

(xi) if the same sheet of drawings contains several figures, the figures must be—

(A) arranged without wasting space and clearly separated from one another; and

(B) numbered consecutively in Arabic numerals, independently of the numbering of the sheets;

(xii) if the figures drawn on 2 or more sheets are intended to form one whole figure, the figures on the sheets must be so arranged that the whole figure can be assembled without concealing any part of the partial figures;

(xiii) reference signs not mentioned in the description and claims must not appear;

(xiv) reference signs not mentioned in the drawings must not appear in the description and claims;

(xv) the same features, when denoted by reference signs, must be denoted by the same signs throughout the application;

(xvi) the drawings must not contain any textual matter, except—

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

Example—

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

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

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

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

(xvii) the sheets of the drawings must be numbered in accordance with section 31Q(3)(d)(ii) of these Rules.

(3) In this section—

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

Note—

Section 31Q(13) of these Rules provides for exemption from this section.

31P. Abstract

(1) This section applies to an abstract referred to in section 37L(2)(c) of the Ordinance of an invention that is the subject of a standard patent (O) application.

(2) The abstract must—

(a) begin with the title of the invention;

(b) contain a concise summary of the matters contained in the specification referred to in section 37L(2)(b) of the Ordinance;

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

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

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

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

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

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

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

(ii) the gist of the solution to the problem through the invention; and

(iii) the principal use or uses of the invention.

(4) If the specification provides for drawings—

(a) the applicant must indicate in the abstract any figure or, exceptionally, figures in the drawings that the applicant suggests should accompany the abstract when it is published;

(b) if the Registrar considers that any other figure or figures better characterizes the invention—the Registrar may decide to publish the other figure or figures; and

(c) each main feature of the invention stated in the abstract and illustrated by a drawing must be followed by the reference sign relating to the feature used in that drawing, placed between parentheses.

31Q. Size and presentation of documents

(1) This section applies to the documents comprising a standard patent (O) application to be filed under section 37L(1)(b) of the Ordinance.

(2) Each of the documents must be presented in a manner that it may be—

(a) reproduced in an unlimited number of copies by photography, photocopying processes, photo offset and micro-filming; and

(b) scanned by a device capable of capturing an image of the document and converting the image into a form suitable for storage on, and retrieval by, a computer.

(3) Each of the documents must—

(a) be free from cracks, creases and folds;

(b) be single-sided;

(c) be on A4 papers (29.7 cm × 21 cm) that are pliable, strong, white, smooth, matt and durable; and

(d) not share a sheet with another document and the sheets comprising the document must be—

(i) connected in a way that the sheets can easily be turned over, separated and combined again; and

(ii) numbered in consecutive Arabic numerals.

(4) The description, claims and abstract—

(a) must not contain drawings;

(b) may contain chemical or mathematical formulae;

(c) subject to subsection (5)—may contain tables; and

(d) subject to subsection (6)—must be typed or printed.

(5) The claims may contain tables only if their subject matter makes the use of tables desirable.

(6) If necessary, graphic symbols and chemical or mathematical formulae may be drawn or written by hand.

- (7) All textual matters in the description, claims and abstract must be in black and indelible.
- (8) The tables and chemical or mathematical formulae—
- (a) subject to paragraph (b)—must be presented in an upright position on a sheet; and
 - (b) if they cannot be presented satisfactorily in an upright position on a sheet—may be presented sideways on the sheet in a way that the top of the tables or formulae are at the left side of the sheet.
- (9) In the documents—
- (a) weights and measures must be expressed in metric units, whether or not they are also expressed in other units;
 - (b) other physical values must be expressed in the units recognized in international practice;
 - (c) chemical or mathematical formulae must be stated by employing the symbols, atomic weights and molecular formulae in general use; and
 - (d) technical terms, signs and symbols generally accepted in the field in question must generally be used.
- (10) If a formula or symbol is used in the specification, a copy of the specification, prepared in the same manner as drawings, must be furnished if the Registrar so directs.
- (11) Terminology and signs must be consistent throughout the application.
- (12) All documents must be—
- (a) legible; and
 - (b) reasonably free from deletions and other alterations, overwritings and interlineations.
- (13) The Registrar may exempt any document from any requirement under this section and section 31O of these Rules if—
- (a) the authenticity of the content of the document is not in question and the requirements for good reproduction are not in jeopardy; or
 - (b) the Registrar considers that there are other circumstances that justify the exemption.

31R. Form of statements, counter-statements and evidence

Subject to the Registrar's direction, any statement, counter-statement or evidence to be filed with the Registrar must comply with the requirements under section 31Q(2) and (3)(c) of these Rules.

31S. Claims

- (1) This section applies to the claims referred to in section 37L(2)(b)(ii) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The claims must define the matter for which protection is sought in terms of the technical features of the invention.
- (3) If appropriate, an independent claim must contain—
- (a) a statement indicating the designation of the subject matter of the invention and technical features that are necessary for the definition of the claimed subject matter but the features, in combination, are part of the prior art; and
 - (b) a characterizing portion, preceded by the expression “characterized in that” or “characterized by” or the equivalent Chinese characters, as appropriate, stating the technical features that, in combination with the technical features referred to in paragraph (a), the claim seeks to protect.
- (4) An independent claim stating the essential features of an invention may be followed by one or more dependent claims concerning particular embodiments of the invention (*dependent claim*).
- (5) A dependent claim that includes all the features of any other claim—
- (a) must contain a reference to that other claim, at the beginning if possible;
 - (b) must state the additional features that the dependent claim seeks to protect; and
 - (c) is admissible even if it directly refers to another claim that is also a dependent claim.
- (6) Dependent claims referring to a single or several previous claims must be grouped together according to the previous claims in the most appropriate way.
- (7) The number of the claims must, having regard to the nature of the invention claimed, be reasonable.
- (8) If there are 2 or more claims, the claims must be numbered consecutively in Arabic numerals.
- (9) A claim must not rely—
- (a) on references to the description or drawings in respect of the technical features of the invention unless it is absolutely necessary; and

- (b) in particular, on the following references or references similar to the following references—
 - (i) “as described in part ... of the description”;
 - (ii) “as illustrated in figure ... of the drawings”;
 - (iii) “如說明第.....部分所描述”; or
 - (iv) “如繪圖的附圖.....所示”.

(10) For an application that contains drawings, the technical features stated in the claims must preferably be followed by the reference signs relating to the features used in the drawings, if doing so makes the claims easier to understand.

(11) The reference signs—

- (a) must be placed between parentheses; and
- (b) are not to be construed as limiting the claims.

31T. Statement under section 37L(3)(c) of Ordinance

The Registrar must send a copy of the statement referred to in section 37L(3)(c) of the Ordinance contained in a standard patent (O) application to each inventor of the relevant invention who is not an applicant.

31U. Registrar to issue receipt for documents

On the first receipt of any of the documents comprising a standard patent (O) application, the Registrar must—

- (a) mark the date of receipt on the documents;
- (b) assign an application number to the application; and
- (c) issue to the applicant a receipt that sets out—
 - (i) the application number;
 - (ii) the nature and number of the documents; and
 - (iii) the date of receipt.

31V. Notice after examination of minimum requirement under section 37M of Ordinance

- (1) If a standard patent (O) application complies with the requirement specified in section 37M(3) of the Ordinance (*minimum requirement*), the Registrar must, by notice given to the applicant, notify the applicant of the date on which the minimum requirement is complied with.
- (2) If the application does not comply with the minimum requirement, the Registrar must, by notice given to the applicant, notify the applicant—
 - (a) of the deficiencies in the application as regards the non-compliance with the minimum requirement; and
 - (b) that unless the applicant corrects the deficiencies within 2 months after the date of the notice, the application is not to be dealt with as a standard patent (O) application.
- (3) If the applicant corrects the deficiencies within the period referred to in subsection (2)(b), the Registrar must, by notice given to the applicant, notify the applicant of the date on which the minimum requirement is complied with.

31W. Requirements for making reference to earlier specified application referred to in section 37M(3)(c)(ii) of Ordinance

- (1) This section applies if a standard patent (O) application contains a purported reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance.
- (2) For the purposes of the minimum requirement under section 37M(3) of the Ordinance, a reference to an earlier specified application is not to be regarded as having been made unless the reference states—
 - (a) the date of filing of the earlier specified application;
 - (b) the application number of the earlier specified application; and
 - (c) the country, territory or area in or for which the earlier specified application was made.
- (3) The applicant must file the following documents with the Registrar within 4 months after the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with—
 - (a) a copy of the earlier specified application; and
 - (b) a copy of the certificate issued by the authority that received the earlier specified application (*certificate*).

- (4) If the earlier specified application is an application made under the Ordinance, the copies referred to in subsection (3)(a) and (b) are to be regarded as having been filed in due time.
- (5) If the earlier specified application or the certificate is in neither English nor Chinese, sections 56(1), 56A and 56B(3) of these Rules apply to it.
- (6) If a copy of the earlier specified application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(3) of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.

31X. Filing for purposes of section 37N of Ordinance

- (1) If a missing description or missing drawing is required by a notice under section 37N(1) of the Ordinance to be filed—
- (a) it must be filed within 2 months after the date of the notice; and
- (b) the previous application documents must be filed for the purposes of section 37N(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (2) If a missing description or missing drawing is to be filed on an applicant's own initiative under section 37N(2) of the Ordinance—
- (a) it must be filed within 2 months after the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with; and
- (b) the previous application documents must be filed for the purposes of section 37N(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (3) No notice is to be sent by the Registrar under section 37N(1) of the Ordinance after the Registrar is satisfied that the standard patent (O) application complies with the formal requirements under section 37P(1) of the Ordinance.
- (4) If the previous application referred to in section 37N(5)(a) of the Ordinance is an application made under the Ordinance, a copy of the previous application is to be regarded as having been filed in due time for the purposes of section 37N(5)(d) of the Ordinance.
- (5) If the previous application is in neither English nor Chinese, sections 56A and 56C of these Rules apply to it.
- (6) If a copy of the previous application or the translation required by sections 56A and 56C of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.
- (7) In this section—
- missing description* (欠交說明) has the meaning given by section 37N(6) of the Ordinance;
- missing drawing* (欠交繪圖) has the meaning given by section 37N(6) of the Ordinance;
- previous application documents* (過往申請的文件) means—
- (a) the copy of the previous application referred to in section 37N(5)(d)(i) of the Ordinance; and
- (b) the statement referred to in section 37N(5)(d)(iii) of the Ordinance indicating which part of the previous application represents the description or drawing that is missing in the standard patent (O) application.

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

31Y. Correction of deficiencies in standard patent (O) application as regards formal requirements

- (1) If an examination under section 37P(1) of the Ordinance reveals deficiencies in a standard patent (O) application as regards the formal requirements within the meaning of that section, the Registrar must, by notice given to the applicant—
- (a) notify the applicant of the deficiencies; and
- (b) require the applicant to correct the deficiencies within 2 months after the date of the notice.
- (2) If the application is refused or is to be regarded as being withdrawn under section 37P(2) or (4) of the Ordinance, the Registrar must, by notice given to the applicant—
- (a) notify the applicant of the refusal or withdrawal; and
- (b) give the reasons for the refusal or withdrawal.

31Z. Time for publication of standard patent (O) application

- (1) The prescribed time referred to in section 37Q(1)(a) of the Ordinance in relation to the publication of a standard patent (O) application is—
- (a) if there is no claim for priority—18 months after the date of filing of the application; or
 - (b) if there is a claim for priority—18 months after the earliest date of priority claimed.
- (2) For the purposes of section 37Q(1)(a) and (2) of the Ordinance, the Registrar must—
- (a) determine the date on which preparations for publication are to be regarded as having been completed; and
 - (b) notify the applicant of the determination by notice given to the applicant as soon as practicable after determining the date.

31ZA. Observations by third parties

- (1) This section applies to a notice referred to in section 37R(1) of the Ordinance of a person's observations on the patentability of an invention that is the subject of a standard patent (O) application.
- (2) The notice must be filed with the Registrar during the following period—
- (a) after the date of publication of the application under section 37Q of the Ordinance; and
 - (b) before one of the following dates, as appropriate—
 - (i) the date on which the Registrar gives notice of the Registrar's determination under section 31ZP(2) of these Rules;
 - (ii) the date on which the Registrar gives the final refusal notice in relation to the standard patent (O) application referred to in section 31ZN(2) of these Rules;
 - (iii) if the standard patent (O) application has not been subsequently reinstated or restored under section 37ZD of the Ordinance—the date on which the standard patent (O) application is withdrawn or is to be regarded as being withdrawn.
- (3) Section 37R(3) of the Ordinance does not apply to a notice that, in the opinion of the Registrar, would—
- (a) disparage any person in a way likely to damage the person; or
 - (b) be generally expected to encourage any offensive, immoral or anti-social behaviour.

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

31ZB. Interpretation

In this Division—

examination notice (審查通知)—see section 31ZD of these Rules;

examination requirement (審查規定) has the meaning given by section 37S of the Ordinance;

final refusal notice (最終拒絕通知)—see section 31ZN(2) of these Rules;

further examination notice (進一步審查通知)—see section 31ZF(2) of these Rules;

further review opinion (進一步覆核意見)—see section 31ZL(2) of these Rules;

provisional refusal notice (暫定拒絕通知)—see section 31ZH(2) of these Rules;

request to review (覆核請求)—see section 31ZI(1) of these Rules;

response to examination notice (審查通知的回應)—see section 31ZE(1) of these Rules;

response to further examination notice (進一步審查通知的回應)—see section 31ZG(1) of these Rules;

response to further review opinion (進一步覆核意見的回應)—see section 31ZM(1) of these Rules;

response to review opinion (覆核意見的回應)—see section 31ZK(1) of these Rules;

review opinion (覆核意見)—see section 31ZJ of these Rules;

substantive examination (實質審查) means an examination under section 37U(2) of the Ordinance.

31ZC. Request for substantive examination

- (1) A request made for substantive examination of a standard patent (O) application under section 37T(1) of the Ordinance must be—
- (a) in the specified form; and

- (b) filed with the Registrar.
- (2) The prescribed time referred to in section 37T(2)(a) of the Ordinance is—
- (a) for a standard patent (O) application that is not a specified new application—3 years after the material date of the application;
 - (b) for a specified new application the fulfilment date of which is not less than 2 months before the expiry of the period of 3 years after the material date of the earlier application—3 years after the material date of the earlier application (3-year period);
 - (c) for a specified new application the fulfilment date of which is less than 2 months before the expiry of the 3-year period—2 months after the fulfilment date of the new application; or
 - (d) for a specified new application the fulfilment date of which is on or after the date of expiry of the 3-year period—2 months after the fulfilment date of the new application.
- (3) The prescribed fee for the request must be paid to the Registrar no later than 1 month after the date of the request.
- (4) If the prescribed fee is not paid within the time limit specified in subsection (3), it is to be regarded as having been paid within the time limit if it is paid within a grace period—
- (a) that is allowed by the Registrar by a notice given to the applicant; and
 - (b) that—
 - (i) begins on the date of expiry of the time limit; and
 - (ii) ends at the expiry of 1 month after the date of the notice.
- (5) In this section—
- earlier application*** (較早申請) means an earlier application referred to in section 37J(1)(a) or 37Z(1)(a) of the Ordinance, or an application under section 55(4) of the Ordinance to which the reference under section 55(1) of the Ordinance relates, as the case requires;
- fulfilment date*** (符合日期) means the date—
- (a) on which the minimum requirement under section 37M(3) of the Ordinance is complied with; and
 - (b) notified to the applicant by a notice under section 31V(1) or (3) of these Rules;
- material date*** (關鍵日期) has the meaning given by section 2(1) of the Ordinance;
- specified new application*** (指明新申請) means a new standard patent (O) application referred to in section 37J(2)(a) or 37Z(1)(b) of the Ordinance, or a new application referred to in section 55(4) of the Ordinance, as the case requires.

31ZD. Examination notice

If the Registrar gives a notice under section 37V(1) of the Ordinance in respect of a standard patent (O) application (*examination notice*), the Registrar must, in that notice, state that the applicant may respond to that notice in accordance with section 31ZE(1) of these Rules.

31ZE. Response to examination notice

- (1) A response to an examination notice to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (*response to examination notice*) must be filed by the applicant with the Registrar within 4 months after the date of the notice.
- (2) If the applicant fails to comply with the requirement under subsection (1), the standard patent (O) application is to be regarded as being withdrawn.

31ZF. Further examination notice

- (1) This section applies if—
 - (a) the applicant of a standard patent (O) application files a response to examination notice in accordance with section 31ZE(1) of these Rules; and
 - (b) the Registrar has considered the response.
- (2) The Registrar may, by notice given to the applicant under section 37V(1) of the Ordinance (*further examination notice*)—
 - (a) set out any matter covered in the response to examination notice in respect of which the Registrar considers that elaboration, revision or clarification is required; and

- (b) state that the applicant may file a further response in relation to the matter in accordance with section 31ZG(1) of these Rules to elaborate on, revise or clarify the matter.
- (3) The Registrar may give further examination notice more than once.

31ZG. Response to further examination notice

- (1) A response to a further examination notice to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (*response to further examination notice*) must be filed by the applicant with the Registrar within 4 months after the date of the notice.
- (2) If the applicant fails to comply with the requirement under subsection (1), the standard patent (O) application is to be regarded as being withdrawn.
- (3) Section 31ZF of these Rules applies in relation to a response to further examination notice as if—
 - (a) the words “a response to examination notice in accordance with section 31ZE(1)” in section 31ZF(1)(a) of these Rules were substituted by the words “a response to further examination notice in accordance with section 31ZG(1)”; and
 - (b) the words “the response to examination notice” in section 31ZF(2)(a) of these Rules were substituted by the words “the response to further examination notice”.

31ZH. Provisional refusal notice

- (1) If the Registrar, having considered—
 - (a) a response to examination notice; and
 - (b) a response to further examination notice, if any,is of the opinion that the standard patent (O) application does not comply with the examination requirement concerned, the Registrar may make a provisional decision of refusal to grant the standard patent (O).
- (2) If the Registrar makes a provisional decision, the Registrar must, by notice given to the applicant (*provisional refusal notice*)—
 - (a) notify the applicant of the decision;
 - (b) set out the examination requirement concerned; and
 - (c) state that the applicant may respond to the provisional refusal notice by filing a request to review the Registrar’s opinion under section 37V(3)(c) of the Ordinance in accordance with section 31ZI(1) and (2) of these Rules.

31ZI. Request to review

- (1) A request to review the Registrar’s opinion under section 37V(3)(c) of the Ordinance (*request to review*) must be filed by the applicant with the Registrar within 2 months after the date of the provisional refusal notice.
- (2) A request to review must be—
 - (a) in the specified form; and
 - (b) accompanied by the prescribed fee for the request.
- (3) A request to review may contain either or both of the following—
 - (a) a representation to establish that the standard patent (O) application complies with the examination requirement concerned;
 - (b) a request to amend the application under section 31ZT of these Rules to achieve compliance with that requirement.
- (4) A request to review that does not comply with the requirements under subsection (1) or (2) is to be regarded as not having been made.
- (5) If no request to review is filed, the Registrar must—
 - (a) make a final decision of refusal to grant the standard patent (O); and
 - (b) give the applicant a final refusal notice.

31ZJ. Review opinion

If the Registrar, having considered a request to review, is of the opinion that the standard patent (O) application does not comply with the examination requirement concerned (*review opinion*), the Registrar must, by notice given to the applicant—

- (a) notify the applicant of the review opinion;
- (b) set out the examination requirement concerned;
- (c) state that the applicant may file a response to the review opinion in accordance with section 31ZK(1) of these Rules; and
- (d) if the Registrar thinks fit, and if applicable—state that the applicant may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(a) of these Rules.

31ZK. Response to review opinion

- (1) A response to a review opinion to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (*response to review opinion*) must be filed by the applicant with the Registrar within 2 months after the date of the review opinion.
- (2) If the review opinion states that the applicant may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(a) of these Rules.
- (3) A request for hearing must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (4) If no response to review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
 - (a) make a final decision of refusal to grant the standard patent (O); and
 - (b) give the applicant a final refusal notice.

31ZL. Further review opinion

- (1) This section applies if—
 - (a) the Registrar has considered—
 - (i) a request to review filed by the applicant of a standard patent (O) application in accordance with section 31ZI(1) and (2) of these Rules; and
 - (ii) a response to review opinion filed by the applicant in accordance with section 31ZK(1) of these Rules, if any; and
 - (b) where the applicant had requested a hearing under section 82(1) of these Rules—the hearing has been held.
- (2) The Registrar may, by notice given to the applicant (*further review opinion*)—
 - (a) set out any matter covered in the following request, response and hearing, if any, in respect of which the Registrar considers that elaboration, revision or clarification is required—
 - (i) the request to review;
 - (ii) the response to review opinion; and
 - (iii) the hearing under section 82(1) of these Rules;
 - (b) state that the applicant may file a further response in relation to the matter in accordance with section 31ZM(1) of these Rules to elaborate on, revise or clarify the matter; and
 - (c) if the Registrar thinks fit, and if applicable—state that the applicant may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(b) of these Rules.
- (3) The Registrar may give further review opinion more than once.

31ZM. Response to further review opinion

- (1) A response to a further review opinion to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (*response to further review opinion*) must be filed by the applicant with the Registrar within 2 months after the date of the further review opinion.
- (2) If the further review opinion states that the applicant may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(b) of these Rules.
- (3) A request for hearing must be—

- (a) in the specified form;
- (b) accompanied by the prescribed fee for the request; and
- (c) filed with the Registrar.
- (4) If no response to further review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
 - (a) make a final decision of refusal to grant the standard patent (O); and
 - (b) give the applicant a final refusal notice.
- (5) Section 31ZL of these Rules applies in relation to a response to further review opinion as if—
 - (a) the words “a response to review opinion filed by the applicant in accordance with section 31ZK(1) of these Rules” in section 31ZL(1)(a)(ii) of these Rules were substituted by the words “a response to review opinion and a response to further review opinion filed by the applicant in accordance with sections 31ZK(1) and 31ZM(1) of these Rules respectively”; and
 - (b) the words “the response to review opinion” in section 31ZL(2)(a)(ii) of these Rules were substituted by the words “the response to review opinion and the response to further review opinion”.

31ZN. Final refusal notice

- (1) If the Registrar, having considered the matters raised in the following request, responses and hearing, if any, is still of the opinion that the standard patent (O) application does not comply with the examination requirement concerned, the Registrar may make a final decision of refusal to grant the standard patent (O)—
 - (a) a request to review;
 - (b) a response to review opinion;
 - (c) a response to further review opinion;
 - (d) the hearing under section 82(1) of these Rules.
- (2) If the Registrar makes the final decision, the Registrar must, by notice given to the applicant (*final refusal notice*)—
 - (a) notify the applicant of the decision; and
 - (b) give the reasons for the decision.

31ZO. Continuing substantive examination on compliance with examination requirement concerned

If the Registrar is of the opinion that the examination requirement concerned has been complied with, the Registrar must continue to carry out the substantive examination of the standard patent (O) application.

31ZP. Grant and publication of standard patent (O)

- (1) The Registrar must, on granting a standard patent (O) under section 37X of the Ordinance, determine the date on which preparations for publication under section 37X(2)(a) of the Ordinance are to be regarded as having been completed.
- (2) The Registrar must, by notice given to the applicant, notify the applicant of the determination as soon as practicable after making the determination.

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

31ZO. Interpretation

In this Division—

request to review (覆核請求)—see section 31ZI(1) of these Rules;

response to examination notice (審查通知的回應)—see section 31ZE(1) of these Rules;

response to further examination notice (進一步審查通知的回應)—see section 31ZG(1) of these Rules;

response to further review opinion (進一步覆核意見的回應)—see section 31ZM(1) of these Rules;

response to review opinion (覆核意見的回應)—see section 31ZK(1) of these Rules.

31ZR. Claim regarding non-prejudicial disclosure under section 37B(2)(b)(i) of Ordinance

For the purposes of a claim regarding a disclosure that was due to, or in consequence of, an evident abuse under section 37B(2)(b)(i) of the Ordinance, a standard patent (O) application must contain—

- (a) a statement stating that there has been an evident abuse as described in that section; and
- (b) written evidence in support of the statement.

31ZS. Divisional standard patent (O) application under section 37Z of Ordinance

(1) A new standard patent (O) application referred to in section 37Z(1)(b) of the Ordinance (new application) must state—

- (a) that the new application is an application under that section; and
- (b) the application number of the earlier application within the meaning of section 37Z(1)(a) of the Ordinance (*earlier application*).

(2) If an earlier application is refused under section 37P(2) or (4)(b) or 37Y of the Ordinance, the applicant may file a new application within 2 months after the date of the notice under section 31Y(2) of these Rules or the date of the final refusal notice under section 31ZN(2) of these Rules, as the case requires.

(3) If an appeal is made under section 130 of the Ordinance in relation to the refusal, the Registrar may specify a period within which a new application may be filed.

(4) A new application is to be regarded as duly filed on the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with.

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

(1) Subject to section 45(3) of these Rules, a request to amend a standard patent (O) application before grant under section 37ZA(1) of the Ordinance must—

- (a) be in the specified form;
- (b) identify the amendment;
- (c) give the reasons for the amendment; and
- (d) be filed with the Registrar.

(2) Subject to section 103(2) of the Ordinance, the applicant of a standard patent (O) application may request to amend the application—

- (a) when filing a request for substantive examination under section 37T(1) of the Ordinance;
- (b) when filing with the Registrar—
 - (i) a response to examination notice;
 - (ii) a response to further examination notice;
 - (iii) a request to review;
 - (iv) a response to review opinion; or
 - (v) a response to further review opinion;
- (c) once before preparations for publication of the application under section 37Q of the Ordinance are completed whether a request to amend the application has been filed under paragraph (a); and
- (d) within 3 months after the date of the notice issued under section 37U(1) of the Ordinance.

(3) If the applicant requests to amend the description, claims or drawings in the specification contained in a standard patent (O) application (requested amendment), the Registrar may, if the Registrar thinks fit, by notice given to the applicant, require the applicant to file the following copies of the amended specification (*required copies*) with the Registrar within the period specified by the Registrar—

- (a) a clean copy of the specification with the requested amendment incorporated into it; and
- (b) a copy of the specification with the requested amendment incorporated into it and indicated in it.

(4) If the required copies are not filed within the period specified under subsection (3), the request for amendment to which the required copies relate is to be regarded as being withdrawn.

(5) For the purposes of subsections (1) and (3), the amendment of the standard patent (O) application must be prepared in compliance with the requirements specified in sections 31M(2) and (3), 31N, 31O, 31P, 31Q(1) to (12), 31R and 31S of these Rules.

31ZU. Notice requesting reinstatement of standard patent (O) application under section 28(1) and (2) of Ordinance as applied by section 37ZD(1) of Ordinance

A notice requesting reinstatement of a standard patent (O) application under section 28(1) and (2) of the Ordinance as applied by section 37ZD(1) of the Ordinance must be—

- (a) in the specified form;
- (b) accompanied by the additional prescribed fee for the request; and
- (c) filed with the Registrar.

31ZV. Application for restoration of rights lost in respect of standard patent (O) application under section 29(1) and (2) of Ordinance as applied by section 37ZD(1) of Ordinance

An application for restoration of the rights lost in respect of a standard patent (O) application under section 29(1) and (2) of the Ordinance as applied by section 37ZD(1) of the Ordinance must be—

- (a) made to the Registrar;
- (b) in the specified form; and
- (c) accompanied by the additional prescribed fee for the application for restoration of rights.

31ZW. Requirements concerning standard patent (O) application for invention requiring use of micro-organisms under section 149(2A) of Ordinance

Schedule 1 to these Rules has effect under section 149(2A) of the Ordinance in relation to a standard patent (O) application for an invention that requires the use of micro-organisms for the performance of the invention.

31ZX. Requirements concerning sequence listing in standard patent (O) application for invention involving nucleotide and amino acid sequences

- (1) A standard patent (O) application for an invention that involves nucleotide and amino acid sequences must contain a sequence listing as a part of the description in the specification contained in the application.
- (2) A sequence listing must—
 - (a) comply with the requirements and standards adopted under the Patent Cooperation Treaty for the presentation of sequence listings in patent applications; and
 - (b) be filed—
 - (i) with the Registrar; and
 - (ii) in electronic form, if so required by the Registrar.
- (3) A sequence listing filed in relation to a standard patent (O) application may be filed in electronic form even if the application is not filed by way of electronic filing under section 93A(2) of these Rules.
- (4) A sequence listing filed after the date of filing of the standard patent (O) application must be accompanied by a statement made by the applicant confirming to the satisfaction of the Registrar that the sequence listing does not contain any matter extending beyond the sequence disclosed in the application.

Part 4
Provisions as to Patents after Grant

-(L.N. 150 of 2014)

Part 4
Provisions on Patents after Grant

Division 1
Standard Patents

(L.N. 150 of 2014)

32. Renewal of standard patents

- (1) Payment of the renewal fee prescribed for the purposes of section 39(2) of the Ordinance shall be made by filing a request for renewal in the specified form accompanied by the renewal fee.

- (2) On receipt of the request for renewal duly completed and renewal fee, the Registrar shall issue a confirmation of payment.
- (3) Where the period for payment of a renewal fee pursuant to section 39(2) and (3) of the Ordinance has expired, the Registrar shall, not later than 6 weeks after the last date for payment under that section and if the fee still remains unpaid, send to the proprietor of the standard patent a notice reminding him that payment is overdue and of the consequences of non-payment.
- (4) Notice to a proprietor under subsection (3) shall be sent to—
 - (a) the address in Hong Kong specified by the proprietor on payment of the last renewal fee;
 - (b) where another address in Hong Kong has been notified to the Registrar for that purpose by the proprietor since the last renewal, that address; or
 - (c) in any other case, the address for service entered in the register.
- (5) The late payment of a renewal fee in the manner provided for in section 39(4) of the Ordinance shall be made by filing a request for renewal in the specified form accompanied by the renewal fee and any additional fee prescribed for the purposes of that section.

33. Notification of lapsed standard patent

Where—

- (a) a standard patent has ceased to have effect because a renewal fee has not been paid within the period specified in section 39(2) and (3) of the Ordinance; and
- (b) the extended period specified in section 39(4) of the Ordinance has expired without the renewal and prescribed additional fee having been paid,

the Registrar shall, within 6 weeks after the expiration of the extended period, notify the proprietor of the patent of the fact and draw his attention to the provisions of section 40 of the Ordinance.

34. Restoration of lapsed standard patents under section 40 of the Ordinance

- (1) An application under section 40 of the Ordinance for the restoration of a standard patent which has ceased to have effect by reason of a failure to pay any renewal fee—
 - (a) shall be in the specified form; and
 - ~~(b) shall be signed by the applicant;~~
 - ~~(c) shall be supported by evidence of the statements made in it; and~~
 - (d) shall be accompanied by the fee prescribed for the purposes of that section.

(1A) The application must be accompanied by evidence to satisfy the Registrar that the applicant has taken all reasonable care required by the circumstances of the case for the purposes of section 40(4) of the Ordinance.

(1B) If the application is not accompanied by the evidence, the Registrar must specify a period within which the evidence must be filed with the Registrar.

~~(2) If, upon consideration of the evidence provided in support of an application, the Registrar~~

(2) If the Registrar, having considered the supporting evidence of the application, is not satisfied that a case for an order under section 40 of the Ordinance has been made out, he shall notify the applicant accordingly and, unless within 1 month the applicant requests to be heard in the matter, the Registrar shall refuse the application.

(3) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

~~(4) If the Registrar decides to allow the application, he shall notify the applicant accordingly and require him, within 2 months from the date on which the notification is sent to him, to file a request for renewal in the specified form, duly completed, accompanied by any unpaid renewal fee and any additional fee prescribed for the purposes of section 40(4) of the Ordinance, upon receipt of which the Registrar shall order the restoration of the standard patent and shall advertise the fact of such order in the official journal. (2 of 2001 s. 19)~~

(4) If the Registrar, having considered the supporting evidence of the application, decides to allow the application, the Registrar must, by notice given to the applicant, require the applicant to file a request for renewal with the Registrar within 2 months after the date of the notice.

(5) The request for renewal must be—

(a) in a duly completed form specified for the purposes of section 39(2) of the Ordinance; and

(b) accompanied by any unpaid renewal fee and any additional fee prescribed for the purposes of section 40(4) of the Ordinance.

- (6) On receiving the request for renewal filed in accordance with subsections (4) and (5), the Registrar must—
(a) order the restoration of the standard patent; and
(b) advertise the fact of the order by notice in the official journal.

35. Amendment of ~~standard patent~~standard patent (R) under section 43 of the Ordinance

- (1) The period prescribed for the purposes of section 43(1) of the Ordinance is the period of 6 months beginning from— (*L.N. 37 of 2004*)
- (a) the date of the amendment in the designated patent office; or
 - (b) the date of grant of the ~~standard patent~~standard patent (R), whichever is the later.
- (2) A filing of documents with the Registrar for the purposes of section 43(1) of the Ordinance shall be made by filing—
- (a) a verified copy of—
 - (i) the amended specification; or
 - (ii) the amending order;
 - (b) a notice of the amendment in the specified form; and
 - (c) such translations of the documents filed under paragraph (a) as may be required under section 56 of these Rules. (*L.N. 37 of 2004*)
- (3) The Registrar may, if he thinks fit, require—
- (a) the amendment be shown on a copy of the specification of which amendment has been made in the designated patent office; or
 - (b) the filing, within the time specified by the Registrar, of a new specification as amended, which shall be prepared in accordance with section 12.

36. Prescribed opposition or revocation proceedings in designated patent office for purposes of sections 43 and 44 of Ordinance

The opposition or revocation proceedings in a designated patent office prescribed for the purposes of sections 43 and 44 of the Ordinance are, if the office is the European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.

~~36. Opposition or revocation proceedings in the designated patent office for the purposes of sections 43 and 44 of the Ordinance~~

~~The following opposition or revocation proceedings are prescribed for the purposes of sections 43 and 44 of the Ordinance—~~

- ~~(a) in the State Intellectual Property Office, any post-grant revocation proceedings under or in accordance with Articles 41 to 44 of the Patent Law of the People's Republic of China and Rules 55 to 63 of the Implementing Regulations of the Patent Law of the People's Republic of China; (2 of 2001 s. 18)~~
- ~~(b) in European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.~~

37. Revocation of ~~standard patent~~standard patent (R) under section 44 of the Ordinance

- (1) A filing of documents with the Registrar for the purposes of section 44(2) of the Ordinance shall be made by filing those documents together with a notice, which shall be in the specified form, and such translations of the documents as may be required under section 56.
- (2) An application under section 44(4) of the Ordinance for revocation of a ~~patent~~standard patent (R) shall—
- (a) be in the specified form; (*L.N. 37 of 2004*)
 - (b) be supported by evidence of the statements made in the application and, where appropriate, shall be accompanied by a prescribed translation of such evidence in accordance with section 56; and (*L.N. 402 of 1997*)
 - (c) be accompanied by the prescribed fee.

- (3) The documentation prescribed for the purposes of section 44(2) of the Ordinance is a verified copy of an entry in the patent register of the designated patent office showing the revocation of the designated patent.
- (4) A person who files an application under section 44(4) of the Ordinance shall, at the same time, send a copy of the application and any evidence and translation accompanying the application to every person registered as proprietor ~~of the patent of the standard patent (R)~~ and to every other person who is shown in the register as having a right in or under the patent. *(L.N. 37 of 2004)*
- (5) Any recipient of such a copy of an application under subsection (4) who wishes to oppose the application shall, within 3 months from the date of ~~its issue receipt~~, file a counter-statement which shall be in the specified form, shall set out fully the grounds of objection to the application being opposed and shall be accompanied by the prescribed fee. *(L.N. 37 of 2004)*
- (6) The recipient shall, at the same time as he files the counter-statement, send a copy of it to each of the persons described in subsection (4) other than any person who is party to the counter-statement. *(L.N. 37 of 2004)*
- (7) The Registrar may give ~~such directions as he may think fit with regard to the subsequent procedure.~~ directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

Division 2 Patents Generally

(L.N. 150 of 2014)

~~38. Mention of inventor under section 45 of the Ordinance~~

- ~~(1) A person claiming to be the inventor or a joint inventor of an invention for which a patent has been granted may apply to the Registrar for a finding that he is entitled to be mentioned in the patent as the inventor or joint inventor of the invention in pursuance of section 45(1) of the Ordinance.~~
- ~~(2) Application for a finding under subsection (1), or a request under section 45(2) of the Ordinance for a finding that a person ought not to have been mentioned in a patent as sole or joint inventor in pursuance of such a finding, shall—~~
 - ~~(a) be in the specified form;~~
 - ~~(b) be accompanied by a copy of the application or request and a statement setting out fully the facts relied upon; and *(L.N. 402 of 1997; L.N. 37 of 2004)*~~
 - ~~(c) be accompanied by the prescribed fee.~~
- ~~(3) A person who files an application under subsection (1) or a request under section 45(2) of the Ordinance shall, at the same time, send a copy of the application or request and any statement accompanying it to—~~
 - ~~(a) every person registered as proprietor of the patent other than the applicant or person making the request;~~
 - ~~(b) every person who has been identified in the patent as the inventor or a joint inventor of the invention;~~
 - ~~(c) every person who has been identified in the statement referred to in subsection (2)(b) as the inventor or a joint inventor of the invention; and~~
 - ~~(d) every other person who is shown in the register as having a right in or under the patent. *(L.N. 37 of 2004)*~~
- ~~(4) Any recipient of such a copy of an application or request and statement who wishes to oppose the application or request shall, within 3 months from the date on which it is sent to him, file a counter statement.~~
- ~~(5) (a) The counter statement shall be in the specified form, shall set out fully the grounds of objection to the application or the request being opposed and shall be accompanied by the prescribed fee.~~
 - ~~(b) A person who files a counter statement shall, at the same time, send a copy of it to each of the persons described in this section other than any person who is party to the counter statement. *(L.N. 37 of 2004)*~~
- ~~(6) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.~~

38A. Application to amend specification after grant

- (1) This section applies to an application under section 46 of the Ordinance to amend the specification of—
 - (a) a standard patent (O); or
 - (b) a short-term patent in respect of which a certificate of substantive examination has been issued.
- (2) The application must be—
 - (a) in the specified form;

- (b) accompanied by—
 - (i) a copy of the specification incorporating the requested amendment indicated by—
 - (A) striking through the text, figure or other matter to be replaced or deleted; and
 - (B) underlining the replacement text, figure or other matter;
 - (ii) the evidence furnished by the proprietor of the patent to establish the circumstances underlying the requested amendment; and
 - (iii) the prescribed fee for the application; and
 - (c) filed with the Registrar.
- (3) For the purposes of subsection (2), the requested amendment must be prepared in compliance with the requirements specified in—
- (a) for a standard patent (O)—sections 31M(2) and (3), 31N, 31O, 31Q(1) to (12) and 31S of these Rules; or
 - (b) for a short-term patent—sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.
- (4) The Registrar may, by notice given to the proprietor of the patent, require the proprietor to do either or both of the following within the period specified in the notice—
- (a) correct any deficiencies in the requested amendment;
 - (b) file further evidence to supplement the evidence referred to in subsection (2)(b)(ii).
- (5) If the deficiencies mentioned in the notice are not corrected, or the further evidence required by the notice is not filed, within the period specified in the notice, the application is to be regarded as being withdrawn.
- (6) The Registrar may, having regard to the evidence referred to in subsections (2)(b)(ii) and (4)(b), if any, and the circumstances underlying the requested amendment—
- (a) subject to section 103(3) of the Ordinance, accept the requested amendment in whole or in part as an allowable amendment (*allowable amendment*); or
 - (b) refuse to accept the requested amendment.
- (7) If the Registrar accepts an allowable amendment under subsection (6)(a), the Registrar must, in addition to complying with section 46(3)(a) and (b) of the Ordinance, notify the proprietor of the patent of the Registrar’s decision.
- (8) A request for a hearing under section 82(1) of these Rules made for the purposes of a decision under subsection (6) must be—
- (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.

38B. Opposition notice

- (1) Any person who intends to oppose an allowable amendment referred to in section 38A(6)(a) of these Rules and published under section 46(3)(a) of the Ordinance (*opponent*) may file an opposition notice with the Registrar.
- (2) The opposition notice must be filed within 1 month after the date on which the fact of the publication of the allowable amendment is advertised under section 46(3)(b) of the Ordinance.
- (3) The opposition notice must be—
- (a) in the specified form; and
 - (b) accompanied by—
 - (i) a statement setting out—
 - (A) the facts on which the opponent relies; and
 - (B) the relief sought; and
 - (ii) the prescribed fee for the notice.
- (4) An opponent who files an opposition notice must, at the same time, send a copy of the opposition notice and statement to the proprietor of the patent.
- (5) The opponent must, within 3 days after the date of filing of the opposition notice, notify the Registrar in writing that the opponent has complied with subsection (4).
- (6) If the opponent fails to comply with the requirements under subsection (2), (3), (4) or (5), the opposition notice is to be regarded as not having been filed.

38C. Counter-statement

- (1) The proprietor of a patent who receives from an opponent referred to in section 38B of these Rules a copy of an opposition notice and intends to resist the opposition may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 1 month after the date on which the copy of the opposition notice is received by the proprietor.
- (3) The counter-statement must—
 - (a) be in the specified form;
 - (b) set out the grounds on which the opposition is resisted; and
 - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) A proprietor who files a counter-statement must, at the same time, send a copy of it to the opponent.
- (5) If the proprietor fails to file a counter-statement in accordance with the requirements under subsection (2) or (3), the application to amend the specification of the patent made in accordance with section 38A of these Rules is to be regarded as being withdrawn.
- (6) The proprietor or the opponent may request a hearing under section 82A(2) or (3) of these Rules.

38D. Directions by Registrar

In the proceedings concerning the application to amend the specification of a patent under section 46 of the Ordinance, the Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

38E. Final decision by Registrar

- (1) If an opposition notice is filed under section 38B(1) of these Rules in opposition to an allowable amendment, and a counter-statement is filed under section 38C(1) of these Rules to resist the opposition, the Registrar—
 - (a) must, before making a final decision under paragraph (b), consider—
 - (i) the opposition notice and the statement referred to in section 38B(3)(b)(i) of these Rules;
 - (ii) the counter-statement;
 - (iii) the representation made at a hearing requested under section 82A(2) or (3) of these Rules, if any; and
 - (iv) the evidence furnished under section 38A(2)(b)(ii) and (4)(b) of these Rules, or in accordance with the directions given under section 38D of these Rules, if any; and
 - (b) must make a final decision to—
 - (i) allow the allowable amendment in whole or in part as an allowed amendment; or
 - (ii) refuse to allow the allowable amendment.
- (2) If no opposition notice is filed in opposition to an allowable amendment, the Registrar must, having decided to allow the amendment in whole or in part, make a final decision to allow the amendment in whole or in part as an allowed amendment.
- (3) If a final decision is made under subsection (1)(b)(i) or (2), the Registrar must, in addition to complying with section 46(7)(a) and (b) of the Ordinance, notify the proprietor of the patent and the opponent referred to in section 38B(1) of these Rules, if any, of the final decision.
- (4) If a final decision is made under subsection (1)(b)(ii), the Registrar must—
 - (a) notify the proprietor and the opponent of the final decision; and
 - (b) advertise the final decision by notice in the official journal.
- (5) In this section—

allowable amendment (可容許修訂) means a requested amendment—

 - (a) accepted in whole or in part as an allowable amendment under section 38A(6)(a) of these Rules; and
 - (b) published under section 46(3)(a) of the Ordinance.

38F. Publication of amendment under section 46(3)(a) or (7)(a) of Ordinance

- (1) This section applies to the publication of an amendment under section 46(3)(a) or (7)(a) of the Ordinance.
- (2) The Registrar may, if the Registrar thinks fit, by notice given to the proprietor of the patent, require the proprietor to file, for the purposes of publishing the amendment, the following copies of the amended specification (**required copies**) with the Registrar within the period specified by the Registrar—
 - (a) a clean copy of the specification with the amendment incorporated into it; and
 - (b) a copy of the specification with the amendment incorporated into it and indicated in it.

- ~~(3) For the purposes of subsection (2), the required copies must be prepared in compliance with the requirements specified in—~~
~~(a) for a standard patent (O)—sections 31M(2) and (3), 31N, 31O, 31Q(1) to (12) and 31S of these Rules; or~~
~~(b) for a short-term patent—sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.~~
~~(4) If the required copies are not filed within the period specified under subsection (2), the application for amendment to which the required copies relate is to be regarded as being withdrawn.~~

39. *(Repealed L.N. 37 of 2004)*

40. Surrender of patents

- (1) A notice of an offer by a proprietor of a patent under section 48 of the Ordinance to surrender his patent shall be in the specified form and details of any such notice given to the Registrar shall be advertised by the Registrar in the official journal. *(2 of 2001 s. 19)*
- (2) Notice of opposition under section 48(2) of the Ordinance to the surrender of a patent may be given at any time within 2 months from the date of the advertisement.
- (3) Such notice shall—
 - (a) be in the specified form;
 - (b) be supported by a statement setting out fully the facts upon which the opponent relies and the relief which he seeks; and
 - (c) be accompanied by the prescribed fee, and the opponent shall, at the same time as he files the notice, send a copy of the notice and of the statement to the proprietor of the patent. *(L.N. 37 of 2004)*
- (4) Within 3 months from the date on which ~~the copies are sent to him, the proprietor of the patent shall, if he~~ the copy of the notice is received by the proprietor of the patent, the proprietor must, if the proprietor wishes to continue with the surrender, file a counter-statement which shall—
 - (a) be in the specified form;
 - (b) set out fully the grounds of objection to the surrender being opposed; and
 - (c) be accompanied by the prescribed fee, and the proprietor shall send a copy of the counter-statement to the opponent. *(L.N. 37 of 2004)*
- ~~(5) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.~~
- ~~(5) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.~~

41. Registrar's power to revoke patent on grounds of "ordre public" or morality under section 49 of the Ordinance

- (1) A reference under section 49(1) of the Ordinance to the Registrar of the question as to whether an invention is a patentable invention having regard to any of the matters specified in section ~~93(5)9A(5)~~ of the Ordinance shall—
 - (a) be in the specified form;
 - (b) be accompanied by a statement setting out fully the reference sought and the facts upon which the person making the reference (*the applicant*) relies; and
 - (c) be accompanied by the prescribed fee. *(L.N. 37 of 2004)*
- (2) The applicant shall, at the same time as he files the reference, send a copy of the reference and statement to the proprietor of the patent. *(L.N. 37 of 2004)*
- (3) Within 3 months from the date of the sending of the copy of the reference and statement, the proprietor of the patent shall, if he wishes to contest the reference, file a counter-statement which shall—
 - (a) be in the specified form;
 - (b) set out fully the grounds of objection to the reference being opposed; and
 - (c) be accompanied by the prescribed fee, and the proprietor shall send a copy of the counter-statement to the applicant. *(L.N. 37 of 2004)*
- (4) The applicant may, within 3 months from the date on which the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence to the proprietor.

- (5) Within 3 months from the date of the sending of the copy of the applicant's evidence, or, if the applicant does not file any evidence, within 3 months of the expiration of the time within which such evidence might have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within 3 months from the date of the sending of the copy of the proprietor's evidence, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.
- (6) No further evidence shall be filed except by leave or direction of the Registrar.
- (7) The Registrar may give ~~such directions as he may think fit with regard to the subsequent procedure.~~directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

41A. Registrar to notify old proprietor etc. if order mentioned in section 55(4) or 56(2) of Ordinance is made

- (1) If a specified order is made in relation to a patent and is filed with the Registrar, the Registrar must, by notice given to each of the persons specified in subsection (2), notify the person of the order.
- (2) The persons are—
 - (a) the old proprietor of the patent referred to in section 56(2) of the Ordinance;
 - (b) the old proprietor of the original patent referred to in section 56(3A) of the Ordinance;
 - (c) the person whom the Registrar is aware of at the time of giving the notice is—
 - (i) the licensee of the patent referred to in section 56(3) of the Ordinance; and
 - (ii) the licensee of the original patent referred to in section 56(3A) of the Ordinance.
- (3) A request for licence under section 56(3B)(b) of the Ordinance may be made—
 - (a) by the old proprietor within 2 months after the date of the notice given to the old proprietor; or
 - (b) by the licensee within 4 months after the date of the notice given to the licensee.
- (4) In subsection (1)—

specified order (指明命令), in relation to a patent, means an order—

 - (a) made under section 55(4) of the Ordinance; or
 - (b) referred to in section 56(2) of the Ordinance.

Part 5 Property in Patents and Applications; Registration

(L.N. 150 of 2014)

42. Address for service in respect of patents

- (1) Every person concerned in any proceedings before the Registrar shall file an address for service.
- (2) The address for service must be a residential or business address in Hong Kong.
- (3) A person may file an address for service—
 - (a) where the person files any specified form that requires the person who completes it to provide an address for service, by filing the specified form with the address for service stated on it; or
 - (b) in any other case, by notifying the Registrar in writing.
- (4) Where a specified form referred to in subsection (3)(a) is filed in the name of 2 or more persons, the address for service stated on that form shall be treated as the address for service of each of those persons.
- (5) An applicant for a patent or the proprietor of a patent may use only one address for service for the purposes of all proceedings before the Registrar concerning that application or patent.
- (6) Subject to any filing to the contrary under this section, on the grant of an application for a patent, the address for service of the applicant shall be treated as the address for service of the proprietor of the patent for the purposes of all proceedings before the Registrar concerning that patent.
- (7) Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings.
- (8) Where, after a person has become a party to proceedings before the Registrar, the person appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file an address for service.

- (9) No act required or authorized by the Ordinance or these Rules to be done by or to a person referred to in subsection (8) in connection with the proceedings in question may be done by or to the newly appointed agent before the date on which he files an address for service.
- (10) Any person may withdraw his address for service by notifying the Registrar in writing.

(L.N. 37 of 2004)

42A. Failure to file address for service

- (1) Where an address for service is not filed as required by section 42, or where the Registrar is satisfied that the address for service of the proprietor of a patent or a party to any proceedings before the Registrar is no longer valid, the Registrar may send to the person concerned, at any of the addresses referred to in subsection (2), a notice to file an address for service.
- (2) For the purposes of subsection (1), the addresses are—
- any previously filed address for service of the person;
 - any address of the person in Hong Kong that is shown in the register;
 - any residential or business address of the person in Hong Kong; and
 - any other address of the person that is known to the Registrar.
- (3) If any person to whom a notice is sent under subsection (1) fails to file an address for service within 2 months after the date of the notice—
- any application (other than an application for a patent), notice or request filed by that person shall be treated as abandoned or withdrawn; and
 - the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party (other than as an applicant for a patent).
- (4) This section is without prejudice to the operation of sections 17 ~~and 68, 31Y and 68 of these Rules.~~

(L.N. 37 of 2004)

43. Entries in the register

- ~~(1) No entry shall be made in the register—~~
- ~~in respect of any application for a standard patent before the request to record has been published in accordance with section 20 of the Ordinance; or~~
 - ~~in respect of any application for a short term patent before the short term patent has been granted.~~
- ~~(1) No entry is to be made in the register—~~
- ~~for a standard patent (R) application—before the request to record is published in accordance with section 20 of the Ordinance;~~
 - ~~for a standard patent (O) application—before the application is published in accordance with section 37Q of the Ordinance; or~~
 - ~~for a short-term patent application—before the short-term patent is granted.~~
- ~~(2) Upon publication of the application for the standard patent or upon grant of the short term patent, the Registrar shall~~
- ~~(2) On the publication of the request to record for the standard patent (R) application, the publication of the standard patent (O) application, or the grant of the short-term patent, the Registrar must~~ cause to be entered in the register—
- the name and address of the applicant or proprietor ~~(as the case may be), as the case requires;~~
 - the name of the person stated by the applicant or proprietor believed to be the inventor or inventors;
 - the title of the invention;
 - the date of filing of the application for the patent and the application number;
 - the date of filing and the application number of any application declared for the purposes of section ~~9811B,~~ 37E or 111 of the Ordinance and the country, territory or area in or for which the application was made;
 - ~~in the case of an application for a standard patent, the date of filing and the publication number of the corresponding designated patent application;~~
 - ~~the date of publication of the application for the standard patent or grant of the short term patent (as the case may be); and~~
 - ~~in relation to a standard patent (R) application—the date of filing and the application number of the corresponding designated patent application;~~

- (g) the date of publication of the request to record for the standard patent (R) application, the date of publication of the standard patent (O) application, or the date of grant of the short-term patent, as the case requires; and
- (h) the address for service of the applicant or proprietor ~~(as the case may be), as the case requires.~~
- (3) The Registrar shall also cause to be entered in the register—
- ~~(a) in relation to any patent or published application for a standard patent—~~
- (a) in relation to a patent, published request to record for a standard patent (R) application, or published standard patent (O) application—
- (i) the address for service, if different to the entry made in accordance with subsection (2)(h);
- (ii) notice of any transaction, instrument or event referred to in section 52(3) of the Ordinance; and
- (b) in relation to any standard patent or standard patent application, in addition to the matters specified in paragraph (a)—
- (i) the date on which the published application is withdrawn, deemed to be withdrawn or refused;
- (ii) in relation to a standard patent (R) application—the date of grant of the corresponding designated patent;
- (iii) the date on which the standard patent is granted;
- (iv) the name and address of the person or persons to whom the standard patent is granted, if different to the entry made in accordance with subsection (2)(a).
- (4) The Registrar may at any time enter in the register such other particulars as he may think fit.

44. Entries relating to section 13(1) or 37H(1) of the Ordinance

On the reference to the Registrar of a question under section 13(1) ~~of the Ordinance~~ or 37H(1) of the Ordinance the Registrar shall, subject to section 43(1), cause an entry to be made in the register of the fact and of such other information relating to the reference as he may think fit.

45. Alteration of name or address

- (1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the registry shall be in the specified form.
- (2) Before acting on a request to alter a name, the Registrar may require such proof of the alteration as he thinks fit.
- (3) A request by any person for the alteration or correction of his address or address for service entered in the register or on any application or other document filed with the Registrar shall be made in the specified form or by notice in writing and shall identify any relevant application or patent to which the request relates. (*L.N. 37 of 2004*)
- (4) If the Registrar is satisfied that a request to alter a name or to alter or correct an address or address for service may be allowed, he shall cause the register, application or other document to be altered accordingly.

46. Registration of transactions, etc., in relation to patents and patent applications

- (1) An application to register, or a notice to the Registrar of, any transaction, instrument or event to which section 52 of the Ordinance applies shall be in the specified form and shall be accompanied by the prescribed fee.
- (2) An application or a notice under subsection (1) shall—
- (a) where it relates to an assignment referred to in section 52(3)(a) or (c) of the Ordinance, be signed by or on behalf of the assignor; (*L.N. 37 of 2004*)
- (b) where it relates to a mortgage or the granting of a licence or sub-licence or security referred to in section 52(3)(b) or (c) of the Ordinance, be signed by or on behalf of the mortgagor or the grantor of the licence or security, as the case may be,
- or, if not so signed, shall be accompanied by such documentary evidence as suffices to establish the transaction, instrument or event.
- (3) The Registrar may direct that such evidence as he may require in connection with the application or notice shall be sent to him within such period as he may specify.
- (4) An application or a notice under subsection (1) may be rejected only in the event of failure to comply with the conditions laid down in subsection (2) or (3) or, where appropriate, in section 50(6) of the Ordinance and, if so rejected, the application will not be considered as an application or a notice for the purposes of section 52(1) of the Ordinance.

47. Request for correction of error in the register or in any document filed in connection with registration

- (1) Except as provided in section 45(3), a request for the correction of an error in the register or in any document filed with the Registrar in connection with registration shall—
 - (a) be made in the specified form and the correction shall be clearly identified on a document annexed to the request or, if not, on the request itself;
 - (b) be accompanied by the prescribed fee.
- (2) The Registrar may call for such written explanation of the reasons for the request or evidence in support of it as he may require in order to satisfy himself that there is an error and, upon being so satisfied, shall make such correction as may be agreed between the proprietor of the patent or applicant and the Registrar.

48. Correction of errors in patents and applications under section 146 of the Ordinance

- (1) Except where section 45(3) has effect, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall—
 - (a) be in the specified form;
 - (b) clearly identify the proposed correction; and
 - (c) be accompanied by the prescribed fee,and the Registrar may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.
- (2) Where such a request relates to a specification, no correction shall be made in the specification unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.
- (3) Where the Registrar requires notice of the proposed correction to be advertised, he shall advertise the request and the nature of the proposed correction in the official journal. (*2 of 2001 s. 19*)
- (4) At any time within 2 months after the date of the advertisement, any person may give notice to the Registrar of opposition to the request.
- (5) Such notice shall be in the specified form, shall be supported by a statement setting out fully the facts on which the opponent relies and the relief which he seeks and shall be accompanied by the prescribed fee. (*L.N. 37 of 2004*)
- (6) The opponent shall, at the same time as he files the notice, send a copy of the notice and the statement to the person making the request. (*L.N. 37 of 2004*)
- (6A) If the person making the request desires to proceed with the request, ~~he shall, within 3 months from the date of the sending of the copies to him~~ the person must, within 3 months after the date on which the copy of the notice is received by the person—
 - (a) file a counter-statement in the specified form setting out fully the grounds on which he contests the opposition;
 - (b) pay the prescribed fee; and
 - (c) send a copy of the counter-statement to the opponent. (*L.N. 37 of 2004*)
- (7) The Registrar may give ~~such directions as he may think fit with regard to the subsequent procedure.~~ directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

49. (*Repealed L.N. 37 of 2004*)

50. Inspection of register

- (1) The register, or entries or reproductions of entries in it, shall be made available for inspection by the public during the hours of business of the registry as published in accordance with section 148 of the Ordinance.
- ~~(2) A request to be allowed to inspect the register shall be accompanied by the prescribed fee, if any, but a~~
- (2) A copy of an entry in or extract from the register shall be requested only in accordance with section 51.

51. Certificates and copies supplied by Registrar

- (1) Upon written request made in the specified form and payment of the prescribed fee, but subject to subsection (3), the Registrar shall supply—
 - (a) a certified copy or certified extract falling within section 51(11) of the Ordinance;
 - (b) a certificate for the purposes of section 51(10) of the Ordinance.
- (2) Upon written request and payment of the prescribed fee, if any, but subject to subsection (3), the Registrar shall supply an uncertified copy of an entry in or an uncertified extract from the register or an uncertified copy of or an uncertified extract from anything referred to in section 51(11)(b) of the Ordinance.
- (3) The restrictions on making documents available for inspection contained in section 89(1) shall apply equally to the supply by the Registrar under this section of copies of or extracts from such documents or requests as are referred to in section 89(1), and nothing in this section shall be construed as imposing upon the Registrar the duty of supplying copies of or extracts from any document or file of a description referred to in section 89(2).
(L.N. 37 of 2004)

52. Order or direction by court

- (1) Where the court makes any order or gives any direction under any provision of the Ordinance except section 46 or 102 of the Ordinance, the person in whose favour the order or direction is made or given shall file a sealed copy of the order or direction with the Registrar.
- (2) Where the court makes any order under section 46 or 102 of the Ordinance, the person in whose favour the order is made shall file with the Registrar a copy of any documents referred to in the order that show the amendments to be made, together with such translations of those documents as may be required under section 56 of these Rules.
- (3) The documents and translations referred to in subsection (2) shall be filed at such time as a copy of the order is filed with the Registrar in accordance with the order or direction made by the court or rules of court.
(L.N. 37 of 2004)

Part 6 Employees' Inventions

(L.N. 150 of 2014)

53. Time limit for application under section 58 of the Ordinance

- (1) Subject to subsection (2), the period prescribed for the purposes of section 58(1) and (2) of the Ordinance shall be that period which begins when the relevant patent is granted and expires one year after the relevant patent has ceased to have effect.
- (2) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the period prescribed for the payment of that fee and an application for restoration is made under section 40 or 127 of the Ordinance, then—
 - (a) if restoration is ordered, the period specified in subsection (1) shall continue as if the patent had remained continuously in effect; or
 - (b) if restoration is refused, the period specified in subsection (1) shall be treated as expiring one year after the patent ceased to have effect or 6 months after the refusal, whichever is the later.

Part 6A Single Inventive Concept

53A. Single inventive concept

- (1) For the purposes of the Ordinance, if a technical relationship existing between 2 or more inventions involves one or more of the same or corresponding special technical features, the inventions are to be regarded as being so linked as to form a single inventive concept.
- (2) For the purposes of subsection (1), special technical features are the technical features that define a contribution that each of the claimed inventions, considered as a whole, makes over the prior art.

Part 7 Revocation of Patents

(L.N. 150 of 2014)

54. Prescribed opposition or revocation proceedings in designated patent office for purposes of section 91(1)(i) of Ordinance

The opposition or revocation proceedings in a designated patent office prescribed for the purposes of section 91(1)(i) of the Ordinance are, if the office is the European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.

~~54.—Opposition or revocation proceedings in the designated patent office for the purposes of section 91(1)(i) of the Ordinance~~

~~The following opposition or revocation proceedings are prescribed for the purposes of section 91(1)(i) of the Ordinance—~~

- ~~(a) in the State Intellectual Property Office, any post-grant revocation proceedings under or in accordance with Articles 41 to 44 of the Patent Law of the People's Republic of China and Rules 55 to 63 of the Implementing Regulations of the Patent Law of the People's Republic of China; (2 of 2001 s. 18)~~
- ~~(b) in the European Patent Office, any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention.~~

~~55.—Exhibition or meeting under section 95(1)(b) of the Ordinance~~

~~The following exhibitions or meetings are prescribed for the purposes of section 95(1)(b) of the Ordinance—~~

- ~~(a) an official or officially recognized international exhibition within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong;~~
- ~~(b) an international exhibition sponsored or recognized by the Chinese Government or an academic or technological meeting organized by a competent department concerned of the State Council of the Chinese Government or by a national academic or technological association, so recognized by the Chinese Government.~~

Part 8 Language of Proceedings; Authentic Text

(L.N. 150 of 2014)

56. The language of proceedings before the Registrar

- (1) Except as expressly provided in these Rules, where any document or part of a document which is not in one of the official languages is filed with the Registrar or sent to the registry in pursuance of the Ordinance or these Rules, it shall contain a translation into the language of the proceedings, and such translation shall state the name of the translator and his official capacity, if any. *(L.N. 37 of 2004)*
- (2) For the purposes of sections 15(3), ~~23(4)~~23(4), 37L(4) and 113(3) of the Ordinance and sections 8, ~~4919~~, 31M and 58 of these Rules—
 - (a) the title of the invention and the abstract, if in one of the official languages, shall contain a translation into the other official language;
 - (b) the title of the invention and the abstract, if not in one of the official languages, shall contain a translation into both official languages;
 - (c) the names of the applicant and inventor, if not in the Roman alphabet or in Chinese characters, shall contain a transliteration of the same in the Roman alphabet. *(L.N. 37 of 2004)*
- (3) For the purposes of sections 15(2)(d), ~~23(3)(b)~~23(3)(b), 37L(3)(c) and 113(2)(c) of the Ordinance, if any documents supporting the respective statements under sections 15(2)(d), ~~23(3)(b)~~23(3)(b), 37L(3)(c) and 113(2)(c) of the Ordinance are not in one of the official languages, they shall contain a translation into the language of the proceedings.

- (4) A translation into the language of the proceedings or into one of the official languages of the designated patent application as referred to in section 15(2)(a) of the Ordinance will not be required.
 - (5) A translation into the language of the proceedings or into one of the official languages of the published specification of the designated patent as referred to in section 23(3)(a) of the Ordinance will not be required.
 - (6) Any party in oral proceedings before the Registrar, or any witness or expert called by any such party to give evidence in such proceedings, may use in those proceedings a language other than the language of the proceedings if, and only if—
 - (a) the party gives to the Registrar and any other party notice of his intention to do this, and of the language he proposes to use, not less than 14 days before the date laid down for the oral proceedings;
 - (b) the party makes such provision for interpretation into the language of the proceedings as the Registrar may require;
 - (c) the party complies with any requirement as the Registrar may specify as to interpretation of the oral proceedings into the other official language and as to the expenses of that interpretation.
 - (7) Subject to the consent of the parties concerned, the Registrar may in any proceedings before him, on such terms as he thinks fit, give directions relating to the use of the official language that is not the language of the proceedings.
 - (8) The Registrar may, in respect of any document to be used for the purposes of evidence in proceedings before the Registrar and which is in a language other than the language of the proceedings, give directions as to—
 - (a) the filing of the document in that other language;
 - (b) the filing of a translation of the document into the language of the proceedings.
 - (9) The Registrar may specify periods within which any translation of a document is to be filed or within which information in the official languages is to be provided; and the Registrar may, upon application by a party to the proceedings, extend such periods as he may think fit subject to the payment of a penalty fee.
- (9A) Subsection (9) does not apply if the translation is required to be filed with the Registrar—**
- (a) within a prescribed time or period under these Rules;**
 - (b) within a specified period as referred to in these Rules other than that subsection; or**
 - (c) by a notice given under section 17, 24, 31Y(1) or 68(1) of these Rules.**
- (10) The Registrar may, on the request of the applicant or proprietor, if he is satisfied that there is good reason for such request, direct that the official language which is not being used as the language of the proceedings for the purposes of section 104 of the Ordinance shall become and shall be used as the language of the proceedings, and his direction shall have effect accordingly.

56A. General provisions for sections 56B and 56C of these Rules

- (1) Sections 56B and 56C of these Rules apply to any of the following applications that is in neither English nor Chinese—**
 - (a) an earlier specified application; or**
 - (b) a previous application.**
- (2) In this section and sections 56B and 56C of these Rules—**

earlier specified application (較早前提出的指明申請) means an earlier specified application referred to in section 37M(3)(c)(ii) or 114(3)(c)(ii) of the Ordinance;

previous application (過往的申請) means a previous application referred to in section 37E(1) or 111(1) of the Ordinance.

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

- (1) For the purposes of section 111(1) of the Ordinance, the applicant for the short-term patent must file the document specified in subsection (2) with the Registrar within—**
 - (a) 16 months after the earliest date of priority claimed; or**
 - (b) if the Registrar approves the restoration application under section 68B of these Rules—a period specified by the Registrar.**
- (2) The document is—**
 - (a) a translation of the title of the invention, the claims and the filing date of the previous application together with a transliteration of the name of the applicant into the Roman alphabet; or**

- (b) if the short-term patent application for which priority is claimed is a translation of the previous application—a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate.
- (3) For the purposes of sections 37M(3)(c)(ii) and 114(3)(c)(ii) of the Ordinance, the applicant must file the following document with the Registrar within 4 months after the date on which the minimum requirement under section 37M(3) or 114(3) of the Ordinance, as the case requires, is complied with—
 - (a) a translation of the earlier specified application in the language of the proceedings; or
 - (b) if a specification that is a translation of the specification of the earlier specified application has been filed under section 37L(2)(b) or 113(1A)(b) of the Ordinance—a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate.
- (4) If the requirement under subsection (1) or (3) is not complied with, the Registrar must—
 - (a) for section 37M(3)(c)(ii) of the Ordinance—by notice given to the applicant referred to in section 31Y(1) of these Rules, require the applicant to comply with the requirement;
 - (b) for section 111(1) or 114(3)(c)(ii) of the Ordinance—by notice given to the applicant referred to in section 68(1) of these Rules, require the applicant to comply with the requirement.
- (5) For the purposes of sections 37E(1) and 111(1) of the Ordinance, the Registrar may, by a notice under section 31ZD, 31ZF(2), 31ZJ, 31ZL(2), 81D(1), 81F(2), 81J or 81L(2) of these Rules, require the applicant for a standard patent (O) or the proprietor of a short-term patent to file the following document with the Registrar—
 - (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent, as the case requires; or
 - (b) if the standard patent (O) application or the short-term patent for which priority is claimed is a translation of the previous application—a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate.

56C. Language requirements for sections 37N(5) and 114A(5) of Ordinance

- (1) For the purposes of filing a missing description or missing drawing under sections 37N(5) and 114A(5) of the Ordinance, the applicant must file the following documents with the Registrar within the period specified under subsection (2)—
 - (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent application, as the case requires; and
 - (b) a statement indicating which part of the translation represents the description or drawing that is missing in the patent application.
- (2) The period is—
 - (a) if the applicant is required to file the missing description or missing drawing by a notice under section 37N(1) or 114A(1) of the Ordinance—
 - (i) 2 months after the date of the notice; or
 - (ii) 16 months after the earliest date of priority claimed, whichever expires later;
 - (b) if the applicant files the missing description or missing drawing on the applicant's own initiative under section 37N(2) or 114A(2) of the Ordinance—16 months after the earliest date of priority claimed.

56D. Registrar may require evidence on accuracy of translations

- (1) If the Registrar has reasonable doubts about the accuracy of any translation of a document that has been filed by any person in accordance with the Ordinance or these Rules, the Registrar—
 - (a) must notify the person of the reasons for the Registrar's doubts; and
 - (b) may require the person to file the following documents with the Registrar within the period specified by the Registrar—
 - (i) an accurate translation of the document;
 - (ii) evidence to establish that the translation is accurate.
- (2) If the person fails to comply with the requirement under subsection (1)(b), the document is to be regarded as not having been filed.

57. Filing of corrected translation under section 106(3) of the Ordinance

- (1) Section 12 shall apply in relation to a corrected translation filed under section 106(3) of the Ordinance as it applies in relation to the documents making up a request to record.
- (2) Payment of the fee prescribed for the purposes of section 106(3) of the Ordinance in connection with the publication of the corrected translation shall be made by filing a request for publication in the specified form accompanied by the fee.
- (3) The period prescribed for payment of the prescribed fee for the purposes of section 106(3) of the Ordinance shall be 14 days from the day on which the corrected translation is filed.

Part 9

Applications for Short-term Patents

(L.N. 150 of 2014)

Part 9

Short-term Patents

Division 1—Applications for Short-term Patents

58. Applications for the grant of short-term patents under section 113 of the Ordinance

- (1) An application for the grant of a short-term patent made under section 113 or 125 of the Ordinance shall be in the specified form.
- (2) The specification contained in an application for a short-term patent shall state the title of the invention and include the following—
 - (a) a description of the invention;
 - (b) one or more claims but not exceeding ~~one independent claim~~ 2 independent claims;
 - (c) any drawings referred to in the description or the claim or claims. *(L.N. 48 of 2002)*
- (3) The title shall be short and indicate the matter to which the invention relates.
- ~~(4) The description shall include a list briefly describing the figures in the drawings, if any.~~
- (5) The application for the grant of a short-term patent shall contain—
 - (a) a search report as prescribed in section 72;
 - (b) *(Repealed L.N. 37 of 2004)*
 - (c) in the case of an applicant claiming priority of a previous application under section 111 of the Ordinance, a statement of priority as prescribed by section 69 and a copy of the previous application; *(L.N. 37 of 2004)*
 - (d) any request for deferral of the grant of a patent for a specified period under section 119 of the Ordinance;
 - ~~(e) in the case of a claim regarding non-prejudicial disclosure of the invention as referred to in section 109(a) of the Ordinance, a statement to the effect that the invention has been displayed in accordance with that paragraph together with written evidence in support of the statement.~~
 - (f) any statement required by section 109 of the Ordinance in relation to non-prejudicial disclosure of the invention referred to in paragraph (b) of that section, together with written evidence in support of the statement as prescribed in section 70 of these Rules;
 - (g) the name and address of the inventor or inventors;
 - (h) a list of the documents comprising the application and an indication of the number of sheets of each such document;
 - (i) for a reference to an earlier specified application under section 114(3)(c)(ii) of the Ordinance—the documents required under section 67A(3) of these Rules; and
 - (j) the translation of documents and transliteration of names required under sections 56, 56A and 56B of these Rules.

59. Description

- (1) The description shall—
 - (a) specify the technical field to which the invention relates;

- (b) indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention and, preferably, cite the documents reflecting such art;
 - (c) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;
 - (d) briefly describe the figures in the drawings, if any;
 - (e) describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any;
 - (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is ~~capable of exploitation in industry~~industrially applicable.
- (2) The description shall be presented in the manner and order specified in subsection (1), unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

60. Drawings

- (1)
 - (a) Drawings forming part of an application for a short-term patent shall be on sheets the usable ~~service~~surface area of which shall not exceed 26.2 cm x 17 cm.
 - (b) The sheets shall not contain frames round the usable or used surface.
 - (c) The minimum margins shall be as follows—
 - top 2.5 cm
 - left side 2.5 cm
 - right side 1.5 cm
 - bottom 1.0 cm
- (2) Drawings shall be executed as follows—
 - (a) without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
 - (b) cross-sections shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;
 - (c) the scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty; and that if, as an exception, the scale is given on a drawing, it shall be represented graphically;
 - (d) all numbers, letters, and reference signs, appearing on the drawing shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers, letters and characters;
 - (e) all lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments;
 - (f) elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;
 - (g) the height of the numbers, letters and characters shall be not less than 0.32 cm and for the lettering of drawings, the Latin and, where customary, the Greek alphabets or Chinese characters, as appropriate, shall be used;
 - (h) where the same sheet of drawings contains several figures, the different figures shall be arranged without wasting space, clearly separated from one another; and the different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets;
 - (i) where figures drawn on 2 or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures;
 - (j) reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa; and the same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;
 - (k) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as, "water", "steam", "open", "close", "section on AA" or the equivalent Chinese characters, as appropriate, and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords or the equivalent Chinese characters, as appropriate, indispensable for understanding; and any such words or characters shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings;

- (1) the sheets of the drawings shall be numbered in accordance with section 62.
- (3) Flow sheets and diagrams shall be considered to be drawings for the purposes of these Rules.

Note—

Section 62(14) of these Rules provides for exemption from this section.

61. The abstract

- (1) The abstract shall commence with a title for the invention.
- (2) The abstract shall contain a concise summary of the matter contained in the specification; the summary shall indicate the technical field to which the invention belongs and be drafted in a way which allows a clear understanding of the technical problem to which the invention relates, the gist of the solution to that problem through the invention and the principal use or uses of the invention; where appropriate, the abstract shall also contain the chemical formula which, among those contained in the specification, best characterizes the invention; and the abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.
- (3) The abstract shall normally not contain more than 150 words or 200 Chinese characters as appropriate;
- (4) If the specification contains any drawings, the applicant shall indicate on the abstract the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when published; the Registrar may decide to publish one or more other figures if he considers that they better characterize the invention; and each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing, placed between parentheses.

62. Size and presentation of documents

- (1) All documents making up an application for a short-term patent shall be so presented as to permit of—
 - (a) reproduction by photography, photocopying processes, photo offset and micro-filming, in an unlimited number of copies; and (*L.N. 37 of 2004*)
 - (b) the scanning of the document by a device capable of capturing an image of the document and converting that image into a form suitable for storing on and retrieval by a computer.
- (2) All sheets of the documents making up an application shall be free from cracks, creases and folds; and only one side of the sheet shall be used.
- (3) All documents shall be on A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable.
- (4) Each of the documents shall commence on a new sheet and the sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.
- (5)-(6) (*Repealed L.N. 37 of 2004*)
- (7) All the sheets contained in the documents shall be numbered in consecutive Arabic numerals. (*L.N. 37 of 2004*)
- (8) (*Repealed L.N. 37 of 2004*)
- ~~(9) (a) The description, the claims and the abstract shall not contain drawings.~~
- ~~(b) The description, the claims and the abstract may contain chemical or mathematical formulae.~~
- ~~(c) The description and the abstract may contain tables; the claims may contain tables only if their subject-matter makes the use of tables desirable.~~
- ~~(d) Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position on the sheet; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the top of the tables or formulae are at the left side of the sheet.~~
- (9) The description, claims and abstract—
 - (a) must not contain drawings;
 - (b) may contain chemical or mathematical formulae;
 - (c) subject to subsection (9A), may contain tables; and
 - (d) subject to subsection (9B), must be typed or printed.
- (9A) The claims may contain tables only if their subject matter makes the use of tables desirable.
- (9B) If necessary, graphic symbols and chemical or mathematical formulae may be drawn or written by hand.
- (9C) All textual matters in the description, claims and abstract must be in black and indelible.
- (9D) The tables and chemical or mathematical formulae—

(a) subject to paragraph (b)—must be presented in an upright position on a sheet; and
(b) if they cannot be presented satisfactorily in an upright position on a sheet—may be presented sideways on the sheet in a way that the top of the tables or formulae are at the left side of the sheet.

- (10) In all documents—
 - (a) weights and measures shall be expressed in metric units or, if expressed in different units, shall also be expressed in metric units as well;
 - (b) the other physical values shall be expressed in the units recognized in international practice;
 - (c) in stating mathematical or chemical formulae, the symbols, atomic weights and molecular formulae in general use shall be employed; and
 - (d) in general, use should be made of technical terms, signs and symbols generally accepted in the field in question.
- (11) If a formula or symbol is used in the specification, a copy of the specification, prepared in the same manner as drawings, shall be furnished if the Registrar so directs.
- (12) The terminology and the signs shall be consistent throughout the application.
- (13) All documents shall be reasonably free from deletions and other alterations overwritings and interlineations and shall, in any event, be legible.
- (14) The Registrar may exempt any document from compliance with any of the provisions of this section or section 60 of these Rules if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy, or in such other circumstances as he may think fit.
- (15) Regardless of any exemption granted under subsection (14), in the case of an application for a short-term patent based on an international application under section 125 of the Ordinance, the documents comprising the international application shall be taken as complying with this section. (*L.N. 37 of 2004*)

63. Form of statements, counter-statements and evidence

Any statement, counter-statement or evidence filed shall, unless the Registrar otherwise directs, comply with the requirements of section 62(1) and (3), except that both sides of the sheet may be used in the case of statutory declarations and evidence.

64. Claims

- (1) The claims shall define the matter for which protection is sought in terms of the technical features of the invention and, wherever appropriate, claims shall contain—
 - (a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;
 - (b) a characterizing portion, preceded by the expression "characterized in that" or "characterized by" or the equivalent Chinese characters, as appropriate, stating the technical features which, in combination with the features stated in paragraph (a), it is desired to protect.
- (2) An independent claim stating the essential features of an invention may be followed by one or more dependent claims concerning particular embodiments of that invention.
- (3)
 - (a) Any claim which includes all ~~these~~ features of any other claim (*dependent claim*) shall contain, if possible at the beginning, a reference to the other claim and shall then state the additional features which it is desired to protect.
 - (b) A dependent claim shall also be admissible where the claim it directly refers to is itself a dependent claim.
 - (c) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way.
- (4) The number of the claims shall be reasonable in consideration of the nature of the invention claimed; and if there are several claims, they shall be numbered consecutively in Arabic numerals.
- (5) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings; and in particular, they shall not rely on such references as "as described in part ... of the description", or "as illustrated in figure ... of the drawings" or the equivalent Chinese characters, as appropriate.

- (6) If the application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to these features and placed between parentheses; and these reference signs shall not be construed as limiting the claim.

65. Procedure where applicant is not the inventor or sole inventor

Where the applicant or applicants are not the inventor or inventors—

- (a) the statement required by section 113(2)(c) of the Ordinance shall be in the specified form; and
- (b) the Registrar shall send a copy of the statement to each inventor who is not one of the applicants. (*L.N. 37 of 2004*)

66. Issue of receipt by Registrar

On first receipt of any of the documents comprising an application for a short-term patent, the Registrar shall—

- (a) mark the documents with the date of their receipt by him;
- (b) assign an application number to the application; and
- (c) issue to the applicant a receipt which shows an application number, the nature and number of the documents received and the date of their receipt.

67. Notice after examination of minimum requirement under section 114 of Ordinance

- (1) If a short-term patent application complies with the requirement specified in section 114(3) of the Ordinance (*minimum requirement*), the Registrar must, by notice given to the applicant, notify the applicant of the date on which the minimum requirement is complied with.
- (2) If the application does not comply with the minimum requirement, the Registrar must, by notice given to the applicant, notify the applicant—
 - (a) of the deficiencies in the application as regards the non-compliance with the minimum requirement; and
 - (b) that unless the applicant corrects the deficiencies within 2 months after the date of the notice, the application is not to be dealt with as a short-term patent application.
- (3) If the applicant corrects the deficiencies within the period referred to in subsection (2)(b), the Registrar must, by notice given to the applicant, notify the applicant of the date on which the minimum requirement is complied with.

~~67.—Communication following examination on filing under section 114 of the Ordinance~~

- ~~(1) If a short term patent application fails to meet any of the minimum requirements specified in section 114(2) of the Ordinance, the Registrar shall communicate the disclosed deficiencies to the applicant and inform him that his application for a short term patent shall not be dealt with as an application for a short term patent unless he remedies the disclosed deficiencies within 1 month from the date of the communication.~~
- ~~(2) If the applicant remedies the disclosed deficiencies within that period, the Registrar shall inform him of the date of filing accorded to the short term patent application.~~

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

- (1) This section applies if a short-term patent application contains a purported reference to an earlier specified application referred to in section 114(3)(c)(ii) of the Ordinance.
- (2) For the purposes of the minimum requirement under section 114(3) of the Ordinance, a reference to an earlier specified application is not to be regarded as having been made unless the reference states—
 - (a) the date of filing of the earlier specified application;
 - (b) the application number of the earlier specified application; and
 - (c) the country, territory or area in or for which the earlier specified application was made.
- (3) The applicant must file the following documents with the Registrar within 4 months after the date on which the minimum requirement under section 114(3) of the Ordinance is complied with—
 - (a) a copy of the earlier specified application; and
 - (b) a copy of the certificate issued by the authority that received the earlier specified application (*certificate*).

- (4) If the earlier specified application is an application made under the Ordinance, the copies referred to in subsection (3)(a) and (b) are to be regarded as having been filed in due time.
- (5) If the earlier specified application or the certificate is in neither English nor Chinese, sections 56(1), 56A and 56B(3) of these Rules apply to it.
- (6) If a copy of the earlier specified application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(3) of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.

67B. Filing for purposes of section 114A of Ordinance

- (1) If a missing description or missing drawing is required by a notice under section 114A(1) of the Ordinance to be filed—
- (a) it must be filed within 2 months after the date of the notice; and
- (b) the previous application documents must be filed for the purposes of section 114A(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (2) If a missing description or missing drawing is to be filed on an applicant's own initiative under section 114A(2) of the Ordinance—
- (a) it must be filed within 2 months after the date on which the minimum requirement under section 114(3) of the Ordinance is complied with; and
- (b) the previous application documents must be filed for the purposes of section 114A(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (3) If the previous application referred to in section 114A(5)(a) of the Ordinance is an application made under the Ordinance, a copy of the previous application is to be regarded as having been filed in due time for the purposes of section 114A(5)(d) of the Ordinance.
- (4) If the previous application is in neither English nor Chinese, sections 56A and 56C of these Rules apply to it.
- (5) If a copy of the previous application or the translation required by sections 56A and 56C of these Rules as applied by subsection (4) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.
- (6) In this section—
- missing description* (欠交說明) has the meaning given by section 114A(6) of the Ordinance;
- missing drawing* (欠交繪圖) has the meaning given by section 114A(6) of the Ordinance;
- previous application documents* (過往申請的文件) means—
- (a) the copy of the previous application referred to in section 114A(5)(d)(i) of the Ordinance; and
- (b) the statement referred to in section 114A(5)(d)(iii) of the Ordinance indicating which part of the previous application represents the description or drawing that is missing in the short-term patent application.

Division 2—Examination on Formal Requirements of Short-term Patent Applications

68. Correction of deficiencies in short-term patent application as regards formal requirements

- (1) If an examination under section 115(1) of the Ordinance reveals deficiencies in a short-term patent application as regards the formal requirements within the meaning of that section, the Registrar must, by notice given to the applicant—
- (a) notify the applicant of the deficiencies; and
- (b) require the applicant to correct the deficiencies within 2 months after the date of the notice.
- (2) If the application is refused or is to be regarded as being withdrawn under section 115(1A) or (3) of the Ordinance, the Registrar must, by notice given to the applicant—
- (a) notify the applicant of the refusal or withdrawal; and
- (b) give the reasons for the refusal or withdrawal.

68.—Rectification of deficiencies in short-term patent applications

- (1) ~~If the examination provided for in section 115(1) of the Ordinance reveals deficiencies in the short-term patent application, the Registrar shall inform the applicant by notice accordingly and shall invite him to remedy the~~

~~deficiencies within a period of 2 months from the date of such notice; except that in the case of an applicant claiming priority of a previous application under section 111 of the Ordinance where the deficiency in the short-term patent application is the failure to file a copy of the previous application together with a translation of that application (as the case may require under section 69 of these Rules), the Registrar shall specify a period of not less than 3 months from the date of filing of the subsequent application within which the applicant may remedy the deficiencies. (L.N. 37 of 2004)~~

- ~~(2) The Registrar may, upon request by the applicant presented before the expiry of such period and payment of the prescribed fee, grant an extension of that period for a further 2 months.~~
- ~~(3) If in any particular case the Registrar is satisfied that the applicant's failure to remedy the deficiencies within the period allowed under subsection (1) or (2) was wholly or mainly attributable to—~~
- ~~(a) a failure or undue delay in the postal services in Hong Kong or in the country, territory or area of the designated patent office; or~~
- ~~(b) any natural disaster or strike in Hong Kong or in the country, territory or area of the designated patent office, the Registrar may grant such further extension of that period, not exceeding 2 months, as he considers reasonable.~~
- ~~(4) Where—~~
- ~~(a) an application for a short term patent includes a request for deferral of grant of the patent under section 119 of the Ordinance; and~~
- ~~(b) the only deficiency in the short term patent application at the expiry of periods specified in subsections (1), (2) and (3) (as may be applicable) is the failure to file a search report under section 113(1)(d) of the Ordinance,~~
- ~~the applicant may request an extension of time for filing the search report to a date not later than 1 month prior to the expiry of the deferred date of grant of the patent. (L.N. 402 of 1997)~~
- ~~(5) If the only deficiency in the short term patent application after the expiry of the periods specified in subsections (1), (2) and (3) (as may be applicable) is the failure to file a translation of the title of invention or abstract as referred to in section 56(2)(a) and (b) or a transliteration of the names of the applicant or inventor as referred to in section 56(2)(c), the Registrar may, on the request of the applicant, allow for a specified period within which the applicant may make good that deficiency on the payment of a penalty fee.~~
- ~~(6) If the filing fee or advertisement fee has not been paid within the time limit provided for in section 113(5) of the Ordinance, it may still be validly paid within a period of grace of 1 month of notification of a communication pointing out the failure to observe the time limit if, and only if, within this period an additional fee is paid.~~

Division 3—Procedure up to and including Grant of Short-term Patents

68A. Extension of time for filing search report and paying filing fee or advertisement fee

- ~~(1) If—~~
- ~~(a) an application for a short-term patent includes a request for deferral of grant of the patent described in section 119 of the Ordinance; and~~
- ~~(b) the only deficiency in the short-term patent application is the failure to file a search report as required by section 113(1A)(d) of the Ordinance,~~
- ~~the applicant may request an extension of time for filing the search report to a date not later than 1 month before the deferred date of grant of the patent.~~
- ~~(2) If a filing fee or an advertisement fee payable under section 113(5) of the Ordinance is not paid within the time limit specified in that section, it is to be regarded as having been paid within the time limit if it is paid, with an additional fee, within a grace period—~~
- ~~(a) that is allowed by the Registrar by a notice given to the applicant; and~~
- ~~(b) that—~~
- ~~(i) begins on the date of expiry of the time limit; and~~
- ~~(ii) ends at the expiry of 1 month after the date of the notice.~~

68B. Restoration of priority right under section 110A of Ordinance

- (1) This section applies to a restoration application under section 110A of the Ordinance in relation to the priority right of a subsequent short-term patent application referred to in section 110A(1)(b) of the Ordinance.
- (2) A restoration application must be—
 - (a) in the specified form;
 - (b) accompanied by—
 - (i) a statement of priority referred to in section 111(1) of the Ordinance;
 - (ii) evidence—
 - (A) to establish why the subsequent short-term patent application was not filed before the expiry of the period of 12 months referred to in section 110(1A) of the Ordinance; and
 - (B) to satisfy the Registrar that all reasonable care required by the circumstances of the case has been taken for the purposes of section 110A(5) of the Ordinance; and
 - (iii) the prescribed fee for the restoration application; and
 - (c) filed with the Registrar.
- (3) If the restoration application is not accompanied by the evidence required by subsection (2)(b)(ii), the Registrar must specify a period within which the evidence must be filed with the Registrar.
- (4) If there is any deficiency in the statement of priority filed, the Registrar must specify a period within which the deficiency must be corrected.
- (5) The restoration application is to be regarded as being withdrawn if—
 - (a) the evidence is not filed within the period specified under subsection (3); or
 - (b) the deficiency is not corrected within the period specified under subsection (4).
- (6) If the Registrar approves the restoration application, the following documents must be filed with the Registrar within a period specified by the Registrar—
 - (a) a copy of the patent application on the basis of which the priority right is restored (*previous application*); and
 - (b) a copy of the certificate (*certificate*) that—
 - (i) is issued by the authority that received the previous application; and
 - (ii) states the date of filing of the previous application.
- (7) If the previous application is a Hong Kong application as defined by section 108A of the Ordinance, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time.
- (8) If the previous application or the certificate is in neither English nor Chinese—
 - (a) sections 56(1), 56A and 56B(1) and (2) of these Rules apply to it; and
 - (b) the Registrar may make a requirement under section 56B(5) of these Rules in relation to it.
- (9) If a copy of the previous application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(1), (2) and (5) of these Rules as applied by subsection (8) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.

69. Claiming priority under section 111 of Ordinance

- (1) Subject to section 69A of these Rules, this section applies if—
 - (a) an applicant of a short-term patent application (*subsequent application*) claims priority of a non-Hong Kong application or Hong Kong application (*previous application*) under section 111 of the Ordinance; and
 - (b) the date of filing of the subsequent application is within 12 months after the date of filing of the previous application.
- (2) The applicant must file with the Registrar—
 - (a) a statement of priority; and
 - (b) the documents referred to in subsection (7).
- (3) A statement of priority must be filed with the Registrar in the specified form together with the subsequent application.
- (4) Despite subsection (3), if the conditions specified in subsection (5) are met, the statement of priority may be filed within 16 months after the earliest date of priority claimed.
- (5) The conditions are that—
 - (a) the statement of priority is accompanied by the prescribed fee; and
 - (b) preparations for publication of the specification of the short-term patent under section 118(2)(a) of the Ordinance have not been completed.
- (6) The statement of priority must state the following particulars of the previous application—

- (a) the date of filing;
 - (b) the application number;
 - (c) the country, territory or area in or for which the previous application was made.
- (7) The following documents must be filed with the Registrar within 16 months after the earliest date of priority claimed—
- (a) a copy of the previous application; and
 - (b) a copy of the certificate (*certificate*) that—
 - (i) is issued by the authority that received the previous application; and
 - (ii) states the date of filing of the previous application.
- (8) If the previous application is a Hong Kong application, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time.
- (9) If the previous application or the certificate is in neither English nor Chinese—
- (a) sections 56(1), 56A and 56B(1) and (2) of these Rules apply to it; and
 - (b) the Registrar may make a requirement under section 56B(5) of these Rules in relation to it.
- (10) If a copy of the previous application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(1), (2) and (5) of these Rules as applied by subsection (9) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.
- (11) In this section—
- Hong Kong application* (香港申請) has the meaning given by section 108A of the Ordinance;
- non-Hong Kong application* (非香港申請) has the meaning given by section 108A of the Ordinance.

69.— Claiming priority under section 111 of the Ordinance

- ~~(1) A statement of priority for the purposes of section 111 of the Ordinance shall be made at the time of filing the application for a short term patent and shall state the date of filing and the application number of any application specified in the statement and the country, territory or area in or for which the application was made.~~
- ~~(2) In the case of a new application filed under section 116 of the Ordinance, no statement of priority shall be made which has not also been made in the earlier application.~~
- ~~(3) The copy of the previous application as referred to in section 111(1) of the Ordinance shall be accompanied by a copy of a certificate issued by the authority that received the application and that states the date of filing of the application. (L.N. 37 of 2004)~~
- ~~(4) If the previous application is not in one of the official languages, it shall be accompanied by a translation in accordance with section 56, except that the Registrar shall accept as satisfying the requirements of section 56 a translation of the title of the invention, the claims and the filing date together with a transliteration of the name of the applicant into the Roman alphabet.~~
- ~~(5) Where the previous application is an application under the Ordinance, the applicant may request the Registrar to include such a copy with the patent application upon payment of the prescribed fee. (L.N. 37 of 2004)~~

69A. Claiming priority for divisional short-term patent application

- (1) This section applies if—
 - (a) an earlier short-term patent application referred to in section 116 of the Ordinance has been filed; and
 - (b) the applicant or the applicant's successor in title files a new application referred to in that section that meets the conditions specified in that section.
- (2) A right of priority that has not been claimed for the earlier short-term patent application may not be claimed for the new application.

70. Claim regarding non-prejudicial disclosure under section 109(b) of the Ordinance

The following written evidence is prescribed for the purposes of section 109 of the Ordinance in relation to non-prejudicial disclosure as provided for under paragraph (b) of that section—

- (a) a certificate, issued ~~at the exhibition~~ by the authority responsible for holding the exhibition, stating—
 - (i) that the invention was ~~in fact exhibited there;~~ displayed at the exhibition; and

~~(ii) the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure;~~

(ii) the date of the first disclosure of the invention at the exhibition; and

- (b) an identification of the invention, duly authenticated by the authority.

71. Searching authority

The following searching authorities are prescribed for the purposes of section 113(8)(a) of the Ordinance—

- (a) the International Searching Authorities appointed under Article 16 of the Patent Cooperation Treaty;
(b) the patent offices designated for the purposes of the Ordinance under section 8 of the Ordinance.

72. Contents of the search report

A search report shall—

- (a) identify by name the searching authority which prepared the report;
(b) be dated and shall indicate the date on which the search was actually completed;
(c) contain the classification of the subject-matter according to the International Patent Classification;
(d) contain the citations of the documents considered to be relevant;
(e) list the classification identification of the fields searched;
(f) contain the name of the officer of the searching authority responsible for the report.

73. Requirements concerning short-term patent application for invention requiring use of micro-organisms under section 149(2A) of Ordinance

Schedule 1 to these Rules has effect under section 149(2A) of the Ordinance in relation to a short-term patent application for an invention that requires the use of micro-organisms for the performance of the invention.

~~73.—Requirements concerning applications relating to microorganisms under section 128 of the Ordinance~~

~~Schedule 1 shall have effect in relation to applications for short-term patents which require for their performance the use of micro-organisms.~~

73A. Requirements concerning sequence listing in short-term patent application for invention involving nucleotide and amino acid sequences

(1) A short-term patent application for an invention that involves nucleotide and amino acid sequences must contain a sequence listing as a part of the description in the specification contained in the application.

(2) A sequence listing must—

(a) comply with the requirements and standards adopted under the Patent Cooperation Treaty for the presentation of sequence listings in patent applications; and

(b) be filed—

(i) with the Registrar; and

(ii) in electronic form, if so required by the Registrar.

(3) A sequence listing filed in relation to a short-term patent application may be filed in electronic form even if the application is not filed by way of electronic filing under section 93A(2) of these Rules.

(4) A sequence listing filed after the date of filing of the short-term patent application must be accompanied by a statement made by the applicant confirming to the satisfaction of the Registrar that the sequence listing does not contain any matter extending beyond the sequence disclosed in the application.

74. Divisional short-term patent application under section 116 of the Ordinance

- (1) Subject to section 122 of the Ordinance, a new short-term patent application within the meaning of section 116 of the Ordinance, may be filed at any time after the filing of the earlier application, except that a new application may not be filed after the earlier application has been refused, is withdrawn, or is ~~deemed to be~~ regarded as being withdrawn.

- (2) Where possible, the description and drawings of the earlier application and the new application shall relate only to the matter for which protection is sought by each such application; however, where it is necessary for an application to describe the matter for which protection is sought by reference to another application, such reference shall include the application number of that other application and shall indicate the matter for which protection is claimed in the other application.
- (3) A new application is to be regarded as duly filed on the date on which the minimum requirement under section 114(3) of the Ordinance is complied with.

74A. Claim regarding non-prejudicial disclosure under section 109(a) of Ordinance

A claim regarding a disclosure that was due to, or in consequence of, an evident abuse under section 109(a) of the Ordinance must contain—

- (a) a statement stating that there has been an evident abuse as described in that section; and
(b) written evidence in support of the statement.

Part 10 **Procedure up to and including Grant of Short-term Patents**

(L.N. 150 of 2014)

75. Request to amend short-term patent application before grant under section 120(1) of Ordinance

- (1) Subject to section 45(3) of these Rules, a request to amend a short-term patent application before grant under section 120(1) of the Ordinance must—
- (a) be in the specified form;
(b) identify the amendment;
(c) give the reasons for the amendment; and
(d) be filed with the Registrar.
- (2) If the applicant requests to amend the description, claims or drawings in the specification contained in a short-term patent application (*requested amendment*), the Registrar may, if the Registrar thinks fit, by notice given to the applicant, require the applicant to file the following copies of the amended specification (*required copies*) with the Registrar within the period specified by the Registrar—
- (a) a clean copy of the specification with the requested amendment incorporated into it; and
(b) a copy of the specification with the requested amendment incorporated into it and indicated in it.
- (3) If the required copies are not filed within the period specified under subsection (2), the request for amendment to which the required copies relate is to be regarded as being withdrawn.
- (4) For the purposes of subsections (1) and (2), the amendment of the short-term patent application must be prepared in compliance with the requirements specified in sections 58(2) and (3), 59, 60, 61, 62(1) to (13), 63 and 64 of these Rules.
- (5) The Registrar may, by notice given to the applicant, require the applicant to correct any deficiencies in the requested amendment within the period specified in the notice.
- (6) If the deficiencies mentioned in the notice are not corrected within the period specified by the Registrar under subsection (5), the request to amend the short-term patent application is to be regarded as being withdrawn.

75.—Amendment of application for short-term patent under section 120 of the Ordinance

- (1) ~~Subject to section 45(3), an application under section 120 of the Ordinance for amendment of an application for a short-term patent shall be in the specified form, shall clearly identify the proposed amendment and shall state the reasons for it.~~
- (2) ~~Where any amendment is proposed to be made to the description, claims or drawings, the Registrar may, if he thinks fit, require the filing, within the time specified by the Registrar, of a new specification or drawings as amended, which shall be prepared in accordance with sections 59, 60, 61, 62 and 64.~~

76. Notice requesting reinstatement of an application for a short-term patent under section 123 of the Ordinance

A notice under section 123 of the Ordinance requesting reinstatement of an application for a short-term patent shall be in the specified form and shall be accompanied by the additional prescribed fee.

77. Application for restoration of rights in relation to an application for a short-term patent under section 123 of the Ordinance

An application under section 123 of the Ordinance for restoration of rights lost in relation to an application for a short-term patent shall be in the specified form and shall be accompanied by the additional prescribed fee.

78. Short-term patent application based on international application under section 125 of Ordinance

(1) The other date referred to in section 125(2) of the Ordinance is any date within 6 months after the date of issuance of an official notification by the State Intellectual Property Office stating that the international application has entered the national phase in the State Intellectual Property Office.

(2) An application to which subsection (1) applies must be accompanied by a copy of the official notification issued by the State Intellectual Property Office.

~~78.—Short-term patent application based on international application under section 125 of the Ordinance~~

~~(1) The other date as referred to in section 125(2) of the Ordinance is any date within 6 months after the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the State Intellectual Property Office. (2 of 2001 s. 18)~~

~~(2) An application made within the date specified in subsection (1) shall be accompanied by the copy of the National Application Notification (國家申請號通知書).~~

Division 4 — Provisions on Short-term Patents after Grant

Part 11

Provisions as to Short-term Patents after Grant

(L.N. 150 of 2014)

79. Renewal of short-term patents

- (1) Payment of the renewal fee prescribed for the purposes of section 126(2) or (3) of the Ordinance shall be made by filing a request for renewal in the specified form accompanied by the renewal fee.
- (2) On receipt of the request for renewal duly completed and renewal fee, the Registrar shall issue a confirmation of payment.
- (3) Where the period for payment of a renewal fee pursuant to section 126(2) or (3) of the Ordinance has expired, the Registrar shall, not later than 6 weeks after the last date for payment under that section and if the fee still remains unpaid, send to the proprietor of the short-term patent a notice reminding him that payment is overdue and of the consequences of non-payment.
- (4) Notice to a proprietor under subsection (3) shall be sent to—
 - (a) any address in Hong Kong notified by the proprietor for that purpose; or
 - (b) if no address has been so notified, the address for service entered in the register.
- (5) The late payment of a renewal fee in the manner provided for in section 126(5) of the Ordinance shall be made by filing a request for renewal in the specified form accompanied by the renewal fee and any additional fee prescribed for the purposes of that subsection.

79A. Observations by third parties

- (1) This section applies to a notice referred to in section 126A(1) of the Ordinance of a person's observations on the patentability of an invention that is the subject of a short-term patent.
- (2) The notice must be filed with the Registrar during the following period—
- (a) after the date on which the short-term patent is granted; and
 - (b) before the earliest of the following dates—
 - (i) the date on which the Registrar issues the certificate of substantive examination in respect of the short-term patent;
 - (ii) the date on which the Registrar gives the final revocation notice in relation to the short-term patent referred to in section 81N(2) of these Rules;
 - (iii) the date on which the short-term patent is found by the court to be wholly valid in any proceedings in which the validity of the patent is contested that are mentioned in section 127B(4)(b) of the Ordinance;
 - (iv) if the short-term patent has not been subsequently restored under section 127 of the Ordinance—the date on which the short-term patent has ceased to have effect under section 126 of the Ordinance;
 - (v) the end of the period referred to in section 126(1)(b) of the Ordinance.
- (3) Section 126A(3) of the Ordinance does not apply to a notice that, in the opinion of the Registrar, would—
- (a) disparage any person in a way likely to damage the person; or
 - (b) be generally expected to encourage any offensive, immoral or anti-social behaviour.

80. Notification of lapsed short-term patent

Where—

- (a) a short-term patent has ceased to have effect because a renewal fee has not been paid within the period prescribed for the purposes of section 126(2) or (3) of the Ordinance; and
- (b) the extended period specified in section 126(5) of the Ordinance has expired without the renewal and prescribed additional fee under that subsection having been paid,

the Registrar shall, within 6 weeks after the expiration of the extended period, notify the proprietor of the short-term patent of the fact and draw his attention to the provisions of section 127 of the Ordinance.

81. Restoration of lapsed short-term patents under section 127 of the Ordinance

Section 34 shall apply to short-term patents, with necessary modification, as if reference in that section to a standard patent was a reference to a short-term patent and reference to section 40 of the Ordinance was reference to that section as applied by section 127 of the Ordinance.

Division 5—Substantive Examination of Short-term Patents

81A. Interpretation

In this Division—

examination notice (審查通知)—see section 81D(1) of these Rules;

examination requirement (審查規定) has the meaning given by section 127A of the Ordinance;

final revocation notice (最終撤銷通知)—see section 81N(2) of these Rules;

further examination notice (進一步審查通知)—see section 81F(2) of these Rules;

further review opinion (進一步覆核意見)—see section 81L(2) of these Rules;

provisional revocation notice (暫定撤銷通知)—see section 81H(2) of these Rules;

request to review (覆核請求)—see section 81I(1) of these Rules;

requester (請求人)—see section 81B(1)(b) of these Rules;

response to examination notice (審查通知的回應)—see section 81E(1) of these Rules;

response to further examination notice (進一步審查通知的回應)—see section 81G(1) of these Rules;

response to further review opinion (進一步覆核意見的回應)—see section 81M(1) of these Rules;

response to review opinion (覆核意見的回應)—see section 81K(1) of these Rules;

review opinion (覆核意見)—see section 81J of these Rules;

substantive examination (實質審查) means an examination under section 127C(1) of the Ordinance.

81B. Request for substantive examination

- (1) This section applies to the following requests for substantive examination of a short-term patent—
 - (a) the request made by the proprietor of a short-term patent under section 127B(1) of the Ordinance; and
 - (b) the request made by any other person under section 127B(2) of the Ordinance (*requester*).
- (2) A request for substantive examination made under section 127B(1)(a) of the Ordinance must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (3) A request for substantive examination made under section 127B(2) of the Ordinance must—
 - (a) be in the specified form;
 - (b) set out the information and particulars to satisfy the Registrar as to the matters specified in section 127B(2)(a) or (b) of the Ordinance that are applicable to the request;
 - (c) be accompanied by the prescribed fee for the request; and
 - (d) be filed with the Registrar.

81C. Registrar may require further information and particulars

- (1) If the Registrar receives a request under section 127B(2) of the Ordinance, the Registrar may, by notice given to the requester, require the requester to file further information and particulars within the period specified in the notice to satisfy the Registrar as to the matters specified in section 127B(2)(a) or (b) of the Ordinance that are applicable to the request.
- (2) If the requester fails to comply with the requirement under subsection (1), the request is to be regarded as not having been made.
- (3) The Registrar must—
 - (a) consider the information and particulars filed under section 81B(3)(b) of these Rules and subsection (1) (if any); and
 - (b) by notice given to the proprietor and the requester—
 - (i) notify them of the Registrar's decision on whether to carry out substantive examination of the short-term patent; and
 - (ii) give the reasons for the decision.

81D. Examination notice

- (1) If the Registrar gives a notice under section 127D(1) of the Ordinance in respect of a short-term patent (*examination notice*), the Registrar must, in that notice, state that the proprietor may respond to that notice in accordance with section 81E(1) of these Rules.
- (2) In subsection (1)—

short-term patent (短期專利) includes any amendment under section 120(1) of the Ordinance and any requested amendment under section 127B(1)(b) of the Ordinance.

81E. Response to examination notice

- (1) A response to an examination notice to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to examination notice*) must be filed by the proprietor with the Registrar within 2 months after the date of the notice.
- (2) If the proprietor fails to comply with the requirement under subsection (1), the Registrar must make a provisional decision to revoke the patent.

81F. Further examination notice

- (1) This section applies if—
 - (a) the proprietor of a short-term patent files a response to examination notice in accordance with section 81E(1) of these Rules; and

- (b) the Registrar has considered the response.
- (2) The Registrar may, by notice given to the proprietor under section 127D(1) of the Ordinance (**further examination notice**)—
 - (a) set out any matter covered in the response to examination notice in respect of which the Registrar considers that elaboration, revision or clarification is required; and
 - (b) state that the proprietor may file a further response in relation to the matter in accordance with section 81G(1) of these Rules to elaborate on, revise or clarify the matter.
- (3) The Registrar may give further examination notice more than once.

81G. Response to further examination notice

- (1) A response to a further examination notice to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (**response to further examination notice**) must be filed by the proprietor with the Registrar within 2 months after the date of the notice.
- (2) If the proprietor fails to comply with the requirement under subsection (1), the Registrar must make a provisional decision to revoke the patent under section 81H(1) of these Rules.
- (3) Section 81F of these Rules applies in relation to a response to further examination notice as if—
 - (a) the words “a response to examination notice in accordance with section 81E(1)” in section 81F(1)(a) of these Rules were substituted by the words “a response to further examination notice in accordance with section 81G(1)”; and
 - (b) the words “the response to examination notice” in section 81F(2)(a) of these Rules were substituted by the words “the response to further examination notice”.

81H. Provisional revocation notice

- (1) If the Registrar, having considered—
 - (a) a response to examination notice;
 - (b) a response to further examination notice, if any; and
 - (c) any amendment under section 120(1) of the Ordinance and any requested amendment under section 127B(1)(b) of the Ordinance,is of the opinion that the short-term patent does not comply with the examination requirement concerned, the Registrar may make a provisional decision to revoke the patent.
- (2) If the Registrar makes a provisional decision, the Registrar must, by notice given to the proprietor (**provisional revocation notice**)—
 - (a) notify the proprietor of the decision;
 - (b) set out the examination requirement concerned; and
 - (c) state that the proprietor may respond to the provisional revocation notice by filing a request to review the Registrar’s opinion under section 127D(3)(c) of the Ordinance in accordance with section 81I(1) and (2) of these Rules.

81I. Request to review

- (1) A request to review the Registrar’s opinion under section 127D(3)(c) of the Ordinance (**request to review**) must be filed by the proprietor with the Registrar within 2 months after the date of the provisional revocation notice.
- (2) A request to review must be—
 - (a) in the specified form; and
 - (b) accompanied by the prescribed fee for the request.
- (3) A request to review may contain either or both of the following—
 - (a) a representation to establish that the patent complies with the examination requirement concerned;
 - (b) a request to amend the specification of the patent under section 81P of these Rules to achieve compliance with that requirement.
- (4) A request to review that does not comply with the requirements under subsection (1) or (2) is to be regarded as not having been made.
- (5) If no request to review is filed, the Registrar must—
 - (a) make a final decision to revoke the patent; and

(b) give the proprietor a final revocation notice.

81J. Review opinion

If the Registrar, having considered a request to review, is of the opinion that the short-term patent does not comply with the examination requirement concerned (*review opinion*), the Registrar must, by notice given to the proprietor of the patent—

- (a) notify the proprietor of the review opinion;
- (b) set out the examination requirement concerned;
- (c) state that the proprietor may file a response to the review opinion in accordance with section 81K(1) of these Rules; and
- (d) if the Registrar thinks fit, and if applicable—state that the proprietor may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(c) of these Rules.

81K. Response to review opinion

- (1) A response to a review opinion to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to review opinion*) must be filed by the proprietor with the Registrar within 2 months after the date of the review opinion.
- (2) If the review opinion states that the proprietor may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(c) of these Rules.
- (3) A request for hearing must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (4) If no response to review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
 - (a) make a final decision to revoke the patent; and
 - (b) give the proprietor a final revocation notice.

81L. Further review opinion

- (1) This section applies if—
 - (a) the Registrar has considered—
 - (i) a request to review filed by the proprietor of a short-term patent in accordance with section 81I(1) and (2) of these Rules; and
 - (ii) a response to review opinion filed by the proprietor in accordance with section 81K(1) of these Rules, if any; and
 - (b) where the proprietor had requested a hearing under section 82(1) of these Rules—the hearing has been held.
- (2) The Registrar may, by notice given to the proprietor (*further review opinion*)—
 - (a) set out any matter covered in the following request, response and hearing, if any, in respect of which the Registrar considers that elaboration, revision or clarification is required—
 - (i) the request to review;
 - (ii) the response to review opinion; and
 - (iii) the hearing under section 82(1) of these Rules;
 - (b) state that the proprietor may file a further response in relation to the matter in accordance with section 81M(1) of these Rules to elaborate on, revise or clarify the matter; and
 - (c) if the Registrar thinks fit, and if applicable—state that the proprietor may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(d) of these Rules.
- (3) The Registrar may give further review opinion more than once.

81M. Response to further review opinion

- (1) A response to a further review opinion to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to further review opinion*) must be filed by the proprietor with the Registrar within 2 months after the date of the further review opinion.
- (2) If the further review opinion states that the proprietor may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(d) of these Rules.
- (3) A request for hearing must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (4) If no response to further review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
 - (a) make a final decision to revoke the patent; and
 - (b) give the proprietor a final revocation notice.
- (5) Section 81L of these Rules applies in relation to a response to further review opinion as if—
 - (a) the words “a response to review opinion filed by the proprietor in accordance with section 81K(1) of these Rules” in section 81L(1)(a)(ii) of these Rules were substituted by the words “a response to review opinion and a response to further review opinion filed by the proprietor in accordance with sections 81K(1) and 81M(1) of these Rules respectively”; and
 - (b) the words “the response to review opinion” in section 81L(2)(a)(ii) of these Rules were substituted by the words “the response to review opinion and the response to further review opinion”.

81N. Final revocation notice

- (1) If the Registrar, having considered the matters raised in the following request, responses and hearing, if any, is still of the opinion that the short-term patent does not comply with the examination requirement concerned, the Registrar may make a final decision to revoke the patent—
 - (a) a request to review;
 - (b) a response to review opinion;
 - (c) a response to further review opinion;
 - (d) the hearing under section 82(1) of these Rules.
- (2) If the Registrar makes the final decision, the Registrar must, by notice given to the proprietor and the requester, if any (*final revocation notice*)—
 - (a) notify the proprietor and the requester, if any, of the decision; and
 - (b) give the reasons for the decision.

81O. Continuing substantive examination on compliance with examination requirement concerned

If the Registrar is of the opinion that the examination requirement concerned has been complied with, the Registrar must continue to carry out the substantive examination of the short-term patent.

Division 6—Amendment of Short-term Patents after Grant

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

- (1) This section applies to a request to amend the specification of a short-term patent after grant under section 127B(1)(b) or 127D(3)(b) of the Ordinance.
- (2) The request must be—
 - (a) in the specified form;
 - (b) accompanied by a copy of the specification incorporating the requested amendment indicated by—
 - (i) striking through the text, figure or other matter to be replaced or deleted; and
 - (ii) underlining the replacement text, figure or other matter; and
 - (c) filed with the Registrar.
- (3) For the purposes of subsection (2), the requested amendment must be prepared in compliance with the requirements specified in sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.

- (4) The Registrar may, having regard to all examination requirements and any unfulfilled requirements being complied with—
- (a) subject to section 103(3) of the Ordinance, accept the requested amendment in whole or in part as an allowable amendment (*allowable amendment*) for publication under section 127E(2)(a) of the Ordinance;
 - or
 - (b) refuse to accept the requested amendment.
- (5) If the Registrar accepts an allowable amendment under subsection (4)(a), the Registrar must, in addition to publishing the allowable amendment under section 127E(2)(a) of the Ordinance—
- (a) notify the proprietor of the Registrar’s decision; and
 - (b) advertise the fact of the publication by notice in the official journal.

81Q. Opposition notice

- (1) Any person who intends to oppose an allowable amendment referred to in section 81P(4)(a) of these Rules and published under section 127E(2)(a) of the Ordinance (*opponent*) may file an opposition notice with the Registrar.
- (2) The opposition notice must be filed within 1 month after the date on which the fact of the publication of the allowable amendment is advertised under section 81P(5)(b) of these Rules.
- (3) The opposition notice must be—
- (a) in the specified form; and
 - (b) accompanied by—
 - (i) a statement setting out—
 - (A) the facts on which the opponent relies; and
 - (B) the relief sought; and
 - (ii) the prescribed fee for the notice.
- (4) An opponent who files an opposition notice must, at the same time, send a copy of the opposition notice and statement to the proprietor of the short-term patent.
- (5) The opponent must, within 3 days after the date of filing of the opposition notice, notify the Registrar in writing that the opponent has complied with subsection (4).
- (6) If the opponent fails to comply with the requirements under subsection (2), (3), (4) or (5), the opposition notice is to be regarded as not having been filed.

81R. Counter-statement

- (1) The proprietor of a short-term patent who receives from an opponent referred to in section 81Q of these Rules a copy of an opposition notice and intends to resist the opposition may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 1 month after the date on which the copy of the opposition notice is received by the proprietor.
- (3) The counter-statement must—
- (a) be in the specified form;
 - (b) set out the grounds on which the opposition is resisted; and
 - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) A proprietor who files a counter-statement must, at the same time, send a copy of it to the opponent.
- (5) If the proprietor fails to file a counter-statement in accordance with the requirements under subsection (2) or (3), the request to amend the specification of the patent made in accordance with section 81P of these Rules is to be regarded as being withdrawn.
- (6) The proprietor or the opponent may request a hearing under section 82A(2) or (3) of these Rules.

81S. Directions by Registrar

In the proceedings concerning the request to amend the specification of a short-term patent under section 127B(1)(b) or 127D(3)(b) of the Ordinance, the Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

81T. Decision by Registrar under section 127E(2)(c) of Ordinance

- (1) If an opposition notice is filed under section 81Q(1) of these Rules in opposition to an allowable amendment, and a counter-statement is filed under section 81R(1) of these Rules to resist the opposition, the Registrar—
- (a) must, before making a decision under section 127E(2)(c) of the Ordinance, consider—
 - (i) the opposition notice and the statement referred to in section 81Q(3)(b)(i) of these Rules;
 - (ii) the counter-statement;
 - (iii) the representation made at a hearing requested under section 82A(2) or (3) of these Rules, if any; and
 - (iv) the evidence furnished in accordance with the directions given under section 81S of these Rules, if any;
and
 - (b) must, under section 127E(2)(c) of the Ordinance—
 - (i) decide to allow the allowable amendment in whole or in part as an allowed amendment; or
 - (ii) decide to refuse to allow the allowable amendment.
- (2) If no opposition notice is filed in opposition to an allowable amendment, the Registrar must, having decided under section 127E(2)(c) of the Ordinance to allow the amendment in whole or in part, allow the amendment in whole or in part as an allowed amendment.
- (3) If a decision is made under subsection (1)(b)(i) or (2), the Registrar must, in addition to complying with section 127E(4)(a) and (b) of the Ordinance—
- (a) notify the proprietor of the short-term patent and the opponent referred to in section 81Q(1) of these Rules, if any, of the decision; and
 - (b) consider if the patent with the allowed amendment would achieve compliance with the examination requirements under section 127C(2) of the Ordinance.
- (4) If a decision is made under subsection (1)(b)(ii), the Registrar must—
- (a) notify the proprietor and the opponent of the decision; and
 - (b) advertise the decision by notice in the official journal.
- (5) To avoid doubt, the decision of the Registrar to not allow any allowable amendment does not in itself affect the duty of the Registrar to—
- (a) examine the patent to determine whether the patent complies with the examination requirements under section 127C(2) of the Ordinance; and
 - (b) make a consideration and decision or review under section 127E(1)(a)(i) or (b) of the Ordinance.
- (6) In this section—
- allowable amendment*** (可容許修訂) means a requested amendment—
- (a) accepted in whole or in part as an allowable amendment under section 81P(4)(a) of these Rules; and
 - (b) published under section 127E(2)(a) of the Ordinance.

81U. Publication of amendment under section 127E(2)(a) or (4)(a) of Ordinance

- (1) This section applies to the publication of an amendment under section 127E(2)(a) or (4)(a) of the Ordinance.
- (2) The Registrar may, if the Registrar thinks fit, by notice given to the proprietor of the patent, require the proprietor to file, for the purposes of publishing the amendment, the following copies of the amended specification (***required copies***) with the Registrar within the period specified by the Registrar—
- (a) a clean copy of the specification with the amendment incorporated into it; and
 - (b) a copy of the specification with the amendment incorporated into it and indicated in it.
- (3) For the purposes of subsection (2), the required copies must be prepared in compliance with the requirements specified in sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.
- (4) If the required copies are not filed within the period specified under subsection (2), the request for amendment to which the required copies relate is to be regarded as being withdrawn.

81V. Registrar to follow procedure in Part 9, Division 5 of these Rules

- (1) This section applies to the Registrar in the consideration of any relevant amendment.
- (2) If the Registrar, having considered the relevant amendment, is of the opinion that the relevant amendment does not achieve compliance with the examination requirement concerned, the Registrar must notify the proprietor of the Registrar's opinion by issuing a relevant document to the proprietor, as the case requires.
- (3) In deciding which relevant document to issue under subsection (2), the Registrar is to have regard to the nature of the document in which the relevant amendment is contained.

(4) Part 9, Division 5 of these Rules applies to any relevant document issued under subsection (2) and any part of the procedure including the subsequent procedure to be followed.

(5) In this section—

relevant amendment (有關修訂) means—

(a) a requested amendment referred to in section 81P(2)(b) of these Rules; and

(b) an allowed amendment referred to in section 81T(1)(b)(i) or (2) of these Rules;

relevant document (有關文件) means—

(a) an examination notice under section 81D(1) of these Rules;

(b) a further examination notice under section 81F(2) of these Rules;

(c) a review opinion under section 81J of these Rules; and

(d) a further review opinion under section 81L(2) of these Rules.

Part 12

Hearings and Agents

(L.N. 150 of 2014)

82. Registrar's discretionary powers

(1) Before exercising adversely to any person any discretionary power given to the Registrar by the Ordinance or these Rules the Registrar shall, if so ~~required~~requested by the person who would be so affected, hear him on the subject.

~~(2) A request under subsection (1) for a hearing shall be filed within 1 month from the date on which the person filing the request receives notice sent by the Registrar of any objection to an application or of any other proposal to exercise a discretionary power.~~

(2) A request made under subsection (1) for a hearing must be filed—

(a) for a request referred to in section 31ZK(2) of these Rules—within 2 months after the date of the relevant review opinion referred to in section 31ZJ of these Rules stating that the applicant may request a hearing;

(b) for a request referred to in section 31ZM(2) of these Rules—within 2 months after the date of the relevant further review opinion referred to in section 31ZL of these Rules stating that the applicant may request a hearing;

(c) for a request referred to in section 81K(2) of these Rules—within 2 months after the date of the relevant review opinion referred to in section 81J of these Rules stating that the proprietor may request a hearing;

(d) for a request referred to in section 81M(2) of these Rules—within 2 months after the date of the relevant further review opinion referred to in section 81L of these Rules stating that the proprietor may request a hearing;

(e) for any other request—within 1 month after the date on which the person filing the request receives from the Registrar the notice of any objection to an application or of any other proposal to exercise the Registrar's discretionary power.

(3) Upon receipt of a request filed under subsection (2) the Registrar shall send to the person making the request notice of a time when he may be heard, which shall be not less than 10 days after the date of receipt of the notice by that person.

(4) In inter partes proceedings, any party who intends to refer at the hearing to any document not already mentioned in the proceedings shall, unless the Registrar consents and the other party agrees, give at least 10 days notice of his intention with details of, or a copy of, the document to the Registrar and the other party.

(5) After hearing any party or parties desiring to be heard, the Registrar shall decide the matter and shall notify all parties of his decision and, if any party so desires, shall give his reasons for the decision.

(6) Subsections (2) and (3) do not apply to a hearing that is conducted at a request referred to in section 38C(6) or 81R(6) of these Rules.

82A. Request referred to in section 38C(6) or 81R(6) of these Rules

(1) This section applies in relation to a request referred to in section 38C(6) or 81R(6) of these Rules.

(2) A proprietor who files a counter-statement under section 38C or 81R of these Rules—

- (a) may, at the same time, request a hearing; or
- (b) may, after doing so, request a hearing no later than 1 month after the date of expiry of the time limit for the filing.
- (3) An opponent referred to in section 38C or 81R of these Rules, as the case requires, may, after the filing of the counter-statement, request a hearing no later than 1 month after the date of expiry of the time limit for the filing.
- (4) A request for hearing must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the request; and
 - (c) filed with the Registrar.
- (5) If the Registrar receives a request for hearing, the Registrar must, by notice given to the proprietor and the opponent, notify them of the date, time and place for the hearing.
- (6) At any time before the Registrar gives the notice, the person who filed the request may, by a notice in writing, withdraw the request.
- (7) A withdrawal under subsection (6) is irrevocable.
- (8) A proprietor or opponent who—
 - (a) did not file a request for hearing; and
 - (b) receives the notice referred to in subsection (5),
may, if the proprietor or the opponent intends to appear at the hearing, file a notice of intention to appear at the hearing with the Registrar.
- (9) A notice of intention to appear at the hearing must be—
 - (a) in the specified form;
 - (b) accompanied by the prescribed fee for the notice; and
 - (c) filed within 14 days after the date on which the proprietor or the opponent receives the notice referred to in subsection (5).
- (10) A person who may file a notice of intention under subsection (8) but has not done so may not appear at the hearing concerned.
- (11) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

83. Hearings in public

- (1) Subject to subsection (2), the following hearings must be held in public—
 - (a) any hearing before the Registrar of any dispute between 2 or more parties relating to any matter in connection with a patent; ~~and~~
 - (b) any such hearing in connection with an application for a standard patent which takes place after the publication of the request to record ~~in accordance with section 20 of the Ordinance, or after the publication of the standard patent (O) application in accordance with section 20 or 37Q of the Ordinance; and~~
 - (c) any hearing in connection with a short-term patent after the publication of the specification of the patent under section 118(2)(a) of the Ordinance.
~~shall be held in public.~~
- (2) After consulting those parties to the dispute who appear in person or are represented at a hearing to which subsection (1) applies, the Registrar may direct that the hearing be not held in public.

84. Signature of documents by partnerships, companies and associations

- (1) A document signed for or on behalf of a firm shall be signed by its partners, by any partner stating that he signs on behalf of the firm or by any other person who satisfies the Registrar that he is authorized to sign the document.
- (2) A document signed for or on behalf of a body corporate shall be signed by a director or the secretary or other principal officer of the body or by any other person who satisfies the Registrar that he is authorized to sign the document.
- (3) A document signed for or on behalf of an unincorporated body or association of persons other than a firm may be signed by any person who satisfies the Registrar that he is authorized to sign the document.

85. Agents

- (1) Except as otherwise required by these Rules, but without prejudice to section 84, any act required or permitted to be done under the Ordinance or these rules by or to any person may be done by or to an agent authorized by that person.
- (2) In any particular case the Registrar may require the personal signature or presence of any person.
- (3) The Registrar may by notice in writing sent to an agent require him to produce evidence of his authority.
- (4) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, which notice shall be given in the specified form or in writing. (*L.N. 37 of 2004*)
- (5) If a person who has given notice under subsection (4) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing. (*L.N. 37 of 2004*)
- (6) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subsection (4). (*L.N. 37 of 2004*)
- (7) The Registrar may refuse to recognize as an agent in respect of any business under the Ordinance or these Rules—
 - (a) a person who has been convicted of a criminal offence;
 - (b) a person whose name has been struck off the roll of barristers or roll of solicitors kept under and in accordance with the Legal Practitioners Ordinance (Cap 159) or any person who has been suspended from acting as a barrister or solicitor;
 - (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognize as an agent under paragraph (a) or (b);
 - (d) a person against whom a disqualification order has been made under section 168E, 168F, 168G, 168H, 168J or 168L of the Companies (Winding Up and Miscellaneous Provisions) Ordinance (Cap 32); (*28 of 2012 ss. 912 & 920*)
 - (e) a person against whom an order has been made under section 23(1)(a) or 24(1) of the repealed Securities (Insider Dealing) Ordinance (Cap 395); or
 - (f) a person against whom an order has been made under section 214(2)(d), 257(1)(a), 258(1) or 303(2)(a) of the Securities and Futures Ordinance (Cap 571). (*L.N. 37 of 2004*)

Note: Section 140(4) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong. (*L.N. 37 of 2004*)

86. Award of costs in proceedings before Registrar under section 49 of the Ordinance

If, in proceedings before the Registrar under section 49 of the Ordinance, the proprietor of a patent offers to surrender it under section 48 of the Ordinance, the Registrar shall, in deciding whether costs should be awarded to the person referring the question as to whether an invention is a patentable invention, consider whether proceedings might have been avoided if the person referring the question had given reasonable notice to the proprietor before the question was referred.

87. Security for costs

If any of the following persons, that is to say—

- (a) any person by whom a reference is made to the Registrar under section 13 or 37H of the Ordinance;
- (b) any person who has referred to the Registrar under section 49 of the Ordinance the question as to whether an invention is a patentable invention;
- (c) any person by whom notice of opposition is given to the Registrar under section 48(2) or 146(2) of the Ordinance;

(d) any person who files an opposition referred to in section 46(3)(c) or 127E(2)(b) of the Ordinance,

neither resides nor carries on business in Hong Kong, the Registrar may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.

Part 13

Information and Inspection

(L.N. 150 of 2014)

Part 13

Administrative and Miscellaneous Provisions

Division 1 — Information and Inspection

88. Request for information under section 147 of the Ordinance

- (1) A request under section 147 of the Ordinance—
 - (a) for information relating to any standard patent or standard patent application, may be made as to—
 - (i) when a request to record or a standard patent (O) application has been published;
 - (ii) when a standard patent has been granted;
 - (iii) in the case of an application for a standard patent which has been published, when an application has been withdrawn, is deemed to have been withdrawn or has been refused;
 - (iv) whether a maintenance fee has not been paid within the period specified in section 33(2) of the Ordinance;
 - (v) when a maintenance fee has been paid within the further period specified in section 33(4) of the Ordinance;
 - (vi) whether a renewal fee has not been paid within the period specified in section 39(2) of the Ordinance;
 - (vii) when a renewal fee has been paid within the further period specified in section 39(4) of the Ordinance;
 - (b) for information relating to the grant of any short-term patent, may be made as to—
 - (i) when a short-term patent has been granted;
 - (ii) whether a renewal fee has not been paid within the period specified in section 126(2) or (3) of the Ordinance;
 - (iii) when a renewal fee has been paid within the further period specified in section 126(5) of the Ordinance;
 - (c) for information relating to any patent or patent application, may be made as to—
 - (i) when a patent has ceased to have effect or when an application for restoration of a patent has been filed, or both;
 - (ii) when an entry has been made in the register or an application has been made for the making of such entry;
 - (iii) when any application or request is made or action taken involving an entry in the register or advertisement in the official journal, if the nature of the application, request or action is specified in the request; and *(2 of 2001 s. 19)*
 - (iv) when any document may be inspected in accordance with section 89 or 90.
- (2) Any such request shall be in the specified form. *(L.N. 37 of 2004)*

89. Restriction on inspection of documents under section 147 of the Ordinance

- (1) The following restrictions are prescribed for the purposes of section 147(1) of the Ordinance in relation to the giving of information or the inspection of documents—
 - (a) no document shall be open to inspection until 14 days after it has been filed at the registry;
 - (b) documents prepared in the registry ~~solely~~, or prepared by an adviser appointed under section 99(1) of these Rules, solely for use in the registry shall not be open to inspection;
 - (c) any document sent to the registry, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;
 - (d) no request made under section 50(2), 51(2) or 88 of these Rules or section 147 of the Ordinance shall be open to inspection; *(L.N. 37 of 2004)*
 - (e) documents in respect of which the Registrar issues directions under section 90 that they are to be treated as confidential shall not be open to inspection, except as permitted in accordance with that section; *(L.N. 37 of 2004)*
 - (f) any documents issued by the registry which the Registrar considers should be treated as confidential shall not be open to inspection unless the Registrar otherwise directs; and *(L.N. 37 of 2004)*

- (g) subject to the restrictions prescribed in paragraphs (a) to (f), only documents kept by the registry shall be open to inspection. (*L.N. 37 of 2004*)
- (2) Nothing in section 147 of the Ordinance shall be construed as imposing on the Registrar any duty of making available for public inspection, any document or any part of a document—
- (a) which in his opinion disparages any person in a way likely to damage him; or
- (b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

90. Confidential documents

- (1) A person filing with, or sending to, the Registrar, a document other than a document for which a form has been specified under section 150 of the Ordinance, or any party to any proceedings to which the document relates, may, within 14 days of the filing or sending of the document, request the Registrar (giving reasons for the request) to direct that the document or any part of it specified by him be treated as confidential, and the Registrar may, at his discretion, so direct; and while the request is being considered by the Registrar, that document or part of the document (in this section referred to as *the relevant document*) shall not be open to public inspection.
- (2) Where such a direction has been given and not withdrawn, nothing in this section shall be taken to authorize or require any person to be allowed to inspect the relevant document to which the direction relates except by leave of the Registrar. (*L.N. 37 of 2004*)
- (3) The Registrar shall not withdraw any direction given under this section, nor shall he give leave for any person to inspect any relevant document to which a direction which has not been withdrawn relates, without prior consultation with the person at whose request the direction was given, unless the Registrar is satisfied that such prior consultation is not reasonably practicable.
- (4) Where such a direction is given or withdrawn a record of the fact shall be filed with the relevant document to which it relates.
- (5) Where the period referred to in subsection (1) is extended under ~~section 100~~section 100AA of these Rules, the relevant document shall not be, or, if the period is extended after it has expired, shall cease to be, open to public inspection until the expiry of the extended period, and if a request for a direction is made the relevant document shall not be open to public inspection while the matter is being determined by the Registrar.

91. Bibliographic information for purposes of section 147(3) of the Ordinance

The following bibliographic information is prescribed for the purposes of section 147(3) of the Ordinance—

- (a) the number of the application;
- (b) the date of filing of the application and, where a statement has been made under section 37E(1) or 111 (1) of the Ordinance, the filing date, country and application number when available of each application referred to in that statement;
- (c) the name of the applicant or applicants;
- (ca) the address for service relating to the application; (*L.N. 37 of 2004*)
- (cb) if the application has been filed by an agent, the name of the agent and the address in Hong Kong where he resides or carries on his business activities; (*L.N. 37 of 2004*)
- (cc) the name and address of any person whose name and address the Registrar is required to communicate to any other person under ~~section 3~~section 3(6) or 31F(4)(b) of these Rules; (*L.N. 37 of 2004*)
- (d) the title of the invention;
- (e) if the application has been withdrawn, is deemed to have been withdrawn or has been refused, that fact; and
- (f) an alteration of name of the applicant or applicants under section 45.

92. Request for information where section 147(4) or (5) of the Ordinance applies

- (1) Where the circumstances specified in section 147(4) or (5) of the Ordinance exist, a request under section 147(1) of the Ordinance shall be accompanied by a statutory declaration verifying their existence and such documentary evidence (if any) supporting the request as the Registrar may require.
- (2) The Registrar shall send a copy of the request, the declaration and the evidence (if any) to the applicant for the patent and shall not comply with the request until the expiry of 14 days after that.

Division 2—Filing and Service of Documents and Related Matters

Part 14 Miscellaneous

(L.N. 150 of 2014)

93. Filing of documents with the Registrar

- (1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered by hand to the Registrar at the registry during the normal business hours of the registry or sent to the Registrar by post.
- (2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the registry.
- (3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the registry and is recorded as received.

(L.N. 37 of 2004)

93A. Electronic filing

- (1) The Registrar may at his discretion permit, as an alternative to the filing of a document or other thing with the Registrar in a paper or other physical form, the filing of an electronic record of that document or thing.
- (2) The Registrar may at his discretion permit, as an alternative to delivering or sending a document or other thing to the Registrar in the manner provided by section 93, the sending of an electronic record of that document or thing by electronic means to an information system designated by the Registrar.
- (3) The filing of an electronic record, and the sending of an electronic record by electronic means to the information system designated under subsection (2), shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person desiring to file an electronic record or to send an electronic record to the Registrar by electronic means.
- (4) Where, in accordance with this section, a document or other thing in the form of an electronic record is sent by electronic means to the information system designated under subsection (2), the filing of that document or thing shall be deemed to be effected at such time as that electronic record is accepted by the designated information system.

(L.N. 37 of 2004)

93B. Terms for electronic filing

- (1) Without limiting the generality of section 93A(3), the Registrar may specify terms under that section—
 - (a) providing for the approval by the Registrar of the process that must be used to make or send an electronic record;
 - (b) providing for the approval by the Registrar of the format or media in which an electronic record must be recorded or stored;
 - (c) respecting the manner of authenticating an electronic record in circumstances where the document or other thing in question is required to be signed or sealed or authenticated in any manner;
 - (d) requiring any document or other thing sent to the Registrar in the form of an electronic record to include or be accompanied by the electronic signature or digital signature of the person who sends it; and
 - (e) respecting the manner of filing a document or other thing in cases where there is an interruption in the operation of the information system designated under section 93A(2).
- (2) Without limiting the generality of section 93A(3), the Registrar may refuse to accept or to register any document or other thing that is in the form of an electronic record if—
 - (a) the information contained in the electronic record is not capable of being displayed in a legible form;
 - (b) the electronic record is not capable of being stored in the information system designated under section 93A(2);

- (c) the electronic record appears to the Registrar to be altered, damaged or incomplete;
- (d) any electronic signature or digital signature or other kind of authentication accompanying or included with the electronic record appears to the Registrar to be altered or incomplete; or
- (e) any term specified by the Registrar under that section has been breached.

(L.N. 37 of 2004)

93C. Designation of electronic mail box

- (1) On the request of any person, the Registrar may designate an electronic mail box within an information system designated by the Registrar which may be used by that person to communicate with the Registrar.
- (2) The use by any person of an electronic mail box within the designated information system shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person for whom the electronic mail box is designated.
- (3) Where the Registrar designates an electronic mail box for a person under this section, any document or other thing required or authorized by the Ordinance or these Rules to be sent by the Registrar to that person shall be deemed to be properly sent if it is sent in the form of an electronic record to that person's designated electronic mail box.
- (4) Sending to a designated electronic mail box shall be deemed to be effected at such time as the electronic record is accepted by the designated information system.
- (5) An electronic record sent to a designated electronic mail box shall be deemed to be received by the addressee at such time as the electronic record is accepted and recorded by that electronic mail box.

(L.N. 37 of 2004)

93D. Service of documents

- (1) Except as provided by sections 93, 93A, 93B and 93C, where any document or other thing is required or authorized by the Ordinance or these Rules to be sent to any person—
 - (a) the document or other thing may be left at, or sent by post to, the address for service of the person; or
 - (b) if the person does not have an address for service, the document or other thing may be sent by post to his last known address.
- (2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the address for service of the person or, if he does not have an address for service, at his last known address, and unless the contrary is shown, the document or thing shall be deemed to have been received by that person at the time when the letter would be delivered in the ordinary course of post.

(L.N. 37 of 2004)

93E. Form in which the records of the registry are kept, etc.

- (1) The Registrar shall determine the form in which the records of the registry are constituted and kept and may determine the period for which such records, or any document or other thing kept by the registry, shall be kept and the circumstances in which they may be destroyed or otherwise disposed of.
- (2) Where the Registrar keeps a record of a document or other thing in a form that differs from that in which the document or thing was originally filed with, or originally generated by, the Registrar, the record of that document or thing shall be presumed, unless the contrary is shown, to accurately represent the information contained in the document or thing as originally filed or generated.

(L.N. 37 of 2004)

94. Correction of irregularities

- (1) Subject to subsection (2), any document filed in any proceedings before the Registrar may, if he thinks fit, be amended, and any irregularity in procedure in or before the registry may be rectified, on such terms as he may direct.
- (2) In the case of an irregularity or prospective irregularity—

- (a) which consists of a failure to comply with any limitation as to times or periods prescribed in these Rules which has occurred, or appears to the Registrar is likely to occur in the absence of a direction under this section;
 - (b) which is attributable wholly or in part to an error, default or omission on the part of the registry; and
 - (c) which it appears to be Registrar should be rectified,
- the Registrar may direct that the time or period in question shall be altered but not otherwise.
- (3) Subsection (2) is without prejudice to the Registrar's power to ~~extend any times or periods under section 100~~ grant any extended period under section 100AA, 100AAB, 100AAC or 100AAD of these Rules.

95. Dispensation by Registrar

Where, under these Rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the Registrar may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence.

Division 3—Evidence

96. Evidence

- (1) Where under these Rules evidence may be filed, it shall be by statutory declaration or affidavit.
- (2) The Registrar may if he thinks fit in any particular case take oral evidence in lieu of or in addition to such evidence and shall allow any witness to be cross-examined on his affidavit or declaration, unless he directs otherwise.

97. Statutory declarations and affidavits

- (1) The statutory declarations or affidavits required by, or used in any proceedings under, the Ordinance shall be made and subscribed as follows—
 - (a) in Hong Kong, before any justice of the peace, notary public or any commissioner or other officer authorized by law in Hong Kong to administer an oath for the purpose of any legal proceeding;
 - (b) in any place outside Hong Kong before any court, judge, justice of the peace, notary public, notary, officer or other person authorized by law to administer an oath or to exercise notarization functions in that place for the purpose of a legal proceeding.
- (2) A person signing the declaration or affidavit by virtue of section 84 shall state on the declaration or affidavit the capacity in which he makes the declaration or affidavit. (*L.N. 402 of 1997*)
- (3) Any document purporting to have affixed, impressed or subscribed to or on it the seal or signature of any person authorized by this section to take a declaration or affidavit, in testimony that the declaration or affidavit was made and subscribed before him, may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration or affidavit. (*L.N. 402 of 1997*)

Division 4—Furnishing of Documents etc.

98. Directions as to furnishing of documents etc.

At any stage of any proceedings before the Registrar he may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.

98A. Registrar may make and send copy of document

For the purposes of any proceedings before the Registrar, the Registrar may, if the Registrar thinks fit—

- (a) make a copy of any document (or any part of the document) containing reference to the state of the art; and

(b) send the copy to any party to the proceedings.

Division 5—Advisers

99. Appointment of advisers

- (1) The Registrar may appoint an adviser to assist him in any proceeding before the Registrar and shall settle the question or instructions to be submitted or given to such adviser.
- (2) The Registrar may give directions as to who should be responsible for the payment of the remuneration of the advisers.

Division 6—Time Limits

100. Interpretation

In this Division—

current period (現行限期), in relation to an extended period to be granted under this Division (relevant extended period), means—

(a) if no extended period is granted under this Division—the initial period; and

(b) if an extended period has been granted under this Division—the extended period immediately before the relevant extended period;

extended period (延展期) means a period of extension granted by the Registrar under this Division;

initial period (首段限期) means the time or period prescribed in, or specified under, a provision in these Rules (except a provision in this Division or set out in Part 1 of Schedule 4 to these Rules) for doing any act or taking any proceedings under these Rules.

100. Alteration of time limits

- ~~(1) The times or periods prescribed by these Rules for doing any act or taking any proceeding under the Rules, other than times or periods prescribed in the provisions mentioned in subsection (2), may be extended by the Registrar if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted even though the time or period for doing such act or taking such proceeding has expired.~~
- ~~(2) The provisions referred to in subsection (1) are sections 11, 16, 17, 21, 23, 24, 29, 35(1), 40(2), 48(4), 53, 57, 67, 68 and 69. (L.N. 157 of 2002; L.N. 235 of 2002; L.N. 37 of 2004)~~

100AA. Extension of time—general provision

- (1) Subject to subsection (4), the Registrar may grant an extended period for a current period within which a person must do any act or a party must take any proceedings under these Rules if—
 - (a) a request is made to the Registrar in the specified form for the grant of an extended period; and
 - (b) the prescribed fee for the request is paid.
- (2) An extended period—
 - (a) is to be granted by the Registrar by giving to the person or the party a notice of the extended period; and
 - (b) may be granted on any terms as determined by the Registrar.
- (3) An extended period may be granted before or after the expiry of the current period.
- (4) The Registrar may not grant an extended period under this section for—
 - (a) an initial period that is prescribed in, or specified under, a provision set out in Part 2, 3, 4, 5, 6 or 7 of Schedule 4 to these Rules; and
 - (b) an extended period that has been granted under section 100AAB, 100AAC or 100AAD of these Rules.

100AAB. Grant of extended period on request

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 2, 3, 4 or 5 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if, before the expiry of the time limit referred to in subsection (2)—
- (a) a request is made to the Registrar in the specified form for the grant of an extended period; and
 - (b) the prescribed fee for the request is paid.
- (2) For the purposes of subsection (1), the time limit is—
- (a) for a provision set out in Part 2 or 4 of Schedule 4 to these Rules—the current period;
 - (b) for a provision set out in Part 3 of Schedule 4 to these Rules—1 month after the expiry of the current period;
or
 - (c) for a provision set out in Part 5 of Schedule 4 to these Rules—2 months after the expiry of the current period.
- (3) The extended period that may be granted under this section is—
- (a) for a provision set out in Part 2 or 3 of Schedule 4 to these Rules—1 month; and
 - (b) for a provision set out in Part 4 or 5 of Schedule 4 to these Rules—2 months.
- (4) No extended period may be granted under subsection (1) for any period for which an extended period has been granted under that subsection.

100AAC. Grant of extended period for failure or undue delay in postal services, natural disaster or strike

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 6 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if the Registrar is satisfied that the failure to do any act or take any proceedings required by the provision within the current period was wholly or mainly attributable to any of the following events in Hong Kong, or in the country, territory or area of the designated patent office, as the case requires—
- (a) any failure or undue delay in the postal services;
 - (b) any natural disaster;
 - (c) any strike.
- (2) The extended period that may be granted under this section is a period not exceeding 2 months that the Registrar considers reasonable.

100AAD. Grant of extended period for failure to file translation or transliteration

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 7 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if, after the expiry of the current period—
- (a) the applicant to whom the provision applies has—
 - (i) made a request to the Registrar in the specified form for the grant of an extended period; and
 - (ii) paid the prescribed fee for the request; and
 - (b) the Registrar is satisfied that the only deficiency remaining in the subject document is the failure to file—
 - (i) a translation of the title of the invention or the abstract referred to in section 56(2)(a) or (b) of these Rules; or
 - (ii) a transliteration of the names of the applicant or inventor referred to in section 56(2)(c) of these Rules.
- (2) The extended period that may be granted under this section is a period that the Registrar considers reasonable for correcting the only deficiency remaining.
- (3) In this section—
- subject document* (標的文件) means any of the following documents referred to in a provision in these Rules in which deficiencies are revealed and required to be corrected—
- (a) if the provision is section 17 of these Rules—a request to record under section 15 of the Ordinance;
 - (b) if the provision is section 24 of these Rules—a request for registration and grant under section 23 of the Ordinance;
 - (c) if the provision is section 31Y(1) of these Rules—a standard patent (O) application under section 37L of the Ordinance;
 - (d) if the provision is section 68(1) of these Rules—a short-term patent application under section 113 or 125 of the Ordinance.

100A. Extension of time limits in the case of an interruption in the registry's operations

- (1) Where on any day there is an event or circumstances causing an interruption in the normal operation of the registry, the Registrar may notify the day as being one on which there is an interruption in the operations of the registry.
- (2) Where any period of time specified in the Ordinance or these Rules, or as extended under these Rules, for the filing of any document or other thing with the Registrar expires on a day so notified, the period shall be extended to the first day next following (not being an excluded day) that is not so notified.
- (3) Any notification given by the Registrar under this section shall be posted in the registry.
- (4) In this section, *excluded day* (非辦公日) means a day that is not a business day of the registry.

(L.N. 37 of 2004)

Division 7—Publication, Sale, Verification and Advertisement

101. Publication and sale of documents

The Registrar may arrange for the publication and sale of copies of specifications and other documents in the registry and of indexes to, and abridgements or abstracts of, such documents.

102. Verification of documents

For the purposes of the Ordinance and these Rules, a filed copy of a document shall be treated as a verified copy if the person filing it confirms in writing to the Registrar that it is a true copy of a document issued by or kept at the relevant designated patent office.

(L.N. 37 of 2004)

103. Advertisements in relation to register

The Registrar may arrange for the publication and advertisement of such things done under the Ordinance or these Rules in relation to the register as he may think fit.

Division 8 — Fees

104. Fees

- (1) The fees to be paid in relation to any matter or proceeding under the Ordinance are those specified in Schedule 2.
- (2) Fees shall be paid by such means and in such manner as the Registrar directs.

Part 15 Transitional

(L.N. 150 of 2014)

105. Interpretation (Part 15)

In this Part and in Schedule 3, unless the context otherwise requires—

- (a) *Transitional Rules* (《過渡性規則》) means the Patents (Transitional Arrangements) Rules (Cap 514 sub. leg. B) made under section 158 of the Ordinance;
- (b) terms used which are also used in the Transitional Rules have the same meaning as in those Rules.

(E.R. 3 of 2015)

106. Entries in the register

- (1) In respect of a standard patent deemed to be granted by virtue of section 3(1) of the Transitional Rules, the details to be entered in the register for the purposes of section 13(2) of those Rules shall include—

- (a) the name and address of the applicant or applicants;
 - (b) the title of the invention;
 - (c) the date of filing and the publication number of the application for the corresponding 1949 Act or 1977 Act patent;
 - (d) the date of grant of the corresponding 1949 Act or 1977 Act patent;
 - (e) the date of filing of any application under the repealed Ordinance and its application number;
 - (f) the date on which the patent was registered under the repealed Ordinance;
 - (g) the name and address of the person or persons to whom the standard patent is deemed to be granted as on the commencement date, if different to the name in the entry made in accordance with paragraph (a);
 - (h) the number assigned by the Registrar to the certificate of registration issued under the repealed Ordinance.
- (2) In respect of standard patents granted by virtue of section 6, 8 or 9 of the Transitional Rules, the Registrar shall cause to be entered into the register—
- (a) the name and address of the applicant or applicants;
 - (b) the name of the person or persons stated by the proprietor as believed to be the inventor or inventors;
 - (c) the title of the invention;
 - (d) the date of filing and the publication number of the application for the corresponding 1949 Act or 1977 Act patent;
 - (e) the date of grant of the corresponding 1949 Act or 1977 Act patent;
 - (f) the date of filing of an application for a standard patent and its application number;
 - (g) the address for service of the proprietor;
 - (h) the date of filing and the application number of any application declared for the purposes of section **9811B** of the Ordinance and the country or territory in or for which the application was made;
 - (i) the date on which the patent is granted;
 - (j) the name and address of the person or persons to whom the standard patent is granted, if different to the name in the entry made in accordance with paragraph (a);
 - (k) the address for service, if different to the address in the entry made in accordance with paragraph (g);
 - (l) notice of any transaction, instrument or event referred to in section 52(3) of the Ordinance in relation to the patent.
- (3) The Registrar may at any time enter in the register such other particulars as he may think fit.
- (4) Section 43 of these Rules applies, with necessary modification, in relation to an application for a standard patent made by virtue of section 7 of the Transitional Rules and to a patent granted in pursuance of such an application as it applies in relation to an application for a standard patent based on a designated patent application and to a patent granted in pursuance of such an application.

107. Notice of proposed deletion from the register under section 13(3) of the Transitional Rules

- (1) If the Registrar proposes to delete any details in relation to a deemed standard patent from the register under section 13(3) of the Transitional Rules, the notice under section 13(6) of those Rules to the person named in the register as the proprietor of the deemed standard patent shall specify a period of not less than 1 month within which the proprietor may request to be heard in the matter, and if at the expiry of that period no such request has been received the Registrar shall make the deletion.
- (2) If the proprietor requests a hearing within the time allowed, the Registrar shall, after giving him an opportunity of being heard, determine whether the deletion shall be made.

108. Application under section 13(4) of the Transitional Rules

- (1) An application under section 13(4) of the Transitional Rules for the deletion from the register of any details in relation to a deemed standard patent shall be in the specified form. (*L.N. 37 of 2004*)
- (2) The applicant shall, at the same time as he files the application, send a copy of it to any person, other than the applicant, who is named in the register as the proprietor of the deemed standard patent. (*L.N. 37 of 2004*)
- (3) If any person who is sent a copy of the application under subsection (2) wishes to oppose the application, he (*the opponent*) shall, within 3 months from the date of the sending of the copies to him, file counter-statement setting out fully the grounds of his opposition; and the opponent shall send a copy of the counter-statement to the person making the application and to those recipients of the copy of the application who are not party to the counter-statement. (*L.N. 37 of 2004*)

- (4) The counter-statement shall be in the specified form and shall be accompanied by the prescribed fee. (*L.N. 37 of 2004*)
- (5) The person making the application or any recipient of the counter-statement may, within 3 months from the date of the sending of the copy of the counter-statement to him, file evidence in support of his case and shall send a copy of the evidence—
 - (a) in any case, to the opponent; and
 - (b) in the case of evidence filed by such a recipient, to the person making the application.
- (6) Within 3 months from the date of receipt of the copy of such evidence sent to him or, if no such evidence is filed, within 3 months of the expiration of the time within which it might have been filed, the opponent may file evidence in support of his case and shall send a copy of the evidence so filed to the person making the application and those recipients; and within 3 months from the date on which the copy of the opponent's evidence is sent to him, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in subsection (5)(a) and (b).
- (7) No further evidence shall be filed except by leave or direction of the Registrar.
- (8) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

109. Application under section 13(8) of the Transitional Rules

An application under section 13(8) of the Transitional Rules shall be in the specified form and shall be supported by evidence and the facts upon which the applicant relies.

110. Request for information under section 147 of the Ordinance

A request under section 147 of the Ordinance for information relating to any existing registered patent or pending application for registration of a patent under the repealed Ordinance as mentioned in section 5 of the Transitional Rules may be made only as to—

- (a) when a certificate of registration was issued under the repealed Ordinance;
 - (b) when the patent was first renewed under this Ordinance,
- and section 88(2) of these Rules shall apply accordingly.

111. Modified application of these Rules to applications by virtue of sections 6, 8 and 9 of the Transitional Rules

In the application of these Rules in relation to an application for a standard patent by virtue of section 6, 8 or 9 of the Transitional Rules, the provisions of these Rules specified in column 1 of Part 1 of Schedule 3 and of any other provision of these Rules referred to in such provision shall be read subject to the modifications specified opposite that provision in column 2 of Part 1 of that Schedule.

(L.N. 150 of 2014)

112. Modified application of these Rules to applications by virtue of section 7 of the Transitional Rules

In the application of these Rules in relation to an application for a standard patent by virtue of section 7 of the Transitional Rules, the provisions of these Rules specified in column 1 of Part 2 of Schedule 3 shall be read subject to the modifications specified opposite that provision in column 2 of Part 2 of that Schedule.

(L.N. 150 of 2014)

113. Transitional provision relating to the Patents (General) (Amendment) Rules 2004

The amendments to sections 3, 4, 6, 7, 35, 37, ~~38~~, 40, 41, 48 and 108 of these Rules effected by sections 4, 5, 6, 12, 13, ~~14~~, 16, 17, 21 and 39 of the Patents (General) (Amendment) Rules 2004 (*L.N. 37 of 2004*) do not apply to proceedings pending before the Registrar on the commencement* of those sections, which proceedings shall continue as if those amendments had not been made.

(L.N. 37 of 2004)

Editorial Note:

* Commencement date: 7 May 2004.

114. Transitional provisions relating to Patents (General) (Amendment) Rules 2019

- (1) Subject to subsection (2), these Rules as in force immediately before the commencement date of the Patents (General) (Amendment) Rules 2019 (Amendment Rules) continue to apply to proceedings before the Registrar that are pending immediately before that date as if the Amendment Rules had not been made.
- (2) Schedule 2 to these Rules as amended by the Amendment Rules applies to a fee that is—
 - (a) set out in that Schedule as in force immediately before the commencement date of the Amendment Rules; and
 - (b) payable before that date, but is paid on or after that date.

Schedule 1

~~{section 73}~~ [ss. 31ZW & 73 & Sch. 4]

Micro-organisms

(L.N. 150 of 2014)

1A. Interpretation

In this Schedule—

application for a patent (專利的申請) and patent application (專利申請) mean a standard patent (O) application or short-term patent application;
patent (專利) means a standard patent (O) or short-term patent.

1. Application

- (1) If an invention which is the subject of ~~an application for a short term patent, or a short term patent, a patent application or patent~~ requires for its performance the use of a micro-organism—
 - (a) which is not available to the public at the date of filing of the application; and
 - (b) which cannot be described in the application or the specification of the patent in such a manner as to enable the invention to be performed by a person skilled in the art,the invention ~~shall only be regarded~~ is to be regarded, in relation to the micro-organism itself, as being disclosed for the purposes of section 77 of the Ordinance if the conditions set out in subparagraph (2) are satisfied.
- (2) The conditions referred to in subparagraph (1) are that—
 - (a) not later than the date of filing of the application, a culture of the micro-organism has been deposited in a depositary institution which is able to furnish a sample of the micro-organism;
 - (b) the name of the depositary institution, the date when the culture was deposited and the accession number of the deposit are given in the specification of the application;
 - (c) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and
 - (d) where a new deposit is made under paragraph 3, the applicant or proprietor makes a new deposit in accordance with that paragraph.
- (3) ~~The~~ For a short-term patent application, the information specified in subparagraph (2)(b) shall be submitted—
 - (a) together with the request for grant of a short-term patent; or
 - (b) within 1 month after the Registrar has ~~communicated to the applicant that a right for information and inspection of documents under section 147(5) of the Ordinance exists,~~ informed the applicant that a request referred to in section 147(5) of the Ordinance has been made,whichever is the earlier.
- ~~(4) The giving of the information specified in subparagraph (2)(b) shall constitute the unreserved and irrevocable consent of the applicant to the deposited culture (including a deposited culture which is to be treated as having always been available by virtue of paragraph 3(2)) being made available in accordance with this Schedule to any person as from the date of grant of the short term patent or prior to that date to any person~~

- ~~having the right to information and inspection of documents under section 147(5) of the Ordinance subject to—~~
- ~~(a) the production of the Registrar's notice of confirmation regarding the release to the person who is named in the notice of confirmation as a person to whom the culture may be made available; and~~
- ~~(b) the making of a valid request, to the depositary institution with which the culture is deposited, for the culture to be made available.~~
- (4) For a standard patent (O) application, if the information specified in subparagraph (2)(b) is not submitted at the time the application is filed, it must be submitted before the earliest of the following time—
- (a) the expiry of 16 months after—
- (i) if priority has been claimed—the date of priority claimed; or
- (ii) if priority has not been claimed—the date of filing;
- (b) if a request is made under section 37Q(2) of the Ordinance—the date of the request;
- (c) the expiry of 1 month after the Registrar has informed the applicant that a request referred to in section 147(4) of the Ordinance has been made.
- (5) For a patent application, the applicant is, on giving the information specified in subparagraph (2)(b) in the specification of the application, to be regarded as having also given the specified consent under paragraph 1B.

1B. Specified consent

- (1) A specified consent—
- (a) is the consent of an applicant of a patent application to make a deposited culture available to—
- (i) an entitled person after the information specified in paragraph 1(2)(b) is given; and
- (ii) any person who is not an entitled person, after the date of publication of the standard patent (O) application or the date of grant of the short-term patent;
- (b) is unconditional and irrevocable; and
- (c) is subject to—
- (i) the production of the Registrar's confirmation notice regarding the release to the person who is named in the confirmation notice as a person to whom the culture may be made available; and
- (ii) the making of a valid request for the culture to be made available to the depositary institution with which the culture is deposited.
- (2) In subparagraph (1)—
- deposited culture** (寄存的培養物) includes a deposited culture that is treated under paragraph 3(2) as having always been available;
- entitled person** (具有權利的人) means a person who has the right to make a request in the circumstances specified in—
- (a) for a standard patent (O) application—section 147(4) of the Ordinance;
- (b) for a short-term patent application—section 147(5) of the Ordinance.

2. Availability of cultures

- (1) A request to the Registrar for the issue of a ~~notice of confirmation~~ confirmation notice regarding the release of a deposited culture shall be in the specified form. (*L.N. 37 of 2004*)
- (2) The Registrar shall send a copy of the form lodged with him under subparagraph (1) and of his ~~notice of confirmation~~ confirmation notice regarding the release of the sample— (*L.N. 37 of 2004*)
- (a) to the applicant for, or proprietor of, the patent;
- (b) to the depositary institution; and
- (c) to the person making the request.
- (3) A request under subparagraph (1) shall comprise, on the part of the person making the request, undertakings for the benefit of the applicant for, or proprietor of, the patent—
- (a) not to make the culture, or any culture derived from it, available to any other person; and
- (b) not to use the culture, or any culture derived from it, otherwise than for experimental purposes relating to the subject-matter of the invention,
- and, in this subparagraph, references to a culture derived from a deposited culture of a micro-organism are references to a culture so derived which exhibits those characteristics of the deposited culture essential for the performance of the invention.

- (4) Further to subparagraph (3)—
- (a) and subject to sub-subparagraph (c), both undertakings shall have effect during any period before the application for a patent has been withdrawn, is ~~deemed to have been to be regarded as being~~ withdrawn or has been refused ~~(including any further period allowed under section 94 or 100 of these Rules but excluding where an application is reinstated under either of those sections, the period before it is reinstated);~~
 - (b) if a patent is granted on the application, the undertaking set out in subparagraph (3)(a) shall also have effect during any period for which the patent is in force and during the further period of 6 months referred to in section 39(4) or 126(5) of the Ordinance; and
 - (c) the undertaking set out in subparagraph (3)(b) shall not have effect after the date of publication in the official journal of a notice advertising that the patent has been granted. *(2 of 2001 s. 19)*
- (4A) The period referred to in subparagraph (4)(a)—
- (a) if it is a period that has been altered under section 94 of these Rules or for which an extended period has been granted under section 100AA, 100AAB, 100AAC or 100AAD of these Rules—includes such altered period and extended period but does not include the period before the alteration or the grant of the extension; and
 - (b) if an application is reinstated under section 28 of the Ordinance as applied by section 37ZD or 123 of the Ordinance—does not include the period between the withdrawal, deemed withdrawal or refusal (as the case requires) and the reinstatement of the application.
- (5) For the purpose of enabling any Government use specified in section 69 of the Ordinance in relation to the culture, the undertakings specified in subparagraph (3)—
- (a) shall not be required from any Government department or person authorized in writing by a Government department for the purposes of this paragraph; and
 - (b) shall not have effect in relation to any such person who has already given the undertakings.
- (6) An undertaking given pursuant to subparagraph (3) may be varied by way of derogation by agreement between the applicant or proprietor and the person by whom it is given.
- (7) Where, in respect of a patent to which the undertaking set out in subparagraph 3(a) has effect, a compulsory licence is granted under section 64 of the Ordinance, that undertaking shall not have effect to the extent necessary for effect to be given to any such licence.

2A. Making cultures available only to experts

- (1) This paragraph and paragraphs 2B, 2C, 2D and 2E do not affect the rights of the Government or any person authorized in writing by a public officer under section 69 of the Ordinance.
- (2) This paragraph and paragraphs 2B, 2C, 2D and 2E apply if—
- (a) before preparations for publication of a patent application under one of the following provisions have been completed—
 - (i) for a standard patent (O) application—section 37Q(1)(a) of the Ordinance;
 - (ii) for a short-term patent application—section 118(2)(a) of the Ordinance; and
 - (b) the applicant for the patent has, by notice filed with the Registrar in the specified form, notified the Registrar of the intention of the applicant that the sample of micro-organism should be made available only to an expert.
- (3) If the applicant files the notice, the Registrar must—
- (a) at the time of publication of the standard patent (O) application under section 37Q(1)(a) of the Ordinance or the short-term patent under section 118(2)(a) of the Ordinance, advertise in the official journal that the provisions of this paragraph have effect; and
 - (b) despite paragraph 2, not issue any confirmation notice regarding the release of a deposited culture otherwise than under paragraph 2E until—
 - (i) the patent is granted; or
 - (ii) the patent application is—
 - (A) withdrawn;
 - (B) regarded as being withdrawn; or
 - (C) refused.

2B. Request to make cultures available to experts

- (1) If a notice is filed under paragraph 2A(2), any person may request the Registrar to make the sample of micro-organism available to an expert (*requester*).
- (2) The request must—
 - (a) be in the specified form;
 - (b) nominate the expert to whom the requester wishes the sample to be made available;
 - (c) set out the particulars and the credentials of the expert;
 - (d) be accompanied by the undertakings of the expert made for the benefit of the applicant for, or the proprietor of, the patent—
 - (i) not to make the sample, or any sample derived from it, available to any other person; and
 - (ii) not to use the sample, or any sample derived from it, otherwise than for experimental purposes relating to the subject matter of the invention; and
 - (e) be filed with the Registrar.
- (3) An undertaking—
 - (a) referred to in subparagraph (2)(d) has effect, subject to sub-subparagraph (c), during any period before the patent application has been withdrawn, is to be regarded as being withdrawn or has been refused;
 - (b) referred to in subparagraph (2)(d)(i) also has effect, if a patent is granted on the application, during any period for which the patent is in force and during the further period of 6 months referred to in section 39(4) or 126(5) of the Ordinance; and
 - (c) referred to in subparagraph (2)(d)(ii) does not have effect after the date of publication in the official journal of a notice advertising the grant of the patent.
- (4) The period referred to in subparagraph (3)(a)—
 - (a) if it is a period that has been altered under section 94 of these Rules or for which an extended period has been granted under section 100AA, 100AAB, 100AAC or 100AAD of these Rules—includes such altered period and extended period but does not include the period before the alteration or the grant of the extension; and
 - (b) if an application is reinstated under section 28 of the Ordinance as applied by section 37ZD or 123 of the Ordinance—does not include the period between the withdrawal, deemed withdrawal or refusal (as the case requires) and the reinstatement of the application.
- (5) For the purposes of enabling any Government use specified in section 69 of the Ordinance in relation to the culture, the undertakings referred to in subparagraph (2)(d)—
 - (a) are not required from any Government department or person authorized in writing by a Government department for the purposes of this paragraph; and
 - (b) do not have effect in relation to the expert who made the undertakings.
- (6) An undertaking referred to in subparagraph (2)(d) may be varied by way of derogation by agreement between—
 - (a) the applicant or proprietor; and
 - (b) the expert who made the undertaking.
- (7) If, in respect of a patent to which an undertaking referred to in subparagraph (2)(d) relates, a compulsory licence is granted under section 64 of the Ordinance, the undertaking does not have effect to the extent necessary for the licence to have effect.

2C. Applicant may file opposition notice

- (1) If a request is filed under paragraph 2B, the Registrar must—
 - (a) send a copy of the request to the applicant for the patent; and
 - (b) specify a period within which the applicant may file an opposition notice to oppose the request.
- (2) The Registrar may extend the period specified under subparagraph (1)(b) if, before its expiry, the applicant makes a request to the Registrar to extend the period.

2D. Opposition notice

- (1) An applicant for a patent who intends to oppose a request filed under paragraph 2B may file an opposition notice within the period specified under paragraph 2C(1)(b).

- (2) The opposition notice must—
 - (a) be in the specified form;
 - (b) set out the grounds of opposition to releasing a sample of micro-organism to the expert; and
 - (c) be filed with the Registrar.
- (3) An applicant who files an opposition notice must, at the same time, send a copy of it to the requester referred to in paragraph 2B(1).

2E. Confirmation notice in favour of expert

- (1) If an opposition notice is filed in accordance with paragraph 2D(1) and (2), the Registrar must—
 - (a) decide, having regard to the credentials of the expert and any other factors the Registrar considers relevant, whether to issue a confirmation notice in favour of the expert;
 - (b) if the Registrar decides to issue a confirmation notice in favour of the expert—send a copy of the request filed under paragraph 2B and the confirmation notice to—
 - (i) the applicant for the patent;
 - (ii) the depositary institution;
 - (iii) the requester referred to in paragraph 2B(1); and
 - (iv) the expert; and
 - (c) if the Registrar decides not to issue a confirmation notice—notify the requester and the applicant of the decision in writing.
- (2) If the Registrar notifies the requester under subparagraph (1)(c), the requester may nominate another expert under paragraph 2B.
- (3) If no opposition notice is filed in accordance with paragraph 2D(1) and (2), the Registrar must send a copy of the request and the confirmation notice to—
 - (a) the applicant;
 - (b) the depositary institution;
 - (c) the requester; and
 - (d) the expert.
- (4) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

3. New deposits

- (1) Where the depositary institution with which a deposit or a new deposit of a culture has been made under this Schedule—
 - (a) notifies the applicant or proprietor that it—
 - (i) cannot satisfy a request made in accordance with paragraph 2(1) or 2B(1); or
 - (ii) is not able lawfully, to satisfy such a request, for the culture to be made available;
 - (b) ceases temporarily or permanently to carry out the functions of a depositary institution; or
 - (c) ceases for any reason to conduct its activities as a depositary institution in an objective and impartial manner,
 then subject to subparagraph (3), the applicant or proprietor may, unless the culture has been transferred to another depositary institution which is able to make it available, make a new deposit of a culture of that micro-organism.
- (2) For the purposes of paragraph 1 and of this paragraph, the deposit shall be treated as always having been available if, within 3 months of the receipt of such notification or of the depositary institution ceasing to perform the functions of a depositary institution or to conduct its activities as such an institution in an objective and impartial manner, the applicant or proprietor, ~~—~~
 - (a) in a case where the deposit has not already been transferred, makes the new deposit;
 - (b) furnishes to the depositary institution with which the new deposit is made a declaration that the culture so deposited is of the same micro-organism as was the culture originally deposited; and
 - (c) requests amendment of the specification under section 37ZA, 46 or 120 of the Ordinance, as the case may be, so as to indicate the accession number of the transferred or new deposit and, where applicable, the name of the depositary institution with which the deposit has been made.

- (3) The new deposit referred to in subparagraph (1)—
- (a) shall, except as provided in sub-subparagraph (b), be made with the same depositary institution as was the original deposit; or
 - (b) in the cases referred to in subparagraph (1)(a)(ii), (b) and (c), shall be made with another depositary institution which is able to satisfy the request.

4. Interpretation of Schedule

- (1) In this Schedule—

the Budapest Treaty (《布達佩斯條約》) means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest in 1977 as revised or amended from time to time; and

international depositary authority (國際寄存主管當局) means ~~a depositary~~an institution which has acquired the status of international depositary authority as provided in Article 7 of the Budapest Treaty.

- (2) For the purposes of this Schedule a *depositary institution* ~~is an institution which, at all relevant times—~~
- ~~(a) carries out the functions of receiving, accepting and storing micro-organism and the furnishing of samples thereof; and~~
 - ~~(b) conducts its affairs in so far as they relate to the carrying out of those functions in an objective and impartial manner.~~
- is—
- (a) an international depositary authority; or
 - (b) an institution that at all relevant times—
 - (i) performs the functions of receiving, accepting and storing micro-organism and furnishing samples of micro-organism; and
 - (ii) conducts its affairs in so far as they relate to those functions in an objective and impartial manner.

Schedule 2

~~[section 104]~~[ss. 104 & 114]

Fees

(L.N. 150 of 2014)

<u>Fee No.</u> <u>Item</u>	Matter or proceeding	Amount \$
1	On reference under section 13(1)(a), 13(1)(b) or 14(5) <u>13(1)(a) or (b), 14(5), 37H(1)(a) or (b) or 37K(7)</u> of the Ordinance made to the Registrar to apply for grant of standard patent or licence or whether the period or terms of a licence are reasonable	190
2	On filing of notice of opposition or counter-statement under section 3(7), 7(4), 37(5), 38(5), 2C(1), 3(7), 7(4)(a), 31G(1), 31L(1), 37(5) , 40(3) or (4), 41(3), 48(5) or (6A) or 108(3) <u>of these Rules</u>	325
3	On application under section 13(5) <u>or 37I(4)</u> of the Ordinance for authorization by the Registrar to carry out directions under section 13(3)(c) or (4) <u>or 37I(1)(d)(ii)</u> of the Ordinance on behalf of the person to whom the directions were given	190
4	On filing request to record a designated patent application under section 15 or 22 of the Ordinance	380
<u>4</u>	<u>Filing request to record a designated patent application under section 15 or 22 of the Ordinance—</u>	

	<u>if the filing is made in paper or other physical form or is by fax</u>	<u>380</u>
	<u>if the filing is made by electronic means to an information system designated by the Registrar</u>	<u>275</u>
5	On filing request for registration of a designated patent and grant of a standard patent under section 23 of the Ordinance	380
5	<u>Filing request for registration of a designated patent and grant of a standard patent (R) under section 23 of the Ordinance—</u>	
	<u>if the filing is made in paper or other physical form or is by fax</u>	<u>380</u>
	<u>if the filing is made by electronic means to an information system designated by the Registrar</u>	<u>275</u>
6	On filing application for grant of a short-term patent under section 113, 116 or 125 of the Ordinance	755
6	<u>Filing application for grant of a short-term patent under section 113, 116 or 125 of the Ordinance—</u>	
	<u>if the filing is made in paper or other physical form or is by fax</u>	<u>755</u>
	<u>if the filing is made by electronic means to an information system designated by the Registrar</u>	<u>545</u>
7	Advertisement fee for request to record, or for request for registration and grant, under section 15 or 23 of the Ordinance	68
8	Advertisement fee for application for grant of a short-term patent under section 113 of the Ordinance	68
9	Additional fee for late payment of filing fee or advertisement fee for request to record, or for request for registration and grant, under section 11 or 21 <u>of these Rules</u>	95
10	Additional fee for late payment of filing fee or advertisement fee for application for grant of a short-term patent under section 68(6) <u>68A(2) of these Rules</u>	95
11	On application for maintenance of a standard patent <u>standard patent (R)</u> application under section 33 of the Ordinance—	
	Application for maintenance for a further year after the expiry of the 5th year	270
	Application for maintenance of any succeeding year thereafter	270
12	Additional fee for late payment of a maintenance fee under section 33(4) of the Ordinance	95
13	Request for renewal of a standard patent under section 39 of the Ordinance—	
	Request for renewal for a further year after the expiry of the 3rd year—	540
	Request for renewal of any succeeding year thereafter—	540
13	<u>Request for renewal of a standard patent under section 39 of the Ordinance—</u>	
	<u>request for renewal for a further year after the expiry of the 3rd, 4th, 5th, 6th, 7th, 8th or 9th year</u>	<u>450</u>
	<u>request for renewal for a further year after the expiry of the 10th, 11th, 12th, 13th or 14th year</u>	<u>620</u>
	<u>request for renewal for a further year after the expiry of the 15th, 16th, 17th, 18th or 19th year</u>	<u>850</u>
14	Additional fee for late payment of a renewal fee under section 39(4) of the Ordinance	270

15	Request for renewal of a short-term patent under section 126 of the Ordinance	1,080
16	Additional fee for late payment of a renewal fee under section 126(5) of the Ordinance	270
17	On application to restore a withdrawn standard patent application <u>standard patent (R) application</u> due to non-payment of maintenance fee under section 34 of the Ordinance	405
	On application to restore a lapsed standard patent under section 40 of the Ordinance	405
	On application to restore a lapsed short-term patent under section 127 of the Ordinance	405
18	Additional fee for reinstatement of a withdrawn patent application under section 28, <u>37ZD</u> or 123 of the Ordinance	405
	Additional fee for restoration of rights under section 29, <u>37ZD</u> or 123 of the Ordinance	405
19	Mention of inventor under section <u>459F</u> of the Ordinance	135
20	On application to revoke a standard patent <u>standard patent (R)</u> under section 44(4) of the Ordinance	190
	On reference to the Registrar under section 49 of the Ordinance to revoke a patent	190
21	On application to register or to give notice of rights acquired in or under a patent or an application for a patent under section 46 <u>of these Rules</u>	325
22	On request for correction of an error under section 51(2)(b)(ii) or 146 of the Ordinance	135
23-24	<i>(Repealed L.N. 37 of 2004)</i>	
25	Extension fee under section 17, 24, 29, 68 or 100 <u>100AA(1)(b) or 100AAB(1)(b) of these Rules</u>	215
26	Penalty fee for late filing of translation <u>or transliteration</u> under section 104 of the Ordinance or sections 17(4), 24(4), 56 or 68 <u>section 56(9) or 100AAD(1)(a)(ii)</u> of these Rules	190
27	Request to publish a corrected translation under section 106(3) of the Ordinance	190
28	Request for certified copy of an entry in the register or certified extract from the register under section 51(6) of the Ordinance.	95
	Request for a certificate for the purposes of section 51(10) of the Ordinance	95
29	For certifying office copy or photographic or printed matter, other than a certified copy of an entry in the register or a certified extract from the register	95
30	For providing uncertified copy or printout of an entry in the register, of an extract from the register or of a document (For each page or portion of a page)	6
<u>31</u>	<u>Restoration application under section 37D of the Ordinance and section 31B of these Rules, or under section 110A of the Ordinance and section 68B of these Rules</u>	<u>405</u>
<u>32</u>	<u>Filing statement of priority under section 31C(4) or 69(4) of these Rules</u>	<u>135</u>
<u>33</u>	<u>Filing standard patent (O) application under section 37L(1)(b) of the Ordinance and section 31M of these Rules, or under section 37Z(1)(b) of the Ordinance and section 31ZS of these Rules—</u>	
	<u>if the filing is made in paper or other physical form or is by fax</u>	<u>480</u>
	<u>if the filing is made by electronic means to an information system designated by the Registrar</u>	<u>345</u>

<u>34</u>	<u>Advertisement fee for standard patent (O) application under section 37L(5) of the Ordinance and section 31M(5) of these Rules</u>	<u>68</u>
<u>35</u>	<u>Additional fee for late payment of filing fee or advertisement fee for standard patent (O) application under section 31M(5)(b) of these Rules</u>	<u>95</u>
<u>36</u>	<u>Request for substantive examination of a standard patent (O) application under section 37T(1) of the Ordinance and section 31ZC of these Rules</u>	<u>4,000</u>
<u>37</u>	<u>Filing request to review under section 37V(3)(c) of the Ordinance and section 31ZI(1) of these Rules, or under section 127D(3)(c) of the Ordinance and section 81I(1) of these Rules</u>	<u>1,700</u>
<u>38</u>	<u>Request for hearing referred to in section 31ZK(2), 31ZM(2), 38A(8), 38C(6), 81K(2), 81M(2) or 81R(6) of these Rules</u>	<u>1,700</u>
<u>39</u>	<u>Application to amend specification after the grant of a patent under section 46 of the Ordinance and section 38A of these Rules</u>	<u>1,700</u>
<u>40</u>	<u>Filing opposition notice under section 38B(1) or 81Q(1) of these Rules</u>	<u>1,525</u>
<u>41</u>	<u>Filing counter-statement under section 38C(1) or 81R(1) of these Rules</u>	<u>325</u>
<u>42</u>	<u>Request for substantive examination of a short-term patent under section 127B(1)(a) of the Ordinance and section 81B(2)(b) of these Rules, or under section 127B(2) of the Ordinance and section 81B(3)(c) of these Rules</u>	<u>4,000</u>
<u>43</u>	<u>Filing notice of intention to appear at the hearing under section 82A(8) of these Rules</u>	<u>1,700</u>

(L.N. 37 of 2004)

Schedule 3

[ss. 105, 111 & 112]

Modified Application of these Rules to Applications for Standard Patents by virtue of the Transitional Rules

(L.N. 150 of 2014)

Part 1

Application for a Standard Patent by virtue of Sections 6, 8 and 9 of the Transitional Rules

(L.N. 150 of 2014)

Provision of these Rules

Modification

Section 19

For "designated patent" wherever it appears read "patent".

Section 19(1)

For "section 23(1) of the Ordinance" read "section 6, 8 or 9 of the Transitional Rules".

Part 2

Application for a Standard Patent by virtue of Sections 7 of the Transitional Rules

Provision of these Rules

Modification

- Section 8(1) (a) For "a designated patent application" read—
"any of the following applications, namely—
(a) an application in the United Kingdom Patent Office for a 1977 Act patent, which application has been published under the law of the United Kingdom Patent Office;
(b) an application in the European Patent Office for a European patent (UK), which application has been published under the law of the European Patent Office;
(c) an international application which has been published and which has validly entered its national phase in the United Kingdom Patent Office or the European Patent Office (as the case may be)".
(b) For the passage beginning "section 15" and ending "Ordinance)", read "section 7 of the Transitional Rules".
- Section 19 For "designated patent" read "patent".
- Section 19(1) For "section 23(1) of the Ordinance" read "section 7 of the Transitional Rules".

Schedule 4

[ss. 100, 100AA, 100AAB, 100AAC & 100AAD]

Time Limits

Part 1

Periods that may not be Extended under Section 100AA of these Rules

Column 1

Column 2

<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 11 (grace period)</u>
<u>2.</u>	<u>Section 16(1) (notice following examination under section 18 of Ordinance)</u>
<u>3.</u>	<u>Section 21 (grace period)</u>
<u>4.</u>	<u>Section 23(1) (communication following examination under section 25(1) of the Ordinance)</u>
<u>5.</u>	<u>Section 31B(6) (restoration of priority right under section 37D of Ordinance)</u>
<u>6.</u>	<u>Section 31C(4) and (7) (claiming priority under section 37E of Ordinance)</u>
<u>7.</u>	<u>Section 31M(5) (standard patent (O) application under section 37L of Ordinance)</u>
<u>8.</u>	<u>Section 31V(2)(b) (notice after examination of minimum requirement under section 37M of Ordinance)</u>
<u>9.</u>	<u>Section 31W(3) (requirements for making reference to earlier specified application referred to in section 37M(3)(c)(ii) of Ordinance)</u>
<u>10.</u>	<u>Section 31ZA(2) (observations by third parties)</u>
<u>11.</u>	<u>Section 31ZC(3) and (4) (request for substantive examination)</u>
<u>12.</u>	<u>Section 31ZS(2) (divisional standard patent (O) application under section 37Z of Ordinance)</u>
<u>13.</u>	<u>Section 31ZT(2) (request to amend standard patent (O) application before grant under section 37ZA(1) of Ordinance)</u>
<u>14.</u>	<u>Section 35(1) (amendment of standard patent (R) under section 43 of the Ordinance)</u>
<u>15.</u>	<u>Section 40(2) (surrender of patents)</u>

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>16.</u>	<u>Section 48(4) (correction of errors in patents and applications under section 146 of the Ordinance)</u>
<u>17.</u>	<u>Section 53(1) and (2) (time limit for application under section 58 of the Ordinance)</u>
<u>18.</u>	<u>Section 56(9) (the language of proceedings before the Registrar)</u>
<u>19.</u>	<u>Section 56B(1) and (3) (language requirements for sections 37E(1), 37M(3)(c)(ii), 111(1) and 114(3)(c)(ii) of Ordinance)</u>
<u>20.</u>	<u>Section 57(3) (filing of corrected translation under section 106(3) of the Ordinance)</u>
<u>21.</u>	<u>Section 67(2)(b) (notice after examination of minimum requirement under section 114 of Ordinance)</u>
<u>22.</u>	<u>Section 67A(3) (requirements for making reference to earlier specified application referred to in section 114(3)(c)(ii) of Ordinance)</u>
<u>23.</u>	<u>Section 68A(2) (extension of time for filing search report and paying filing fee or advertisement fee)</u>
<u>24.</u>	<u>Section 68B(6) (restoration of priority right under section 110A of Ordinance)</u>
<u>25.</u>	<u>Section 69(4) and (7) (claiming priority under section 111 of Ordinance)</u>
<u>26.</u>	<u>Section 74(1) (divisional short-term patent application under section 116 of the Ordinance)</u>
<u>27.</u>	<u>Section 78(1) (short-term patent application based on international application under section 125 of Ordinance)</u>
<u>28.</u>	<u>Section 79A(2) (observations by third parties)</u>
<u>29.</u>	<u>Paragraph 2C(1)(b) of Schedule 1 (micro-organisms)</u>

Part 2

Periods that may be Extended for 1 Month on Request under Section 100AAB of these Rules before Expiry of Current Period

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 38B(2) (opposition notice)</u>
<u>2.</u>	<u>Section 38C(2) (counter-statement)</u>
<u>3.</u>	<u>Section 81Q(2) (opposition notice)</u>
<u>4.</u>	<u>Section 81R(2) (counter-statement)</u>
<u>5.</u>	<u>Section 82(2)(c) and (d) (Registrar's discretionary powers)</u>
<u>6.</u>	<u>Section 82A(2)(b) and (3) (request referred to in section 38C(6) or 81R(6) of these Rules)</u>

Part 3

Periods that may be Extended for 1 Month on Request under Section 100AAB of these Rules no later than 1 Month after Expiry of Current Period

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 81E(1) (response to examination notice)</u>
<u>2.</u>	<u>Section 81G(1) (response to further examination notice)</u>
<u>3.</u>	<u>Section 81I(1) (request to review)</u>
<u>4.</u>	<u>Section 81K(1) (response to review opinion)</u>
<u>5.</u>	<u>Section 81M(1) (response to further review opinion)</u>

Part 4

Periods that may be Extended for 2 Months on Request under Section 100AAB of these Rules before Expiry of Current Period

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 17 (correction of deficiencies in request to record)</u>
<u>2.</u>	<u>Section 24 (correction of deficiencies in request for registration and grant)</u>
<u>3.</u>	<u>Section 29(2) (correction of deficiencies and removal of doubts in maintenance documents)</u>
<u>4.</u>	<u>Section 31X(1) and (2) (filing for purposes of section 37N of Ordinance)</u>
<u>5.</u>	<u>Section 31Y(1)(b) (correction of deficiencies in standard patent (O) application as regards formal requirements)</u>
<u>6.</u>	<u>Section 56C(1) and (2) (language requirements for sections 37N(5) and 114A(5) of Ordinance)</u>
<u>7.</u>	<u>Section 67B(1) and (2) (filing for purposes of section 114A of Ordinance)</u>
<u>8.</u>	<u>Section 68(1)(b) (correction of deficiencies in short-term patent application as regards formal requirements)</u>
<u>9.</u>	<u>Section 82(2)(a) and (b) (Registrar's discretionary powers)</u>

Part 5

Periods that may be Extended for 2 Months on Request under Section 100AAB of these Rules no later than 2 Months after Expiry of Current Period

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 31ZE(1) (response to examination notice)</u>
<u>2.</u>	<u>Section 31ZG(1) (response to further examination notice)</u>
<u>3.</u>	<u>Section 31ZI(1) (request to review)</u>
<u>4.</u>	<u>Section 31ZK(1) (response to review opinion)</u>
<u>5.</u>	<u>Section 31ZM(1) (response to further review opinion)</u>

Part 6

Periods that may be Extended for not exceeding 2 Months under Section 100AAC of these Rules

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 17 (correction of deficiencies in request to record)</u>
<u>2.</u>	<u>Section 24 (correction of deficiencies in request for registration and grant)</u>
<u>3.</u>	<u>Section 29(2) (correction of deficiencies and removal of doubts in maintenance documents)</u>
<u>4.</u>	<u>Section 31Y(1)(b) (correction of deficiencies in standard patent (O) application as regards formal requirements)</u>
<u>5.</u>	<u>Section 31ZC(2) (request for substantive examination)</u>
<u>6.</u>	<u>Section 31ZE(1) (response to examination notice)</u>
<u>7.</u>	<u>Section 31ZG(1) (response to further examination notice)</u>
<u>8.</u>	<u>Section 31ZI(1) (request to review)</u>

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>9.</u>	<u>Section 31ZK(1) (response to review opinion)</u>
<u>10.</u>	<u>Section 31ZM(1) (response to further review opinion)</u>
<u>11.</u>	<u>Section 68(1)(b) (correction of deficiencies in short-term patent application as regards formal requirements)</u>
<u>12.</u>	<u>Section 81E(1) (response to examination notice)</u>
<u>13.</u>	<u>Section 81G(1) (response to further examination notice)</u>
<u>14.</u>	<u>Section 81I(1) (request to review)</u>
<u>15.</u>	<u>Section 81K(1) (response to review opinion)</u>
<u>16.</u>	<u>Section 81M(1) (response to further review opinion)</u>

Part 7

Periods that may be Extended under Section 100AAD of these Rules

<u>Column 1</u>	<u>Column 2</u>
<u>Item</u>	<u>Provision of these Rules to which the period relates</u>
<u>1.</u>	<u>Section 17 (correction of deficiencies in request to record)</u>
<u>2.</u>	<u>Section 24 (correction of deficiencies in request for registration and grant)</u>
<u>3.</u>	<u>Section 31Y(1)(b) (correction of deficiencies in standard patent (O) application as regards formal requirements)</u>
<u>4.</u>	<u>Section 68(1)(b) (correction of deficiencies in short-term patent application as regards formal requirements)</u>