

HONG KONG
Patents (General) Rules
as amended by L.N. 40 of 2004
ENTRY INTO FORCE: May 7, 2004
Chapter: 514C

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PART I PRELIMINARY

Section 1 (omitted as spent)

Section 2 Interpretation

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

"application number" 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" has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

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

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

"European Patent Office" 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" has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap 553); (L.N. 37 of 2004)

"International Patent Classification" 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" 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" includes give, and cognate expressions are to be construed accordingly; (L.N. 37 of 2004)

"State Intellectual Property Office" 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" 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)

Section 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 II APPLICATIONS FOR STANDARD PATENTS

Right to apply

Section 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 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 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 for that invention has been published before the reference is filed, to each person who 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 of the names and addresses of those persons.

(5) In addition, if an application for a standard patent 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; 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 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, 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.

(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).

(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.

(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.

(L.N. 37 of 2004)

Section 4 (Repealed L.N. 37 of 2004)

Section 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 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 under subsection (1).

Section 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.

(L.N. 37 of 2004)

Section 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, within 3 months from the date on which the copies are sent to him, file a counter-statement setting out fully the grounds of his 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.

(L.N. 37 of 2004)

Request to record a designated patent application

Section 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;

(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 of the National Application Notification 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 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.

Section 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 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; 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, 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 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.

Section 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 55 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.

Section 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.

Section 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.

Section 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.

Section 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.

Section 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 of the National Application Notification 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.

(2 of 2001 s. 18)

Section 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.

Section 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.

Section 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.

Request for registration and grant

Section 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.

(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.

Section 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.

Section 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.

Section 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.

Section 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) 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.

Section 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.

Section 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 shall be in the specified form and shall

be accompanied by the additional prescribed fee.

Section 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 shall be in the specified form and shall be accompanied by the additional prescribed fee.

PART III PROVISIONS AS TO APPLICATIONS FOR STANDARD PATENTS BEFORE GRANT

Section 27 Amendment of application for standard patent under section 31 of the Ordinance

(1) Any amendment under section 31 of the Ordinance to an application for a standard patent 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.

Section 28 Maintenance of application for standard patent under section 33 of the Ordinance

(1) An application to maintain an application for a standard patent 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 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 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.

Section 29 Rectification 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.

(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.

Section 30 Notification of deemed withdrawn application for standard patent

Where--

(a) an application for a standard patent 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 of the fact and draw his attention to the provisions of section 34 of the Ordinance.

Section 31 Restoration of application for standard patent under section 34 of the Ordinance

(1) An application to restore an application for a standard patent under section 34 of the Ordinance shall be in the specified form and be signed by the applicant.

(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 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.

(3) If, upon consideration of the statements, 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)

PART IV PROVISIONS AS TO PATENTS AFTER GRANT

Standard patents

Section 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.

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.

Section 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;
- (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.

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

Section 35 Amendment of standard patent 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,
- 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.

Section 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.

Section 37 Revocation of standard patent 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 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 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, 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.

Patents generally

Section 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.

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

Section 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 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.

Section 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) 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.

PART V PROPERTY IN PATENTS AND APPLICATIONS; REGISTRATION

Section 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)

Section 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--

- (a) any previously filed address for service of the person;
- (b) any address of the person in Hong Kong that is shown in the register;
- (c) any residential or business address of the person in Hong Kong; and
- (d) 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--

- (a) any application (other than an application for a patent), notice or request filed by that person shall be treated as abandoned or withdrawn; and
- (b) 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.

(L.N. 37 of 2004)

Section 43 Entries in the register

(1) No entry shall be made in the register--

- (a) 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
- (b) in respect of any application for a short-term patent before the short-term patent has been granted.

(2) Upon publication of the application for the standard patent or upon

grant of the short-term patent, the Registrar shall cause to be entered in the register--

- (a) the name and address of the applicant or proprietor (as the case may be);
- (b) the name of the person stated by the applicant or proprietor believed to be the inventor or inventors;
- (c) the title of the invention;
- (d) the date of filing of the application for the patent and the application number;
- (e) the date of filing and the application number of any application declared for the purposes of section 98 or 111 of the Ordinance and the country, territory or area in or for which the application was made;
- (f) in the case of an application for a standard patent, the date of filing and the publication number of the corresponding designated patent application;
- (g) the date of publication of the application for the standard patent or grant of the short-term patent (as the case may be); and
- (h) the address for service of the applicant or proprietor (as the case may be).

(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--
 - (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) 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.

Section 44 Entries relating to section 13(1) of the Ordinance

On the reference to the Registrar of a question under section 13(1) of the Ordinance he 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.

Section 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.

Section 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.

Section 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.

Section 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-
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(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.

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

Section 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 copy of an entry in or extract from the register shall be requested only in accordance with section 51.

Section 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)

Section 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 VI EMPLOYEES' INVENTIONS

Section 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 VII REVOCATION OF PATENTS

Section 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.

Section 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 VIII LANGUAGE OF PROCEEDINGS; AUTHENTIC TEXT

Section 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) and 113(3) of the Ordinance and sections 8, 19 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) and 113(2)(c) of the Ordinance, if any documents supporting the respective statements under sections 15(2)(d), 23(3)(b) 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.

(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.

Section 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 IX APPLICATIONS FOR SHORT-TERM PATENTS

Section 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;
- (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.

Section 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.

(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.

Section 60 Drawings

(1)(a) Drawings forming part of an application for a short-term patent shall be on sheets the usable service 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;

(l) 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.

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.

Section 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.

(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 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)

Section 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.

Section 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 possible.

(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.

Section 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)

Section 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.

Section 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.

Section 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.

Section 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)

Section 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(b) 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;

(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;

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

Section 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.

Section 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.

Section 73 Requirements concerning applications relating to micro-organisms 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.

Section 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 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.

PART X PROCEDURE UP TO AND INCLUDING GRANT OF SHORT-TERM PATENTS

Section 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.

Section 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.

Section 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.

Section 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 of the National Application Notification 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.

PART XI PROVISIONS AS TO SHORT-TERM PATENTS AFTER GRANT

Section 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.

Section 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.

Section 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.

PART XII HEARINGS AND AGENTS

Section 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 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.

(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.

Section 83 Hearings in public

(1) Subject to subsection (2)--

(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, 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.

Section 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.

Section 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 Ordinance (Cap 32);
- (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)

Section 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.

Section 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 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,
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 XIII INFORMATION AND INSPECTION

Section 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 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)

Section 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 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.

Section 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, 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.

Section 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 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; (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.

Section 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.

PART XIV MISCELLANEOUS

Section 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)

Section 93A Electric 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)

Section 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)

Section 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)

Section 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)

Section 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)

Section 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 appears to 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.

Section 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.

Section 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.

Section 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)

Section 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.

Section 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.

Section 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)

Section 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" means a day that is not a business day of the registry.

(L.N. 37 of 2004)

Section 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.

Section 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)

Section 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.

Section 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 XV TRANSITIONAL

Section 105 Interpretation (Part XV)

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

- (a) "Transitional Rules" means the Patents (Transitional Arrangements) Rules 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.

Section 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 98 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.

Section 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.

Section 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.

Section 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.

Section 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.

Section 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 I of that Schedule.

Section 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 II of Schedule 3 shall be read subject to the modifications specified opposite that provision in column 2 of Part II of that Schedule.

Section 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)

SCHEDULE 1 MICRO-ORGANISMS (Section 73)

1. Application

(1) If an invention which is the subject of an application for a short-term patent, or a short-term 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 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 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, 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.

2. Availability of cultures

(1) A request to the Registrar for the issue of a notice of confirmation 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 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 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 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)

(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.

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

(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 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" means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest in 1977; and

"international depositary authority" means a depositary 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.

SCHEDULE 2 FEES (Section 104)

Fee No.	Matter or proceeding	Amount \$
1	On reference under section 13(1)(a), 13(1)(b) or 14(5) 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), 40(3) or (4), 41(3), 48(5) or (6A) or 108(3)	325
3	On application under section 13(5) of the Ordinance for authorization by the Registrar to carry out directions under section 13(3)(c) or (4) 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
5	On filing request for registration of a designated patent and grant of a standard patent under section 23 of the Ordinance	380
6	On filing application for grant of a short-term patent under section 113, 116 or 125 of the Ordinance	755
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	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)	95
11	On application for maintenance of a standard patent 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
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 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 or 123 of the Ordinance	405
	Additional fee for restoration of rights under section 29 or 123 of the Ordinance	405
19	Mention of inventor under section 45 of the Ordinance	135
20	On application to revoke a standard patent 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	325
22	On request for correction of an error under section 51(2)(b)(ii) or 146 of the Ordinance	135
23	(Repealed L.N. 37 of 2004)	
24	(Repealed L.N. 37 of 2004)	
25	Extension fee under section 17, 24, 29, 68 or 100	215
26	Penalty fee for late filing of translation under section 104 of the Ordinance or sections 17(4), 24(4), 56 or 68 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

(L.N. 37 of 2004)

SCHEDULE 3 MODIFIED APPLICATION OF THESE RULES TO APPLICATIONS FOR STANDARD PATENTS BY VIRTUE OF THE TRANSITIONAL RULES (Sections 105, 111 & 112)

PART I APPLICATION FOR A STANDARD PATENT BY VIRTUE OF SECTIONS 6, 8 AND 9 OF THE TRANSITIONAL RULES

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 II APPLICATION FOR A STANDARD PATENT BY VIRTUE OF SECTION 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".