

L.N. 35 of 2019

## Patents (General) (Amendment) Rules 2019

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## Patents (General) (Amendment) Rules 2019

(Made by the Registrar of Patents under section 149 of the Patents Ordinance (Cap. 514) with the consent of the Financial Secretary)

### 1. Commencement

These Rules come into operation on a day to be appointed by the Registrar of Patents by notice published in the Gazette.

### 2. Patents (General) Rules amended

- (1) The Patents (General) Rules (Cap. 514 sub. leg. C) (*principal Rules*) are amended as set out in subsections (2) and (3) and sections 3 to 76.
- (2) The provisions of the principal Rules set out in column 2 of Schedule 1 are amended by repealing the words set out in column 3 of that Schedule and substituting the words set out in column 4 of that Schedule.
- (3) The headings of certain Parts and Divisions of the principal Rules are amended as set out in Schedule 2.

### 3. Part 1A added

After Part 1—

**Add**

## “Part 1A

### Mention of Inventor

#### 2B. Request

- (1) A person (*requester*) may make a request to the Registrar in relation to section 9F(1) or (2) of the Ordinance (*request*) that—

- (a) for a request to make a finding in relation to section 9F(1) of the Ordinance—the requester has a right to be mentioned as the inventor or a joint inventor of an invention in—
    - (i) any published patent application for the invention; or
    - (ii) any patent granted for the invention; or
  - (b) for a request to make a finding in relation to section 9F(2) of the Ordinance—a person ought not to have been mentioned as the sole inventor or a joint inventor of an invention in—
    - (i) any published patent application for the invention; or
    - (ii) any patent granted for the invention.
- (2) The request must be—
- (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement setting out—
      - (A) the facts on which the requester relies; and
      - (B) the finding sought; and
    - (ii) the prescribed fee for the request; and
  - (c) filed with the Registrar.
- (3) A requester who files a request must, at the same time—
- (a) send a copy of the request and statement to each person who meets the conditions specified in subsection (4);

- (b) attach to each copy of the request and statement a list of the names and addresses of all those persons; and
  - (c) notify the Registrar in writing of those names and addresses.
- (4) The conditions are that—
- (a) the person is not the requester; and
  - (b) the person falls within any of the following descriptions—
    - (i) the person is registered as a proprietor of the patent;
    - (ii) the person is an applicant for the patent;
    - (iii) the person has been identified in the patent application or the patent as the inventor or a joint inventor of the invention;
    - (iv) the person has been identified in the statement as the inventor or a joint inventor of the invention;
    - (v) the person is shown in the register as having a right in or under the patent application or the patent.

## **2C. Counter-statement**

- (1) A person who receives a copy of a request and statement under section 2B(3)(a) of these Rules and intends to oppose the request (*opponent*) may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 3 months after the date on which the copy of the request and statement is received by the opponent.

- (3) The counter-statement must—
  - (a) be in the specified form;
  - (b) set out the grounds of opposition; and
  - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) An opponent who files a counter-statement must, at the same time, send a copy of it to—
  - (a) the person making the request; and
  - (b) all other persons to whom a copy of the request and statement is sent.
- (5) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

#### **4. Part 2, Division 1A added**

Part 2, before Division 1—

**Add**

### **“Division 1A—Novelty**

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

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

- (a) an official, or officially recognized, international exhibition within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong;

- (b) an international exhibition sponsored or recognized by the Central People’s Government;
- (c) an academic or technological meeting organized by—
  - (i) a competent agency of the Central People’s Government; or
  - (ii) a national academic or technological association recognized by the Central People’s Government.”.

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

- (1) Section 3(3)(c), after “who”—

**Add**

“is not a party to the reference and”.

- (2) Section 3(4), after “Registrar”—

**Add**

“in writing”.

- (3) Section 3(7)—

**Repeal**

“is sent”

**Substitute**

“receives”.

- (4) Section 3(7)—

**Repeal**

“sent to him”

**Substitute**

“received by the person”.

## (5) Section 3—

**Repeal subsection (9)****Substitute**

- “(9) A person referred to in subsection (8)(a), (b) or (c)—
- (a) may, within 3 months after the date on which the copy of the counter-statement is received by the person, file evidence in support of the case of the person making the reference; and
  - (b) if the person files the evidence—must send a copy of it to—
    - (i) the opponent; and
    - (ii) if the evidence is not filed by the person making the reference—the person making the reference.”.

## (6) After section 3(9)—

**Add**

- “(9A) On filing evidence under subsection (9), a person referred to in subsection (8)(b) or (c) joins as a party to the reference.”.

## (7) Section 3(10)—

**Repeal**

everything after “of evidence is”

**Substitute**

“received by the opponent under subsection (9) or, if no evidence is filed under that subsection, within 3 months after the expiry of the time within which the evidence might have been filed, the opponent—

- (a) may file evidence in support of the opponent’s case; and

- (b) if the opponent files the evidence—must send a copy of it to—
  - (i) the person making the reference; and
  - (ii) any other person who has filed the evidence under subsection (9).”.

(8) Section 3(11)—

**Repeal**

everything after “copy is”

**Substitute**

“received by the person, file further evidence confined to matters strictly in reply to the opponent’s evidence and, if the person files the further evidence, the person must send a copy of it to—

- (a) the opponent; and
- (b) if further evidence is filed by that other person—the person making the reference.”.

(9) Section 3—

**Repeal subsection (13)**

**Substitute**

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

**6. Section 5 amended (orders under section 13 of the Ordinance)**

Section 5(2)(a) and (b)—

**Repeal**

“on which a notification is sent to him”

**Substitute**

“of the notification”.

**7. Section 6 amended (authorization under section 13(5) of the Ordinance)**

Section 6(3)—

**Repeal**

everything after “give”

**Substitute**

“directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**8. Section 7 amended (reference to the Registrar under section 14(5) of the Ordinance)**

(1) Section 7(3)—

**Repeal**

“he shall”

**Substitute**

“the recipient must”.

(2) Section 7(3)—

**Repeal**

“sent to him”

**Substitute**

“received by the recipient”.

(3) Section 7(3), English text—

**Repeal**

“his”



**Substitute**

“the recipient’s”.

- (4) Section 7(5)—

**Repeal**

everything after “give”

**Substitute**

“directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**9. Section 8 amended (request to record a designated patent application under section 15 of the Ordinance)**

- (1) Section 8(2)(d)—

**Repeal subparagraph (iv)**

**Substitute**

“(iv) the following date—

- (A) if the designated patent application is based on the international application referred to in section 15(1)(a)(i), (ii) or (iii) of these Rules, as the case requires—the date of publication of the international application by the designated patent office showing that the international application has entered the national phase in the designated patent office; or
- (B) the date of issuance of an official notification referred to in section 15(1)(b) of these Rules, if applicable;”.

- (2) Section 8(2)(d)—

**Repeal subparagraph (v).**

**10. Section 10 amended (details relating to the previous disclosure of the invention)**

Section 10(a)—

**Repeal**

“55”

**Substitute**

“2D”.

**11. Section 11 substituted**

Section 11—

**Repeal the section**

**Substitute**

**“11. Grace period**

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

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

**12. Sections 15, 16 and 17 substituted**

Sections 15, 16 and 17—

**Repeal the sections****Substitute****“15. Date of publication of designated patent application based on international application under section 16 of Ordinance**

- (1) For the purposes of section 15(1) of the Ordinance, and despite section 5(2)(d)(ii) of the Ordinance—
  - (a) the reference to the date of publication of the designated patent application based on an international application under section 16(a)(i) of the Ordinance is to be construed as—
    - (i) for an international application designating the European Patent Office—the date of publication by the European Patent Office in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the European Patent Office;
    - (ii) for an international application designating the United Kingdom Patent Office—the date of publication by the United Kingdom Patent Office in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the United Kingdom Patent Office; or
    - (iii) for an international application designating the State Intellectual Property Office—the date of publication by the State Intellectual Property Office in its Patent Gazette of the

relevant bibliographical data showing that the international application has entered the national phase in the State Intellectual Property Office; and

- (b) the reference to the other date referred to in section 16(a)(ii) of the Ordinance as applicable to an international application designating the State Intellectual Property Office published by the International Bureau in the Chinese language is to be construed as the date of issuance of an official notification by the State Intellectual Property Office stating that the international application has entered the national phase in the State Intellectual Property Office.
- (2) An application to which section 16(a)(ii) of the Ordinance applies must be accompanied by a copy of the official notification issued by the State Intellectual Property Office.

#### **16. Notice following examination under section 18 of Ordinance**

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

**17. Correction of deficiencies in request to record**

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

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

Section 19(1)—

**Repeal**

everything after “Ordinance”

**Substitute**

“must be in the specified form.”.

**14. Section 21 substituted**

Section 21—

**Repeal the section**

**Substitute**

**“21. Grace period**

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

(a) that is allowed by the Registrar by a notice given to the applicant; and

(b) that—

- (i) begins on the date of expiry of the time limit; and
- (ii) ends at the expiry of 1 month after the date of the notice.”.

**15. Section 23 amended (communication following examination on filing under section 25(1) of the Ordinance)**

- (1) Section 23, heading—

**Repeal**

“on filing”.

- (2) Section 23(1)—

**Repeal**

“25(3)(b)”

**Substitute**

“25(4)”.

**16. Section 24 substituted**

Section 24—

**Repeal the section**

**Substitute**

**“24. Correction of deficiencies in request for registration and grant**

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

correct the deficiencies within 2 months after the date of the notice.”.

**17. Section 29 amended (rectification of deficiencies and removal of doubts in maintenance documents)**

- (1) Section 29, heading—

**Repeal**

**“Rectification”**

**Substitute**

**“Correction”.**

- (2) Section 29—

**Repeal subsections (1) and (2)**

**Substitute**

“(1) Subsection (2) applies if the Registrar—

- (a) notes deficiencies in a maintenance application under section 33(2) of the Ordinance; or
- (b) has reason to doubt the veracity of any statement in the application.

(2) The Registrar must, by notice given to the applicant, notify the applicant that unless the applicant corrects the deficiencies or removes the doubt, as the case requires, within 2 months after the date of the notice, the maintenance application is to be refused.”.

- (3) Section 29—

**Repeal subsection (3).**

**18. Section 31 amended (restoration of application for standard patent under section 34 of the Ordinance)**

(1) Section 31(1)—

**Repeal**

everything after “Ordinance”

**Substitute**

“must be in the specified form.”.

(2) Section 31(2)—

**Repeal**

“including, but without limiting those matters, statements”.

(3) After section 31(2)—

**Add**

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

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

(4) Section 31(3), after “statements”—

**Add**

“and the evidence (if any)”.

(5) Section 31—

**Repeal subsection (5)**

**Substitute**



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

**19. Part 3A added**

Before Part 4—

**Add**

**“Part 3A**

**Standard Patents by Original Grant**

**Division 1—Novelty and Priority**

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

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

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

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

- (1) This section applies to a restoration application under section 37D of the Ordinance in relation to the priority right of a subsequent standard patent (O) application referred to in section 37D(1)(b) of the Ordinance.
- (2) A restoration application must be—
  - (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement of priority referred to in section 37E(1) of the Ordinance;
    - (ii) evidence—
      - (A) to establish why the subsequent standard patent (O) application was not filed before the expiry of the period of 12 months referred to in section 37C(2) of the Ordinance; and

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

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

### **31C. Claiming priority under section 37E of Ordinance**

- (1) Subject to section 31D of these Rules, this section applies if—
  - (a) an applicant of a standard patent (O) application (*subsequent application*) claims priority of a non-Hong Kong application or Hong Kong application (*previous application*) under section 37E of the Ordinance; and
  - (b) the date of filing of the subsequent application is within 12 months after the date of filing of the previous application.

- 
- (2) The applicant must file with the Registrar—
    - (a) a statement of priority; and
    - (b) the documents referred to in subsection (7).
  - (3) A statement of priority must be filed with the Registrar in the specified form together with the subsequent application.
  - (4) Despite subsection (3), if the conditions specified in subsection (5) are met, the statement of priority may be filed within 16 months after the earliest date of priority claimed.
  - (5) The conditions are that—
    - (a) the statement of priority is accompanied by the prescribed fee; and
    - (b) either one of the following—
      - (i) the applicant has not made a request under section 37Q(2) of the Ordinance for publication of the subsequent application;
      - (ii) if the applicant has made the request—the request is withdrawn before preparations for publication of the subsequent application are completed.
  - (6) The statement of priority must state the following particulars of the previous application—
    - (a) the date of filing;
    - (b) the application number;
    - (c) the country, territory or area in or for which the previous application was made.
  - (7) The following documents must be filed with the Registrar within 16 months after the earliest date of priority claimed—

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

***Hong Kong application*** (香港申請) has the meaning given by section 37A of the Ordinance;

***non-Hong Kong application*** (非香港申請) has the meaning given by section 37A of the Ordinance.

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

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

**Division 2—Right to Apply****Subdivision 1—Reference to Registrar on Question as to who may Apply****31E. Interpretation**

In this Subdivision—

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

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

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

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

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

*referrer* (轉介人) means a person who makes a reference;  
*statement* (陳述書)—see section 31F(1)(b)(i) of these Rules.

### 31F. Reference

- (1) A reference must be—
  - (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement setting out—
      - (A) the nature of the question being referred;
      - (B) the facts on which the referrer relies; and
      - (C) the order or relief sought; and
    - (ii) the prescribed fee for the reference; and
  - (c) filed with the Registrar.
- (2) A referrer who files a reference must, at the same time—
  - (a) send a copy of the reference and statement to each person who meets the conditions specified in subsection (3) (*recipient*);
  - (b) attach to each copy of the reference and statement a list of the names and addresses of all recipients; and
  - (c) notify the Registrar in writing of those names and addresses.
- (3) The conditions are that—
  - (a) the person is not a party to the reference;



- (b) for a reference under section 37H(1)(a) of the Ordinance, the person is—
    - (i) alleged in the reference to be entitled to apply for the grant of a standard patent (O) for the invention that is the subject of the reference; or
    - (ii) believed by the referrer to be the inventor or a joint inventor of the invention;
  - (c) for a reference under section 37H(1)(b) of the Ordinance, the person is—
    - (i) a joint proprietor of the application who has not otherwise indicated the joint proprietor's consent to the making of the order, or the granting of the relief, sought in the reference; or
    - (ii) a person—
      - (A) to whom it is alleged in the reference that any right in or under the application should be transferred or granted; or
      - (B) whom the referrer believes to be the inventor or a joint inventor of the invention; and
  - (d) for a reference filed after the application has been published, the person is shown in the register as having a right in or under the application.
- (4) If the reference is filed before the standard patent (O) application has been published, the Registrar must—

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

### **31G. Counter-statement**

- (1) A recipient or an additional recipient who receives a copy of a reference and statement under section 31F(2) or (4) of these Rules and intends to oppose the making of the order, or granting of the relief, sought in the reference (*opponent*) may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 3 months after the date on which the copy of the reference is received by the opponent.

- (3) The counter-statement must—
  - (a) be in the specified form;
  - (b) set out the grounds of opposition; and
  - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) An opponent who files a counter-statement must, at the same time, send a copy of it to—
  - (a) the referrer;
  - (b) the recipient—
    - (i) who is not the opponent; and
    - (ii) whose name and address appear in the list mentioned in section 31F(2)(b) or (4)(b) of these Rules; and
  - (c) the additional recipient—
    - (i) who is not the opponent; and
    - (ii) whose name and address appear in the list mentioned in section 31F(4)(b) of these Rules.

### **31H. Evidence**

- (1) A person referred to in section 31G(4)(a), (b) or (c) of these Rules may file evidence in support of the referrer's case.
- (2) On filing evidence under subsection (1), a person referred to in section 31G(4)(b) or (c) of these Rules joins as a party to the reference.
- (3) The evidence must be filed with the Registrar within 3 months after the date on which the last copy of the counter-statement is received by the person.

- (4) A person who files evidence under subsection (1) must, at the same time, send a copy of it to—
  - (a) the opponent; and
  - (b) if the person is not the referrer—the referrer.
- (5) The opponent may file evidence in support of the opponent's case.
- (6) The opponent's evidence must be filed with the Registrar—
  - (a) if a copy of evidence has been sent under subsection (4)(a)—within 3 months after the date on which the last copy of the evidence is received by the opponent under that subsection; or
  - (b) if no copy of evidence has been sent under subsection (4)(a)—within 3 months after the time when a copy of evidence is required to be sent under that subsection.
- (7) An opponent who files evidence under subsection (5) must, at the same time, send a copy of it to—
  - (a) the referrer; and
  - (b) any other person who has filed evidence under subsection (1).
- (8) Subject to subsection (10), the referrer and the other person may file further evidence in reply to the opponent's evidence filed under subsection (5) within 3 months after the date on which the last copy of the opponent's evidence is received by the referrer and the other person under subsection (7).
- (9) A person who files further evidence under subsection (8) must, at the same time, send a copy of it to—

- (a) the opponent; and
  - (b) if the person is not the referrer—the referrer.
- (10) No further evidence may be filed except with the leave granted by, or at the direction of, the Registrar.
- (11) The Registrar may, on the initiative of the Registrar or on application of a party to the reference, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

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

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

- (1) This section applies to an application made by person B under section 37I(4) of the Ordinance in relation to the directions given to person A under section 37I(1)(d)(ii) of the Ordinance.
- (2) The application must be—
- (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement setting out—
      - (A) the facts on which the applicant relies; and
      - (B) the nature of the authorization sought; and
    - (ii) the prescribed fee for the application; and
  - (c) filed with the Registrar.

- (3) Person B must, when the application is filed, send a copy of the application and statement to person A.
- (4) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.
- (5) In this section—  
*person A* (後者) has the meaning given by section 37I(4) of the Ordinance;  
*person B* (前者) has the meaning given by section 37I(4) of the Ordinance.

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

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

- (1) If a specified order is made in relation to a standard patent (O) application, the Registrar must, by notice given to each of the persons specified in subsection (2), notify the persons of the order.
- (2) The persons are—
  - (a) the applicant of the earlier application referred to in section 37J(1)(a) of the Ordinance;
  - (b) the original applicant referred to in section 37K(2) of the Ordinance; and

- (c) the licensee of the applicant referred to in paragraph (a) or (b) whom the Registrar is aware of when the notice is given.
- (3) A request for licence under section 37K(5)(b) of the Ordinance may be made—
- (a) by the applicant of the earlier application within 2 months after the date of the notice given to the applicant;
  - (b) by the original applicant within 2 months after the date of the notice given to the original applicant; or
  - (c) by the licensee within 4 months after the date of the notice given to the licensee.
- (4) In subsection (1)—
- specified order*** (指明命令) means—
- (a) an order made under section 37J(2) of the Ordinance; or
  - (b) an order referred to in section 37K(2) of the Ordinance.

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

##### **31K. Reference**

- (1) A person (*referrer*) may make a reference to the Registrar under section 37K(7) of the Ordinance in relation to a licence (*reference*) after the making of—
- (a) an order under section 37J(2) of the Ordinance; or
  - (b) an order referred to in section 37K(2) of the Ordinance.

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- (2) A licence for the purposes of subsection (1) is a licence under section 37K(3) or (4) of the Ordinance to continue working or to work, as the case requires, the invention that is the subject of—
- (a) a new standard patent (O) application made in accordance with the order referred to in subsection (1)(a); or
  - (b) a standard patent (O) application that is to proceed in accordance with the order referred to in subsection (1)(b).
- (3) A reference must be—
- (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement setting out—
      - (A) the facts on which the referrer relies; and
      - (B) the period and terms of the licence that the referrer is prepared to grant or accept; and
    - (ii) the prescribed fee for the reference; and
  - (c) filed with the Registrar.
- (4) A referrer who files a reference must, at the same time, send a copy of the reference and statement to each person who meets the conditions specified in subsection (5).
- (5) The conditions are that—
- (a) the person is not the referrer; and
  - (b) the person—



- (i) is the one in whose name the new standard patent (O) application is made or the standard patent (O) application is to proceed; or
- (ii) claims to be entitled to be granted a licence.

### **31L. Counter-statement**

- (1) A person who receives a copy of a reference under section 31K(4) of these Rules and does not agree to grant or accept the licence for the period or on the terms set out in the statement (*opponent*) may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 3 months after the date on which the copy of the reference is received by the opponent.
- (3) The counter-statement must—
  - (a) be in the specified form;
  - (b) set out the grounds of disagreement; and
  - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) An opponent who files a counter-statement must, at the same time, send a copy of it to the referrer referred to in section 31K(1) of these Rules.
- (5) The Registrar may, on the initiative of the Registrar or on application of a party to the reference, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.

**Division 3—Applications for Standard Patents (O)****31M. Standard patent (O) application under section 37L of Ordinance**

- (1) A standard patent (O) application under section 37L of the Ordinance must be in the specified form.
- (2) The specification referred to in section 37L(2)(b) of the Ordinance must—
  - (a) state the title of the invention that is the subject of the application; and
  - (b) include—
    - (i) a description of the invention;
    - (ii) at least one claim; and
    - (iii) drawings referred to in the description or the claim or claims, if any.
- (3) The title of the invention must be short and indicate the matter to which the invention relates.
- (4) A standard patent (O) application under section 37L of the Ordinance must contain—
  - (a) the name and address of the inventor or inventors;
  - (b) a list of the documents comprising the application;
  - (c) an indication of the number of sheets of each of the documents;
  - (d) the translation of documents and transliteration of names required by the Registrar under sections 56, 56A and 56B(3) of these Rules;

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- (e) for the purposes of a claim regarding a disclosure that was due to, or in consequence of, the condition referred to in section 37B(2)(b)(ii) of the Ordinance—
    - (i) a statement referred to in section 37B(3)(a) of the Ordinance; and
    - (ii) the prescribed written evidence referred to in section 31A of these Rules in support of the statement;
  - (f) for the purposes of a claim for priority of a previous application under section 37E of the Ordinance—the documents required under section 31C(2) of these Rules and the documents required by application of section 31C(9) of these Rules, as the case requires; and
  - (g) for the purposes of a reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance for compliance with section 37L(2)(b) of the Ordinance—the documents required under section 31W(3) of these Rules and the documents required by application of section 31W(5) of these Rules, as the case requires.
- (5) For section 37L(5) and (6) of the Ordinance, the filing fee and advertisement fee must be paid to the Registrar—
- (a) no later than 1 month after the date of receipt referred to in section 31U(c)(iii) of these Rules; or
  - (b) if the fee is not paid within the time limit specified in paragraph (a)—with an additional fee within a grace period—

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

### **31N. Description**

- (1) This section applies to a description referred to in section 37L(2)(b)(i) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The description must—
  - (a) specify the technical field to which the invention relates;
  - (b) indicate the background art that, as far as known to the applicant, can be regarded as useful for understanding the invention;
  - (c) preferably, cite the documents reflecting the background art;
  - (d) disclose the invention in a way that the following can be understood—
    - (i) the technical problem to which the invention relates (even if not so expressly stated); and
    - (ii) the solution to the problem;
  - (e) state any advantageous effects of the invention with reference to the background art;

- (f) briefly describe the figures in the drawings referred to in the description, if any;
  - (g) describe in detail at least one way of carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
  - (h) indicate the way in which the invention is industrially applicable, if it is not obvious from the description or nature of the invention.
- (3) The description must be presented in the manner and order specified in subsection (2) unless not doing so is conducive to a better understanding of the invention because of its nature and a more economical presentation.

### **31O. Drawings referred to in description**

- (1) This section applies to the drawings referred to in the description under section 37L(2)(b)(iii) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The drawings—
  - (a) must be on sheets each of which—
    - (i) has an usable surface area not exceeding 26.2 cm × 17 cm;
    - (ii) does not contain frames round the usable or used surface; and
    - (iii) has the following minimum margins—
      - (A) from the top—2.5 cm;
      - (B) from the left—2.5 cm;

- (C) from the right—1.5 cm; and
  - (D) from the bottom—1 cm; and
- (b) must be executed in the following manner—
- (i) executed without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
  - (ii) the cross-sections, if any, contained in the drawings must be indicated by hatching that does not impede the clear reading of the reference signs and leading lines;
  - (iii) the scale and distinctness of graphical execution must enable all details of the drawings to be distinguished without difficulty in a photographic reproduction of the drawings with a linear reduction in size to two-thirds of the drawings;
  - (iv) if, as an exception, a scale is given, the scale must be represented graphically;
  - (v) all numbers, letters and reference signs must be simple and clear;
  - (vi) brackets, circles and inverted commas must not be used in association with numbers, letters and characters;
  - (vii) all lines must ordinarily be drawn with the aid of drafting instruments;
  - (viii) elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;

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- (ix) the height of the numbers, letters and characters must not be less than 0.32 cm;
  - (x) the lettering must be in—
    - (A) Latin alphabets; and
    - (B) if customary—Greek alphabets or Chinese characters, as appropriate;
  - (xi) if the same sheet of drawings contains several figures, the figures must be—
    - (A) arranged without wasting space and clearly separated from one another; and
    - (B) numbered consecutively in Arabic numerals, independently of the numbering of the sheets;
  - (xii) if the figures drawn on 2 or more sheets are intended to form one whole figure, the figures on the sheets must be so arranged that the whole figure can be assembled without concealing any part of the partial figures;
  - (xiii) reference signs not mentioned in the description and claims must not appear;
  - (xiv) reference signs not mentioned in the drawings must not appear in the description and claims;
  - (xv) the same features, when denoted by reference signs, must be denoted by the same signs throughout the application;

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

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

**Example—**

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

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

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

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

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

(3) In this section—

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

**Note—**

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



**31P. Abstract**

- (1) This section applies to an abstract referred to in section 37L(2)(c) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The abstract must—
  - (a) begin with the title of the invention;
  - (b) contain a concise summary of the matters contained in the specification referred to in section 37L(2)(b) of the Ordinance;
  - (c) normally, not contain more than 150 words or 200 Chinese characters, as appropriate;
  - (d) if appropriate, contain the chemical formula that, among those chemical formulae contained in the specification, best characterizes the invention; and
  - (e) not contain statements on the alleged merits or value of the invention or on its speculative application.
- (3) The summary referred to in subsection (2)(b) must—
  - (a) specify the technical field to which the invention relates; and
  - (b) be written in a way that allows a clear understanding of—
    - (i) the technical problem to which the invention relates;
    - (ii) the gist of the solution to the problem through the invention; and
    - (iii) the principal use or uses of the invention.

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

### **31Q. Size and presentation of documents**

- (1) This section applies to the documents comprising a standard patent (O) application to be filed under section 37L(1)(b) of the Ordinance.
- (2) Each of the documents must be presented in a manner that it may be—
  - (a) reproduced in an unlimited number of copies by photography, photocopying processes, photo offset and micro-filming; and
  - (b) scanned by a device capable of capturing an image of the document and converting the image into a form suitable for storage on, and retrieval by, a computer.
- (3) Each of the documents must—
  - (a) be free from cracks, creases and folds;
  - (b) be single-sided;

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

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

- (a) the authenticity of the content of the document is not in question and the requirements for good reproduction are not in jeopardy; or
- (b) the Registrar considers that there are other circumstances that justify the exemption.

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

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

### **31S. Claims**

- (1) This section applies to the claims referred to in section 37L(2)(b)(ii) of the Ordinance of an invention that is the subject of a standard patent (O) application.
- (2) The claims must define the matter for which protection is sought in terms of the technical features of the invention.
- (3) If appropriate, an independent claim must contain—
  - (a) a statement indicating the designation of the subject matter of the invention and technical features that are necessary for the definition of the claimed subject matter but the features, in combination, are part of the prior art; and
  - (b) a characterizing portion, preceded by the expression “characterized in that” or “characterized by” or the equivalent Chinese characters, as appropriate, stating the technical features that, in combination with the technical

features referred to in paragraph (a), the claim seeks to protect.

- (4) An independent claim stating the essential features of an invention may be followed by one or more dependent claims concerning particular embodiments of the invention (*dependent claim*).
- (5) A dependent claim that includes all the features of any other claim—
  - (a) must contain a reference to that other claim, at the beginning if possible;
  - (b) must state the additional features that the dependent claim seeks to protect; and
  - (c) is admissible even if it directly refers to another claim that is also a dependent claim.
- (6) Dependent claims referring to a single or several previous claims must be grouped together according to the previous claims in the most appropriate way.
- (7) The number of the claims must, having regard to the nature of the invention claimed, be reasonable.
- (8) If there are 2 or more claims, the claims must be numbered consecutively in Arabic numerals.
- (9) A claim must not rely—
  - (a) on references to the description or drawings in respect of the technical features of the invention unless it is absolutely necessary; and
  - (b) in particular, on the following references or references similar to the following references—
    - (i) “as described in part ... of the description”;
    - (ii) “as illustrated in figure ... of the drawings”;

- (iii) “如說明第……部分所描述”; or
  - (iv) “如繪圖的附圖……所示”.
- (10) For an application that contains drawings, the technical features stated in the claims must preferably be followed by the reference signs relating to the features used in the drawings, if doing so makes the claims easier to understand.
- (11) The reference signs—
- (a) must be placed between parentheses; and
  - (b) are not to be construed as limiting the claims.

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

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

### **31U. Registrar to issue receipt for documents**

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

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

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

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

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

- (1) This section applies if a standard patent (O) application contains a purported reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance.



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- (2) For the purposes of the minimum requirement under section 37M(3) of the Ordinance, a reference to an earlier specified application is not to be regarded as having been made unless the reference states—
    - (a) the date of filing of the earlier specified application;
    - (b) the application number of the earlier specified application; and
    - (c) the country, territory or area in or for which the earlier specified application was made.
  - (3) The applicant must file the following documents with the Registrar within 4 months after the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with—
    - (a) a copy of the earlier specified application; and
    - (b) a copy of the certificate issued by the authority that received the earlier specified application (*certificate*).
  - (4) If the earlier specified application is an application made under the Ordinance, the copies referred to in subsection (3)(a) and (b) are to be regarded as having been filed in due time.
  - (5) If the earlier specified application or the certificate is in neither English nor Chinese, sections 56(1), 56A and 56B(3) of these Rules apply to it.
  - (6) If a copy of the earlier specified application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(3) of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the

document under these Rules, it is to be regarded as having been filed in due time.

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

- (1) If a missing description or missing drawing is required by a notice under section 37N(1) of the Ordinance to be filed—
  - (a) it must be filed within 2 months after the date of the notice; and
  - (b) the previous application documents must be filed for the purposes of section 37N(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (2) If a missing description or missing drawing is to be filed on an applicant's own initiative under section 37N(2) of the Ordinance—
  - (a) it must be filed within 2 months after the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with; and
  - (b) the previous application documents must be filed for the purposes of section 37N(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
- (3) No notice is to be sent by the Registrar under section 37N(1) of the Ordinance after the Registrar is satisfied that the standard patent (O) application complies with the formal requirements under section 37P(1) of the Ordinance.

- (4) If the previous application referred to in section 37N(5)(a) of the Ordinance is an application made under the Ordinance, a copy of the previous application is to be regarded as having been filed in due time for the purposes of section 37N(5)(d) of the Ordinance.
- (5) If the previous application is in neither English nor Chinese, sections 56A and 56C of these Rules apply to it.
- (6) If a copy of the previous application or the translation required by sections 56A and 56C of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.
- (7) In this section—
  - missing description*** (欠交說明) has the meaning given by section 37N(6) of the Ordinance;
  - missing drawing*** (欠交繪圖) has the meaning given by section 37N(6) of the Ordinance;
  - previous application documents*** (過往申請的文件) means—
    - (a) the copy of the previous application referred to in section 37N(5)(d)(i) of the Ordinance; and
    - (b) the statement referred to in section 37N(5)(d)(iii) of the Ordinance indicating which part of the previous application represents the description or drawing that is missing in the standard patent (O) application.

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

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

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

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

- (1) The prescribed time referred to in section 37Q(1)(a) of the Ordinance in relation to the publication of a standard patent (O) application is—
  - (a) if there is no claim for priority—18 months after the date of filing of the application; or

- (b) if there is a claim for priority—18 months after the earliest date of priority claimed.
- (2) For the purposes of section 37Q(1)(a) and (2) of the Ordinance, the Registrar must—
  - (a) determine the date on which preparations for publication are to be regarded as having been completed; and
  - (b) notify the applicant of the determination by notice given to the applicant as soon as practicable after determining the date.

### **31ZA. Observations by third parties**

- (1) This section applies to a notice referred to in section 37R(1) of the Ordinance of a person's observations on the patentability of an invention that is the subject of a standard patent (O) application.
- (2) The notice must be filed with the Registrar during the following period—
  - (a) after the date of publication of the application under section 37Q of the Ordinance; and
  - (b) before one of the following dates, as appropriate—
    - (i) the date on which the Registrar gives notice of the Registrar's determination under section 31ZP(2) of these Rules;
    - (ii) the date on which the Registrar gives the final refusal notice in relation to the standard patent (O) application referred to in section 31ZN(2) of these Rules;

- (iii) if the standard patent (O) application has not been subsequently reinstated or restored under section 37ZD of the Ordinance—the date on which the standard patent (O) application is withdrawn or is to be regarded as being withdrawn.
- (3) Section 37R(3) of the Ordinance does not apply to a notice that, in the opinion of the Registrar, would—
- (a) disparage any person in a way likely to damage the person; or
  - (b) be generally expected to encourage any offensive, immoral or anti-social behaviour.

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

### **31ZB. Interpretation**

In this Division—

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

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

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

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

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

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

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

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

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

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

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

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

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

### **31ZC. Request for substantive examination**

- (1) A request made for substantive examination of a standard patent (O) application under section 37T(1) of the Ordinance must be—
  - (a) in the specified form; and
  - (b) filed with the Registrar.
- (2) The prescribed time referred to in section 37T(2)(a) of the Ordinance is—
  - (a) for a standard patent (O) application that is not a specified new application—3 years after the material date of the application;

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- (b) for a specified new application the fulfilment date of which is not less than 2 months before the expiry of the period of 3 years after the material date of the earlier application—3 years after the material date of the earlier application (*3-year period*);
  - (c) for a specified new application the fulfilment date of which is less than 2 months before the expiry of the 3-year period—2 months after the fulfilment date of the new application; or
  - (d) for a specified new application the fulfilment date of which is on or after the date of expiry of the 3-year period—2 months after the fulfilment date of the new application.
- (3) The prescribed fee for the request must be paid to the Registrar no later than 1 month after the date of the request.
- (4) If the prescribed fee is not paid within the time limit specified in subsection (3), it is to be regarded as having been paid within the time limit if it is paid within a grace period—
- (a) that is allowed by the Registrar by a notice given to the applicant; and
  - (b) that—
    - (i) begins on the date of expiry of the time limit; and
    - (ii) ends at the expiry of 1 month after the date of the notice.
- (5) In this section—



**earlier application** (較早申請) means an earlier application referred to in section 37J(1)(a) or 37Z(1)(a) of the Ordinance, or an application under section 55(4) of the Ordinance to which the reference under section 55(1) of the Ordinance relates, as the case requires;

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

- (a) on which the minimum requirement under section 37M(3) of the Ordinance is complied with; and
- (b) notified to the applicant by a notice under section 31V(1) or (3) of these Rules;

**material date** (關鍵日期) has the meaning given by section 2(1) of the Ordinance;

**specified new application** (指明新申請) means a new standard patent (O) application referred to in section 37J(2)(a) or 37Z(1)(b) of the Ordinance, or a new application referred to in section 55(4) of the Ordinance, as the case requires.

### **31ZD. Examination notice**

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

### **31ZE. Response to examination notice**

- (1) A response to an examination notice to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (**response to examination notice**) must be filed by the applicant with the Registrar within 4 months after the date of the notice.

- (2) If the applicant fails to comply with the requirement under subsection (1), the standard patent (O) application is to be regarded as being withdrawn.

### **31ZF. Further examination notice**

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

### **31ZG. Response to further examination notice**

- (1) A response to a further examination notice to be filed for the purposes of section 37V(3)(a) or (b) of the Ordinance (*response to further examination notice*) must be filed by the applicant with the Registrar within 4 months after the date of the notice.

- (2) If the applicant fails to comply with the requirement under subsection (1), the standard patent (O) application is to be regarded as being withdrawn.
- (3) Section 31ZF of these Rules applies in relation to a response to further examination notice as if—
  - (a) the words “a response to examination notice in accordance with section 31ZE(1)” in section 31ZF(1)(a) of these Rules were substituted by the words “a response to further examination notice in accordance with section 31ZG(1)”; and
  - (b) the words “the response to examination notice” in section 31ZF(2)(a) of these Rules were substituted by the words “the response to further examination notice”.

### **31ZH. Provisional refusal notice**

- (1) If the Registrar, having considered—
  - (a) a response to examination notice; and
  - (b) a response to further examination notice, if any, is of the opinion that the standard patent (O) application does not comply with the examination requirement concerned, the Registrar may make a provisional decision of refusal to grant the standard patent (O).
- (2) If the Registrar makes a provisional decision, the Registrar must, by notice given to the applicant (*provisional refusal notice*)—
  - (a) notify the applicant of the decision;
  - (b) set out the examination requirement concerned; and

- (c) state that the applicant may respond to the provisional refusal notice by filing a request to review the Registrar's opinion under section 37V(3)(c) of the Ordinance in accordance with section 31ZI(1) and (2) of these Rules.

### **31ZI. Request to review**

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

**31ZJ. Review opinion**

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

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

**31ZK. Response to review opinion**

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

- (c) filed with the Registrar.
- (4) If no response to review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
  - (a) make a final decision of refusal to grant the standard patent (O); and
  - (b) give the applicant a final refusal notice.

### **31ZL. Further review opinion**

- (1) This section applies if—
  - (a) the Registrar has considered—
    - (i) a request to review filed by the applicant of a standard patent (O) application in accordance with section 31ZI(1) and (2) of these Rules; and
    - (ii) a response to review opinion filed by the applicant in accordance with section 31ZK(1) of these Rules, if any; and
  - (b) where the applicant had requested a hearing under section 82(1) of these Rules—the hearing has been held.
- (2) The Registrar may, by notice given to the applicant (*further review opinion*)—
  - (a) set out any matter covered in the following request, response and hearing, if any, in respect of which the Registrar considers that elaboration, revision or clarification is required—
    - (i) the request to review;

- (ii) the response to review opinion; and
    - (iii) the hearing under section 82(1) of these Rules;
  - (b) state that the applicant may file a further response in relation to the matter in accordance with section 31ZM(1) of these Rules to elaborate on, revise or clarify the matter; and
  - (c) if the Registrar thinks fit, and if applicable—state that the applicant may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(b) of these Rules.
- (3) The Registrar may give further review opinion more than once.

### **31ZM. Response to further review opinion**

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

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

### **31ZN. Final refusal notice**

- (1) If the Registrar, having considered the matters raised in the following request, responses and hearing, if any, is still of the opinion that the standard patent (O) application does not comply with the examination requirement concerned, the Registrar may make a final decision of refusal to grant the standard patent (O)—



- (a) a request to review;
  - (b) a response to review opinion;
  - (c) a response to further review opinion;
  - (d) the hearing under section 82(1) of these Rules.
- (2) If the Registrar makes the final decision, the Registrar must, by notice given to the applicant (*final refusal notice*)—
- (a) notify the applicant of the decision; and
  - (b) give the reasons for the decision.

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

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

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

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

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

### **31ZQ. Interpretation**

In this Division—

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

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

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

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

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

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

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

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

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

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

- (a) that the new application is an application under that section; and
  - (b) the application number of the earlier application within the meaning of section 37Z(1)(a) of the Ordinance (*earlier application*).
- (2) If an earlier application is refused under section 37P(2) or (4)(b) or 37Y of the Ordinance, the applicant may file a new application within 2 months after the date of the notice under section 31Y(2) of these Rules or the date of the final refusal notice under section 31ZN(2) of these Rules, as the case requires.
  - (3) If an appeal is made under section 130 of the Ordinance in relation to the refusal, the Registrar may specify a period within which a new application may be filed.
  - (4) A new application is to be regarded as duly filed on the date on which the minimum requirement under section 37M(3) of the Ordinance is complied with.

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

- (1) Subject to section 45(3) of these Rules, a request to amend a standard patent (O) application before grant under section 37ZA(1) of the Ordinance must—
  - (a) be in the specified form;
  - (b) identify the amendment;
  - (c) give the reasons for the amendment; and
  - (d) be filed with the Registrar.

- 
- (2) Subject to section 103(2) of the Ordinance, the applicant of a standard patent (O) application may request to amend the application—
- (a) when filing a request for substantive examination under section 37T(1) of the Ordinance;
  - (b) when filing with the Registrar—
    - (i) a response to examination notice;
    - (ii) a response to further examination notice;
    - (iii) a request to review;
    - (iv) a response to review opinion; or
    - (v) a response to further review opinion;
  - (c) once before preparations for publication of the application under section 37Q of the Ordinance are completed whether a request to amend the application has been filed under paragraph (a); and
  - (d) within 3 months after the date of the notice issued under section 37U(1) of the Ordinance.
- (3) If the applicant requests to amend the description, claims or drawings in the specification contained in a standard patent (O) application (***requested amendment***), the Registrar may, if the Registrar thinks fit, by notice given to the applicant, require the applicant to file the following copies of the amended specification (***required copies***) with the Registrar within the period specified by the Registrar—
- (a) a clean copy of the specification with the requested amendment incorporated into it; and

- (b) a copy of the specification with the requested amendment incorporated into it and indicated in it.
- (4) If the required copies are not filed within the period specified under subsection (3), the request for amendment to which the required copies relate is to be regarded as being withdrawn.
- (5) For the purposes of subsections (1) and (3), the amendment of the standard patent (O) application must be prepared in compliance with the requirements specified in sections 31M(2) and (3), 31N, 31O, 31P, 31Q(1) to (12), 31R and 31S of these Rules.

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

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

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

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

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

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

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

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

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

- (1) A standard patent (O) application for an invention that involves nucleotide and amino acid sequences must contain a sequence listing as a part of the description in the specification contained in the application.
- (2) A sequence listing must—
  - (a) comply with the requirements and standards adopted under the Patent Cooperation Treaty for the presentation of sequence listings in patent applications; and
  - (b) be filed—
    - (i) with the Registrar; and
    - (ii) in electronic form, if so required by the Registrar.

- (3) A sequence listing filed in relation to a standard patent (O) application may be filed in electronic form even if the application is not filed by way of electronic filing under section 93A(2) of these Rules.
- (4) A sequence listing filed after the date of filing of the standard patent (O) application must be accompanied by a statement made by the applicant confirming to the satisfaction of the Registrar that the sequence listing does not contain any matter extending beyond the sequence disclosed in the application.”.

**20. Section 34 amended (restoration of lapsed standard patents under section 40 of the Ordinance)**

- (1) Section 34(1)(a), after the semicolon—

**Add**

“and”.

- (2) Section 34(1)—

**Repeal paragraphs (b) and (c).**

- (3) After section 34(1)—

**Add**

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

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

- (4) Section 34(2)—

**Repeal**

everything before “is not”

**Substitute**

“(2) If the Registrar, having considered the supporting evidence of the application,”.

- (5) Section 34—

**Repeal subsection (4)**

**Substitute**

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

- (5) The request for renewal must be—

- (a) in a duly completed form specified for the purposes of section 39(2) of the Ordinance; and
- (b) accompanied by any unpaid renewal fee and any additional fee prescribed for the purposes of section 40(4) of the Ordinance.

- (6) On receiving the request for renewal filed in accordance with subsections (4) and (5), the Registrar must—

- (a) order the restoration of the standard patent; and
- (b) advertise the fact of the order by notice in the official journal.”.



**21. Section 36 substituted**

Section 36—

**Repeal the section**

**Substitute**

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

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

**22. Section 37 amended (revocation of standard patent under section 44 of the Ordinance)**

(1) Section 37(5)—

**Repeal**

“its issue”

**Substitute**

“receipt”.

(2) Section 37(7)—

**Repeal**

everything after “give”

**Substitute**

“directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**23. Section 38 repealed (mention of inventor under section 45 of the Ordinance)**

Section 38—

**Repeal the section.**

**24. Sections 38A to 38F added**

The Rules—

**Add**

**“38A. Application to amend specification after grant**

- (1) This section applies to an application under section 46 of the Ordinance to amend the specification of—
  - (a) a standard patent (O); or
  - (b) a short-term patent in respect of which a certificate of substantive examination has been issued.
- (2) The application must be—
  - (a) in the specified form;
  - (b) accompanied by—
    - (i) a copy of the specification incorporating the requested amendment indicated by—
      - (A) striking through the text, figure or other matter to be replaced or deleted; and
      - (B) underlining the replacement text, figure or other matter;
    - (ii) the evidence furnished by the proprietor of the patent to establish the circumstances underlying the requested amendment; and

- (iii) the prescribed fee for the application; and
  - (c) filed with the Registrar.
- (3) For the purposes of subsection (2), the requested amendment must be prepared in compliance with the requirements specified in—
  - (a) for a standard patent (O)—sections 31M(2) and (3), 31N, 31O, 31Q(1) to (12) and 31S of these Rules; or
  - (b) for a short-term patent—sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.
- (4) The Registrar may, by notice given to the proprietor of the patent, require the proprietor to do either or both of the following within the period specified in the notice—
  - (a) correct any deficiencies in the requested amendment;
  - (b) file further evidence to supplement the evidence referred to in subsection (2)(b)(ii).
- (5) If the deficiencies mentioned in the notice are not corrected, or the further evidence required by the notice is not filed, within the period specified in the notice, the application is to be regarded as being withdrawn.
- (6) The Registrar may, having regard to the evidence referred to in subsections (2)(b)(ii) and (4)(b), if any, and the circumstances underlying the requested amendment—
  - (a) subject to section 103(3) of the Ordinance, accept the requested amendment in whole or in part as an allowable amendment (***allowable amendment***); or

- (b) refuse to accept the requested amendment.
- (7) If the Registrar accepts an allowable amendment under subsection (6)(a), the Registrar must, in addition to complying with section 46(3)(a) and (b) of the Ordinance, notify the proprietor of the patent of the Registrar's decision.
- (8) A request for a hearing under section 82(1) of these Rules made for the purposes of a decision under subsection (6) must be—
  - (a) in the specified form;
  - (b) accompanied by the prescribed fee for the request; and
  - (c) filed with the Registrar.

### **38B. Opposition notice**

- (1) Any person who intends to oppose an allowable amendment referred to in section 38A(6)(a) of these Rules and published under section 46(3)(a) of the Ordinance (*opponent*) may file an opposition notice with the Registrar.
- (2) The opposition notice must be filed within 1 month after the date on which the fact of the publication of the allowable amendment is advertised under section 46(3)(b) of the Ordinance.
- (3) The opposition notice must be—
  - (a) in the specified form; and
  - (b) accompanied by—
    - (i) a statement setting out—
      - (A) the facts on which the opponent relies; and

- (B) the relief sought; and
  - (ii) the prescribed fee for the notice.
- (4) An opponent who files an opposition notice must, at the same time, send a copy of the opposition notice and statement to the proprietor of the patent.
  - (5) The opponent must, within 3 days after the date of filing of the opposition notice, notify the Registrar in writing that the opponent has complied with subsection (4).
  - (6) If the opponent fails to comply with the requirements under subsection (2), (3), (4) or (5), the opposition notice is to be regarded as not having been filed.

### **38C. Counter-statement**

- (1) The proprietor of a patent who receives from an opponent referred to in section 38B of these Rules a copy of an opposition notice and intends to resist the opposition may file a counter-statement with the Registrar.
- (2) The counter-statement must be filed within 1 month after the date on which the copy of the opposition notice is received by the proprietor.
- (3) The counter-statement must—
  - (a) be in the specified form;
  - (b) set out the grounds on which the opposition is resisted; and
  - (c) be accompanied by the prescribed fee for the counter-statement.
- (4) A proprietor who files a counter-statement must, at the same time, send a copy of it to the opponent.

- (5) If the proprietor fails to file a counter-statement in accordance with the requirements under subsection (2) or (3), the application to amend the specification of the patent made in accordance with section 38A of these Rules is to be regarded as being withdrawn.
- (6) The proprietor or the opponent may request a hearing under section 82A(2) or (3) of these Rules.

### **38D. Directions by Registrar**

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

### **38E. Final decision by Registrar**

- (1) If an opposition notice is filed under section 38B(1) of these Rules in opposition to an allowable amendment, and a counter-statement is filed under section 38C(1) of these Rules to resist the opposition, the Registrar—
  - (a) must, before making a final decision under paragraph (b), consider—
    - (i) the opposition notice and the statement referred to in section 38B(3)(b)(i) of these Rules;
    - (ii) the counter-statement;
    - (iii) the representation made at a hearing requested under section 82A(2) or (3) of these Rules, if any; and

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

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

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

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

- (1) This section applies to the publication of an amendment under section 46(3)(a) or (7)(a) of the Ordinance.
- (2) The Registrar may, if the Registrar thinks fit, by notice given to the proprietor of the patent, require the proprietor to file, for the purposes of publishing the amendment, the following copies of the amended specification (*required copies*) with the Registrar within the period specified by the Registrar—
  - (a) a clean copy of the specification with the amendment incorporated into it; and
  - (b) a copy of the specification with the amendment incorporated into it and indicated in it.
- (3) For the purposes of subsection (2), the required copies must be prepared in compliance with the requirements specified in—
  - (a) for a standard patent (O)—sections 31M(2) and (3), 31N, 31O, 31Q(1) to (12) and 31S of these Rules; or
  - (b) for a short-term patent—sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.



- (4) If the required copies are not filed within the period specified under subsection (2), the application for amendment to which the required copies relate is to be regarded as being withdrawn.”.

**25. Section 40 amended (surrender of patents)**

- (1) Section 40(4)—

**Repeal**

everything after “on which” and before “wishes”

**Substitute**

“the copy of the notice is received by the proprietor of the patent, the proprietor must, if the proprietor”.

- (2) Section 40—

**Repeal subsection (5)**

**Substitute**

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

**26. Section 41 amended (Registrar’s power to revoke patent on grounds of “ordre public” or morality under section 49 of the Ordinance)**

- (1) Section 41(1)—

**Repeal**

“93(5)”

**Substitute**

“9A(5)”.

(2) Section 41(7)—

**Repeal**

everything after “give”

**Substitute**

“directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**27. Section 41A added**

Part 4, after section 41—

**Add**

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

- (1) If a specified order is made in relation to a patent and is filed with the Registrar, the Registrar must, by notice given to each of the persons specified in subsection (2), notify the person of the order.
- (2) The persons are—
  - (a) the old proprietor of the patent referred to in section 56(2) of the Ordinance;
  - (b) the old proprietor of the original patent referred to in section 56(3A) of the Ordinance;
  - (c) the person whom the Registrar is aware of at the time of giving the notice is—
    - (i) the licensee of the patent referred to in section 56(3) of the Ordinance; and
    - (ii) the licensee of the original patent referred to in section 56(3A) of the Ordinance.

- (3) A request for licence under section 56(3B)(b) of the Ordinance may be made—
- (a) by the old proprietor within 2 months after the date of the notice given to the old proprietor; or
  - (b) by the licensee within 4 months after the date of the notice given to the licensee.
- (4) In subsection (1)—
- specified order* (指明命令), in relation to a patent, means an order—
- (a) made under section 55(4) of the Ordinance; or
  - (b) referred to in section 56(2) of the Ordinance.”.

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

Section 42A(4)—

**Repeal**

“and 68”

**Substitute**

“, 31Y and 68 of these Rules”.

**29. Section 43 amended (entries in the register)**

(1) Section 43—

**Repeal subsection (1)**

**Substitute**

“(1) No entry is to be made in the register—

- (a) for a standard patent (R) application—before the request to record is published in accordance with section 20 of the Ordinance;

- (b) for a standard patent (O) application—before the application is published in accordance with section 37Q of the Ordinance; or
- (c) for a short-term patent application—before the short-term patent is granted.”.

(2) Section 43(2)—

**Repeal**

everything before “cause to—”

**Substitute**

“(2) On the publication of the request to record for the standard patent (R) application, the publication of the standard patent (O) application, or the grant of the short-term patent, the Registrar must”.

(3) Section 43(2)(a)—

**Repeal**

“(as the case may be)”

**Substitute**

“, as the case requires”.

(4) Section 43(2)(e)—

**Repeal**

“98”

**Substitute**

“11B, 37E”.

(5) Section 43(2)—

**Repeal paragraphs (f) and (g)**

**Substitute**

- “(f) in relation to a standard patent (R) application—the date of filing and the application number of the corresponding designated patent application;
- (g) the date of publication of the request to record for the standard patent (R) application, the date of publication of the standard patent (O) application, or the date of grant of the short-term patent, as the case requires; and”.

- (6) Section 43(2)(h)—

**Repeal**

“(as the case may be)”

**Substitute**

“, as the case requires”.

- (7) Section 43(3)(a)—

**Repeal everything before subparagraph (i)**

**Substitute**

- “(a) in relation to a patent, published request to record for a standard patent (R) application, or published standard patent (O) application—”.

- (8) Section 43(3)(b)(ii), before “the date”—

**Add**

“in relation to a standard patent (R) application—”.

**30. Section 44 amended (entries relating to section 13(1) of the Ordinance)**

- (1) Section 44, heading, after “**13(1)**”—

**Add**

“or **37H(1)**”.

(2) Section 44—

**Repeal**

“of the Ordinance he”

**Substitute**

“or 37H(1) of the Ordinance the Registrar”.

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

(1) Section 48(6A)—

**Repeal**

“he shall, within 3 months from the date of the sending of the copies to him”

**Substitute**

“the person must, within 3 months after the date on which the copy of the notice is received by the person”.

(2) Section 48(7)—

**Repeal**

everything after “give”

**Substitute**

“directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**32. Section 50 amended (inspection of register)**

Section 50(2)—

**Repeal**

everything before “copy”

**Substitute**

“(2) A”.

**33. Part 6A added**

After Part 6—

**Add**

**“Part 6A**

**Single Inventive Concept**

**53A. Single inventive concept**

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

**34. Section 54 substituted**

Section 54—

**Repeal the section**

**Substitute**

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

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

**35. Section 55 repealed (exhibition or meeting under section 95(1)(b) of the Ordinance)**

Section 55—

**Repeal the section.**

**36. Section 56 amended (the language of proceedings before the Registrar)**

(1) Section 56(2)—

**Repeal**

“23(4)”

**Substitute**

“23(4), 37L(4)”.

(2) Section 56(2)—

**Repeal**

“19”

**Substitute**

“19, 31M”.



- (3) Section 56(3)—

**Repeal**

“23(3)(b)” (wherever appearing)

**Substitute**

“23(3)(b), 37L(3)(c)”.

- (4) After section 56(9)—

**Add**

“(9A) Subsection (9) does not apply if the translation is required to be filed with the Registrar—

- (a) within a prescribed time or period under these Rules;
- (b) within a specified period as referred to in these Rules other than that subsection; or
- (c) by a notice given under section 17, 24, 31Y(1) or 68(1) of these Rules.”.

**37. Sections 56A to 56D added**

After section 56—

**Add**

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

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

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

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

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

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

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

of a short-term patent to file the following document with the Registrar—

- (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent, as the case requires; or
- (b) if the standard patent (O) application or the short-term patent for which priority is claimed is a translation of the previous application—a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate.

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

- (1) For the purposes of filing a missing description or missing drawing under sections 37N(5) and 114A(5) of the Ordinance, the applicant must file the following documents with the Registrar within the period specified under subsection (2)—
  - (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent application, as the case requires; and
  - (b) a statement indicating which part of the translation represents the description or drawing that is missing in the patent application.
- (2) The period is—
  - (a) if the applicant is required to file the missing description or missing drawing by a notice under section 37N(1) or 114A(1) of the Ordinance—

- (i) 2 months after the date of the notice; or
- (ii) 16 months after the earliest date of priority claimed,

whichever expires later;

- (b) if the applicant files the missing description or missing drawing on the applicant's own initiative under section 37N(2) or 114A(2) of the Ordinance—16 months after the earliest date of priority claimed.

**56D. Registrar may require evidence on accuracy of translations**

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

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

- (1) Section 58(2)(b)—

**Repeal**

“one independent claim”

**Substitute**

“2 independent claims”.

(2) Section 58—

**Repeal subsection (4).**

(3) Section 58(5)—

**Repeal paragraph (e).**

(4) Section 58(5)(h)—

**Repeal the full stop**

**Substitute a semicolon.**

(5) After section 58(5)(h)—

**Add**

“(i) for a reference to an earlier specified application under section 114(3)(c)(ii) of the Ordinance—the documents required under section 67A(3) of these Rules; and

(j) the translation of documents and transliteration of names required under sections 56, 56A and 56B of these Rules.”.

**39. Section 59 amended (description)**

(1) Section 59(1)(c), Chinese text—

**Repeal**

“有利的效用”

**Substitute**

“有益效果”.

- (2) Section 59(1)(d), Chinese text—

**Repeal**

“圖形”

**Substitute**

“附圖”.

- (3) Section 59(1)(f)—

**Repeal**

“capable of exploitation in industry”

**Substitute**

“industrially applicable”.

**40. Section 60 amended (drawings)**

- (1) Section 60(1)(a), English text—

**Repeal**

“service”

**Substitute**

“surface”.

- (2) Section 60(1)(a), Chinese text—

**Repeal**

“圖紙”

**Substitute**

“紙張”.

- (3) Section 60(1)(b), Chinese text—

**Repeal**

“圖紙”

**Substitute**

“紙張”.

- (4) Section 60(2)(c), Chinese text—

**Repeal**

“圖形繪畫”

**Substitute**

“表達”.

- (5) Section 60(2)(c), Chinese text—

**Repeal**

“圖形表示”

**Substitute**

“圖表示”.

- (6) Section 60(2)(f), Chinese text—

**Repeal**

“圖形” (wherever appearing)

**Substitute**

“附圖”.

- (7) Section 60(2)(g), Chinese text—

**Repeal**

“繪圖中的字母”

**Substitute**

“繪圖中標示的字母”.

- (8) Section 60(2)(g), Chinese text—

**Repeal**

“視乎適當而使用希臘字母或中文字”

**Substitute**

“(如屬適當)使用希臘字母或中文字”.



(9) Section 60(2)(h), Chinese text—

**Repeal**

“圖形” (wherever appearing)

**Substitute**

“附圖”.

(10) Section 60(2)(h), Chinese text—

**Repeal**

“所獲安排的位置”

**Substitute**

“的排位”.

(11) Section 60(2)(h), Chinese text—

**Repeal**

“圖紙”

**Substitute**

“紙張”.

(12) Section 60(2)(i), Chinese text—

**Repeal**

“圖紙” (wherever appearing)

**Substitute**

“紙張”.

(13) Section 60(2)(i), Chinese text—

**Repeal**

“圖形” (wherever appearing)

**Substitute**

“附圖”.

- (14) Section 60(2)(i), Chinese text—

**Repeal**

“該等部分附圖任何部分的方式安排位置”

**Substitute**

“該等附圖組成部分中的任何部分的方式排位”.

- (15) Section 60(3), Chinese text—

**Repeal**

“流程簡圖”

**Substitute**

“示意圖”.

- (16) After section 60(3)—

**Add**

“Note—

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

**41. Section 61 amended (the abstract)**

- (1) Section 61(2), Chinese text—

**Repeal**

“化學程式”

**Substitute**

“化學式”.

- (2) Section 61(2), Chinese text—

**Repeal**

“純理論”

**Substitute**

“臆測”.

- (3) Section 61(4), Chinese text—

**Repeal**

“圖形” (wherever appearing)

**Substitute**

“附圖”.

**42. Section 62 amended (size and presentation of documents)**

- (1) Section 62—

**Repeal subsection (9)**

**Substitute**

- “(9) The description, claims and abstract—
- (a) must not contain drawings;
  - (b) may contain chemical or mathematical formulae;
  - (c) subject to subsection (9A), may contain tables; and
  - (d) subject to subsection (9B), must be typed or printed.
- (9A) The claims may contain tables only if their subject matter makes the use of tables desirable.
- (9B) If necessary, graphic symbols and chemical or mathematical formulae may be drawn or written by hand.
- (9C) All textual matters in the description, claims and abstract must be in black and indelible.
- (9D) The tables and chemical or mathematical formulae—
- (a) subject to paragraph (b)—must be presented in an upright position on a sheet; and

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

(2) Section 62(10)(c), Chinese text—

**Repeal**

“數學程式或化學程式”

**Substitute**

“數學或化學式”.

(3) Section 62(11), Chinese text—

**Repeal**

“程式、分子式”

**Substitute**

“式”.

(4) Section 62(14), Chinese text—

**Repeal**

“如任何文件的內容真確性不成疑問，而關於妥善複製該等文件的規定亦沒有受危害”

**Substitute**

“在任何文件的內容真確性不成疑問，以及不損關於妥善複製該等文件的規定的情況下”.

(5) Section 62(14), after “section 60”—

**Add**

“of these Rules”.

**43. Section 64 amended (claims)**

(1) Section 64(3)(a)—

**Repeal**

“these”.

- (2) Section 64(3)(a), Chinese text—

**Repeal**

“該其他權利要求”

**Substitute**

“該項其他權利要求”.

- (3) Section 64(3)(c), Chinese text—

**Repeal**

“過往” (wherever appearing)

**Substitute**

“在前”.

**44. Section 67 substituted**

Section 67—

**Repeal the section**

**Substitute**

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

- (1) If a short-term patent application complies with the requirement specified in section 114(3) of the Ordinance (*minimum requirement*), the Registrar must, by notice given to the applicant, notify the applicant of the date on which the minimum requirement is complied with.

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

#### **45. Sections 67A and 67B added**

After section 67—

##### **Add**

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

- (1) This section applies if a short-term patent application contains a purported reference to an earlier specified application referred to in section 114(3)(c)(ii) of the Ordinance.
- (2) For the purposes of the minimum requirement under section 114(3) of the Ordinance, a reference to an earlier specified application is not to be regarded as having been made unless the reference states—
  - (a) the date of filing of the earlier specified application;

- (b) the application number of the earlier specified application; and
  - (c) the country, territory or area in or for which the earlier specified application was made.
- (3) The applicant must file the following documents with the Registrar within 4 months after the date on which the minimum requirement under section 114(3) of the Ordinance is complied with—
- (a) a copy of the earlier specified application; and
  - (b) a copy of the certificate issued by the authority that received the earlier specified application (*certificate*).
- (4) If the earlier specified application is an application made under the Ordinance, the copies referred to in subsection (3)(a) and (b) are to be regarded as having been filed in due time.
- (5) If the earlier specified application or the certificate is in neither English nor Chinese, sections 56(1), 56A and 56B(3) of these Rules apply to it.
- (6) If a copy of the earlier specified application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(3) of these Rules as applied by subsection (5) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.

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

- (1) If a missing description or missing drawing is required by a notice under section 114A(1) of the Ordinance to be filed—

- 
- (a) it must be filed within 2 months after the date of the notice; and
    - (b) the previous application documents must be filed for the purposes of section 114A(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
  - (2) If a missing description or missing drawing is to be filed on an applicant's own initiative under section 114A(2) of the Ordinance—
    - (a) it must be filed within 2 months after the date on which the minimum requirement under section 114(3) of the Ordinance is compiled with; and
    - (b) the previous application documents must be filed for the purposes of section 114A(5)(d) of the Ordinance within 16 months after the earliest date of priority claimed.
  - (3) If the previous application referred to in section 114A(5)(a) of the Ordinance is an application made under the Ordinance, a copy of the previous application is to be regarded as having been filed in due time for the purposes of section 114A(5)(d) of the Ordinance.
  - (4) If the previous application is in neither English nor Chinese, sections 56A and 56C of these Rules apply to it.
  - (5) If a copy of the previous application or the translation required by sections 56A and 56C of these Rules as applied by subsection (4) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.



(6) In this section—

*missing description* (欠交說明) has the meaning given by section 114A(6) of the Ordinance;

*missing drawing* (欠交繪圖) has the meaning given by section 114A(6) of the Ordinance;

*previous application documents* (過往申請的文件) means—

- (a) the copy of the previous application referred to in section 114A(5)(d)(i) of the Ordinance; and
- (b) the statement referred to in section 114A(5)(d)(iii) of the Ordinance indicating which part of the previous application represents the description or drawing that is missing in the short-term patent application.”.

#### 46. Section 68 substituted

Section 68—

**Repeal the section**

**Substitute**

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

- (1) If an examination under section 115(1) of the Ordinance reveals deficiencies in a short-term patent application as regards the formal requirements within the meaning of that section, the Registrar must, by notice given to the applicant—
  - (a) notify the applicant of the deficiencies; and
  - (b) require the applicant to correct the deficiencies within 2 months after the date of the notice.

- (2) If the application is refused or is to be regarded as being withdrawn under section 115(1A) or (3) of the Ordinance, the Registrar must, by notice given to the applicant—
  - (a) notify the applicant of the refusal or withdrawal; and
  - (b) give the reasons for the refusal or withdrawal.”.

#### **47. Sections 68A and 68B added**

After section 68—

##### **Add**

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

- (1) If—
  - (a) an application for a short-term patent includes a request for deferral of grant of the patent described in section 119 of the Ordinance; and
  - (b) the only deficiency in the short-term patent application is the failure to file a search report as required by section 113(1A)(d) of the Ordinance,

the applicant may request an extension of time for filing the search report to a date not later than 1 month before the deferred date of grant of the patent.
- (2) If a filing fee or an advertisement fee payable under section 113(5) of the Ordinance is not paid within the time limit specified in that section, it is to be regarded as having been paid within the time limit if

it is paid, with an additional fee, within a grace period—

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

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

- (1) This section applies to a restoration application under section 110A of the Ordinance in relation to the priority right of a subsequent short-term patent application referred to in section 110A(1)(b) of the Ordinance.
- (2) A restoration application must be—
  - (a) in the specified form;
  - (b) accompanied by—
    - (i) a statement of priority referred to in section 111(1) of the Ordinance;
    - (ii) evidence—
      - (A) to establish why the subsequent short-term patent application was not filed before the expiry of the period of 12 months referred to in section 110(1A) of the Ordinance; and

- (B) to satisfy the Registrar that all reasonable care required by the circumstances of the case has been taken for the purposes of section 110A(5) of the Ordinance; and
- (iii) the prescribed fee for the restoration application; and
- (c) filed with the Registrar.
- (3) If the restoration application is not accompanied by the evidence required by subsection (2)(b)(ii), the Registrar must specify a period within which the evidence must be filed with the Registrar.
- (4) If there is any deficiency in the statement of priority filed, the Registrar must specify a period within which the deficiency must be corrected.
- (5) The restoration application is to be regarded as being withdrawn if—
- (a) the evidence is not filed within the period specified under subsection (3); or
- (b) the deficiency is not corrected within the period specified under subsection (4).
- (6) If the Registrar approves the restoration application, the following documents must be filed with the Registrar within a period specified by the Registrar—
- (a) a copy of the patent application on the basis of which the priority right is restored (***previous application***); and
- (b) a copy of the certificate (***certificate***) that—
- (i) is issued by the authority that received the previous application; and

- (ii) states the date of filing of the previous application.
- (7) If the previous application is a Hong Kong application as defined by section 108A of the Ordinance, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time.
- (8) If the previous application or the certificate is in neither English nor Chinese—
  - (a) sections 56(1), 56A and 56B(1) and (2) of these Rules apply to it; and
  - (b) the Registrar may make a requirement under section 56B(5) of these Rules in relation to it.
- (9) If a copy of the previous application, a copy of the certificate or the translation required by sections 56(1), 56A and 56B(1), (2) and (5) of these Rules as applied by subsection (8) is available to the Registrar before the expiry of the period for filing the document under these Rules, it is to be regarded as having been filed in due time.”.

#### **48. Section 69 substituted**

Section 69—

**Repeal the section**

**Substitute**

#### **“69. Claiming priority under section 111 of Ordinance**

- (1) Subject to section 69A of these Rules, this section applies if—

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

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

*non-Hong Kong application* (非香港申請) has the meaning given by section 108A of the Ordinance.”.

**49. Section 69A added**

After section 69—

**Add**

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

(1) This section applies if—

- (a) an earlier short-term patent application referred to in section 116 of the Ordinance has been filed; and
- (b) the applicant or the applicant’s successor in title files a new application referred to in that section that meets the conditions specified in that section.

(2) A right of priority that has not been claimed for the earlier short-term patent application may not be claimed for the new application.”.

**50. Section 70 amended (claim regarding non-prejudicial disclosure under section 109(b) of the Ordinance)**

(1) Section 70(a)—

**Repeal**

“at the exhibition”.

(2) Section 70(a)(i)—

**Repeal**

“in fact exhibited there;”



**Substitute**

“displayed at the exhibition; and”.

- (3) Section 70(a)—

**Repeal subparagraph (ii)**

**Substitute**

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

- (4) Section 70(b), Chinese text—

**Repeal**

“識別”

**Substitute**

“辨識”.

**51. Section 73 substituted**

Section 73—

**Repeal the section**

**Substitute**

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

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

**52. Section 73A added**

After section 73—

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

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

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

(1) Section 74(1)—

**Repeal**

“deemed to be”

**Substitute**

“regarded as being”.

(2) After section 74(2)—

**Add**

“(3) A new application is to be regarded as duly filed on the date on which the minimum requirement under section 114(3) of the Ordinance is complied with.”.

**54. Section 74A added**

Part 9, after section 74—

**Add**

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

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

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

**55. Section 75 substituted**

Section 75—

**Repeal the section**

### Substitute

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

- (1) Subject to section 45(3) of these Rules, a request to amend a short-term patent application before grant under section 120(1) of the Ordinance must—
  - (a) be in the specified form;
  - (b) identify the amendment;
  - (c) give the reasons for the amendment; and
  - (d) be filed with the Registrar.
- (2) If the applicant requests to amend the description, claims or drawings in the specification contained in a short-term patent application (*requested amendment*), the Registrar may, if the Registrar thinks fit, by notice given to the applicant, require the applicant to file the following copies of the amended specification (*required copies*) with the Registrar within the period specified by the Registrar—
  - (a) a clean copy of the specification with the requested amendment incorporated into it; and
  - (b) a copy of the specification with the requested amendment incorporated into it and indicated in it.
- (3) If the required copies are not filed within the period specified under subsection (2), the request for amendment to which the required copies relate is to be regarded as being withdrawn.

- (4) For the purposes of subsections (1) and (2), the amendment of the short-term patent application must be prepared in compliance with the requirements specified in sections 58(2) and (3), 59, 60, 61, 62(1) to (13), 63 and 64 of these Rules.
- (5) The Registrar may, by notice given to the applicant, require the applicant to correct any deficiencies in the requested amendment within the period specified in the notice.
- (6) If the deficiencies mentioned in the notice are not corrected within the period specified by the Registrar under subsection (5), the request to amend the short-term patent application is to be regarded as being withdrawn.”.

**56. Section 78 substituted**

Section 78—

**Repeal the section**

**Substitute**

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

- (1) The other date referred to in section 125(2) of the Ordinance is any date within 6 months after the date of issuance of an official notification by the State Intellectual Property Office stating that the international application has entered the national phase in the State Intellectual Property Office.
- (2) An application to which subsection (1) applies must be accompanied by a copy of the official notification issued by the State Intellectual Property Office.”.

**57. Section 79A added**

Before section 80—

**Add****“79A. Observations by third parties**

- (1) This section applies to a notice referred to in section 126A(1) of the Ordinance of a person’s observations on the patentability of an invention that is the subject of a short-term patent.
- (2) The notice must be filed with the Registrar during the following period—
  - (a) after the date on which the short-term patent is granted; and
  - (b) before the earliest of the following dates—
    - (i) the date on which the Registrar issues the certificate of substantive examination in respect of the short-term patent;
    - (ii) the date on which the Registrar gives the final revocation notice in relation to the short-term patent referred to in section 81N(2) of these Rules;
    - (iii) the date on which the short-term patent is found by the court to be wholly valid in any proceedings in which the validity of the patent is contested that are mentioned in section 127B(4)(b) of the Ordinance;
    - (iv) if the short-term patent has not been subsequently restored under section 127 of the Ordinance—the date on which the short-term patent has ceased to have effect under section 126 of the Ordinance;

- (v) the end of the period referred to in section 126(1)(b) of the Ordinance.
- (3) Section 126A(3) of the Ordinance does not apply to a notice that, in the opinion of the Registrar, would—
- (a) disparage any person in a way likely to damage the person; or
- (b) be generally expected to encourage any offensive, immoral or anti-social behaviour.”.

**58. Part 9, Divisions 5 and 6 added**

After section 81—

**Add**

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

**81A. Interpretation**

In this Division—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

## **81B. Request for substantive examination**

- (1) This section applies to the following requests for substantive examination of a short-term patent—
  - (a) the request made by the proprietor of a short-term patent under section 127B(1) of the Ordinance; and
  - (b) the request made by any other person under section 127B(2) of the Ordinance (*requester*).
- (2) A request for substantive examination made under section 127B(1)(a) of the Ordinance must be—
  - (a) in the specified form;
  - (b) accompanied by the prescribed fee for the request; and



- (c) filed with the Registrar.
- (3) A request for substantive examination made under section 127B(2) of the Ordinance must—
  - (a) be in the specified form;
  - (b) set out the information and particulars to satisfy the Registrar as to the matters specified in section 127B(2)(a) or (b) of the Ordinance that are applicable to the request;
  - (c) be accompanied by the prescribed fee for the request; and
  - (d) be filed with the Registrar.

**81C. Registrar may require further information and particulars**

- (1) If the Registrar receives a request under section 127B(2) of the Ordinance, the Registrar may, by notice given to the requester, require the requester to file further information and particulars within the period specified in the notice to satisfy the Registrar as to the matters specified in section 127B(2)(a) or (b) of the Ordinance that are applicable to the request.
- (2) If the requester fails to comply with the requirement under subsection (1), the request is to be regarded as not having been made.
- (3) The Registrar must—
  - (a) consider the information and particulars filed under section 81B(3)(b) of these Rules and subsection (1) (if any); and
  - (b) by notice given to the proprietor and the requester—

- (i) notify them of the Registrar's decision on whether to carry out substantive examination of the short-term patent; and
- (ii) give the reasons for the decision.

#### **81D. Examination notice**

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

(2) In subsection (1)—

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

#### **81E. Response to examination notice**

(1) A response to an examination notice to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to examination notice*) must be filed by the proprietor with the Registrar within 2 months after the date of the notice.

(2) If the proprietor fails to comply with the requirement under subsection (1), the Registrar must make a provisional decision to revoke the patent.

#### **81F. Further examination notice**

(1) This section applies if—

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

### **81G. Response to further examination notice**

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

- (a) the words “a response to examination notice in accordance with section 81E(1)” in section 81F(1)(a) of these Rules were substituted by the words “a response to further examination notice in accordance with section 81G(1)”; and
- (b) the words “the response to examination notice” in section 81F(2)(a) of these Rules were substituted by the words “the response to further examination notice”.

#### **81H. Provisional revocation notice**

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

- (c) state that the proprietor may respond to the provisional revocation notice by filing a request to review the Registrar's opinion under section 127D(3)(c) of the Ordinance in accordance with section 81I(1) and (2) of these Rules.

### **81I. Request to review**

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

**81J. Review opinion**

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

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

**81K. Response to review opinion**

- (1) A response to a review opinion to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to review opinion*) must be filed by the proprietor with the Registrar within 2 months after the date of the review opinion.
- (2) If the review opinion states that the proprietor may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(c) of these Rules.
- (3) A request for hearing must be—
  - (a) in the specified form;
  - (b) accompanied by the prescribed fee for the request; and

- (c) filed with the Registrar.
- (4) If no response to review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
  - (a) make a final decision to revoke the patent; and
  - (b) give the proprietor a final revocation notice.

### **81L. Further review opinion**

- (1) This section applies if—
  - (a) the Registrar has considered—
    - (i) a request to review filed by the proprietor of a short-term patent in accordance with section 81I(1) and (2) of these Rules; and
    - (ii) a response to review opinion filed by the proprietor in accordance with section 81K(1) of these Rules, if any; and
  - (b) where the proprietor had requested a hearing under section 82(1) of these Rules—the hearing has been held.
- (2) The Registrar may, by notice given to the proprietor (*further review opinion*)—
  - (a) set out any matter covered in the following request, response and hearing, if any, in respect of which the Registrar considers that elaboration, revision or clarification is required—
    - (i) the request to review;
    - (ii) the response to review opinion; and

- (iii) the hearing under section 82(1) of these Rules;
  - (b) state that the proprietor may file a further response in relation to the matter in accordance with section 81M(1) of these Rules to elaborate on, revise or clarify the matter; and
  - (c) if the Registrar thinks fit, and if applicable—state that the proprietor may file a request for hearing under section 82(1) of these Rules in accordance with section 82(2)(d) of these Rules.
- (3) The Registrar may give further review opinion more than once.

#### **81M. Response to further review opinion**

- (1) A response to a further review opinion to be filed for the purposes of section 127D(3)(a) or (b) of the Ordinance (*response to further review opinion*) must be filed by the proprietor with the Registrar within 2 months after the date of the further review opinion.
- (2) If the further review opinion states that the proprietor may request a hearing under section 82(1) of these Rules, a request for hearing under that section may be filed within the period referred to in section 82(2)(d) of these Rules.
- (3) A request for hearing must be—
  - (a) in the specified form;
  - (b) accompanied by the prescribed fee for the request; and
  - (c) filed with the Registrar.



- (4) If no response to further review opinion is filed in accordance with subsection (1) and no request for hearing, if applicable, is filed in accordance with subsections (2) and (3), the Registrar must—
  - (a) make a final decision to revoke the patent; and
  - (b) give the proprietor a final revocation notice.
- (5) Section 81L of these Rules applies in relation to a response to further review opinion as if—
  - (a) the words “a response to review opinion filed by the proprietor in accordance with section 81K(1) of these Rules” in section 81L(1)(a)(ii) of these Rules were substituted by the words “a response to review opinion and a response to further review opinion filed by the proprietor in accordance with sections 81K(1) and 81M(1) of these Rules respectively”; and
  - (b) the words “the response to review opinion” in section 81L(2)(a)(ii) of these Rules were substituted by the words “the response to review opinion and the response to further review opinion”.

#### **81N. Final revocation notice**

- (1) If the Registrar, having considered the matters raised in the following request, responses and hearing, if any, is still of the opinion that the short-term patent does not comply with the examination requirement concerned, the Registrar may make a final decision to revoke the patent—
  - (a) a request to review;
  - (b) a response to review opinion;

- (c) a response to further review opinion;
  - (d) the hearing under section 82(1) of these Rules.
- (2) If the Registrar makes the final decision, the Registrar must, by notice given to the proprietor and the requester, if any (*final revocation notice*)—
- (a) notify the proprietor and the requester, if any, of the decision; and
  - (b) give the reasons for the decision.

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

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

## **Division 6—Amendment of Short-term Patents after Grant**

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

- (1) This section applies to a request to amend the specification of a short-term patent after grant under section 127B(1)(b) or 127D(3)(b) of the Ordinance.
- (2) The request must be—
  - (a) in the specified form;
  - (b) accompanied by a copy of the specification incorporating the requested amendment indicated by—
    - (i) striking through the text, figure or other matter to be replaced or deleted; and

- (ii) underlining the replacement text, figure or other matter; and
  - (c) filed with the Registrar.
- (3) For the purposes of subsection (2), the requested amendment must be prepared in compliance with the requirements specified in sections 58(2) and (3), 59, 60, 62(1) to (13) and 64 of these Rules.
- (4) The Registrar may, having regard to all examination requirements and any unfulfilled requirements being complied with—
  - (a) subject to section 103(3) of the Ordinance, accept the requested amendment in whole or in part as an allowable amendment (***allowable amendment***) for publication under section 127E(2)(a) of the Ordinance; or
  - (b) refuse to accept the requested amendment.
- (5) If the Registrar accepts an allowable amendment under subsection (4)(a), the Registrar must, in addition to publishing the allowable amendment under section 127E(2)(a) of the Ordinance—
  - (a) notify the proprietor of the Registrar's decision; and
  - (b) advertise the fact of the publication by notice in the official journal.

### 81Q. Opposition notice

- (1) Any person who intends to oppose an allowable amendment referred to in section 81P(4)(a) of these Rules and published under section 127E(2)(a) of the Ordinance (***opponent***) may file an opposition notice with the Registrar.

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

### **81R. Counter-statement**

- (1) The proprietor of a short-term patent who receives from an opponent referred to in section 81Q of these Rules a copy of an opposition notice and intends to resist the opposition may file a counter-statement with the Registrar.

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

### **81S. Directions by Registrar**

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

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

- (1) If an opposition notice is filed under section 81Q(1) of these Rules in opposition to an allowable amendment, and a counter-statement is filed under section 81R(1) of these Rules to resist the opposition, the Registrar—
  - (a) must, before making a decision under section 127E(2)(c) of the Ordinance, consider—
    - (i) the opposition notice and the statement referred to in section 81Q(3)(b)(i) of these Rules;
    - (ii) the counter-statement;
    - (iii) the representation made at a hearing requested under section 82A(2) or (3) of these Rules, if any; and
    - (iv) the evidence furnished in accordance with the directions given under section 81S of these Rules, if any; and
  - (b) must, under section 127E(2)(c) of the Ordinance—
    - (i) decide to allow the allowable amendment in whole or in part as an allowed amendment; or
    - (ii) decide to refuse to allow the allowable amendment.
- (2) If no opposition notice is filed in opposition to an allowable amendment, the Registrar must, having decided under section 127E(2)(c) of the Ordinance to allow the amendment in whole or in part, allow the

amendment in whole or in part as an allowed amendment.

- (3) If a decision is made under subsection (1)(b)(i) or (2), the Registrar must, in addition to complying with section 127E(4)(a) and (b) of the Ordinance—
  - (a) notify the proprietor of the short-term patent and the opponent referred to in section 81Q(1) of these Rules, if any, of the decision; and
  - (b) consider if the patent with the allowed amendment would achieve compliance with the examination requirements under section 127C(2) of the Ordinance.
- (4) If a decision is made under subsection (1)(b)(ii), the Registrar must—
  - (a) notify the proprietor and the opponent of the decision; and
  - (b) advertise the decision by notice in the official journal.
- (5) To avoid doubt, the decision of the Registrar to not allow any allowable amendment does not in itself affect the duty of the Registrar to—
  - (a) examine the patent to determine whether the patent complies with the examination requirements under section 127C(2) of the Ordinance; and
  - (b) make a consideration and decision or review under section 127E(1)(a)(i) or (b) of the Ordinance.
- (6) In this section—

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

- (a) accepted in whole or in part as an allowable amendment under section 81P(4)(a) of these Rules; and
- (b) published under section 127E(2)(a) of the Ordinance.

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

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



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

- (1) This section applies to the Registrar in the consideration of any relevant amendment.
- (2) If the Registrar, having considered the relevant amendment, is of the opinion that the relevant amendment does not achieve compliance with the examination requirement concerned, the Registrar must notify the proprietor of the Registrar's opinion by issuing a relevant document to the proprietor, as the case requires.
- (3) In deciding which relevant document to issue under subsection (2), the Registrar is to have regard to the nature of the document in which the relevant amendment is contained.
- (4) Part 9, Division 5 of these Rules applies to any relevant document issued under subsection (2) and any part of the procedure including the subsequent procedure to be followed.
- (5) In this section—

***relevant amendment*** (有關修訂) means—

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

***relevant document*** (有關文件) means—

- (a) an examination notice under section 81D(1) of these Rules;
- (b) a further examination notice under section 81F(2) of these Rules;

- (c) a review opinion under section 81J of these Rules; and
- (d) a further review opinion under section 81L(2) of these Rules.”.

**59. Section 82 amended (Registrar’s discretionary powers)**

- (1) Section 82(1)—

**Repeal**

“required”

**Substitute**

“requested”.

- (2) Section 82—

**Repeal subsection (2)**

**Substitute**

- “(2) A request made under subsection (1) for a hearing must be filed—
- (a) for a request referred to in section 31ZK(2) of these Rules—within 2 months after the date of the relevant review opinion referred to in section 31ZJ of these Rules stating that the applicant may request a hearing;
  - (b) for a request referred to in section 31ZM(2) of these Rules—within 2 months after the date of the relevant further review opinion referred to in section 31ZL of these Rules stating that the applicant may request a hearing;

- (c) for a request referred to in section 81K(2) of these Rules—within 2 months after the date of the relevant review opinion referred to in section 81J of these Rules stating that the proprietor may request a hearing;
  - (d) for a request referred to in section 81M(2) of these Rules—within 2 months after the date of the relevant further review opinion referred to in section 81L of these Rules stating that the proprietor may request a hearing;
  - (e) for any other request—within 1 month after the date on which the person filing the request receives from the Registrar the notice of any objection to an application or of any other proposal to exercise the Registrar’s discretionary power.”.
- (3) After section 82(5)—

**Add**

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

**60. Section 82A added**

After section 82—

**Add**

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

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

- 
- (2) A proprietor who files a counter-statement under section 38C or 81R of these Rules—
    - (a) may, at the same time, request a hearing; or
    - (b) may, after doing so, request a hearing no later than 1 month after the date of expiry of the time limit for the filing.
  - (3) An opponent referred to in section 38C or 81R of these Rules, as the case requires, may, after the filing of the counter-statement, request a hearing no later than 1 month after the date of expiry of the time limit for the filing.
  - (4) A request for hearing must be—
    - (a) in the specified form;
    - (b) accompanied by the prescribed fee for the request; and
    - (c) filed with the Registrar.
  - (5) If the Registrar receives a request for hearing, the Registrar must, by notice given to the proprietor and the opponent, notify them of the date, time and place for the hearing.
  - (6) At any time before the Registrar gives the notice, the person who filed the request may, by a notice in writing, withdraw the request.
  - (7) A withdrawal under subsection (6) is irrevocable.
  - (8) A proprietor or opponent who—
    - (a) did not file a request for hearing; and
    - (b) receives the notice referred to in subsection (5), may, if the proprietor or the opponent intends to appear at the hearing, file a notice of intention to appear at the hearing with the Registrar.

- (9) A notice of intention to appear at the hearing must be—
  - (a) in the specified form;
  - (b) accompanied by the prescribed fee for the notice; and
  - (c) filed within 14 days after the date on which the proprietor or the opponent receives the notice referred to in subsection (5).
- (10) A person who may file a notice of intention under subsection (8) but has not done so may not appear at the hearing concerned.
- (11) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.

**61. Section 83 amended (hearings in public)**

- (1) Section 83(1), after “subsection (2)”—

**Add**

“, the following hearings must be held in public”.

- (2) Section 83(1)(a)—

**Repeal**

“and”.

- (3) Section 83(1)(b)—

**Repeal**

everything after “record”

**Substitute**

“or after the publication of the standard patent (O) application in accordance with section 20 or 37Q of the Ordinance; and”.

- (4) After section 83(1)(b)—

**Add**

“(c) any hearing in connection with a short-term patent after the publication of the specification of the patent under section 118(2)(a) of the Ordinance.”.

- (5) Section 83(1)—

**Repeal**

“shall be held in public.”.

**62. Section 87 amended (security for costs)**

- (1) Section 87(a), after “13”—

**Add**

“or 37H”.

- (2) Section 87(c)—

**Repeal the comma**

**Substitute a semicolon.**

- (3) After section 87(c)—

**Add**

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

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

- Section 88(1)(a)(i), after “record”—

**Add**

“or a standard patent (O) application”.

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

Section 89(1)(b)—

**Repeal**

“solely”

**Substitute**

“, or prepared by an adviser appointed under section 99(1) of these Rules, solely”.

**65. Section 90 amended (confidential documents)**

Section 90(5)—

**Repeal**

“section 100”

**Substitute**

“section 100AA of these Rules”.

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

(1) Section 91(b), after “section”—

**Add**

“37E(1) or”.

(2) Section 91(cc)—

**Repeal**

“section 3”

**Substitute**

“section 3(6) or 31F(4)(b) of these Rules”.

**67. Section 94 amended (correction of irregularities)**

Section 94(3)—

**Repeal**

everything after “power to”

**Substitute**

“grant any extended period under section 100AA, 100AAB, 100AAC or 100AAD of these Rules.”.

**68. Section 98A added**

After section 98—

**Add**

**“98A. Registrar may make and send copy of document**

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

- (a) make a copy of any document (or any part of the document) containing reference to the state of the art; and
- (b) send the copy to any party to the proceedings.”.

**69. Section 100 substituted**

Section 100—

**Repeal the section**

**Substitute**



**“100. Interpretation**

In this Division—

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

- (a) if no extended period is granted under this Division—the initial period; and
- (b) if an extended period has been granted under this Division—the extended period immediately before the relevant extended period;

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

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

**70. Sections 100AA to 100AAD added**

After section 100—

**Add**

**“100AA. Extension of time—general provision**

- (1) Subject to subsection (4), the Registrar may grant an extended period for a current period within which a person must do any act or a party must take any proceedings under these Rules if—
  - (a) a request is made to the Registrar in the specified form for the grant of an extended period; and
  - (b) the prescribed fee for the request is paid.

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

#### **100AAB. Grant of extended period on request**

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 2, 3, 4 or 5 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if, before the expiry of the time limit referred to in subsection (2)—
  - (a) a request is made to the Registrar in the specified form for the grant of an extended period; and
  - (b) the prescribed fee for the request is paid.
- (2) For the purposes of subsection (1), the time limit is—
  - (a) for a provision set out in Part 2 or 4 of Schedule 4 to these Rules—the current period;

- (b) for a provision set out in Part 3 of Schedule 4 to these Rules—1 month after the expiry of the current period; or
  - (c) for a provision set out in Part 5 of Schedule 4 to these Rules—2 months after the expiry of the current period.
- (3) The extended period that may be granted under this section is—
- (a) for a provision set out in Part 2 or 3 of Schedule 4 to these Rules—1 month; and
  - (b) for a provision set out in Part 4 or 5 of Schedule 4 to these Rules—2 months.
- (4) No extended period may be granted under subsection (1) for any period for which an extended period has been granted under that subsection.

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

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 6 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if the Registrar is satisfied that the failure to do any act or take any proceedings required by the provision within the current period was wholly or mainly attributable to any of the following events in Hong Kong, or in the country, territory or area of the designated patent office, as the case requires—
- (a) any failure or undue delay in the postal services;
  - (b) any natural disaster;
  - (c) any strike.

- (2) The extended period that may be granted under this section is a period not exceeding 2 months that the Registrar considers reasonable.

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

- (1) For an initial period prescribed in, or specified under, a provision set out in Part 7 of Schedule 4 to these Rules, the Registrar may grant an extended period for a current period if, after the expiry of the current period—
  - (a) the applicant to whom the provision applies has—
    - (i) made a request to the Registrar in the specified form for the grant of an extended period; and
    - (ii) paid the prescribed fee for the request; and
  - (b) the Registrar is satisfied that the only deficiency remaining in the subject document is the failure to file—
    - (i) a translation of the title of the invention or the abstract referred to in section 56(2)(a) or (b) of these Rules; or
    - (ii) a transliteration of the names of the applicant or inventor referred to in section 56(2)(c) of these Rules.
- (2) The extended period that may be granted under this section is a period that the Registrar considers reasonable for correcting the only deficiency remaining.

(3) In this section—

*subject document* (標的文件) means any of the following documents referred to in a provision in these Rules in which deficiencies are revealed and required to be corrected—

- (a) if the provision is section 17 of these Rules—a request to record under section 15 of the Ordinance;
- (b) if the provision is section 24 of these Rules—a request for registration and grant under section 23 of the Ordinance;
- (c) if the provision is section 31Y(1) of these Rules—a standard patent (O) application under section 37L of the Ordinance;
- (d) if the provision is section 68(1) of these Rules—a short-term patent application under section 113 or 125 of the Ordinance.”.

**71. Section 106 amended (entries in the register)**

Section 106(2)(h)—

**Repeal**

“98”

**Substitute**

“11B”.

**72. Section 113 amended (transitional provision relating to the Patents (General) (Amendment) Rules 2004)**

(1) Section 113—

**Repeal**

“38,”.

(2) Section 113—

**Repeal**

“14.”.

**73. Section 114 added**

After section 113—

**Add**

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

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

**74. Schedule 1 amended (micro-organisms)**

(1) Schedule 1—

**Repeal**

“[s. 73]”

**Substitute**

“[ss. 31ZW & 73 & Sch. 4]”.

- (2) Schedule 1, before paragraph 1—

**Add****“1A. Interpretation**

In this Schedule—

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

*patent* (專利) means a standard patent (O) or short-term patent.”.

- (3) Schedule 1, paragraph 1(1)—

**Repeal**

everything after “subject of” and before “requires”

**Substitute**

“a patent application or patent”.

- (4) Schedule 1, paragraph 1(1)—

**Repeal**

“shall only be regarded”

**Substitute**

“is to be regarded, in relation to the micro-organism itself,”.

- (5) Schedule 1, paragraph 1(3)—

**Repeal**

“The”

**Substitute**

“For a short-term patent application, the”.

- (6) Schedule 1, paragraph 1(3)(b)—

**Repeal**

everything after “has”

**Substitute**

“informed the applicant that a request referred to in section 147(5) of the Ordinance has been made.”.

- (7) Schedule 1, paragraph 1—

**Repeal subparagraph (4)**

**Substitute**

- “(4) For a standard patent (O) application, if the information specified in subparagraph (2)(b) is not submitted at the time the application is filed, it must be submitted before the earliest of the following time—
- (a) the expiry of 16 months after—
    - (i) if priority has been claimed—the date of priority claimed; or
    - (ii) if priority has not been claimed—the date of filing;
  - (b) if a request is made under section 37Q(2) of the Ordinance—the date of the request;
  - (c) the expiry of 1 month after the Registrar has informed the applicant that a request referred to in section 147(4) of the Ordinance has been made.
- (5) For a patent application, the applicant is, on giving the information specified in subparagraph (2)(b) in the specification of the application, to be regarded as having also given the specified consent under paragraph 1B.”.



(8) Schedule 1, after paragraph 1—

**Add**

**“1B. Specified consent**

(1) A specified consent—

(a) is the consent of an applicant of a patent application to make a deposited culture available to—

(i) an entitled person after the information specified in paragraph 1(2)(b) is given; and

(ii) any person who is not an entitled person, after the date of publication of the standard patent (O) application or the date of grant of the short-term patent;

(b) is unconditional and irrevocable; and

(c) is subject to—

(i) the production of the Registrar's confirmation notice regarding the release to the person who is named in the confirmation notice as a person to whom the culture may be made available; and

(ii) the making of a valid request for the culture to be made available to the depositary institution with which the culture is deposited.

(2) In subparagraph (1)—

*deposited culture* (寄存的培養物) includes a deposited culture that is treated under paragraph 3(2) as having always been available;

**entitled person** (具有權利的人) means a person who has the right to make a request in the circumstances specified in—

- (a) for a standard patent (O) application—section 147(4) of the Ordinance;
- (b) for a short-term patent application—section 147(5) of the Ordinance.”.

(9) Schedule 1, English text, paragraph 2(1) and (2)—

**Repeal**

“notice of confirmation”

**Substitute**

“confirmation notice”.

(10) Schedule 1, paragraph 2(4)(a)—

**Repeal**

“deemed to have been”

**Substitute**

“to be regarded as being”.

(11) Schedule 1, paragraph 2(4)(a)—

**Repeal**

everything after “been refused”

**Substitute a semicolon.**

(12) Schedule 1, paragraph 2(4)(b), before “126(5)”—

**Add**

“39(4) or”.

(13) Schedule 1, after paragraph 2(4)—

**Add**

“(4A) The period referred to in subparagraph (4)(a)—

- (a) if it is a period that has been altered under section 94 of these Rules or for which an extended period has been granted under section 100AA, 100AAB, 100AAC or 100AAD of these Rules—includes such altered period and extended period but does not include the period before the alteration or the grant of the extension; and
  - (b) if an application is reinstated under section 28 of the Ordinance as applied by section 37ZD or 123 of the Ordinance—does not include the period between the withdrawal, deemed withdrawal or refusal (as the case requires) and the reinstatement of the application.”.
- (14) Schedule 1, after paragraph 2—

**Add**

**“2A. Making cultures available only to experts**

- (1) This paragraph and paragraphs 2B, 2C, 2D and 2E do not affect the rights of the Government or any person authorized in writing by a public officer under section 69 of the Ordinance.
- (2) This paragraph and paragraphs 2B, 2C, 2D and 2E apply if—
  - (a) before preparations for publication of a patent application under one of the following provisions have been completed—
    - (i) for a standard patent (O) application—section 37Q(1)(a) of the Ordinance;
    - (ii) for a short-term patent application—section 118(2)(a) of the Ordinance; and

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

## **2B. Request to make cultures available to experts**

- (1) If a notice is filed under paragraph 2A(2), any person may request the Registrar to make the sample of micro-organism available to an expert (*requester*).
- (2) The request must—
  - (a) be in the specified form;
  - (b) nominate the expert to whom the requester wishes the sample to be made available;

- (c) set out the particulars and the credentials of the expert;
  - (d) be accompanied by the undertakings of the expert made for the benefit of the applicant for, or the proprietor of, the patent—
    - (i) not to make the sample, or any sample derived from it, available to any other person; and
    - (ii) not to use the sample, or any sample derived from it, otherwise than for experimental purposes relating to the subject matter of the invention; and
  - (e) be filed with the Registrar.
- (3) An undertaking—
- (a) referred to in subparagraph (2)(d) has effect, subject to sub-subparagraph (c), during any period before the patent application has been withdrawn, is to be regarded as being withdrawn or has been refused;
  - (b) referred to in subparagraph (2)(d)(i) also has effect, if a patent is granted on the application, during any period for which the patent is in force and during the further period of 6 months referred to in section 39(4) or 126(5) of the Ordinance; and
  - (c) referred to in subparagraph (2)(d)(ii) does not have effect after the date of publication in the official journal of a notice advertising the grant of the patent.

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- (4) The period referred to in subparagraph (3)(a)—
- (a) if it is a period that has been altered under section 94 of these Rules or for which an extended period has been granted under section 100AA, 100AAB, 100AAC or 100AAD of these Rules—includes such altered period and extended period but does not include the period before the alteration or the grant of the extension; and
  - (b) if an application is reinstated under section 28 of the Ordinance as applied by section 37ZD or 123 of the Ordinance—does not include the period between the withdrawal, deemed withdrawal or refusal (as the case requires) and the reinstatement of the application.
- (5) For the purposes of enabling any Government use specified in section 69 of the Ordinance in relation to the culture, the undertakings referred to in subparagraph (2)(d)—
- (a) are not required from any Government department or person authorized in writing by a Government department for the purposes of this paragraph; and
  - (b) do not have effect in relation to the expert who made the undertakings.
- (6) An undertaking referred to in subparagraph (2)(d) may be varied by way of derogation by agreement between—
- (a) the applicant or proprietor; and
  - (b) the expert who made the undertaking.

- (7) If, in respect of a patent to which an undertaking referred to in subparagraph (2)(d) relates, a compulsory licence is granted under section 64 of the Ordinance, the undertaking does not have effect to the extent necessary for the licence to have effect.

## **2C. Applicant may file opposition notice**

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

## **2D. Opposition notice**

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

**2E. Confirmation notice in favour of expert**

- (1) If an opposition notice is filed in accordance with paragraph 2D(1) and (2), the Registrar must—
  - (a) decide, having regard to the credentials of the expert and any other factors the Registrar considers relevant, whether to issue a confirmation notice in favour of the expert;
  - (b) if the Registrar decides to issue a confirmation notice in favour of the expert—send a copy of the request filed under paragraph 2B and the confirmation notice to—
    - (i) the applicant for the patent;
    - (ii) the depositary institution;
    - (iii) the requester referred to in paragraph 2B(1); and
    - (iv) the expert; and
  - (c) if the Registrar decides not to issue a confirmation notice—notify the requester and the applicant of the decision in writing.
- (2) If the Registrar notifies the requester under subparagraph (1)(c), the requester may nominate another expert under paragraph 2B.
- (3) If no opposition notice is filed in accordance with paragraph 2D(1) and (2), the Registrar must send a copy of the request and the confirmation notice to—
  - (a) the applicant;
  - (b) the depositary institution;
  - (c) the requester; and
  - (d) the expert.



- (4) The Registrar may, on the initiative of the Registrar or on application of a party to the proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed.”.
- (15) Schedule 1, paragraph 3(1)(a)(i), after “2(1)”—  
**Add**  
“or 2B(1)”.
- (16) Schedule 1, English text, paragraph 3(2)—  
**Repeal**  
“,—”  
**Substitute**  
“—”.
- (17) Schedule 1, paragraph 3(2)(c), after “section”—  
**Add**  
“37ZA,”.
- (18) Schedule 1, paragraph 4(1), definition of *the Budapest Treaty*, after “1977”—  
**Add**  
“as revised or amended from time to time”.
- (19) Schedule 1, paragraph 4(1), definition of *international depositary authority*—  
**Repeal**  
“a depositary”  
**Substitute**  
“an”.

- (20) Schedule 1, paragraph 4(2)—

**Repeal**

everything after “*depository institution*”

**Substitute**

“is—

- (a) an international depository authority; or
- (b) an institution that at all relevant times—
  - (i) performs the functions of receiving, accepting and storing micro-organism and furnishing samples of micro-organism; and
  - (ii) conducts its affairs in so far as they relate to those functions in an objective and impartial manner.”.

**75. Schedule 2 amended (fees)**

- (1) Schedule 2—

**Repeal**

“[s. 104]”

**Substitute**

“[ss. 104 & 114]”.

- (2) Schedule 2—

**Repeal**

“Fee No.”

**Substitute**

“Item”.

- (3) Schedule 2, item 1—

**Repeal**

“13(1)(a), 13(1)(b) or 14(5)”

**Substitute**

“13(1)(a) or (b), 14(5), 37H(1)(a) or (b) or 37K(7)”.

- (4) Schedule 2, item 2—

**Repeal**

“3(7), 7(4), 37(5), 38(5),”

**Substitute**

“2C(1), 3(7), 7(4)(a), 31G(1), 31L(1), 37(5),”.

- (5) Schedule 2, item 2, after “108(3)”—

**Add**

“of these Rules”.

- (6) Schedule 2, item 3, after “13(5)”—

**Add**

“or 37I(4)”.

- (7) Schedule 2, item 3, after “(4)”—

**Add**

“or 37I(1)(d)(ii)”.

- (8) Schedule 2—

**Repeal item 4**

**Substitute**

“4 Filing request to record a designated patent application under section 15 or 22 of the Ordinance—

if the filing is made in paper or other physical form or is by fax 380

if the filing is made by electronic means to an information system designated by the Registrar 275”.

(9) Schedule 2—

**Repeal item 5**

**Substitute**

“5 Filing request for registration of a designated patent and grant of a standard patent (R) under section 23 of the Ordinance—

if the filing is made in paper or other physical form or is by fax 380

if the filing is made by electronic means to an information system designated by the Registrar 275”.

(10) Schedule 2—

**Repeal item 6**

**Substitute**

“6 Filing application for grant of a short-term patent under section 113, 116 or 125 of the Ordinance—

if the filing is made in paper or other physical form or is by fax 755

if the filing is made by electronic means to an information system designated by the Registrar 545”.

(11) Schedule 2, item 9, after “21”—

**Add**

“of these Rules”.

- (12) Schedule 2, item 10—

**Repeal**

“68(6)”

**Substitute**

“68A(2) of these Rules”.

- (13) Schedule 2—

**Repeal item 13**

**Substitute**

“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, 4th, 5th, 6th, 7th, 8th or 9th year 450

request for renewal for a further year after the expiry of the 10th, 11th, 12th, 13th or 14th year 620

request for renewal for a further year after the expiry of the 15th, 16th, 17th, 18th or 19th year 850”.

- (14) Schedule 2, item 18, after “28”—

**Add**

“, 37ZD”.

- (15) Schedule 2, item 18, after “29”—

**Add**

“, 37ZD”.

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- (16) Schedule 2, item 19—  
**Repeal**  
“45”  
**Substitute**  
“9F”.
- (17) Schedule 2, item 21, after “46”—  
**Add**  
“of these Rules”.
- (18) Schedule 2, item 25—  
**Repeal**  
“17, 24, 29, 68 or 100”  
**Substitute**  
“100AA(1)(b) or 100AAB(1)(b) of these Rules”.
- (19) Schedule 2, item 26, after “translation”—  
**Add**  
“or transliteration”.
- (20) Schedule 2, item 26—  
**Repeal**  
“sections 17(4), 24(4), 56 or 68”  
**Substitute**  
“section 56(9) or 100AAD(1)(a)(ii)”.

## (21) Schedule 2, after item 30—

**Add**

“31	Restoration application under section 37D of the Ordinance and section 31B of these Rules, or under section 110A of the Ordinance and section 68B of these Rules	405
32	Filing statement of priority under section 31C(4) or 69(4) of these Rules	135
33	Filing standard patent (O) application under section 37L(1)(b) of the Ordinance and section 31M of these Rules, or under section 37Z(1)(b) of the Ordinance and section 31ZS of these Rules—	
	if the filing is made in paper or other physical form or is by fax	480
	if the filing is made by electronic means to an information system designated by the Registrar	345
34	Advertisement fee for standard patent (O) application under section 37L(5) of the Ordinance and section 31M(5) of these Rules	68
35	Additional fee for late payment of filing fee or advertisement fee for standard patent (O) application under section 31M(5)(b) of these Rules	95

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



**76. Schedule 4 added**  
After Schedule 3—  
**Add**

**“Schedule 4**

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

**Time Limits**

**Part 1**

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

Column 1	Column 2
Item	Provision of these Rules to which the period relates
1.	Section 11 (grace period)
2.	Section 16(1) (notice following examination under section 18 of Ordinance)
3.	Section 21 (grace period)

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Column 1	Column 2
Item	Provision of these Rules to which the period relates
4.	Section 23(1) (communication following examination under section 25(1) of the Ordinance)
5.	Section 31B(6) (restoration of priority right under section 37D of Ordinance)
6.	Section 31C(4) and (7) (claiming priority under section 37E of Ordinance)
7.	Section 31M(5) (standard patent (O) application under section 37L of Ordinance)
8.	Section 31V(2)(b) (notice after examination of minimum requirement under section 37M of Ordinance)
9.	Section 31W(3) (requirements for making reference to earlier specified application referred to in section 37M(3)(c)(ii) of Ordinance)
10.	Section 31ZA(2) (observations by third parties)
11.	Section 31ZC(3) and (4) (request for substantive examination)
12.	Section 31ZS(2) (divisional standard patent (O) application under section 37Z of Ordinance)

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Column 1	Column 2
Item	Provision of these Rules to which the period relates
13.	Section 31ZT(2) (request to amend standard patent (O) application before grant under section 37ZA(1) of Ordinance)
14.	Section 35(1) (amendment of standard patent (R) under section 43 of the Ordinance)
15.	Section 40(2) (surrender of patents)
16.	Section 48(4) (correction of errors in patents and applications under section 146 of the Ordinance)
17.	Section 53(1) and (2) (time limit for application under section 58 of the Ordinance)
18.	Section 56(9) (the language of proceedings before the Registrar)
19.	Section 56B(1) and (3) (language requirements for sections 37E(1), 37M(3)(c)(ii), 111(1) and 114(3)(c)(ii) of Ordinance)
20.	Section 57(3) (filing of corrected translation under section 106(3) of the Ordinance)
21.	Section 67(2)(b) (notice after examination of minimum requirement under section 114 of Ordinance)

Column 1	Column 2
Item	Provision of these Rules to which the period relates
22.	Section 67A(3) (requirements for making reference to earlier specified application referred to in section 114(3)(c)(ii) of Ordinance)
23.	Section 68A(2) (extension of time for filing search report and paying filing fee or advertisement fee)
24.	Section 68B(6) (restoration of priority right under section 110A of Ordinance)
25.	Section 69(4) and (7) (claiming priority under section 111 of Ordinance)
26.	Section 74(1) (divisional short-term patent application under section 116 of the Ordinance)
27.	Section 78(1) (short-term patent application based on international application under section 125 of Ordinance)
28.	Section 79A(2) (observations by third parties)
29.	Paragraph 2C(1)(b) of Schedule 1 (micro-organisms)

## Part 2

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

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

### Part 3

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

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

## Part 4

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

Column 1	Column 2
Item	Provision of these Rules to which the period relates
1.	Section 17 (correction of deficiencies in request to record)
2.	Section 24 (correction of deficiencies in request for registration and grant)
3.	Section 29(2) (correction of deficiencies and removal of doubts in maintenance documents)
4.	Section 31X(1) and (2) (filing for purposes of section 37N of Ordinance)
5.	Section 31Y(1)(b) (correction of deficiencies in standard patent (O) application as regards formal requirements)
6.	Section 56C(1) and (2) (language requirements for sections 37N(5) and 114A(5) of Ordinance)
7.	Section 67B(1) and (2) (filing for purposes of section 114A of Ordinance)

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Column 1	Column 2
Item	Provision of these Rules to which the period relates
8.	Section 68(1)(b) (correction of deficiencies in short-term patent application as regards formal requirements)
9.	Section 82(2)(a) and (b) (Registrar's discretionary powers)

## Part 5

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

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



## Part 6

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

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

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

## Part 7

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

Column 1	Column 2
Item	Provision of these Rules to which the period relates
1.	Section 17 (correction of deficiencies in request to record)

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

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## Schedule 1

[s. 2]

### Minor Amendments to Patents (General) Rules Relating to Replacement of “standard patent” or “patent” by “standard patent (R)”

Column 1 Item	Column 2 Provision	Column 3 Words repealed	Column 4 Words substituted
1.	Section 3(2)(a)	“standard patent”	“standard patent (R)”
2.	Section 3(2)(c)	“standard patent”	“standard patent (R)”
3.	Section 3(3)(c)	“standard patent”	“standard patent (R)”
4.	Section 3(5)	“standard patent” (wherever appearing)	“standard patent (R)”
5.	Section 8(2)(e)	“standard patent”	“standard patent (R)”
6.	Section 9(a)	“standard patent” (wherever appearing)	“standard patent (R)”
7.	Section 9(b)	“standard patent”	“standard patent (R)”
8.	Section 9(c)	“standard patent”	“standard patent (R)”
9.	Section 25	“standard patent”	“standard patent (R)”
10.	Section 26	“standard patent”	“standard patent (R)”
11.	Section 27, heading	“ <b>standard patent</b> ”	“ <b>standard patent (R)</b> ”
12.	Section 27(1)	“standard patent”	“standard patent (R)”

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Column 1 Item	Column 2 Provision	Column 3 Words repealed	Column 4 Words substituted
13.	Section 28, heading	<b>“standard patent”</b>	<b>“standard patent (R)”</b>
14.	Section 28(1)	“standard patent”	“standard patent (R)”
15.	Section 28(2)	“patent” (wherever appearing)	“standard patent (R)”
16.	Section 30, heading	<b>“standard patent”</b>	<b>“standard patent (R)”</b>
17.	Section 30	“standard patent” (wherever appearing)	“standard patent (R)”
18.	Section 31, heading	<b>“standard patent”</b>	<b>“standard patent (R)”</b>
19.	Section 31(1)	“standard patent”	“standard patent (R)”
20.	Section 31(2)	“standard patent”	“standard patent (R)”
21.	Section 35, heading	<b>“standard patent”</b>	<b>“standard patent (R)”</b>
22.	Section 35(1)(b)	“standard patent”	“standard patent (R)”
23.	Section 37, heading	<b>“standard patent”</b>	<b>“standard patent (R)”</b>
24.	Section 37(2)	“patent”	“standard patent (R)”
25.	Section 37(4)	“of the patent”	“of the standard patent (R)”
26.	Schedule 2, item 11	“standard patent”	“standard patent (R)”
27.	Schedule 2, item 17	“standard patent application”	“standard patent (R) application”

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Column 1 Item	Column 2 Provision	Column 3 Words repealed	Column 4 Words substituted
28.	Schedule 2, item 20	“standard patent”	“standard patent (R)”

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## Schedule 2

[s. 2]

### Amendments Relating to Headings of Provisions

1. **Part 2 heading substituted**

Part 2, heading—

**Repeal the heading**

**Substitute**

**“Part 2**

**Standard Patents by Re-registration”.**

2. **Part 2, Division 1 heading substituted**

Part 2, Division 1, heading—

**Repeal the heading**

**Substitute**

**“Division 1—Who may Apply for Standard Patent  
(R)”.**

3. **Part 2, Division 2 heading substituted**

Part 2, Division 2, heading—

**Repeal the heading**

**Substitute**

**“Division 2—Request to Record Designated Patent Application”.**

4. **Part 3 heading repealed (provisions as to applications for standard patents before grant)**

Part 3, heading—

**Repeal the heading.**

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

Before section 27—

**Add**

**“Division 4—Provisions on Standard Patent (R) Applications before Grant”.**

6. **Part 4 heading substituted**

Part 4, English text, heading—

**Repeal the heading**

**Substitute**

**“Part 4**

**Provisions on Patents after Grant”.**

7. **Part 9 heading substituted**

Part 9, heading—

**Repeal the heading**

**Substitute**



## **“Part 9**

### **Short-term Patents”.**

**8. Part 9, Division 1 heading added**

Part 9, before section 58—

**Add**

**“Division 1—Applications for Short-term Patents”.**

**9. Part 9, Division 2 heading added**

Before section 68—

**Add**

**“Division 2—Examination on Formal Requirements  
of Short-term Patent Applications”.**

**10. Part 9, Division 3 heading added**

After section 68—

**Add**

**“Division 3—Procedure up to and including Grant of  
Short-term Patents”.**

**11. Part 10 heading repealed (procedure up to and including grant of  
short-term patents)**

Part 10, heading—

**Repeal the heading.**

**12. Part 9, Division 4 heading added**

Part 9, after section 78—

**Add**

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

**13. Part 11 heading repealed (provisions as to short-term patents after grant)**

Part 11, heading—

**Repeal the heading.**

**14. Part 13 heading substituted**

Part 13, heading—

**Repeal the heading**

**Substitute**

**“Part 13**

**Administrative and Miscellaneous Provisions”.**

**15. Part 13, Division 1 heading added**

Before section 88—

**Add**

**“Division 1—Information and Inspection”.**

**16. Part 13, Division 2 heading added**

Part 13, after section 92—

**Add**

**“Division 2—Filing and Service of Documents and Related Matters”.**

**17. Part 14 heading repealed (miscellaneous)**

Part 14, heading—

**Repeal the heading.**

**18. Part 13, Division 3 heading added**

After section 95—

**Add**

**“Division 3—Evidence”.**

**19. Part 13, Division 4 heading added**

After section 97—

**Add**

**“Division 4—Furnishing of Documents etc.”.**

**20. Part 13, Division 5 heading added**

Before section 99—

**Add**

**“Division 5—Advisers”.**

**21. Part 13, Division 6 heading added**

Before section 100—

**Add**

**“Division 6—Time Limits”.**

**22. Part 13, Division 7 heading added**

Before section 101—

**Add**

**“Division 7—Publication, Sale, Verification and  
Advertisement”.**

**23. Part 13, Division 8 heading added**

Before section 104—

**Add**

**“Division 8—Fees”.**

Ada K. L. LEUNG  
Registrar of Patents

12 March 2019

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## Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg. C) (*principal Rules*).

2. The main purpose of the Rules is to reflect the changes made to the Patents Ordinance (Cap. 514) (*Ordinance*) by the Patents (Amendment) Ordinance 2016 (17 of 2016) which, among other things, provides for standard patents by original grant (*standard patents (O)*) and substantive examination of short-term patents.
3. Section 3 of the Rules adds a new Part 1A to the principal Rules to provide for the procedural matters for a request to the Registrar of Patents (*Registrar*) to make a finding in relation to section 9F(1) of the Ordinance that the person who makes the request has a right to be mentioned as the inventor or a joint inventor of an invention, or a request to the Registrar to make a finding in relation to section 9F(2) of the Ordinance that a person ought not to have been mentioned as the sole inventor or a joint inventor of an invention. The new Part 1A replaces and expands the scope of the existing section 38 of the principal Rules to cover an invention in any published patent application for the invention. The existing section 38 of the principal Rules is repealed (see section 23 of the Rules).
4. Section 4 of the Rules adds a new Division 1A to Part 2 of the principal Rules to provide for the exhibition and meeting under section 11A of the Ordinance (which addresses non-prejudicial disclosure in relation to standard patent (R) applications). The new Division 1A replaces the existing section 55 of the principal Rules, which is repealed (see section 35 of the Rules).

5. Section 12 of the Rules replaces sections 15, 16 and 17 of the principal Rules with new sections 15, 16 and 17, in order to bring them in line with the latest drafting conventions. In addition, the new section 15 provides for the other date referred to in section 16(a)(ii) of the Ordinance as applicable to an international application designating the State Intellectual Property Office and provides that an application to which section 16(a)(ii) of the Ordinance applies must be accompanied by a copy of the official notification issued by the State Intellectual Property Office.
6. Section 18 of the Rules amends section 31 of the principal Rules mainly to provide for the filing of evidence by the applicant of a standard patent (R) application with the Registrar to satisfy, for the purposes of section 34(3)(a) of the Ordinance, the Registrar that the applicant has taken all reasonable care required by the circumstances of the case.
7. Section 19 of the Rules adds a new Part 3A to the principal Rules to provide for the procedural matters for standard patent (O) applications under Part 3 of the Ordinance. The new Part 3A is divided into 6 Divisions—
  - (a) Division 1 (new sections 31A to 31D) contains provisions on novelty and priority under Division 1 of Part 3 of the Ordinance. Some of the provisions are based on the corresponding provisions on short-term patents under Part 9 of the principal Rules. The new section 31A provides for the prescribed written evidence in relation to a non-prejudicial disclosure under section 37B(3)(b) of the Ordinance. The new sections 31B, 31C and 31D provide for related matters on restoring the priority right and claiming priority under sections 37D and 37E of the Ordinance respectively;

- (b) Division 2 (new sections 31E to 31L) contains provisions on who may apply for standard patents (O) under Division 2 of Part 3 of the Ordinance and is organized in 4 subdivisions. Subdivision 1 (new sections 31E to 31H) provides for the reference to the Registrar on the question as to who may apply and is based on section 3 of the principal Rules concerning reference to the Registrar on the question as to who may apply for standard patents (R). Subdivision 2 (new section 31I) provides for the application to the Registrar under section 37I(4) of the Ordinance in relation to the directions given under section 37I(1)(d)(ii) of the Ordinance. Subdivision 3 (new section 31J) provides for notification to the applicant and licensee of the applicant by the Registrar if an order in relation to a standard patent (O) application is made under section 37J(2) of the Ordinance or referred to in section 37K(2) of the Ordinance. Subdivision 4 (new sections 31K and 31L) provides for the reference to the Registrar in relation to a licence to continue working or to work an invention after the making of an order under section 37J(2) of the Ordinance or referred to in section 37K(2) of the Ordinance;
- (c) Division 3 (new sections 31M to 31X) provides for the procedural matters for filing standard patent (O) applications with the Registrar under Division 3 of Part 3 of the Ordinance. The new section 31M sets out the application requirements. The new sections 31N to 31S provide for the requirements in respect of description, drawings referred to in a description, abstract, size and presentation of documents, form of statements, counter-statements and evidence as well as claims. Some of the new provisions are based

on the corresponding provisions on applications for short-term patents under Part 9 of the principal Rules. The new sections 31T to 31X provide for statements by an applicant who is not an inventor, requirements for making a reference to an earlier specified application referred to in section 37M(3)(c)(ii) of the Ordinance, filing of missing description or missing drawing as well as other miscellaneous procedural matters;

- (d) Division 4 (new sections 31Y, 31Z and 31ZA) provides for the procedural matters for examination on the formal requirements and publication of standard patent (O) applications under Division 4 of Part 3 of the Ordinance. The new section 31Y provides for correction of deficiencies in a standard patent (O) application as regards the formal requirements under section 37P(1) of the Ordinance. The new sections 31Z and 31ZA respectively provide for the publication of the application under section 37Q of the Ordinance and the filing of a notice of observations on the patentability of an invention that is the subject of the application under section 37R of the Ordinance;
- (e) Division 5 (new sections 31ZB to 31ZP) provides for the procedural matters for substantive examination of standard patent (O) application under Division 5 of Part 3 of the Ordinance. The new sections 31ZB to 31ZH provide for the request for substantive examination, and the procedural matters for the substantive examination covering examination notice, further examination notice, the responses to those notices, and provisional refusal notice. The new sections 31ZI to 31ZN provide for the request to review under section 37V(3)(c) of the Ordinance, and



the procedural matters for the request to review covering review opinion, further review opinion, the responses to those opinions, and final refusal notice. The new section 31ZP provides for the procedural matters for the grant and publication of a standard patent (O) if the Registrar is of the opinion that the standard patent (O) application complies with all the examination requirements;

- (f) Division 6 (new sections 31ZQ to 31ZX) contains provisions on standard patent (O) applications before grant. Some of them are based on the corresponding provisions on short-term patents under Part 9 of the principal Rules. The provisions include those on a claim regarding a disclosure that was due to, or in consequence of, an evident abuse under section 37B(2)(b)(i) of the Ordinance, divisional standard patent (O) applications under section 37Z of the Ordinance, request to amend a standard patent (O) application before grant under section 37ZA(1) of the Ordinance, notice requesting reinstatement of a standard patent (O) application under section 28(1) and (2) of the Ordinance as applied by section 37ZD(1) of the Ordinance and application for restoration of rights lost in respect of standard patent (O) applications under section 29(1) and (2) of the Ordinance as applied by section 37ZD(1) of the Ordinance. The provisions also provide for the requirements concerning inventions requiring the use of micro-organisms under section 149(2A) of the Ordinance and requirements concerning the sequence listing for an invention involving nucleotide and amino acid sequences under section 37L(7)(b) of the Ordinance.

8. Section 20 of the Rules amends section 34 of the principal Rules to provide for the filing of evidence by an applicant with the Registrar to satisfy, for the purposes of section 40(4) of the Ordinance, the Registrar that the applicant has taken all reasonable care required by the circumstances of the case.
9. Section 21 of the Rules replaces section 36 of the principal Rules with a new section 36 to remove the reference to post-grant revocation proceedings in the Mainland for the purposes of sections 43 and 44 of the Ordinance.
10. Section 24 of the Rules adds new sections 38A to 38F to the principal Rules to provide for the application to the Registrar to amend the specification of patents after grant under section 46 of the Ordinance. The provisions include the related procedural matters covering opposition notice, counter-statement and the final decision by the Registrar.
11. Section 27 of the Rules adds a new section 41A to the principal Rules to provide that the Registrar must notify certain persons if an order under section 55(4) of the Ordinance or referred to in section 56(2) of the Ordinance is made.
12. Section 29 of the Rules amends section 43 of the principal Rules to include references to standard patent (R) application and standard patent (O) application.
13. Section 33 of the Rules adds a new Part 6A (new section 53A) to the principal Rules to provide for the circumstances under which inventions are to be regarded as being so linked as to form a single inventive concept.

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14. Section 34 of the Rules replaces section 54 of the principal Rules with a new section 54 to remove the reference to post-grant revocation proceedings in the Mainland for the purposes of section 91(1)(i) of the Ordinance.
  15. Section 36(4) of the Rules adds a new section 56(9A) to the principal Rules to limit the application of section 56(9) of the principal Rules by which the Registrar may specify or extend periods within which translation of a document is to be filed or information in English or Chinese is to be provided.
  16. Section 37 of the Rules adds new sections 56A to 56D to the principal Rules to provide for the language requirements for the following applications that are in neither English nor Chinese—
    - (a) an earlier specified application referred to in section 37M(3)(c)(ii) or 114(3)(c)(ii) of the Ordinance;
    - (b) a previous application referred to in section 37E(1) or 111(1) of the Ordinance.
  17. Section 38 of the Rules amends section 58 of the principal Rules to provide for the maximum of 2 independent claims that may be contained in a short-term patent application and the filing of the documents required under section 67A of the principal Rules for a reference to an earlier specified application under section 114(3)(c)(ii) of the Ordinance and the translation of documents and transliteration of names required by the Registrar under sections 56, 56A and 56B of the principal Rules for the application.
  18. Section 42(1) of the Rules replaces section 62(9) of the principal Rules with a new section 62(9) with the addition of the new section 62(9A) to (9D), in order to bring the provisions in line with the latest drafting conventions and to provide for requirements on size and presentation of documents for the

description, claims and abstract for a short-term patent application.

19. Section 45 of the Rules adds new sections 67A and 67B to the principal Rules to provide for the requirements for making a reference to an earlier specified application referred to in section 114(3)(c)(ii) of the Ordinance, as well as the filing of a missing description or missing drawing for the purposes of section 114A of the Ordinance.
20. Section 46 of the Rules replaces section 68 of the principal Rules with a new section 68 to provide for the time for the applicant to correct the deficiencies in a short-term patent application in relation to formal requirements.
21. Section 47 of the Rules adds new sections 68A and 68B to the principal Rules. The new section 68A replaces the existing section 68(4) and (6) of the principal Rules to be repealed by section 46 of the Rules to bring the provision dealing with the extension of time for filing search report and paying filing fee or advertisement fee for a short-term patent application in line with the latest drafting conventions. The new section 68B provides for the restoration application under section 110A of the Ordinance in relation to the priority right of a subsequent short-term patent application referred to in section 110A(1)(b) of the Ordinance.
22. Section 48 of the Rules replaces section 69 of the principal Rules with a new section 69 to provide for claiming priority under section 111 of the Ordinance. It also provides that a statement of priority must be filed together with a short-term patent application, or within 16 months after the earliest date of priority claimed.

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23. Section 49 of the Rules adds a new section 69A to the principal Rules to provide for claiming priority for a divisional short-term patent application referred to in section 116 of the Ordinance.
  24. Section 50 of the Rules amends section 70 of the principal Rules to provide for the claims regarding a non-prejudicial disclosure under section 109(b) of the Ordinance.
  25. Section 51 of the Rules replaces section 73 of the principal Rules with a new section 73 to provide for the requirements concerning a short-term patent application for an invention requiring the use of micro-organisms under section 149(2A) of the Ordinance.
  26. Section 52 of the Rules adds a new section 73A to the principal Rules to provide for the requirements concerning the sequence listing in a short-term patent application for an invention involving nucleotide and amino acid sequences under section 113(4)(b) of the Ordinance.
  27. Section 53 of the Rules amends section 74 of the principal Rules to provide that a new short-term patent application is to be regarded as duly filed on the date on which the minimum requirement under section 114(3) of the Ordinance is complied with.
  28. Section 54 of the Rules adds a new section 74A to the principal Rules to provide for the requirements for making a claim regarding a non-prejudicial disclosure under section 109(a) of the Ordinance.

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29. Section 55 of the Rules replaces section 75 of the principal Rules with a new section 75 to provide for the request to amend a short-term patent application before grant under section 120 of the Ordinance.
  30. Section 56 of the Rules replaces section 78 of the principal Rules with a new section 78 to provide for the other date referred to in section 125(2) of the Ordinance.
  31. Section 57 of the Rules adds a new section 79A to the principal Rules to provide for the filing of a notice of observations on the patentability of an invention that is the subject of a short-term patent.
  32. Section 58 of the Rules adds new Divisions 5 and 6 to Part 9 of the principal Rules—
    - (a) Division 5 (new sections 81A to 81O) provides for the procedural matters for substantive examination of short-term patents under Division 5 of Part 15 of the Ordinance. The new sections 81A to 81H provide for the request for substantive examination, and the procedural matters for substantive examination covering examination notice, further examination notice, the responses to those notices, and provisional revocation notice. The new sections 81I to 81N provide for the request to review under section 127D(3)(c) of the Ordinance, and the procedural matters for the request to review covering review opinion, further review opinion, the responses to those opinions, and final revocation notice. The new section 81O provides for continuing substantive examination by the Registrar upon compliance with the examination requirement concerned;

- (b) Division 6 (new sections 81P to 81V) contains provisions on a request for amendment of a short-term patent after grant. The provisions include the related procedural matters covering opposition notice, counter-statement, directions by the Registrar and the final decision by the Registrar.
33. Section 59 of the Rules amends section 82 of the principal Rules to provide for the filing of a request for hearing referred to in new sections 31ZK(2), 31ZM(2), 81K(2) and 81M(2) of the principal Rules.
34. Section 60 of the Rules adds a new section 82A to the principal Rules to provide for the request for a hearing referred to in new section 38C(6) or 81R(6) of the principal Rules.
35. Section 61 of the Rules amends section 83 of the principal Rules to expand the scope of hearings in public to a standard patent (O) application after publication of the application in accordance with section 37Q of the Ordinance and a short-term patent after publication of the patent under section 118(2)(a) of the Ordinance.
36. Section 62 of the Rules amends section 87 of the principal Rules to enable the Registrar to order for security for costs in proceedings under section 37H of the Ordinance and to include a reference to any person who files an opposition referred to in section 46(3)(c) or 127E(2)(b) of the Ordinance.

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37. Section 63 of the Rules amends section 88 of the principal Rules to include a reference to standard patent (O) application.
  38. Section 64 of the Rules amends section 89 of the principal Rules to provide that, in addition to the documents prepared in the Patents Registry solely for use in the Registry, documents prepared by an adviser appointed by the Registrar under section 99(1) of the principal Rules solely for the same use are also not open to inspection.
  39. Section 66 of the Rules amends section 91 of the principal Rules to expand the scope of that section 91 to cover a statement of priority for a standard patent (O) application referred to in section 37E(1) of the Ordinance and also to cover the name and address of any person which the Registrar is required to communicate to any other person under section 31F(4)(b) of the principal Rules.
  40. Section 68 of the Rules adds a new section 98A to the principal Rules to provide for the power of the Registrar to make and send a copy of any document containing reference to the state of the art.
  41. Section 74 of the Rules amends Schedule 1 to the principal Rules so that the provisions in that Schedule would be expanded to provide for the procedural matters for making samples of micro-organisms available to experts only, and that the provisions also apply to a standard patent (O) application and a standard patent (O).



## 42. The Rules also—

- (a) reorganize provisions in the principal Rules in respect of extension of time limits for doing any act or taking any proceedings under the principal Rules into an consolidated scheme for better clarity and accessibility, by substituting section 100 of the principal Rules and adding new sections 100AA to 100AAD and a new Schedule 4 to the principal Rules (see sections 69, 70 and 76 of the Rules);
- (b) make consequential amendments to repeal the redundant provisions in sections 17, 24 and 29 of the principal Rules, as a result of the reorganization mentioned in subparagraph (a) (see sections 12, 16 and 17 of the Rules);
- (c) amend Schedule 2 to the principal Rules to provide for the new fees for the purposes of section 149(2)(c) of the Ordinance for several existing and the new procedural matters under the principal Rules as amended by the Rules (see section 75 of the Rules);
- (d) add a new section 114 to the principal Rules to provide for the transitional arrangement as a result of the amendments made by the Rules (see section 73 of the Rules);
- (e) amend certain provisions in the principal Rules so that the time for some procedural steps would be reckoned by the time when the person concerned receives a document instead of the time when it is sent (see sections 5(3), (4), (5) and (8), 6, 8(2), 22(1), 25(1) and 31(1) of the Rules);
- (f) make amendments to the principal Rules to dispense with certain signing requirements (see sections 13 and 18(1) of the Rules);

- (g) make miscellaneous amendments to sections 11 and 21 of the principal Rules to replace the English references to “period of grace” with references to “grace period”, and to provide that the grace periods are to begin on the date of expiry of the original time limits, to ensure consistency throughout the principal Rules (see sections 11 and 14 of the Rules);
- (h) make miscellaneous amendments to the principal Rules to replace certain references to “standard patent” or “patent” with references to “standard patent (R)” (see section 2(2) of the Rules and Schedule 1 to the Rules);
- (i) make miscellaneous amendments to the principal Rules to update the references to provisions in the Ordinance and the principal Rules (see sections 10, 15(2), 26(1), 28, 29(4), 30, 36(1), (2) and (3), 62(1), 65, 66 and 67 of the Rules);
- (j) make miscellaneous amendments to the principal Rules relating to the headings of provisions in the principal Rules (see section 2(3) of the Rules and Schedule 2 to the Rules);
- (k) make textual amendments to certain provisions in the principal Rules to bring them in line with the latest drafting conventions or to make minor textual changes (see sections 5(2), 7, 8(4), 18(2), (4) and (5), 20(4), 22(2), 25(2), 26(2), 31(2), 39(3), 40(1) and (16), 42(5), 43(1) and 44 of the Rules); and
- (l) make Chinese textual amendments to certain provisions in the principal Rules to improve drafting and clarity (see sections 39(1) and (2), 40(2) to (15), 41, 42(2), (3) and (4), 43(2) and (3) and 50(4) of the Rules).

43. The Rules come into operation on a day to be appointed by the Registrar by notice published in the Gazette.