

## Patents Ordinance

### (Cap. 514)

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# Patents Ordinance

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An Ordinance to make provisions in respect of patents and related matters.

*(Amended 17 of 2016 s. 3)*

*(Format changes—E.R. 4 of 2020)*

[27 June 1997] *L.N. 367 of 1997*

*(Enacting provision omitted—E.R. 4 of 2020)*

## **Part 1**

### **Preliminary**

*(Replaced 17 of 2016 s. 4)*

*(Format changes—E.R. 4 of 2020)*

#### **1. Short title**

*(Amended E.R. 4 of 2020)*

(1) This Ordinance may be cited as the Patents Ordinance.

(2) *(Omitted as spent—E.R. 4 of 2020)*

#### **2. Interpretation**

(1) In this Ordinance, unless the context otherwise requires—

***application for a patent*** (專利的申請) and ***patent application*** (專利申請) mean—

(a) an application for a standard patent (R);

(b) an application for a standard patent (O); or

(c) an application for a short-term patent; *(Added 17 of 2016 s. 5)*

**application for a patent or other protection** (專利或其他保護的申請) means an application for any of the following—

- (a) a patent;
- (b) the registration of a utility model;
- (c) a utility certificate;
- (d) an inventor's certificate; (*Added 17 of 2016 s. 5*)

**application for a short-term patent** (短期專利的申請) and **short-term patent application** (短期專利申請) mean an application under Part 15 for a short-term patent; (*Added 17 of 2016 s. 5*)

**application for a standard patent** (標準專利的申請) and **standard patent application** (標準專利申請) mean—

- (a) an application for a standard patent (R); or
- (b) an application for a standard patent (O); (*Added 17 of 2016 s. 5*)

**application for a standard patent (O)** (原授標準專利的申請) and **standard patent (O) application** (原授標準專利申請) mean an application under Part 3 for a standard patent (O); (*Added 17 of 2016 s. 5*)

**certificate of substantive examination** (實質審查證明書) means a certificate issued by the Registrar under section 127F in respect of a short-term patent; (*Added 17 of 2016 s. 5*)

**court** (法院) means the Court of First Instance; (*Amended 25 of 1998 s. 2*)

**date of filing** (提交日期)—

- (a) in relation to a request to record or a request for registration and grant, means the date which is the date of filing that request by virtue of section 17 or 24 respectively;

- (b) in relation to an application for a standard patent (R), has the meaning specified in relation to that term in section 3(ii); (*Amended 17 of 2016 s. 5*)
- (c) in relation to a designated patent application, means the date specified as such in the designated patent application;
- (d) in relation to an application for a standard patent (O), means the date of filing accorded in accordance with section 37M; (*Added 17 of 2016 s. 5*)
- (e) in relation to an application for a short-term patent, means the date of filing accorded in accordance with section 114; (*Added 17 of 2016 s. 5*)

***Doha Declaration*** (《多哈宣言》) means the Declaration on the TRIPS Agreement and Public Health adopted on 14 November 2001 by the Fourth WTO Ministerial Conference at Doha, Qatar; (*Added 21 of 2007 s. 3*)

***eligible importing member*** (合資格進口成員地) means—

- (a) a WTO member country, territory or area recognized by the United Nations as being a least-developed country; or
- (b) any other WTO member country, territory or area that has given notice in writing to the TRIPS Council that it intends to import pharmaceutical products in accordance with the General Council Decision or the Protocol; (*Added 21 of 2007 s. 3*)

***employee*** (僱員) means a person who works or (where the employment has ceased) worked under a contract of employment (whether with the Government or with any other person);

***employer*** (僱主), in relation to an employee, means the person by whom the employee is or was employed;

***exclusive licence*** (專用特許) means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorized by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application for a patent relates, and ***exclusive licensee*** (專用特許持有人) and ***non-exclusive licence*** (非專用特許) shall be construed accordingly;

***exporting member*** (出口成員地) means a WTO member country, territory or area that makes a patented pharmaceutical product for export to an eligible importing member in accordance with the General Council Decision or the Protocol; (*Added 21 of 2007 s. 3*)

***General Council Decision*** (《總理事會決定》) means the Decision adopted by the General Council of the WTO on 30 August 2003 on the Implementation of Paragraph 6 of the Doha Declaration; (*Added 21 of 2007 s. 3*)

***international application*** (國際申請) means an international application for a patent made under the Patent Cooperation Treaty;

***International Bureau*** (國際局) means the International Bureau of Intellectual Property provided for under the Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967;

***law of the designated patent office*** (指定專利當局的法律) means—

- (a) in relation to a designated patent office established under the law of any country, territory or area other than Hong Kong, the law of that country, territory or area;



- (b) in relation to a designated patent office established under an international agreement, the provisions of the international agreement;

**material date** (關鍵日期) means—

- (a) for a standard patent (R) application, the date of filing of the corresponding designated patent application or, if priority is claimed, the date of priority;
- (b) for a standard patent (R), the deemed date of filing of the application for the patent or, if priority is claimed, the date of priority;
- (c) for a standard patent (O) application, the date of filing of the application or, if priority is claimed, the date of priority;
- (d) for a standard patent (O), the date of filing of the application for the patent or, if priority is claimed, the date of priority;
- (e) for a short-term patent application, the date of filing of the application or, if priority is claimed, the date of priority;
- (f) for a short-term patent, the date of filing of the application for the patent or, if priority is claimed, the date of priority; (*Added 17 of 2016 s. 5*)

**mortgage** (按揭) when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

**non-prejudicial disclosure** (不具損害性的披露) means, in relation to an invention, a disclosure of the invention which is not to be taken into consideration for the purposes of determining whether or not the invention forms part of the state of the art;

**official journal** (官方公報) means the publication for the time being specified under section 150A as the official journal of record; (*Added 2 of 2001 s. 2*)

**opposition or revocation proceedings** (反對或撤銷專利的法律程序) means, in relation to a designated patent, proceedings under the law of the designated patent office providing for the revocation or amendment of the designated patent within a specified period after the grant;

**Paris Convention** (《巴黎公約》) means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883, as revised or amended from time to time; (*Amended 2 of 2001 s. 2*)

**Paris Convention country** (巴黎公約國) means—

- (a) any country for the time being specified in Schedule 1 as being a country which has acceded to the Paris Convention;
- (b) any territory or area subject to the authority or under the suzerainty of any country specified in Schedule 1 pursuant to paragraph (a), or any territory or area administered by any such country, on behalf of which such country has acceded to the Paris Convention;

**Patent Cooperation Treaty** (《專利合作條約》) means the treaty of that name done at Washington on 19 June 1970, as revised or amended from time to time; (*Amended 2 of 2001 s. 2*)

**patented invention** (專利發明) means an invention for which a standard patent or, as the case may be, a short-term patent is granted and **patented process** (專利方法) shall be construed accordingly;

**patented pharmaceutical product** (專利藥劑製品) means—

- (a) a pharmaceutical product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;
- (b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a pharmaceutical product obtained directly by means of the process or to which the process has been applied;  
*(Added 21 of 2007 s. 3)*

***patented product*** (專利產品) means—

- (a) a product which is an invention for which a standard patent or a short-term patent (as the case may be) has been granted;
- (b) in relation to a process for which a standard patent or a short-term patent (as the case may be) has been granted, a product obtained directly by means of the process or to which the process has been applied;

***pharmaceutical product*** (藥劑製品) means—

- (a) a pharmaceutical product within the meaning of section 2(1) of the Pharmacy and Poisons Ordinance (Cap. 138);
- (b) an active ingredient that is needed for making of a pharmaceutical product mentioned in paragraph (a); or
- (c) a diagnostic kit that is needed for the use of a pharmaceutical product mentioned in paragraph (a);  
*(Added 21 of 2007 s. 3)*

***prescribed*** (訂明) means prescribed or provided for by rules made under section 149;

**protected layout-design (topography)** (受保護的布圖設計(拓撲圖)) has the meaning assigned to that term by section 2(1) of the Layout-design (Topography) of Integrated Circuits Ordinance (Cap. 445);

**Protocol** (《日內瓦議定書》) means the Protocol Amending the TRIPS Agreement adopted by the General Council of the WTO at Geneva on 6 December 2005, the Annex to the Protocol Amending the TRIPS Agreement, the Annex to the TRIPS Agreement and the Appendix to the Annex to the TRIPS Agreement; (*Added 21 of 2007 s. 3*)

**register** (註冊紀錄冊、註冊)—

- (a) as a noun, means the register of patents kept under section 51; and
- (b) as a verb, means, in relation to any thing, to register or register particulars, or enter notice of that thing in the register and, in relation to a person, means to enter his name in the register,

and cognate expressions shall be construed accordingly;

**Registrar** (處長) means the Registrar of Patents;

**Registrar of Patents** (專利註冊處處長) means the person holding that office by virtue of the Director of Intellectual Property (Establishment) Ordinance (Cap. 412);

**registry** (註冊處) means the Patents Registry administered by the Registrar;

**relevant instrument or legislation** (有關文書或法例) means—

- (a) the General Council Decision;
- (b) the Protocol; or
- (c) legislation made by the exporting member or the eligible importing member, as the case may be, pursuant to or for the purpose of implementing—

- (i) the General Council Decision; or
- (ii) the Protocol; (*Added 21 of 2007 s. 3*)

***request for registration and grant*** (註冊與批予請求) means a request under section 23 for the registration of a designated patent and the grant of a standard patent (R) for the invention shown in the published specification of the designated patent; (*Amended 17 of 2016 s. 5*)

***request to record*** (記錄請求) means a request under section 15 to record a designated patent application;

***right*** (權利), in relation to any patent or patent application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

***rules*** (規則) means rules made by the Registrar under section 149;

***short-term patent*** (短期專利) means a patent for an invention granted under Part 15; (*Amended 17 of 2016 s. 5*)

***specification*** (說明書), in relation to an application for a patent under this Ordinance, a designated patent application or an international application, means the description, claims and drawings contained in the application;

***standard patent*** (標準專利) means— (*Amended 17 of 2016 s. 5*)

- (a) a standard patent (R); or
- (b) a standard patent (O); (*Amended 17 of 2016 s. 5*)

***standard patent (O)*** (原授標準專利) means a patent for an invention granted under Part 3; (*Added 17 of 2016 s. 5*)

***standard patent (R)*** (轉錄標準專利) means a patent for an invention granted under Part 2; (*Added 17 of 2016 s. 5*)

***substantive examination*** (實質審查) means—

- (a) for a standard patent (O) application, an examination of the application under Division 5 of Part 3;

(b) for a short-term patent, an examination of the patent under Division 5 of Part 15; (*Added 17 of 2016 s. 5*)

**TRIPS Agreement** (《知識產權協議》) means the Agreement on Trade-Related Aspects of Intellectual Property Rights, being Annex 1C of the World Trade Organisation Agreement; (*Added 21 of 2007 s. 3*)

**TRIPS Council** (知識產權理事會) means the Council for Trade-Related Aspects of Intellectual Property Rights referred to in Article 68 of the TRIPS Agreement; (*Added 21 of 2007 s. 3*)

**verified copy** (核實副本) means, in relation to a document, a copy verified in the prescribed manner;

**World Trade Organisation Agreement** (《世界貿易組織協議》) means the agreement of that name done at Marrakesh in 1994, as revised or amended from time to time; (*Amended 2 of 2001 s. 2*)

**WTO** (世界貿易組織) means the World Trade Organisation established in Geneva on 1 January 1995 under the World Trade Organisation Agreement; (*Added 21 of 2007 s. 3*)

**WTO member country, territory or area** (世界貿易組織成員國、地區或地方) means any country, territory or area for the time being specified in Schedule 1 as being a country, territory or area which has acceded to the World Trade Organisation Agreement.

(*Amended 17 of 2016 s. 5*)

(2) The expressions listed in the left-hand column below are defined in, or fall to be construed in accordance with, the provisions of this Ordinance listed in the right-hand column in relation to those expressions.

Expression	Relevant Provision
Application for a standard patent (R) (轉錄標準專利的申請) and standard patent (R) application (轉錄標準專利申請) ( <i>Amended 17 of 2016 s. 5</i> )	section 3
Corresponding designated patent (相應指定專利)	section 4
Corresponding designated patent application (相應指定專利申請)	section 4
Deemed date of filing (當作提交日期)	section 38
Designated patent (指定專利)	section 4
Designated patent application (指定專利申請)	section 4
Divisional designated patent application (指定專利的分開申請)	section 22(1)
Government use (政府徵用)	section 69(2)
Patent (專利)	section 6(1)
Published (發表)	section 5
Work (實施)	section 6(4)

*(Amended 17 of 2016 s. 5)*

**3. Meaning of *application for a standard patent (R)* and *standard patent (R) application***

*(Amended 17 of 2016 s. 6)*



In this Ordinance, unless the context otherwise requires, reference to an application for a standard patent (R) or a standard patent (R) application is a reference to proceedings under Part 2— (*Amended 17 of 2016 s. 6*)

- (a) under sections 15 to 22 to record a designated patent application; and
- (b) under sections 23 to 27 for the registration of a designated patent and the grant of a standard patent (R) for the invention shown in the published specification of the designated patent,

up to but not including the grant of the standard patent (R), and cognate expressions shall be construed accordingly; and reference to— (*Amended 17 of 2016 s. 6*)

- (i) the filing of an application for a standard patent (R) or a standard patent (R) application is a reference to the filing of a request to record;
- (ii) the date of filing an application for a standard patent (R) or a standard patent (R) application is a reference to the date of filing a request to record;
- (iii) an application for a standard patent (R) or a standard patent (R) application as filed is a reference to a request to record as filed;
- (iv) the publication of an application for a standard patent (R) or a standard patent (R) application is a reference to the publication of a request to record;
- (v) an invention which is the subject of an application for a standard patent (R) or a standard patent (R) application, or an invention in respect of which an application for a standard patent (R) or a standard patent (R) application has been made, is a reference to the invention disclosed in the specification of the corresponding designated patent or, if no request for registration and grant has



been filed in the application, of the designated patent application;

- (vi) the specification of an application for a standard patent (R) or a standard patent (R) application is a reference to the specification of the corresponding designated patent application.

*(Amended 17 of 2016 s. 6)*

#### 4. **Meaning of *designated patent*, etc.**

(1) In this Ordinance, unless the context otherwise requires—

***designated patent*** (指定專利) means a patent granted by a designated patent office;

***designated patent application*** (指定專利申請) means—

- (a) an application in a designated patent office for a patent, which application has been published under the law of the designated patent office;
- (b) an international application which has been published and which has validly entered its national phase in a designated patent office;

***designated patent office*** (指定專利當局) means a patent office designated for the purpose of this Ordinance under section 8.

(2) In this Ordinance, unless the context otherwise requires, a reference—

- (a) to a “corresponding designated patent” in relation to a standard patent (R), is a reference to the designated patent which was registered under section 27 in an application for the grant of the standard patent (R);
- (b) to a “corresponding designated patent application”—
  - (i) in relation to an application for a standard patent (R) for an invention, is a reference to the

designated patent application in respect of that invention;

- (ii) in relation to a standard patent (R), is a reference to the designated patent application in pursuance of which the corresponding designated patent was granted. (*Amended 17 of 2016 s. 7*)

## 5. Meaning of *published*

- (1) In this Ordinance, unless the context otherwise requires—
- (a) ***published*** (發表) means made available to the public (whether in Hong Kong or elsewhere); and
  - (b) a document shall be taken to be published under any provision of this Ordinance if it can be inspected as of right at any place in Hong Kong by members of the public, whether on payment of a fee or not.
- (2) Without prejudice to subsection (1), and unless the context otherwise requires, a reference in this Ordinance—
- (a) to the grant of a standard patent (R) being published is a reference to its being published under section 27; (*Amended 17 of 2016 s. 8*)
  - (b) to a request to record being published is a reference to its being published under section 20;
  - (c) to a designated patent being published is a reference to its being published by the designated patent office by which the patent was granted for the purposes of the law of that office relating to applications for and the granting of patents;
  - (d) to a designated patent application being published is a reference—

- (i) except as provided in subparagraph (ii), to its being published by the designated patent office in which the application was made;
- (ii) in the case of a designated patent application based on an international application, to the international application being published by the International Bureau under the Patent Cooperation Treaty, or by the designated patent office in which the application was made, whichever is the earlier;
- (da) to a standard patent (O) application being published is a reference to its being published under section 37Q;  
*(Added 17 of 2016 s. 8)*
- (db) to the grant of a standard patent (O) being published is a reference to its being published under section 37X;  
*(Added 17 of 2016 s. 8)*
- (e) to a short-term patent being published is a reference to its being published under section 118.

## 6. Other references

- (1) Unless the context otherwise requires, a reference in this Ordinance to a patent is a reference to a standard patent or a short-term patent granted under this Ordinance.
- (2) Unless the context otherwise requires, a reference in this Ordinance to an international agreement is a reference to—
  - (a) the agreement, or any other international agreement replacing it, as may from time to time be amended or supplemented by or in accordance with any international agreement (including any protocol or annex);
  - (b) any instrument made under any such agreement to provide for amendment to or supplementation of the agreement.

- (3) Unless the context otherwise requires, a reference in this Ordinance to an enactment or law of a country, territory or area other than Hong Kong shall be construed as a reference to that enactment or law as it may from time to time be amended or extended by or under any other enactment or law of the country, territory or area.
- (4) Unless the context otherwise requires, a reference in this Ordinance to an invention being worked in Hong Kong includes a reference to the invention being worked by importation into Hong Kong for the purpose of putting the patented product on the market or stocking it for that purpose.
- (5) For the purposes of this Ordinance, a matter shall be taken to have been disclosed in any designated patent application or standard patent (O) application, or in the specification of a patent or a designated patent, if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in any such application or specification. (*Amended 17 of 2016 s. 9*)

*[cf. 1977 c. 37 s. 130(3) U.K.]*

## **7. Provisions regarding filing of documents, etc.**

In this Ordinance, unless the context otherwise requires, a reference providing for the filing of any document with the Registrar shall be deemed to include a reference requiring the payment of any fee that may be prescribed for the filing of that document, and a document shall be deemed not to be duly filed for the purposes of this Ordinance unless any such fee as may be prescribed for the filing of the document is paid as so prescribed.

## **8. Designation of patent offices**

The Chief Executive in Council may for the purposes of this Ordinance by notice published in the Gazette designate a patent office established under the law of any country, territory or area

other than Hong Kong or established under any international agreement.

*(Amended 22 of 1999 s. 3)*

**9. Special provision regarding invention covered by 2 or more patents**

Where there are in effect 2 or more patents for the same invention, any use of the invention which does not constitute an infringement of any one such patent (whether by virtue of consent given by the proprietor, a compulsory licence having effect under Part 8, the provisions of Part 9 relating to Government use, an import compulsory licence having effect under Part 9A or an export compulsory licence having effect under Part 9B) shall not constitute an infringement of the other such patent.

*(Amended 21 of 2007 s. 4; 17 of 2016 s. 10)*

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## Part 1A

### Patentability, Right to Patent and Mention of Inventor

*(Part 1A added 17 of 2016 s. 11)*

#### Division 1—Patentability

##### 9A. Patentable inventions

- (1) An invention is patentable if it—
  - (a) is new;
  - (b) involves an inventive step; and
  - (c) is susceptible of industrial application.
- (2) The following are not to be regarded as an invention for the purposes of subsection (1)—
  - (a) a discovery, scientific theory or mathematical method;
  - (b) an aesthetic creation;
  - (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; and
  - (d) a presentation of information.
- (3) Subsection (2) excludes the patentability of the subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to the subject-matter or activities as such.
- (4) A method for the treatment of the human or animal body by surgery or therapy, or a diagnostic method practised on the human or animal body, is not to be regarded as an invention that is susceptible of industrial application for the purposes of subsection (1). However, this subsection does not apply to a

product, and in particular a substance or composition, for use in any such method.

- (5) An invention the publication or working of which would be contrary to public order (“ordre public”) or morality is not a patentable invention. However, the working of an invention is not to be regarded as so contrary only because it is prohibited by any law in force in Hong Kong.
- (6) The following are not patentable—
  - (a) a plant or animal variety; and
  - (b) an essentially biological process for the production of plants or animals (other than a microbiological process or its products).

## **9B. Novelty**

- (1) An invention is to be regarded as new if it does not form part of the state of the art.
- (2) For a patent application for an invention (*subject application*), the state of the art comprises everything made available to the public (in Hong Kong or elsewhere), whether by means of a written or oral description, by use or in any other way before the material date of the subject application.
- (3) For the subject application, the state of the art also comprises the contents of the following applications for an invention—
  - (a) a standard patent (R) application as filed—
    - (i) the material date of which is before the material date of the subject application; and
    - (ii) the corresponding designated patent application of which was published by the designated patent office on or after the material date of the subject application;

- 
- (b) a designated patent application as filed in a designated patent office—
    - (i) the date of filing of which or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office, is before the material date of the subject application; and
    - (ii) which was published by the designated patent office on or after the material date of the subject application;
  - (c) a standard patent (O) application, as filed and as published—
    - (i) the material date of which is before the material date of the subject application; and
    - (ii) which was published under section 37Q on or after the material date of the subject application; and
  - (d) a short-term patent application—
    - (i) the material date of which is before the material date of the subject application; and
    - (ii) because of which a short-term patent was published under section 118 on or after the material date of the subject application.
- (4) For an invention consisting of a substance or composition for use in a method referred to in section 9A(4), if the use of the substance or composition in any such method does not form part of the state of the art, then the fact that the substance or composition forms part of the state of the art does not prevent the invention from being regarded as new.
- (5) For an invention consisting of a substance or composition for a specific use in a method referred to in section 9A(4), if the specific use of the substance or composition in any such



method does not form part of the state of the art, then the fact that the substance or composition, and any other use of the substance or composition in any such method, form part of the state of the art does not prevent the invention from being regarded as new.

- (6) For the purpose of any validity proceedings commenced before the commencement date in relation to a pre-existing patent, section 94 as in force immediately before that date continues to apply to the invention, which is the subject of the patent, as if that section had not been repealed.
- (7) For the purpose of any validity proceedings commenced on or after the commencement date in relation to a pre-existing patent, this section applies to the invention, which is the subject of the patent, as if the patent was granted on or after the commencement date.
- (8) In this section—

*\*commencement date* (生效日期) means the date on which the Patents (Amendment) Ordinance 2016 (17 of 2016) comes into operation;

*pre-existing patent* (既有專利) means a standard patent or short-term patent granted before the commencement date;

*validity proceedings* (有效性法律程序) means any proceedings in which the validity of a patent is put in issue under section 101(1).

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Editorial Note:

\* Commencement date: 19 December 2019.

## 9C. Inventive step

- (1) An invention is to be regarded as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

- (2) For the purposes of subsection (1), if the state of the art also comprises the contents of the applications falling within section 9B(3), those applications are not to be considered in deciding whether there has been an inventive step.

**9D. Industrial application**

An invention is to be regarded as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

**Division 2—Right to Patent and Mention of Inventor**

**9E. Right to patent belongs to inventor**

- (1) Subject to subsections (2) and (3), the right to a patent belongs to the inventor or the inventor's successor in title.
- (2) If the inventor is an employee, the right to the patent is to be determined—
- (a) in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed; or
  - (b) if the identity of the country, territory or area cannot be determined, in accordance with the law of the country, territory or area where the employer's place of business to which the employee is attached is located.
- (3) If 2 or more persons have made an invention independently of each other, the right to a patent for the invention belongs to the person whose patent application has the earlier or earliest material date (as the case requires).
- (4) Subsection (3) does not apply to a standard patent application that has not been published under section 20 or 37Q.

**9F. Mention of inventor**

- (1) The inventor or joint inventors of an invention have a right to be mentioned as such in—
  - (a) any published patent application for the invention; and
  - (b) any patent granted for the invention.
- (2) If a person has been mentioned as the sole inventor or a joint inventor of an invention because of this section, any other person who alleges that the person ought not to have been so mentioned may request the Registrar to make a finding to that effect.
- (3) If the Registrar makes such a finding, the Registrar—
  - (a) must accordingly amend the register;
  - (b) must advertise the fact of the amendment by notice in the official journal; and
  - (c) may issue a certificate of the finding to the person who made the request.

## Part 2

### Standard Patents by Re-registration

*(Replaced 17 of 2016 s. 12)*

*(Format changes—E.R. 4 of 2020)*

#### Division 1—General

*(Replaced 17 of 2016 s. 12)*

#### 10. General provision regarding applications for standard patents (R)

*(Amended 17 of 2016 s. 13)*

This Part shall be construed as providing for the grant of a standard patent (R) for an invention in the following circumstances, and only in those circumstances, namely where— *(Amended 17 of 2016 s. 13)*

- (a) an application for a patent for that invention has been filed in and published by a designated patent office;
- (b) as the first stage of an application for a standard patent (R), the designated patent application has been recorded in the register and published in Hong Kong in accordance with sections 15 to 22;
- (c) a patent has been granted in the designated patent office in pursuance of the designated patent application; and
- (d) as the second stage of the application for a standard patent (R), the designated patent has been registered in accordance with sections 23 to 27.

*(Amended 17 of 2016 s. 13)*

#### 11. Formality examination of applications for standard patent (R)

*(Amended 17 of 2016 s. 14)*

Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a standard patent (R) for an invention shall be construed as imposing upon the Registrar any obligation to consider or to have regard to, for the purpose of such examination, any question as to— *(Amended 17 of 2016 s. 14)*

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) whether any requirement under sections 9A, 9B, 9C, 9D, 9E, 9F, 11A, 11B, 11C, 77, 78 or 79 has been complied with. *(Amended 17 of 2016 s. 14)*

## **Division 2—Novelty and Priority**

*(Division 2 added 17 of 2016 s. 15)*

### **11A. Non-prejudicial disclosure**

- (1) For the purposes of section 9B, if the conditions specified in subsection (2) are satisfied, a disclosure of an invention that is the subject of a standard patent (R) application is not to be taken into consideration in determining whether the invention forms part of the state of the art.
- (2) The conditions are—
  - (a) the disclosure occurred no earlier than 6 months before the deemed date of filing of the standard patent (R) application; and
  - (b) the disclosure was due to, or in consequence of—

- (i) an evident abuse in relation to the applicant or a proprietor of the invention for the time being; or
  - (ii) the fact that the applicant or a proprietor of the invention for the time being had displayed the invention at a prescribed exhibition or meeting.
- (3) Subsection (2)(b)(ii) applies only if—
  - (a) at the time of filing the corresponding designated patent application, the applicant stated, in accordance with the law of the designated patent office relating to non-prejudicial disclosure, that the invention had been so displayed; and
  - (b) the request to record the designated patent application contains a statement that indicates the prescribed details relating to the disclosure, as required under section 15(2)(f).

### **11B. Priority right**

- (1) Subsection (3) applies if the proprietor of a designated patent application for an invention, on the basis of an earlier application for a patent or other protection for the same invention filed in or for a Paris Convention country, enjoys in the designated patent office a right of priority for the period of 12 months after the date of filing of the earlier application (*priority period*) under the law of the office.
- (2) Subsection (3) also applies if the proprietor, on the basis of an earlier application for a patent or other protection for the same invention filed in or for a country, territory or area that is not a Paris Convention country, enjoys in the designated patent office a right of priority for the priority period consequent on an international agreement—
  - (a) that applies to Hong Kong because either Hong Kong is a party to it or it is applied to Hong Kong by the Central

People's Government of the People's Republic of China;  
and

- (b) that provides for the grant of such priority on the basis of a first filing made in or for that country, territory or area and subject to conditions equivalent to those laid down in the Paris Convention.
- (3) The proprietor or the proprietor's successor in title enjoys, for the purpose of filing a standard patent (R) application for the invention, which is the subject of the designated patent application, the same right of priority as the person enjoys in respect of the designated patent application in the designated patent office.
- (4) The right conferred by subsection (3) is subject to sections 15(2)(e) and 23(3)(c).
- (5) In this section, a reference to the law of a designated patent office includes the law of the office dealing with the circumstances under which—
- (a) a filing made in or for a Paris Convention country that is equivalent to a regular national filing under the domestic legislation of that country, or under bilateral or multilateral agreements, gives rise to a right of priority;
  - (b) a subsequent application for a patent for the same subject-matter as in a previous first application and filed in or for the same Paris Convention country is to be considered as the first application for the purpose of determining priority; and
  - (c) multiple priorities may be claimed in respect of a designated patent application.
- (6) In this section—

***Paris Convention country*** (巴黎公約國) means a country or territory other than Hong Kong which is a party to the Paris

Convention or a dependent territory of any such country to which that Convention has been extended;

***regular national filing*** (正規國家提交) means a filing that establishes the date on which an application was filed, whatever the outcome of the application may be.

### **11C. Effect of priority right**

- (1) The right of priority conferred by section 11B has the effect that the date of priority enjoyed in the designated patent office is to be regarded as the date of priority of the standard patent (R) application for the purposes of this Ordinance.
- (2) A standard patent (R) granted because of a standard patent (R) application in respect of which the proprietor enjoys a right of priority as provided in section 11B is not to be invalidated only because any subject-matter disclosed in the earlier application (that is to say, the application on the basis of which the right of priority is enjoyed in the designated patent office) was made available to the public at any time after the date of filing of the earlier application.

## **Division 3—Who may Apply for Standard Patent (R)**

*(Replaced 17 of 2016 s. 16)*

### **12. Who may apply**

- (1) The person who may apply for the grant of a standard patent (R) for an invention is— *(Amended 17 of 2016 s. 17)*
  - (a) the person named as applicant in a designated patent application for a patent for the invention, or his successor in title to the rights under the designated patent application in Hong Kong; or



- (b) in preference to the person mentioned in paragraph (a), the person who is entitled to the property in the invention in Hong Kong.
- (2) Subject to any determination under section 13, the applicant for a standard patent (R) for an invention in proceedings before the Registrar shall for the purpose of those proceedings be deemed to be the person entitled to apply for the grant of a patent for that invention under subsection (1). (*Amended 17 of 2016 s. 17*)

[*cf. 1977 c. 37 s. 7 U.K.*]

### **13. Determination before grant of questions as to who may apply**

- (1) At any time before a standard patent (R) has been granted for an invention (whether or not an application has been made for a standard patent (R) for the invention)— (*Amended 17 of 2016 s. 18*)
- (a) any person may refer to the Registrar or the court the question of whether he is entitled under section 12 (alone or with other persons) to apply for the grant of a standard patent (R) for the invention; or
- (b) any of 2 or more joint proprietors of an application for a standard patent (R) for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person. (*Amended 17 of 2016 s. 18*)
- (2) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under this section.
- (3) Where a question is referred to the Registrar or the court under this section after an application for a standard patent (R) has been filed but before a standard patent (R) is granted in pursuance of the application then the Registrar or the court may, unless the application is withdrawn before

the reference is disposed of by the Registrar or the court—  
(Amended 17 of 2016 s. 18)

- (a) order that the application for a standard patent (R) shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;  
(Amended 17 of 2016 s. 18)
  - (b) where the reference was made by 2 or more persons, order that the application shall proceed in all their names jointly; or
  - (c) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.
- (4) Where a person refers a question under subsection (1)(b) relating to an application, any order under subsection (2) may contain directions to any person for transferring or granting any right in or under the application.
- (5) If any person to whom directions have been given under subsection (3)(c) or (4) fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the Registrar or the court may on application made to him or it by any person in whose favour or on whose reference the directions were given authorize him to do that thing on behalf of the person to whom the directions were given.
- (6) No order may be made under subsection (3) unless notice of the reference is given in the prescribed manner to each person who, not being a party to the reference, is—
- (a) an applicant named in the standard patent (R) application; or

- (b) a person alleged in the reference to have the right to apply for the grant of a standard patent (R) for the invention, whether alone or jointly with any other person, because of any transaction, instrument or event relating to—
- (i) the invention; or
  - (ii) the standard patent (R) application. (*Replaced 17 of 2016 s. 18*)
- (6A) A person who receives a notice under subsection (6) may oppose the making of the order, which is sought in the reference. (*Added 17 of 2016 s. 18*)
- (7) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

[*cf. 1977 c. 37 s. 8 U.K.*]

#### **14. Effect of transfer of application under section 13**

- (1) Where an order is made or directions are given under section 13 that an application for a standard patent (R) shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the order and any directions under that section, continue in force and be treated as granted by the persons in whose name the application is to proceed. (*Amended 17 of 2016 s. 19*)
- (2) Where an order is made or directions are given under section 13 that an application for a standard patent (R) shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to apply

under section 12 for the grant of the patent), any licences or other rights in or under the application for a standard patent (R) shall, subject to the order and any directions under that section and subject to subsection (3), lapse on the registration of that person or those persons as the applicant or applicants or, where the application for a standard patent (R) has not been published, on the making of the order. (*Amended 17 of 2016 s. 19*)

(3) If before a reference to the Registrar or the court under section 13 resulting in the making of any order mentioned in subsection (2)—

- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in Hong Kong or made effective and serious preparations to do so; or
- (b) a licensee of the applicant, acting in good faith, worked the invention in Hong Kong or made effective and serious preparations to do so,

that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2), the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the Registrar or the court the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the Registrar or the court, as

appropriate, shall determine the question and may, if he or it considers it appropriate, order the grant of such a licence.

- (6) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under subsection (5).

*[cf. 1977 c. 37 s. 11 U.K.]*

### **Division 4—Request to Record Designated Patent Application**

*(Replaced 17 of 2016 s. 20)*

#### **15. Filing of request to record**

- (1) A person entitled under section 12(1) to apply for the grant of a standard patent (R) for an invention may, at any time within 6 months after the date of publication of an application in a designated patent office for a patent for the invention, request the Registrar to enter a record of that designated patent application in the register (in this Ordinance referred to as a *request to record*). *(Amended 17 of 2016 s. 21)*
- (2) Every such request shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain—
- (a) a photocopy of the designated patent application as published, that is to say, including any description, claims, drawings, search report or abstract published together with the designated patent application;
  - (b) where the designated patent application does not contain the name of any person as being the inventor, a statement identifying the person or persons whom the applicant believes to be the inventor or inventors;
  - (c) the name and address of the person making the request;

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- (d) where the person filing the request is a person other than the person named as applicant in the designated patent application, a statement explaining his entitlement to apply for the grant of a standard patent (R) for the invention and prescribed documents supporting that statement; (*Amended 17 of 2016 s. 21*)
- (e) where priority is claimed under section 11B in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application as mentioned in that section, a statement that indicates the details of— (*Amended 2 of 2001 s. 3; 17 of 2016 s. 21*)
- (i) the date of priority claimed;
  - (ii) the country in which the earlier application was filed;
- (f) where at the time of filing the designated patent application a claim was made in accordance with the law of the designated patent office in respect of any previous disclosure of the invention that was, for the purposes of the law of the designated patent office, a non-prejudicial disclosure, a statement that indicates the prescribed details relating to the previous disclosure; and (*Amended 2 of 2001 s. 3*)
- (g) an address in Hong Kong for service of documents.
- (3) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.
- (4) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the request to record, and if either fee is not paid within that period or within such further period as may be allowed under subsection (5) the application for a standard patent (R) shall be deemed to be withdrawn. (*Amended 17 of 2016 s. 21*)

- (5) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (4) may still be validly paid.
- (6) Subsection (1) shall not apply in respect of a designated patent application published before the date on which the designated patent office was designated under section 8.
- (7) Nothing in this section shall preclude a request to record being initiated by documents complying with section 17.

*[cf. EPC Art. 78; 1977 c. 37 s. 14 U.K.]*

## **16. Designated patent application based on international application**

Where a designated patent application is the national phase of an international application under the Patent Cooperation Treaty, then—

- (a) for the purposes of section 15(1), and notwithstanding section 5(2)(d)(ii), the date of publication of the designated patent application shall be—
  - (i) the date of such publication in the designated patent office as serves to indicate that the international application has validly entered its national phase in the designated patent office; or
  - (ii) such other date as may be prescribed in rules, being a date not earlier than the date on which the international application has validly entered its national phase in the designated patent office;
- (b) reference in section 15(2)(a) to a photocopy of the designated patent application shall be read as reference to—
  - (i) a photocopy of the international application as published by the International Bureau;



- (ii) a photocopy of any translation of the international application published by the designated patent office; and
  - (iii) a photocopy of any publication of information in the designated patent office concerning the international application;
- (c) *(Repealed 2 of 2001 s. 4)*
- (d) section 17(1)(c) shall have effect in such manner as may be specified in rules made for the purposes of this section.

#### **17. Date of filing of request to record**

- (1) Subject to subsection (2) and section 18(3), the date of filing a request to record shall be the earliest date on which documents filed by the applicant contain—
- (a) an indication that a request is made to record a designated patent application;
  - (b) information identifying the applicant; and
  - (c) a reference to the designated patent application, including—
    - (i) the application number assigned to it by the designated patent office; and
    - (ii) the publication number (if any) assigned to it by the designated patent office, and the date (if any) of its publication by the designated patent office.  
*(Amended 2 of 2001 s. 5)*
- (2) If the earliest filing with the Registrar of any part of a request to record occurs more than 6 months after the publication of the corresponding designated patent application the request shall not be dealt with as an application for a standard patent (R). *(Amended 17 of 2016 s. 22)*



[*cf. EPC Art. 80*]

## 18. Examination on filing of request to record

- (1) The Registrar shall examine whether—
  - (a) the request to record satisfies the requirements of section 17(1) for the accordance of a date of filing (*minimum requirements*);
  - (b) the filing fee and advertisement fee have been paid in due time.
- (2) Subject to section 17(2), if a date of filing cannot be accorded because of deficiencies in the request as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.
- (3) If such deficiencies are not corrected within the prescribed time, the request shall not be dealt with as an application for a standard patent (R).

(*Amended 17 of 2016 s. 23*)

[*cf. EPC Art. 90*]

## 19. Examination as to formal requirements of request to record

- (1) If a request to record has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 15(4), the Registrar must examine the request to ascertain whether the requirements of section 15(2) and (3) (*formal requirements*) have been satisfied. (*Amended 17 of 2016 s. 24*)
- (1A) If there are deficiencies in the request as regards the formal requirements that cannot be corrected, the standard patent (R) application must be refused. (*Added 17 of 2016 s. 24*)
- (2) If there are deficiencies in the request as regards the formal requirements that may be corrected, the Registrar must give

the applicant an opportunity to correct them in accordance with the rules. *(Replaced 17 of 2016 s. 24)*

- (3) If any deficiencies referred to in subsection (2) are not corrected in accordance with the rules, then except as provided in subsection (4)—
  - (a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn; or
  - (b) in any other case, the application must be refused. *(Replaced 17 of 2016 s. 24)*
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected, then only the right is lost for the application. *(Amended 17 of 2016 s. 24)*

*[cf. EPC Art. 91]*

## **20. Publication of request to record**

- (1) If on an examination under section 19(1) a request to record is found to have satisfied the requirements of section 15(2) and (3), or if on a subsequent examination by the Registrar the deficiencies under section 19(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to this section and section 37— *(Amended 17 of 2016 s. 25)*
  - (a) record the designated patent application in the register and enter particulars of the request to record in the register;
  - (b) publish the request to record in the prescribed manner;
  - (c) advertise the fact of such publication and entry by notice in the official journal; and *(Amended 2 of 2001 s. 6; 2 of 2001 s. 14)*
  - (d) inform the applicant of the publication of the request to record.

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- (2) A request to record shall not be published if—
- (a) before the completion of preparations for publication, it has been finally refused or withdrawn or has been deemed to have been withdrawn; or
  - (b) the filing fee or advertisement fee has not been paid.
- (3) For the purposes of subsection (1)(b) the request to record shall include—
- (a) the designated patent application, including the description, the claims, any drawings and any search report or abstract published by the designated patent office and filed in the request to record;
  - (b) the names of the proprietor and (if different) the inventor.

**21. Registrar may publish additional matters**

In publishing a request to record under section 20(1)(b), the Registrar may publish such matters constituting or relating to the request which in the Registrar's opinion it is desirable to publish in addition to the matters specified in section 20(3).

**22. Provision for request to record in the event of a divisional designated patent application**

- (1) Where in an application for a standard patent (R)— (*Amended 17 of 2016 s. 26*)
- (a) a request to record has been published under section 20 and has not been refused, withdrawn or deemed to be withdrawn; and
  - (b) the applicant for the corresponding designated patent application or his successor in title has filed in the designated patent office a divisional patent application (*divisional designated patent application*), that is to

say, an application for a patent which— (*Amended 17 of 2016 s. 26*)

- (i) is in respect of the same subject-matter and does not extend beyond the contents of the corresponding designated patent application as filed in the designated patent office;
- (ii) has as its date of filing the date of filing of the corresponding designated patent application; and
- (iii) enjoys the same benefit of any right of priority as the corresponding designated patent application,

the applicant may within 6 months after the date of publication of the divisional designated patent application or publication of the request to record under this Ordinance, whichever is the later, request the Registrar to enter a record of that divisional designated patent application in the register.

- (2) Subject to section 103(1), where a request to record a divisional designated patent application is filed under this section— (*Amended 17 of 2016 s. 26*)
  - (a) it shall be deemed to have been filed on the date of filing of the earlier request to record and the application for a standard patent (R) shall have the benefit of any right of priority; (*Amended 17 of 2016 s. 26*)
  - (b) subject to paragraph (a), the provisions of this Ordinance shall apply to such a request as they apply to a request to record filed under section 15(1).
- (3) For the purpose of the application of the other provisions of this Ordinance to this section—
  - (a) any reference in those other provisions to a corresponding designated patent application shall be read as a reference to the divisional designated patent application mentioned in subsection (1)(b);

- (b) any reference in those other provisions to a corresponding designated patent shall be read as a reference to the designated patent granted in pursuance of the divisional designated patent application.

*[cf. EPC Art. 76; 1992 No. 1 s. 24 Eire; 1977 c. 37 s. 15 U.K.]*

## **Division 5—Request for Registration and Grant**

*(Replaced 17 of 2016 s. 27)*

### **23. Filing of request for registration and grant**

- (1) Where in an application for a standard patent (R)— *(Amended 17 of 2016 s. 28)*
- (a) a designated patent application has been recorded in the register and a request to record has been published and the request to record is not refused or deemed withdrawn or abandoned; and *(Amended 17 of 2016 s. 28)*
- (b) a patent has been granted in the designated patent office in pursuance of the designated patent application,
- the applicant or his successor in title may, subject to subsection (2), request the Registrar to register the designated patent so granted and to grant a standard patent (R) for the invention shown in the published specification of the designated patent (in this Ordinance referred to as a ***request for registration and grant***). *(Amended 17 of 2016 s. 28)*
- (2) A request for registration and grant under subsection (1) shall be made within 6 months after the date of grant of the designated patent by the designated patent office or publication of the request to record, whichever is the later.
- (3) Every such request shall be filed with the Registrar in the prescribed manner and shall contain—

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- (a) a verified copy of the published specification of the designated patent, including the description, the claims and any drawings published by the designated patent office;
  - (b) if the person filing the request is a person other than the person named in the register as the applicant for a standard patent (R) for the invention, a statement explaining the first-mentioned person's entitlement to apply for the grant of a standard patent (R) for the invention and prescribed documents supporting that statement; (*Amended 17 of 2016 s. 28*)
  - (c) where the request to record contains a statement under section 15(2)(e) to the effect that priority is claimed on the basis of a right of priority claimed in the designated patent office, such copies as may be prescribed of the documents filed in the designated patent office claiming and supporting such right of priority.
- (4) Every such request shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.
  - (5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing of a part of the request for registration and grant, and if either fee is not paid within that period or within such further period as may be allowed under subsection (6) the application for a standard patent (R) shall be deemed to be withdrawn. (*Amended 17 of 2016 s. 28*)
  - (6) Rules may provide for a period of grace within which a filing fee or advertisement fee that has not been paid within the time limit specified in subsection (5) may still be validly paid.
  - (7) Nothing in this section shall preclude a request for registration and grant being initiated in accordance with section 24.

**24. Date of filing request for registration and grant**

- (1) Subject to subsection (2) and section 25(2) and (4), the date of filing of a request for registration and grant shall be the earliest date on which documents filed by the applicant contain— (*Amended 17 of 2016 s. 29*)
  - (a) an indication that a request is made for the registration of a designated patent and the grant of a standard patent (R); (*Amended 17 of 2016 s. 29*)
  - (b) information identifying the applicant;
  - (c) the publication number assigned to the designated patent by the designated patent office, and the date of its publication; and
  - (d) the publication number assigned to the request to record by the Registrar.
- (2) If the earliest filing with the Registrar of any part of a request for registration and grant occurred more than 6 months after the later of—
  - (a) the date of grant of the designated patent; and
  - (b) publication of the request to record in accordance with section 20,then the application shall be deemed to be withdrawn.

**25. Examination on filing of request for registration and grant**

- (1) The Registrar shall examine whether—
  - (a) the request for registration and grant satisfies the requirements of section 24(1) for the accordance of a date of filing; and
  - (b) the filing fee and advertisement fee have been paid in due time.



- (2) If there are deficiencies in the request as regards the requirements of section 24(1) that cannot be corrected, the standard patent (R) application must be refused. *(Replaced 17 of 2016 s. 30)*
- (3) Subject to section 24(2), if there are deficiencies in the request as regards the requirements of section 24(1) that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules. *(Replaced 17 of 2016 s. 30)*
- (4) If any deficiencies referred to in subsection (3) are not corrected in accordance with the rules—
  - (a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn; or
  - (b) in any other case, the application must be refused. *(Added 17 of 2016 s. 30)*

**26. Examination as to formal requirements of the request for registration and grant**

- (1) If a request for registration and grant has been accorded a date of filing and is not deemed to be withdrawn by virtue of section 23(5), the Registrar must examine the request to ascertain whether the requirements of section 23(3) and (4) (*formal requirements*) have been satisfied. *(Amended 17 of 2016 s. 31)*
- (1A) If there are deficiencies in the request as regards the formal requirements that cannot be corrected, the standard patent (R) application must be refused. *(Added 17 of 2016 s. 31)*
- (2) If there are deficiencies in the request as regards the formal requirements that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules. *(Replaced 17 of 2016 s. 31)*



- (3) If any deficiencies referred to in subsection (2) are not corrected in accordance with the rules, then except as provided in subsection (4)—
  - (a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn; or
  - (b) in any other case, the application must be refused. *(Replaced 17 of 2016 s. 31)*
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected, then only the right is lost for the application. *(Amended 17 of 2016 s. 31)*

*[cf. EPC Art. 91]*

**27. Registration of designated patent and grant of standard patent (R)**

*(Amended 17 of 2016 s. 32)*

- (1) If on examination under section 26(1) a request for registration and grant is found to have satisfied the requirements of section 23(3) and (4) or if on a subsequent examination the deficiencies under section 26(2) are found to have been corrected in accordance with the rules, then the Registrar shall as soon as practicable after such examination, but subject to section 37— *(Amended 17 of 2016 s. 32)*
  - (a) register the designated patent by making an appropriate entry in the register; and
  - (b) grant a standard patent (R) for the invention shown in the published specification of the designated patent as filed under section 23(3)(a) and issue a certificate of grant to that effect.
- (2) A standard patent (R) shall not be granted under this section unless the filing fee and advertisement fee specified in

section 23 and any other fees payable under the preceding provisions of this Part have been paid.

- (3) As soon as practicable after a standard patent (R) has been granted under this section the Registrar shall— (*Amended 17 of 2016 s. 32*)
- (a) publish in the prescribed manner the specification of the patent, the names of the proprietor and, if different, the inventor;
  - (b) send the certificate of grant issued under subsection (1)(b) to the proprietor; and
  - (c) advertise the fact of such grant by notice in the official journal. (*Amended 2 of 2001 s. 14*)
- (4) In publishing under subsection (3)(a) any matters specified in that subsection, the Registrar may publish in addition such other matters constituting or relating to the patent which in his opinion it is desirable to publish.

*(Amended 17 of 2016 s. 32)*

## **Division 6—Further Processing and Restoration of Rights**

*(Replaced 17 of 2016 s. 33)*

### **28. Further processing of application for standard patent (R)**

*(Amended 17 of 2016 s. 34)*

- (1) Subject to this section, where—
- (a) an application for a standard patent (R), or any part of an application, is refused or is deemed to be or regarded as being withdrawn following the applicant's failure to comply with a time limit under this Part (including any time limit set by the Registrar); and (*Amended 17 of 2016 s. 34*)

- (b) the applicant has by notice filed with the Registrar requested reinstatement of the application or part of the application,
- then the legal consequence of the failure to comply with the time limit, as provided under the Ordinance, shall not ensue or, if it has already ensued, shall be retracted.
- (2) A notice under this section—
- (a) shall be in writing and shall be filed within 2 months after such refusal or withdrawal; (*Amended 17 of 2016 s. 34*)
- (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
- (c) shall not be deemed to be filed unless the omission which constituted the failure to comply with a time limit has been made good.
- (3) This section does not apply to an application that—
- (a) is refused under section 25(2) or (4)(b); or
- (b) is deemed to be or regarded as being withdrawn under section 15(4), 23(5), 24(2), 25(4)(a) or 33(2). (*Replaced 17 of 2016 s. 34*)
- (4) The Registrar may by regulation amend the period specified in subsection (2)(a) within which a notice under this section shall be filed.

[*cf. EPC Art. 121*]

## 29. Restoration of rights

- (1) Subject to this section, where—
- (a) an applicant for a standard patent (R) has failed to comply with a time limit under this Part (including any time limit set by the Registrar); and

- 
- (b) the Registrar is satisfied that the failure to comply with the time limit occurred in spite of the applicant having taken all reasonable care required by the circumstances, then upon application by the applicant to the Registrar under this section for restoration of his rights lost—
- (i) if the standard patent (R) application is refused, or is deemed to be or regarded as being withdrawn, as a direct consequence of the failure to comply with the time limit, the refusal or withdrawal is of no effect and the application is to be regarded for the purposes of proceedings under this Part as if there had been no such failure;
- (ii) any right or means of redress lost by the applicant as a direct consequence of the failure to comply with the time limit is to be restored to the applicant.
- (2) An application under this section—
- (a) shall be in writing and shall be made not later than—
- (i) 1 year after the expiry of the time limit referred to in subsection (1)(a); or
- (ii) 2 months after the removal of the cause of non-compliance with the time limit, whichever is the earlier;
- (b) shall not be deemed to be filed unless the additional prescribed fee has been paid; and
- (c) shall not be deemed to be made unless the omission which constituted the failure to comply with a time limit has been made good.
- (3) Where prior to the refusal or withdrawal of the application mentioned in subsection (1)(i) the request to record had been published under section 20, the Registrar shall advertise in

the official journal notice of any application under subsection (1). (*Amended 2 of 2001 s. 14*)

- (4) The Registrar may by regulation amend the periods specified in subsection (2)(a) within which an application under this section shall be filed.
- (5) This section does not apply to any failure to comply with a time limit under section 15 (except as regards any time limit specified for the purposes of section 15(3)), 17(2), 18, 19, 22, 23(5), 24(2), 25(4), 31(1), 32(1) or 33(2) or (4).

*(Amended 17 of 2016 s. 35)*

*[cf. EPC Art. 122]*

### **30. Effect of restoration of rights under section 29**

- (1) The effect of a restoration under section 29 is as follows.
- (2) A person who, during the period between the loss of rights referred to in section 29(1) and the advertisement in the official journal of notice of the application for restoration under section 29(3)— (*Amended 2 of 2001 s. 14*)
  - (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a standard patent (R) if those rights had not been lost; or
  - (b) makes in good faith effective and serious preparations to do such an act,has the rights specified in subsection (3).
- (3) The rights referred to in subsection (2) are—
  - (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);
  - (b) if such act was done or preparations had been made to do it in the course of a business—

- (i) in the case of an individual—
  - (A) the right to assign the right to do it or to transmit such right on death; or
  - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
- (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a standard patent (R) concerned.

- (4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).
- (5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant in the standard patent (R) application.

*(Amended 17 of 2016 s. 36)*

*[cf. 1992 No. 1 s. 55(2) to (4) Eire]*

## **Division 7—Provisions on Standard Patent (R) Applications before Grant**

*(Replaced 17 of 2016 ss. 37 & 45)*

### **31. Amendment of application for standard patent (R)**

*(Amended 17 of 2016 s. 38)*

- (1) Subject to this section and sections 36 and 103(2), an applicant for a standard patent (R) may at any time before a standard patent (R) is granted pursuant to the application, in accordance with the prescribed conditions, amend the application of his own volition. (*Amended 17 of 2016 s. 38*)
- (2) No amendment may be made under subsection (1) to the title of the invention, the abstract, a priority claim or any claim, description or drawing unless—
  - (a) the application has been published; and
  - (b) the amendment is an amendment that has been made to the corresponding designated patent application.
- (3) Upon receipt of particulars of an amendment filed in accordance with subsections (1) and (2) the Registrar shall record the amendment.

### **32. Withdrawal of application**

- (1) Subject to section 36, an applicant for a standard patent (R) may at any time before a standard patent (R) is granted pursuant to the application withdraw in writing his application and any such withdrawal may not be revoked.
- (2) Where a standard patent (R) application is withdrawn under this section, or is deemed or regarded under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, then— (*Amended 17 of 2016 s. 39*)
  - (a) if the application has been published, section 9B(3) shall continue to apply as regards the application;
  - (b) the applicant shall continue to enjoy the right of priority under section 11B which he enjoyed immediately before such withdrawal or refusal;
  - (c) no other right may be claimed under this Ordinance in relation to the application.



*(Amended 17 of 2016 s. 39)*

### **33. Maintaining application for standard patent (R)**

*(Amended 17 of 2016 s. 40)*

- (1) This section applies to an application for a standard patent (R) which has been published but in which no request has been made for registration and grant under section 23.
- (2) If it is desired to maintain a standard patent (R) application to which this section applies for a further year after the expiry of the 5th or any succeeding year from the date specified in subsection (3), the applicant shall, before the expiry of that 5th or succeeding year (as the case may be), but not earlier than a date 3 months before that expiry, apply to the Registrar in the prescribed manner for the maintenance of the patent application (*maintenance application*) and pay the prescribed fee (*maintenance fee*) and a standard patent (R) application to which this section applies shall be deemed to be withdrawn and abandoned at the expiry of that 5th or succeeding year if the maintenance application is not so made or the maintenance fee is not so paid.
- (3) The date specified for the purpose of subsection (2) is the anniversary of the date of filing the corresponding designated patent application first occurring after the date of publishing the request to record.
- (4) If, within 6 months after the end of the period specified in subsection (2) for the making of a maintenance application, an application is made under subsection (2) and the maintenance fee and any prescribed additional fee are paid in the prescribed manner then the standard patent (R) application shall be treated as if it had not been withdrawn or abandoned.
- (5) If statements contained in the maintenance application indicate—



- (a) that as at a date specified in the application, being a date not earlier than 1 month before the date of making the application—
  - (i) the designated patent application has not been withdrawn or abandoned for the purposes of the law of the designated patent office; and
  - (ii) there has been no final refusal by the designated patent office to grant a patent pursuant to the designated patent application; and
- (b) that—
  - (i) as at the date specified for the purposes of paragraph (a) a patent had not been granted pursuant to the designated patent application; or
  - (ii) a patent has been granted pursuant to the designated patent application, and the date of such grant is a date within 6 months before the date of the application,

the Registrar shall, subject to subsection (9), maintain the standard patent (R) application.

- (6) Where a statement contained in a maintenance application indicates that a designated patent has been granted on a date within the 6 months before the date of the maintenance application, any maintenance of the standard patent (R) application by virtue of subsection (5) shall have effect for a term ending 6 months after the date of such grant.
- (7) If there are deficiencies in the maintenance application that may be corrected the Registrar shall give the applicant an opportunity to correct them in accordance with the rules.
- (8) If the Registrar is not satisfied as to the veracity of a statement in the maintenance application, he shall notify the applicant accordingly giving reasons and shall allow the

applicant an opportunity to make further statements or adduce material for the purpose of so satisfying him.

- (9) If in an application under this section—
- (a) statements contained in the application indicate that—
    - (i) the designated patent application has been withdrawn or abandoned pursuant to the law of the designated patent office;
    - (ii) the designated patent office has finally refused the grant of a patent in pursuance of the designated patent application; or
    - (iii) a designated patent has been granted in pursuance of the designated patent application, and the date of such grant was a date more than 6 months before the date of the application;
  - (b) deficiencies as noted by the Registrar are not corrected in accordance with the rules; or
  - (c) the applicant has failed to satisfy the Registrar as to the veracity of a statement in respect of which notice has been given under subsection (8),

the Registrar shall refuse to maintain the standard patent (R) application and upon such refusal that application shall be deemed to be withdrawn or abandoned.

- (10) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for making a maintenance application under that subsection is determined.
- (11) The Chief Executive in Council may by regulation amend the period specified in subsection (2) as being the period after which a standard patent (R) application not maintained shall be deemed to be withdrawn and abandoned. (*Amended 22 of 1999 s. 3*)

*(Amended 17 of 2016 s. 40)*

*[cf. EPC Art. 86]*

### **34. Restoring application for standard patent (R)**

*(Amended 17 of 2016 s. 41)*

- (1) Where an application for a standard patent (R) is deemed withdrawn under section 33 by reason only of the failure to pay any maintenance fee under that section within the period specified then the applicant may, within 12 months after the date on which the application was deemed withdrawn and on payment of the prescribed fee, apply to the Registrar in the prescribed manner for the restoration of the application for a standard patent (R). *(Amended 17 of 2016 s. 41)*
- (2) The Registrar shall advertise in the official journal notice of any application under subsection (1). *(Amended 2 of 2001 s. 14)*
- (3) If on an application under subsection (1)—
  - (a) the Registrar is satisfied that the failure to pay the maintenance fee within the specified period, or that fee and any additional fee under section 33(4) within 6 months after the end of the specified period, occurred in spite of the applicant having taken all reasonable care required by the circumstances; and
  - (b) the requirements of subsection (4) are met,the Registrar shall order that the request to record be restored on payment of any such unpaid maintenance fee and additional fee.
- (4) An order for restoration shall not be made under subsection (3) unless it appears to the Registrar that at the date of the application for restoration—

- (a) the designated patent application is still valid and not withdrawn; and
- (b) a patent has not been granted in pursuance of that application or, if granted, the time for filing a request for registration and grant under section 23 has not expired.

*[cf. EPC Art. 122]*

### **35. Effect of restoration order under section 34**

- (1) The effect of a restoration under section 34(4) is as follows.
- (2) A person who, during the period between any deemed withdrawal such as is mentioned in section 34(1) and the advertisement in the official journal of notice of the application for restoration under section 34(2)— (*Amended 2 of 2001 s. 14*)
  - (a) does in good faith an act which would constitute an infringement of the applicant's rights under the published application for a standard patent (R) if those rights had not been lost; or
  - (b) makes in good faith effective and serious preparations to do such an act,has the rights specified in subsection (3).
- (3) The rights referred to in subsection (2) are—
  - (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (2);
  - (b) if such act was done or preparations had been made to do it in the course of a business—
    - (i) in the case of an individual—
      - (A) the right to assign the right to do it or to transmit such right on death; or

- (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
- (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,
- and the doing of that act by virtue of this subsection shall not amount to an infringement of the applicant's rights under the published application for a standard patent (R) concerned.
- (4) The rights specified in subsection (3) shall not include the right to grant a licence to any person to do an act referred to in subsection (2).
- (5) Where a product is disposed of to another in exercise of a right conferred by subsection (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant of the standard patent (R) application.
- (6) This section applies in relation to the Government use of an invention in respect of which an application has been made as it applies in relation to infringement of the rights conferred by publication of an application for a standard patent (R) for the invention.

*(Amended 17 of 2016 s. 42)*

*[cf. 1992 No. 1 s. 55(2) to (4) Eire]*

### **36. Limitation on withdrawal, amendment, etc. of application**

No withdrawal of an application under section 32, no request to enter a record of a divisional application under section 22(1) nor any amendment under section 31 shall be allowed after the date on which preparations for publication under section 27(3) of the

specification of a standard patent (R) to be granted in pursuance of the application have been completed.

*(Amended 17 of 2016 s. 43)*

**37. Registrar may refuse to record under section 20 or to register and grant under section 27**

- (1) The Registrar may refuse to record a designated patent application under section 20(1) or to register a designated patent under section 27 if he considers that the invention the subject of the application for the standard patent (R) is not a patentable invention by reason of any of the matters specified in section 9A(5). *(Amended 17 of 2016 s. 44)*
  - (2) The Registrar shall give notice in writing to the applicant of any such refusal.
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## Part 3

### Standard Patents by Original Grant

(Part 3 added 17 of 2016 ss. 37 & 45)

#### Division 1—Novelty and Priority

##### 37A. Interpretation of Division 1 of Part 3

In this Division—

***Hong Kong application*** (香港申請) means a standard patent (O) application or short-term patent application;

***non-Hong Kong application*** (非香港申請) means an application for a patent or other protection in or for a Paris Convention country or WTO member country, territory or area, other than a patent application under this Ordinance.

##### 37B. Non-prejudicial disclosure

- (1) For the purposes of section 9B, if the conditions specified in subsection (2) are satisfied, a disclosure of an invention that is the subject of a standard patent (O) application is not to be taken into consideration in determining whether the invention forms part of the state of the art.
- (2) The conditions are—
  - (a) the disclosure occurred no earlier than 6 months before the date of filing of the standard patent (O) application; and
  - (b) the disclosure was due to, or in consequence of—
    - (i) an evident abuse in relation to the applicant or a proprietor of the invention for the time being; or

- (ii) the fact that the applicant or a proprietor of the invention for the time being had displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928, as applied to Hong Kong.
- (3) Subsection (2)(b)(ii) applies only if the standard patent (O) application as filed contains—
  - (a) a statement to the effect that the invention had been so displayed; and
  - (b) the prescribed written evidence in support of the statement.

### **37C. Priority right**

- (1) Subsection (2) applies if a person has filed—
  - (a) a non-Hong Kong application for an invention; or
  - (b) a Hong Kong application for an invention.
- (2) The person or the person's successor in title enjoys, for the purpose of filing a subsequent standard patent (O) application for the same invention, a right of priority for the period of 12 months after the date of filing of the first non-Hong Kong application or Hong Kong application, subject to compliance with the prescribed conditions.
- (3) For the purposes of subsection (2)—
  - (a) every filing of a non-Hong Kong application that is equivalent to a regular national filing under the domestic legislation of the place in or for which the application is filed, or under bilateral or multilateral agreements, is to be recognized as giving rise to a right of priority;



- (b) a subsequent non-Hong Kong application for the same subject-matter as in a previous first non-Hong Kong application and filed in or for the same place is to be considered as the first application for the purpose of determining priority only if, on the date of filing the subsequent application, the previous application—
    - (i) has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding; and
    - (ii) has not served as a basis for claiming a right of priority; and
  - (c) if, because of paragraph (b), a subsequent non-Hong Kong application is considered as the first application, the previous non-Hong Kong application may not later serve as a basis for claiming a right of priority.
- (4) For the purposes of subsection (2)—
- (a) every regular filing of a Hong Kong application is to be recognized as giving rise to a right of priority;
  - (b) a subsequent Hong Kong application for the same subject-matter as in a previous first Hong Kong application is to be considered as the first application for the purpose of determining priority only if, on the date of filing the subsequent application, the previous application—
    - (i) has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding; and
    - (ii) has not served as a basis for claiming a right of priority; and
  - (c) if, because of paragraph (b), a subsequent Hong Kong application is considered as the first application, the

previous Hong Kong application may not later serve as a basis for claiming a right of priority.

- (5) A right of priority that arises as a result of a non-Hong Kong application or Hong Kong application for an invention may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (2) to a person's successor in title is to be construed accordingly.
- (6) In this section—

***regular filing of a Hong Kong application*** (香港申請的正規提交) means a filing of a Hong Kong application that establishes the date on which the application was filed, whatever the outcome of the application may be;

***regular national filing*** (正規國家提交) means a filing that establishes the date on which an application was filed, whatever the outcome of the application may be.

### **37D. Restoration of priority right**

- (1) This section applies if—
- (a) a person files a non-Hong Kong application or Hong Kong application for an invention; and
  - (b) the person or the person's successor in title files a subsequent standard patent (O) application for the same invention within 2 months after the expiry of the 12-month period referred to in section 37C(2).
- (2) The applicant of the subsequent standard patent (O) application may apply to the Registrar for restoring the priority right of the patent application.
- (3) The application for restoring the priority right (***restoration application***) must be made in the prescribed manner before the earlier of the following—

- (a) the end of 2 months after the expiry of the 12-month period;
  - (b) the date on which preparations for publication under section 37Q of the subsequent standard patent (O) application are completed.
- (4) A restoration application is to be regarded as being made only if the prescribed fee for the application is paid.
- (5) The Registrar may approve a restoration application if the Registrar is satisfied that the applicant failed to file the subsequent standard patent (O) application within the 12-month period even though the applicant had taken all reasonable care required by the circumstances.

### **37E. Claiming priority**

- (1) An applicant for a standard patent (O) desiring to take advantage of the priority of a previous application must file, in the prescribed manner and within the prescribed time, a statement of priority and a copy of the previous application.
- (2) Multiple priorities, whether or not they originated in different countries, may be claimed—
- (a) in respect of a standard patent (O) application; and
  - (b) if appropriate, for any one claim in the application.
- (3) If multiple priorities are claimed, a time limit that runs from the date of priority is to run from the earliest date of priority.
- (4) If one or more priorities are claimed in respect of a standard patent (O) application, the right of priority is to cover only those elements of the application that are included in the previous application or applications the priority of which is claimed.
- (5) Although certain elements of the invention for which priority is claimed do not appear among the claims formulated in

the previous application, priority may still be granted if the documents of the previous application as a whole specifically disclosed the elements.

### **37F. Effect of priority right**

- (1) The right of priority conferred by section 37C has the effect that the date of priority of a previous application claimed under section 37E is to be regarded as the date of priority of the standard patent (O) application for the purposes of this Ordinance.
- (2) If—
  - (a) a standard patent (O) application is filed; and
  - (b) the priority of a previous application is claimed under section 37E,

then despite anything contained in this Ordinance, the standard patent (O) application, and the standard patent (O) granted because of it, are not to be invalidated only because any subject-matter disclosed in the previous application was made available to the public at any time after the date of filing of the previous application.

## **Division 2—Who may Apply for Standard Patent (O)**

### **37G. Application may be made alone or jointly**

- (1) An application for a standard patent (O) for an invention may be made by a person alone or jointly with any other person.
- (2) Subject to any determination under section 37H, for the purpose of proceedings before the Registrar, the applicant is to be regarded as being entitled to apply for a standard patent (O) for the invention.

### **37H. Determination before grant of questions as to who may apply**

- (1) At any time before a standard patent (O) has been granted for an invention—
  - (a) whether or not a standard patent (O) application for the invention has been filed, a person may refer to the Registrar or the court the question whether the person is entitled, whether alone or jointly with any other person, to apply for a standard patent (O) for the invention; or
  - (b) if such an application has been filed, any of the joint proprietors of the application may refer to the Registrar or the court the question whether any right in or under the application should be transferred or granted to any other person.
- (2) The Registrar or the court may make an order that the Registrar or the court thinks fit to give effect to a determination on the question referred.

**37I. Powers of Registrar and court if standard patent (O) application has been filed**

- (1) Without limiting section 37H(2), if a question is referred to the Registrar or the court under section 37H(1) after a standard patent (O) application has been filed—
  - (a) the Registrar or the court may order that the application must proceed in the name of the person who makes the reference, or in joint names of that person and any other person;
  - (b) the Registrar or the court may order that, because of the reference, the standard patent (O) must not be granted;
  - (c) the Registrar or the court may order the application to be amended, subject to section 103(2), so as to exclude any matter to which the question relates; or
  - (d) the Registrar or the court may—

- (i) make an order transferring or granting a licence or other right in or under the application; and
  - (ii) give directions to any person for carrying out the provisions of the order.
- (2) No order may be made under subsection (1) unless notice of the reference is given in the prescribed manner to each person who, not being a party to the reference, is—
  - (a) an applicant named in the standard patent (O) application; or
  - (b) a person alleged in the reference to have the right to apply for a standard patent (O) for the invention, whether alone or jointly with any other person, because of any transaction, instrument or event relating to—
    - (i) the invention; or
    - (ii) the standard patent (O) application.
- (3) A person who receives a notice under subsection (2) may oppose the making of the order, which is sought in the reference.
- (4) If a person (*person A*) to whom directions have been given under subsection (1)(d)(ii) fails to do anything necessary for carrying out the directions within 14 days after the date of the directions, the Registrar or the court may, on application by a person (*person B*) in whose favour or on whose reference the directions have been given, authorize person B to do the thing on behalf of person A.
- (5) No direction is to be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

**37J. Registrar and court may order new standard patent (O)**

**application under certain circumstances**

- (1) This section applies if—
  - (a) a question is referred to the Registrar or the court under section 37H(1)(a) after a standard patent (O) application (*earlier application*) has been filed; and
  - (b) the earlier application—
    - (i) is refused according to an order under section 37I(1)(b);
    - (ii) is amended according to an order under section 37I(1)(c); or
    - (iii) is refused under any other provision of this Ordinance, or is withdrawn, before the Registrar or the court has disposed of the reference.
- (2) The Registrar or the court may make an order providing—
  - (a) that a person who made the reference may, within the time specified in the order and subject to section 103(1), make a new standard patent (O) application for—
    - (i) all or any of the matters comprised in the earlier application; or
    - (ii) if applicable, all or any of the matters excluded from the earlier application;
  - (b) that the date of filing of the earlier application is to be regarded as the date of filing of the new application; and
  - (c) that the new application enjoys the benefit of any right of priority.

**37K. Effect of transfer of application on licences and other rights in or under application etc.**

- (1) If an order is made under section 37I that a standard patent (O) application must proceed in the name of any



- original applicant (whether or not the application is also to proceed in the name of some other person), a licence or other right in or under the application is, subject to the order and any directions under section 37I(1)(d)(ii)—
- (a) to continue in force; and
  - (b) to be treated as granted by the person in whose name the application is to proceed.
- (2) If an order is made under section 37I that a standard patent (O) application must not proceed in the name of any original applicant, but must proceed in the name of another person (on the ground that the original applicant was not entitled to apply for the patent), a licence or other right in or under the application is, subject to the order and any directions under section 37I(1)(d)(ii), to lapse—
- (a) on the registration of the other person as the new applicant; or
  - (b) if the application has not been published, on the making of the order.
- (3) If an order referred to in subsection (2) is made, an original applicant of the standard patent (O) application or a licensee of the applicant who meets the conditions specified in subsection (5) is entitled to be granted a licence by the new applicant to continue working or to work, as the case may be, the invention which is the subject of the application.
- (4) If a new standard patent (O) application is made in accordance with an order under section 37J(2), an applicant of the earlier application or a licensee of the applicant who meets the conditions specified in subsection (5) is entitled to be granted a licence by the applicant of the new application to continue working or to work, as the case may be, the invention, so far as it is the subject of the new application.
- (5) The conditions are—



- (a) the applicant or licensee, acting in good faith before the reference that results in the making of the order—
    - (i) worked the invention in Hong Kong; or
    - (ii) made effective and serious preparations to do so; and
  - (b) the applicant or licensee makes a request for licence to the new applicant or applicant of the new application, as the case may be, within the prescribed time.
- (6) A licence granted under subsection (3) or (4)—
- (a) is a non-exclusive licence; and
  - (b) must be granted for a reasonable period and on reasonable terms.
- (7) A person to whom a request for licence is made, or a person claiming to be entitled to be granted a licence, may refer to the Registrar or the court the question—
- (a) whether the latter is so entitled; and
  - (b) whether the period or terms of the licence are reasonable.
- (8) On a reference under subsection (7), the Registrar or the court—
- (a) must determine the question; and
  - (b) may make an order that the Registrar or the court thinks fit to give effect to the determination, including an order for the grant of a licence.

### **Division 3—Applications for Standard Patents (O)**

#### **37L. Requirements of standard patent (O) application**

- (1) A standard patent (O) application must—
  - (a) be signed by the applicant; and

- (b) be filed with the Registrar in the prescribed manner.
- (2) A standard patent (O) application must contain—
  - (a) a request for the grant of a standard patent (O);
  - (b) a specification that provides for—
    - (i) a description of the invention which is the subject of the application;
    - (ii) at least one claim; and
    - (iii) any drawing referred to in the description or the claim or claims;
  - (c) an abstract;
  - (d) if the applicant desires to claim non-prejudicial disclosure of the invention under section 37B(2)(b)(ii), the statement and evidence required under section 37B(3);
  - (e) if the applicant desires to take advantage of the priority of a previous application, a statement of priority and a copy of the previous application required under section 37E(1); and
  - (f) if the invention requires for its performance the use of a micro-organism, information on the availability of samples of the micro-organism to the public (if any).
- (3) A standard patent (O) application—
  - (a) must state the name and address of the applicant;
  - (b) must—
    - (i) identify each inventor of the invention; and
    - (ii) specify the last known address of each inventor (unless the inventor is also the applicant);
  - (c) if the applicant is not an inventor, must contain a statement in the specified form indicating how the

- applicant becomes entitled to apply for a standard patent (O) for the invention; and
- (d) must specify an address in Hong Kong for service of documents.
- (4) A standard patent (O) application must also comply with the requirements of this Ordinance on providing information in, or translating documents into, one or both official languages.
- (5) A filing fee and an advertisement fee are payable within the prescribed time.
- (6) If any of the fees is not paid within the prescribed time or the grace period provided in the rules, the application is to be regarded as being withdrawn.
- (7) The rules may—
- (a) provide that a standard patent (O) application must or may contain a title of the invention and a designation of the classification of the invention; and
- (b) provide for the requirements of a standard patent (O) application for an invention that involves nucleotide and amino acid sequences.
- (8) This section does not prevent a standard patent (O) application from being initiated by documents complying with section 37M(3).

### **37M. Date of filing of standard patent (O) application**

- (1) For the purpose of according a date of filing to a standard patent (O) application, the Registrar must examine the application to ascertain—
- (a) whether it complies with the requirement specified in subsection (3) (*minimum requirement*); and
- (b) whether the prescribed filing fee and advertisement fee have been paid within the prescribed time.

- 
- (2) Subject to section 37N(3), the date of filing of a standard patent (O) application is the earliest date on which the application complies with the minimum requirement.
- (3) The requirement specified for subsection (1)(a) is that the documents filed for the standard patent (O) application contain—
- (a) an indication that a standard patent (O) is sought;
  - (b) information identifying the applicant; and
  - (c) either one of the following—
    - (i) something that appears to be a description of an invention;
    - (ii) a reference to an earlier specified application made by the applicant or the applicant's predecessor in title, together with a statement indicating that a description and the drawings (if any) of the invention, which is the subject of the standard patent (O) application, are completely contained in the specified application.
- (4) If a date of filing cannot be accorded to a standard patent (O) application because of deficiencies in the application as regards the minimum requirement, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.
- (5) If any deficiencies referred to in subsection (4) are not corrected within the prescribed time, the application must not be dealt with as an application for a standard patent (O).
- (6) In subsection (3)(c)(ii)—
- specified application*** (指明申請) means—
- (a) an application for a patent or other protection in or for a Paris Convention country or WTO member country,

territory or area, other than a patent application under this Ordinance;

- (b) a standard patent (O) application; or
- (c) a short-term patent application.

### **37N. Filing of missing description or missing drawing**

- (1) The Registrar may, by written notice, require the applicant of a standard patent (O) application to file a missing description or missing drawing in the prescribed manner and within the prescribed time.
- (2) The applicant may also, on the applicant's own initiative, file a missing description or missing drawing in the prescribed manner and within the prescribed time.
- (3) If the standard patent (O) application has been accorded a date of filing in accordance with section 37M(2), then on the filing of a missing description or missing drawing, the date of filing is to be changed to the date on which the description or drawing is filed.
- (4) The Registrar must, by written notice, inform the applicant of the change of the date of filing.
- (5) Subsection (3) does not apply if—
  - (a) the applicant has claimed priority of a previous application under section 37E;
  - (b) the missing description or missing drawing is completely contained in the previous application;
  - (c) when filing the description or drawing, the applicant makes, in accordance with the rules, a request that the date of filing accorded in accordance with section 37M(2) remains unchanged; and
  - (d) the applicant files within the prescribed time—

- (i) a copy of the previous application;
- (ii) if the previous application is not in one of the official languages, its translation in one of the official languages; and
- (iii) a statement indicating the location of the description or drawing in the previous application and, if applicable, in its translation.

(6) In this section—

**missing description** (欠交說明) means a part of the description of an invention referred to in section 37L(2)(b)(i), that has not been filed in a standard patent (O) application;

**missing drawing** (欠交繪圖) means a drawing referred to in section 37L(2)(b)(iii), that has not been filed in a standard patent (O) application.

### **37O. Missing description or missing drawing not filed or withdrawn**

- (1) If any missing description or missing drawing as defined by section 37N(6) is not filed within the prescribed time under section 37N(1) or (2), any reference to the description or drawing in the specification contained in the standard patent (O) application under section 37L(2)(b) is to be regarded as being deleted.
- (2) If a notice of change of the date of filing is issued under section 37N(4), the applicant of the standard patent (O) application may, within 1 month after the date of the notice, withdraw the missing description or missing drawing that has been filed.
- (3) On the withdrawal of the description or drawing—
  - (a) any reference to the description or drawing in the specification contained in the patent application under section 37L(2)(b) is to be regarded as being deleted;

- (b) the description or drawing is to be regarded as not having been filed; and
- (c) the original date of filing of the patent application accorded in accordance with section 37M(2) is to remain unchanged.

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

#### **37P. Examination on formal requirements**

- (1) If a standard patent (O) application has been accorded a date of filing and is not regarded as being withdrawn under section 37L(6), the Registrar must examine the application to ascertain whether the requirements of section 37L and of any rules made for the purposes of that section (*formal requirements*) have been complied with.
- (2) If there are deficiencies in the application as regards the formal requirements that cannot be corrected, the application must be refused.
- (3) If there are deficiencies in the application as regards the formal requirements that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.
- (4) If any deficiencies referred to in subsection (3) are not corrected in accordance with the rules, then except as provided in subsection (5)—
  - (a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn; or
  - (b) in any other case, the application must be refused.



- (5) If a deficiency relating solely to a claim to any right of priority is not duly corrected, then only the right is lost for the application.

### **37Q. Publication of application**

- (1) If a standard patent (O) application has been accorded a date of filing, and the Registrar is satisfied that the application complies with the formal requirements under section 37P, the Registrar must—
- (a) publish the application as filed, together with any subsequent amendment, as soon as practicable on the expiry of the prescribed time, unless the application is withdrawn or refused before preparations for its publication are completed by the Registrar; and
  - (b) advertise the fact of the publication by notice in the official journal.
- (2) The Registrar may publish the application within the prescribed time referred to in subsection (1)(a), if so requested by the applicant.
- (3) In publishing the application, the Registrar may omit from the specification contained in the application any matter—
- (a) that, in the Registrar's opinion, disparages any person in a way likely to damage the person; or
  - (b) the publication or working of which, in the Registrar's opinion, would—
    - (i) be contrary to public order (“ordre public”) or morality; or
    - (ii) be likely to encourage offensive, immoral or anti-social behaviour.
- (4) In subsection (1)(a)—



*subsequent amendment* (其後修訂), for a standard patent (O) application, includes any amendment to the claims in, and any new claim added to, the application as filed, before preparations for publication of the application are completed by the Registrar.

### **37R. Observations by third parties on patentability of invention**

- (1) After a standard patent (O) application for an invention has been published, any person may file with the Registrar a written notice of the person's observations on the patentability of the invention.
- (2) The notice must—
  - (a) set out the observations and the grounds for the observations; and
  - (b) be filed in the prescribed manner and within the prescribed time.
- (3) The Registrar must, as soon as practicable after receiving a notice under subsection (1), send a copy of the notice to the applicant.
- (4) The Registrar must consider the observations when carrying out a substantive examination of the patent application.
- (5) A person does not become a party to any proceedings under this Ordinance only because the person files a notice under subsection (1).

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

### **37S. Interpretation of Division 5 of Part 3**

In this Division—

*examination requirement* (審查規定) means a requirement specified in section 37U(3);

*unfulfilled requirement* (不獲符合的規定), for a standard patent (O) application, means an examination requirement that—

- (a) in the Registrar's opinion, is not complied with by the application; and
- (b) is set out in the notice to the applicant under section 37V(2).

**37T. Request for substantive examination of standard patent (O) application**

- (1) The applicant of a standard patent (O) application must, in accordance with the rules, request the Registrar to carry out a substantive examination of the application.
- (2) The application is to be regarded as being withdrawn if—
  - (a) no request for substantive examination is made within the prescribed time; or
  - (b) where a request has been made, the prescribed fee for the examination is not paid within the prescribed time or the grace period provided in the rules.

**37U. Substantive examination by Registrar**

- (1) On receiving a request for substantive examination of a standard patent (O) application and the prescribed fee, the Registrar must, by written notice, inform the applicant that the application has entered into the stage of substantive examination.
- (2) The Registrar must examine the application to determine whether the application complies with all the requirements specified in subsection (3).

- (3) The requirements are—
- (a) the invention, which is the subject of the application, is patentable under section 9A;
  - (b) the specification contained in the application discloses the invention in accordance with section 77;
  - (c) all the claims contained in the specification comply with the requirements of section 78(1);
  - (d) the matter disclosed in the specification contained in the application does not extend beyond that disclosed in—
    - (i) the application as filed; and
    - (ii) if the application is a specified new application, the earlier standard patent (O) application as filed;
  - (e) the application is not one of 2 relevant patent applications that—
    - (i) are filed for the same invention made by the same inventor; and
    - (ii) have the same material date.
- (4) In examining a standard patent (O) application to determine whether the application complies with the requirement specified in subsection (3)(a), the Registrar must have regard to—
- (a) if a claim for priority of a previous application has been made in respect of the application under section 37E, whether the applicant is entitled to the priority claimed; and
  - (b) if a missing description or missing drawing as defined by section 37N(6) has been filed, whether the date of filing of the application remains unchanged.
- (5) The Registrar must carry out the examination in accordance with the rules.

(6) In subsection (3)—

***relevant patent application*** (有關專利申請) means—

- (a) a patent application which is pending; or
- (b) a patent application because of which a patent, being one that is in force, was granted;

***specified new application*** (指明新申請) means—

- (a) a new standard patent (O) application made in accordance with an order under section 37J(2);
- (b) a new standard patent (O) application referred to in section 37Z; or
- (c) a new standard patent (O) application made in accordance with an order under section 55(4).

**37V. Applicant may file representations and requests for amendment, etc.**

- (1) If the Registrar is of the opinion that a standard patent (O) application does not comply with any examination requirement, the Registrar must, by written notice, inform the applicant of the opinion.
- (2) The notice must set out each examination requirement that, in the Registrar's opinion, is not complied with by the application.
- (3) The applicant may respond to the notice by filing, in accordance with the rules, any or all of the following—
  - (a) a representation to establish that the application complies with an unfulfilled requirement;
  - (b) subject to section 103(2), a request to amend the application to enable the application to comply with an unfulfilled requirement;
  - (c) a request to review the Registrar's opinion.

**37W. Registrar must consider representations and requests for amendment, etc.**

The Registrar must, in accordance with the rules—

- (a) consider and decide—
  - (i) whether a representation filed under section 37V(3)(a) establishes that a standard patent (O) application complies with an unfulfilled requirement; and
  - (ii) whether a requested amendment filed under section 37V(3)(b) would enable the application to comply with an unfulfilled requirement; and
- (b) review the Registrar’s opinion on a request filed under section 37V(3)(c).

**37X. Grant of standard patent (O)**

- (1) The Registrar must grant a standard patent (O) for an invention, if the Registrar—
  - (a) has examined the standard patent (O) application;
  - (b) has considered the representation and requested amendment, and reviewed the Registrar’s opinion, under section 37W (where applicable); and
  - (c) is of the opinion that the application, together with any requested amendment, complies with all the examination requirements.
- (2) As soon as practicable after the standard patent (O) is granted, the Registrar must—
  - (a) publish in the prescribed manner—
    - (i) the specification of the patent;
    - (ii) the name of the applicant; and

- (iii) the name of the inventor;
  - (b) issue a certificate of grant in respect of the patent to the applicant; and
  - (c) advertise the fact of the grant by notice in the official journal.
- (3) The Registrar may, in addition to the matters specified in subsection (2)(a), publish any other matters constituting or relating to the patent that the Registrar considers it desirable to publish.

### **37Y. Refusal to grant standard patent (O)**

The Registrar must refuse to grant a standard patent (O) for an invention, if the Registrar—

- (a) has examined the standard patent (O) application;
- (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 37W (where applicable); and
- (c) is of the opinion that the application, together with any requested amendment, does not comply with all the examination requirements.

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

### **37Z. Divisional standard patent (O) application**

- (1) Subsection (2) applies if—
- (a) a standard patent (O) application (*earlier application*) has been filed; and
  - (b) the applicant or the applicant's successor in title files a new standard patent (O) application that meets the conditions specified in subsection (3).

- 
- (2) Subject to section 103(1)—
- (a) the date of filing of the earlier application is regarded as the date of filing of the new application; and
  - (b) the new application enjoys the benefit of any right of priority.
- (3) The conditions are—
- (a) the new application is filed—
    - (i) before the earlier application is withdrawn;
    - (ii) before the earlier application is regarded as being withdrawn;
    - (iii) if a standard patent (O) has been granted because of the earlier application, before preparations for publication under section 37X(2)(a) of the specification of the patent are completed; or
    - (iv) within the prescribed time after the earlier application is refused by the Registrar; and
  - (b) the new application—
    - (i) is made in respect of any part of the subject-matter contained in the earlier application; and
    - (ii) complies with the prescribed requirements.

**37ZA. Amendment of standard patent (O) application before grant**

- (1) subject to section 103(2), the applicant of a standard patent (O) application may amend the application in accordance with the rules within the prescribed time.
- (2) The Registrar may, on the Registrar's initiative, amend the specification and abstract contained in a standard patent (O) application so as to acknowledge a registered trade mark.

**37ZB. Withdrawal of standard patent (O) application**

- (1) An applicant may, by written notice, withdraw a standard patent (O) application at any time before preparations for publication under section 37X(2)(a) of the specification of the standard patent (O) are completed.
- (2) A notice of withdrawal is irrevocable.

**37ZC. Effect of withdrawal and refusal of standard patent (O) application**

If a standard patent (O) application is withdrawn, is regarded as being withdrawn, or is refused, under this Ordinance—

- (a) section 9B(3) continues to apply as regards the application if the application has been published;
- (b) the applicant continues to enjoy, on the basis of the application, a right of priority under section 37C or 110 for filing a subsequent standard patent (O) application or short-term patent application; and
- (c) no other right may be claimed under this Ordinance in relation to the application.

**37ZD. Further processing of, and restoration of rights in respect of, standard patent (O) application**

- (1) Sections 28(1) and (2), 29(1), (2) and (3) and 30 apply, subject to the necessary modifications, to an application for a standard patent (O) as if—
  - (a) a reference in those sections to an application or an applicant for a standard patent (R) were a reference to an application or an applicant for a standard patent (O);
  - (b) a reference in those sections to Part 2 were a reference to this Part; and
  - (c) the words “the request to record had been published under section 20” in section 29(3) were substituted by



the words “the application had been published under section 37Q”.

- (2) Section 28(1) and (2), as applied by subsection (1), does not apply to—
  - (a) a standard patent (O) application that is regarded as being withdrawn under section 37L(6) or 37T(2)(b); or
  - (b) a standard patent (O) application that is refused under section 37Y because the applicant fails to comply with a time limit under the rules made for the purposes of section 37V or 37W.
- (3) Section 29(1) and (2), as applied by subsection (1), does not apply to a failure to comply with a time limit under section 37D, 37E, 37N, 37O, 37Z, 37ZA or 37ZB.

## Part 4

### Provisions on Patents after Grant

*(Replaced 17 of 2016 s. 46)*

*(Format changes—E.R. 4 of 2020)*

#### Division 1—Standard Patents

*(Replaced 17 of 2016 s. 46)*

#### 38. Deemed date of filing where standard patent (R) has been granted

*(Amended 17 of 2016 s. 47)*

Where a standard patent (R) is granted, the application for the standard patent (R) shall be deemed to have as its date of filing the date of filing of the corresponding designated patent application, and in this Ordinance ***deemed date of filing*** (當作提交日期) in relation to an application for a standard patent (R) shall be construed accordingly.

*(Amended 17 of 2016 s. 47)*

#### 39. Term of standard patent

(1) A standard patent granted under this Ordinance—

- (a) shall take effect from the date on which the fact of its grant is advertised in the official journal; and *(Amended 2 of 2001 s. 14)*
- (b) subject to subsection (2), shall remain in force until the end of the period of 20 years beginning with— *(Amended 17 of 2016 s. 48)*
  - (i) for a standard patent (R), the deemed date of filing of the application for the patent;

- 
- (ii) for a standard patent (O), the date of filing of the application for the patent. (*Amended 17 of 2016 s. 48*)
- (2) If it is desired to keep a standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subsection (3), the prescribed renewal fee shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid.
- (3) The date specified for the purpose of subsection (2) is— (*Amended 17 of 2016 s. 48*)
- (a) for a standard patent (R), the anniversary of the deemed date of filing of the application for the patent first occurring after the date of grant of the patent;
- (b) for a standard patent (O), the anniversary of the date of filing of the application for the patent first occurring after the date of grant of the patent. (*Amended 17 of 2016 s. 48*)
- (4) If within 6 months after the end of the period specified in subsection (2) for payment of the renewal fee the renewal fee and any prescribed additional fee are paid, the standard patent shall be treated as if it had never expired, and accordingly—
- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.

- (5) The Registrar may by regulation amend the period specified in subsection (2) by reference to which the earliest date for payment of the prescribed renewal fee is determined.
- (6) The Chief Executive in Council may by regulation amend— (*Amended 22 of 1999 s. 3*)
  - (a) the period specified in subsection (1)(b) as being the period for which a standard patent shall remain in force;
  - (b) the period specified in subsection (2) by reference to which a standard patent, if not renewed, shall cease to have effect.

*[cf. 1977 c. 37 s. 25 U.K.]*

#### **40. Restoration of lapsed standard patents**

- (1) Where a standard patent has ceased to have effect by reason of the failure to pay any renewal fee as provided in section 39, application may be made to the Registrar, at any time within 18 months after the date on which the patent ceased to have effect, for the restoration of the patent.
- (2) An application under this section may be made by the person who was the proprietor of the standard patent at the time it ceased to have effect or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was at that time held by 2 or more persons jointly the application may, with the leave of the Registrar, be made by one or more of them without joining the others.
- (3) The Registrar shall advertise in the official journal notice of any application under this section. (*Amended 2 of 2001 s. 14*)
- (4) If the Registrar is satisfied that the failure to pay any renewal fee as provided in section 39, or to pay that fee and any additional fee under that section within 6 months after the end of that period, occurred in spite of the applicant having

taken all reasonable care required by the circumstances the Registrar shall by order restore the patent on payment of any such unpaid renewal fee and any prescribed additional fee.

- (5) An order under this section may be made subject to such terms and conditions as the Registrar thinks fit.

*[cf. 1949 c. 87 s. 28 U.K.; 1977 c. 37 s. 28 U.K.; EPC Art. 122]*

#### **41. Effect of order for restoration of standard patent**

- (1) The effect of an order for the restoration of a standard patent is as follows.
- (2) Anything done during the period between expiry and restoration which would have constituted an infringement if the patent had not expired shall be treated as an infringement—
- (a) if done at a time when it was possible for the patent to be renewed under section 39(4); or
- (b) if it was a continuation or repetition of an earlier infringing act.
- (3) A person who in Hong Kong, after it was no longer possible for the patent to be so renewed and before advertisement in the official journal of notice of an application for restoration under section 40— (*Amended 2 of 2001 s. 14*)
- (a) began in good faith to do an act which would constitute an infringement of the patent if it were in force; or
- (b) made in good faith effective and serious preparations to do such an act,
- has the rights specified in subsection (4).
- (4) The rights referred to in subsection (3) are—

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (3);
- (b) if such act was done or preparations had been made to do it in the course of a business—
  - (i) in the case of an individual—
    - (A) the right to assign the right to do it or to transmit such right on death; or
    - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
  - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

- (5) The rights specified in subsection (4) shall not include the right to grant a licence to any person to do an act referred to in subsection (3).
- (6) Where a patented product is disposed of to another in exercise of a right conferred by subsection (4), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

*[cf. 1992 No. 1 s. 55(2) to (5) Eire]*

#### **42. Determination after grant of questions referred before grant**

- (1) If a question with respect to a standard patent or application for a standard patent is referred by any person to the Registrar or the court under section 13 or 37H, whether before or after the making of an application for the patent, and is not

determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a standard patent, but on its grant that person shall be treated as having referred to the Registrar or the court under section 55 any question mentioned in that section which the Registrar or the court thinks appropriate.

- (2) In determining any such question under section 55 the Registrar shall exercise only the powers that are available to him for the purposes of determining the same question referred to him under section 13 or 37H.

*(Amended 17 of 2016 s. 49)*

*[cf. 1977 c. 37 s. 9 U.K.]*

**43. Amendment of standard patent (R) following opposition or revocation proceedings in the designated patent office**

*(Amended 17 of 2016 s. 50)*

- (1) If the specification of the corresponding designated patent in respect of a standard patent (R) granted under Part 2 has (whether before or after the grant of the standard patent (R)) been amended in the designated patent office following prescribed opposition or revocation proceedings, the proprietor of the standard patent (R) shall file with the Registrar in the prescribed manner and within the prescribed period a verified copy of the amended specification or the amending order or other prescribed documentation.
- (2) The Registrar shall record the amendment to the specification of the designated patent by making an appropriate entry in the register and upon that recording the standard patent (R) shall be treated as having been amended in a like manner.

- (3) As soon as practicable after a standard patent (R) has been amended under this section the Registrar shall— (*Amended 17 of 2016 s. 50*)
- (a) publish the amendment;
  - (b) advertise the fact of the amendment by notice in the official journal. (*Amended 2 of 2001 s. 14*)
- (4) Any amendment of the specification of a standard patent (R) under this section shall have effect from the date of grant of the patent.
- (5) Any amendment of the specification of a standard patent (R) under this section shall have effect subject to section 103(3).  
*(Amended 17 of 2016 s. 50)*  
*[cf. EPC Art. 102]*

**44. Revocation of standard patent (R) following opposition or revocation proceedings in the designated patent office**

*(Amended 17 of 2016 s. 51)*

- (1) This section applies to any standard patent (R) of which the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.
- (2) The proprietor of a standard patent (R) to which this section applies shall after publication of the revocation by the designated patent office and in the prescribed manner file with the Registrar a verified copy of the order of revocation or other prescribed documentation.
- (3) The Registrar shall record any filing under subsection (2) and shall advertise the fact of such filing by notice in the official journal. (*Amended 2 of 2001 s. 14*)
- (4) A person other than the proprietor of a standard patent (R) to which this section applies may apply to the Registrar in



the prescribed manner for an order under this subsection, and where on such an application the Registrar is satisfied that the patent is one to which this section applies he shall, subject to subsection (5), order that the patent be revoked.

- (5) The Registrar may, if he thinks fit, refer any application under subsection (4) to the court and the court shall have jurisdiction to make an order for the revocation of the patent.
- (6) Upon the Registrar advertising the fact of a filing by the proprietor of a standard patent (R) under subsection (2) in the official journal, or upon the making of an order by the Registrar under subsection (4) or by the court under subsection (5) for the revocation of a standard patent (R), the patent shall be treated as never having had effect. (*Amended 2 of 2001 s. 14*)

*(Amended 17 of 2016 s. 51)*

*[cf. EPC Art. 102]*

*(Cross-heading repealed 17 of 2016 s. 52)*

45. *(Repealed 17 of 2016 s. 52)*

## **Division 2—Patents Generally**

*(Added 17 of 2016 s. 53)*

### **46. Application to amend specification after grant**

- (1) Subject to section 103(3), the proprietor of a patent may apply to amend the specification of the patent.
- (2) An application under subsection (1) must be made—
  - (a) for a standard patent (R), to the court;
  - (b) for a standard patent (O), to the Registrar or the court;

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- (c) for a short-term patent in respect of which a certificate of substantive examination has been issued, to the Registrar or the court.
  - (3) The Registrar or the court (as the case requires) must, in accordance with the rules made by the Registrar or the court—
    - (a) publish an application to amend the specification of a patent;
    - (b) advertise the fact of the publication by notice in the official journal; and
    - (c) consider any opposition to the application filed within the prescribed time.
  - (4) Despite subsection (3), the Registrar may decide not to publish the application or a part of the application if, in the Registrar’s opinion, the amendment proposed in the application or the part—
    - (a) would cause the specification of the patent to contravene section 77 or 78;
    - (b) contains any matter that disparages any person in a way likely to damage the person;
    - (c) contains any matter the publication or working of which would—
      - (i) be contrary to public order (“ordre public”) or morality; or
      - (ii) be likely to encourage offensive, immoral or anti-social behaviour; or
    - (d) is invalid under section 103(3).
  - (5) The Registrar or the court may by order—
    - (a) allow an amendment to the specification of a patent; and

- (b) attach conditions to the amendment that the Registrar or the court thinks fit.
- (6) No amendment may be allowed under subsection (5) if there are pending before the court proceedings in which the validity of the patent may be put in issue.
- (7) If an amendment to the specification of a patent is allowed by the Registrar or the court under subsection (5), the Registrar must, in accordance with the rules—
- (a) record and publish the amendment; and
- (b) advertise the fact of the publication by notice in the official journal.
- (8) The Registrar may, on the Registrar’s initiative, amend the specification of a patent so as to acknowledge a registered trade mark.
- (9) An amendment to the specification of a patent under this section has effect as from the grant of the patent.
- (10) The rules of court may provide for—
- (a) the manner in which an application under this section is to be made to the court;
- (b) the notification of the application to the Registrar and the Registrar’s appearance in proceedings;
- (c) the filing of opposition to the application; and
- (d) the procedures for determining the application.
- (11) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to an application that is filed with the court before that date to amend the specification of a patent.

*(Replaced 17 of 2016 s. 54)*

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**Editorial Note:**

\* Commencement date: 19 December 2019.

**47. Patent not to be impugned for lack of unity**

No person may in any proceedings object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate—

- (a) to more than one invention; or
- (b) to a group of inventions which are not so linked as to form a single inventive concept.

*[cf. 1977 c. 37 s. 26 U.K.]*

**48. Surrender of patents**

- (1) The proprietor of a patent may at any time by written notice given to the Registrar offer to surrender his patent.
- (2) Any person may give notice to the Registrar of his opposition to the surrender of a patent under this section, and if he does so the Registrar shall notify the proprietor of the patent and, subject to subsection (4), shall determine the question.
- (3) If the Registrar is satisfied that the patent may properly be surrendered he may accept the offer and, as from the date on which notice of his acceptance is advertised in the official journal, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any Government use of the patented invention before that date.  
*(Amended 2 of 2001 s. 14)*
- (4) The Registrar may if he thinks fit refer the matter to the court for determination.

*[cf. 1977 c. 37 s. 29 U.K.]*

**49. Registrar's power to revoke patent on grounds of "ordre public" or morality**

- (1) Any person may at any time after a patent has been granted for an invention under this Ordinance refer to the Registrar the question of whether, having regard to any of the matters specified in section 9A(5), the invention is a patentable invention.
- (2) Where a question is so referred—
  - (a) subject to paragraph (b), the Registrar shall determine the question;
  - (b) the Registrar may if he thinks fit refer the question to be determined by the court and, without prejudice to the court's jurisdiction apart from this paragraph to determine any such question, the court shall have jurisdiction to do so.
- (3) If the Registrar or the court determines that the invention is not a patentable invention by reason of any of the matters specified in section 9A(5) he or it shall order that the patent shall be revoked and upon the making of such an order the patent shall be treated as never having had effect.
- (4) Any person may oppose a reference under subsection (1).

*(Amended 17 of 2016 s. 55)*

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## Part 5

### Property in Patents and Applications; Registration

*(Replaced 17 of 2016 s. 56)*

*(Format changes—E.R. 4 of 2020)*

#### **50. Nature of, and transactions in, patents and applications for patents**

- (1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (7).
- (2) Subject to section 54, any patent or any such application, or any right in it, may be assigned or mortgaged.
- (3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (4) Subject to section 54, a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application; and—
  - (a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and
  - (b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (5) Subsections (2) to (4) shall have effect subject to this Ordinance.

- (6) Any of the following transactions, that is to say—
- (a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;
  - (b) any assent relating to any patent or any such application or right,
- shall be void unless it is in writing and is signed by or on behalf of the assignor, mortgagor or party granting such assent as the case may be (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.
- (7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 80 or 88 for a previous infringement or to bring proceedings under section 72 for a previous act.

*[cf. 1977 c. 37 s. 30 U.K.]*

## **51. Register of patents**

- (1) The Registrar shall keep a register to be known as the register of patents, which shall comply with rules made for the purposes of this section and shall be kept in accordance with such rules.
- (2) Without prejudice to any other provision of this Ordinance—
  - (a) rules shall be made providing for the registration of—
    - (i) patents and of published applications for standard patents; and

- (ii) transactions, instruments or events affecting rights in or under patents and published applications for standard patents;
  - (b) rules made for the purposes of this section may provide, in connection with rules made for the purposes of paragraph (a), for—
    - (i) the furnishing to the Registrar of any prescribed documents or description of documents in connection with any matter which is required to be registered;
    - (ii) the correction of errors in the register and in any documents filed with the Registrar in connection with registration; and
    - (iii) the publication and advertisement of anything done under this Ordinance in relation to the register; and
  - (c) rules made for the purposes of this section may provide for notification to the Registrar of any matter affecting the property in an application for a patent.
- (3) Notwithstanding subsection (2)(a)(ii), no notice of any trust, whether express, implied or constructive, shall be entered in the register and the Registrar shall not be affected by any such notice.
  - (4) The register need not be kept in documentary form.
  - (5) Subject to any rules, the public shall have a right to inspect the register at the registry at all convenient times.
  - (6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy



or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

- (7) Applications under subsection (6) or rules made by virtue of that subsection shall be made in such manner as may be prescribed.
- (8) In relation to any portion of the register kept otherwise than in documentary form—
  - (a) the right of inspection conferred by subsection (5) is a right to inspect the material on the register; and
  - (b) the right to a copy or extract conferred by subsection (6) or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (9) Subject to subsection (12), the register shall be prima facie evidence of anything required or authorized by this Ordinance to be registered.
- (10) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorized by this Ordinance to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be prima facie evidence of the matters so certified.
- (11) Each of the following, that is to say—
  - (a) a copy of an entry in the register or an extract from the register which is supplied under subsection (6);
  - (b) a copy of any document kept at the registry or an extract from any such document, any specification of a patent or any application for a standard patent which has been published,

which purports to be a certified copy or a certified extract shall, subject to subsection (12), be admitted in evidence without further proof and without production of any original.

- (12) This section is without prejudice to section 22A or 22B or Part IV of the Evidence Ordinance (Cap. 8) or any provision made by virtue of that section or Part. (*Replaced 2 of 1999 s. 6*)
- (13) In this section *certified copy* (核證副本) and *certified extract* (核證摘錄) mean a copy and extract certified by the Registrar and sealed with the seal of the Registrar.

[*cf. 1977 c. 37 s. 32 U.K.*]

## 52. Effect of registration procedures on rights in patents

- (1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event—
- (a) either—
- (i) application has not been made for registration of the earlier transaction, instrument or event; or
  - (ii) in the case of any application for a standard patent which has not been published or any application for a short-term patent, notice of the earlier transaction, instrument or event has not been given to the Registrar in accordance with rules (if any) made for the purposes of section 51(2)(c); and
- (b) the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event.

- (2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.
- (3) This section applies to the following transactions, instruments and events—
- (a) the assignment of a patent or application for a patent, or a right in it;
  - (b) the mortgage of a patent or application or the granting of security over it;
  - (c) the grant or assignment of a licence or sub-licence or mortgage of a licence or sub-licence under a patent or application;
  - (d) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right; and
  - (e) any order or directions of a court or other competent authority transferring a patent or application or any right in or under it to any person and the event by virtue of which the court or authority had power to make any such order or give any such directions.

*[cf. 1977 c. 37 s. 33 U.K.]*

### **53. Rectification of register**

- (1) The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.

- (2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

*[cf. 1977 c. 37 s. 34 U.K.]*

#### **54. Co-ownership of patents and applications for patents**

- (1) Where a patent is granted to 2 or more persons each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.
- (2) Where 2 or more persons are proprietors of a patent, then, subject to this section and to any agreement to the contrary, each of them shall be entitled, by himself or his agent, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and sections 68 and 69 amount to an infringement of the patent concerned; and any such act shall not amount to an infringement of the patent concerned.
- (3) Subject to sections 13, 37H, 37I, 37J and 55 and to any agreement for the time being in force, where 2 or more persons are proprietors of a patent one of them shall not without the consent of the other or others— (*Amended 17 of 2016 s. 57*)
- (a) make an application for amending the specification of the patent or for revoking the patent; or
- (b) grant a licence under the patent, or assign or mortgage a share in the patent. (*Amended 17 of 2016 s. 57*)
- (4) Subject to those sections, where 2 or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply

of those means by virtue of this subsection shall not amount to an infringement of the patent.

- (5) Where a patented product is disposed of by any of 2 or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.
- (6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.
- (7) This section shall have effect in relation to an application for a patent as filed as it has effect in relation to a patent and—
  - (a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and
  - (b) the reference in subsection (5) to a patented product shall be construed accordingly.

*[cf. 1977 c. 37 s. 36 U.K.; EPC Art. 59]*

## **55. Determination of right to patent after grant**

- (1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the court the question—
  - (a) who is or are the true proprietor or proprietors of the patent;
  - (b) whether the patent should have been granted to the person or persons to whom it was granted; or
  - (c) whether any right in or under the patent should be transferred or granted to any other person or persons,and the court shall determine the question and make such order as it thinks fit to give effect to the determination.

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- (2) Without prejudice to the generality of subsection (1), an order under that subsection may contain provision—
- (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;
  - (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
  - (c) granting any licence or other right in or under the patent;
  - (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.
- (3) If any person to whom directions have been given under subsection (2)(d) fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the court may, on application made to it by any person in whose favour or on whose reference the order containing the directions was made, authorize him to do that thing on behalf of the person to whom the directions were given.
- (4) Where the court finds on a reference under this section that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 91 makes an order on that ground for the conditional or unconditional revocation of the patent, the court may order that the person by whom the application was made or his successor in title may, subject to section 103(1), make a new application for a patent—  
(*Amended 17 of 2016 s. 58*)

- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
  - (b) in the case of conditional revocation, for the matter which in the opinion of the court should be excluded from that specification by amendment under section 102.
- (5) Where a new application for a patent is made under subsection (4), it shall be treated—
  - (a) as having been filed on the date of filing the application to which the reference relates; (*Amended 17 of 2016 s. 58*)
  - (b) as having the same date of filing and, where the reference under this section is in respect of a standard patent (R), as having the same deemed date of filing, as the application to which the reference relates; and (*Amended 17 of 2016 s. 58*)
  - (c) as having the benefit of any right of priority enjoyed by the patent, which is the subject of the unconditional or conditional revocation (as the case may be). (*Added 17 of 2016 s. 58*)
- (6) Where the reference under this section is in respect of a standard patent (R), the court may order in respect of any new application under subsection (4)— (*Amended 17 of 2016 s. 58*)
  - (a) that all or any of the requirements of section 15(2) or (3) or 23(3) or (4) be dispensed with; and
  - (b) that the person making the new application shall for the purposes of that application be deemed to have filed a request to record having the same date of filing as the request to record in the application for the patent to which the reference relates.



- (7) On any such reference as is mentioned in subsection (4) no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) on that ground, if the reference was made after the end of 2 years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.
- (8) Where a question is referred to the court under this section an order shall not be made by virtue of subsection (2) or under subsection (4) on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent except those who are parties to the reference.

[*cf.* 1977 c. 37 s. 37 U.K.]

## **56. Effect of transfer of patent under section 55**

- (1) Where an order is made under section 55 that a patent shall be transferred from any person or persons (the *old proprietor or proprietors*) to one or more persons (whether or not including an old proprietor), then, except in a case falling within subsection (2), any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 50 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the *new proprietor or proprietors*).
- (2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor (on the ground that the patent was granted to a person not entitled to be granted the



patent), any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3), lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.

- (3) If an order referred to in subsection (2) is made, an old proprietor or a licensee of the patent who meets the conditions specified in subsection (3B) is entitled to be granted a licence (but not an exclusive licence) by the new proprietor or proprietors of the patent to continue working or to work, as the case may be, the invention which is the subject of the patent. *(Replaced 17 of 2016 s. 59)*
- (3A) If a new application for a patent is made in accordance with an order under section 55(4), an old proprietor or a licensee of the original patent who meets the conditions specified in subsection (3B) is entitled to be granted a licence (but not an exclusive licence) by the applicant of the new application to continue working or to work, as the case may be, the invention for which the original patent was granted, so far as it is the subject of the new application. *(Added 17 of 2016 s. 59)*
- (3B) The conditions are—
- (a) the old proprietor or licensee, acting in good faith before the reference that results in the making of the order—
    - (i) worked the invention in Hong Kong; or
    - (ii) made effective and serious preparations to do so; and
  - (b) the old proprietor or licensee makes a request for licence to the new proprietor or proprietors of the patent, or the applicant of the new application, as the case may be, within the prescribed time. *(Added 17 of 2016 s. 59)*

- (4) Any such licence shall be granted for a reasonable period and on reasonable terms.
- (5) The new proprietor or proprietors of the patent, or the applicant of the new application, as the case may be, or any person claiming that he is entitled to be granted any such licence may refer to the court the question whether that person is so entitled and whether any such period is or terms are reasonable, and the court shall determine the question and may, if it considers it appropriate, order the grant of such a licence. (*Amended 17 of 2016 s. 59*)

*[cf. 1977 c. 37 s. 38 U.K.]*

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## Part 6

### Employees' Inventions

*(Replaced 17 of 2016 s. 60)*

*(Format changes—E.R. 4 of 2020)*

#### 57. Right to employees' inventions

- (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Ordinance and all other purposes if—
  - (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
  - (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.
- (2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.
- (3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent; or
- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any protected layout-design (topography) right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

*[cf. 1977 c. 37 s. 39 U.K.]*

## **58. Compensation of employees for certain inventions**

- (1) Where it appears to the court on an application made by an employee within the prescribed period that—
  - (a) the employee has made an invention belonging to the employer for which a patent has been granted;
  - (b) the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer; and
  - (c) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,the court may award him such compensation of an amount determined under section 59.
- (2) Where it appears to the court on an application made by an employee within the prescribed period that—
  - (a) a patent has been granted for an invention made by and belonging to the employee;
  - (b) his rights in the invention, or in any patent or application for a patent for the invention, have since the commencement\* of this section been assigned to the

employer or an exclusive licence under the patent or application for a patent has since the commencement\* of this section been granted to the employer;

- (c) having regard to all the circumstances of the case, including the terms of the contract of assignment or grant or any ancillary contract (*the relevant contract*), the benefit derived by the employee from the relevant contract is inadequate in relation to the benefit derived by the employer from the patent; and
- (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract,

the court may award him such compensation of an amount determined under section 59.

- (3) Subsection (2) shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention.
- (4) References in this section to an invention belonging to an employer or an employee are references to it so belonging as between the employer and the employee.

*[cf. 1977 c. 37 s. 40 U.K.]*

Editorial Note:

\* Commencement date: 27 June 1997.

## **59. Amount of compensation**

- (1) An award of compensation to an employee under section 58(1) or (2) in relation to a patent for an invention shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which

the employer has derived, or may reasonably be expected to derive, from—

- (a) the patent; or
  - (b) the assignment or grant to a person connected with the employer of—
    - (i) the property or any right in the invention; or
    - (ii) the property in, or any right in or under, an application for that patent.
- (2) For the purposes of subsection (1), the amount of any benefit derived or expected to be derived by an employer from the assignment or grant of—
- (a) the property in, or any such right in or under—
    - (i) a patent for the invention; or
    - (ii) an application for such a patent; or
  - (b) the property or any right in the invention,
- to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.
- (3) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to an employer, the court shall, among other things, take the following matters into account, that is to say—
- (a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Ordinance;
  - (b) the effort and skill which the employee has devoted to making the invention;

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- (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
  - (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.
- (4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which originally belonged to him, the court shall, among other things, take the following matters into account, that is to say—
- (a) any conditions in a licence or licences granted under this Ordinance or otherwise in respect of the invention or the patent;
  - (b) the extent to which the invention was made jointly by the employee with any other person; and
  - (c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (3)(d).
- (5) Any order for the payment of compensation under section 58 may be an order for the payment of a lump sum or for periodical payment, or both.
- (6) Without prejudice to section 39(1) of the Interpretation and General Clauses Ordinance (Cap. 1), the refusal of the court to make any such order on an application made by an employee under section 58 shall not prevent a further application being made under that section by him or any successor in title of his.

- (7) Where the court has made any such order, the court may on the application of either the employer or the employee vary or discharge it or suspend any provision of the order and revive any provision so suspended.

*[cf. 1977 c. 37 s. 41 U.K.]*

**60. Enforceability of contracts relating to employees' inventions**

- (1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—
- (a) with the employer (alone or with another); or
  - (b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.
- (2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the commencement\* of this section and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.
- (3) Subsection (2) is without prejudice to any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.
- (4) This section applies to any arrangement made with a public officer in the course of his duties as it applies to any contract made between an employee and an employer other than the Government.

*[cf. 1977 c. 37 s. 42 U.K.]*

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Editorial Note:



\* Commencement date: 27 June 1997.

## **61. Supplementary**

- (1) Sections 57 to 60 shall not apply to an invention made before the commencement\* of this Ordinance.
- (2) Sections 57 to 60 shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say—
  - (a) he was mainly employed in Hong Kong; or
  - (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in Hong Kong to which the employee was attached, whether or not he was also attached elsewhere.
- (3) In sections 57 to 60 and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.
- (4) Any references in sections 57 to 60—
  - (a) to a patent are references to a patent or other forms of protection for an invention;
  - (b) to a patent being granted are references to its being granted,whether under the law of Hong Kong or the law in force in any other country, territory or area or under any treaty or international convention.

- (5) For the purposes of sections 58 and 59 the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 58 in respect of the patent, include any benefit derived or expected to be derived from the patent by his personal representatives or by any person in whom the patent was vested by their assent.
- (6) Where an employee dies before an award is made under section 58 in respect of a patented invention made by him, his personal representatives or their successors in title may exercise his right to make or proceed with an application for compensation under subsection (1) or (2) of that section.
- (7) In sections 58 and 59 and this section **benefit** (利益) means benefit in money or money's worth.
- (8) In section 59(2)—
- person connected with** (有關連的人), in relation to an employer, means—
- (a) where the employer is a natural person—
- (i) a relative of the employer;
  - (ii) a partner of the employer and any relative of that partner;
  - (iii) a partnership in which the employer is a partner;
  - (iv) any corporation controlled by the employer, by a partner of the employer or by a partnership in which the employer is a partner;
  - (v) any director or principal officer of any such corporation as is referred to in subparagraph (iv);
- (b) where the employer is a corporation—
- (i) any associated corporation;

- (ii) any person who controls the corporation and any partner of such person, and, where either such person is a natural person, any relative of such person;
  - (iii) any director or principal officer of that corporation or of any associated corporation and any relative of any such director or officer;
  - (iv) any partner of the corporation and, where such partner is a natural person, any relative of such partner;
- (c) where the employer is a partnership—
- (i) any partner of the partnership and where such partner is a partnership any partner of that partnership, any partner with the partnership in any other partnership and where such partner is a partnership any partner of that partnership and where any partner of, or with, or in any of the partnerships mentioned in this subparagraph is a natural person, any relative of such partner;
  - (ii) any corporation controlled by the partnership or by any partner thereof or, where such a partner is a natural person, any relative of such partner;
  - (iii) any corporation of which any partner is a director or principal officer;
  - (iv) any director or principal officer of a corporation referred to in subparagraph (ii);

and for the purposes of that definition—

***associated corporation*** (有聯繫法團), in relation to a person, means—

- (a) a corporation over which the person has control;
- (b) if the person is a corporation—
  - (i) a corporation which has control over the person; or
  - (ii) a corporation which is under the control of the same person as is the first-mentioned person;

**control** (控制), in relation to a corporation, means the power of a person to secure—

- (a) by means of the holding of shares or the possession of voting power in or in relation to that or any other corporation; or
- (b) by virtue of any powers conferred by the articles of association or other document regulating that or any other corporation,

that the affairs of the first-mentioned corporation are conducted in accordance with the wishes of that person;

**principal officer** (主要人員) means—

- (a) a person employed by a corporation who, either alone or jointly with one or more other persons, is responsible under the immediate authority of the directors for the conduct of the business of the corporation; or
- (b) a person so employed who, under the immediate authority of a director of the corporation or a person to whom paragraph (a) applies, exercises managerial functions in respect of the corporation;

*relative* (親屬) means the spouse, parent, child, brother or sister of the relevant person, and, in deducing such a relationship, an adopted child shall be deemed to be a child both of the natural parents and the adopting parent and a step child to be the child of both the natural parents and of any step parent.

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Editorial Note:

\* Commencement date: 27 June 1997.

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## Part 7

### Contracts as to Patented Products etc.

*(Replaced 17 of 2016 s. 61)*

*(Format changes—E.R. 4 of 2020)*

#### **62. Avoidance of certain restrictive conditions**

- (1) Subject to this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far as it purports—
  - (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;
  - (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied;
  - (c) in either case, to prohibit the person supplied or licensee from using articles (whether patented products or not) which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.

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- (2) Subsection (1) does not apply to contracts made or licences granted before the commencement\* of this Ordinance.
- (3) In proceedings against any person for infringement of a patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.
- (4) A condition or term of a contract or licence shall not be void by virtue of this section if—
- (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or licensee, on reasonable terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1); and
  - (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party 3 months' notice in writing and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may in default of agreement between the parties be determined by an arbitrator appointed by the parties.
- (5) If in any proceeding it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall lie on the supplier or licensor to prove the matters set out in subsection (4)(a).

- (6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only—
- (a) that it prohibits any person from selling goods other than those supplied by a specified person; or
  - (b) in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

[cf. 1977 c. 37 s. 44 U.K.]

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Editorial Note:

\* Commencement date: 27 June 1997.

### 63. Determination of parts of certain contracts

- (1) This section applies to—
- (a) any contract for the supply of a patented product;
  - (b) any licence to work a patented invention; or
  - (c) any contract relating to any such supply or licence,
- where the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force.
- (2) Notwithstanding anything to the contrary in the contract or licence or in any other contract, a contract or licence to which this section applies may to the extent (and only to the extent) that the contract or licence relates to the product or invention, be determined by either party on giving 3 months' notice in writing to the other party.
- (3) In subsection (1) *patented product* (專利產品) and *patented invention* (專利發明) include respectively a product and an



invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application for a patent which had been filed before that time, as it applies to a patent in force at that time.

- (4) If, on an application under this subsection made by either party to a contract or licence falling within subsection (1), the court is satisfied that, in consequence of the patent or patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all terms and conditions of the contract or licence, it may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.
- (5) The foregoing provisions of this section apply to contracts and licences whether made before or after the commencement\* of this section.
- (6) The provisions of this section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.

*[cf. 1977 c. 37 s. 45 U.K.]*

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Editorial Note:

\* Commencement date: 27 June 1997.

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## Part 8

### Compulsory Licences for Standard Patents

*(Replaced 17 of 2016 s. 62)*

*(Format changes—E.R. 4 of 2020)*

#### 64. Compulsory licences for standard patents

- (1) At any time after the expiration of 3 years from the date of grant of a standard patent any person may apply to the court on one or more of the grounds specified in subsection (2)—
  - (a) for a licence under the patent;
  - (b) where the applicant is the Government, for the grant of a licence under the patent to any person specified in the application.
- (2) The grounds referred to in subsection (1) are—
  - (a) where the patented invention is capable of being commercially worked in Hong Kong, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;
  - (b) where the patented invention is a product, that a demand for the product in Hong Kong is not being met on reasonable terms;
  - (c) where the patented invention is capable of being commercially worked in Hong Kong by manufacture, that it is being prevented or hindered from being so worked—
    - (i) in the case of a product, by the importation of the product; or

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- (ii) in the case of a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
  - (d) that by reason of the refusal by the proprietor of the patent to grant a licence or licences on reasonable terms—
    - (i) the working or efficient working in Hong Kong of any other patented invention which involves an important technical advance of considerable economic significance in relation to the patent is prevented or hindered; or
    - (ii) the establishment or development of commercial or industrial activities in Hong Kong is unfairly prejudiced; or
  - (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent or the establishment or development of commercial or industrial activities in Hong Kong, is unfairly prejudiced.
- (3) The court may, if it is satisfied that any of those grounds are established, and subject to subsections (4) and (5), order the grant of a licence on such terms as it thinks fit—
- (a) to the applicant, where the application is made under subsection (1)(a); or
  - (b) to the person specified in the application, where the application is made under subsection (1)(b).
- (4) Where the application is made on the ground that the patented invention is not being commercially worked in Hong Kong or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the court that the time which

has elapsed since the grant of the patent was advertised in the official journal has for any reason been insufficient to enable the invention to be so worked, the court may adjourn the hearing for such period as will in the opinion of the court give sufficient time for the invention to be so worked. (*Amended 2 of 2001 s. 14*)

- (5) No order shall be made under this section unless the court is satisfied that the applicant has made reasonable efforts to obtain authorization from the proprietor on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.
- (6) No order shall be made under this section in respect of a patent (*patent A*) on the ground mentioned in subsection (2)(d)(i) unless the court is satisfied that the proprietor of the patent for the other invention (*patent B*) is able and willing to grant to the proprietor of patent A and his licensees a licence under patent B on reasonable terms.
- (7) An order granting a licence under this section shall provide—
  - (a) that the licence shall be non-exclusive; and
  - (b) that such licence shall be non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence, and in the case of a licence granted under subsection (6) the licence in respect of patent A shall only be assignable with the assignment of patent B, (*Amended 2 of 2001 s. 7*)

and shall specify the scope and duration of such licence.

- (8) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped from relying on any of the matters specified in subsection (2) because of any admission made by him, whether in such

licence or otherwise or by reason of his having accepted such licence.

*[cf. 1977 c. 37 s. 48 U.K.]*

**65. Provisions about licences under section 64**

- (1) Where the court is satisfied, on an application made under section 64 in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, the court may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as it thinks fit as well as to the applicant.
- (2) Where an application under section 64 is made in respect of a patent by a person who holds a licence under the patent, the court may—
  - (a) if it orders the grant of a licence to the applicant, order the existing licence to be cancelled; or
  - (b) instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

*[cf. 1977 c. 37 s. 49 U.K.]*

**66. Exercise of powers on applications under section 64**

- (1) The powers of the court on an application under section 64 in respect of a patent shall be exercised with a view to securing the following purposes—
  - (a) that inventions which can be worked on a commercial scale in Hong Kong and which should in the public interest be so worked shall be worked there without

- undue delay and to the fullest extent that is reasonably practicable;
- (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;
  - (c) that the interests of any person for the time being working or developing an invention in Hong Kong under the protection of a patent shall not be unfairly prejudiced.
- (2) Subject to subsection (1), the court shall, in determining whether to make an order in pursuance of such an application, take account of the following matters—
- (a) the nature of the invention, the time which has elapsed since the grant of the patent was advertised in the official journal and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention; (*Amended 2 of 2001 s. 14*)
  - (b) the ability of any person to whom a licence would be granted by the court to work the invention to the public advantage;
  - (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,
- but the court shall not be required to take account of any such matter occurring subsequent to the making of the application. (*Amended E.R. 4 of 2020*)
- (3) Any person aggrieved by an order made under section 64 or 65 may apply to the court for an order for the variation or cancellation of the licence if the court in all the circumstances should think fit.

[*cf. 1977 c. 37 s. 50 U.K.*]

**67. Opposition to application under sections 64 to 66**

The proprietor of the patent concerned or any other person wishing to oppose an application under sections 64 to 66 may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

*[cf. 1977 c. 37 s. 52 U.K.]*

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## Part 9

### Government Use of Patented Inventions

*(Replaced 17 of 2016 s. 63)*

*(Format changes—E.R. 4 of 2020)*

#### 68. Declaration of extreme urgency

The Chief Executive in Council may, for the purposes of applying sections 69 to 71, by regulation declare a period of extreme urgency whenever Chief Executive in Council considers it to be necessary or expedient in the public interest for the maintenance of supplies and services essential to the life of the community or for securing sufficient supplies and services essential to the life of the community.

*(Amended 22 of 1999 s. 3)*

#### 69. Government use of patents during a period of extreme urgency

(1) During a period of declared extreme urgency a public officer authorized in writing by the Chief Executive or any person authorized in writing by such public officer may in relation to— *(Amended 22 of 1999 s. 3)*

- (a) a patented invention, without the consent of the proprietor of the patent; or
- (b) an invention in respect of which an application for a patent has been filed, without the consent of the applicant,

do any act in Hong Kong in relation to the invention as appears to the public officer or person authorized to be necessary or expedient in connection with the urgency giving rise to the declaration under section 68.



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- (2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use, or Government use, of the invention; and *use* (徵用), in relation to an invention, in section 70 to 72 shall be construed accordingly.
- (3) Government use may include any act which would, apart from this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 88 to bring proceedings in respect of the application for a standard patent.
- (4) Any Government use of the invention made at any time either—
- (a) after the publication of an application for a standard patent or the grant of a short-term patent for the invention; or
  - (b) without prejudice to paragraph (a), in consequence of a relevant communication made otherwise than in confidence after the material date of the patent application or of the patent for the invention, (*Amended 17 of 2016 s. 64*)

shall be made on such terms as may be agreed, either before or after the use, by the Government and the proprietor of the patent or as may in default of agreement be determined by the court on a reference under section 72.

- (5) Where an invention is used by virtue of this section at any time after publication of an application for a standard patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only—
- (a) after such a patent is granted; and

- (b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application as published.
- (6) The authority of a public officer in respect of an invention may be given under this section either before or after the patent is granted, and may be given to any person whether or not he is authorized directly or indirectly by the proprietor of the patent to do anything in relation to the invention.
- (7) Where any Government use of an invention is made by or with the authority of a public officer under this section, then the public officer shall notify the proprietor of the patent as soon as practicable, and furnish him with such information as to the extent of the use as he may from time to time require.
- (8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Government.
- (9) Any reference in this section to a patented invention, in relation to any time, is a reference to an invention to which a patent has before that time been, or is subsequently, granted.
- (10) In this section *relevant communication* (有關通訊), in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.
- (11) Subsection (4) is without prejudice to any rule of law relating to the confidentiality of information.

[*cf.* 1977 c. 37 ss. 55 & 56 U.K.]

**70. Rights of third parties in respect of Government use**

- (1) The provisions of any licence, assignment or agreement specified in subsection (3) are of no effect in relation to—
  - (a) any Government use of an invention by a public officer, or a person authorized by a public officer, by virtue of section 69; or
  - (b) anything done for Government use to the order of a public officer by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending,  
so far as those provisions—
    - (i) restrict or regulate the working of the invention, or the use of any model, document or information relating to it; or
    - (ii) provide for the making of payments in respect of, or calculated by reference to, such working or use.
- (2) The reproduction or publication of any model or document in connection with a working or use referred to in subsection (1) shall not be deemed to be an infringement of any copyright or protected layout-design (topography) subsisting in the model or document.
- (3) The licence, assignment or agreement referred to in subsection (1) is any licence, assignment or agreement which is made, whether before or after the date of commencement\* of this Ordinance, between any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title (on the one hand), and any person whatever other than the Government (on the other hand).

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- (4) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application concerned, then—
- (a) section 69(4) applies in relation to anything done in respect of the invention which, but for this section and section 69(1), would be an infringement of the rights of the licensee, with the substitution in those provisions of reference to the proprietor of the patent with reference to the licensee; and
  - (b) section 69(4) does not apply in relation to anything done in respect of the invention by the licensee by virtue of an authority given under section 69(1).
- (5) Subject to subsection (4), where the patent, or the right to the grant of the patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then—
- (a) section 69(4) applies in relation to any Government use of the invention as if reference to the proprietor of the patent included a reference to the assignor, and any sum payable for Government use under that subsection shall be divided between those persons in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 72; and
  - (b) section 69(4) applies in relation to any act done in respect of the invention for Government use by the proprietor of the patent or application to the order of a public officer, as if that act were use made by virtue of an authority given under that section.

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- (6) Where section 69(4) applies to any use of an invention and a person holds an exclusive licence under the patent or application concerned (other than such a licence as is mentioned in subsection (4)) authorizing him to work the invention, then subsections (8) and (9) shall apply.
- (7) In subsections (8) and (9) *the section 69(4) payment* (第69(4)條付款) means such payment (if any) as the proprietor of the patent or application and the Government agree under section 69, or the court determines under section 72, should be made by the public officer concerned to the proprietor in respect of the use of the invention.
- (8) The licensee shall be entitled to recover from the proprietor of the patent or application such part (if any) of the section 69(4) payment as may be agreed on by them or as may in default of agreement be determined by the court under section 72 to be just having regard to any expenditure incurred by the licensee—
- (a) in developing the invention; or
  - (b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.
- (9) Any agreement by the proprietor of the patent or application and the Government under section 69(4) as to the amount of the section 69(4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the court under section 69(4) as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard.
- (10) In this section *the public officer concerned* (有關公職人員), in relation to any Government use of an invention, means the

public officer by whom or on whose authority the use was made.

*[cf. 1977 c. 37 s. 57 U.K.]*

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Editorial Note:

\* Commencement date: 27 June 1997.

### **71. Compensation for loss of profit**

- (1) Where Government use is made of an invention, the Government shall pay—
  - (a) to the proprietor of the patent; or
  - (b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee,compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.
- (2) Compensation is payable only to the extent that such a contract could have been fulfilled from the existing manufacturing or other capacity of the proprietor or licensee; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.
- (3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used.
- (4) No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for Government use.

- (5) The amount payable shall, if not agreed between the proprietor or licensee and the Government, be determined by the court on a reference under section 72, and is in addition to any amount payable under section 69 or 70.

*[cf. 1977 c. 37 s. 57A U.K.]*

## **72. References of disputes as to Government use**

- (1) Any dispute as to—
- (a) the exercise by a public officer, or a person authorized by a public officer, of the powers conferred by section 69;
  - (b) terms for Government use of an invention under section 69;
  - (c) the right of any person to receive any part of a payment made in pursuance of section 69(4); or
  - (d) the right of any person to receive a payment under section 71,
- may be referred to the court by either party to the dispute after a patent has been granted for the invention.
- (2) In determining under this section any dispute between the Government and any person as to the terms for the Government use of an invention, the court shall have regard—
- (a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any public officer in respect of the invention in question;



- (b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the public officer concerned for Government use of the invention on reasonable terms.
- (3) On a reference under this section the court may refuse to grant relief by way of compensation in respect of Government use of an invention—
  - (a) during any further period specified under section 33(4), but before payment of the maintenance fee and any additional fee prescribed for the purposes of that section; or
  - (b) during any further period specified under section 39(4) or 126(5) (as the case may be), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.
- (4) Where an amendment of the specification of a patent has been allowed under this Ordinance or has been recorded under section 43(2), the court shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment or the recording of the amendment unless the court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.
- (5) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (6), grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used in Government use.



- (6) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded.
- (7) As a condition of any such relief the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 102, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.
- (8) In considering the amount of any compensation for Government use of an invention after publication of an application for a standard patent for the invention and before such a patent is granted, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use, and if the court finds that it would not have been reasonable, it shall reduce the compensation to such amount as it thinks just.
- (9) Where a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent (the *new proprietor or licensee*) by virtue of a transaction, instrument or event to which section 52 applies, then unless—

- (a) an application for registration of the prescribed particulars of the transaction, instrument or event is made before the end of the period of 6 months beginning with its date; or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

the new proprietor or licensee shall not be entitled to any compensation under section 69(4) (as it stands or as modified by section 70(4)) or to any compensation under section 71 in respect of any use of the patented invention by a public officer or a person authorized by a public officer under section 69 after the date of the transaction, instrument or event and before the prescribed particulars of the transaction, instrument or event are registered.

- (10) One of 2 or more joint proprietors of a patent or application for a patent may without the concurrence of the others refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

*[cf. 1977 c. 37 s. 58 U.K.]*

## Part 9A

### Import Compulsory Licences for Patented Pharmaceutical Products

*(Replaced 17 of 2016 s. 65)*

*(Part 9A added 21 of 2007 s. 5)*

*(Format changes—E.R. 4 of 2020)*

#### 72A. Interpretation of Part 9A

*(Amended 17 of 2016 s. 66)*

In this Part, unless the context otherwise requires—

**Director** (署長) means the Director of Health;

**import compulsory licence** (進口強制性特許) means a compulsory licence granted under section 72C;

**import compulsory licensee** (進口強制性特許持有人) means the holder of an import compulsory licence;

**proprietor** (所有人), in relation to a patent, means the proprietor of the patent that is granted in Hong Kong.

#### 72B. Declaration of extreme urgency for public health problem

- (1) The Chief Executive in Council may, for the purposes of applying sections 72C to 72J, by notice published in the Gazette declare a period of extreme urgency whenever the Chief Executive in Council considers it to be necessary or expedient in the public interest to do so to address any public health problem or threatened public health problem in Hong Kong.
- (2) Where a period of extreme urgency has been declared under subsection (1), the Chief Executive in Council shall review

from time to time, or cause to be reviewed from time to time, the public health problem or the threatened public health problem leading to the declaration.

- (3) The period of extreme urgency declared under subsection (1) continues to run until such a date as may be specified by the Chief Executive in Council by notice published in the Gazette terminating the period of extreme urgency.
- (4) A notice published under subsection (1) or (3) is subsidiary legislation.

**72C. Grant of import compulsory licences for patented pharmaceutical products**

During a period of extreme urgency declared under section 72B(1), where the Director considers that the pharmaceutical industry in Hong Kong has no or insufficient capacity to manufacture a patented pharmaceutical product to meet the needs for the product in Hong Kong, the Director may grant an import compulsory licence under the patent concerned, subject to such terms and conditions as he may impose, to a public officer or any other person to do in Hong Kong in relation to the product all or any of the following which appears to the Director to be necessary or expedient in connection with the extreme urgency giving rise to the declaration—

- (a) importing, putting on the market, stocking or using the product;
- (b) any other act which would, apart from this section, amount to an infringement of the patent concerned.

**72D. Terms, conditions and nature of import compulsory licences**

- (1) The terms and conditions subject to which an import compulsory licence is granted under section 72C shall include—

- (a) terms and conditions in respect of—
    - (i) the acts authorized to be done in relation to the patented pharmaceutical product under the licence;
    - (ii) the amount of the patented pharmaceutical product covered by the licence; and
    - (iii) the duration of the licence;
  - (b) terms and conditions providing that—
    - (i) the patented pharmaceutical product which is imported to Hong Kong under the licence shall not be exported out of Hong Kong;
    - (ii) the patented pharmaceutical product shall be—
      - (A) clearly identified as being imported under the licence through specific labelling or marking; and
      - (B) distinguished from the same product made by or under authorization of the proprietor of the patent concerned through special packaging, colouring or shaping; and
    - (iii) the licence is non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence; and
  - (c) any other terms or conditions as the Director thinks fit having regard to the public health needs in Hong Kong in the period of extreme urgency declared under section 72B(1).
- (2) An import compulsory licence is non-exclusive.

**72E. Payment of remuneration to proprietors of patents**

- (1) If remuneration has been paid to the proprietor of a patent granted in an exporting member for production and export

of a patented pharmaceutical product to Hong Kong in accordance with the relevant instrument or legislation, no remuneration shall be paid to the proprietor of the patent concerned granted in Hong Kong for the import compulsory licence in relation to the product.

- (2) If the proprietor of the patent concerned granted in Hong Kong establishes to the satisfaction of the Director that remuneration has not been paid to the proprietor of the patent granted in the exporting member for the production and export of the patented pharmaceutical product to Hong Kong in accordance with the relevant instrument or legislation and all legal remedies to recover payment of the remuneration in the exporting member have been exhausted, the Government shall pay to the proprietor of the patent concerned granted in Hong Kong such amount of remuneration—
  - (a) as may be agreed between the Director and the proprietor of the patent concerned granted in Hong Kong subject to any order made by the court on an application under section 72J(2); or
  - (b) as may be determined by the court on an application under section 72J(1) or (2),for the import compulsory licence in relation to the product.
- (3) Before reaching any agreement as to the amount of remuneration, the Director shall take into account any advice given by the Director of Intellectual Property as regards the remuneration.
- (4) The total amount of remuneration agreed under subsection (2)(a) to be payable in respect of the patent or all the patents (if there is more than one patent in relation to the patented pharmaceutical product) shall not exceed 4% of the total purchase price for the product payable by the

import compulsory licensee to the seller of the product in the exporting member.

- (5) Where there is more than one patent in relation to the patented pharmaceutical product, the total amount of remuneration agreed under subsection (2)(a) shall be apportioned on an equal share basis among all the proprietors of the patents concerned.
- (6) The Secretary for Commerce and Economic Development may by notice published in the Gazette vary the percentage specified in subsection (4).

**72F. Notification of grant of import compulsory licences and remuneration agreed, etc.**

- (1) The Director shall as soon as practicable after the grant of an import compulsory licence under section 72C—
  - (a) give notice in writing to the proprietor of the patent concerned of the grant of the licence and its terms and conditions; and
  - (b) advertise in the official journal notice of the grant of the licence and its terms and conditions.
- (2) The Director shall—
  - (a) as soon as practicable after any amount of remuneration has been agreed under section 72E(2)(a) between him and the proprietor of the patent concerned, advertise in the official journal a notice stating—
    - (i) the amount of remuneration so agreed with the proprietor of the patent concerned named in the notice and, where applicable, the apportionment of the amount of remuneration under section 72E(5); and



- (ii) that any other person who is entitled to claim remuneration payable under section 72E(2) may make an application to the court under section 72J(2); or
- (b) as soon as practicable after he is satisfied that he and the proprietor of the patent concerned have failed to agree on the amount of remuneration payable under section 72E(2), advertise in the official journal a notice stating—
  - (i) the fact of the failure to agree on the amount of remuneration with the proprietor of the patent concerned named in the notice; and
  - (ii) that any other person who is entitled to claim remuneration payable under that section may make an application to the court under section 72J(2).

**72G. Termination of import compulsory licences**

- (1) The Director may terminate an import compulsory licence by giving notice in writing to the import compulsory licensee if he is satisfied that any term or condition of the licence imposed under section 72C has been contravened.
- (2) The Director shall as soon as practicable after the termination of an import compulsory licence under subsection (1)—
  - (a) give notice in writing to the proprietor of the patent concerned of the termination; and
  - (b) advertise in the official journal notice of the termination.

**72H. Disposal of patented pharmaceutical products after period of extreme urgency etc.**

- (1) On the termination of the period of extreme urgency by a notice under section 72B(3), the import compulsory licensee shall take reasonable steps to recall or cause to recall any



patented pharmaceutical product which is imported under the import compulsory licence from any person (other than a person who is in possession of the product privately for non-commercial purposes) who is in possession of the product disposed of in accordance with the licence.

- (2) An import compulsory licensee shall—
  - (a) surrender to the Director any patented pharmaceutical product which is in his possession or recalled under subsection (1); or
  - (b) dispose of the product in such a way as may be agreed with the proprietor of the patent concerned granted in Hong Kong.
- (3) Where a patented pharmaceutical product is surrendered to the Director under subsection (2)(a)—
  - (a) the Government shall pay to the import compulsory licensee a sum equivalent to the purchase price for the product paid by the licensee to the seller of the product in the exporting member; and
  - (b) the Director shall—
    - (i) dispose of the product in such a way as may be agreed with the proprietor of the patent concerned granted in Hong Kong; or
    - (ii) in default of agreement, destroy the product as soon as practicable.
- (4) For the avoidance of doubt, stocking of any patented pharmaceutical product which is imported under an import compulsory licence does not amount to an infringement of the patent concerned on the part of the import compulsory licensee or the Director from the termination of the period of extreme urgency by a notice under section 72B(3) until—

- (a) the import compulsory licensee surrenders the product to the Director under subsection (2)(a) or disposes of the product under subsection (2)(b); or
  - (b) the Director disposes of the product under subsection (3)(b)(i) or destroys the product under subsection (3)(b)(ii),
- as the case may be.

**72I. No infringement of patents by persons to whom patented pharmaceutical products are disposed of in accordance with import compulsory licences**

- (1) A person to whom a patented pharmaceutical product is disposed of in accordance with an import compulsory licence may, without consent of the proprietor of the patent concerned, put on the market, stock or use the product, in Hong Kong, for the purposes in connection with the extreme urgency giving rise to the declaration under section 72B(1) as if he had been authorized by the licence to do so.
- (2) A person to whom a patented pharmaceutical product is disposed of in accordance with an import compulsory licence shall not export or cause to export the product out of Hong Kong.

**72J. References of disputes as to import compulsory licences**

- (1) If the Director and the proprietor of the patent concerned fail to agree on the amount of remuneration payable under section 72E(2), either party may, subject to subsection (5), apply to the court for an order to determine the amount of remuneration payable under that section.
- (2) A person who is not a party to any agreement reached on the amount of remuneration under section 72E(2)(a) but is entitled to claim remuneration payable under section 72E(2)

may, subject to subsection (5), apply to the court for an order for payment of remuneration under that section.

- (3) In determining the appropriate amount of remuneration payable to the proprietor of the patent concerned, the court shall take into account all factors relevant to the circumstances, including—
  - (a) the economic value to Hong Kong of the use of the patented pharmaceutical product imported under the relevant import compulsory licence; and
  - (b) humanitarian or non-commercial factors relevant to the grant of the licence.
- (4) The total amount of remuneration determined by the court under subsection (3) to be payable in respect of the patent or all the patents (if there is more than one patent in relation to the patented pharmaceutical product) may exceed the maximum amount of remuneration that may be agreed under section 72E(2)(a).
- (5) No application may be made under subsection (1) or (2) after the expiry of the period of 28 days from the date of the advertisement of the notice under section 72F(2), unless the court determines otherwise.
- (6) Any person aggrieved by—
  - (a) the grant of an import compulsory licence;
  - (b) any term or condition of an import compulsory licence imposed under section 72C;
  - (c) the apportionment of the amount of remuneration under section 72E(5); or
  - (d) the termination of an import compulsory licence under section 72G(1),

may, within 28 days after the date of the advertisement of the notice under section 72F(1)(b) or (2)(a)(i) or the date of the

termination of the licence (as the case may be) or such further period as may be allowed by the court, apply to the court for a review of the grant of the licence, the terms or conditions of the licence, the apportionment of the amount of remuneration or the termination of the licence (as the case may be).

- (7) In a review the court may—
- (a) confirm, vary or cancel the import compulsory licence;
  - (b) confirm, vary or cancel a term or condition of the import compulsory licence imposed under section 72C;
  - (c) confirm or vary the apportionment of the amount of remuneration under section 72E(5);
  - (d) confirm or reverse the termination of the import compulsory licence under section 72G(1); or
  - (e) make any other order as the court thinks fit in the circumstances.
- (8) The proprietor of the patent concerned may apply to the court for an order to terminate an import compulsory licence on the ground that any term or condition of the licence imposed under section 72C has been contravened.
- (9) The court may, on an application under subsection (8)—
- (a) make an order to terminate the import compulsory licence if the court is satisfied that any term or condition of the licence imposed under section 72C has been contravened; and
  - (b) make any other order as the court thinks fit in the circumstances.

## Part 9B

### Export Compulsory Licences for Patented Pharmaceutical Products

*(Replaced 17 of 2016 s. 67)*

*(Part 9B added 21 of 2007 s. 5)*

*(Format changes—E.R. 4 of 2020)*

#### 72K. Interpretation of Part 9B

*(Amended 17 of 2016 s. 68)*

In this Part, unless the context otherwise requires—

**Director** (署長) means the Director of Health;

**export compulsory licence** (出口強制性特許) means a compulsory licence granted under section 72M;

**export compulsory licensee** (出口強制性特許持有人) means the holder of an export compulsory licence;

**Hong Kong patent number** (香港專利編號), in relation to a patent, means—

- (a) a number assigned by the Registrar to a certificate of grant issued in respect of the patent under section 27(1)(b); *(Amended 17 of 2016 s. 68)*
- (ab) a number assigned by the Registrar to a certificate of grant issued in respect of the patent under section 37X(2)(b); *(Added 17 of 2016 s. 68)*
- (b) a number assigned by the Registrar to a certificate of grant issued in respect of the patent under section 118(2)(b); or
- (c) a number assigned by the Registrar to a certificate of registration issued in respect of the patent under the

Registration of Patents Ordinance (Cap. 42) which has been repealed under section 154(1);

*proprietor* (所有人), in relation to a patent, means the proprietor of the patent that is granted in Hong Kong.

**72L. Application for export compulsory licences for patented pharmaceutical products**

- (1) At any time after the grant of a standard patent or a short-term patent in respect of a patented pharmaceutical product, any person may apply to the Director for the grant of an export compulsory licence under the patent concerned in relation to the product under section 72M.
- (2) The application shall be made in writing and—
  - (a) shall specify the following information—
    - (i) the name and address of the applicant and of any agent or representative authorized by the applicant for the purpose of the application;
    - (ii) the name of the patented pharmaceutical product to be made and sold for export under an export compulsory licence the subject of the application;
    - (iii) the amount of the patented pharmaceutical product to be made and sold for export under the export compulsory licence;
    - (iv) the name of the eligible importing member to which the patented pharmaceutical product is to be exported under the export compulsory licence;
    - (v) the duration of the export compulsory licence applied for by the applicant;
    - (vi) the Hong Kong patent number or Hong Kong patent numbers in relation to the patented pharmaceutical product;

- (vii) the proposed labelling, marking, packaging, colouring or shaping for the patented pharmaceutical product required by section 72N(1)(b)(ii);
  - (viii) the address of a website on which the applicant is required to post the information referred to in section 72N(1)(b)(iii);
  - (ix) any information obtained pursuant to subsection (3);
  - (x) any other information as the Director may reasonably require for the purposes of granting the export compulsory licence; and
- (b) shall be accompanied by—
- (i) a copy of the written request from the eligible importing member, any representative, non-governmental organization or international health organization authorized by the eligible importing member to the applicant for the patented pharmaceutical product and the amount of the product requested;
  - (ii) a copy of the notification made by the eligible importing member to the TRIPS Council stating—
    - (A) the name and the amount of the patented pharmaceutical product requested by the eligible importing member;
    - (B) where the eligible importing member is not a least-developed country recognized by the United Nations, that the eligible importing member has no or insufficient capacity to manufacture the patented pharmaceutical product; and



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- (C) where the pharmaceutical product is patented in the eligible importing member, that the eligible importing member has granted or intends to grant a compulsory licence to import the product in accordance with the relevant instrument or legislation;
- (iii) where applicable, a copy of notice of the intended application given to the proprietor of the patent concerned under subsection (4)(b)(i) or (5)(a)(i);
- (iv) where applicable, a declaration made by the applicant under the Oaths and Declarations Ordinance (Cap. 11) declaring that he has made reasonable efforts in accordance with subsection (4)(a) to obtain authorization from the proprietor of the patent concerned on reasonable commercial terms and conditions but the efforts have not been successful within 28 days after they had been made; and
- (v) if the pharmaceutical product is patented in the eligible importing member, documentary evidence of any compulsory licence granted by the eligible importing member for importation of the product.
- (3) A person who intends to make an application under subsection (1) shall, before he makes the application, take reasonable steps to obtain from the eligible importing member information on the amount of the patented pharmaceutical product to be made and exported to the eligible importing member by any exporting member other than Hong Kong under any compulsory licence granted elsewhere.



- (4) Where a person intends to make an application under subsection (1) and the eligible importing member has not notified the TRIPS Council that it is faced with a national emergency or other circumstances of extreme urgency, the person shall—
- (a) not later than 28 days before the date of the application, make reasonable efforts to obtain authorization from the proprietor of the patent concerned on reasonable commercial terms and conditions to make and sell for export the patented pharmaceutical product of such amount as requested by the eligible importing member; and
  - (b) not later than 14 days before the date of the application—
    - (i) give the proprietor of the patent concerned notice of the intended application containing the information required under subsection (2)(a) (except subparagraphs (viii) and (x) of that subsection); and
    - (ii) attach to the notice all the documents and documentary evidence required under subsection (2)(b) (except subparagraphs (iii) and (iv) of that subsection).
- (5) Where a person intends to make an application under subsection (1) and the eligible importing member has notified the TRIPS Council that it is faced with a national emergency or other circumstances of extreme urgency, the person shall—
- (a) (i) at any time before the application is made, give the proprietor of the patent concerned notice of the intended application containing the information required under subsection (2)(a) (except subparagraphs (viii) and (x) of that subsection); or

- (ii) as soon as practicable after the application is made, give the proprietor of the patent concerned notice of the application containing the information required under subsection (2)(a);
- (b) attach to the notice all the documents and documentary evidence required under subsection (2)(b) (except subparagraphs (iii) and (iv) of that subsection); and
- (c) as soon as practicable after notice is given under paragraph (a), submit a copy of the notice to the Director.

**72M. Grant of export compulsory licences for patented pharmaceutical products**

The Director may grant an export compulsory licence under the patent concerned, subject to such terms and conditions as he may impose, to an applicant to make a patented pharmaceutical product and sell the product for export to an eligible importing member if he is satisfied that—

- (a) all the requirements of section 72L have been met;
- (b) the amount of the product applied for by the applicant to be made and sold for export under the licence does not exceed the amount stated in the notification referred to in section 72L(2)(b)(ii)(A), after taking into account any information obtained pursuant to section 72L(3); and
- (c) the application is made in response to the request from the eligible importing member referred to in section 72L(2)(b)(i).

**72N. Terms, conditions and nature of export compulsory licences**

- (1) The terms and conditions subject to which an export compulsory licence is granted under section 72M shall include—

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- (a) terms and conditions in respect of—
    - (i) the acts authorized to be done in relation to the patented pharmaceutical product under the licence;
    - (ii) the amount of the patented pharmaceutical product authorized to be made and sold for export under the licence;
    - (iii) the eligible importing member to which the patented pharmaceutical product is to be exported under the licence; and
    - (iv) the duration of the licence;
  - (b) terms and conditions providing that—
    - (i) the licence is non-assignable except with that part of the enterprise or goodwill which enjoys the use of the patent under the licence;
    - (ii) the patented pharmaceutical product shall be—
      - (A) clearly identified as being made under the licence through specific labelling or marking; and
      - (B) distinguished from the same product made by or under authorization of the proprietor of the patent concerned through special packaging, colouring or shaping;
    - (iii) the export compulsory licensee shall, before shipment of the patented pharmaceutical product to the eligible importing member under the licence, post on the website maintained by or on behalf of the licensee or on the WTO website information in relation to—
      - (A) the amount of the patented pharmaceutical product that will be exported to the eligible importing member under the shipment; and

- (B) the labelling, marking, packaging, colouring or shaping for the patented pharmaceutical product required by subparagraph (ii);
  - (iv) the export compulsory licensee shall pay to the proprietor of the patent concerned such amount of remuneration as determined by the Director under section 72P(1) for the export compulsory licence in relation to the product;
  - (v) where there is more than one patent in relation to the patented pharmaceutical product, the export compulsory licensee shall apportion on an equal share basis among all the proprietors of the patents concerned the total amount of remuneration determined by the Director under section 72P(1);
  - (vi) subject to subparagraph (vii), the patented pharmaceutical product made under the licence shall be exported only to the eligible importing member specified in the licence; and
  - (vii) if the patented pharmaceutical product is also patented in the eligible importing member, the product shall be exported to the eligible importing member after it has granted a compulsory licence for importation of the product; and
- (c) any other terms or conditions as the Director thinks fit.
- (2) An export compulsory licence is non-exclusive.

## **72O. Notification of grant of export compulsory licences**

The Director shall as soon as practicable after the grant of an export compulsory licence under section 72M—

- (a) give notice in writing to the proprietor of the patent concerned, as identified pursuant to the information specified in the application in accordance with

section 72L(2)(a)(vi), of the grant of the licence and its terms and conditions; and

- (b) advertise in the official journal notice of the grant of the licence and its terms and conditions.

**72P. Determination of remuneration payable to proprietors of patents**

- (1) The Director shall determine the amount of remuneration payable to the proprietor of the patent concerned under section 72N(1)(b)(iv).
- (2) In determining the amount of remuneration, the Director shall take into account any advice given by the Director of Intellectual Property as regards the remuneration.
- (3) The total amount of remuneration determined by the Director under subsection (1) to be payable in respect of the patent or all the patents (if there is more than one patent in relation to the patented pharmaceutical product) shall not exceed 4% of the total purchase price for the product payable by the eligible importing member to the export compulsory licensee.
- (4) The Secretary for Commerce and Economic Development may by notice published in the Gazette vary the percentage specified in subsection (3).

**72Q. Termination of export compulsory licences**

- (1) The Director may terminate an export compulsory licence by giving notice in writing to the export compulsory licensee if he is satisfied that—
  - (a) any term or condition of the licence imposed under section 72M has been contravened; or
  - (b) any information, document or documentary evidence specified in or accompanying the application in

accordance with section 72L(2) is false, incorrect or incomplete in any material particular.

- (2) The Director shall as soon as practicable after the termination of an export compulsory licence under subsection (1)—
  - (a) give notice in writing to the proprietor of the patent concerned, as identified pursuant to the information specified in the application in accordance with section 72L(2)(a)(vi), of the termination; and
  - (b) advertise in the official journal notice of the termination.

#### **72R. References of disputes as to export compulsory licences**

- (1) Any person aggrieved by—
  - (a) the grant of an export compulsory licence;
  - (b) any term or condition of an export compulsory licence imposed under section 72M; or
  - (c) the termination of an export compulsory licence under section 72Q(1),may, within 28 days after the date of the advertisement of the notice under section 72O(b) or the date of the termination of the licence (as the case may be) or such further period as may be allowed by the court, apply to the court for a review of the grant of the licence, the terms or conditions of the licence or the termination of the licence (as the case may be).
- (2) In a review the court may—
  - (a) confirm, vary or cancel the export compulsory licence;
  - (b) confirm, vary or cancel a term or condition of the export compulsory licence imposed under section 72M;
  - (c) confirm or vary the determination of the amount of remuneration under section 72P(1);

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- (d) confirm or reverse the termination of the export compulsory licence under section 72Q(1); or
  - (e) make any other order as the court thinks fit in the circumstances.
- (3) In determining the appropriate amount of remuneration payable to the proprietor of the patent concerned, the court shall take into account all factors relevant to the circumstances, including—
- (a) the economic value to the eligible importing member of the use of the patented pharmaceutical product exported to it under the relevant export compulsory licence; and
  - (b) humanitarian or non-commercial factors relevant to the grant of the licence.
- (4) The total amount of remuneration determined by the court under subsection (3) to be payable in respect of the patent or all the patents (if there is more than one patent in relation to the patented pharmaceutical product) may exceed the maximum amount of remuneration that may be determined by the Director under section 72P(1).
- (5) The proprietor of the patent concerned may apply to the court for an order to terminate an export compulsory licence on the ground that—
- (a) any term or condition of the licence imposed under section 72M has been contravened; or
  - (b) any information, document or documentary evidence specified in or accompanying the application in accordance with section 72L(2) is false, incorrect or incomplete in any material particular.
- (6) The court may, on an application under subsection (5)—
- (a) make an order to terminate the export compulsory licence if the court is satisfied that—



- (i) any term or condition of the licence imposed under section 72M has been contravened; or
  - (ii) any information, document or documentary evidence specified in or accompanying the application in accordance with section 72L(2) is false, incorrect or incomplete in any material particular; and
- (b) make any other order as the court thinks fit in the circumstances.

**72S. Signature of documents by partnerships, companies and associations**

For the purposes of this Part—

- (a) a document signed for or on behalf of a firm shall be signed by all of its partners, by any partner stating that he signs on behalf of the firm or by any other person who satisfies the Director that he is authorized by the firm to sign the document;
- (b) a document signed for or on behalf of a body corporate shall be signed by a director or the secretary or other principal officer of the body corporate or by any other person who satisfies the Director that he is authorized by the body corporate to sign the document; and
- (c) a document signed for or on behalf of an unincorporated body or association of persons other than a firm shall be signed by any person who satisfies the Director that he is authorized by the unincorporated body or association of persons (as the case may be) to sign the document.



## Part 10

### Effects of Patent and Patent Application

*(Replaced 17 of 2016 s. 69)*

*(Format changes—E.R. 4 of 2020)*

#### 73. Prevention of direct use of invention

A patent while it is in force shall confer on its proprietor the right to prevent all third parties not having his consent from doing in Hong Kong all or any of the following—

- (a) in relation to any product which is the subject-matter of the patent—
  - (i) making, putting on the market, using or importing the product; or
  - (ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise;
- (b) in relation to any process which is the subject-matter of the patent—
  - (i) using the process; or
  - (ii) offering the process for use in Hong Kong when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent;
- (c) where the invention is a process, then in relation to any product obtained directly by means of that process—
  - (i) putting on the market, using or importing the product; or

- (ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise.

*[cf. 1992 No. 1 s. 40 Eire]*

#### **74. Prevention of indirect use of invention**

- (1) A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply in Hong Kong a person, other than a party entitled to work the patented invention, with means, relating to an essential element of that invention, for putting it into effect, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect in Hong Kong.
- (2) Subsection (1) shall not apply when the means referred to therein are staple commercial products, unless the supply or offering is made for the purpose of inducing the person supplied or, as the case may be, to whom the offer is made to commit acts which the proprietor of a patent is enabled to prevent by virtue of section 73.
- (3) Persons performing acts referred to in section 75(a), (b) or (c) shall not be considered to be parties entitled to work an invention pursuant to subsection (1).
- (4) For the purposes of subsection (1)—
  - (a) reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 69; and
  - (b) a person who by virtue of section 30, 35, 39(4), 41(4) or (5), 83, 106(4) or 126(5) (including, in the case of section 41, that section as applied by section 127) is entitled to do an act in relation to the invention without

it constituting an infringement of a patent for the invention shall, so far as concerns that act, be treated as a person entitled to work the invention.

*[cf. 1992 No. 1 s. 41 Eire]*

## 75. Limitation of effect of patent

The rights conferred by a patent shall not extend to—

- (a) acts done privately for non-commercial purposes;
- (b) acts done for experimental purposes relating to the subject-matter of the relevant patented invention;
- (c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription issued by a *registered medical practitioner* or *registered dentist* (which terms bear the meaning assigned to them by section 2 of the Medical Registration Ordinance (Cap. 161) and section 2(1) of the Dentists Registration Ordinance (Cap. 156) respectively) or acts concerning the medicine so prepared;
- (d) the use of the invention which is the subject of the patent—
  - (i) on board vessels registered in any of the Paris Convention countries or WTO member countries, territories or areas, other than Hong Kong; or
  - (ii) in the body of such vessels, or in the machinery, tackle, gear or other accessories of such vessels, when such vessels temporarily or accidentally enter the territorial waters of Hong Kong, but only if the invention is used in such waters exclusively for the needs of the vessel;

- (e) the use of the invention which is the subject of the patent in the construction or operation of—
  - (i) aircraft, hovercraft or land vehicles of Paris Convention countries or WTO member countries, territories or areas, other than Hong Kong; or
  - (ii) such aircraft, hovercraft or land vehicle accessories, when such aircraft, hovercraft or land vehicles temporarily or accidentally enter Hong Kong;
- (f) the use of an aircraft to which section 10(4) of the Civil Aviation Ordinance (Cap. 448) applies which has lawfully entered or is lawfully crossing Hong Kong (including the air space above it and its territorial waters), or the importation into Hong Kong, or the use or storage there, of any part or accessory for such an aircraft.

*[cf. 1992 No. 1 s. 42 Eire]*

## **76. Extent of invention**

- (1) For the purposes of this Ordinance—
  - (a) an invention in respect of which an application for a patent has been filed shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application, as interpreted by the description and any drawings contained in that specification;
  - (b) an invention for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the patent, as interpreted by the description and any drawings contained in that specification,

and the extent of the protection conferred by a patent or an application for a patent shall be determined accordingly.

- (2) Where more than one invention is specified in any such claim in relation to a patent or an application for a patent, each invention may have a different date of priority for the purposes of this Ordinance.
- (3) Subsection (1) should not be interpreted in either of the following senses, namely—
  - (a) in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims, on the one hand; or
  - (b) in the sense that the claims serve only as a guideline and that the actual protection conferred by a patent may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated, on the other hand,

but rather is to be interpreted as defining a position between these extremes which combines a fair protection for the proprietor of the patent or the application for a patent with a reasonable degree of certainty for third parties.

*[cf. 1977 c. 37 s. 125 U.K.]*

## **77. Disclosure of invention**

The application for and specification of a patent for an invention shall disclose the invention to which it relates in a manner sufficiently clear and complete for it to be performed by a person skilled in the art.

*[cf. EPC Art. 83]*

**78. Claims**

- (1) The claims contained in the specification of a patent application or of a patent must—
  - (a) define the matter for which protection is sought or given;
  - (b) be clear and concise;
  - (c) be supported by the description in the specification; and
  - (d) relate to 1 invention or to a group of inventions that are so linked as to form a single inventive concept.
- (2) The rules may provide for the circumstances under which a group of inventions are to be regarded as being so linked as to form a single inventive concept.
- (3) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a patent application filed, or a patent the application for which is filed, before that date.

*(Replaced 17 of 2016 s. 70)*

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Editorial Note:

\* Commencement date: 19 December 2019.

**79. The abstract**

The abstract shall only serve for use as technical information; it may not be taken into account for any other purpose and in particular it may be used neither for the purpose of interpreting the scope of the protection given nor for the purpose of applying section 9B(3).

*(Amended 17 of 2016 s. 71)*

Patents Ordinance

Part 10

10-14

Section 79

Cap. 514

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*[cf. EPC Art. 85; 1992 No. 1 s. 22(1) Eire]*

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## Part 11

### Infringement

*(Replaced 17 of 2016 s. 72)*

*(Format changes—E.R. 4 of 2020)*

#### 80. Proceedings for infringement of patent

- (1) Subject to this Part and section 129(1), civil proceedings may be brought in the court by the proprietor of a patent in respect of any act of infringement which he alleges he is entitled under sections 73 to 75 to prevent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made— *(Amended 17 of 2016 s. 73)*
  - (a) for an injunction restraining the defendant from any apprehended act of such infringement;
  - (b) for an order requiring the defendant to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which the product is inextricably comprised;
  - (c) for damages in respect of the infringement;
  - (d) for an account of the profits derived by the defendant from the infringement;
  - (e) for a declaration that the patent is valid and has been infringed by the defendant.
- (2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.
- (3) Subject to this Part, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court shall apply the principles applied



by the court in relation to that kind of relief immediately before the commencement\* of this Part.

*[cf. 1977 c. 37 s. 61 U.K; 1992 No. 1 s. 47 Eire]*

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Editorial Note:

\* Commencement date: 27 June 1997.

### **81. Restrictions on recovery of damages for infringement**

- (1) In proceedings for the infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed.
- (2) For the purposes of subsection (1) a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented” or “專利” or “取得專利”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.
- (3) In proceedings for infringement of a patent the court may, if it thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during the further period specified in section 39(4) or 126(5), as the case may be, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.  
*(Amended 17 of 2016 s. 74)*
- (4) Where an amendment of the specification of a patent has been allowed under this Ordinance, no damages shall be awarded in any proceedings for an infringement of the patent committed before the date of the decision to allow the amendment or of the recording of the amendment pursuant to section 43(2), as the case may be, unless the court is satisfied

that the specification of the patent as originally published was framed in good faith and with reasonable skill and knowledge.

- (5) Without limiting the effect of subsection (4), where an order has been made by the court under section 46(5) allowing an amendment of the specification of a patent, no damages shall be awarded in any proceedings for an infringement of the patent committed after the date on which the order is made and before a copy of the order is filed with the Registrar for the purposes of section 46(7). (*Amended 17 of 2016 s. 74*)

*[cf. 1977 c. 37 s. 62 U.K.]*

## **82. Relief for infringement of partially valid patent**

- (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.
- (2) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of damages or costs, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court as to costs and as to the date from which damages should be reckoned.
- (3) As a condition of relief under subsection (1) or (2) the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 102, and such an application may be made whether or not all other issues in the proceedings have been determined.

[*cf.* 1977 c. 37 s. 63 U.K.]

**83. Right to continue use begun before priority date**

- (1) A person has the rights specified in subsection (2) if the person, in Hong Kong and before the material date of a patent—
  - (a) does in good faith an act that would constitute an infringement of the patent if the patent were in force; or
  - (b) makes in good faith effective and serious preparations to do such an act. (*Replaced 17 of 2016 s. 75*)
- (2) The rights referred to in subsection (1) are—
  - (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (1);
  - (b) if such act was done or preparations had been made to do it in the course of a business—
    - (i) in the case of an individual—
      - (A) the right to assign the right to do it or to transmit such right on death; or
      - (B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;
    - (ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.
- (3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

- (4) Where a patented product is disposed of to another in exercise of a right conferred by subsection (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by a registered proprietor of the patent.

*[cf. 1992 No. 1 s. 55 Eire]*

#### **84. Certificate of contested validity of patent**

- (1) If in any proceedings before the court the validity of a patent to any extent is contested and that patent is found by the court to be wholly or partially valid, the court may certify the finding and the fact that the validity of the patent was so contested.
- (2) Where a certificate is granted under this section, then if, in any subsequent proceedings before the court for infringement of the patent concerned or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent that party shall, unless the court otherwise directs, be entitled to his costs on the *indemnity basis* within the meaning of that term as appearing in Order 62 rule 28 of the Rules of the High Court (Cap. 4 sub. leg. A) (other than the costs of any appeal in the subsequent proceedings). (*Amended 25 of 1998 s. 2; E.R. 4 of 2020*)

*[cf. 1977 c. 37 s. 65 U.K.]*

#### **85. Proceedings for infringement by a co-owner**

- (1) In the application of section 73 to a patent of which there are 2 or more joint proprietors the reference to the proprietor shall be construed—
- (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 54 or any

agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and

- (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 54 or any such agreement, is or are the proper person or persons to give the requisite consent.
- (2) One of 2 or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings, but any of the others made a defendant in pursuance of this subsection shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

*[cf. 1977 c. 37 s. 66 U.K.]*

#### **86. Proceedings for infringement by exclusive licensee**

- (1) Subject to this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in the provisions of this Ordinance relating to infringement shall be construed accordingly.
- (2) In awarding damages or granting any other relief in any such proceedings the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

- (3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant in pursuance of this subsection shall not be liable for costs or expenses unless he enters an appearance and takes part in the proceedings.

*[cf. 1977 c. 37 s. 67 U.K.]*

### **87. Effect of non-registration on infringement proceedings**

Where a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent by virtue of a transaction, instrument or event to which section 52 applies, then unless—

- (a) an application for registration of the prescribed particulars of the transaction, instrument or event is made before the end of the period of 6 months beginning with its date; or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the patent occurring after the date of the transaction, instrument or event and before the prescribed particulars of the transaction, instrument or event are registered.

*[cf. 1977 c. 37 s. 68 U.K.]*

### **88. Infringement of rights conferred by publication of application for standard patent**

- (1) Subject to this section, where an application for a standard patent is published the applicant shall have, as from the date of publication and until the grant of the standard patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to

- bring proceedings in the court for damages in respect of any act which would have infringed the patent.
- (2) Further to subsection (1), references in sections 73, 74, 75, 80, 81 and 85 to 87—
- (a) to a patent and the proprietor of a patent, as they relate to a standard patent, shall be respectively construed as including references to the application for the standard patent and the applicant; and
- (b) to a patent being in force, being granted, being valid or existing, as they relate to a standard patent, shall be construed accordingly, and for this purpose, for a standard patent (R), the reference in section 81(3) to section 39(4) shall be read as a reference to section 33(4). (*Amended 17 of 2016 s. 76*)
- (3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—
- (a) after the standard patent has been granted; and
- (b) if the act would, if the patent had been granted on the publication date of the request to record (for a standard patent (R)) or the publication date of the patent application (for a standard patent (O)), have infringed not only the standard patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the published request to record or published application. (*Amended 17 of 2016 s. 76*)
- (4) Section 81(4) shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application for a standard patent as published that a patent would be granted conferring



on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court finds that it would not have been reasonable, it shall reduce the damages to such an amount as it thinks just.

- (5) An applicant shall be deemed never to have had the rights set out in subsection (1) if the application for a standard patent is refused or withdrawn or is deemed to be withdrawn.

*[cf. 1977 c. 37 s. 69 U.K.]*

### **89. Remedy for groundless threats of infringement proceedings**

- (1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats for any such relief as is mentioned in subsection (3).
- (2) Subject to section 89A, in any such proceedings the plaintiff shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed. *(Amended 17 of 2016 s. 77)*
- (3) The said relief is—
- (a) a declaration to the effect that the threats are unjustifiable;
  - (b) an injunction against the continuance of the threats; and
  - (c) such damages, if any, as have been sustained by the plaintiff by reason of the threats.
- (4) Proceedings may not be brought under this section as regards a threat to bring proceedings for an infringement alleged to



consist of making a product for putting on the market or of using a process.

- (5) For the purposes of this section a notification of the existence of a patent does not of itself constitute a threat of proceedings.
- (6) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to proceedings brought under subsection (1) in respect of a threat that is made before that date. (*Added 17 of 2016 s. 77*)

[*cf. 1977 c. 37 s. 70 U.K.*]

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Editorial Note:

\* Commencement date: 19 December 2019.

### **89A. Circumstances under which plaintiff not entitled to relief claimed**

- (1) Where a threat alleged an infringement of a standard patent, the plaintiff in the relief proceedings is not entitled to the relief claimed if—
  - (a) the defendant proves that the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent; and
  - (b) the plaintiff fails to prove that the patent is invalid in the relevant respect.
- (2) Where a threat alleged an infringement of a short-term patent in respect of which a certificate of substantive examination has not been issued, the plaintiff in the relief proceedings is not entitled to the relief claimed if the defendant proves that—

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- (a) the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent;
  - (b) the patent is valid in the relevant respect; and
  - (c) the defendant has complied with any access request for patent information made by the plaintiff before commencing the relief proceedings.
- (3) For subsection (2)(c)—
- (a) a request is taken to be an access request only if it is made in writing and is accompanied by a copy of this section;
  - (b) the defendant is taken to have complied with an access request only if the defendant provides the patent information as at the request date to the plaintiff, without charge, within 14 days from the request date or any longer period agreed to by the plaintiff; and
  - (c) the defendant is taken to have complied with an access request in relation to any patent information that the defendant has already provided to the plaintiff on or before the request date.
- (4) Where a threat alleged an infringement of a short-term patent in respect of which a certificate of substantive examination has been issued, the plaintiff in the relief proceedings is not entitled to the relief claimed if—
- (a) the defendant proves that the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent; and
  - (b) the plaintiff fails to prove that the patent is invalid in the relevant respect.
- (5) This section only applies to relief proceedings brought in respect of a threat that is made on or after the commencement

date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016).

(6) In this section—

**patent information** (專利資料), for a short-term patent, means—

- (a) the number assigned by the Registrar to the certificate of grant issued in respect of the patent under section 118(2)(b); and
- (b) a copy of any requested amendment to the specification of the patent that has been filed with the Registrar or the court, but not yet been published;

**relief proceedings** (濟助法律程序) means any proceedings brought by a person under section 89(1) in respect of a threat;

**request date** (請求日期) means the date of delivery of a request;

**threat** (威脅) means a threat referred to in section 89(1) to bring proceedings for an infringement of a patent.

*(Added 17 of 2016 s. 78)*

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Editorial Note:

\* Commencement date: 19 December 2019.

## 90. Declaration as to non-infringement

Without prejudice to the court's jurisdiction to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown that—

- (a) that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration

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claimed, and has furnished him with full particulars in writing of the act in question; and

- (b) the proprietor has refused or failed to give any such acknowledgment.

*[cf. 1977 c. 37 s. 71 U.K.]*

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## Part 12

### Revocation of Patents

*(Replaced 17 of 2016 s. 79)*

*(Format changes—E.R. 4 of 2020)*

*(Cross-heading repealed 17 of 2016 s. 80)*

#### **91. Power to revoke patents on application**

- (1) Subject to this Ordinance, the court may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say—
  - (a) that the invention is not a patentable invention;
  - (b) that the patent was granted to a person who was not entitled to be granted that patent;
  - (c) that the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art;
  - (d) that the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application filed under section 55(4) or as mentioned in section 22, 37Z or 116, in the earlier application for a patent as filed;
  - (e) that the protection conferred by the patent has been extended by an amendment of the application for the patent or the specification of the patent which is invalid;
  - (f) that the patent is one of 2 patents that—
    - (i) are granted for the same invention made by the same inventor; and

- (ii) have the same material date; (*Replaced 17 of 2016 s. 81*)
- (g)-(h) (*Repealed 17 of 2016 s. 81*)
- (i) in the case of a standard patent (R), that the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office.
- (2) An order under this section may be—
- (a) an order for the unconditional revocation of the patent; or
- (b) where the court determines that one of the grounds mentioned in subsection (1)(a), (b), (c), (d), (e) and (f) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 102 to the satisfaction of the court.
- (3) (*Repealed 17 of 2016 s. 81*)
- (4) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a patent the application for which is filed before that date. (*Added 17 of 2016 s. 81*)

(*Amended 17 of 2016 s. 81*)

[*cf. 1977 c. 37 s. 72 U.K.; EPC Art. 138*]

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Editorial Note:

\* Commencement date: 19 December 2019.

## 92. Application for revocation

- (1) An application for the revocation of a patent on the ground

mentioned in section 91(1)(b)—

- (a) may be made only by a person found by the court in an action for a declaration or on a reference under section 55 to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked, or in case more than one person is found to be so entitled, by all those persons; and
  - (b) notwithstanding paragraph (a), may not be made if the action for a declaration was commenced or the reference under section 55 was made after the end of the period of 2 years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.
- (2) On an application for the revocation of a patent on the ground mentioned in section 91(1)(f), the court shall not make an order for revocation unless the proprietor of each patent has been allowed an opportunity of making observations and of amending the specification of the patent, and if the proprietors fail to satisfy the court that there are not 2 patents in respect of the same invention made by the same inventor, or to amend one or both specifications so as to prevent there being 2 patents in respect of the same invention made by the same inventor, the court shall revoke the patent having the shorter remaining period in force under section 39(1) or 126(1) (as may be appropriate) or, if both patents have the same remaining period in force, shall revoke any one of the patents. (*Amended 17 of 2016 s. 82*)
  - (3) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a patent the

application for which is filed before that date. *(Added 17 of 2016 s. 82)*

*[cf. 1977 c. 37 s. 72 U.K.]*

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Editorial Note:

\* Commencement date: 19 December 2019.

*(Cross-heading repealed 17 of 2016 s. 83)*

**93-97.** *(Repealed 17 of 2016 s. 83)*

*(Cross-heading repealed 17 of 2016 s. 83)*

**98-99.** *(Repealed 17 of 2016 s. 83)*

*(Cross-heading repealed 17 of 2016 s. 83)*

**100.** *(Repealed 17 of 2016 s. 83)*

*(Cross-heading repealed 17 of 2016 s. 84)*

**101. Proceedings in which validity of patent may be put in issue**

- (1) Subject to the following provisions of this section, the validity of a patent may be put in issue—
  - (a) by way of defence, in proceedings for infringement of the patent under section 80 or, in the case of a standard patent, in proceedings under section 88 for infringement of rights conferred by the publication of an application;
  - (b) in proceedings under section 89;
  - (c) in proceedings in which a declaration in relation to the patent is sought under section 90;
  - (d) in proceedings before the court under section 91 for the revocation of the patent;



- (e) in proceedings under section 72; and (*Amended 17 of 2016 s. 85*)
  - (f) in proceedings commenced under section 129(1)(b). (*Added 17 of 2016 s. 85*)
- (2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Ordinance or otherwise) seeking only a declaration as to the validity or invalidity of a patent.
- (3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 91 or otherwise) are the grounds on which the patent may be revoked under that section.
- (4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground mentioned in section 91(1)(b) unless—
- (a) it has been determined—
    - (i) in entitlement proceedings commenced by that person; or
    - (ii) in the proceedings in which the validity of the patent is in issue,
 

that the patent should have been granted to him and not some other person; and
  - (b) except in the case at paragraph (a)(i)—
    - (i) the proceedings in which the validity of the patent is in issue are commenced before the end of 2 years beginning with the date of the grant of the patent; or
    - (ii) it is shown that any person registered as a proprietor of the patent knew at the time of the

grant or of the transfer of the patent to him that he was not entitled to the patent.

- (5) Where the validity of a patent is put in issue by way of defence or counterclaim the court shall, if it thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a).
- (6) In subsection (4) *entitlement proceedings* (享有權法律程序), in relation to a patent, means a reference under section 55(1) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted.

[*cf.* 1977 c. 37 s. 74 U.K.]

**101A. Powers of court in validity proceedings in relation to short-term patents**

- (1) Without limiting section 101, the court may, in any validity proceedings in relation to a short-term patent, exercise any of its powers under this section.
- (2) If the short-term patent has not been subjected to a substantive examination, the court may—
  - (a) direct the proprietor of the patent to request the Registrar to carry out the examination; and
  - (b) stay the proceedings pending the outcome of the examination.
- (3) If the short-term patent is being subjected to a substantive examination, the court may—
  - (a) direct the examination to be suspended; or
  - (b) stay the proceedings pending the outcome of the examination.

- (4) If the substantive examination of a short-term patent has been suspended under subsection (3)(a), the court may, after the validity proceedings have been disposed of, order—
- (a) the examination to be resumed, on the conditions that the court thinks fit; or
  - (b) the examination to be terminated.

- (5) In this section—

**validity proceedings** (有效性法律程序) means any proceedings in which the validity of a patent is put in issue under section 101(1).

*(Added 17 of 2016 s. 86)*

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## Part 13

### General Provisions on Amendment of Patents and Patent Applications

*(Replaced 17 of 2016 s. 87)*

*(Format changes—E.R. 4 of 2020)*

#### **102. Amendment of patent in infringement or revocation proceedings**

- (1) In any proceedings before the court in which the validity of a patent is put in issue the court may, subject to section 103(3), allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court thinks fit. *(Amended 17 of 2016 s. 88)*
- (2) A person may give notice to the court of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.
- (3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.
- (4) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

*[cf. 1977 c. 37 s. 75 U.K.]*

#### **103. Amendments of applications and patents not to include added**

**matter**

- (1) An application for a patent—
  - (a) which is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and
  - (b) which discloses additional matter, that is, matter extending beyond that disclosed in the earlier application as filed, or the application for the patent as filed,is invalid to the extent that it extends the subject-matter disclosed in the earlier application as filed, or the application for the patent as filed.
- (2) Any amendment of an application for a patent is invalid to the extent that it extends the subject-matter disclosed in the application as filed.
- (3) Any amendment of the specification of a patent is invalid to the extent that it—
  - (a) extends the subject-matter disclosed in the application as filed; or
  - (b) extends the protection conferred by the patent.

*(Amended 17 of 2016 s. 89)*

*[cf. 1977 c. 37 s. 76 U.K.]*

## Part 14

### Language of Proceedings and Authentic Text

*(Replaced 17 of 2016 s. 90)*

*(Format changes—E.R. 4 of 2020)*

#### 104. Language of proceedings before Registrar

- (1) An application for a patent must be filed in one of the official languages.
- (2) Except as otherwise provided in rules made for the purposes of this section, and notwithstanding section 5 of the Official Languages Ordinance (Cap. 5), the official language in which an application for a patent is filed shall be used as the language of the proceedings in all proceedings before the Registrar concerning the application or the resulting patent.
- (3) Where a designated patent application in respect of an invention is in one of the official languages, nothing in this section shall be construed as requiring an application for a standard patent (R) in respect of that invention to be filed in the same official language. *(Amended 17 of 2016 s. 91)*
- (4) Rules may be made—
  - (a) requiring, in respect of any document filed or to be filed with the Registrar in proceedings under this Ordinance, the filing of a translation of the document into the language of the proceeding or into one or both official languages;
  - (b) providing for the use by any person in oral proceedings before the Registrar, of a language other than the language of the proceedings;

- (c) in respect of documents to be used for the purpose of evidence in proceedings before the Registrar and which are in a language other than the language of the proceedings, providing for the filing of the document in that other language and the filing of a translation of the document into the language of the proceedings or into one of the official languages;
  - (d) in respect of information provided or to be provided to the Registrar and which is to be entered in the register, requiring the provision of that information in both official languages;
  - (e) specifying, in cases of entries which are made in the register in both official languages, which entry is to be authentic.
- (5) Rules made for the purposes of subsection (4)(a) or (d)—
- (a) may specify periods within which translations of documents into the language of the proceedings or into the official languages are to be filed or within which information in the official languages is to be provided;
  - (b) may provide for extensions, upon application by a party to the proceedings, of such periods, and may require that applications for such extension shall be subject to the payment of a penalty fee.

### **105. Authentic text**

Except as provided in section 106, the text of a patent or an application for a patent in the language of the proceedings before the Registrar shall be the authentic text in any proceedings before the Registrar or a court.

*[cf. EPC Art. 70(1)]*

### **106. Authentic text of standard patent (R) and standard patent (R)**

**application**

*(Amended 17 of 2016 s. 92)*

(1) Subject to subsection (2), the text of the specification of a corresponding designated patent or corresponding designated patent application in the language of the proceedings before the designated patent office shall be the authentic text of the specification of the standard patent (R) or standard patent (R) application respectively for the purposes of any proceedings under this Ordinance relating to the standard patent (R) or standard patent (R) application before the Registrar or a court.  
*(Amended 17 of 2016 s. 92)*

(2) If—

- (a) the language of the proceedings before the designated patent office is other than one of the official languages; and
- (b) the corresponding designated patent or designated patent application as translated into one of the official languages confers protection which is narrower than that conferred by it in the language of the proceedings before the designated patent office,

then a translation into one of the official languages of the specification of the corresponding designated patent or of the claims of the corresponding designated patent application shall be treated as the authentic text of the specification of the standard patent (R) or of the claims of the standard patent (R) application respectively for the purpose of any proceedings under this Ordinance, other than proceedings for the revocation of the patent. *(Amended 17 of 2016 s. 92)*

(3) If any translation such as is mentioned in subsection (2) results in a designated patent or designated patent application conferring the narrower protection, the proprietor of or applicant for the standard patent (R) may file a corrected



translation with the Registrar and, if he pays the prescribed fee within the prescribed period, the Registrar shall publish it, but— (*Amended 17 of 2016 s. 92*)

- (a) any payment for any use of the invention which (apart from section 69) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section;
- (b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent has been granted,

unless before that use or the doing of the act the corrected translation has been published by the Registrar or the proprietor or applicant has sent the corrected translation by post or delivered it to the public officer who made use or authorized the use of the invention or, as the case may be, to the person alleged to have done that act.

- (4) Where a correction of a translation is published under subsection (3) and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 69) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by section 41(4) and (5), and section 41(6) shall apply accordingly.
- (5) In this section ***language of the proceedings before the designated patent office*** (在指定專利當局進行的法律程序的語文), in relation to a corresponding designated patent or corresponding designated patent application, means the

language in which proceedings relating to that patent or application are to be conducted before the designated patent office.

*[cf. 1977 c. 37 s. 80 U.K.]*

**107. Amendment to patent or patent application to be in authentic text**

An amendment to the specification of a patent or to an application for a patent may only be made in the language of the authentic text of the patent or application.

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## Part 15

### Short-term Patents

*(Replaced 17 of 2016 s. 93)*

*(Format changes—E.R. 4 of 2020)*

*(Cross-heading repealed 17 of 2016 s. 94)*

**108.** *(Repealed 17 of 2016 s. 94)*

*(Cross-heading repealed 17 of 2016 s. 95)*

#### Division 1—Novelty and Priority

*(Added 17 of 2016 s. 96)*

#### **108A. Interpretation of Division 1 of Part 15**

In this Division—

***Hong Kong application*** (香港申請) means a standard patent (O) application or short-term patent application;

***non-Hong Kong application*** (非香港申請) means an application for a patent or other protection in or for a Paris Convention country or WTO member country, territory or area, other than a patent application under this Ordinance.

*(Added 17 of 2016 s. 96)*

#### **109. Non-prejudicial disclosure**

For the purposes of section 9B, a disclosure of an invention shall not be taken into consideration if it occurred no earlier than 6 months before the filing of the short-term patent application and if it was due to, or in consequence of— *(Amended 17 of 2016 s. 97)*

- (a) an evident abuse in relation to the applicant or a proprietor of the invention for the time being; or
- (b) the fact that the applicant or a proprietor of the invention for the time being had displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to Hong Kong,

but paragraph (b) shall apply only if the short-term patent application as filed contains a statement to the effect that the invention had been so displayed and contains the prescribed written evidence in support of the statement.

*(Amended 17 of 2016 s. 97)*

*[cf. EPC Art. 55]*

*(Cross-heading repealed 17 of 2016 s. 98)*

## **110. Priority right**

- (1) Subsection (1A) applies if a person has filed—
  - (a) a non-Hong Kong application for an invention; or
  - (b) a Hong Kong application for an invention. *(Replaced 17 of 2016 s. 99)*
- (1A) The person or the person's successor in title enjoys, for the purpose of filing a subsequent short-term patent application for the same invention, a right of priority for the period of 12 months after the date of filing of the first non-Hong Kong application or Hong Kong application, subject to compliance with the prescribed conditions. *(Added 17 of 2016 s. 99)*
- (2) For the purposes of subsection (1A)— *(Amended 17 of 2016 s. 99)*

- (a) every filing of a non-Hong Kong application that is equivalent to a regular national filing under the domestic legislation of the place in or for which the application is filed, or under bilateral or multilateral agreements, is to be recognized as giving rise to a right of priority;
- (b) a subsequent non-Hong Kong application for the same subject-matter as in a previous first non-Hong Kong application and filed in or for the same place is to be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority; and
- (c) where pursuant to paragraph (b) a subsequent non-Hong Kong application is considered as a first application, the previous non-Hong Kong application may not later serve as a basis for claiming a right of priority,

and in this subsection, ***regular national filing*** (正規國家提交) means any filing that establishes the date on which the application was filed, whatever may be the outcome of the application.

- (3) For the purposes of subsection (1A)— (*Amended 17 of 2016 s. 99*)
  - (a) every regular filing of a Hong Kong application is to be recognized as giving rise to a right of priority in relation to other applications under this Part;
  - (b) a subsequent Hong Kong application for the same subject-matter as in a previous first Hong Kong application is to be considered as the first application for the purposes of determining priority if, and only

if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority; and

- (c) where pursuant to paragraph (b) a subsequent Hong Kong application is considered as a first application, the previous Hong Kong application may not later serve as a basis for claiming a right of priority,

and in this subsection *regular filing of a Hong Kong application* (香港申請的正規提交) means any filing that establishes the date on which the Hong Kong application was filed, whatever may be the outcome of the application.

- (3A) A right of priority that arises as a result of a non-Hong Kong application or Hong Kong application for an invention may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1A) to a person's successor in title shall be construed accordingly. *(Added 2 of 2001 s. 8)*

- (4) *(Repealed 17 of 2016 s. 99)*

*(Amended 17 of 2016 s. 99)*

*[cf. EPC Art. 87; 1992 No. 1 s. 25 Eire]*

### **110A. Restoration of priority right**

- (1) This section applies if—
- (a) a person files a non-Hong Kong application or Hong Kong application for an invention; and
- (b) the person or the person's successor in title files a subsequent short-term patent application for the same invention within 2 months after the expiry of the 12-month period referred to in section 110(1A).

- (2) The applicant of the subsequent short-term patent application may apply to the Registrar for restoring the priority right of the patent application.
- (3) The application for restoring the priority right (*restoration application*) must be made in the prescribed manner before the earlier of the following—
  - (a) the end of 2 months after the expiry of the 12-month period;
  - (b) the date on which preparations for publication under section 118(2) of the short-term patent granted because of the subsequent short-term patent application are completed.
- (4) A restoration application is to be regarded as being made only if the prescribed fee for the application is paid.
- (5) The Registrar may approve a restoration application if the Registrar is satisfied that the applicant failed to file the subsequent short-term patent application within the 12-month period even though the applicant had taken all reasonable care required by the circumstances.

*(Added 17 of 2016 s. 100)*

### **111. Claiming priority**

- (1) An applicant for a short-term patent desiring to take advantage of the priority of a previous application must file, in the prescribed manner and within the prescribed time, a statement of priority and a copy of the previous application.  
*(Amended 17 of 2016 s. 101)*
- (2) Multiple priorities may be claimed in respect of a short-term patent application, notwithstanding the fact that they originated in different countries, and where appropriate, multiple priorities may be claimed for any one claim.



- (3) Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.
- (4) If one or more priorities are claimed in respect of a short-term patent application, the right of priority shall cover only those elements of the short-term patent application which are included in the application or applications whose priority is claimed.
- (5) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted if the documents of the previous application as a whole specifically disclosed such elements.
- (6) Subject to section 127C(3)(a), where a statement of priority is filed in accordance with this section, the applicant shall for the purpose of proceedings before the Registrar be deemed to be entitled to enjoy the right of priority shown in the statement. *(Amended 17 of 2016 s. 101)*

*[cf. EPC Art. 88]*

## **112. Effect of priority right**

- (1) The right of priority shall have the effect that the date of priority of the previous application claimed under section 111 shall be regarded as being the date of priority of the short-term patent application for the purposes of this Ordinance. *(Amended 17 of 2016 s. 102)*
- (2) Where a short-term patent application is filed and the priority of a previous application is claimed under section 111, then, notwithstanding anything contained in this Ordinance, the short-term patent application and any short-term patent granted in pursuance of it shall not be invalidated by reason only of the fact that any subject-matter disclosed in the



previous application was made available to the public at any time after the date of filing of the previous application.

*[cf. EPC Art. 89]*

## **Division 2—Applications for Short-term Patents**

*(Added 17 of 2016 s. 103)*

### **112A. Application may be made alone or jointly**

- (1) An application for a short-term patent for an invention may be made by a person alone or jointly with any other person.
- (2) For the purpose of proceedings before the Registrar, the applicant is to be regarded as being entitled to exercise the right to the short-term patent.

*(Added 17 of 2016 s. 103)*

*(Cross-heading repealed 17 of 2016 s. 104)*

### **113. Requirements of short-term patent application**

- (1) A short-term patent application must—
  - (a) be signed by the applicant; and
  - (b) be filed with the Registrar in the prescribed manner.  
*(Replaced 17 of 2016 s. 105)*
- (1A) A short-term patent application must contain—
  - (a) a request for the grant of a short-term patent;
  - (b) a specification that provides for—
    - (i) a description of the invention which is the subject of the application;
    - (ii) one or more claims but not exceeding 2 independent claims; and

- (iii) any drawing referred to in the description or the claim or claims;
  - (c) an abstract;
  - (d) a search report in relation to the invention;
  - (e) if the applicant desires to claim non-prejudicial disclosure of the invention under section 109(b), the statement and evidence required under section 109;
  - (f) if the applicant desires to take advantage of the priority of a previous application, a statement of priority and a copy of the previous application required under section 111(1);
  - (g) if applicable, a request for deferring the grant of a short-term patent under section 119; and
  - (h) if the invention requires for its performance the use of a micro-organism, information on the availability of samples of the micro-organism to the public (if any).  
*(Added 17 of 2016 s. 105)*
- (2) A short-term patent application—
- (a) must state the name and address of the applicant;
  - (b) must—
    - (i) identify each inventor of the invention; and
    - (ii) specify the last known address of each inventor (unless the inventor is also the applicant);
  - (c) if the applicant is not an inventor, must contain a statement in the specified form indicating how the applicant becomes entitled to apply for a short-term patent for the invention; and
  - (d) must specify an address in Hong Kong for service of documents. *(Replaced 17 of 2016 s. 105)*

- (3) Every such application shall also comply with the requirements of this Ordinance as to the provision of information in, or the translation of documents into, one or both official languages.
- (4) Rules may— (*Amended 17 of 2016 s. 105*)
- (a) provide that a short-term patent application shall or may contain a title of the invention and a designation of the classification of the invention; and (*Amended 17 of 2016 s. 105*)
  - (b) provide for the requirements of a short-term patent application for an invention that involves nucleotide and amino acid sequences. (*Replaced 17 of 2016 s. 105*)
- (5) A filing fee and an advertisement fee shall be payable within 1 month after the earliest filing with the Registrar of any part of the application, and if either fee is not paid within that period or the grace period provided in the rules, the application is to be regarded as being withdrawn. (*Amended 17 of 2016 s. 105*)
- (6) (*Repealed 17 of 2016 s. 105*)
- (7) The foregoing provisions shall not prevent any application being initiated by documents complying with section 114(3). (*Amended 17 of 2016 s. 105*)
- (7A) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a short-term patent application filed with the Registrar before that date. (*Added 17 of 2016 s. 105*)
- (8) In this section **search report** (查檢報告) means a report—
- (a) by a prescribed searching authority of a search undertaken by that authority as to the prior art in

- relation to the invention, based on the claims and having due regard to the description and drawings (if any); and
- (b) which contains the prescribed information.

*[cf. 1992 No. 1 s. 18 Eire; EPC Art. 78]*

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Editorial Note:

\* Commencement date: 19 December 2019.

#### **114. Date of filing of short-term patent application**

- (1) For the purpose of according a date of filing to a short-term patent application, the Registrar must examine the application to ascertain—
- (a) whether it complies with the requirement specified in subsection (3) (*minimum requirement*); and
- (b) whether the prescribed filing fee and advertisement fee have been paid in due time.
- (2) Subject to section 114A(3), the date of filing of a short-term patent application is the earliest date on which the application complies with the minimum requirement.
- (3) The requirement specified for subsection (1)(a) is that the documents filed for the short-term patent application contain—
- (a) an indication that a short-term patent is sought;
- (b) information identifying the applicant; and
- (c) either one of the following—
- (i) something that appears to be a description of an invention;
- (ii) a reference to an earlier specified application made by the applicant or the applicant's predecessor in title, together with a statement indicating that a description and the drawings (if any) of the

invention, which is the subject of the short-term patent application, are completely contained in the specified application.

- (4) If a date of filing cannot be accorded to a short-term patent application because of deficiencies in the application as regards the minimum requirement, the Registrar must give the applicant an opportunity to correct them in accordance with the rules.
- (5) If any deficiencies referred to in subsection (4) are not corrected within the prescribed time, the application must not be dealt with as a short-term patent application.
- (6) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a short-term patent application filed with the Registrar before that date.
- (7) In subsection (3)(c)(ii)—  
*specified application* (指明申請) means—
  - (a) an application for a patent or other protection in or for a Paris Convention country or WTO member country, territory or area, other than a patent application under this Ordinance;
  - (b) a standard patent (O) application; or
  - (c) a short-term patent application.

*(Replaced 17 of 2016 s. 106)*

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Editorial Note:

\* Commencement date: 19 December 2019.

#### **114A. Filing of missing description or missing drawing**

- (1) The Registrar may, by written notice, require the applicant of a short-term patent application to file a missing description

- or missing drawing in the prescribed manner and within the prescribed time.
- (2) The applicant may also, on the applicant's own initiative, file a missing description or missing drawing in the prescribed manner and within the prescribed time.
  - (3) If the short-term patent application has been accorded a date of filing in accordance with section 114(2), then on the filing of a missing description or missing drawing, the date of filing is to be changed to the date on which the description or drawing is filed.
  - (4) The Registrar must, by written notice, inform the applicant of the change of the date of filing.
  - (5) Subsection (3) does not apply if—
    - (a) the applicant has claimed priority of a previous application under section 111;
    - (b) the missing description or missing drawing is completely contained in the previous application;
    - (c) when filing the description or drawing, the applicant makes, in accordance with the rules, a request that the date of filing accorded in accordance with section 114(2) remains unchanged; and
    - (d) the applicant files within the prescribed time—
      - (i) a copy of the previous application;
      - (ii) if the previous application is not in one of the official languages, its translation in one of the official languages; and
      - (iii) a statement indicating the location of the description or drawing in the previous application and, if applicable, in its translation.
  - (6) In this section—

**missing description** (欠交說明) means a part of the description of an invention referred to in section 113(1A)(b)(i), that has not been filed in a short-term patent application;

**missing drawing** (欠交繪圖) means a drawing referred to in section 113(1A)(b)(iii), that has not been filed in a short-term patent application.

*(Added 17 of 2016 s. 107)*

**114B. Missing description or missing drawing not filed or withdrawn**

- (1) If any missing description or missing drawing as defined by section 114A(6) is not filed within the prescribed time under section 114A(1) or (2), any reference to the description or drawing in the specification contained in the short-term patent application under section 113(1A)(b) is to be regarded as being deleted.
- (2) If a notice of change of the date of filing is issued under section 114A(4), the applicant of the short-term patent application may, within 1 month after the date of the notice, withdraw the missing description or missing drawing that has been filed.
- (3) On the withdrawal of the description or drawing—
  - (a) any reference to the description or drawing in the specification contained in the patent application under section 113(1A)(b) is to be regarded as being deleted;
  - (b) the description or drawing is to be regarded as not having been filed; and
  - (c) the original date of filing of the patent application accorded in accordance with section 114(2) is to remain unchanged.

*(Added 17 of 2016 s. 107)*



**115. Examination as to formal requirements**

- (1) If a short-term patent application has been accorded a date of filing, and is not regarded as being withdrawn under section 113(5), the Registrar must examine the application to ascertain whether the requirements of section 113 and of any rules made for the purposes of that section (*formal requirements*) have been complied with. (*Amended 17 of 2016 s. 108*)
- (1A) If there are deficiencies in the application as regards the formal requirements that cannot be corrected, the application must be refused. (*Added 17 of 2016 s. 108*)
- (2) If there are deficiencies in the application as regards the formal requirements that may be corrected, the Registrar must give the applicant an opportunity to correct them in accordance with the rules. (*Replaced 17 of 2016 s. 108*)
- (3) If any deficiencies referred to in subsection (2) are not corrected in accordance with the rules, then except as provided in subsection (4)—
  - (a) where no steps are taken to correct the deficiencies, the application is to be regarded as being withdrawn; or
  - (b) in any other case, the application must be refused. (*Replaced 17 of 2016 s. 108*)
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected, then only the right is lost for the application. (*Amended 17 of 2016 s. 108*)

[*cf. EPC Art. 91*]

**116. Divisional short-term patent application**

Where, after an application for a short-term patent has been filed and before the date under section 122 on which preparation for



publication of the specification of the patent has been completed, a new application for a short-term patent is filed by the original applicant or his successor in title in accordance with the rules to be prescribed, being an application— (*Amended 64 of 2000 s. 37*)

- (a) which is in respect of any part of the subject-matter contained in the earlier short-term patent application;
- (b) which complies with the relevant requirements including procedures and time limits specified in the rules; and
- (c) which does not contravene section 103(1), (*Amended 17 of 2016 s. 109*)

then such new application shall be treated as having, as its date of filing, the date of filing of the earlier short-term application and shall have the benefit of any right of priority.

#### **117. Formality examination only**

Except as expressly provided to the contrary, nothing in this Part providing for the examination by the Registrar of an application for a short-term patent for an invention shall be construed as imposing any obligation upon the Registrar to consider or to have regard to, for the purpose of such examination, any question as to—

- (a) the patentability of the invention;
- (b) whether the applicant is entitled to any priority claimed in the application;
- (c) whether the invention is properly disclosed in the application; or
- (d) any matter specified in section 9A, 9B, 9C, 9D, 9E, 9F, 77, 78, 79, 103, 109, 110, 111(2), (3), (4), (5) or (6) or 113(1A)(b)(ii). (*Replaced 17 of 2016 s. 110*)

### **Division 3—Procedures up to and Including Grant**

*(Replaced 17 of 2016 s. 111)*

**118. Grant of short-term patent and publication**

- (1) If on examination by the Registrar under section 115(1) an application for a short-term patent is found to have satisfied the requirements of that provision, or if on a subsequent examination the deficiencies under section 115(2) are found to have been corrected in accordance with the rules, then as soon as practicable after such examination, but subject to sections 119 and 124, the Registrar shall grant a short-term patent for the invention. (*Amended 17 of 2016 s. 112*)
- (2) As soon as practicable after a short-term patent has been granted under this section the Registrar shall—
  - (a) publish in the prescribed manner the specification of the short-term patent, the names of the proprietor and, if different, the inventor;
  - (b) issue a certificate of grant; and
  - (c) advertise the fact of such grant by notice in the official journal. (*Amended 2 of 2001 s. 14*)
- (3) The Registrar may in any publication under subsection (2)(a) publish in addition to the matters specified in that subsection any other matters constituting or relating to the patent which in the Registrar's opinion it is desirable to publish.

**119. Deferral of grant of patent at applicant's request**

- (1) Where in his application for a short-term patent an applicant has requested the Registrar to defer the grant of a patent for a period specified in the application, a short-term patent shall not be granted in that application until—
  - (a) the expiry of that period, or of such shorter period as the applicant may subsequently specify by notice filed with the Registrar, after the date on which the requirements of section 115(1) are found to have been satisfied; or

(b) 12 months after the date of filing of the application, whichever occurs first.

- (2) Where a request has been made under this section for the deferral of a grant, any grant under section 118(1) shall be made by the Registrar as soon as possible after the expiry of the period of deferral applying by virtue of this section.

### **120. Amendment of application for short-term patent before grant**

- (1) Subject to this section and sections 122 and 103(2), at any time before a patent is granted under this Part an applicant may, in accordance with the prescribed conditions, amend the application of his own volition. (*Amended 17 of 2016 s. 113*)
- (2) (*Repealed 17 of 2016 s. 113*)
- (3) The Registrar may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a short-term patent so as to acknowledge a registered trade mark.

[*cf. 1977 c. 37 s. 19 U.K.*]

### **121. Withdrawal of application**

- (1) At any time before a short-term patent is granted the applicant may, subject to section 122, withdraw in writing his application and any such withdrawal may not be revoked.
- (2) Where a short-term patent application is withdrawn under this section, or is regarded under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, the following provisions shall apply— (*Amended 17 of 2016 s. 114*)
- (a) the applicant shall continue to enjoy, on the basis of the application, a right of priority under section 37C or 110 for filing a subsequent standard patent (O) application

or short-term patent application; (*Amended 17 of 2016 s. 114*)

- (b) no other right may be claimed under this Ordinance in relation to the application.

**122. Limitation on withdrawal, amendment, etc. of application**

No withdrawal of an application under section 121, no divisional application under section 116 nor any amendment under section 120 shall be allowed after the date on which preparations for publication under section 118(2) of the specification of a short-term patent to be granted in pursuance of the application have been completed.

**123. Further processing of, and restoration of rights in respect of, short-term patent applications**

- (1) Sections 28(1) and (2) and 29(1) and (2) apply, subject to necessary modification, to an application for a short-term patent as if a reference in those sections to an application or an applicant for a standard patent (R) and to Part 2 were a reference to an application or an applicant for a short-term patent and to this Part respectively.
- (2) Section 28 as applied by subsection (1) does not apply to a short-term patent application that is regarded as being withdrawn under section 113(5).
- (3) Section 29 as applied by subsection (1) does not apply in the case of a failure to comply with a time limit under section 110A, 111, 113, 114, 114A, 114B, 115, 116, 120 or 121.
- (4) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to a short-term patent application filed with the Registrar before that date. (*Added 17 of 2016 s. 115*)

*(Amended 17 of 2016 s. 115)*

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Editorial Note:

\* Commencement date: 19 December 2019.

**124. Registrar may refuse to grant short-term patent**

The Registrar may refuse to grant a short-term patent for an invention if he considers that the invention is not a patentable invention by reason of any of the matters specified in section 9A(5), and the Registrar shall give notice of any such refusal to the applicant.

*(Amended 17 of 2016 s. 116)*

**125. Short-term patent application based on international application**

- (1) Where an international application seeking a patent for invention or a patent for a utility model and designating the People's Republic of China has entered its national phase in the People's Republic of China, the applicant in the international application may apply for a short-term patent for the invention (if any) disclosed in that application. *(Amended 17 of 2016 s. 117)*
- (2) An application for a short-term patent made pursuant to this section may be filed at any time before a date 6 months after the entry into the national phase of the international application in the People's Republic of China, or such other date as may be prescribed by rules.
- (3) An application for a short-term patent made pursuant to this section shall contain—
  - (a) a photocopy of the international application as published by the International Bureau under Article 21 of the Patent Cooperation Treaty;

- (b) a photocopy of the international search report in relation to the international application as published under Article 21(3) of the Patent Cooperation Treaty (whether contained in the international application as published or separately published);
  - (c) the date of entry of the international application into the national phase in the People's Republic of China;
  - (d) a photocopy of the translation of the international application (if any) published by the State Intellectual Property Office; and (*Amended 2 of 2001 s. 9*)
  - (e) a photocopy of any information that may be published by the State Intellectual Property Office concerning the international application. (*Amended 2 of 2001 s. 9*)
- (4) Section 113 applies in relation to an application for a short-term patent made pursuant to this section as if for subsection (1A)(b) to (d) of that section there was substituted a reference to the documents specified in subsection (3)(a) to (e) of this section. (*Amended 17 of 2016 s. 117*)
- (5) Where an application made pursuant to this section results in the grant of a short-term patent, the application shall be deemed to have as its date of filing the international filing date accorded to the international application for the purposes of Article 11 of the Patent Cooperation Treaty and, in this Ordinance, reference to the date of filing of an application in relation to a short-term patent which has been granted pursuant to an application made as provided for in this section shall be construed accordingly.
- (6) In this section, ***State Intellectual Property Office*** (國家知識產權局) means the State Intellectual Property Office established under the laws of the People's Republic of China the functions of which include the granting of patents for

inventions and patents for utility models. (*Amended 2 of 2001 s. 9; 17 of 2016 s. 117*)

## **Division 4—Provisions on Short-term Patents after Grant**

*(Replaced 17 of 2016 s. 118)*

### **126. Term of short-term patent**

- (1) A short-term patent granted under this Part—
  - (a) shall take effect on the date on which the fact of its grant is advertised in the official journal; and (*Amended 2 of 2001 s. 14*)
  - (b) subject to subsections (2) and (3), shall remain in force until the end of the period of 8 years beginning with the date of filing the application for the patent. (*Amended E.R. 4 of 2020*)
- (2) If it is desired to keep a short-term patent in force for a further 4 years after the expiry of the 4th year from the date of filing of the application for that patent, the prescribed renewal fee shall be paid within the 3 months ending with the expiry of that 4th year, and a short-term patent shall cease to have effect at the expiry of that 4th year if the renewal fee is not so paid.
- (3) Despite subsection (2), where the date of grant of a short-term patent occurs after the expiry of the 4th year from the date of filing of the application for that patent then—
  - (a) the prescribed renewal fee may be paid at any time before the expiry of 3 months beginning from the date of grant and in the event of such payment the patent shall remain in force for the balance of the period of 4 years specified in subsection (2);



- (b) the patent shall cease to have effect under this section if, and only if, the prescribed renewal fee is not paid as provided in paragraph (a).
- (4) The Registrar may by regulation amend the period specified in subsection (2) as being the period ending with the expiry of the 4th year from the date of filing of the short-term patent application.
- (5) If within 6 months after the end of the period specified in subsection (2) or (3), as the case may be, the renewal fee and any prescribed additional fee is paid, the short-term patent shall be treated as if it had never expired, and accordingly—
- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute Government use of the patented invention if the patent had not expired shall constitute that use.
- (6) The Chief Executive in Council may by regulation amend— (*Amended 22 of 1999 s. 3*)
- (a) the period specified in subsection (1)(b) as being the period for which a short-term patent shall remain in force;
- (b) the period specified in subsection (2) or (3) by reference to which a short-term patent, if not renewed, shall cease to have effect.

[*cf. 1977 c. 37 s. 25 U.K.*]

## **126A. Observations by third parties on patentability of short-term patents**



- (1) After a short-term patent for an invention has been granted, any person may file with the Registrar a written notice of the person's observations on the patentability of the invention.
- (2) The notice must—
  - (a) set out the observations and the grounds for the observations; and
  - (b) be filed in the prescribed manner and within the prescribed time.
- (3) The Registrar must, as soon as practicable after receiving a notice under subsection (1), send a copy of the notice to the proprietor of the short-term patent.
- (4) If the short-term patent is being subjected to a substantive examination, the Registrar must consider the observations when deciding whether to issue a certificate of substantive examination in respect of the patent.
- (5) A person does not become a party to any proceedings under this Ordinance only because the person files a notice under subsection (1).

*(Added 17 of 2016 s. 119)*

### **127. Restoration of lapsed short-term patents**

Sections 40 and 41 shall apply to short-term patents, with necessary modification, as if reference in those sections to a standard patent and to section 39 were a reference to a short-term patent and to section 126 respectively.

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

*(Division 5 added 17 of 2016 s. 120)*

### **127A. Interpretation of Division 5 of Part 15**

In this Division—

*examination requirement* (審查規定) means a requirement specified in section 127C(2);

*unfulfilled requirement* (不獲符合的規定), for a short-term patent, means an examination requirement that—

- (a) in the Registrar's opinion, is not complied with by the patent; and
- (b) is set out in the notice to the proprietor of the patent under section 127D(2).

### **127B. Request for substantive examination of short-term patents**

- (1) The proprietor of a short-term patent may—
  - (a) request the Registrar to carry out a substantive examination of the patent; and
  - (b) subject to section 103(3), file a request to amend the specification of the patent at the same time.
- (2) Any other person may also request the Registrar to carry out a substantive examination of the patent if the person satisfies the Registrar that—
  - (a) there are reasonable grounds to suspect that the invention, which is the subject of the patent—
    - (i) is not new;
    - (ii) lacks an inventive step; or
    - (iii) is not susceptible of industrial application; or
  - (b) because of the person's legitimate business interests, it would be reasonable for the examination to be carried out.
- (3) A request for substantive examination of a short-term patent must—
  - (a) be made in the prescribed manner; and

- (b) be accompanied by the prescribed fee.
- (4) No request for substantive examination of a short-term patent may be made if—
  - (a) a previous request for substantive examination of the patent has been made, and—
    - (i) the outcome of the substantive examination is still pending; or
    - (ii) that request has resulted in the issue of a certificate of substantive examination of the patent or in the revocation of the patent; or
  - (b) the patent has been found by the court to be wholly valid in any proceedings in which the validity of the patent is contested.
- (5) A request for substantive examination of a short-term patent may not be withdrawn.

### **127C. Substantive examination by Registrar**

- (1) On receiving a request for substantive examination of a short-term patent, the Registrar must examine the patent and consider any requested amendment filed under section 127B(1)(b) to determine whether the patent, together with the amendment (if allowed), complies with all the requirements specified in subsection (2).
- (2) The requirements are—
  - (a) the invention, which is the subject of the patent, is patentable under section 9A;
  - (b) the specification of the patent discloses the invention in accordance with section 77;
  - (c) the specification provides for not more than 2 independent claims, as required under section 113(1A)(b)(ii);

- (d) all the claims contained in the specification comply with the requirements of section 78(1);
  - (e) the matter disclosed in the specification of the patent does not extend beyond that disclosed in—
    - (i) the patent application as filed; and
    - (ii) if the patent was granted because of a specified new application, the earlier short-term patent application as filed;
  - (f) the protection conferred by the patent has not been extended by an amendment to its specification;
  - (g) the patent is not one of 2 patents that—
    - (i) are granted for the same invention made by the same inventor; and
    - (ii) have the same material date.
- (3) In examining a short-term patent to determine whether the patent complies with the requirement specified in subsection (2)(a), the Registrar must have regard to—
- (a) if a claim for priority of a previous application has been made in respect of the patent application under section 111, whether the applicant is entitled to the priority claimed; and
  - (b) if a missing description or missing drawing as defined by section 114A(6) has been filed, whether the date of filing of the patent application remains unchanged.
- (4) The Registrar must carry out the examination in accordance with the rules.
- (5) In subsection (2)(e)(ii)—
- specified new application*** (指明新申請) means—
- (a) a new short-term patent application made in accordance with an order under section 55(4); or

- (b) a new short-term patent application referred to in section 116.

**127D. Proprietor may file representations and requests for amendment, etc.**

- (1) If the Registrar is of the opinion that a short-term patent, together with any requested amendment under section 127B(1)(b) (if allowed), does not comply with any examination requirement, the Registrar must, by written notice, inform the proprietor of the patent of the opinion.
- (2) The notice must set out each examination requirement that, in the Registrar's opinion, is not complied with by the patent.
- (3) The proprietor may respond to the notice by filing, in accordance with the rules, any or all of the following—
  - (a) a representation to establish that the patent complies with an unfulfilled requirement;
  - (b) subject to section 103(3), a request to amend the specification of the patent to enable the patent to comply with an unfulfilled requirement;
  - (c) a request to review the Registrar's opinion.

**127E. Registrar must consider representations and requests for amendment, etc.**

- (1) The Registrar must, in accordance with the rules—
  - (a) consider and decide—
    - (i) whether a representation filed under section 127D(3)(a) establishes that a short-term patent complies with an unfulfilled requirement; and
    - (ii) whether a requested amendment filed under section 127D(3)(b), if allowed, would enable the

patent to comply with an unfulfilled requirement;  
and

- (b) review the Registrar's opinion on a request filed under section 127D(3)(c).
- (2) If the Registrar is of the opinion that a requested amendment filed under section 127B(1)(b) or 127D(3)(b), if allowed, would enable the patent to comply with an unfulfilled requirement, the Registrar must, in accordance with the rules—
- (a) publish the requested amendment;
  - (b) consider any opposition to the amendment filed by third parties; and
  - (c) decide whether to allow the amendment.
- (3) If the Registrar thinks fit, the Registrar may refer the opposition proceedings to the court, and the court may allow the amendment by order, subject to any conditions that it thinks fit.
- (4) If the requested amendment filed under section 127B(1)(b) or 127D(3)(b) is allowed by the Registrar or the court, the Registrar must, in accordance with the rules—
- (a) record and publish the amendment; and
  - (b) advertise the fact of the publication by notice in the official journal.
- (5) An amendment to the specification of a patent allowed under this section has effect as from the grant of the patent.

### **127F. Certificate of substantive examination**

- (1) The Registrar must issue a certificate of substantive examination in respect of a short-term patent, if the Registrar—

- 
- (a) has examined the patent and considered any requested amendment filed under section 127B(1)(b);
  - (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 127E(1) (where applicable); and
  - (c) is of the opinion that the patent, together with any amendment allowed under section 127E, complies with all the examination requirements.
- (2) As soon as practicable after the certificate is issued, the Registrar must—
- (a) inform the following persons by written notice that the certificate has been issued—
    - (i) the proprietor of the patent; and
    - (ii) the person who has requested the substantive examination (if that person is not the proprietor);
  - (b) send the certificate to the proprietor; and
  - (c) enter a record of the issue of the certificate in the register.

### **127G. Revocation of short-term patents**

- (1) The Registrar must revoke a short-term patent if the Registrar—
- (a) has examined the patent and considered any requested amendment filed under section 127B(1)(b);
  - (b) has considered the representation and requested amendment, and reviewed the Registrar's opinion, under section 127E(1) (where applicable); and
  - (c) is of the opinion that the patent, together with any amendment allowed under section 127E, does not comply with all the examination requirements.

- (2) As soon as practicable after the patent is revoked, the Registrar must—
- (a) inform the following persons by written notice that the patent has been revoked—
    - (i) the proprietor of the patent; and
    - (ii) the person who has requested the substantive examination (if that person is not the proprietor);
  - (b) advertise the fact of the revocation by notice in the official journal; and
  - (c) enter a record of the revocation in the register.

### **Division 6—Miscellaneous**

*(Replaced 17 of 2016 of s. 121)*

**128.** *(Repealed 17 of 2016 s. 122)*

#### **129. Court proceedings in relation to short-term patents**

- (1) The proprietor of a short-term patent may only commence proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to the patent (*enforcement proceedings*) if—
- (a) a certificate of substantive examination has been issued in respect of the patent;
  - (b) a request for substantive examination of the patent has been made under section 127B and the examination has not been terminated by a court order under section 101A(4)(b); or
  - (c) a certificate has been granted by a court under section 84(1), certifying the court's finding that—
    - (i) the patent is wholly valid; or



- (ii) if the enforcement proceedings relate to a relevant respect of the patent, the patent is valid in that respect. *(Added 17 of 2016 s. 123)*
- (2) In any enforcement proceedings—
- (a) it is for the proprietor of the short-term patent to establish the validity of the patent or a relevant respect of the patent (as the case requires), and the fact that the patent has been granted is of no account in that regard; and
- (b) in the absence of evidence to the contrary, any of the following is sufficient proof of the validity of the patent or a relevant respect of the patent—
- (i) the certificate of substantive examination of the patent;
- (ii) a certificate referred to in subsection (1)(c);
- (iii) any evidence which is sufficient to establish prima facie the validity of the patent or that respect of the patent (as the case requires). *(Replaced 17 of 2016 s. 123)*
- (3) In any enforcement proceedings, an application by the proprietor of the short-term patent for an injunction under section 80(1)(a) in interlocutory proceedings must be accompanied by a certificate or evidence referred to in subsection (2)(b)(i), (ii) or (iii). *(Added 17 of 2016 s. 123)*
- (4) If, in enforcement proceedings, an order is made in interlocutory proceedings granting or refusing an application for an injunction under section 80(1)(a) or an order under section 80(1)(b), any party may apply to the court for an order that the matter proceed to early trial and, subject to compliance by that party with rules of court, the court shall so order unless it considers that the interests of justice would

not be served by the making of such an order. (*Amended 17 of 2016 s. 123*)

- (5) A court making an order for an early trial under subsection (4)— (*Amended 17 of 2016 s. 123*)
- (a) may also make such order as respects the period before trial as the justice of the case requires;
- (b) shall by the order determine the mode of trial.
- (6) This section, as in force immediately before the commencement date\* of the Patents (Amendment) Ordinance 2016 (17 of 2016), continues to apply to enforcement proceedings commenced before that date. (*Added 17 of 2016 s. 123*)

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Editorial Note:

\* Commencement date: 19 December 2019.

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## Part 16

### Miscellaneous

*(Replaced 17 of 2016 s. 124)*

*(Format changes—E.R. 4 of 2020)*

#### **130. Appeal from Registrar**

- (1) Except as otherwise expressly provided by rules, an appeal to the court shall lie from any decision or order of the Registrar under this Ordinance, and for the purposes of this provision **decision** (決定) includes any act of the Registrar in exercise of a discretion vested in him by or under this Ordinance.
- (2) Any appeal under this Ordinance which concerns a patent application which has not been published shall be heard in private.
- (3) In any appeal under this Ordinance—
  - (a) the Registrar shall be entitled to appear or be represented and be heard in support of his decision or order;
  - (b) the Registrar shall appear if so directed by the court.
- (4) In any appeal under this Ordinance the court may exercise any power which could have been exercised by the Registrar in proceedings from which the appeal is brought.

#### **131. Registrar's appearance in proceedings involving register**

- (1) In any proceedings before the court involving an application for the alteration or rectification of the register, the Registrar shall be entitled to appear or be represented and be heard, and shall appear if so directed by the court.

- (2) Unless otherwise directed by the court, the Registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of—
- (a) any proceedings before him in relation to the matter in issue;
  - (b) the grounds of any decision given by him affecting it;
  - (c) the practice of the registry in like cases; or
  - (d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,
- and the statement shall be deemed to form part of the evidence in the proceedings.

### **132. General powers of the court**

- (1) The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Ordinance, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.
- (2) Every order of the court shall be subject to appeal to the Court of Appeal.

*[cf. 1977 c. 37 s. 99 U.K.]*

### **133. Procedure in case of option to apply to court or Registrar**

- (1) Where under this Ordinance an applicant has an option to make an application either to the court or to the Registrar—
  - (a) if an action concerning the patent or application for a patent in question is pending, the application must be made to the court;
  - (b) if in any other case the application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the court, or he

may, after hearing the parties, determine the question between them, subject to appeal to the court.

- (2) Subsection (1) is without prejudice to the court's powers, apart from this section, to determine any question referred to in that subsection.
- (3) Reference in subsection (1) to an option to make an application either to the court or to the Registrar includes reference to an option to refer a question either to the court or to the Registrar.

*[cf. Trade Marks Ord. s. 80]*

#### **134. Burden of proof in certain cases**

- (1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.
- (2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

*[cf. 1977 c. 37 s. 100 U.K.]*

#### **135. Exercise of Registrar's discretionary powers**

Without prejudice to any rule of law, the Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Ordinance or by the rules.

*[cf. 1977 c. 37 s. 101 U.K.]*

#### **136. Costs and expenses in proceedings before court**

- (1) Subject to subsection (2), in all proceedings before the court

under this Ordinance the court may award to any party such costs as it may consider reasonable. (*Amended 2 of 2001 s. 10*)

- (2) In proceedings before the court under section 58 the court shall, in determining whether to award costs or expenses to any party and what costs or expenses to award, have regard to all the relevant circumstances, including the financial position of the parties.
- (3) If in any such proceedings the court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs shall be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court.

*[cf. 1977 c. 37 s. 106 U.K.]*

### **137. Costs and expenses in proceedings before Registrar**

- (1) The Registrar may, in proceedings before him under this Ordinance, by order award to any party such costs as he may consider reasonable and direct how and by what parties they are to be paid.
- (2) Any costs awarded under this section shall, if the court so orders, be recoverable by execution issued from the court as if they were payable under an order of that court.
- (3) Rules may empower the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and may provide for the consequences if security is not given.

*[cf. 1977 c. 37 s. 107 U.K.]*

### **138. Licences granted by order of the court or Registrar or by Director of Health**

*(Amended 21 of 2007 s. 6)*

- (1) Any order for the grant of a licence under section 14, 37K, 56, 64 or 65 shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the standard patent and all other necessary parties, granting a licence in accordance with the order. *(Amended 21 of 2007 s. 6; 17 of 2016 s. 125)*
- (2) Without prejudice to any other method of enforcement, any import compulsory licence or export compulsory licence granted under section 72C or 72M (as the case may be) has effect as if it were a deed, executed by the proprietor of the standard patent or the short-term patent (as the case may be) and all other necessary parties. *(Added 21 of 2007 s. 6)*

*[cf. 1977 c. 37 s. 108 U.K.]*

**139. Immunity of Registrar as regards official acts**

Neither the Registrar nor any officer of his—

- (a) shall be taken to warrant the validity of any patent granted under this Ordinance; or
- (b) shall incur any liability by reason of or in connection with any examination or investigation required or authorized by this Ordinance, or any report or other proceedings consequent on any such examination or investigation.

*[cf. 1977 c. 37 s. 116 U.K.]*

**139A. Protection of Government and public officers**

- (1) No liability shall rest on the Government or any public officer by reason of the fact that—
  - (a) any authority is given under section 69; or

- (b) any import compulsory licence or export compulsory licence is granted under section 72C or 72M (as the case may be).
- (2) A public officer is not personally liable in respect of any act or omission of his if it was done or made by him in the honest belief that it was required or authorized in the exercise of any function, duty or power of his under Part 9, 9A or 9B (as the case may be). (*Amended 17 of 2016 s. 126*)
- (3) The protection conferred on public officers by subsection (2) in respect of any act or omission does not affect any liability of the Government in tort for that act or omission.

*(Added 21 of 2007 s. 7)*

#### **140. Recognition of agents**

- (1) Subject to this section and to the rules, where under this Ordinance any act has to be done by or to any person in connection with a patent or any procedure relating to a patent or the obtaining of a patent, the act may be done by or to an agent of such person duly authorized by that person orally or in writing.
- (2) A person duly authorized by another person under subsection (1) to act as his agent may (subject to any provision to the contrary in any agreement between the agent and that person), on giving notice to the Registrar and the other person, cease to act as agent for the other person.
- (3) Rules may authorize the Registrar to refuse to recognize as agent in respect of any business under this Ordinance any person specified for the purpose in the rules.
- (4) The Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.



## Part 17

### Offences

*(Replaced 17 of 2016 s. 127)*

*(Format changes—E.R. 4 of 2020)*

#### 141. Falsification of register, etc.

A person who—

- (a) makes or causes to be made a false entry in any register kept under this Ordinance, knowing the entry to be false; or
- (b) makes or causes to be made a writing falsely purporting to be a copy or reproduction of an entry in any register kept under this Ordinance, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the writing to be false,

commits an offence and is liable—

- (i) on summary conviction, to a fine at level 5 and to imprisonment for 6 months;
- (ii) on conviction on indictment, to imprisonment for 2 years.

*[cf. 1977 c. 37 s. 109 U.K.]*

#### 142. Unauthorized claim of patent rights

- (1) Subject to this section, a person who falsely represents that anything disposed of by him for value is a patented product commits an offence and is liable on summary conviction to a fine at level 3.
- (2) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed

on it or otherwise applied to it the word “patent” or “patented” or “專利” or “享有專利” or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

- (3) Subsection (1) does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).
- (4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

*[cf. 1977 c. 37 s. 110 U.K.]*

### **143. Unauthorized claim that patent has been applied for**

- (1) Subject to this section, a person who represents that a patent has been applied for in respect of any article disposed of for value by him when in fact—
  - (a) no such application for a patent has been made; or
  - (b) any such application has been refused, withdrawn or deemed withdrawn, (*Amended 17 of 2016 s. 128*)commits an offence and is liable on summary conviction to a fine at level 3.
- (2) Subsection (1)(b) does not apply where the representation is made (or continues to be made) before the expiry of a period which begins with the refusal, withdrawal or deemed withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made). (*Amended 17 of 2016 s. 128*)

- (3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words “patent applied for” or “patent pending” or “已申請專利” or “專利申請待決”, or anything expressing or implying that an application has been made for a patent in respect of the article, shall be taken to represent that an application for such a patent has been made.
- (4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

*[cf. 1977 c. 37 s. 111 U.K.]*

#### **144. Misuse of title “Patents Registry”**

A person who uses on his place of business, or any document issued by him, or otherwise, the words “Patents Registry” or “專利註冊處” or any other words suggesting that his place of business is, or is officially connected with, the Patents Registry, commits an offence and is liable on summary conviction to a fine at level 4.

*[cf. 1977 c. 37 s. 112 U.K.]*

#### **144A. Prohibition on use of certain titles and descriptions**

- (1) A person must not, in the course of or in connection with the person’s business, trade or profession in Hong Kong, knowingly use or permit the use of a title or description specified in subsection (2).
- (2) The title or description is—
  - (a) certified patent agent;
  - (b) registered patent agent;
  - (c) certified patent attorney;
  - (d) registered patent attorney; or

- (e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—
  - (i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and
  - (ii) that is recognized by law or endorsed by the Government.
- (3) Subsection (1) does not prohibit a person from using, or from permitting the use of, a title or description that—
  - (a) solely relates to the person’s qualification for lawfully providing patent agency services in a jurisdiction outside Hong Kong; and
  - (b) clearly indicates the jurisdiction.
- (4) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine of \$500,000.

*(Added 17 of 2016 s. 129)*

**145. Offences by corporations or partners**

- (1) Where an offense under this Ordinance committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- (2) The following provisions apply for the purposes of proceedings for an offence under this Ordinance alleged to have been committed by a body corporate—
  - (a) any rules of court relating to the service of documents;

- (b) section 19A (plea by a corporation before a magistrate) and section 87 (procedure on charge of indictable offence against corporation) of the Magistrates Ordinance (Cap. 227).
- (3) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.
- (4) Where a partnership is guilty of an offence under this Ordinance, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.
- (5) Without prejudice to any liability of the partners under subsection (4), proceedings for an offence under this Ordinance alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners.
- (6) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.
- (7) Where an offence under this Ordinance committed by a partner in a firm is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any other partner in the firm or any person concerned in the management of the firm, that partner or the person concerned in the management of the firm is also guilty of the offence and liable to be proceeded against and punished accordingly.
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## Part 18

### Administrative Provisions

*(Replaced 17 of 2016 s. 130)*

*(Format changes—E.R. 4 of 2020)*

#### **146. Correction of errors in patents and applications**

- (1) The Registrar may, subject to the rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.
- (2) Where the Registrar is requested to correct such an error or mistake any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

*[cf. 1977 c. 37 s. 117 U.K.]*

#### **147. Information about patent applications and patents, and inspection of documents**

- (1) After publication of an application for a standard patent in accordance with section 20 or 37Q or the grant of a short-term patent the Registrar shall upon the filing of a written request in the prescribed manner give the person making the request such information, and permit him to inspect such documents, relating to the application or any patent granted in pursuance of the application or to the short-term patent as may be specified in the request, subject, however, to any prescribed restrictions. *(Amended 17 of 2016 s. 131)*
- (2) Subject to this section, until an application for a standard patent is so published or a short-term patent is granted

documents or information constituting or relating to the application for the standard patent or the short-term patent shall not, without the consent of the proprietor or the applicant (as the case may be), be published or communicated to any person by the Registrar.

- (3) Subsection (2) shall not prevent the Registrar from publishing or communicating to others any prescribed bibliographic information about an unpublished application for a standard patent or an application for a short-term patent.
- (4) Where a person is notified that an application for a standard patent has been made, but not published in accordance with section 20 or 37Q (as the case requires), and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly. (*Amended 17 of 2016 s. 131*)
- (5) Where a person is notified that an application for a short-term patent has been made and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification, that person may make a request under subsection (1) and that subsection shall apply accordingly.
- (6) Where an application for a standard patent is filed, but not published, and a new application for a standard patent is filed in respect of any part of the subject-matter of the earlier application (either in accordance with the rules or in pursuance of an order under section 13 or 37J) and is published, any person may make a request under subsection (1) in the prescribed manner relating to the earlier application and the Registrar shall give him such information



and permit him to inspect such documents as could have been given or inspected if the earlier application had been published. (*Amended 17 of 2016 s. 131*)

[*cf. 1977 c. 37 s. 118 U.K.*]

#### **148. Hours of business and excluded days**

- (1) The Registrar may, by notice published in the official journal, give directions specifying the hours of business of the registry for the purpose of the transaction by the public of business under this Ordinance, and the days which are business days for that purpose. (*Amended 2 of 2001 s. 14*)
- (2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Ordinance expires on a day which is not a business day, that time shall be extended to the next business day.
- (3) Directions made under this section may make different provision for different classes of business.

#### **149. Rules**

- (1) The Registrar may make rules—
  - (a) for the purposes of any provision of this Ordinance authorizing the making of rules (other than rules of court) with respect to any matter; and
  - (b) for prescribing anything authorized or required by an provision of this Ordinance to be prescribed,and generally for regulating practice and procedure under this Ordinance.
- (2) Without limiting subsection (1), rules may make provision— (*Amended 17 of 2016 s. 132*)



- 
- (a) in connection with applications for patents and other documents which may be filed with the Registrar—
    - (i) prescribing the form and contents of any such documents;
    - (ii) requiring copies of such documents to be furnished;
    - (iii) prescribing the manner of filing of such documents;
  - (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or in the registry and authorizing the rectification of irregularities of procedure;
  - (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the registry and providing for the remission of fees in the prescribed circumstances;
  - (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
  - (e) requiring the Registrar to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;
  - (f) providing for the appointment of advisers to assist the Registrar in any proceedings before him;
  - (g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Ordinance or the rules and providing for the alteration of any period of time specified in this Ordinance or the rules;

- 
- (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
  - (i) without prejudice to any other provision of this Ordinance, requiring and regulating the translation of documents in connection with a patent or an application for a patent into the language of the proceedings or into one or both official languages and the filing and verification of any such translations;
  - (j) providing for the publication and sale of documents by the registry and of information about such documents;
  - (k) prescribing opposition or revocation proceedings in designated patent offices for the purposes of sections 43 and 44.
- (2A) Without limiting subsection (1), the rules may, in relation to an invention that requires for its performance the use of a micro-organism—
- (a) provide for the manner in which information on the availability of samples of the micro-organism to the public (if any) is to be contained in a standard patent (O) application or a short-term patent application for the invention;
  - (b) provide for the circumstances under which the patent application or the specification of the patent granted is to be regarded as having disclosed the invention in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art;
  - (c) require the applicant for or proprietor of the patent—
    - (i) to take specified steps to make the samples available to the public; and

- (ii) not to impose or maintain restrictions on the use of the samples, unless expressly provided otherwise; and
  - (d) provide for the circumstances under which the samples need only be made available to a person or a description of persons. (*Added 17 of 2016 s. 132*)
- (3) Rules may make different provision for different cases.
- (4) Rules made under this section—
  - (a) authorizing the rectification of irregularities of procedure; or
  - (b) providing for the alteration of any period of time, may authorize the extension or further extension of any period of time notwithstanding that the period has already expired.
- (5) Rules prescribing fees, including any penalty fee under section 104(5)(b), shall not be made except with the consent of the Financial Secretary.
- (6) Any rules made under subsection (2)(c) may—
  - (a) prescribe fees fixed at; or
  - (b) provide for fees to be fixed at, levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function.
- (7) Rules may provide for arrangements to be made by the Registrar for the publication of reports of cases relating to patents decided by the Registrar and of cases relating to

patents (whether under this Ordinance or otherwise) decided by any court or body (whether in Hong Kong or elsewhere).

*[cf. 1977 c. 37 s. 123 U.K.]*

**150. Registrar may specify forms to be used**

- (1) The Registrar may require the use of such forms as he may, by notice published in the official journal, specify in connection with the granting of a patent or any other proceeding before him under this Ordinance. *(Amended 2 of 2001 s. 14)*
- (2) A notice under subsection (1) may contain any direction of the Registrar with respect to the use of a form specified in the notice.
- (3) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1). *(Added 2 of 2001 s. 11)*

**150A. Power to specify official journal, etc.**

- (1) The Registrar may from time to time, by notice published in the Gazette, specify a publication to be the official journal of record for the purposes of this Ordinance, with effect as of the date specified in the notice.
- (2) Where a publication is specified under subsection (1), every notice, request, document or other matter required by this Ordinance or the rules to be published in the official journal shall, from the effective date specified in the notice, be published in the publication so specified, and any reference in this Ordinance or the rules to the official journal shall be construed accordingly.
- (3) The Registrar may publish or cause to be published a journal in which there may be published such documents and

information relating to a patent or an application for a patent as the Registrar thinks fit.

- (4) For the avoidance of doubt, the Registrar may specify the Gazette or the journal referred to in subsection (3) to be the official journal of record.
- (5) A publication specified under subsection (1) and the journal referred to in subsection (3) need not be in a documentary form.
- (6) A notice published under subsection (1) shall not be regarded as subsidiary legislation for the purpose of section 34 of the Interpretation and General Clauses Ordinance (Cap. 1).

*(Added 2 of 2001 s. 12)*

### **151. Application**

*(Replaced 2 of 2009 s. 6)*

Subject to the provisions of this Ordinance, and notwithstanding section 5(3) of the Crown Proceedings Ordinance (Cap. 300), this Ordinance applies to the Government and the Offices set up by the Central People's Government in the Hong Kong Special Administrative Region.

*(Amended 2 of 2009 s. 6)*

*[cf. Registration of Patents Ord. s. 7A]*

### **152. Forfeited articles**

Nothing in this Ordinance affects the right of the Government or any person deriving title directly or indirectly from the Government to dispose of or use articles forfeited under the law relating to customs or excise.

*[cf. 1977 c. 37 s. 122 U.K.]*

### **153. Amendment of Schedule 1**

The Chief Executive in Council may by order published in the Gazette— (*Amended 22 of 1999 s. 3*)

- (a) add to Schedule 1 the name of—
    - (i) any country which has acceded to the Paris Convention;
    - (ii) any country, territory or area which has acceded to the World Trade Organisation Agreement;
  - (b) delete from the Schedule 1 the name of—
    - (i) any country which has denounced the Paris Convention;
    - (ii) any country, territory or area which has denounced the World Trade Organisation Agreement; and  
(*Amended 2 of 2001 s. 13*)
  - (c) otherwise amend Schedule 1. (*Added 2 of 2001 s. 13*)
-

## Part 19

### Repeals and Transitional Arrangements

*(Replaced 17 of 2016 s. 133)*

*(Format changes—E.R. 4 of 2020)*

#### **154. Repeal**

- (1) The Registration of Patents Ordinance (Cap. 42) is repealed.
- (2) The repeal effected by subsection (1) is subject to the following provisions of this Part.

#### **155. Validity of instruments made or things done under the repealed Ordinance**

Insofar as any instrument made or other thing done at any time under any provision of the repealed Ordinance could have been made or done under a corresponding provision of this Ordinance it shall not be invalidated by the repeals made by this Ordinance but shall have effect as if made or done under that corresponding provision.

#### **156. Use of patented inventions for service of the Crown**

- (1) Section 7G of the repealed Ordinance (which deals with the question of acts done by the Government as constituting the use of an invention for the services of the Crown, and payment falling to be made in respect of any such use) as it applied immediately before the commencement date shall continue in force.
- (2) For ease of reference, section 7G of the repealed Ordinance as applying for the purposes of subsection (1) is set out in Schedule 2.

- (3) Where a patent for an invention has been granted under this Ordinance pursuant to this Part to the proprietor of an existing registered patent for that invention, or to the applicant of a pending application for registration of a patent for that invention under the repealed Ordinance, sections 69 to 72 shall apply to Government use of such invention during any period of extreme urgency declared under section 68, subject to any necessary modifications.

### **157. Infringement**

- (1) Any question whether an act done before the commencement date infringes an existing registered patent shall be determined in accordance with the law relating to infringement in force immediately before the commencement date, and sections 6 and 7 of the repealed Ordinance shall apply accordingly.
- (2) Subject to subsection (3) and to necessary modification—
- (a) sections 73 to 75, 80, 81, 85 to 87, 89 and 90 shall apply to any act done on or after the commencement date which infringes an existing registered patent; and
- (b) sections 82 to 84 shall apply to any such act which infringes an existing registered 1977 Act patent,
- as those sections apply to infringements of a patent granted under this Ordinance.
- (3) Where an act is commenced before the commencement date and continues to be done on or after that date then if that act would not, under the law in force immediately before that day, amount to an infringement of an existing registered patent for an invention it shall not amount to an infringement of any patent for that invention which may be granted under this Ordinance pursuant to this Part.

### **158. Rules providing for transitional arrangements**



- 
- (1) The Chief Executive in Council may, subject to the approval of the Legislative Council, make rules providing for the application of this Ordinance and the continued application of the repealed Ordinance to— (*Amended 22 of 1999 s. 3*)
- (a) existing registered patents;
  - (b) pending applications for registration of a patent under the repealed Ordinance, and patents registered pursuant to such applications;
  - (c) existing 1949 Act or 1977 Act patents;
  - (d) published applications for 1977 Act patents and patents granted after the commencement date pursuant to such applications;
  - (e) existing applications for 1949 Act patents and patents granted after the commencement date pursuant to such applications.
- (2) Without prejudice to the generality of subsection (1), rules made under that subsection may provide for—
- (a) existing registered patents to be treated as standard patents granted under this Ordinance;
  - (b) the registration of patents under the repealed Ordinance pursuant to pending applications for such registration, and for patents so registered to be treated as existing registered patents;
  - (c) the grant of a standard patent to the proprietor of an existing 1949 Act or 1977 Act patent;
  - (d) an application for a standard patent by the applicant of a published application for a 1977 Act patent, and the grant of a standard patent to the proprietor of a patent granted pursuant to such an application after the commencement date;

- (e) the grant of a standard patent to the proprietor of a 1949 Act patent granted after the commencement date pursuant to an existing application for the 1949 Act patent.
- (3) Rules made under subsection (1) may further provide—
- (a) for time limits for making any application for a patent pursuant to rules made under this Part;
  - (b) for the application of this Ordinance to any patent or application for a patent provided for in this Part or in rules made under this Part;
  - (c) subject to any rules that may be made under paragraph (d), that no amendment or revocation of an existing registered patent in the United Kingdom taking effect on or after the commencement date shall have any effect for the purposes of any patent granted under this Ordinance pursuant to this Part, notwithstanding that such amendment or revocation may have effect in the United Kingdom as from a date prior to the commencement date;
  - (d) for the amendment or revocation of a standard patent for an invention granted under this Ordinance pursuant to this Part following the amendment or revocation in the United Kingdom of a 1949 Act patent for that invention;
  - (e) for modifications to this Ordinance as it is applied for the purpose of any provision of this Part;
  - (f) for the resolution of questions of priority as between—
    - (i) 1949 Act patents and patent applications;
    - (ii) 1977 Act patents and patent applications; and
    - (iii) patents and patent applications under this Ordinance;

- (g) for the transfer to the register kept under this Ordinance of details of patents registered under the repealed Ordinance before the commencement date, and for matters connected with the keeping of the register in relation to such details, and in that connection rules may provide for—
- (i) rectification of the register in relation to such details;
  - (ii) application by any person for the inclusion in the register of such details;
- (h) for the amendment by the Registrar by notice published in the Gazette of any time limit specified in, or any Schedule to, such rules.

### 159. Interpretation (Part 19)

*(Amended 17 of 2016 s. 134)*

(1) In this Part, unless the context otherwise requires—

**1949 Act** (《1949年法令》) means the Patents Act 1949 (1949 c. 87 U.K.), and **1949 Act patent** (1949年法令專利) means a patent granted under that Act or under the 1977 Act pursuant to an application under the 1949 Act;

**1977 Act** (《1977年法令》) means the Patents Act 1977 (1977 c. 37 U.K.), and **1977 Act patent** (1977年法令專利) means a patent granted under that Act pursuant to an application made before the commencement date and means also a European patent (UK) that has effect in the United Kingdom pursuant to section 77 of the 1977 Act;

**\*commencement date** (生效日期) means the date appointed under section 1(2) as being the date on which this Ordinance comes into operation;

***European patent (UK)*** (歐洲專利(聯合王國)) means a patent granted under the Convention on the Grant of European Patents (European Patent Convention) and designating the United Kingdom;

***existing 1949 Act or 1977 Act patent*** (現有的1949年法令或1977年法令專利) means a 1949 Act or 1977 Act patent—

- (a) granted before the commencement date and capable as at that date of registration under the repealed Ordinance; and
- (b) for which as at the commencement date no valid application for registration under the repealed Ordinance had been made;

***existing application for a 1949 Act patent*** (1949年法令專利的現有申請) means an application for a patent made under the 1949 Act, in respect of which as at the commencement date a patent had not been granted;

***existing registered patent*** (現有註冊專利) means a 1949 Act or 1977 Act patent which—

- (a) was registered under the repealed Ordinance before the commencement date; and
- (b) at the commencement date—
  - (i) was still in force in the United Kingdom;
  - (ii) had ceased to have effect in the United Kingdom, but subsequently is treated for the purposes of the 1977 Act as having never expired; or
  - (iii) had ceased to have effect in the United Kingdom but subsequently is restored by an order made under the 1977 Act;

***pending application for registration of a patent under the repealed Ordinance*** (待決的將專利根據已廢除條例註冊的申請) means an application made before the commencement

date for registration of a 1949 Act or 1977 Act patent under section 3 of the repealed Ordinance, but not as at that date registered under the repealed Ordinance;

***published application for a 1977 Act patent*** (已發表的1977年法令專利的申請) means an application for a patent—

- (a) pursuant to which there could be granted a 1977 Act patent; and
- (b) published before the commencement date, and in the case of an international application reference in paragraph (b) to publication shall be read as a reference to such publication of the application by a designated patent office as serves to indicate that the international application has validly entered its national phase;

***the repealed Ordinance*** (已廢除條例) means the Registration of Patents Ordinance (Cap. 42).

- (2) In this Part, unless the context otherwise requires—
  - (a) a reference to the registration of a patent under the repealed Ordinance is a reference to the issue of a certificate of registration under section 5 of that Ordinance in respect of that patent;
  - (b) a reference to the repealed Ordinance is a reference to that Ordinance as it applied immediately before the commencement date;
  - (c) a reference to a patent granted under this Ordinance pursuant to this Part includes a reference to a patent treated as so granted.

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Editorial Note:

\* Commencement date: 27 June 1997.

**160-163.** (*Omitted as spent—E.R. 2 of 2014*)

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Part 19

19-16

Section 160

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## Schedule 1

[ss. 2 & 153]

### **Paris Convention Countries and WTO Member Countries, Territories and Areas**

*(Format changes—E.R. 2 of 2014)*

#### **Paris Convention countries**

The following are specified for the purposes of the definition of *Paris Convention country* in section 2(1) as countries which have acceded to the Paris Convention—

The Republic of Albania  
The People's Democratic Republic of Algeria  
The Principality of Andorra  
The Republic of Angola  
Antigua and Barbuda  
Republic of Argentina  
The Republic of Armenia  
The Commonwealth of Australia  
The Republic of Austria  
The Republic of Azerbaijan  
The Commonwealth of The Bahamas  
The Kingdom of Bahrain  
The People's Republic of Bangladesh  
Barbados  
The Republic of Belarus  
The Kingdom of Belgium  
Belize  
The Republic of Benin

The Kingdom of Bhutan  
The Plurinational State of Bolivia  
Bosnia and Herzegovina  
The Republic of Botswana  
The Federative Republic of Brazil  
Brunei Darussalam  
The Republic of Bulgaria  
The Burkina Faso  
The Republic of Burundi  
Kingdom of Cambodia  
The Republic of Cameroon  
Canada  
The Central African Republic  
The Republic of Chad  
Republic of Chile  
The People's Republic of China  
The Republic of Colombia  
Union of the Comoros  
The Democratic Republic of Congo  
The Republic of Congo  
The Republic of Costa Rica  
The Republic of Cote d'Ivoire  
The Republic of Croatia  
The Republic of Cuba  
The Republic of Cyprus  
The Czech Republic  
The Kingdom of Denmark  
The Republic of Djibouti  
The Commonwealth of Dominica  
The Dominican Republic  
The Republic of Ecuador  
The Arab Republic of Egypt  
The Republic of El Salvador  
The Republic of Equatorial Guinea



Republic of Estonia  
The Republic of Finland  
The French Republic  
The Gabonese Republic  
The Republic of the Gambia  
Georgia  
The Federal Republic of Germany  
The Republic of Ghana  
Grenada  
The Republic of Guatemala  
The Republic of Guinea  
The Republic of Guinea-Bissau  
The Republic of Guyana  
The Republic of Haiti  
The Hellenic Republic (Greece)  
Holy See  
The Republic of Honduras  
Hungary  
The Republic of Iceland  
The Republic of India  
The Republic of Indonesia  
The Islamic Republic of Iran  
The Republic of Iraq  
Ireland  
The State of Israel  
The Republic of Italy  
Jamaica  
Japan  
The Hashemite Kingdom of Jordan  
The Republic of Kazakhstan  
The Republic of Kenya  
The Democratic People's Republic of Korea  
Republic of Korea  
The State of Kuwait

The Kyrgyz Republic  
The Lao People's Democratic Republic  
Republic of Latvia  
The Republic of Lebanon  
The Kingdom of Lesotho  
The Republic of Liberia  
Libya  
The Principality of Liechtenstein  
The Republic of Lithuania  
The Grand Duchy of Luxembourg  
The Republic of Macedonia  
The Republic of Madagascar  
The Republic of Malawi  
Malaysia  
The Republic of Mali  
The Republic of Malta  
The Islamic Republic of Mauritania  
The Republic of Mauritius  
The Republic of Moldova  
The Principality of Monaco  
Mongolia  
Montenegro  
The Kingdom of Morocco  
The Republic of Mozambique  
The Republic of Namibia  
The Federal Democratic Republic of Nepal  
The Kingdom of the Netherlands  
New Zealand  
The Republic of Nicaragua  
The Republic of Niger  
The Federal Republic of Nigeria  
The Kingdom of Norway  
The Sultanate of Oman  
The Islamic Republic of Pakistan

The Republic of Panama  
The Independent State of Papua New Guinea  
Republic of Paraguay  
The Republic of Peru  
Republic of the Philippines  
The Republic of Poland  
The Portuguese Republic  
The State of Qatar  
Romania  
The Russian Federation  
The Republic of Rwanda  
The Federation of Saint Kitts and Nevis  
Saint Lucia  
Saint Vincent and the Grenadines  
The Independent State of Samoa  
The Republic of San Marino  
The Democratic Republic of Sao Tome and Principe  
The Kingdom of Saudi Arabia  
The Republic of Senegal  
The Republic of Serbia  
The Republic of Seychelles  
The Republic of Sierra Leone  
The Republic of Singapore  
The Slovak Republic  
The Republic of Slovenia  
The Republic of South Africa  
The Kingdom of Spain  
The Democratic Socialist Republic of Sri Lanka  
The Republic of the Sudan  
The Republic of Suriname  
The Kingdom of Swaziland  
The Kingdom of Sweden  
Swiss Confederation  
The Syrian Arab Republic

The Republic of Tajikistan  
The Kingdom of Thailand  
The Republic of Togo  
The Kingdom of Tonga  
The Republic of Trinidad and Tobago  
The Republic of Tunisia  
The Republic of Turkey  
Turkmenistan  
The Republic of Uganda  
Ukraine  
The United Arab Emirates  
The United Kingdom of Great Britain and Northern Ireland  
The United Mexican States  
The United Republic of Tanzania  
The United States of America  
Oriental Republic of Uruguay  
The Republic of Uzbekistan  
The Bolivarian Republic of Venezuela  
The Socialist Republic of Viet Nam  
The Republic of Yemen  
The Republic of Zambia  
The Republic of Zimbabwe

**WTO member countries, territories and areas (not including Paris  
Convention countries)**

The following are specified as being countries, territories or areas which  
have acceded to the World Trade Organisation Agreement—

The Islamic Republic of Afghanistan  
The Republic of Cabo Verde  
European Union  
The Republic of Fiji

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The Macao Special Administrative Region

The Republic of Maldives

The Republic of the Union of Myanmar

Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu

The Solomon Islands

The Republic of Vanuatu

*(Amended L.N. 341 of 1998; L.N. 66 of 2002; L.N. 217 of 2005; L.N. 252 of 2009; L.N. 62 of 2013; L.N. 68 of 2014; L.N. 121 of 2015; L.N. 16 of 2017)*

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## Schedule 2

[s. 156(2)]

### Registration of Patents Ordinance

*(Format changes—E.R. 2 of 2014)*

Section 7G of the Registration of Patents Ordinance (Cap. 42) as applying for the purposes of section 156(1) of this Ordinance reads—

**“7G. Transitional**

- (1) Any question whether—
  - (a) an act done before the commencement date by the Government or a person authorized by the Governor under section 7B, as it read immediately before the commencement date, constitutes the use of a patented invention for the services of the Crown, or
  - (b) any payment falls to be made in respect of any such use (whether to a person entitled to register a patent for the invention, to the patentee or to an exclusive licensee),

shall be determined in accordance with sections 7B to 7D as they read immediately before the commencement date.

- (2) Where an act is begun before the commencement date and continues to be done on or after that date, then, if that act would under the law in force immediately before that date constitute use of a patented invention for the

services of the Crown, its continuance shall constitute Crown use under this Ordinance and shall not constitute an infringement.

- (3) In this section, \**commencement date* (生效日期) means the date on which section 11 of the Intellectual Property (World Trade Organization Amendments) Ordinance 1996 (11 of 1996) comes into operation.”.

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Editorial Note:

\* Commencement date: 10 May 1996.