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(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.]

Section:	64	Compulsory licences for standard patents	L.N. 40 of 2004	07/05/2004
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## PART VIII

### 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
  - (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 stopped 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.]

Section:	65	Provisions about licences under section 64		30/06/1997
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(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.]

Section:	66	Exercise of powers on applications under section 64	L.N. 40 of 2004	07/05/2004
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(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.

(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.]



Section:	67	Opposition to application under sections 64 to 66		30/06/1997
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Expanded Cross Reference:  
64, 65, 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. <\* Note-Exp. x-Ref: Sections 64, 65, 66 \*>  
[cf. 1977 c. 37 s. 52 U.K.]

Section:	68	Declaration of extreme urgency	22 of 1999	01/07/1997
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Expanded Cross Reference:  
69, 70, 71

Remarks:  
Amendments retroactively made - see 22 of 1999 s. 3

## PART IX

### GOVERNMENT USE OF PATENTED INVENTIONS

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. <\* Note - Exp. X-Ref.: Sections 69, 70, 71 \*>  
(Amended 22 of 1999 s. 3)

Section:	69	Government use of patents during a period of extreme urgency	22 of 1999	01/07/1997
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Expanded Cross Reference:  
70, 71, 72

Remarks:  
Adaptation amendments retroactively made - see 22 of 1999 s. 3

(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.

(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. <\* Note - Exp. X-Ref.: Sections 70, 71, 72 \*>

(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-

- (i) after the deemed date of filing of the application for the standard patent for the invention or the date of filing of the application of the short-term patent for the invention, as the case may be; or
- (ii) where priority was claimed, after the date of priority,

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.]

Section:	70	Rights of third parties in respect of Government use	30/06/1997
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(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).

(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.

(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.]

Section:	71	Compensation for loss of profit		30/06/1997
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(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.]

Section:	72	References of disputes as to Government use	30/06/1997
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- (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.]

Section:	72A	Interpretation of Part IXA	L.N. 234 of 2007	22/02/2008
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## PART IXA

### IMPORT COMPULSORY LICENCES FOR PATENTED PHARMACEUTICAL PRODUCTS

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.

(Part IXA added 21 of 2007 s. 5)

Section:	72B	Declaration of extreme urgency for public health problem	L.N. 234 of 2007	22/02/2008
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Expanded Cross Reference:

72C, 72D, 72E, 72F, 72G, 72H, 72I, 72J

(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. < \* Note-Exp. x-Ref: Sections 72C, 72D, 72E, 72F, 72G, 72H, 72I, 72J \* >

(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.

(Part IXA added 21 of 2007 s. 5)

Section:	72C	Grant of import compulsory licences for patented pharmaceutical products	L.N. 234 of 2007	22/02/2008
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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.

(Part IXA added 21 of 2007 s. 5)

Section:	72D	Terms, conditions and nature of import compulsory licences	L.N. 234 of 2007	22/02/2008
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(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.

(Part IXA added 21 of 2007 s. 5)

Section:	72E	Payment of remuneration to proprietors of patents	L.N. 234 of 2007	22/02/2008
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(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).

(Part IXA added 21 of 2007 s. 5)

Section:	72F	Notification of grant of import compulsory licences and remuneration agreed, etc.	L.N. 234 of 2007	22/02/2008
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- (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).

(Part IXA added 21 of 2007 s. 5)

Section:	72G	Termination of import compulsory licences	L.N. 234 of 2007	22/02/2008
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(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.

(Part IXA added 21 of 2007 s. 5)

Section:	72H	Disposal of patented pharmaceutical products after period of extreme urgency etc.	L.N. 234 of 2007	22/02/2008
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(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.

(Part IXA added 21 of 2007 s. 5)

Section:	72I	No infringement of patents by persons to whom patented pharmaceutical products are disposed of in accordance with import compulsory licences	L.N. 234 of 2007	22/02/2008
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(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.

(Part IXA added 21 of 2007 s. 5)

Section:	72J	References of disputes as to import compulsory licences	L.N. 234 of 2007	22/02/2008
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(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 IXA added 21 of 2007 s. 5)

Section:	72K	Interpretation of Part IXB	L.N. 234 of 2007	22/02/2008
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## PART IXB

### EXPORT COMPULSORY LICENCES FOR PATENTED PHARMACEUTICAL PRODUCTS

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 issued in respect of the patent under section 27(1)(b);
- (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.

(Part IXB added 21 of 2007 s. 5)

Section:	72L	Application for export compulsory licences for patented pharmaceutical products	L.N. 234 of 2007	22/02/2008
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(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
    - (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.

(Part IXB added 21 of 2007 s. 5)

Section:	72M	Grant of export compulsory licences for patented pharmaceutical products	L.N. 234 of 2007	22/02/2008
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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)(i)(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).

(Part IXB added 21 of 2007 s. 5)

Section:	72N	Terms, conditions and nature of export compulsory licences	L.N. 234 of 2007	22/02/2008
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(1) The terms and conditions subject to which an export compulsory licence is granted under section 72M 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 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.

(Part IXB added 21 of 2007 s. 5)

Section:	72O	Notification of grant of export compulsory licences	L.N. 234 of 2007	22/02/2008
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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.

(Part IXB added 21 of 2007 s. 5)

Section:	72P	Determination of remuneration payable to proprietors of patents	L.N. 234 of 2007	22/02/2008
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(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).

(Part IXB added 21 of 2007 s. 5)

Section:	72Q	Termination of export compulsory licences	L.N. 234 of 2007	22/02/2008
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(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.

(Part IXB added 21 of 2007 s. 5)

Section:	72R	References of disputes as to export compulsory licences	L.N. 234 of 2007	22/02/2008
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- (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);
  - (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.

(Part IXB added 21 of 2007 s. 5)

Section:	72S	Signature of documents by partnerships, companies and associations	L.N. 234 of 2007	22/02/2008
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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 IXB added 21 of 2007 s. 5)

Section:	73	Prevention of direct use of invention	30/06/1997
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## PART X

### EFFECTS OF PATENT AND PATENT APPLICATION

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]

Section:	74	Prevention of indirect use of invention	30/06/1997
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(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]

Section:	75	Limitation of effect of patent	30/06/1997
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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]

Section:	76	Extent of invention		30/06/1997
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(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.]

Section:	77	Disclosure of invention		30/06/1997
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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]

Section:	78	The claims		30/06/1997
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The claims shall define the matter for which protection is given or sought, be clear and concise and be supported by the description.

[cf. EPC Art. 84; 1992 No. 1 s. 20 Eire]

Section:	79	The abstract		30/06/1997
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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 94(3).

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

Section:	80	Proceedings for infringement of patent		30/06/1997
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Expanded Cross Reference:

73, 74, 75

## PART XI

### INFRINGEMENT

(1) Subject to this Part, 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- <\* Note-Exp. x-Ref: Sections 73, 74, 75 \*>

- (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]

Section:	81	Restrictions on recovery of damages for infringement		30/06/1997
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(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 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 subsection.

(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(1) 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(5).



Section:	82	Relief for infringement of partially valid patent		30/06/1997
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(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.]

Section:	83	Right to continue use begun before priority date		30/06/1997
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(1) Where a patent is granted for an invention, a person who in Hong Kong before the deemed date of filing of the application for the standard patent or the date of filing of the application for the short-term patent (as the case may be) or, if priority was claimed, before the date of priority-

- (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or
- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (2).

(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]

Section:	84	Certificate of contested validity of patent	25 of 1998 s. 2	01/07/1997
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#### Remarks:

Amendments retroactively made - see 25 of 1998 s. 2

(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.) (other than the costs of any appeal in the subsequent proceedings). (Amended 25 of 1998

s. 2)

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

Section:	85	Proceedings for infringement by a co-owner		30/06/1997
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(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.]

Section:	86	Proceedings for infringement by exclusive licensee		30/06/1997
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(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.]

Section:	87	Effect of non-registration on infringement proceedings		30/06/1997
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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.]

Section:	88	Infringement of rights conferred by publication of application for standard patent		30/06/1997
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Expanded Cross Reference:  
85, 86, 87

(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- <\* Note-Exp. x-Ref: Sections 85, 86, 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 the reference in section 81(3) to section 39(4) shall be read as a reference to section 33(4).

(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 date of publication of the request to record, 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.

(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.]

Section:	89	Remedy for groundless threats of infringement proceedings	30/06/1997
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(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) 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 unless-

- (a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and
- (b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(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.

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

Section:	90	Declaration as to non-infringement	30/06/1997
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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 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.]

Section:	91	Power to revoke patents on application		30/06/1997
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## PART XII

### REVOCATION OF PATENTS

#### General provisions

- (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 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 standard patents for the same invention, the applications for which were filed by the same person and have the same deemed date of filing;
  - (g) that the patent is one of 2 short-term patents for the same invention, the applications for which were filed by the same person and have the same date of filing;
  - (h) that-
    - (i) the patent is one of 2 patents for the same invention, one such patent being a standard patent and the other being a short-term patent, the applications for which were filed by the same person and have the same deemed date of filing or date of filing; and
    - (ii) the 2 patents are not under the proprietorship of the same person;
  - (i) in the case of a standard patent, 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) to (h) 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) In subsection (1)(f), (g) and (h)-
- (a) reference to the date of filing or deemed date of filing of an application for a patent shall be read as a reference to that date or, if priority was claimed in respect of the application, to the date of priority of the application;
  - (b) reference to the applications for 2 patents being filed by the same person shall be read as a reference to that case or to the case where-
    - (i) the person filing one of the applications is the successor in title to the person filing the other application; or
    - (ii) the persons filing the applications are both successors in title to the same former proprietor of the invention.

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

Section:	92	Application for revocation		30/06/1997
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- (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), (g) or (h), 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, or to amend one or both specifications so as to prevent there being 2 patents in respect of the same invention, 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.

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

Section:	93	Patentable inventions		30/06/1997
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#### Patentable inventions

(1) An invention is patentable if it is susceptible of industrial application, is new and involves an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning 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;
- (d) the presentation of information.

(3) Subsection (2) shall exclude patentability of subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to such subject-matter or activities as such.

(4) A method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body shall not be regarded as an invention which is susceptible of industrial application for the purposes of subsection (1), but this subsection shall 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 shall not be a patentable invention; however, the working of an invention shall not be deemed to be so contrary merely because it is prohibited by any law in force in Hong Kong.

(6) A plant or animal variety or an essentially biological process for the production of plants or animals, other than a microbiological process or the products of such a process, shall not be patentable.

[cf. EPC Art. 52 & 53; 1977 c. 37 ss. 1 & 4 U.K.; 1992 No. 1 ss. 9 & 10 Eire]

Section:	94	Novelty		30/06/1997
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(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public (whether in Hong Kong or elsewhere) by means of a written or oral description, by use, or in any other way-

- (a) before the deemed date of filing of an application for a standard patent for the invention or, if priority was claimed, before the date of priority; or
- (b) before the date of filing of an application for a short-term patent for the invention or, if priority was claimed, before the date of priority,

whichever is the earlier.

(3) Additionally, the state of the art shall be considered as comprising the content of-

- (a) any application for a standard patent as filed, of which-
  - (i) the deemed date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and

- (ii) the corresponding designated patent application was published in the designated patent office on or after the date referred to in subsection (2);
- (b) any designated patent application as filed in a designated patent office-
  - (i) of which the date of filing or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office is before the date referred to in subsection (2); and
  - (ii) which was published by the designated patent office on or after the date referred to in subsection (2); or
- (c) any application for a short-term patent-
  - (i) of which the date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and
  - (ii) pursuant to which a short-term patent was published under this Ordinance on or after the date referred to in subsection (2).

(4) Subsections (1) to (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 93(4) where its use for any method referred to in that subsection is not comprised in the state of the art.

[cf. EPC Art. 54; 1977 c. 37 s. 2 U.K.; 1992 No. 1 s. 11 Eire]

Section:	95	Non-prejudicial disclosure in case of standard patent application		30/06/1997
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(1) For the application of section 94 in the case of a standard patent application, but subject to section 15(2)(f), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the deemed date of filing of the application and if it was due to, or in consequence of-

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
- (b) the fact that the applicant or any proprietor of the invention for the time being has displayed the invention at a prescribed exhibition or meeting.

(2) Subsection (1)(b) shall only have effect if, 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.

[cf. EPC Art. 55]

Section:	96	Inventive step		30/06/1997
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(1) An invention shall be considered 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 purpose of subsection (1), if the state of the art also includes documents within the meaning of section 94(3), these documents are not to be considered in deciding whether there has been an inventive step.

[cf. EPC Art. 56]

Section:	97	Industrial application		30/06/1997
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An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

[cf. EPC Art. 57]

Section:	98	Priority right		30/06/1997
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#### Priority for standard patent application

(1) This section applies to the proprietor of a designated patent application for an invention who, on the basis of an earlier application in a Paris Convention country for a patent or other protection for the same invention, enjoys under the law of the designated patent office a right of priority for the period of 12 months after the date of filing the earlier application.

(2) Such person or his successor in title shall enjoy, for the purposes of filing an application for a standard patent for the invention which is the subject of the designated patent application, the same right of priority as he enjoys in respect of the designated patent application under the law of the designated patent office.

(3) Subsections (1) and (2) also apply where-

- (a) the earlier application was filed in a country, territory or area which is not a Paris Convention country; and
- (b) the right of priority enjoyed in the designated patent office is granted consequent upon an international agreement to which Hong Kong is a party or which is otherwise applied to Hong Kong by a party to the agreement, which agreement 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.

(4) Reference in this section to the law of a designated patent office includes reference to the law of the designated patent office dealing with the circumstances under which-

- (a) a filing in 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 a previous first application and filed in or in respect of the same Paris Convention country is to be considered as the first application for the purposes of determining priority;
- (c) multiple priorities may be claimed in respect of a designated patent application.

(5) The rights conferred by this section are subject to sections 15(2)(e) and 23(3)(c).

(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.

[cf. EPC Art. 87 & 88; 1992 No. 1 ss. 25 & 26 Eire; 1977 c. 37 s. 5 U.K.]

Section:	99	Effect of priority right		30/06/1997
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(1) The right of priority conferred under section 98 shall have the effect that the date of priority enjoyed in the designated patent office shall be regarded as being the date of priority of the standard patent application for the purposes of this Ordinance.

(2) A patent granted pursuant to a standard patent application in respect of which the proprietor enjoys a right of priority as provided in section 98 shall not be invalidated by reason only of the fact that 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.

[cf. EPC Art. 89; 1992 No. 1 s. 27 Eire]

Section:	100	Right to a patent to belong to inventor		30/06/1997
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#### Right to a patent

(1) Except as provided in subsection (2), the right to a patent shall belong to the inventor or his successor in title.

(2) If the inventor is an employee, the right to the patent shall be determined in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed or, if the identity of such country, territory or area cannot be determined, in accordance with the law of the country, territory or area in which the employer has his place of business to which the employee is attached.

(3) If 2 or more persons have made an invention independently of each other, the right to the patent shall belong-

- (a) as between persons who have applied for or been granted a standard patent for the invention, to the person in respect of whose application for the standard patent the date of filing of the corresponding designated patent application or, if priority was claimed, the date of priority, is the earlier or earliest; or
- (b) as between persons who have applied for or been granted a short-term patent for the invention, to the person in respect of whose application for a short-term patent the date of filing or, if priority was

claimed, the date of priority, is the earlier or earliest; or

- (c) where one or more of the persons has applied for or been granted a standard patent and one or more of the persons has been granted a short-term patent, to the person in respect of whose application the date specified in paragraphs (a) and (b) (as may be appropriate) is the earlier or earliest,

but in the application of paragraphs (a) and (c) regard shall only be had to an application for a standard patent that has been published under this Ordinance.

[cf. EPC Art. 60; 1992 No. 1 s. 16 Eire]

Section:	101	Proceedings in which validity of patent may be put in issue	30/06/1997
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#### Putting validity 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.

(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.]

Section:	102	Amendment of patent in infringement or revocation proceedings	30/06/1997
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### PART XIII

#### GENERAL PROVISIONS AS TO AMENDMENT OF PATENTS AND PATENT APPLICATIONS

(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, 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.



(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.]

Section:	103	Amendments of applications and patents not to include added matter		30/06/1997
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(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,

may be filed under section 55(4), or as mentioned in section 22 or 116 (as may be appropriate), but shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(2) Any amendment of an application for a standard patent filed under section 31 shall be 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 filed under section 46(1) or 102, or of the specification of a standard patent filed under section 43 shall be 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.

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

Section:	104	Language of proceedings before Registrar		30/06/1997
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## PART XIV

### LANGUAGE OF PROCEEDINGS; AUTHENTIC TEXT

(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 in respect of that invention to be filed in the same official language.

(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.

Section:	105	Authentic text		30/06/1997
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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)]

Section:	106	Authentic text of standard patent and standard patent application		30/06/1997
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(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 or standard patent application respectively for the purposes of any proceedings under this Ordinance relating to the standard patent or standard patent application before the Registrar or a court.

(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 or of the claims of the standard patent application respectively for the purpose of any proceedings under this Ordinance, other than proceedings for the revocation of the patent.

(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 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-

- (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.

Section:	107	Amendment to patent or patent application to be in authentic text		30/06/1997
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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.

Section:	108	Right to apply for a short-term patent		30/06/1997
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## PART XV

### SHORT-TERM PATENTS

#### Right to short-term patent

(1) An application for a short-term patent to be granted under section 118 may be made by any person either alone or jointly with another.

(2) For the purposes of proceedings before the Registrar the applicant shall be deemed to be entitled to exercise the right to the short-term patent.

Section:	109	Non-prejudicial disclosure		30/06/1997
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#### Patentability

For the purposes of section 94, a disclosure of the 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-

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
- (b) the fact that the applicant or his legal predecessor has 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 has been so displayed and contains written evidence in support of the statement complying with any prescribed conditions.

[cf. EPC Art. 55]

Section:	110	Priority right	L.N. 47 of 2002	01/06/2002
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#### Priority

(1) A person who has filed-

- (a) in or for any Paris Convention country or WTO member country, territory or area, an application for a patent or other protection in respect of an invention; or
- (b) in Hong Kong, an application for a short-term patent under this Part in respect of an invention,

or his successors in title, shall enjoy, for the purpose of filing a subsequent application for a short-term patent under this Part in respect of the same invention, a right of priority for the period of 12 months after the date of filing of the first application, subject to compliance with any prescribed conditions.

(2) For the purposes of subsection (1) as it applies in the case of a filing specified in paragraph (a) of that subsection-

- (a) every filing which in a Paris Convention country or WTO member country, territory or area is equivalent to a regular national filing under its domestic legislation or under bilateral or multilateral agreements shall be recognized as giving rise to a right of priority;
- (b) a subsequent application for a patent or other protection for the same subject-matter as a previous first

application and filed in or for the same Paris Convention country or WTO member country, territory or area shall 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;

- (c) where pursuant to paragraph (b) a subsequent application for a patent or other protection is considered as a first application, the previous application may not thereafter 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 (1) as it applies in the case of a filing specified in paragraph (b) of that subsection-

- (a) every regular filing of an application for a short-term patent under this Part shall be recognized as giving rise to a right of priority in relation to other applications under this Part;
- (b) a subsequent application for a short-term patent under this Part for the same subject-matter as a previous first application for a short-term patent shall 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;
- (c) where pursuant to paragraph (b) a subsequent application for a short-term patent is considered as a first application, the previous application for a short-term patent may not thereafter serve as a basis for claiming a right of priority,

and in this subsection "regular filing of an application for a short-term patent" (短期專利申請的正規提交) means any filing that establishes the date on which the application for the short-term patent was filed, whatever may be the outcome of the application.

(3A) A right of priority arising as a result of the filing in or for any Paris Convention country or WTO member country, territory or area of an application for a patent or other protection in respect of an invention, or an application for a short-term patent under this Part, may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the person's "successors in title" shall be construed accordingly. (Added 2 of 2001 s. 8)

(4) In this section, "application for a patent or other protection" (專利或其他保護的申請) means an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate filed in or for any Paris Convention country or WTO member country, territory or area.

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

Section:	111	Claiming priority		30/06/1997
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(1) An applicant for a short-term patent desiring to take advantage of the priority of a previous application shall file in the prescribed manner a statement of priority and a copy of the previous application.

(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) 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.

[cf. EPC Art. 88]

Section:	112	Effect of priority right		30/06/1997
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(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 section 94(2) and (3) as it applies to this Part.

(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]

Section:	113	Requirements of short-term patent application		30/06/1997
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### Applications

(1) Every application for a short-term patent shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain-

- (a) a request for the grant of a short-term patent;
- (b) a specification which provides on the face of it for-
  - (i) a description of the invention to which the application relates;
  - (ii) one or more claims but not exceeding one independent claim;
  - (iii) any drawings referred to in the description or the claim or claims;
- (c) an abstract; and
- (d) a search report in relation to the invention.

(2) An application for a short-term patent-

- (a) shall state the name and address of the applicant;
- (b) shall identify the person or persons whom the applicant believes to be the inventor or inventors and shall specify the last known address of that person or persons;
- (c) where the applicant is not the sole inventor or the applicants are not the joint inventors, shall contain a statement indicating the derivation of his or their entitlement to exercise the right to the short-term patent; and
- (d) shall specify an address in Hong Kong for service of documents.

(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 provide-

- (a) that a short-term patent application shall or may contain a title of the invention and a designation of the classification of the invention;
- (b) for the manner in which the following matters shall or may be contained in a short-term patent application-
  - (i) any statement in accordance with subsection (2) relating to the inventor or the derivation of the applicant's right to grant;
  - (ii) any claim to the priority of an earlier patent application and supporting priority documents in accordance with section 111;
  - (iii) any request for deferral of the grant of a patent in accordance with section 119;
  - (iv) any claim regarding non-prejudicial disclosure in accordance with section 109;
  - (v) in relation to any invention which requires for its performance the use of a micro-organism, information concerning the availability to the public of samples of the micro-organism.

(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 within such further period of grace as may have been allowed under subsection (6) the application shall be deemed to be withdrawn.

(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) The foregoing provisions shall not prevent any application being initiated by documents complying with

section 114(2).

(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]

Section:	114	Examination on filing		30/06/1997
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- (1) The Registrar shall examine whether-
  - (a) the short-term patent application satisfies the requirements specified in subsection (2) for the accordance of a date of filing ("minimum requirements");
  - (b) the prescribed filing fee and advertisement fee has been paid in due time.
- (2) The date of filing of a short-term patent application shall be the earliest date on which documents filed by the applicant contain-
  - (a) an indication that a short-term patent is sought;
  - (b) information identifying the applicant;
  - (c) a part which on the face of it appears to be a description of an invention.
- (3) If a date of filing cannot be accorded because of deficiencies as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules.
- (4) If the deficiencies are not corrected within the time prescribed in the rules, the application shall not be dealt with as an application for a short-term patent.

[cf. EPC Art. 80 & 90]

Section:	115	Examination as to formal requirements		30/06/1997
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- (1) If a short-term patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of section 113(5), the Registrar shall examine whether the requirements of section 113 and of any rules made for the purposes of that section (the "formal requirements") have been satisfied.
- (2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules.
- (3) If-
  - (a) there are deficiencies as regards the formal requirements which cannot be corrected the application for a short-term patent shall be refused; or
  - (b) any deficiencies as regards the formal requirements noted in the examination under subsection (1) are not corrected in accordance with the rules, then except as provided in subsection (4), the application for a short-term patent shall be refused or, if no steps are taken to correct the deficiencies, shall be deemed to be withdrawn.
- (4) If a deficiency relating solely to a claim to any right of priority is not duly corrected then such right shall be lost for the application.

[cf. EPC Art. 91]

Section:	116	Divisional short-term patent application	L.N. 46 of 2001	01/04/2001
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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,

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.

Section:	117	Formality examination only		30/06/1997
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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 45, 77, 78, 79, 93, 94, 96, 97, 100, 109, 110, 111(2) to (6) or 120(2).

Section:	118	Grant of short-term patent and publication	L.N. 40 of 2004	07/05/2004
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#### Procedure up to and including grant

(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 noted by the Registrar 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.

- (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.

Section:	119	Deferral of grant of patent at applicant's request		30/06/1997
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(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.

Section:	120	Amendment of application for short-term patent before grant		30/06/1997
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(1) Subject to this section and sections 122 and 103, 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.

(2) Any amendment made under this section shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(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.]

Section:	121	Withdrawal of application		30/06/1997
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(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 deemed under this Ordinance to have been withdrawn, or is refused under any provision of this Ordinance, the following provisions shall apply-

- (a) the applicant shall continue to enjoy the right of priority under section 112 which he enjoyed immediately before such withdrawal or refusal;
- (b) no other right may be claimed under this Ordinance in relation to the application.

Section:	122	Limitation on withdrawal, amendment, etc. of application		30/06/1997
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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.

Section:	123	Further processing of, and restoration of rights in respect of, short-term patent applications		30/06/1997
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(1) Sections 28(1) and (2), 29(1) and (2) and 30 shall apply, subject to necessary modification, to an application for a short-term patent as if a reference in those sections to an application for a standard patent and to Part II were a reference to an application for a short-term patent and to this Part respectively.

(2) Section 28 as applied by subsection (1) does not apply in the case of a deemed withdrawal of an application 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 113, 114 or 115.

Section:	124	Registrar may refuse to grant short-term patent		30/06/1997
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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 93(5), and the Registrar shall give notice of any such refusal to the applicant.

Section:	125	Short-term patent application based on international application	L.N. 47 of 2002	01/06/2002
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(1) Where an international application seeking 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.

(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 (1)(b) to (d) of that section there was substituted a reference to the documents specified in subsection (3)(a) to (e) of this section.

(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. (Amended 2 of 2001 s. 9)

Section:	126	Term of short-term patent	L.N. 40 of 2004	07/05/2004
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#### Provisions as to short-term patents after grant

(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 subsection (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.

(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.]

Section:	127	Restoration of lapsed short-term patents		30/06/1997
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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.

Section:	128	Disclosure of invention by specification; availability of samples of micro-organisms		30/06/1997
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Miscellaneous

(1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a short-term patent, or of a short-term patent, for an invention which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner sufficiently clear and complete for the invention to be performed by a person skilled in the art.

- (2) The rules may in particular require the applicant or proprietor-
- (a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism; and
  - (b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the Registrar has given his certificate as to any matter.

(4) An application for revocation of the short-term patent under section 91(1)(c) may be made if any of the requirements of the rules cease to be complied with.

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

Section:	129	Court proceedings in relation to short-term patents		30/06/1997
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(1) In any proceedings before a court for the enforcement of rights conferred under this Ordinance in relation to a short-term patent-

- (a) it is for the proprietor of the patent to establish the validity of the patent, and the fact that the patent has been granted under this Part shall be of no account in that regard;
- (b) evidence by the proprietor which is sufficient to establish prima facie the validity of the patent shall in the absence of evidence to the contrary be sufficient proof of such validity.

(2) If in proceedings before the court under this Ordinance in relation to a short-term patent 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.

- (3) A court making an order for an early trial under subsection (2)-
- (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.

Section:	130	Appeal from Registrar		30/06/1997
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**PART XVI**

MISCELLANEOUS

(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.

Section:	131	Registrar's appearance in proceedings involving register		30/06/1997
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(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.

Section:	132	General powers of the court		30/06/1997
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(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.]

Section:	133	Procedure in case of option to apply to court or Registrar		30/06/1997
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(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]

Section:	134	Burden of proof in certain cases		30/06/1997
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(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.]

Section:	135	Exercise of Registrar's discretionary powers		30/06/1997
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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.]

Section:	136	Costs and expenses in proceedings before court	L.N. 47 of 2002	01/06/2002
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(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.]

Section:	137	Costs and expenses in proceedings before Registrar		30/06/1997
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(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.]

Section:	138	Licences granted by order of the court or Registrar or by Director of Health*	L.N. 234 of 2007	22/02/2008
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(1) Any order for the grant of a licence under section 14, 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)

(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.]

\* (Amended 21 of 2007 s. 6)

Section:	139	Immunity of Registrar as regards official acts		30/06/1997
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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.]

Section:	139A	Protection of Government and public officers	L.N. 234 of 2007	22/02/2008
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(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 IX, IXA or IXB (as the case may be).

(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)

Section:	140	Recognition of agents		30/06/1997
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(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.

Section:	141	Falsification of register, etc.		30/06/1997
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## PART XVII

### OFFENCES

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.]

Section:	142	Unauthorized claim of patent rights		30/06/1997
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(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.]

Section:	143	Unauthorized claim that patent has been applied for		30/06/1997
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(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 withdrawn or deemed withdrawn,

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 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).

(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.]

Section:	144	Misuse of title "Patents Registry"		30/06/1997
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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.]

Section:	145	Offences by corporations or partners		30/06/1997
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(1) Where an offence 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.

Section:	146	Correction of errors in patents and applications		30/06/1997
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## PART XVIII

### ADMINISTRATIVE PROVISIONS

(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.]

Section:	147	Information about patent applications and patents, and inspection of documents		30/06/1997
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(1) After publication of an application for a standard patent in accordance with section 20 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.

(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, 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.

(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) 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.

[cf. 1977 c. 37 s. 118 U.K.]

Section:	148	Hours of business and excluded days	L.N. 40 of 2004	07/05/2004
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(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.

Section:	149	Rules		30/06/1997
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(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 a provision of this Ordinance to be prescribed, and generally for regulating practice and procedure under this Ordinance.

- (2) Without prejudice to the generality of subsection (1), rules may make provision-
- (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.
- (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.]

Section:	150	Registrar may specify forms to be used	L.N. 40 of 2004	07/05/2004
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(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)

Section:	150A	Power to specify official journal, etc.	L.N. 40 of 2004	07/05/2004
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(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)

Section:	151	Application*	2 of 2009	08/05/2009
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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]

**Note:**

\* (Replaced 2 of 2009 s. 6)

Section:	152	Forfeited articles		30/06/1997
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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.]

Section:	153	Amendment of Schedule 1	L.N. 47 of 2002	01/06/2002
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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)

Section:	154	Repeal		30/06/1997
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## PART XIX

### REPEALS AND TRANSITIONAL ARRANGEMENTS

- (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.

Section:	155	Validity of instruments made or things done under the repealed Ordinance		30/06/1997
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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.

Section:	156	Use of patented inventions for service of the Crown		30/06/1997
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Expanded Cross Reference:

69, 70, 71, 72

(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. < \* Note-Exp. x-Ref: Sections 69, 70, 71, 72 \* >

Section:	157	Infringement		30/06/1997
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Expanded Cross Reference:

73, 74, 75, 82, 83, 84, 85, 86, 87

(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 < \* Note-Exp. x-Ref: Sections 73, 74, 75, 85, 86, 87 \* >

(b) sections 82 to 84 shall apply to any such act which infringes an existing registered 1977 Act patent, < \* Note-Exp. x-Ref: Sections 82, 83, 84 \* >

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.

Section:	158	Rules providing for transitional arrangements	22 of 1999	01/07/1997
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Remarks:

Amendments retroactively made - see 22 of 1999 s. 3

- (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.

Section:	159	Interpretation (Part XIX)	30/06/1997
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(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.

Section:	160	(Omitted as spent)	30/06/1997
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(Omitted as spent)

Section:	161	(Omitted as spent)	30/06/1997
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(Omitted as spent)

Section:	162	(Omitted as spent)	30/06/1997
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(Omitted as spent)

Section:	163	(Omitted as spent)		30/06/1997
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(Omitted as spent)

Schedule:	1	PARIS CONVENTION COUNTRIES AND WTO MEMBER COUNTRIES, TERRITORIES AND AREAS	L.N. 252 of 2009	26/02/2010
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[sections 2 & 153]

### 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 Democratic People's 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 Republic of Bolivia  
 Bosnia and Herzegovina  
 The Republic of Botswana  
 The Federative Republic of Brazil  
 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 Republic of France  
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 Cooperative Republic of Guyana  
The Republic of Haiti  
The Hellenic Republic (Greece)  
Holy See  
The Republic of Honduras  
The Republic of 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  
Kyrghyz Republic  
The Lao People's Democratic Republic  
Republic of Latvia  
The Republic of Lebanon  
The Kingdom of Lesotho  
The Republic of Liberia  
The Great Socialist People's Libyan Arab Jamahiriya  
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  
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 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 Republic of Tanzania  
 The United States of America  
 The United States of Mexico  
 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-

Negara Brunei Darussalam  
 The Republic of Cape Verde  
 European Community  
 The Republic of The Fiji Islands  
 The State of Kuwait  
 The Macao Special Administrative Region  
 The Republic of Maldives  
 The Union of Myanmar  
 Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu  
 The Solomon Islands

(Amended L.N. 341 of 1998; L.N. 66 of 2002; L.N. 217 of 2005; L.N. 252 of 2009)

Schedule:	2	REGISTRATION OF PATENTS ORDINANCE	30/06/1997
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[section 156(2)]

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."