

**Explanatory Notes on the
Proposed Amendments to
(a) Rules of the High Court (Cap. 4A),
(b) Trade Marks Rules (Cap. 559A),
(c) Patents (General) Rules (Cap. 514C) and
(d) Registered Designs Rules (Cap. 522A)
for proceedings under the Trade Marks Ordinance (Cap. 559),
Patents Ordinance (Cap. 514) and Registered Designs Ordinance (Cap. 522)**

PURPOSE

We are seeking your views on our legislative proposals to –

- (i) substitute the current Order 100 of the Rules of the High Court (Cap. 4A) (“RHC”) concerning court proceedings under the Trade Marks Ordinance (Cap. 559) (“TMO”) by a new Order 100;
- (ii) substitute the current Order 103 of the RHC concerning court proceedings under the repealed Registration of Patents Ordinance (Cap. 42) by a new Order 103 concerning court proceedings under the Patents Ordinance (Cap. 514) (“PO”);
- (iii) add a new Order 122 to the RHC to prescribe procedures related to court proceedings under the Registered Designs Ordinance (Cap. 522) (“RDO”);
- (iv) introduce several necessary or incidental amendments to the Trade Marks Rules (Cap. 559A) (“TMR”), Patents (General) Rules (Cap. 514C) (“PGR”) and Registered Designs Rules (Cap. 522A) (“RDR”) so as to elaborate or clarify certain proceedings before the Registrar of Trade Marks, Patents and Designs under the TMO, PO and RDO respectively.

BACKGROUND

2. At present, certain proceedings under the TMO, PO and RDO may be conducted before the Court of First Instance of the High Court (“the Court”). Such proceedings are regulated by the RHC which are made by the Rules Committee of the High Court. The existing Order 100 and Order 103 of the RHC (concerning court

proceedings under the TMO and PO respectively) were enacted in 1988 and have not been substantively amended since then. As for court proceedings under the RDO, there is no provision in the RHC to regulate the relevant procedures. As such, we need to bring the relevant provisions in the RHC up-to-date for proper and effective regulation of court proceedings under the TMO, PO and RDO as currently in force.

3. On the other hand, certain proceedings under the TMO, PO and RDO may be brought before the Registrar of Trade Marks/Patents/Designs respectively as regulated by the TMR, PGR and RDR, and some of these proceedings may be referred by the Registrar of Trade Marks/Patents/Designs to the Court for determination under the respective principal ordinance. There is however yet to be any provision in the corresponding subsidiary legislation to regulate the procedures for the Registrar of Trade Marks/Patents/Designs in making such reference. As such, we propose introducing amendments to the TMR, PGR and RDR for, amongst others, aligning the procedure of making reference to the Court with the proposed corresponding new procedural rules under the RHC.

KEY PROPOSALS

4. The following paragraphs summarize the key amendments proposed to be introduced to the RHC and the corresponding amendments to the TMR, PGR and RDR with justifications.

A. PROPOSED AMENDMENTS TO THE RHC

(i) *Trade Marks – Proceedings before the Court under the TMO* ***(Draft new Order 100 to substitute the current Order 100 of the RHC)***

5. The existing Order 100 was enacted in 1988 when the old Trade Marks Ordinance (Cap. 43) (“the old Ordinance”) was in force. When the old Ordinance was repealed and replaced by the TMO on 4 April 2003, references to the old Ordinance were removed from Order 100 by consequential amendment. However, no other substantive amendments have been made to Order 100 since then¹ in order to bring it up to date. The existing Order 100 therefore lacks sufficient details to cater for

¹ In 2003, two amendments were made to O100 rule 2: (i) in paragraph (1), repealing “the Trade Marks Ordinance (Cap 43)” and substituting “the Trade Marks Ordinance (Cap 559)”; and (ii) repealing paragraph (6) which relates to certain specific provisions of Cap 43. In 2009, as part of the civil justice reform, references to originating motion in paragraphs (2) and (3) of O100 rule 2 were amended to originating summons, and Form No. 10 was specified (in Appendix A to the RHC (Cap. 4A)).

proceedings under the TMO.

6. As such, we propose to introduce new provisions of Order 100 to substitute the current Order 100, a draft of which is contained in the draft ***Rules of the High Court (Amendment) Rules*** at **Annex A**, to provide the detailed rules and procedures for proceedings before the Court relating to trade marks under the TMO.

7. A summary of the major provisions of the new Order 100 is set out below -

Interpretation (Order 100, rule 1)

7.1 This rule provides for the definitions of terms used in Order 100.

Application (Order 100, rule 2)

7.2 This rule stipulates that subject to the provisions of Order 100, the RHC shall apply to proceedings before the Court under the TMO.

Applications under the TMO (Order 100, rule 3)

7.3 Rule 2 of the existing Order 100 will be replaced by a new rule 3.

7.4 The current rule 2(1) provides that every appeal to the Court under the TMO shall be heard and determined by a single judge. Since this matter is already covered under rule 2 of Order 55², the current rule 2(1) of Order 100 is redundant and should therefore be repealed.

7.5 Currently, rule 2(2) of Order 100 provides that every application to the Court under the TMO may be begun by originating summons in Form No. 10. As decided by the Rules Committee of the High Court, the applicant could choose to commence court proceedings under the TMO by writ or by originating summons³, as appropriate, in accordance with the usual practice in civil litigation. Provision is made under rule 3(1) of Order 100 accordingly.

² Rule 2 of Order 55 (Appeals to the High Court from Court, Tribunal or Person: General) of the RHC (Cap. 4A) specifies that “*Except where it is otherwise provided by these rules or under any enactment, an appeal to which this Order applies shall be heard and determined by a single judge*”.

³ To commence proceedings by originating summons, an applicant may use Form No. 8 (standard form) or Form No. 10 (expedited form).

7.6 The current rule 2(4) provides that where the Registrar of Trade Marks refers to the Court an application made to him, the applicant shall, within one month after receiving notification of the decision to refer, make to the Court the application referred. As it is the Registrar of Trade Marks, rather than the applicant, who should refer such application to the Court under section 77(1)(b) of the TMO, the current rule 2(4) is inconsistent with section 77(1)(b) of the TMO, and should therefore be repealed. We propose to introduce a new rule 6 into Order 100 for prescribing the relevant procedures.

7.7 It is further proposed that the current rule 2(5) of Order 100 should be deleted as the extension of the time limit for filing an appeal to the Court should be at the discretion of the Court and not the Registrar of Trade Marks.

Applications under section 23 or 25 of the TMO (Order 100, rule 4)

7.8 We propose adding a new rule for prescribing the modes of commencing action in the Court to obtain an order for delivery up and order for disposal under sections 23 and 25 of the TMO.

Proceedings for infringement of registered trade mark (Order 100, rule 5)

7.9 The heading of the current rule 3 of Order 100 refers only to dispute of validity of registration. The proposed rule 5 of the draft Order 100 provides that a party may in its defence contest the registration of a trade mark and counterclaim for an order for the revocation of the registration, a declaration of invalidity of the registration, an order for the variation of the registration, or an order for rectification of the register. To reflect more accurately the content of the rule, the heading of this rule should be amended to “*Proceedings for infringement of registered trade mark: registration disputed or revocation, variation or rectification sought*”.

7.10 Rule 5 sets out more clearly the different types of relief a party may seek from the Court under rule 5(1)(b).

7.11 Rule 5(2) seeks to clarify that the defence or counterclaim must include particulars of the objections to the registration of the trade mark.

7.12 Under paragraph 3(a) of rule 5, the defendant must serve on all other parties a copy of the defence or counterclaim. Further, under paragraphs (3)(b) of rule 5, a defendant who counterclaims for any relief set out under rule 5(1)(b) must serve a copy of the counterclaim on the Registrar of Trade Marks. The Registrar is entitled to take part in the proceedings in accordance with paragraphs (4) to (5) of rule 5.

Reference to the Court under section 77(1)(b) of the TMO (Order 100, rule 6)

7.13 The proposed new rule 6 seeks to prescribe the procedures for the Registrar of Trade Marks in referring to the Court an application on a question concerning a registered trade mark or an application for registration of trade mark under section 77(1)(b) of the TMO. In particular, the rule sets out what the Registrar of High Court must do upon receiving the reference from the Registrar of Trade Marks, what the plaintiff and other parties must do upon receiving a written notice of such reference, and what the other parties can do should the plaintiff fail to take out a case management summons within the prescribed time limit.

Service of documents (Order 100, rule 7)

7.14 The proposed new rule 7 allows the service of documents on the owner of a registered trade mark at the address for service as recorded on the register until an address for service is provided under Order 12 of the RHC, and supplements provisions on service of documents under Order 10 of the RHC.

Filing of orders etc. on Registrar of Trade Marks (Order 100, rule 8)

7.15 The proposed new rule 8 provides for the filing of a sealed copy of any order, declaration or certificate made or granted by the Court

under the TMO with the Registrar of Trade Marks.

(ii) ***Patents – Proceedings before the Court under the PO
(Draft new Order 103 of the RHC to substitute the current Order 103 of the RHC)***

8. The existing Order 103 of the RHC sets out the rules for regulating proceedings before the Court in relation to the repealed Registration of Patents Ordinance (Cap 42). That Ordinance has been repealed and replaced by the PO since June 1997 but Order 103 has not been updated to cater for the new PO. As opposed to the repealed Ordinance which only deals with the re-registration in Hong Kong of a patent granted or take effect in the United Kingdom⁴ (UK), the PO has introduced (a) a new re-registration for grant of standard patents in Hong Kong for patents granted in the designated patent offices, namely the State Intellectual Patent Office in Mainland China, the UK Intellectual Property Office and the European Patent Office (in respect of a patent designating UK); and (b) the grant of short-term patents. In addition, the PO provides for a variety of court proceedings relating to patent applications and patents granted in Hong Kong, covering applications/proceedings made/filed directly to the Court and reference of proceedings made by the Registrar of Patents to the Court. For the purposes of these proceedings, a new set of Order 103 (see the draft Order 103 in the draft ***Rules of the High Court (Amendment) Rules*** at **Annex B**) has been drawn up to tally with the relevant provisions in the PO⁵.

9. A summary of the major provisions of the new Order 103 is set out below -

Interpretation (Order 103, rule 1)

9.1 This rule provides for the definitions of terms used in Order 103.

Application (Order 103, rule 2)

9.2 This rule stipulates that the RHC shall apply to proceedings before the Court under the PO subject to the provisions under Order 103.

⁴ Such patent may be a European patent (UK) which takes effect in the United Kingdom pursuant to section 77 of the Patents Act 1977.

⁵ The types of court proceedings covered under the new Order 103 include applications made to the Court under sections 13(1), 14(5), 46(1), 53(1), 55(1), 56(5), 58(1) and (2), 59(7), 64(1), 66(3), 72J, 72R, 91(1) and 102; references made by the Registrar of Patents to the Court under sections 44(5), 48(4), 49(2)(b) and 133(1)(b); and proceedings under sections 80 and 88 of the PO.

Proceedings to be begun by originating summons (Order 103, rule 3)

9.3 This rule prescribes that certain proceedings under the PO must be begun by originating summons.

Supplementary provisions relating to originating summons (Order 103, rule 4)

9.4 This rule sets out what information should an originating summons contain, and also the scope of applicability of Order 10 on service of originating process to the service of an originating summons taken out under Order 103.

Reference under section 13(1)(a) (right to apply for grant of standard patent) (Order 103, rule 5)

9.5 This rule deals with the service of an originating summons in proceedings relating to right to apply for standard patent under section 13(1)(a) of the PO.

Reference under section 13(1)(b) (right in or under application for standard patent) (Order 103, rule 6)

9.6 This rule deals with the service of an originating summons in proceedings relating to right in or under application for standard patent under section 13(1)(b) of the PO.

Reference under section 14(5) (right to be granted licence, etc.) (Order 103, rule 7)

9.7 This rule deals with the service of an originating summons in proceedings relating to the right to be granted licence and the period and terms of the licence under section 14(5) of the PO.

Reference under section 44(5) before/after expiry of period for filing counter-statement (application for revocation under section 44(4)) (Order 103, rules 8 & 9)

- 9.8 Under section 44(4) of the PO, any person other than the proprietor of the patent may apply to the Registrar of Patents for the revocation of a standard patent of which the corresponding designated patent has been revoked following prescribed opposition or revocation proceedings in the designated patent office. Both rules 8 and 9 prescribe the procedures where the Registrar of Patents has decided to refer such application to the Court under section 44(5) of the PO.
- 9.9 Rule 8 shall apply if the reference to the Court is made by the Registrar of Patents before the expiry of the period for filing a counter-statement with the Registrar.
- 9.10 Where the reference to the Court is made by the Registrar of Patents after the expiry of the period for filing a counter-statement with the Registrar, rule 9 would become the applicable provision governing the necessary procedures.
- 9.11 Both rules 8 and 9 set out the respective steps required to be taken by the Registrar of High Court, the plaintiff (i.e. the applicant for revocation) and other parties to the proceedings upon the Registrar of High Court's receipt of the reference from the Registrar of Patents. The main difference between rules 8 and 9 is that, under rule 8, there will be a 28-day period for the proprietor of the patent or a person who is shown in the register as having a right in or under the patent to file a notice of intention to oppose. On the other hand, it is not required for rule 9 to prescribe such period for filing notice of intention to oppose as in the context of the rule, parties who intended to oppose the application should have by then filed their counter-statements with the Registrar.

Application under section 46(1) (application to amend specification of patent after grant) and filing and publication of orders made under section 46(1) (Order 103, rules 10 & 11)

- 9.12 The new rules 10 and 11 provide for the procedures relating to an application to amend specification of a patent after grant under section 46(1) of the PO. Under rule 10, the plaintiff must publish an

advertisement in the Gazette informing the public of his proposed amendment sought under section 46(1) of the PO and that any person may oppose the amendment.

Reference under section 48(4) before/after expiry of period for filing notice of opposition (proprietor's offer to surrender patent) (Order 103, rules 12 & 13)

- 9.13 Under section 48(1) of the PO, the proprietor of a patent may give notice to the Registrar of Patents to surrender his patent. Both rules 12 and 13 prescribe the procedures where the Registrar of Patents refers such matter to the Court under section 48(4) of the PO.
- 9.14 Rule 12 shall apply if the reference to the Court is made by the Registrar of Patents before the expiry of the period for filing a notice of opposition with the Registrar.
- 9.15 Where the reference to the Court is made by the Registrar of Patents after the expiry of the period for filing a notice of opposition with the Registrar, rule 13 would become the applicable provision governing the relevant procedure of the reference.
- 9.16 Both rules 12 and 13 set out the respective steps which the Registrar of High Court, the plaintiff (i.e. the proprietor of the patent in question) and other parties to the proceedings must take upon the Registrar of High Court's receipt of the reference from the Registrar of Patents. The main difference between rules 12 and 13 is that, under rule 12, the plaintiff must publish an advertisement in the Gazette informing the public of his offer to surrender the patent under section 48(1) of the PO and that any person may oppose the surrender. On the other hand, such advertisement is not required under rule 13 as all parties who intended to oppose the application for surrender should have by then filed their notices of opposition with the Registrar of Patents.

Reference under section 49(2)(b) before/after expiry of period for filing notice of opposition (revocation of patent on grounds of "ordre public" or morality) (Order 103, rules 14 & 15)

- 9.17 Under section 49(1) of the PO, any person may after a patent has been granted for an invention refer to the Registrar of Patents the question of whether the invention is a patentable invention on grounds of public order (“ordre public”) or morality. Both rules 14 and 15 prescribe the procedures for the Registrar to refer such matter to the Court under section 49(2)(b) of the PO.
- 9.18 Rule 14 shall apply where the reference to the Court is made by the Registrar of Patents before the expiry of the period for filing a notice of opposition with the Registrar.
- 9.19 Where the reference to the Court is made by the Registrar of Patents after the expiry of the period for filing a notice of opposition with the Registrar, rule 15 is the applicable provision governing the relevant procedures.
- 9.20 Both rules 14 and 15 set out the respective steps which the Registrar of High Court, the plaintiff (i.e. the person making the reference under section 49(1)) and other parties to the reference must take upon the Registrar of High Court’s receipt of the reference from the Registrar of Patents. The main difference between rules 14 and 15 is that, under rule 14, the plaintiff must publish an advertisement in the Gazette informing the public of his reference of question under section 49(1) of the PO and that any person may oppose the determination to be sought by the plaintiff. On the other hand, such advertisement is not required under rule 15 as all parties who intended to oppose the determination to be sought by the plaintiff should have by then filed their notices of opposition with the Registrar of Patents.

Application for purposes of section 53(1) (application for rectification of register) (Order 103, rule 16)

- 9.21 This rule deals with an application for rectification of the register of patents under section 53(1) of the PO.

Reference under section 55(1) (determination of right to patent after grant) (Order 103, rule 17)

9.22 This rule deals with the service of an originating summons in proceedings relating to the determination of right to a patent after grant under section 55(1) of the PO.

Reference under section 56(5) (right to be granted licence etc. after transfer under section 55) (Order 103, rule 18)

9.23 This rule deals with the service of an originating summons in proceedings relating to the right to be granted licence and the period and terms of the licence under section 56(5) of the PO.

Application under section 58(1) or (2) (employee's application for compensation) or 59(7) (application to vary etc. court order made under section 58(1) or (2)) (Order 103, rule 19)

9.24 This rule provides for the procedures relating to an application for employee compensation under section 58(1) or (2) of the PO, or an application to vary, discharge or suspend a court order under section 59(7) of the PO.

Application under section 64(1) (grant of compulsory licence) or 66(3) (variation etc. of compulsory licence) (Order 103, rule 20)

9.25 This rule provides for the procedures relating to an application for grant of a compulsory licence under section 64(1) of the PO, or an application for the variation or cancellation of a compulsory licence under section 66(3) of the PO. The plaintiff must publish an advertisement in the Gazette informing the public of his application under section 64(1) or 66(3) of the PO and that any person may oppose the application.

Application under section 72J(1) (order for determination of amount of remuneration payable) (Order 103, rule 21)

9.26 This rule provides for the procedures relating to an application for determination of amount of remuneration under section 72J(1) of the PO.

***Application under section 72J(2) (order for payment of remuneration)
(Order 103, rule 22)***

9.27 This rule provides for the procedures relating to an application for an order for payment of remuneration under section 72J(2) of the PO.

Application under section 72J(6) (review of grant of import compulsory licence, its terms or conditions, termination, etc.) (Order 103, rule 23)

9.28 This rule provides for the procedures relating to an application for review of grant of import compulsory licence, its terms or conditions, the apportionment of the amount of remuneration or the termination of the licence under section 72J(6) of the PO.

Application under section 72J(8) (application by proprietor of patent for termination of import compulsory licence) (Order 103, rule 24)

9.29 This rule provides for the procedures relating to an application for termination of an import compulsory licence under section 72J(8) of the PO. The plaintiff must publish an advertisement in the Gazette informing the public of his application under section 72J(8) of the PO and that any person may oppose the application.

Application under section 72R(1) (review of grant of export compulsory licence, its terms or conditions, termination, etc.) (Order 103, rule 25)

9.30 This rule provides for the procedures relating to an application for review of grant of export compulsory licence, its terms or conditions, or termination under section 72R(1) of the PO.

Application under section 72R(5) (application by proprietor of patent for termination of export compulsory licence) (Order 103, rule 26)

9.31 This rule provides for the procedures relating to an application for termination of an export compulsory licence under section 72R(5) of the PO. The plaintiff must publish an advertisement in the Gazette informing the public of his application under section 72R(5) of the PO and that any person may oppose the application.

Patent infringement proceedings (Order 103, rule 27)

9.32 This rule deals with the particulars of the infringements and the particulars of the objections to the validity of the patent in proceedings brought under section 80 or 88 of the PO.

Application for purposes of section 91(1)(a) (revocation of patents) (Order 103, rule 28)

9.33 This rule provides for the procedures relating to an application for revocation of patent under section 91(1)(a) of the PO on grounds of public order (“ordre public”) or morality. The plaintiff must publish an advertisement in the Gazette informing the public of his application under section 91(1)(a) of the PO and that any person may oppose the application.

Application for purposes of section 91(1)(f), (g) or (h) (revocation of patents) (Order 103, rule 29)

9.34 This rule provides for the procedures relating to an application for revocation of patent under section 91(1)(f), (g) or (h) of the PO.

Proceedings in which validity of patent is put in issue (Order 103, rule 30)

9.35 This rule deals with proceedings in which validity of patent is put in issue, and sets out the requirement to include the particulars of objections to the validity of a patent and the information to be included therein.

Amendment of particulars (Order 103, rule 31)

9.36 This rule provides for amendment of particulars and service of further or better particulars in certain proceedings relating to patents.

Restrictions on admission of evidence (Order 103, rule 32)

9.37 This rule provides for restrictions on admission of certain evidence in

proceedings relating to patents.

Admissions of facts (Order 103, rule 33)

9.38 This rule deals with notice to admit facts in certain proceedings relating to patents.

Discovery of documents (Order 103, rule 34)

9.39 This rule provides that Order 24 (discovery of documents) with certain modifications apply to certain proceedings relating to patents and provides for discovery of documents in proceedings involving the issue of commercial success.

Experiments (Order 103, rule 35)

9.40 This rule provides for the procedures relating to establishment of facts by experimental proof in certain proceedings relating to patents.

Experts (Order 103, rule 36)

9.41 This rule provides for the procedures for adducing expert evidence in certain proceedings relating to patents.

Case management summons (Order 103, rule 37)

9.42 This rule provides for certain special procedures for case management summons in certain proceedings relating to patents.

Originating summons procedure (Order 103, rule 38)

9.43 This rule provides for certain special procedures for originating summons in certain proceedings relating to patents.

Application for the purposes of section 102 (application to amend specification of patent) (Order 103, rule 39)

9.44 This rule provides for the procedures for an application to amend

specification of a patent under section 102 of the PO. The applicant must publish an advertisement in the Gazette informing the public of his proposed amendment sought under section 102 of the PO and that any person may oppose the amendment.

Referrals by Registrar of Patents under section 133(1)(b) of questions that are referred to Registrar of Patents under section 13(1)/14(5) (Order 103, rules 40 & 41)

9.45 The rules 40 and 41 provide for the procedures relating to referrals made by the Registrar of Patents under section 133(1)(b) of the PO, for question being referred to the Registrar of Patents under section 13(1) or 14(5) of the PO. The rules set out the respective steps which the Registrar of High Court, the plaintiff (i.e. the party who has initiated the proceedings underlying the reference made by the Registrar to the Court) and other parties to the proceedings must take upon the Registrar of High Court's receipt of the reference from the Registrar of Patents.

Appointment of scientific adviser (Order 103, rule 42)

9.46 This rule empowers the Court to appoint a scientific adviser and provides that Order 40, rules 2, 3, 4, 5 and 6 apply to the scientific adviser so appointed and reports made by the adviser as they apply in relation to a court expert and a report made by a court expert.

Service of documents (Order 103, rule 43)

9.47 This rule provides for the service of a document on the proprietor of a patent, until the proprietor has provided an address for service under Order 12, rule 3(2).

Filing of orders etc. with Registrar of Patents (Order 103, rule 44)

9.48 This rule provides for the filing of sealed copies of court orders, directions, declarations and certificates with the Registrar of Patents.

Transitional (Order 103, rule 45)

9.49 This rule is a transitional provision for proceedings commenced under the pre-repealed Order 103 immediately before the commencement date of the new Order 103.

10. We wish to draw to your attention that the current draft Order 103 seeks to cater for proceedings under the existing provisions of PO. We are reviewing the need to further amend the draft Order 103 in view of the recent enactment of the Patents (Amendment) Ordinance 2016 (“PAO”) in June 2016 which is not yet in effect. In gist, the PAO mainly seeks to introduce (a) an “original grant” patent (“OGP”) system to be run in parallel with the current re-registration system for grant of standard patents and (b) post-grant substantive examination of short-term patents as a major measure of refining the existing short-term patent system. Subject to the progress of our preparatory work, we expect that the PAO shall be brought into effect in 2019 at the earliest. In any event, as the PAO does not introduce any substantive amendment to the existing provisions of the PO relating to proceedings before the Court and the Registrar of Patents under the existing patent system, the separate legislative exercise to further amend Order 103 would not affect the substance of our current legislative proposals as stated herein.

*(iii) Registered Designs – Proceedings before the Court under the RDO
(Draft new Order 122 of the RHC)*

11. At present, the RHC contains no provisions to prescribe the procedures for court proceedings under the RDO which came into operation on 27 June 1997. New provisions need to be introduced to the RHC to govern the procedures and conduct of litigation under the RDO before the Court. A new Order 122 has therefore been prepared to provide for the rules for regulating such court proceedings (see the draft Order 122 in the draft *Rules of the High Court (Amendment) Rules* at Annex C).

12. A summary of the major provisions of the Order 122 is set out below -

Interpretation (Order 122, rule 1)

12.1 This rule provides for the definitions of terms used in Order 122.

Application (Order 122, rule 2)

12.2 This rule stipulates that subject to the provisions of Order 122, the RHC shall apply to proceedings before the Court under the RDO.

Proceedings to be begun by originating summons (Order 122, rule 3)

12.3 This rule prescribes that certain proceedings under the RDO must be begun by originating summons.

Supplementary provisions relating to originating summons etc. (Order 122, rule 4)

12.4 This rule sets out the information an originating summons must contain, which, as advised by the Rules Committee of the High Court, includes a concise statement setting out (a) the nature of the question referred to, or of the matter brought to, the Court, (b) the facts, laws and evidence on which the person who takes out the originating summons relies, and (c) the order or relief sought.

12.5 This rule also sets out the scope of applicability of Order 10 on service of originating process to the service of an originating summons taken out under Order 122.

Reference under section 41 (determination of rights after registration) (Order 122, rule 5)

12.6 This rule deals with the service of an originating summons in proceedings relating to the determination of certain rights to a registered design after registration under section 41 of the RDO.

Reference under section 42(5) (entitlement to be granted licence etc. after transfer under section 41) (Order 122, rule 6)

12.7 This rule deals with the service of an originating summons in proceedings relating to entitlement to the grant of a licence and the terms thereof under section 42(5) of the RDO.

Reference under section 44(3) before/after expiry of period for filing notice of opposition (revocation on ground of public order or morality) (Order 122,

rules 7 & 8)

- 12.8 Under section 44(1) of the RDO, any person may refer to the Registrar of Designs the question of whether a registered design is or is not a registrable design having regard to public order or morality under section 7 of the RDO. Rules 7 and 8 prescribe the procedures whereby the Registrar of Designs may refer to the Court for determination such question under section 44(3), and the procedures for opposing a reference to the Registrar made under section 44(1).
- 12.9 Rule 7 shall apply if the reference from the Registrar of Designs is made before the expiry of the period of filing a notice of opposition with the Registrar of Designs.
- 12.10 In the event that the reference from the Registrar of Designs is made after the expiry of the period of filing a notice of opposition, rule 8 shall apply.
- 12.11 Both rules 7 and 8 set out what the Registrar of High Court must do upon receiving the reference from the Registrar of Designs, and what the plaintiff and other parties must do upon receiving the notice of the reference. The main difference between rules 7 and 8 is that, under rule 7, the plaintiff must publish an advertisement in the Gazette informing the public of his application under section 44(1) of the RDO and that any person may oppose the application. Such advertisement is not required under rule 8 as all parties who intended to oppose the application should have already filed their notices of opposition with the Registrar of Designs when the period of filing of notice of opposition has expired.

Application for revocation under section 45 on ground of public order or morality (Order 122, rule 9)

- 12.12 This rule prescribes the procedures for an application to the Court for revocation of a registered design on ground of public order or morality under section 45 of the RDO. Similar to rule 7, the intending plaintiff must, before taking out any proceedings in the Court, publish an advertisement in the Gazette informing the public

of his intended application and that any person may oppose the application.

Application for revocation under section 45 (other than on ground of public order or morality) or 46 (Order 122, rule 10)

12.13 This rule sets out the information to be included in and the procedures relating to an application for the revocation of the registration of a design under section 45 (other than on ground of public order or morality) or section 46(1) of the RDO.

Application under section 53(1) or 54(1) (order for delivery up or disposal) (Order 122, rule 11)

12.14 This rule prescribes the procedures for an application to the Court for an order for delivery up under section 53(1) of the RDO or an order for disposal under section 54(1) of the RDO. The originating summons together with a copy of the supporting affidavit must be served on, apart from the defendant, all persons having an interest in the infringing articles (so far as reasonably ascertainable) so that the latter may have an opportunity to make representations to the Court and apply for orders that they see fit.

Application for purposes of section 66(1) (rectification of Register) (Order 122, rule 12)

12.15 This rule prescribes that the applicant making an application to the Court under section 66(1) of the RDO must serve a copy of the originating summons on the Registrar of Designs.

Counterclaim for rectification of Register, etc. (Order 122, rule 13)

12.16 This rule prescribes the procedures for a defendant in any action in respect of a registered design in challenging the registration of the design in its defence and making a counterclaim for the rectification of the register of designs or for the revocation of the registration of the design.

Application under section 93(3) (Court's power to make declarations) (Order 122, rule 14)

- 12.17 This rule relates to any applications made to the Court under section 93(3) of the RDO. It is proposed that the person making the application must serve a copy of the originating summons on the registered proprietor of the design deemed by section 91 to be registered under the RDO.

Appointment of scientific adviser (Order 122, rule 15)

- 12.18 This rule concerns the appointment of an independent scientific adviser by the Court. There may be circumstances that the opinion of a scientific adviser is useful where, for instance, the dispute is on whether a particular feature performs solely a functional role.
- 12.19 Order 40 rules 2, 3, 4, 5 and 6 of the RHC shall apply. Consequential changes shall also be made to paragraph 4(2), Part II, First Schedule of Order 62 of the RHC concerning the costs of calling an expert witness, such that it would cover a scientific adviser appointed under rule 15 of Order 122.

Service of documents (Order 122, rule 16)

- 12.20 This rule allows the service of documents on the owner of a registered design at the address for service as recorded on the register until an address for service is provided under Order 12 of the RHC. The rule also contains supplementary provisions on service of documents by reference to Order 10 of the RHC.

Filing of orders, etc. with Registrar of Designs (Order 122, rule 17)

- 12.21 This rule provides for the filing of a sealed copy of any order, declaration or certificate made or granted by the Court under the RDO with the Registrar of Designs.

B. PROPOSED AMENDMENTS TO THE TMR, PGR & RDR

(i) Trade Marks – Proceedings before the Registrar of Trade Marks under the TMO

(Draft Trade Marks (Amendment) Rules)

13. Under sections 52, 53, 54, 57 and 60(6) of the TMO, an application may be made either to the Court or to the Registrar of Trade Marks. Section 77(1)(b) of the TMO provides that where in such cases an 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. Currently, there are no prescribed procedures under the TMR for the Registrar to refer an application to the Court. We have prepared the Trade Marks (Amendment) Rules, a draft of which is at **Annex D**, to prescribe the procedures to facilitate conduct of such proceedings, and to introduce new provisions on the notification of proceedings to the public and the filing of certain documents with the Registrar. A summary of the major provisions are set out below –

Notice on receipt of applications for revocation, declaration of invalidity, variation or rectification (rules 36, 40, 46 and 50 of TMR)

13.1 Under rule 51 of the TMR, any person claiming to have an interest in any proceedings under Part 6 of the TMR may file an application on the specified form for leave to intervene. The public is currently not notified of any proceedings that affect trade mark registrations and applications which may otherwise facilitate any party claiming to have an interest in such proceedings to subsequently apply for leave to intervene. We therefore propose to amend rules 36, 40, 46 and 50 to add the requirement that on receipt of an application for revocation, declaration of invalidity, variation or rectification, the Registrar of Trade Marks must (a) enter a notice of the application in the register, and (b) advertise the fact of the application having been filed in the official journal.

Procedures for reference to the Court (new rule 51A of TMR)

13.2 Where a person has an option to make an application either to the Court or to the Registrar of Trade Marks and makes an application to

the latter, the Registrar may, at any stage of the proceedings, refer the application to the Court under section 77(1)(b) of the TMO. The proposed new rule 51A sets out the steps to be taken by the Registrar in referring an application to the Court.

Filing of documents etc. with the Registrar (rule 117 of TMR)

13.3 The proposed amendment to rule 117 of the TMR requires the filing of a sealed copy of any order, declaration or certificate made or granted by the Court under the TMO with the Registrar of Trade Marks. Such proposed amendment is consistent with rule 8 of draft Order 100.

(ii) Patents – Proceedings before the Registrar of Patents under the PO (Draft Patents (General) (Amendment) Rules)

14. Under section 49(1) of the PO, any person may, at any time after a patent has been granted, refer to the Registrar of Patents the question of whether the invention is a patentable invention on grounds of public order (“ordre public”) or morality. While section 49(4) of the PO provides that any person may oppose such reference, there is yet to be any statutory provision to elaborate the opposition procedures, including how a third party can be informed of such reference made to the Registrar. Other than carrying out proceedings before him/her, under sections 44(5), 48(4), 49(2)(b) and 133(1)(b) of the PO, the Registrar of Patents may elect to refer an application, a matter or a question to the Court under the relevant provision. The relevant procedures of such reference have also yet to be prescribed.

15. While the statutory mechanisms stated under paragraph 14 above have not been invoked so far, we consider it desirable to set out the detailed procedures for promoting certainty and clarity of the relevant statutory schemes in the long run. For this purpose, the *Patents (General) (Amendment) Rules* have been drawn up, a draft copy of which is at **Annex E**.

16. A summary of the major provisions are set out below –

References to the Registrar of Patents under section 49(1) of PO (rules 41 to 41G of PGR)

- 16.1 Under section 49 of the PO, any person may, at any time after a patent has been granted, refer to the Registrar of Patents the question of whether the invention is a patentable invention having regard to the matters specified in section 93(5) of the PO. In this connection, an invention is not patentable if the publication or working of the invention would be contrary to public order (“order public”) or morality.
- 16.2 We propose to refine the procedures for the reference made to the Registrar under section 49 of the PO as currently set out in rule 41 of PGR (see the proposed amendments to rule 41 of PGR and the addition of the new rules 41A to 41G to PGR). Under the proposed refinement, the statement in support of the reference under the existing rule 41 of PGR should contain full particulars of the applicant’s case so that the proprietor of the patent, and possibly any third parties, would be in a position to prepare a notice of opposition (see the proposed amendments to rule 41(2) of PGR). In addition, the Registrar of Patents is required to enter a notice of the application in the register and advertise the fact of the application having been filed in the official journal for any third party to oppose the application (see the proposed amendments to rule 41(4) of PGR).
- 16.3 As a third party may have difficulties in preparing a notice of opposition without a copy of the application for reference, we propose that a person (other than the proprietor of the patent) who intends to oppose the application (“intending opponent”) should file with the Registrar of Patents a notice indicating an intention to oppose the application and send a copy of the notice to the applicant and the proprietor of the patent for reference (see the proposed new rule 41A of PGR). Upon receiving such copy, the applicant must send a copy of the application and statement to the intending opponent within the prescribed period so that the intending opponent may consider the application and, if appropriate, proceed with filing a notice of opposition.
- 16.4 The new rules 41B and 41C of PGR prescribe the procedures of filing the notice of opposition by the intending opponent and the proprietor of the patent respectively. It is further proposed that the applicant is

also required to send a copy of the notice of opposition received from an intending opponent to the other intending opponents (see the proposed new rule 41B(5) of PGR).

- 16.5 The new rules 41D to 41F of PGR prescribe the procedures of filing evidence by the parties which is in line with the comparable procedures under the existing rules 41(4) and (5) of PGR.

References to the Court under sections 44(5), 48(4), 49(2)(b) and 133(1)(b) of PO (rules 37A, 40A, 41H, 92A and 92B of PGR)

- 16.6 The Registrar of Patents may refer an application, matter or question filed under sections 44(5), 48(4), 49(2)(b) or 133(1)(b) of the PO to the Court. As the existing PGR does not prescribe the applicable procedures when the Registrar of Patents decides to make such reference to the Court, we propose adding the new rules 37A, 40A, 41H, 92A and 92B into PGR for specifying the applicable procedures for the Registrar to make the reference which correspond with the comparable procedures under rules 8, 9, 12-15, 40 and 41 of the draft new Order 103.

Filing of court orders, declarations or certificates (rule 52 of PGR)

- 16.7 We propose that in addition to the order and direction under the existing rule 52(1) of PGR which require the filing of a sealed copy to the Registrar of Patents, a sealed copy of any certificate or declaration granted by the Court under the PO must also be filed with the Registrar. Such proposed new requirements are also consistent with the corresponding requirement under rule 44 of the draft new Order 103.

Stay of proceedings (rule 104A of PGR)

- 16.8 To empower the Registrar of Patents to stay any proceedings before him in appropriate cases, we propose adding a new rule 104A to the PGR by reference to rule 90 of the TMR.

(iii) Registered Designs – Proceedings before the Registrar of Designs under the

RDO

(Draft Registered Designs (Amendment) Rules)

17. Under section 44 of the RDO, any person may refer to the Registrar of Designs the question of whether a registered design is a registrable design on the grounds of public order or morality. The relevant procedure under the current RDR involves three rounds of pleadings and requires the opponent to the application, rather than the applicant, to file evidence first. To expedite the proceedings, we propose to reduce the number of pleadings to be filed with reference to the procedure for similar proceedings under the TMR. We also consider it more reasonable to require the applicant to file evidence to prove his case prior to commencing a proceeding.

18. Other than carrying out proceedings before him/her, the Registrar of Designs may refer to the Court an application made under section 44 of the RDO. For clarity's sake, we consider it more desirable to spell out the detailed procedures in the relevant provision of the RDR. Furthermore, with reference to the TMR, we propose to introduce a new provision to empower the Registrar of Designs to stay any proceedings before him/her as he/she thinks fit.

19. To effect the aforementioned proposals and other miscellaneous amendments, we propose to amend the RDR by introducing the ***Registered Designs (Amendment) Rules***, a draft of which is at **Annex F**. A summary of the major provisions are set out below –

Applications to the Registrar of Designs under section 44 of RDO (sections 37 to 46 of RDR)

19.1 Under section 44 of the RDO, any person may refer to the Registrar of Designs the question of whether a registered design is a registrable design having regard to section 7 of the RDO, namely whether the publication or use of the design would be contrary to public order or morality.

19.2 The procedures for an application made under section 44 of the RDO are set out in sections 37 to 46 of the current RDR. We propose that the statement required to be filed under section 37 of the RDR should set out the question on which the applicant intends to seek the determination of the Registrar, the determination and order that the

applicant intends to seek, and the full particulars of the grounds and facts in support, so that the registered owner of the design, and other third parties, can consider whether to oppose the application.

- 19.3 Under the current section 37(2) of the RDR, the applicant is only required to send a copy of the application and the statement to the registered owner of the design.
- 19.4 Under section 37(3) of the RDR, the Registrar shall enter a notice of the application in the register of designs and advertise the filing of the application in the official journal. A new section 37A is proposed so that a person (other than the registered owner of the design) who wishes to oppose an application under section 37 (“intending opponent”) may file with the Registrar a notice indicating an intention to oppose the application within 28 days after the date of the advertisement in the official journal. The intending opponent must send a copy of the notice to the applicant and the registered owner of the design. Upon receiving such copy, the applicant must send a copy of the application and statement to the intending opponent within the prescribed period so that the intending opponent could consider the application and the statement, and, if appropriate, file a notice of opposition.
- 19.5 The new sections 38 and 38A of the RDR prescribe the procedures of the filing of the notice of opposition by the intending opponent and by the registered owner respectively. The new sections 38 and 38A will replace the current section 38 of the RDR.
- 19.6 The current section 39 of the RDR requires the applicant to file a counter-statement. In the interest of expediting the proceedings, we consider that it is not necessary for the applicant to file a counter-statement. In this connection, we have made reference to rule 41 of the TMR where an applicant for revocation of a trade mark registration is not required to file further pleadings in reply after the owner of the trade mark files his counter-statement to the application for revocation. We therefore propose to repeal section 39 of the RDR.

19.7 The current section 40 of the RDR requires the opponent to the application made under section 37 of the RDR (including the registered owner of the design and third parties) to initiate the round of evidence by filing evidence in support of opposition, and under section 41, the applicant shall file evidence in support of the application after the opponent files his evidence. However, we consider it more reasonable to require the applicant to prove his case by filing evidence in support of his case first under the proposed new section 40, which is in line with the comparable procedures concerning trade marks (see rule 42 of TMR) and patents (see section 41(4) of PGR). After the applicant files his evidence, the opponent is required to file evidence in support of his opposition, which is reflected in the new section 41 of the RDR.

19.8 The current section 42 of the RDR provides that both the opponent and applicant may file further evidence in reply within the prescribed periods. Having made reference to the comparable position under rule 44 of the TMR, we propose that the new section 42 of the RDR will only provide that the applicant may file evidence in reply after the opponent files his evidence under section 41, and that no further evidence may be filed by the parties except with the leave of the Registrar of Designs.

References to the Court under section 44(3) of RDO (section 46 of RDR)

19.9 The Registrar of Designs may exercise his power to refer an application made under section 44 of the RDO to the Court. The current section 46 of the RDR simply requires the Registrar of Designs, in case he decides to refer a question to the Court for determination, to serve a copy of the reference to the Court on the applicant and the registered owner of the design. For clarity and greater certainty, we propose to introduce a new section 46 to spell out the detailed procedures the Registrar should comply with if he refers a question to the Court under section 44(3) of the RDO.

Filing of Court orders, declarations or certificates (section 48 of RDR)

19.10 We propose to amend section 48 of the RDR by requiring the filing

of a sealed copy, instead of a certified copy, of the order, declaration or certificate made or granted by the Court with the Registrar of Designs, which is in line with the comparable position under rule 17 of draft Order 122.

Stay of proceedings (section 49A of RDR)

19.11 To empower the Registrar of Designs to stay proceedings before him in appropriate cases, we propose adding a new section 49A to the RDR having regard to rule 90 of the TMR.

HOW TO RESPOND TO THE CONSULTATION

20. You are cordially invited to provide your views on our proposed statutory amendments as set out at Annexes A to F **on or before 31 July 2017** by post, email or fax: -

By Post : Director of Intellectual Property
Intellectual Property Department, the HKSAR Government
25th Floor, Wu Chung House
213 Queen's Road East
Wanchai
Hong Kong

By Email : RHC2017@ipd.gov.hk

By Fax : 2838 6315

21. It is voluntary for you to provide your personal data in your submission in response to this consultation document. Any personal data provided with your submission will only be used for the purposes of this consultation exercise. Your submission and personal data (if any) collected by us may be passed to the relevant Government bureaux and departments only for purposes directly relating to this consultation exercise.

22. We may publish your submission in response to this consultation in full or in a summary for public viewing, together with your name or your affiliation (or both). If you do not wish to disclose your identity in such a way, please state so when making your submission.

23. Any party providing personal data in the submission will have the rights of access and correction with respect to such personal data. Any requests for data access or correction should be made in writing to the Director of Intellectual Property to be sent through any of the channels as stated under paragraph 20 above.

Intellectual Property Department

28 April 2017

Rules of the High Court (Amendment) Rules 2017

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Rules of the High Court (Amendment) Rules 2017

(Made by the Rules Committee of the High Court under section 54 of the High Court Ordinance (Cap. 4))

1. Commencement

These Rules come into operation on [].

2. Rules of the High Court amended

The Rules of the High Court (Cap. 4 sub. leg. A) are amended as set out in section 3.

3. Order 100 substituted

Order 100 substituted—

Repeal the Order
Substitute

“Order 100

Trade Marks Ordinance (Cap. 559)

1. Interpretation (O. 100, r. 1)

(1) In this Order—

court (法院) means the Court of First Instance;

the Ordinance (條例) means the Trade Marks Ordinance (Cap. 559).

(2) Expressions used in this Order which are used in the Ordinance have the same meaning in this Order as in the Ordinance.

2. Application (O. 100 r. 2)

These rules apply to proceedings brought before the court under the Ordinance subject to the provision of this Order.

3. Applications under the Trade Marks Ordinance (O. 100, r. 3)

- (1) Subject to rules 4(1) and 5, an application to the court under the Ordinance must be begun by—
 - (a) writ; or
 - (b) originating summons.
- (2) The writ or originating summons by which any such application is made must be served on the Registrar of Trade Marks.

4. Applications under section 23 or 25 of the Ordinance (O. 100, r. 4)

- (1) An application under section 23 or 25 of the Ordinance must be made by—
 - (a) originating summons;
 - (b) if the application is made in a pending action, summons or motion in that action; or
 - (c) including the application in a statement of claim.
- (2) If an application under section 25 of the Ordinance is made in accordance with paragraph (1), the plaintiff must serve notice of the application on all interested persons so far as reasonably ascertainable.
- (3) An interested person under paragraph (2) is a person who has an interest in the goods, material or articles which are the subject of the application, including any person in whose favour an order could be made in respect of the goods, material or articles under—

- (a) section 25(8) of the Ordinance;
- (b) section 54 of the Registered Designs Ordinance (Cap. 522); or
- (c) section 111 or 231 of the Copyright Ordinance (Cap. 528).

5. Proceedings for infringement of registered trade mark: registration disputed or revocation, variation or rectification sought (O. 100, r. 5)

- (1) If in any proceedings in respect of a trade mark a claim is made for relief for infringement of the right conferred on the owner of a registered trade mark by section 14 of the Ordinance, the party against whom the claim is made (*defendant*) may do any or all of the following—
 - (a) in the defence contest the registration of the trade mark;
 - (b) make a counterclaim for any one or more of the following reliefs—
 - (i) an order for the revocation of the registration;
 - (ii) a declaration of invalidity of the registration;
 - (iii) an order for the variation of the registration;
 - (iv) an order for rectification of the register.
- (2) The defence or counterclaim must include particulars of the objections to the registration of the trade mark on which the defendant relies.
- (3) The defendant must—
 - (a) serve on all other parties to the proceedings a copy of the defence or counterclaim;

- (b) if the defendant makes a counterclaim for a relief under paragraph (1)(b)—also serve a copy of the counterclaim on the Registrar of Trade Marks.
- (4) If a copy of a counterclaim is served on the Registrar of Trade Marks, the Registrar of Trade Marks may take part in the proceedings as the Registrar thinks fit.
- (5) If the Registrar of Trade Marks takes part in the proceedings, the Registrar need not serve a defence to counterclaim or other pleading unless ordered to do so by the court.

6. Reference to court under section 77(1)(b) (O. 100, r. 6)

- (1) This rule applies if the Registrar of Trade Marks refers to the court for determination an application on a question concerning a registered trade mark or an application for registration of trade mark under section 77(1)(b).
- (2) The Registrar of High Court must, on receiving the reference—
 - (a) file the reference and make an entry of the fact in the cause book; and
 - (b) give written notice to all of the following persons that proceedings relating to the questions are pending before the court—
 - (i) the Registrar of Trade Marks;
 - (ii) the person who made the application under section 77(1)(b) (*plaintiff*);
 - (iii) if the plaintiff is not the owner of the registered trade mark, the owner;
 - (iv) any other party to the proceedings (*relevant party*).

-
- (3) The plaintiff must, within 7 days after receiving a notice given under paragraph (2)(b)—
 - (a) cause an address for service to be entered in the cause book;
 - (b) take out a case management summons returnable in not less than 21 days to seek directions from the court as to the filing of documents and any other matters in relation to the proceedings; and
 - (c) serve a copy of the summons on—
 - (i) the Registrar of Trade Marks;
 - (ii) if the plaintiff is not the owner of the registered trade mark, the owner; and
 - (iii) every relevant party.
 - (4) The owner (not being the plaintiff) and the relevant party must, within 7 days after receipt of a notice given under paragraph (2)(b), acknowledge receipt of the notice in writing.
 - (5) If the plaintiff fails to take out the case management summons, a person mentioned in paragraph (3)(c)(ii) and (iii) may—
 - (a) take out a summons to seek directions from the court for the further conduct of the proceedings; or
 - (b) apply to the court for an order to dismiss the proceedings.
 - (6) The court may—
 - (a) on hearing a summons taken out under paragraph (5)(a), give directions for the further conduct of the proceedings; or
 - (b) on hearing an application made under paragraph (5)(b)—

- (i) dismiss the proceedings on any term that it thinks just; or
- (ii) deal with the application as if it were a case management summons taken out under this rule.

7. Service of documents on owner of registered trade mark (O. 100, r. 7)

- (1) This rule applies to the service of a document on the owner of a registered trade mark in any proceedings under this Ordinance before the owner has provided an address for service in an acknowledgement of service under Order 12, rule 3(2).
- (2) For the service of an originating process, or any other document which is required to be or may be served in accordance with Order 10, on the owner of a registered trade mark—
 - (a) Order 10 has effect as if in rule 1(2) of that Order—
 - (i) the reference to service on a defendant were a reference to service on a party who is the owner of a registered trade mark; and
 - (ii) the reference to the usual or last known address of the defendant were a reference to—
 - (A) the usual or last known address of the owner; or
 - (B) the address for service of the owner given in the register in relation to the trade mark; and

- (b) Order 65 has effect as if in rule 3(2) of that Order, the reference to Order 10, rule 1(2) were a reference to that rule 1(2) as construed in accordance with subparagraph (a).
- (3) For the service of a document other than those mentioned in paragraph (2) on the owner of a registered trade mark, Order 65 has effect as if, in rule 5 of that Order, the addresses specified in paragraph (2)(a), (b), (c) and (d) of that rule included the address for service of the owner as shown in the register in relation to the trade mark.
- (4) A document served on the owner of a registered trade mark at the address for service of the owner as shown in the register in relation to the trade mark in accordance with a provision of these rules as modified by this rule is treated as having been duly served within the jurisdiction on the owner even if the owner is not within the jurisdiction at the time of service.

8. Filing of orders etc. with Registrar of Trade Marks (O. 100, r. 8)

If the court has made or granted an order, declaration or certificate in favour of a person in any proceedings under the Ordinance, the person or, if there is more than one such person, the person directed by the court must file a sealed copy of the order, declaration or certificate with the Registrar of Trade Marks within 1 month after the date of the order, declaration or certificate.”.

Made this day of 2017.

Explanatory Note

These rules amend Order 100 of the Rules of the High Court (Cap. 4 sub. leg. A) to provide for detailed rules and procedures for proceedings under the Trade Marks Ordinance (Cap. 559) (*the Ordinance*).

2. The proposed amendments include the introduction of—
 - (a) provisions in relation to references made to the court by the Registrar of Trade Marks under section 77(1)(b) of the Ordinance;
 - (b) provisions for the service of documents on the owner of a registered trade mark in proceedings under the Ordinance; and
 - (c) provisions for the filing of orders, declarations and certificates made or granted by the Court of First Instance with the Registrar of Trade Marks.

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Part 2

Amendments to Rules of the High Court

Division 1—Amendments to Order 103

3. Order 103 substituted

Order 103—

Repeal the Order

Substitute

“Order 103

Patents Ordinance (Cap. 514)

I. Preliminary

1. Interpretation (O. 103, r. 1)

(1) In this Order—

Court (法院) means the Court of First Instance;

patent infringement proceedings (侵犯專利法律程序) means any proceedings brought under section 80 or 88;

the Ordinance (《專利條例》) means the Patents Ordinance (Cap. 514);

the Patents Rules (《專利規則》) means the Patents (General) Rules (Cap. 514 sub. leg. C).

(2) In this Order, a section referred to by number means the section so numbered in the Ordinance.

- (3) Expressions used in this Order that are used in the Ordinance have the same meaning in this Order as in the Ordinance.

2. Application (O. 103, r. 2)

These rules apply to proceedings brought before the Court under the Ordinance subject to the following rules of this Order.

II. Originating Proceedings

3. Proceedings to be begun by originating summons (O. 103, r. 3)

- (1) Proceedings relating to a matter under a provision of the Ordinance specified in column (A) of the following Table must be begun by originating summons (column (B) of the Table is for reference only and has no legislative effect).

TABLE

Column (A)	Column (B)
Provision of the Ordinance	Description of matter to be brought before the Court
13(1)(a)	Question as to whether a person is entitled under section 12 to apply for grant of standard patent for invention.
13(1)(b)	Question as to whether any right in or under application for patent should be transferred or

Column (A)	Column (B)
	granted to any other person.
14(5)	Question regarding entitlement to be granted licence following order for transfer of application for patent.
46(1)	Application to amend specification of patent.
53(1)	Application for rectification of register.
55(1)	Question of proprietorship of granted patent.
56(5)	Question of entitlement to grant of licence following transfer of patent under section 55.
58(1) or (2)	Application by employee for compensation.
59(7)	Application for variation, discharge, etc., of order for compensation made under section 58.
63(4)	Application for variation of terms or conditions of certain contracts or licences.

Column (A)	Column (B)
64(1)	Application for compulsory licence under standard patent.
66(3)	Application for variation or cancellation of compulsory licence.
72(1)	Dispute as to Government use.
72J(1)	Application for determination of amount of remuneration payable under section 72E(2).
72J(2)	Application for payment of remuneration under section 72E(2).
72J(6)	Application for review of grant of import compulsory licence, terms or conditions of licence, apportionment of amount of remuneration or termination of licence.
72J(8)	Application for termination of import compulsory licence by proprietor of patent.
72R(1)	Application for review of grant of export compulsory licence, terms or conditions of licence or termination of licence.

Column (A)	Column (B)
72R(5)	Application for termination of export compulsory licence by proprietor of patent.
91(1)	Application for revocation of patent.

- (2) This rule does not apply to a matter to be brought before the Court in proceedings that are pending before it.

4. Supplementary provisions relating to originating summons (O. 103, r. 4)

- (1) An originating summons by which any proceedings under the Ordinance are begun must, in addition to any other information required to be included by other provision of this Order, include a concise statement setting out—
- (a) the nature of the question referred to, or of the matter brought before, the Court;
 - (b) the facts, laws and evidence on which the person who takes out the originating summons relies in support of the proceedings; and
 - (c) the order or relief sought.
- (2) A provision of this Order requiring the service of a copy of an originating summons on a person specified in the provision has no effect in relation to the person if Order 10 or any other provision of these rules requires the service of the originating summons itself on the person.
- (3) Except as otherwise provided in this Order, Order 10 applies to the service of a copy of an originating summons required to be served under this Order as that Order applies to the service of an originating process.

III. Right to Apply for Standard Patent

5. Reference under section 13(1)(a) (right to apply for grant of standard patent) (O. 103, r. 5)

- (1) In any proceedings in which a question is referred to the Court under section 13(1)(a), the plaintiff must serve a copy of the originating summons by which the proceedings are begun—
 - (a) on the Registrar of Patents;
 - (b) on every other person whom the plaintiff alleges is entitled to apply for a standard patent for the invention; and
 - (c) on every person whom the plaintiff believes to be the inventor or joint inventor of the invention.
- (2) If an application for a standard patent for the invention has been made and published at the time when the originating summons is served, the plaintiff must also serve a copy of the originating summons on every person who is shown in the register as having a right in or under the application.
- (3) If an application for a standard patent for the invention has been made but has not been published at the time when the originating summons is served, the plaintiff must also, at the time of serving a copy of the originating summons under paragraph (1)(a)—
 - (a) deliver to the Registrar of Patents such number of copies of the originating summons as ascertained from the Registrar of Patents before the delivery; and
 - (b) notify the Registrar of Patents that the copy is for service on a person who—
 - (i) is an applicant in the application; or

- (ii) has given notice to the Registrar of Patents under section 46 of the Patents Rules of a transaction, instrument or event in relation to the application.
- (4) Each copy of the originating summons mentioned in paragraph (3) must contain a notice setting out—
 - (a) the number assigned by the Registrar of Patents on the filing of the application for a standard patent for the invention if the number is known to the plaintiff; or
 - (b) (if the number mentioned in subparagraph (a) is not known to the plaintiff) the number assigned by a designated patent office on the filing of the application for a designated patent for the invention.
- (5) On receiving the copies of the originating summons under paragraph (3), the Registrar of Patents must send one copy by registered post to every person mentioned in paragraph (3)(b)—
 - (a) at the person’s address for service as shown in—
 - (i) the request to record filed under section 15(1); or
 - (ii) the application to register or notice mentioned in section 46(1) of the Patents Rules; or
 - (b) if a valid address for service substituting the address for service mentioned in subparagraph (a)(i) or (ii) has been filed under the Patents Rules, at the address for service so filed.
- (6) If the Registrar of Patents is unable to comply with paragraph (5), the Registrar of Patents must notify the plaintiff in writing of that fact and state the reason for it.

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- (7) A notice under paragraph (6) may be given to the plaintiff either—
- (a) by sending it by registered post to the address of the plaintiff as shown on the originating summons; or
 - (b) if an electronic mail address of the plaintiff is shown on the originating summons, by sending it in the form of an electronic record to the address.

6. Reference under section 13(1)(b) (right in or under application for standard patent) (O. 103, r. 6)

- (1) In any proceedings in which a question is referred to the Court under section 13(1)(b), the plaintiff must serve a copy of the originating summons by which the proceedings are begun—
 - (a) on the Registrar of Patents;
 - (b) on every joint proprietor of the application for a standard patent for the invention who has not indicated consent to the making of the order sought;
 - (c) on every person to whom the plaintiff alleges any right in or under the application for a standard patent should be transferred or granted; and
 - (d) on every person whom the plaintiff believes to be the inventor or joint inventor of the invention.
- (2) If the application for a standard patent has been published at the time when the originating summons is served, the plaintiff must also serve a copy of the originating summons on every person who is shown in the register as having a right in or under the application.
- (3) If the application for a standard patent for the invention has not been published at the time when the originating summons is served, the plaintiff must also, at the time of

- servicing a copy of the originating summons under paragraph (1)(a)—
- (a) deliver to the Registrar of Patents such number of copies of the originating summons as ascertained from the Registrar of Patents before the delivery; and
 - (b) notify the Registrar of Patents that the copy is for service on a person who has given notice to the Registrar of Patents under section 46 of the Patents Rules of a transaction, instrument or event in relation to the application.
- (4) Each copy of the originating summons delivered to the Registrar of Patent must have attached to it a notice setting out—
- (a) the number assigned by the Registrar of Patents on the filing of the application for a standard patent for the invention if the number is known to the plaintiff; or
 - (b) (if the number mentioned in subparagraph (a) is not known to the plaintiff) the number assigned by a designated patent office on the filing of the application for a designated patent for the invention.
- (5) On receiving the copies of the originating summons under paragraph (3), the Registrar of Patents must send one copy by registered post to every person mentioned in paragraph (3)(b)—
- (a) at the person's address for service as shown in—
 - (i) the request to record filed under section 15(1); or
 - (ii) the application to register or notice mentioned in section 46(1) of the Patents Rules; or

- (b) if a valid address for service substituting the address for service mentioned in subparagraph (a)(i) or (ii) has been filed under the Patents Rules, at the address for service so filed.
- (6) If the Registrar of Patents is unable to comply with paragraph (5), the Registrar of Patents must notify the plaintiff in writing of that fact and state the reason for it.
- (7) A notice under paragraph (6) may be given to the plaintiff either—
 - (a) by sending it by registered post to the address of the plaintiff as shown on the originating summons; or
 - (b) if an electronic mail address of the plaintiff is shown on the originating summons, by sending it in the form of an electronic record to the address.

7. Reference under section 14(5) (right to be granted licence, etc.) (O. 103, r. 7)

In any proceedings in which a question is referred to the Court under section 14(5), the plaintiff must serve a copy of the originating summons by which the proceedings are begun on the Registrar of Patents and—

- (a) if the plaintiff is a person who claims to be entitled to be granted a licence under section 14(3), on every person in whose name the application for a patent is to proceed; or
- (b) if the plaintiff is a person in whose name the application for a patent is to proceed, on every person who claims to be entitled to be granted a licence under section 14(3).

IV. Provisions as to Patents after Grant

8. Reference under section 44(5) before expiry of period for filing counter-statement (application for revocation under section 44(4)) (O. 103, r. 8)

- (1) This rule applies if—
 - (a) the Registrar of Patents refers to the Court under section 44(5) an application for the revocation of a standard patent made under section 44(4); and
 - (b) the reference is made before the expiry of the period for filing a counter-statement under section 37(5) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book;
 - (b) give written notice to the following persons that proceedings relating to the application are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the person who made the application (*plaintiff*);
 - (iii) every person registered as the proprietor of the standard patent;
 - (iv) every other person who is shown in the register as having a right in or under the standard patent.
- (3) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.

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- (4) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
 - (5) If a person mentioned in paragraph (2)(b)(iii) or (iv) has not filed a counter-statement under section 37(5) of the Patents Rules and the person intends to oppose the application, the person must within 28 days from the date of the written notice—
 - (a) send a notice indicating an intention to oppose (*notice of intention to oppose*) by registered post to the plaintiff at the plaintiff's address for service; and
 - (b) specify in the notice the person's address for service in Hong Kong for the purpose of this rule.
 - (6) A person who has sent a notice of intention to oppose under paragraph (5) (*intending opponent*) is, subject to the Court's directions as to costs, entitled to be heard in the proceedings.
 - (7) The plaintiff must, within 7 days after the expiry of the period specified in paragraph (5)—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the application; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person registered as the proprietor of the standard patent;
 - (iii) every person who has filed a counter-statement under section 37(5) of the Patents Rules;

- (iv) every intending opponent.
- (8) Without limiting Order 65, rule 5 —
- (a) service of a copy of the case management summons on an intending opponent may be effected by sending it by registered post to the intending opponent at the address for service specified in the notice of intention to oppose;
 - (b) service of a copy of the case management summons on a person mentioned in paragraph (7)(b)(iii) may be effected by sending it by registered post to the person at the address for service specified in the counter-statement.
- (9) The case management summons must be accompanied by—
- (a) a copy of the specification of the standard patent in issue; and
 - (b) a copy of the decision, if any, of the designated patent office revoking the corresponding designated patent of the standard patent, supported by an affidavit made by or on behalf of the plaintiff—
 - (i) stating the source from which the copy was obtained; and
 - (ii) stating that, to the best of the knowledge of the deponent, the copy is a true copy of the decision.
- (9A) If the specification or decision mentioned in paragraph (9) is not in one of the official languages, the case management summons must also be accompanied by—
- (a) a translation of the specification or decision in one of those languages; and

- (b) a certificate made by the person who made the translation—
 - (i) certifying it as a correct translation; and
 - (ii) containing a statement of the person’s full name, address and qualifications for making the translation.
- (10) On hearing a case management summons taken out under this rule, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist it.
- (11) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
- (12) If the plaintiff fails to take out a case management summons within the period specified in paragraph (7), a person mentioned in paragraph (7)(b)(ii), (iii) or (iv) may—
 - (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (13) The Court may—
 - (a) on hearing a summons taken out under paragraph (12)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (12)(b)—

- (i) dismiss the proceedings on any terms that it thinks just; or
- (ii) deal with the application as if it were a case management summons taken out under this rule.

9. Reference under section 44(5) after expiry of period for filing counter-statement (application for revocation under section 44(4)) (O. 103, r. 9)

- (1) This rule applies if—
 - (a) the Registrar of Patents refers to the Court under section 44(5) an application for the revocation of a standard patent made under section 44(4); and
 - (b) the reference is made after the expiry of the period for filing a counter-statement under section 37(5) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that proceedings relating to the application are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the person who made the application (*plaintiff*);
 - (iii) every person registered as the proprietor of the standard patent;
 - (iv) every person who has filed a counter-statement under section 37(5) of the Patents Rules.

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- (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
 - (4) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
 - (5) The plaintiff must, within 1 month after receiving the written notice—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the application; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person registered as the proprietor of the standard patent;
 - (iii) every person who has filed a counter-statement under section 37(5) of the Patents Rules.
 - (6) Without limiting Order 65, rule 5, service of a copy of the case management summons on a person mentioned in paragraph (5)(b)(iii) may be effected by sending it by registered post to the person at the address for service specified in the counter-statement.
 - (7) The case management summons must be accompanied by—
 - (a) a copy of the specification of the standard patent in issue; and
 - (b) a copy of the decision, if any, of the designated patent office revoking the corresponding designated

- patent of the standard patent, supported by an affidavit made by or on behalf of the plaintiff—
- (i) stating the source from which the copy was obtained; and
 - (ii) stating that, to the best of the knowledge of the deponent, the copy is a true copy of the decision.
- (7A) If the specification or decision mentioned in paragraph (7) is not in one of the official languages, the case management summons must also be accompanied by—
- (a) a translation of the specification or decision in one of those languages; and
 - (b) a certificate made by the person who made the translation—
 - (i) certifying it as a correct translation; and
 - (ii) containing a statement of the person's full name, address and qualifications for making the translation.
- (8) On hearing a case management summons taken out under this rule, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist it.
- (9) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.

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- (10) If the plaintiff fails to take out a case management summons within the period specified in paragraph (5), a person mentioned in paragraph (5)(b)(ii) or (iii) may—
- (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (11) The Court may—
- (a) on hearing a summons taken out under paragraph (10)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (10)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

10. Application under section 46(1) (application to amend specification of patent after grant) (O. 103, r. 10)

- (1) This rule applies to an application to the Court under section 46(1) to amend the specification of a patent.
- (2) The proprietor of a patent who wishes to make an application under section 46(1) (*intending plaintiff*) must publish in the Gazette an advertisement that—
 - (a) sets out particulars of the amendment that the intending plaintiff intends to seek in the application; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.

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- (3) The advertisement must also state that—
- (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person’s address for service in Hong Kong (***notice of intention to oppose***) by registered post to the intending plaintiff at the intending plaintiff’s address for service; and
 - (b) a person who sends a notice of intention to oppose (***intending opponent***) is to be named as a defendant in the proceedings relating to the application to be brought by the intending plaintiff.
- (4) The proceedings must be begun within 28 days after the expiry of the period specified in paragraph (3)(a).
- (5) Every intending opponent is to be named as a defendant in the originating summons by which the proceedings are begun.
- (5A) Without limiting Order 10, rule 1, service of the originating summons on a defendant may be effected—
- (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or
 - (b) if there is a letter box for that address, by inserting through the letter box the originating summons enclosed in a sealed envelope addressed to the defendant.
- (6) The originating summons must be accompanied by a copy of the specification of the patent showing in coloured ink the amendment sought.
- (7) The plaintiff must serve on the Registrar of Patents—

- (a) a copy of the originating summons within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.
- (8) In the proceedings, the Registrar of Patents is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.
- (9) Without limiting Order 28, rule 4, the Court must, on hearing the originating summons—
- (a) give directions requiring the plaintiff and the defendant to exchange—
 - (i) statements of the grounds for allowing the amendment; and
 - (ii) statements of the grounds of objection to the amendment; and
 - (b) give directions as to the manner in which evidence is to be given and, if evidence may be given by an affidavit, directions as to the period within which such an affidavit must be filed.

11. Filing and publication of orders made under section 46(1) (O. 103, r. 11)

- (1) If the Court makes an order under section 46(1) allowing the specification of a patent to be amended, the plaintiff must, within 1 month after the date of the order, file with the Registrar of Patents—
- (a) a sealed copy of the order; and

- (b) subject to paragraph (2), a new specification as amended, which must be prepared in accordance with—
 - (i) section 12 of the Patents Rules if the patent is a standard patent; or
 - (ii) section 62 of the Patents Rules if the patent is a short term patent.
- (2) The Court may order that the filing of a copy of the specification with the amendment marked on it is sufficient compliance with the requirement under paragraph (1)(b).
- (3) The Registrar of Patents must cause a copy of the order to be published at least once in the official journal.

12. Reference under section 48(4) before expiry of period for filing notice of opposition (proprietor's offer to surrender patent) (O. 103, r. 12)

- (1) This rule applies if—
 - (a) the Registrar of Patents refers to the Court under section 48(4) a matter relating to an offer by the proprietor of a patent to surrender the patent under section 48(1); and
 - (b) the reference is made before the expiry of the period for giving a notice of opposition under section 40(2) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that proceedings relating to the matter are pending before the Court—

-
- (i) the Registrar of Patents;
 - (ii) the proprietor of the patent who has given notice to surrender the proprietor's patent under section 48(1) (*plaintiff*);
 - (iii) every person who has given notice of opposition under section 48(2) (*opponent*);
 - (iv) every joint proprietor of the patent (other than the plaintiff or the opponent) (*other joint proprietor*).
 - (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
 - (4) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
 - (5) The plaintiff must, within 1 month after receiving the written notice, publish in the Gazette an advertisement that—
 - (a) sets out—
 - (i) the particulars of the patent that the plaintiff offers to surrender; and
 - (ii) the determination and order that the plaintiff intends to seek in relation to the surrender; and
 - (b) gives the plaintiff's address for service in Hong Kong.
 - (6) The advertisement must also state that—
 - (a) if a person intends to oppose the surrender of the patent, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the

- person's address for service in Hong Kong (*notice of intention to oppose*) by registered post to the plaintiff at the plaintiff's address for service; and
- (b) a person who sends a notice of intention to oppose (*intending opponent*) is, subject to the Court's directions as to costs, entitled to be heard in the proceedings.
- (7) An intending opponent is, subject to the Court's direction as to costs, entitled to be heard in the proceedings.
- (8) The plaintiff must, within 7 days after the expiry of the period specified in paragraph (6)(a)—
- (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every opponent;
 - (iii) every other joint proprietor;
 - (iv) every intending opponent.
- (9) Without limiting Order 65, rule 5 —
- (a) service of a copy of the case management summons on an opponent may be effected by sending it by registered post to the opponent at the address for service specified in the notice of opposition;
 - (b) service of a copy of the case management summons on an intending opponent may be effected by sending it by registered post to the intending

opponent at the address for service specified in the notice of intention to oppose.

- (10) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
- (11) If the plaintiff fails to take out a case management summons within the period specified in paragraph (8), a person mentioned in paragraph (8)(b)(ii), (iii) or (iv) may—
 - (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (12) The Court may—
 - (a) on hearing a summons taken out under paragraph (11)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (11)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

13. Reference under section 48(4) after expiry of period for filing notice of opposition (proprietor's offer to surrender patent) (O. 103, r. 13)

- (1) This rule applies if—
 - (a) the Registrar of Patents refers to the Court under section 48(4) a matter relating to an offer to surrender a patent under section 48(1); and
 - (b) the reference is made after the expiry of the period for giving a notice of opposition under section 40(2) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that proceedings relating to the matter are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the proprietor of the patent who has given notice to surrender the proprietor's patent under section 48(1) (*plaintiff*);
 - (iii) every person who has given notice of opposition under section 48(2) (*opponent*);
 - (iv) every joint proprietor of the patent (other than the plaintiff or the opponent) (*other joint proprietor*).
- (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.

- (4) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
- (5) The plaintiff must, within 1 month after receiving the written notice—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every opponent;
 - (iii) every other joint proprietor.
- (6) Without limiting Order 65, rule 5, service of a copy of the case management summons on an opponent may be effected by sending it by registered post to the opponent at the address for service specified in the notice of opposition.
- (7) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
- (8) If the plaintiff fails to take out a case management summons within the period specified in paragraph (5), a person mentioned in paragraph (5)(b)(ii) or (iii) may—
 - (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or

- (b) apply to the Court for an order to dismiss the proceedings.
- (9) The Court may—
 - (a) on hearing a summons taken out under paragraph (8)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (8)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

14. Reference under section 49(2)(b) before expiry of period for filing notice of opposition (revocation of patent on grounds of “ordre public” or morality) (O. 103, r. 14)

- (1) This rule applies if—
 - (a) the Registrar of Patents refers to the Court under section 49(2)(b) the question of whether an invention is a patentable invention; and
 - (b) the reference is made before the expiry of the period for filing a notice of opposition under section 41B(1) or 41C(1) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that the proceedings relating to the question are pending before the Court—

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- (i) the Registrar of Patents;
 - (ii) the person who referred the question to the Registrar of Patents under section 49(1) (*plaintiff*);
 - (iii) every person registered as the proprietor of the patent concerned;
 - (iv) every person who has filed a notice of intention to oppose under section 41A(1) of the Patents Rules (*intending opponent*).
 - (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
 - (4) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
 - (5) The plaintiff must, within 1 month after receiving the written notice, publish in the Gazette an advertisement that—
 - (a) sets out—
 - (i) the particulars of the question on which the plaintiff intends to seek the determination of the Court;
 - (ii) the determination and order that the plaintiff intends to seek in relation to that question; and
 - (iii) brief particulars of the grounds on which the plaintiff relies in support of the determination and order to be sought; and
 - (b) gives the plaintiff's address for service in Hong Kong.
 - (6) The advertisement must also state that—

- (a) if a person intends to oppose the determination to be sought by the plaintiff, the person must, within 28 days after publication of the advertisement, send a notice, indicating an intention to oppose and specifying the person's address for service in Hong Kong, by registered post to the plaintiff at the plaintiff's address for service; and
 - (b) a person who sends a notice of intention to oppose mentioned in subparagraph (a) is, subject to the Court's directions as to costs, entitled to be heard in the proceedings.
- (7) The person mentioned in paragraph (6)(b) is, subject to the Court's direction as to costs, entitled to be heard in the proceedings.
- (8) If a person sends a notice of intention to oppose mentioned in paragraph (6)(a), the plaintiff must, within 7 days after receiving the notice, furnish that person with a copy of the application in the specified form and the statement mentioned in section 41 of the Patents Rules.
- (9) The plaintiff must, within 7 days after the expiry of the period specified in paragraph (6)(a)—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person registered as the proprietor of the patent;
 - (iii) every intending opponent;

- (iv) every person who has sent a notice of intention to oppose mentioned in paragraph (6)(a).
- (10) Without limiting Order 65, rule 5 —
 - (a) service of a copy of the case management summons on an intending opponent may be effected by sending it by registered post at the address for service specified in the notice of intention to oppose filed under section 41A(1) of the Patents Rules;
 - (b) service of a copy of the case management summons on a person mentioned in paragraph (9)(b)(iv) may be effected by sending it by registered post at the address for service specified in the notice of intention to oppose mentioned in paragraph (6)(a).
- (11) The case management summons must be accompanied by—
 - (a) a copy of the specification of the patent in issue; and
 - (b) if the specification is not in one of the official languages—
 - (i) a translation of it in one of those languages; and
 - (ii) a certificate made by the person who made the translation—
 - (A) certifying it as a correct translation; and
 - (B) containing a statement of the person’s full name, address and qualifications for making the translation.
- (12) On hearing a case management summons under this rule, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist it.

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- (13) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
- (14) If the plaintiff fails to take out a case management summons within the period specified in paragraph (9), a person mentioned in paragraph (9)(b)(ii), (iii) or (iv) may—
- (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (15) The Court may—
- (a) on hearing a summons taken out under paragraph (14)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (14)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

15. Reference under section 49(2)(b) after expiry of period for filing notice of opposition (revocation of patent on grounds of “ordre public” or morality) (O. 103 r. 15)

- (1) This rule applies if—

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- (a) the Registrar of Patents refers to the Court under section 49(2)(b) the question of whether an invention is a patentable invention; and
 - (b) the reference is made after the expiry of the period for filing a notice of opposition under section 41B(1) or 41C(1) of the Patents Rules.
- (2) On receiving the reference, the Registrar must—
- (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give notice to the following persons that proceedings relating to the question are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the person who referred the question to the Registrar of the Patents under section 49(1) (*plaintiff*);
 - (iii) every person registered as the proprietor of the patent concerned;
 - (iv) every person who has filed a notice of opposition under section 41B(1) of the Patents Rules (*opponent*).
- (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
- (4) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
- (5) The plaintiff must, within 1 month after receiving the written notice—

- (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person registered as the proprietor of the patent;
 - (iii) every opponent.
- (6) Without limiting Order 65, rule 5, service of a copy of the case management summons under paragraph (5) on an opponent may be effected by sending it by registered post to the opponent at the address for service specified in the notice of opposition.
- (7) The case management summons must be accompanied by—
 - (a) a copy of the specification of the patent in issue; and
 - (b) if the specification is not in one of the official languages—
 - (i) a translation of it in one of those languages; and
 - (ii) a certificate made by the person who made the translation—
 - (A) certifying it as a correct translation; and
 - (B) containing a statement of the person’s full name, address and qualifications for making the translation.

- (8) On hearing a case management summons under this rule, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist it.
- (9) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
- (10) If the plaintiff fails to take out a case management summons within the period specified in paragraph (5), a person mentioned in paragraph (5)(b)(ii) or (iii) may—
 - (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (11) The Court may—
 - (a) on hearing a summons taken out under paragraph (10)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (10)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

V. Property in Patents and Applications; Registration

16. Application for purposes of section 53(1) (application for rectification of register) (O. 103, r. 16)

- (1) In any proceedings relating to an application for the purposes of section 53(1), the applicant must, within 7 days after the issue of the originating summons by which the proceedings are begun, serve a copy of the originating summons on the Registrar of Patents.
- (2) If an application for the purposes of section 53(1) is made by way of counterclaim in patent infringement proceedings that are pending before the Court, the applicant must, within 7 days after making the counterclaim, serve a copy of the counterclaim on the Registrar of Patents.

17. Reference under section 55(1) (determination of right to patent after grant) (O. 103, r. 17)

In any proceedings in which a question is referred to the Court under section 55(1), the plaintiff must serve a copy of the originating summons by which the proceedings are begun on the following persons—

- (a) the Registrar of Patents;
- (b) every person who is shown in the register as having a right in or under the patent (other than the plaintiff);
- (c) every person who is alleged in the originating summons to be entitled to a right in or under the patent (other than the plaintiff).

18. Reference under section 56(5) (right to be granted licence etc. after transfer under section 55) (O. 103, r. 18)

- (1) In any proceedings in which a question is referred to the Court under section 56(5), the plaintiff must serve a copy of the originating summons by which the proceedings are begun on the Registrar of Patents.
- (2) If the plaintiff is a new proprietor of the patent, a copy of the originating summons must also be served on—
 - (a) every other new proprietor of the patent; and
 - (b) every person who, to the plaintiff's knowledge, claims to be entitled to be granted a licence under section 56(3) to continue working or to work the invention concerned.
- (3) If the plaintiff is a person claiming to be entitled to be granted a licence under section 56(3) to continue working or to work the invention concerned, a copy of the originating summons must also be served on—
 - (a) every new proprietor of the patent; and
 - (b) every other person who, to the plaintiff's knowledge, claims to be entitled to be granted a licence under section 56(3) to continue working or to work the invention concerned.

VI. Employees' Inventions

19. Application under section 58(1) or (2) (employee's application for compensation) or 59(7) (application to vary etc. Court order made under section 58(1) or (2)) (O. 103, r. 19)

- (1) This rule applies to proceedings relating to—

- (a) an application to the Court under section 58(1) or (2) for an award of compensation; or
 - (b) an application to the Court under section 59(7) for the variation or discharge of an order for payment of compensation, or for the suspension of any provision of such an order, or for the revival of any suspended provision of such an order.
- (2) Without limiting Order 28, rule 4, the Court must, on hearing the originating summons by which the proceedings are begun—
 - (a) give directions as to the manner in which evidence (including any accounts of expenditure and receipts relating to the claim for compensation) is to be given and, if evidence may be given by an affidavit, directions as to the period within which such an affidavit must be filed; and
 - (b) give directions as to the provision by the defendant to the plaintiff, or to a person deputed by the plaintiff, of reasonable facilities for inspecting and taking extracts from the books of account—
 - (i) by which the defendant proposes to verify the accounts of expenditure and receipts mentioned in subparagraph (a); or
 - (ii) from which the accounts of expenditure and receipts mentioned in subparagraph (a) have been derived.

VII. Compulsory Licences for Standard Patents

20. Application under section 64(1) (grant of compulsory licence) or 66(3) (variation etc. of compulsory licence) (O. 103, r. 20)

- (1) This rule applies to—
 - (a) an application to the Court under section 64(1) for a licence under a standard patent; or
 - (b) an application to the Court under section 66(3) for an order for the variation or cancellation of a licence granted under an order made under section 64.
- (2) A person who wishes to make an application under section 64(1) or 66(3) (*intending plaintiff*) must publish in the Gazette an advertisement that—
 - (a) sets out the particulars of the order that the intending plaintiff intends to seek in the application; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.
- (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person's address for service in Hong Kong (*notice of intention to oppose*) by registered post to the intending plaintiff at intending plaintiff's address for service; and
 - (b) a person who sends a notice of intention to oppose (*intending opponent*) is to be named as a defendant in the proceedings relating to the application to be brought by the intending plaintiff.

- (4) The proceedings must be begun within 28 days after the expiry of the period specified in paragraph (3)(a).
- (5) Every intending opponent is to be named as a defendant in the originating summons by which the proceedings are begun. Without limiting Order 10, rule 1, service of the originating summons on a defendant may be effected—
 - (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or
 - (b) if there is a letter box for that address, by inserting through the letter box the originating summons enclosed in a sealed envelope addressed to the defendant.

VIII. Import Compulsory Licences for Patented Pharmaceutical Products

21. Application under section 72J(1) (order for determination of amount of remuneration payable) (O. 103, r. 21)

- (1) This rule applies to proceedings relating to an application to the Court under section 72J(1) for an order to determine the amount of remuneration payable under section 72E(2).
- (2) The plaintiff must serve on the defendant—
 - (a) a copy of the originating summons by which the proceedings are begun within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.

- (3) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

22. Application under section 72J(2) (order for payment of remuneration) (O. 103, r. 22)

- (1) This rule applies to proceedings relating to an application to the Court under section 72J(2) for an order for payment of remuneration under section 72E(2).
- (2) The proprietor of the patent concerned is to be named as a defendant in the proceedings.
- (3) The plaintiff must serve on the Director of Health—
 - (a) a copy of the originating summons by which the proceedings are begun within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.
- (4) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

23. Application under section 72J(6) (review of grant of import compulsory licence, its terms or conditions, termination, etc.) (O. 103, r. 23)

- (1) This rule applies to proceedings relating to an application to the Court under section 72J(6) for a review of—
 - (a) the grant of an import compulsory licence;
 - (b) the terms or conditions of an import compulsory licence;

- (c) the apportionment of the amount of remuneration;
or
 - (d) the termination of an import compulsory licence.
- (2) The plaintiff must serve on the Director of Health—
 - (a) a copy of the originating summons by which the proceedings are begun within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.
- (3) If the application is for a review of a matter mentioned in paragraph (1)(a), (b) or (d), the plaintiff must also serve on the import compulsory licensee the documents specified in paragraph (2)(a) and (b).
- (4) If the application is for a review of the apportionment of the amount of remuneration, the plaintiff must also serve on every proprietor of the patent concerned the documents specified in paragraph (2)(a) and (b).
- (5) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

24. Application under section 72J(8) (application by proprietor of patent for termination of import compulsory licence) (O. 103, r. 24)

- (1) This rule applies to an application by the proprietor of a patent to the Court under section 72J(8) for an order to terminate an import compulsory licence.

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- (2) The proprietor of a patent who wishes to make an application under section 72J(8) (*intending plaintiff*) must publish in the Gazette an advertisement that—
 - (a) sets out the particulars of the order that the intending plaintiff intends to seek in the application; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.
 - (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person's address for service in Hong Kong (*notice of intention to oppose*) by registered post to the intending plaintiff at the intending plaintiff's address for service; and
 - (b) a person who sends the notice of intention to oppose (*intending opponent*) is to be named as a defendant in the proceedings relating to the application to be brought by the intending plaintiff.
 - (4) The proceedings must be begun within 28 days after the expiry of the period specified in paragraph (3)(a).
 - (5) Every intending opponent is to be named as a defendant in the originating summons by which the proceedings are begun. Without limiting Order 10, rule 1, service of the originating summons on a defendant may be effected—
 - (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or
 - (b) if there is a letter box for that address, by inserting through the letter box the originating summons

enclosed in a sealed envelope addressed to the defendant.

- (6) The plaintiff must serve on the Director of Health and the import compulsory licensee—
 - (a) a copy of the originating summons within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.
- (7) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

IX. Export Compulsory Licences for Patented Pharmaceutical Products

25. Application under section 72R(1) (review of grant of export compulsory licence, its terms or conditions, termination, etc.) (O. 103, r. 25)

- (1) In proceedings relating to an application to the Court under section 72R(1) for a review of the grant of an export compulsory licence, the terms or conditions of an export compulsory licence or the termination of an export compulsory licence, the plaintiff must serve on the Director of Health and the export compulsory licensee—
 - (a) a copy of the originating summons by which the proceedings are begun within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2 for the hearing of the originating summons not

less than 14 days before the day fixed for the hearing.

- (2) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

26. Application under section 72R(5) (application by proprietor of patent for termination of export compulsory licence) (O. 103, r. 26)

- (1) This rule applies to an application by the proprietor of a patent to the Court under section 72R(5) for an order to terminate an export compulsory licence.
- (2) The proprietor of a patent who wishes to make an application under section 72R(5) (*intending plaintiff*) must publish in the Gazette an advertisement that—
 - (a) sets out particulars of the order that the intending plaintiff intends to seek in the application; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.
- (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person's address for service in Hong Kong (*notice of intention to oppose*) by registered post to the intending plaintiff at the intending plaintiff's address; and
 - (b) a person who sends the notice of intention to oppose (*intending opponent*) is to be named as a defendant in the proceedings relating to the application to be brought by the intending plaintiff.

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- (4) The proceedings must be begun within 28 days after the expiry of the period specified in paragraph (3)(a).
 - (5) Every intending opponent is to be named as a defendant in the originating summons by which the proceedings are begun.
 - (5A) Without limiting Order 10, rule 1, service of the originating summons on a defendant may be effected—
 - (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or
 - (b) if there is a letter box for that address, by inserting through the letter box the originating summons enclosed in a sealed envelope addressed to the defendant.
 - (6) The plaintiff must serve on the Director of Health and the export compulsory licensee—
 - (a) a copy of the originating summons within 7 days after it is issued; and
 - (b) a copy of the notice of the day fixed under Order 28, rule 2, for the hearing of the originating summons not less than 14 days before the day fixed for the hearing.
 - (7) In the proceedings, the Director of Health is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.

X. Infringement, Revocation and Putting Validity in Issue

27. Patent infringement proceedings (O. 103, r. 27)

- (1) This rule applies to patent infringement proceedings if they are begun by writ.

- (2) The plaintiff must include in the statement of claim particulars of the infringements on which the plaintiff relies in support of the claim.
- (3) In proceedings under section 80, the particulars of the infringements must—
 - (a) specify which of the claims in the specification of the patent are alleged to have been infringed; and
 - (b) give at least 1 instance of each type of infringement alleged.
- (4) In proceedings under section 88, the particulars of the infringements must—
 - (a) specify which of the claims in the specification of the patent and which of the claim in the specification of the published request to record are alleged to have been infringed; and
 - (b) give at least 1 instance of each type of infringement alleged.
- (5) Paragraph (6) applies if a defendant alleges, as a defence to the plaintiff's claim, that—
 - (a) at the time of the infringement, there was in force—
 - (i) a contract relating to the patent made by or with the consent of the plaintiff; or
 - (ii) a licence under the patent granted by the plaintiff or with the plaintiff's consent; and
 - (b) the contract or the licence contains a condition or term that is void by virtue of section 62.
- (6) The defendant must include in the defence—
 - (a) particulars of the date of, and parties to, the contract or licence; and
 - (b) particulars of the void condition or term.

28. Application for purposes of section 91(1)(a) (revocation of patents) (O. 103, r. 28)

- (1) This rule applies to an application to the Court for an order to revoke a patent for an invention on the ground that the invention is not a patentable invention by reason of a matter specified in section 93(5).
- (2) A person who wishes to make an application for the purposes of section 91(1)(a) (*intending plaintiff*) must publish in the Gazette an advertisement that—
 - (a) sets out—
 - (i) particulars of the order that the intending plaintiff intends to seek in the application; and
 - (ii) brief particulars of the ground on which the intending plaintiff relies in support of the application; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.
- (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person's address for service in Hong Kong (*notice of intention to oppose*) by registered post to the intending plaintiff at the intending plaintiff's address for service; and
 - (b) a person who sends a notice of intention to oppose (*intending opponent*) is to be named as a defendant in the proceedings relating to the application to be brought by the intending plaintiff.
- (4) The proceedings must be begun within 28 days after the expiry of the period specified in paragraph (3)(a).

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- (5) Every intending opponent is to be named as a defendant in the originating summons by which the proceedings are begun.
 - (5A) Without limiting Order 10, rule 1, service of the originating summons on a defendant may be effected—
 - (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or
 - (b) if there is a letter box for that address, by inserting through the letter box the originating summons enclosed in a sealed envelope addressed to the defendant.
 - (6) The plaintiff must serve on the Registrar of Patents a copy of the originating summons.

29. Application for purposes of section 91(1)(f), (g) or (h) (revocation of patents) (O. 103 r. 29)

- (1) This rule applies to proceedings relating to an application to the Court for an order to revoke a patent for an invention on a ground mentioned in section 91(1)(f), (g) or (h).
- (2) The plaintiff must give written notice to the proprietor of each patent concerned that the proprietor may, within 3 months after receiving the notice—
 - (a) make observations; and
 - (b) apply to amend the specification of the patent.

30. Proceedings in which validity of patent is put in issue(O. 103, r. 30)

- (1) This rule applies to the following proceedings in which the validity of a patent is put in issue—

- (a) proceedings under section 72;
 - (b) patent infringement proceedings;
 - (c) proceedings under section 89;
 - (d) proceedings in which a declaration in relation to the patent is sought under section 90;
 - (e) proceedings before the Court under section 91 for the revocation of the patent.
- (2) The originating summons by which proceedings mentioned in paragraph (1)(a) or (e) are begun must include particulars of the objections to the validity of the patent on which the plaintiff relies in support of the allegation of invalidity.
- (3) If the defendant in proceedings mentioned in paragraph (1)(a) puts in issue the validity of the patent, the defendant must—
 - (a) include in the defendant's affidavit evidence particulars of the objections to the validity of the patent on which the defendant relies in support of the allegation of invalidity; and
 - (b) despite Order 28, rule 1A, within 42 days after plaintiff's service of the originating summons on the defendant, serve the affidavit evidence on the plaintiff and any other defendant.
- (4) The statement of claim endorsed on a writ by which proceedings mentioned in paragraph (1)(c) or (d) are begun must include particulars of the objections to the validity of the patent on which the plaintiff relies in support of the allegation of invalidity.
- (5) If a defendant in proceedings mentioned in paragraph (1)(b) that are begun by writ puts in issue the validity of the patent by way of defence or applies by way of

counterclaim for the revocation of the patent on a ground mentioned in section 91(1)—

- (a) the defence or counterclaim must include particulars of the objections to the validity of the patent on which the defendant relies in support of the allegation of invalidity; and
 - (b) despite Order 18, rule 2, a copy of the defence or counterclaim, including the particulars of objections, must be served on every other party in the proceedings within 42 days after the statement of claim is served on the defendant.
- (6) The particulars of objections mentioned in paragraph (2), (3), (4) or (5) must—
- (a) state all the grounds on which the validity of the patent is put in issue; and
 - (b) include any particulars that will clearly define every issue that the plaintiff or any other party to the proceedings intends to raise.
- (7) If the validity of a patent is put in issue on the ground that the invention is not a patentable invention because it is not new or does not involve an inventive step, the particulars of objections must—
- (a) state the manner, time and place of every prior publication or user relied on to support the ground; and
 - (b) if prior user is alleged—
 - (i) specify the name of every person alleged to have made the user;
 - (ii) state whether the user is alleged to have continued until the priority date of the claim in question or of the invention (as may be

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- appropriate) and, if not, the earliest and latest date on which the user is alleged to have taken place;
- (iii) contain a description accompanied by drawings, if necessary, sufficient to identify the user; and
 - (iv) if the user relates to machinery or apparatus, state whether the machinery or apparatus is in existence and where it can be inspected.
- (8) If the validity of a patent is put in issue on the ground that the invention is not a patentable invention because it does not involve an inventive step, a party to the proceedings who intends to establish that the invention involves an inventive step by relying on the commercial success of the patent must—
- (a) if the proceedings are begun by writ, state the facts of the commercial success in the party's pleadings; or
 - (b) if the proceedings are begun by originating summons, state the facts of the commercial success and provide the relevant evidence in the party's affidavit evidence.

31. Amendment of particulars (O. 103, r. 31)

In any patent infringement proceedings or proceedings under section 44(4), 49 or 91(1), the Court may at any stage of the proceedings—

- (a) without limiting Order 20, rule 5, allow a party to amend any particulars given by the party under rule 27 or 30 on any terms as to costs or otherwise that the Court thinks just; or

- (b) order a party to serve on any other party further and better particulars of the alleged infringement of, or of the objections to the validity of, the patent.

32. Restrictions on admission of evidence (O. 103, r. 32)

- (1) In any proceedings relating to a patent, if an alleged infringement of the patent is not raised in the particulars of infringements, evidence is not admissible in proof of the infringement unless the Court orders otherwise.
- (2) In any proceedings relating to a patent, if an objection to the validity of the patent is not raised in the particulars of objections to the validity of the patent, evidence is not admissible in support of the objection unless the Court orders otherwise.
- (3) In any proceedings relating to a patent, if any evidence in support of the objection to the validity of the patent is not in accordance with a statement contained in the particulars of objections, the evidence is not admissible unless the Court orders otherwise.
- (4) In any proceedings relating to a patent, if a party alleges that—
 - (a) any machinery or apparatus has been used before the priority date mentioned in rule 30(6)(b)(ii); and
 - (b) the machinery or apparatus is in existence at the date of service of the particulars of objections,evidence of the user of the machinery or apparatus before that priority date is not admissible unless any of the matters referred to in paragraph (5) is proved.
- (5) The matters are—
 - (a) if the machinery or apparatus is in the party's possession, the party offered inspection of the

machinery or apparatus to the other parties to the proceedings; and

- (b) if the machinery or apparatus is not in the party's possession, the party did the party's best to obtain inspection of the machinery or apparatus for the other parties to the proceedings.

33. Admissions of facts (O. 103, r. 33)

- (1) This rule applies to—
 - (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings before the Court under section 91 for the revocation of a patent;
 - (c) proceedings in which a declaration in relation to a patent is sought under section 90; and
 - (d) proceedings in which the validity of a patent is put in issue.
- (2) Despite Order 27, rule 2(1), a party to the proceedings who wishes to seek an admission of facts from another party must, within 21 days—
 - (a) if proceedings are begun by writ, after service of a reply or the expiry of the period for the service; or
 - (b) if proceedings are begun by originating summons, after service of the affidavit evidence in reply or the expiry of the period for the service,serve on that other party a notice requiring that other party to admit for the purposes of the proceedings the facts specified in the notice (*notice to admit*).
- (3) A party on whom a notice to admit is served must, within 21 days after service of the notice, serve a notice in reply on the party who serves the notice to admit.

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- (4) A notice in reply must, in respect of each fact specified in the notice to admit, state whether the fact is admitted or not.

34. Discovery of documents (O. 103, r. 34)

- (1) This rule applies to the following proceedings if they are begun by writ—
- (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings in which a declaration in relation to a patent is sought under section 90;
 - (c) proceedings in which the validity of a patent is put in issue.
- (2) Subject to the modifications set out in paragraph (3), Order 24 applies to proceedings mentioned in paragraph (1).
- (3) The modifications are—
- (a) the list of documents mentioned in Order 24, rule 2, must be served by each party to the proceedings—
 - (i) within 21 days after service of a notice in reply under rule 33(3) or, if more than one notice in reply has been served under that rule, within 21 days after service of the last notice in reply; or
 - (ii) if no notice to admit has been served under rule 33(2), within 21 days after the expiry of the period for serving a notice to admit under that rule; and
 - (b) documents from any of the following exempt classes are not required to be listed—

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- (i) documents relating to the alleged infringement of a patent by a product or process if, before serving a list of documents, the party against whom the allegation of infringement is made has served on the other parties full particulars of the product or process alleged to have infringed the patent, including, if necessary, drawings or other illustrations, that are verified by a statement of truth in accordance with Order 41A;
 - (ii) documents relating to any ground on which the validity of a patent is put in issue, except documents that came into existence within the period beginning 2 years before the earliest claimed priority date and ending 2 years after that date;
 - (iii) documents relating to the issue of commercial success of a patent.
- (4) The party against whom an allegation of infringement of a patent is made in the proceedings must verify the particulars of the product or process alleged to have infringed the patent by a statement of truth in accordance with Order 41A.
- (5) If the issue of commercial success relating to an article or product arises in the proceedings, the proprietor of the patent must, within the period specified in paragraph (3)(a), serve on the other parties to the proceedings a schedule containing—
- (a) an identification of the article or product (for example by product code number) that the proprietor asserts has been made in accordance with the claims in the specification of the patent;

- (b) a summary by convenient periods of sales of any such article or product;
 - (c) a summary for the equivalent periods of sales, if any, of any equivalent prior article or product marketed before the article or product mentioned in subparagraph (a);
 - (d) a summary by convenient periods of any expenditure on advertising and promotion that supported the marketing of the articles or products mentioned in subparagraphs (a) and (c).
- (6) If the issue of commercial success relating to the use of a process arises in the proceedings, the proprietor of the patent must, within the period specified in paragraph (3)(a), serve on the other parties to the proceedings a schedule containing—
 - (a) an identification of the process that the proprietor asserts has been used in accordance with the claims in the specification of the patent;
 - (b) a summary by convenient periods of the revenues received from the use of the process;
 - (c) a summary for the equivalent periods of the revenues, if any, received from the use of any equivalent prior process used before the process mentioned in subparagraph (a); and
 - (d) a summary by convenient periods of any expenditure that supported the use of the processes mentioned in subparagraphs (a) and (c).
- (7) Despite paragraphs (2) and (3), a party may apply to the Court under Order 24, rule 3 or 7, for an order for discovery of any document in an exempt class, but the

Court may only make the order if it is satisfied that justice is unlikely to be done unless the discovery is ordered.

- (8) If a party who produces for inspection a document from an exempt class is requested in writing by any other party to serve a supplementary list of all other documents within the same class as the document produced for inspection, the party must serve on that other party the supplementary list within 14 days after receiving the request unless the Court otherwise orders.
- (9) This rule does not create any privilege in a document from an exempt class.
- (10) This rule does not limit the Court's power to limit the discovery of documents on any other ground.

35. Experiments (O. 103, r. 35)

- (1) This rule applies to—
 - (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings before the Court under section 91 for the revocation of a patent;
 - (c) proceedings in which a declaration in relation to a patent is sought under section 90; and
 - (d) proceedings in which the validity of a patent is put in issue.
- (2) A party to the proceedings mentioned in paragraph (1)(a), (c) or (d) that are begun by writ who wishes to establish any facts by experimental proof must, within 21 days after being served with a list of documents under rule 34, serve on any other party a notice to establish facts.
- (3) A party to the proceedings mentioned in paragraph (1) that are begun by originating summons who wishes to

establish any facts by experimental proof must serve on any other party a notice to establish facts—

- (a) within 21 days after service of a notice in reply under rule 33(3) or, if more than one notice in reply has been served under that rule, within 21 days after service of the last notice in reply; or
 - (b) if no notice to admit has been served under rule 33(2), within 21 days after the expiry of the period for serving a notice to admit under that rule.
- (4) A notice to establish facts must—
- (a) state the facts that the party wishes to establish; and
 - (b) give full particulars of the experiments by which the party proposes to establish the facts.
- (5) A party on whom a notice to establish facts is served may request the party who served the notice to show or repeat to the first mentioned party any of the experiments identified in the notice.
- (6) A party on whom a notice to establish facts is served must, within 21 days after service of the notice, serve a notice in reply on the party who served the notice to establish facts.
- (7) A notice in reply mentioned in paragraph (6) must, in respect of each fact stated in the notice to establish facts, state whether the fact is admitted or not.
- (8) If any fact that a party wishes to establish by experimental proof is not admitted, the party may at the hearing of the case management summons taken out under rule 37 or the hearing of the originating summons taken out under rule 38, apply for directions for the experiment mentioned in paragraph (5).

36. Experts (O. 103, r. 36)

- (1) This rule applies to—
 - (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings before the Court under section 91 for the revocation of a patent;
 - (c) proceedings in which a declaration in relation to a patent is sought under section 90; and
 - (d) proceedings in which the validity of a patent is put in issue.
- (2) A party to the proceedings who wishes to adduce oral expert evidence must, not later than 14 days before the hearing of the case management summons taken out under rule 37 or the hearing of the originating summons taken out under rule 38, give notice of the name of each expert the party intends to call as a witness to every other party and to the Court.
- (3) This rule does not limit the Court's power to restrict the number of expert witnesses to be called at the trial of any particular issue.

37. Case management summons (O. 103, r. 37)

- (1) This rule applies to the following proceedings if they are begun by writ—
 - (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings in which a declaration in relation to a patent is sought under section 90;
 - (c) proceedings in which the validity of a patent is put in issue.

- (2) Subject to the modifications set out in paragraphs (3) and (4), Order 25, rules 1, 1A, 1B, 1C, 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out in proceedings mentioned in paragraph (1).
- (3) The modifications are—
 - (a) the questionnaire mentioned in Order 25, rule 1(1)(a), must be filed and served—
 - (i) if a notice to establish facts has been served under rule 35(2), within 7 days after the expiry of the period for serving a notice in reply under rule 35(6) or, if more than one notice in reply is to be served under rule 35(6), within 7 days after the expiry of the period for serving the last notice in reply; or
 - (ii) if no notice to establish facts has been served under rule 35(2), within 7 days after the expiry of the period for serving a notice to establish facts under that rule; and
 - (b) the case management summons mentioned in Order 25, rule 1(1B)(b) taken out by the plaintiff must be returnable in not less than 21 days.
- (4) A case management summons taken out in the proceedings must be accompanied by—
 - (a) a copy of the specification of the patent in issue; and
 - (b) a copy of all the documents served under rules 33, 34 and 35.
- (5) On hearing a case management summons taken out in the proceedings, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist the Court.

38. Originating summons procedure (O. 103, r. 38)

- (1) This rule applies to the following proceedings if they are begun by originating summons—
 - (a) patent infringement proceedings (whether or not relief in relation to any other matter is claimed);
 - (b) proceedings before the Court under section 91 for the revocation of a patent;
 - (c) proceedings in which a declaration in relation to a patent is sought under section 90;
 - (d) proceedings in which the validity of a patent is put in issue.
- (2) Subject to the modifications set out in paragraphs (3) and (4), Order 28 applies to proceedings mentioned in paragraph (1).
- (3) The plaintiff must obtain an appointment for the attendance of the parties before the Court for the hearing of the originating summons—
 - (a) within 21 days after service of a notice in reply under rule 35(6) or, if more than one notice in reply has been served under that rule, within 21 days after service of the last notice in reply; or
 - (b) if no notice to establish facts has been served under rule 35(2) or (3), within 21 days after the expiry of the period for serving the notice to establish facts under that rule.
- (4) The notice of fixing the hearing of the originating summons must be accompanied by—
 - (a) a copy of the specification of the patent in issue; and
 - (b) a copy of all the documents served under rules 33, 34 and 35.

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- (5) On hearing the originating summons, the Court must consider whether an independent scientific adviser should be appointed under rule 42 to assist the Court.
 - (6) On hearing the originating summons, if the Court gives any directions that it could give under Order 25 pursuant to Order 28, rule 4(4), then rule 37 and Order 25 apply to the proceedings as if they were begun by writ and the originating summons were a case management summons taken out under Order 25.

XI. Amendment of Patents

39. Application for purposes of section 102 (application to amend specification of patent) (O. 103, r. 39)

- (1) An application by the proprietor of a patent to amend the specification of the patent for the purposes of section 102 must be made by summons.
- (2) The applicant must, within 1 month after the issue of the summons or within a further period that the Court may direct, publish in the Gazette an advertisement that—
 - (a) identifies the proceedings to which the application relates;
 - (b) sets out particulars of the amendment that the applicant intends to seek in the application; and
 - (c) gives the applicant's address for service in Hong Kong.
- (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after publication of the advertisement, send a notice indicating an intention to oppose and specifying the person's address for service in Hong Kong (*notice of intention to*

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- oppose*) by registered post to the applicant at the applicant's address of service; and
- (b) a person who sends a notice of intention to oppose (*intending opponent*) is entitled to be heard at the hearing of the application, subject to the Court's directions as to costs.
- (4) An intending opponent is, subject to the Court's directions as to costs, entitled to be heard at the hearing of the application.
- (5) As soon as practicable after the expiry of the period specified in paragraph (3)(a), the applicant must serve on the Registrar of Patents and every intending opponent—
- (a) a copy of the summons;
- (b) a copy of the specification of the patent showing in coloured ink the amendment sought; and
- (c) any translations that the Court may require.
- (6) Without limiting Order 65, rule 5, service of a document on an intending opponent under paragraph (5) may be effected by sending the document by registered post to the intending opponent at the address for service specified in the notice of intention to oppose.
- (7) In the proceedings, the Registrar of Patents is entitled to appear before the Court or be represented and be heard, and must appear if so directed by the Court.
- (8) The Court must, on hearing the application, give any directions for the further conduct of the proceedings that it thinks necessary or expedient and, in particular—
- (a) directions requiring the applicant and an intending opponent to exchange—

- (i) statements of the grounds for allowing the amendment; and
 - (ii) statements of the grounds of objection to the amendment;
 - (b) directions as to whether the application is to be heard with other proceedings relating to the patent in question or separately and, if the application is to be heard separately, directions as to the date of hearing of the application; and
 - (c) directions as to the manner in which evidence is to be given and, if evidence may be given by an affidavit, directions as to the period within which such an affidavit must be filed.
- (9) If the Court makes an order allowing the specification of a patent to be amended, the applicant must, within 1 month after the date of the order, file with the Registrar of Patents—
- (a) a sealed copy of the order; and
 - (b) subject to paragraph (10), a new specification as amended, which must be prepared in accordance with—
 - (i) section 12 of the Patents Rules if the patent is a standard patent; or
 - (ii) section 62 of the Patents Rules if the patent is a short term patent.
- (10) The Court may order that the filing of a copy of the specification with the amendment marked on it is sufficient compliance with the requirement under paragraph (9)(b).
- (11) The Registrar of Patents must cause a copy of the order to be published at least once in the official journal.

XII. Miscellaneous

40. Referrals by Registrar of Patents under section 133(1)(b) of questions that are referred to Registrar of Patents under section 13(1) (O. 103, r. 40)

- (1) This rule applies if—
 - (a) a question is referred to the Registrar of Patents under section 13(1); and
 - (b) the Registrar of Patents refers it to the Court under section 133(1)(b).
- (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that proceedings relating to the question are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the person who referred the question to the Registrar of Patents under section 13(1) (*plaintiff*);
 - (iii) every person to whom the plaintiff has sent a copy of the reference and statement under section 3(3) of the Patents Rules.
- (3) If an application for a patent has been filed but has not been published before the question is referred to the Registrar of Patents under section 13(1), the Registrar must also give the written notice to the following persons (other than the plaintiff or a person to whom the copy of the reference and statement has been sent by the plaintiff)—
 - (a) the applicant in the application;

- (b) every person who has given notice to the Registrar of Patents under section 46 of the Patents Rules of a transaction, instrument or event in relation to the patent application.
- (4) A person mentioned in paragraph (2)(b)(iii) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
- (5) A person mentioned in paragraph (3)(a) or (b) must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
- (6) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
- (7) The plaintiff must, within 1 month after receiving the written notice—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person to whom the plaintiff has sent a copy of the reference and statement under section 3(3) of the Patents Rules;
 - (iii) the applicant in the patent application;
 - (iv) every person who has given notice to the Registrar of Patents under section 46 of the Patent Rules of a transaction, instrument or event in relation to the patent application.

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- (8) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve on the other parties a notice specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.
 - (9) If the plaintiff fails to take out a case management summons within the period specified in paragraph (7), a person mentioned in paragraph (2)(b)(iii) or (3)(a) or (b) may—
 - (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
 - (10) The Court may—
 - (a) on hearing a summons taken out under paragraph (9)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (9)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

41. Referrals by Registrar of Patents under section 133(1)(b) of questions that are referred to the Registrar of Patents under section 14(5) (O. 103, r. 41)

- (1) This rule applies if—

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- (a) a question is referred to the Registrar of Patents under section 14(5); and
 - (b) the Registrar of Patents refers it to the Court under section 133(1)(b).
 - (2) On receiving the reference, the Registrar must—
 - (a) file the reference and make an entry of the filing in the cause book; and
 - (b) give written notice to the following persons that proceedings relating to the question are pending before the Court—
 - (i) the Registrar of Patents;
 - (ii) the person who referred to question to the Registrar of Patent under section 14(5) (*plaintiff*).
 - (3) If the plaintiff is a person in whose name the application for a standard patent is to proceed under an order made under section 13, the Registrar must also, on receiving the reference, give written notice to every person who claims that the person is entitled to be granted a licence under section 14(3) that proceedings relating to the question referred are pending before the Court.
 - (4) If the plaintiff is a person claiming that the person is entitled to be granted a licence under section 14(3), the Registrar must also, on receiving the reference, give written notice to every person in whose name the application for a standard patent is to proceed under an order made under section 13 that proceedings relating to the question referred are pending before the Court.
 - (5) A person who claims that the person is entitled to be granted a licence under section 14(3) must, within 7 days

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- after receiving the written notice, acknowledge receipt of the notice in writing.
- (6) A person in whose name the application for a standard patent is to proceed under an order made under section 13 must, within 7 days after receiving the written notice, acknowledge receipt of the notice in writing.
 - (7) The plaintiff must, within 7 days after receiving the written notice, cause the plaintiff's address for service to be entered in the cause book.
 - (8) The plaintiff must, within 1 month after receiving the written notice—
 - (a) take out a case management summons returnable in not less than 21 days to seek directions from the Court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the case management summons on the following persons—
 - (i) the Registrar of Patents;
 - (ii) every person who claims that the person is entitled to be granted a licence under section 14(3);
 - (iii) every person in whose name the application for a standard patent is to proceed under an order made under section 13.
 - (9) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that a party to whom the case management summons is addressed is not required to serve a notice on the other parties specifying those orders and directions in so far as they differ from the orders and directions asked for by the summons under rule 7(1) of that Order.

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- (10) If the plaintiff fails to take out a case management summons within the period specified in paragraph (8), a person mentioned in paragraph (5) or (6) may—
- (a) take out a summons to seek directions from the Court for the further conduct of the proceedings; or
 - (b) apply to the Court for an order to dismiss the proceedings.
- (11) The Court may—
- (a) on hearing a summons taken out under paragraph (10)(a), give directions for the further conduct of the proceedings that it thinks necessary or expedient; or
 - (b) on hearing an application to dismiss the proceedings made under paragraph (10)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

42. Appointment of scientific adviser (O. 103, r. 42)

- (1) In any proceedings under the Ordinance, the Court may at any time, either of its own motion or on application of any party, appoint an independent scientific adviser—
- (a) to assist the Court; or
 - (b) to inquire into and report on any question of fact, or of opinion, not involving a question of law or construction.
- (2) The Court must settle—
- (a) the question to be submitted to the scientific adviser; and

- (b) the instructions to be given to the scientific adviser.
- (3) Order 40, rules 2, 3, 4, 5 and 6, apply in relation to a scientific adviser appointed under this rule and any report made by a scientific adviser as they apply in relation to a court expert and a report made by a court expert.

43. Service of documents on proprietors (O. 103, r. 43)

- (1) This rule applies to the service of a document on the proprietor of a patent in any proceedings under this Ordinance, before the proprietor has provided an address for service in an acknowledgement of service under Order 12, rule 3(2).
- (2) For the service of an originating process, or any other document that is required to be or may be served in accordance with Order 10, on the proprietor of a patent—
 - (a) Order 10 has effect as if in rule 1(2) of that Order—
 - (i) the reference to service on a defendant were a reference to service on a party who is the proprietor of a patent; and
 - (ii) the reference to the usual or last known address of the defendant were a reference—
 - (A) to the usual or last known address of the proprietor; or
 - (B) to the proprietor’s address for service as shown in the register in relation to the patent; and
 - (b) Order 65 has effect as if in rule 3(2) of that Order, the reference to Order 10, rule 1(2), were a reference to that rule 1(2) as construed in accordance with subparagraph (a).

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- (3) For the service of a document other than those mentioned in paragraph (2) on the proprietor of a patent, Order 65 has effect as if in rule 5 of that Order, the addresses specified in paragraph (2)(a), (b), (c) and (d) of that rule included the address for service of the proprietor as shown in the register in relation to the patent.
- (4) A document served on the proprietor of a patent at the address for service of the proprietor shown in the register in relation to the patent in accordance with these rules is treated as having been duly served within the jurisdiction on the proprietor even if the proprietor is not within the jurisdiction on the date of service mentioned in Order 10, rule 1(3)(a).

44. Filing of orders etc. with Registrar of Patents (O. 103, r. 44)

Without limiting rule 11(1), if the Court has made an order, a direction or a declaration, or has granted a certificate, in favour of a person in any proceedings under the Ordinance, the person or, if there is more than one such person, the person directed by the Court, must file a sealed copy of the order, direction, declaration or certificate with the Registrar of Patents within 1 month after the date of the order, direction, declaration or certificate.

45. Transitional (O. 103, r. 45)

Despite the repeal effected by rule 3 of the Rules of the High Court (Amendment) Rules 2017 (L.N. _____ of 2017), the provisions of this Order as in force immediately before the commencement date of those Rules continue to apply to proceedings brought under the Ordinance that are pending immediately before that commencement date.”.

Division 2—Related and Consequential Amendments

- 4. Order 25, rule 1 amended (case management summons and conference)**
 - (1) Order 25, rule 1(2)(f), after “pending;”—
Add
“and”.
 - (2) Order 25, rule 1(2)—
Repeal subparagraph (h).

- 5. Order 29, rule 7 amended (directions)**

Order 29, rule 7(2)—

Repeal
“and (e) to (h)”

Substitute
“, (e) and (f)”.

- 6. Order 33, rule 4 amended (determining the place and mode of trial)**

Order 33, rule 4(4)—

Repeal
“rule 26”

Substitute
“rule 37”.

- 7. Order 62, First Schedule amended**
 - (1) Order 62, First Schedule, Part II, paragraph 4(2)—
Repeal

“rule 27”

Substitute

“, rule 42”.

(2) Order 62, First Schedule, Part II, paragraph 4—

Repeal sub-paragraph (3).

Made this day of 2017.

Explanatory Note

These Rules repeal and replace the existing Order 103 of the Rules of the High Court (Cap. 4 sub. leg. A) (**RHC**) consequent on the enactment of the Patents Ordinance (Cap. 514) (*the Ordinance*) and the repeal of the Registration of Patents Ordinance (Cap. 42).

2. Rule 2 of the new Order 103 provides that RHC apply to all proceedings brought before the Court of First Instance (**Court**) under the Ordinance subject to special provisions of the new Order 103.

II. Originating Proceedings

3. The new rule 3(1) provides that certain proceedings under the Ordinance must be begun by originating summons.
4. The new rule 4 deals with information to be included in an originating summons and the scope of application of Order 10 in relation to the service of an originating summons.

III. Right to Apply for Standard Patent

5. The new rules 5 and 6 deal with the service of an originating summons in proceedings relating to right to apply for standard patent under section 13(1)(a) and (b) of the Ordinance.
6. The new rule 7 deals with the service of an originating summons in proceedings relating to right to be granted licence, etc. under section 14(5) of the Ordinance.

IV. Provisions as to Patents after Grant

7. The new rules 8 and 9 provide for the procedures by which to an application for revocation of a standard patent is referred to the Court under section 44(5) of the Ordinance.

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8. The new rules 10 and 11 provide for the procedures relating to an application to amend specification of a patent after grant under section 46(1) of the Ordinance.
 9. The new rules 12 and 13 provide for the procedures relating to a proprietor's offer to surrender a patent under section 48(4) of the Ordinance.
 10. The new rules 14 and 15 provide for the procedures relating to revocation of a patent on grounds of "ordre public" or morality under section 49(2)(b) of the Ordinance.

V. Property in Patents and Application; Registration

11. The new rule 16 deals with an application for rectification of the register of patents under section 53(1) of the Ordinance.
12. The new rule 17 deals with the service of an originating summons in proceedings relating to a determination of right to patent after grant under section 55(1) of the Ordinance.
13. The new rule 18 deals with the service of an originating summons in proceedings relating to right to be granted licence, etc. under section 56(5) of the Ordinance.

VI. Employees' Inventions

14. The new rule 19 provides for the procedures relating to an application for employee compensation under section 58(1) or (2) of the Ordinance and application to vary, discharge or suspend a Court order under section 59(7) of the Ordinance.

VII. Compulsory Licences for Standard Patents

15. The new rule 20 provides for the procedures relating to an application for grant of a compulsory licence under section 64(1) of the Ordinance or variation or cancellation of a compulsory licence under section 66(3) of the Ordinance.

**VIII. Import Compulsory Licences for Patented
Pharmaceutical Products**

16. The new rule 21 provides for the procedures relating to an application for determination of remuneration under section 72J(1) of the Ordinance.
17. The new rule 22 provides for the procedures relating to an application for an order for payment of remuneration under section 72J(2) of the Ordinance.
18. The new rule 23 provides for the procedures relating to an application for review of grant of import compulsory licences, etc. under section 72J(6) of the Ordinance.
19. The new rule 24 provides for the procedures relating to an application for termination of an import compulsory licence under section 72J(8) of the Ordinance.

**IX. Export Compulsory Licences for Patented
Pharmaceutical Products**

20. The new rule 25 provides for the procedures relating to an application for review of grant of export compulsory licence, etc. under section 72R(1) of the Ordinance.
21. The new rule 26 provides for the procedures relating to an application for termination of an export compulsory licence under section 72R(5) of the Ordinance.

X. Infringement, Revocation and Putting Validity in Issue

22. The new rule 27 deals with the particulars of the infringements and the particulars of the objections to the validity of the patent in patent infringement proceedings.

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23. The new rules 28 and 29 provide for the procedures relating to applications for revocation of patents under section 91(1) of the Ordinance.
 24. The new rule 30 deals with particulars of objections to the validity of a patent.
 25. The new rule 31 provides for amendment of particulars and service of further or better particulars in certain proceedings relating to patents.
 26. The new rule 32 provides for restrictions on admission of certain evidence in proceedings relating to patents.
 27. The new rule 33 deals with notice to admit facts in certain proceedings relating to patents.
 28. The new rule 34—
 - (a) provides that Order 24 (discovery of documents) with certain modifications apply to certain proceedings relating to patents; and
 - (b) provides for discovery of documents in proceedings involving the issue of commercial success.
 29. The new rule 35 provides for the procedures relating to establishment of facts by experimental proof in certain proceedings relating to patents.
 30. The new rule 36 provides for the procedures for adducing expert evidence in certain proceedings relating to patents.
 31. The new rule 37 provides for certain special procedures for case management summons in certain proceedings relating to patents.
 32. The new rule 38 provides for certain special procedures for originating summons in certain proceedings relating to patents.

XI. Amendment of Patents

33. The new rule 39 provides for the procedures for an application to amend specification of a patent under section 102 of the Ordinance.

XII. Miscellaneous

34. The new rules 40 and 41 provide for the procedures relating to referrals made by the Registrar of Patents under section 133(1)(b) of the Ordinance.
35. The new rule 42—
- (a) empowers the Court to appoint a scientific adviser; and
 - (b) provides that Order 40, rules 2, 3, 4, 5 and 6 apply to the scientific adviser so appointed and reports made by the adviser.
36. The new rule 43 provides for the service of a document on the proprietor of a patent, before the proprietor has provided an address for service under Order 12, rule 3(2).
37. The new rule 44 provides for filing of court orders, directions, declarations and certificates with the Registrar of Patents.
38. The new rule 45 is a transitional provision for any proceedings brought under the pre-repealed Order 103 that are pending immediately before the commencement date of the new Order 103.
39. Rules 4, 5, 6 and 7 are related and consequential amendments.

Rules of the High Court (Amendment) Rules 2017

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Order 122

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Rules of the High Court (Amendment) Rules 2017

(Made by the Rules Committee of the High Court under section 54 of the High Court Ordinance (Cap. 4))

1. Commencement

These Rules come into operation on [].

2. Rules of the High Court amended

The Rules of the High Court (Cap. 4 sub. leg. A) are amended as set out in sections 3 and 4.

3. Order 122 added

After Order 121—

Add

“Order 122

Registered Designs Ordinance (Cap. 522)

1. Interpretation (O. 122, r. 1)

(1) In this Order—

court () means the Court of First Instance;

the Registered Designs Rules () means the Registered Designs Rules (Cap. 522 sub. leg. A);

the Ordinance () means the Registered Designs Ordinance (Cap. 522).

(2) In this Order, a section referred to by number means the section so numbered in the Ordinance.

- (3) Expressions used in this Order that are used in the Ordinance have the same meaning in this Order as in the Ordinance.

2. Application (O. 122, r. 2)

These rules apply to proceedings brought before the court under the Ordinance subject to this Order.

3. Proceedings to be begun by originating summons (O. 122, r. 3)

- (1) Proceedings relating to matters under the following provisions of the Ordinance must be begun by originating summons —
- (a) section 40 (disputes as to Government use);
 - (b) section 41 (question of right after registration of design);
 - (c) section 42(5) (question of entitlement to grant of licence following transfer of registered design under section 41);
 - (d) section 45 (application for revocation of registration of design);
 - (e) section 46(1) (application for revocation of design on ground that person is not entitled to be registered as owner);
 - (f) section 53(1) (application for order for delivery up);
 - (g) section 54(1) (application for order for disposal);
 - (h) section 66(1) (application for rectification of Register); and
 - (i) section 93(3) (application for declaration regarding exclusive privileges and rights in design).

- (2) This rule does not apply to a matter to be brought before the court in proceedings pending before it.

4. Supplementary provisions for originating summons etc. (O. 122, r. 4)

- (1) An originating summons by which any proceedings under the Ordinance are begun must include a concise statement setting out—
 - (a) the nature of the question referred to, or of the matter brought before, the court;
 - (b) the facts, laws and evidence on which the person who takes out the originating summons relies; and
 - (c) the order or relief sought.
- (2) A provision of this Order specifying information that must be included in an originating summons is not to be read as limiting the application of paragraph (1).
- (3) If a person is—
 - (a) required under this Order to serve a copy of an originating summons on another person; and
 - (b) required under Order 10 or any other provision of these rules to serve the originating summons on that other person,the person must serve on that other person the summons under Order 10 or that other provision instead of a copy of it.
- (4) Except as otherwise provided in this Order, Order 10 applies in relation to the service of a copy of an originating summons required to be served under this Order as that Order applies to the service of an originating process.

5. Reference under section 41 (determination of rights after registration) (O. 122, r. 5)

In any proceedings in which a question is referred to the court under section 41(1) in relation to a registered design, the plaintiff must serve a copy of the originating summons by which the proceedings are begun on—

- (a) the Registrar of Designs;
- (b) every person who is shown in the Register as having a right in or under the registered design (other than the plaintiff); and
- (c) every person who is alleged in the originating summons to be entitled to a right in or under the registered design (other than the plaintiff).

6. Reference under section 42(5) (entitlement to be granted licence etc. after transfer under section 41) (O. 122, r. 6)

In any proceedings in which a question is referred to the court under section 42(5) in relation to a registered design, the plaintiff must serve a copy of the originating summons by which the proceedings are begun on—

- (a) the Registrar of Designs;
- (b) every new owner of the registered design to which the licence relates (other than the plaintiff); and
- (c) every person who, to the plaintiff's knowledge, claims to be entitled to be granted a licence under section 42(3) to continue to do the act or to do the act concerned (other than the plaintiff).

7. Reference under section 44(3) within period for filing notice of opposition (revocation on ground of public order or morality) (O. 122, r. 7)

- (1) This rule applies if—
 - (a) a question of whether a design is a registrable design is referred to the Registrar of Designs under section 44(1) by an application under section 37 of the Registered Design Rules;
 - (b) the Registrar of Designs refers the question to the court under section 44(3); and
 - (c) the reference by the Registrar of Designs is made within the period for filing a notice of opposition under section 38(1) or 38A(1) of the Registered Designs Rules in relation to the application.
- (2) The Registrar of High Court must, on receiving the reference—
 - (a) file the reference and make an entry of the fact in the cause book; and
 - (b) give written notice to all of the following persons that proceedings relating to the question are pending before the court—
 - (i) the Registrar of Designs;
 - (ii) the person who made the application mentioned in subsection (1)(a) (*plaintiff*);
 - (iii) every registered owner of the registered design;
 - (iv) every person who has filed a notice of intention to oppose under section 37A of the Registered Designs Rules in relation to the application (*intending opponent*).

- (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving a notice given under paragraph (2)(b), acknowledge receipt of the notice in writing.
- (4) The plaintiff must, within 7 days after receiving a notice given under paragraph (2)(b), cause the plaintiff's address for service to be entered in the cause book.
- (5) The plaintiff must, within 1 month after receiving a notice given under paragraph (2)(b), publish in the Gazette an advertisement that—
 - (a) sets out—
 - (i) the question on which the plaintiff seeks the determination of the court;
 - (ii) the determination and order that the plaintiff seeks in relation to the question; and
 - (iii) the brief particulars of the grounds and facts on which the plaintiff relies; and
 - (b) gives the plaintiff's address for service in Hong Kong.
- (6) The advertisement must also state that—
 - (a) if a person intends to oppose the determination sought by the plaintiff, the person must, within 28 days after the day on which the advertisement is published—
 - (i) send a notice indicating an intention to oppose the determination (***notice of intention to oppose***) by registered post to the plaintiff at the plaintiff's address for service; and
 - (ii) specify in the notice the person's address for service in Hong Kong; and

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- (b) the person is, subject to the court's directions as to costs, entitled to be heard in the proceedings.
- (7) A person who sends a notice of intention to oppose mentioned in paragraph (6)(a) is, subject to the Court's direction as to costs, entitled to be heard in the proceedings.
- (8) If a person sends a notice of intention to oppose, the plaintiff must, within 7 days after receiving the notice, furnish that person with a copy of the application and statement mentioned in section 37(1) of the Registered Designs Rules.
- (9) The plaintiff must, within 7 days after the expiry of the period mentioned in paragraph (6)(a)—
- (a) take out a case management summons returnable in not less than 21 days to seek directions from the court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the summons on—
 - (i) the Registrar of Designs;
 - (ii) every registered owner of the registered design;
 - (iii) every intending opponent; and
 - (iv) every person who has sent a notice of intention to oppose.
- (10) Without limiting Order 65, rule 5—
- (a) service of a copy of the case management summons on an intending opponent may be effected by sending it by registered post at the address for service of the intending opponent specified in the notice filed by the intending

opponent under section 37A(1) of the Registered Designs Rules;

- (b) service of a copy of the case management summons on a person mentioned in paragraph (9)(b)(iv) may be effected by sending it by registered post at the address for service of the person specified in the notice of intention to oppose sent by that person.
- (11) On hearing a case management summons under this rule, the Court must consider whether an independent scientific adviser should be appointed under rule 14 to assist it.
 - (12) Order 25, rules 2, 3, 4, 5, 6 and 7, apply in relation to a case management summons taken out under this rule except that the party to whom the case management summons is addressed is not required to serve on the other parties the notice required by rule 7(1) of that Order.
 - (13) If the plaintiff fails to take out the case management summons, a person mentioned in paragraph (9)(b)(ii), (iii) or (iv) may—
 - (a) take out a summons to seek directions from the court for the further conduct of the proceedings; or
 - (b) apply to the court for an order to dismiss the proceedings.
 - (14) The court may—
 - (a) on hearing a summons taken out under paragraph (13)(a), give directions for the further conduct of the proceedings; or
 - (b) on hearing an application made under paragraph (13)(b)—

- (i) dismiss the proceedings on any terms that it thinks just; or
- (ii) deal with the application as if it were a case management summons taken out under this rule.

8. Reference under section 44(3) after deadline for filing notice of opposition (revocation on ground of public order or morality) (O. 122, r. 8)

- (1) This rule applies if—
 - (a) a question of whether a design is a registrable design is referred to the Registrar of Designs under section 44(1) by an application under section 37 of the Registered Design Rules;
 - (b) the Registrar of Designs refers the question to the court under section 44(3); and
 - (c) the reference by the Registrar of Designs is made after the deadline for filing a notice of opposition under section 38 or 38A(1) of the Registered Designs Rules in relation to the application.
- (2) The Registrar of High Court must, on receiving the reference—
 - (a) file the reference and make an entry of the fact in the cause book; and
 - (b) give written notice to all of the following persons that proceedings relating to the question are pending before the court—
 - (i) the Registrar of Designs;
 - (ii) the person who made the application mentioned in subsection (1) (*plaintiff*);

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- (iii) every registered owner of the registered design;
 - (iv) every person who has filed a notice of opposition under section 38 of the Registered Designs Rules in relation to the application (*opponent*).
- (3) A person mentioned in paragraph (2)(b)(iii) or (iv) must, within 7 days after receiving a notice given under paragraph (2)(b), acknowledge receipt of the notice in writing.
- (4) The plaintiff must, within 7 days after receiving a notice given under paragraph (2)(b), cause the plaintiff's address for service to be entered in the cause book.
- (5) The plaintiff must, within 1 month after receiving a notice given under paragraph (2)(b)—
- (a) take out a case management summons returnable in not less than 21 days to seek directions from the court as to the filing of documents and any other matters in relation to the proceedings; and
 - (b) serve a copy of the summons on—
 - (i) the Registrar of Designs;
 - (ii) every registered owner of the registered design; and
 - (iii) every opponent.
- (6) If the plaintiff fails to take out the case management summons, a person mentioned in paragraph (5)(b)(ii) or (iii) may—
- (a) take out a summons to seek directions from the court for the further conduct of the proceedings; or

- (b) apply to the court for an order to dismiss the proceedings.
- (7) The court may—
 - (a) on hearing a summons taken out under paragraph (6)(a), give directions for the further conduct of the proceedings; or
 - (b) on hearing an application made under paragraph (6)(b)—
 - (i) dismiss the proceedings on any terms that it thinks just; or
 - (ii) deal with the application as if it were a case management summons taken out under this rule.

9. Application for revocation under section 45 (on ground of public order or morality) (O. 122, r. 9)

- (1) This rule applies to proceedings relating to an application to the court under section 45 for an order to revoke the registration of a registered design on the ground that the design was not registrable by reason of section 7.
- (2) A person who wishes to make an application (*intending plaintiff*) must, before doing so, publish in the Gazette an advertisement that—
 - (a) sets out—
 - (i) the order that the intending plaintiff intends to seek; and
 - (ii) brief particulars of the grounds and facts on which the intending plaintiff relies; and
 - (b) gives the intending plaintiff's address for service in Hong Kong.

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- (3) The advertisement must also state that—
 - (a) if a person intends to oppose the application, the person must, within 28 days after the day on which the advertisement is published—
 - (i) send a notice indicating an intention to oppose the application (***notice of intention to oppose***) by registered post to the intending plaintiff at the intending plaintiff's address for service; and
 - (ii) specify in the notice the person's address for service in Hong Kong; and
 - (b) a person who sends a notice of intention to oppose (***intending opponent***) is to be named as the defendant in the proceedings relating to the application to be brought by the intending plaintiff.
 - (4) The originating summons concerned must—
 - (a) be taken out within 28 days after the expiry of the period mentioned in paragraph (3)(a);
 - (b) include the particulars of the objections to the registration of the design on which the plaintiff relies.
 - (5) Every intending opponent is to be named as a defendant in the originating summons.
 - (6) Without limiting Order 10, rule 1, service of the originating summons on the defendant may be effected—
 - (a) by sending the originating summons by registered post to the defendant at the address for service specified in the notice of intention to oppose; or

- (b) if there is a letter box for that address, by inserting through the letter box the originating summons enclosed in a sealed envelope addressed to the defendant.
- (7) The particulars of objections mentioned in paragraph (4)(b) must—
 - (a) state every ground on which the registration of the design is contested; and
 - (b) include any particulars that will clearly define every issue which the plaintiff or any other party to the proceedings intends to raise.
- (8) The plaintiff must serve on the Registrar of Designs a copy of the originating summons within 7 days after the date on which the summons is taken out.

10. Application for revocation under section 45 (other than on ground of public order or morality) or 46 (O. 122, r. 10)

- (1) The originating summons by which proceedings are begun for the purposes of section 45 or 46(1) must include the particulars of the objections to the registration of the design on which the plaintiff relies.
- (2) Paragraph (1) does not apply to proceedings to which rule 8 applies.
- (3) The particulars of the objections mentioned in paragraph (1) must—
 - (a) state all the grounds on which the registration of the design is contested; and
 - (b) include any particulars that will clearly define every issue which the plaintiff or any other party to the proceedings intends to raise.

- (4) The plaintiff must serve on the Registrar of Designs a copy of the originating summons within 7 days after the date on which the summons is taken out.

11. Application under section 53(1) or 54(1) (order for delivery up or disposal) (O. 122, r. 11)

- (1) In any proceedings relating to an application for an order under section 53(1) or 54(1), the person who has in the person's possession, custody or control in the course of a business the article or thing in respect of which the order is sought (*subject item*) must be made defendant to the proceedings.
- (2) The originating summons by which proceedings are begun for the purposes of section 53(1) or 54(1) must be supported by an affidavit—
 - (a) stating the name and the last known address of the defendant;
 - (b) specifying and describing the subject item; and
 - (c) stating—
 - (i) that to the best of the information or belief of the deponent the defendant is within the jurisdiction and has in the defendant's possession, custody or control in the course of a business the subject item; and
 - (ii) the sources of the deponent's information or the grounds for the belief.
- (3) The plaintiff must serve the originating summons together with a copy of the supporting affidavit on all persons interested in the subject item so far as reasonably ascertainable.

12. Application for purposes of section 66(1) (rectification of Register) (O. 122, r. 12)

In any proceedings relating to an application for the purposes of section 66(1), the applicant must, within 7 days after the issue of the originating summons by which the proceedings are begun, serve a copy of the summons on the Registrar of Designs.

13. Counterclaim for rectification of Register, etc. (O. 122, r. 13)

- (1) The defendant in any proceedings in respect of a registered design may do any or all of the following—
 - (a) in the defence contest the registration of the design;
 - (b) make a counterclaim for either or both of the following orders—
 - (i) an order that the Register be rectified by deleting or varying the registration;
 - (ii) an order that the registration of the design be revoked.
- (2) The defence or counterclaim must include particulars of the objections to the registration of the design on which the defendant relies.
- (3) Despite Order 18, rule 2, the defendant must, within 42 days after the day on which the statement of claim was served on the defendant—
 - (a) serve on all other parties to the proceedings a copy of the defence or counterclaim; and
 - (b) if the defendant makes a counterclaim for an order under paragraph (1)(b)—also serve a copy of the counterclaim on the Registrar of Designs.

- (4) The particulars of objections referred to in paragraph (2) must—
 - (a) state all the grounds on which the registration of the design is contested; and
 - (b) include any particulars that will clearly define every issue that the plaintiff or any other party to the action intends to raise.
- (5) If a copy of a counterclaim is served on the Registrar of Designs, the Registrar of Designs may take part in the proceedings as the Registrar of Designs thinks fit.
- (6) If the Registrar of Designs takes part in the proceedings, the Registrar need not serve a defence to counterclaim or other pleading unless ordered to do so by the court.

14. Application under section 93(3) (court’s power to make declarations) (O. 122, r. 14)

In any proceedings relating to an application for the purposes of section 93(3), the applicant must serve a copy of the originating summons by which the proceedings are begun on the registered proprietor of the design deemed by section 91 to be registered under the Ordinance.

15. Appointment of scientific adviser (O. 122, r. 15)

- (1) In any proceedings under the Ordinance, the court may at any time, either of its own motion or on application of any party, appoint an independent scientific adviser—
 - (a) to assist the court; or
 - (b) to inquire into and report on any question of fact, or of opinion, not involving a question of law or construction.
- (2) The court must settle—

- (a) the question to be referred to the scientific adviser;
and
 - (b) the instructions to be given to the scientific adviser.
- (3) Order 40, rules 2, 3, 4, 5 and 6 apply in relation to a scientific adviser appointed under this rule and any report made by a scientific adviser as they apply in relation to a court expert and a report made by a court expert.

16. Service of documents on owner of registered design (O. 122, r. 16)

- (1) This rule applies to the service of a document on the owner of a registered design in any proceedings under the Ordinance before the owner has provided an address for service in an acknowledgement of service under Order 12, rule 3(2).
- (2) For the service of an originating process, or of any other document which is required to be or may be served in accordance with Order 10, on the owner of a registered design—
 - (a) Order 10 has effect as if in rule 1(2) of that Order—
 - (i) the reference to service on a defendant were a reference to service on a party who is the owner of a registered design; and
 - (ii) the reference to the usual or last known address of the defendant were a reference to—
 - (A) the usual or last known address of the owner; or

- (B) the address for service of the owner as shown in the Register in relation to the design; and
- (b) Order 65 has effect as if in rule 3(2) of that Order, the reference to Order 10, rule 1(2) were a reference to that rule 1(2) as construed in accordance with subparagraph (a).
- (3) For the service of a document other than those mentioned in paragraph (2) on the owner of a registered design, Order 65 has effect as if, in rule 5 of that Order, the addresses specified in paragraph (2)(a), (b), (c) and (d) of that rule included the address for service of the owner as shown in the Register in relation to the design.
- (4) A document served on the owner of a registered design at the address for service of the owner as shown in the Register in relation to the design in accordance with these rules as modified by this rule is treated as having been duly served within the jurisdiction on the owner even if the owner is not within the jurisdiction at the time of service.

17. Filing of orders, etc. with Registrar of Designs (O. 122, r. 17)

If the court has made or granted an order, declaration or certificate in favour of a person in any proceedings under the Ordinance, the person or, if there is more than one such person, the person directed by the court must file a sealed copy of the order, declaration or certificate with the Registrar of Designs within 1 month after the date of the order, declaration or certificate.”

4. Order 62, First Schedule amended

Order 62, First Schedule, Part II, paragraph 4(2)—

Repeal

“() shall not”

Substitute

“or Order 122, rule 15) must not”.

Made this day of 2017.

Explanatory Note

These Rules add a new Order 122 to the Rules of the High Court (Cap. 4 sub. leg. A) (*RHC*) consequent on the enactment of the Registered Designs Ordinance (Cap. 522) (*the Ordinance*) and to make a related amendment to Order 62 of the RHC. In the following paragraphs, a rule referred to by number means the rule so numbered under the new Order 122.

2. Rule 2 provides that the RHC apply to proceedings brought before the Court of First Instance (*the Court*) under the Ordinance subject to specific provisions of the new Order 122.
3. Rule 3(1) provides that certain proceedings under the Ordinance must be begun by originating summons.
4. Rule 4 deals with the information to be included in an originating summons and the scope of application of Order 10 and other rules of the RHC in relation to the service of an originating summons for commencing proceedings under the Ordinance.
5. Rule 5 deals with the service of an originating summons in proceedings relating to the right to a design after its registration under section 41(1) of the Ordinance.
6. Rule 6 deals with the service of an originating summons in proceedings relating to the entitlement to be granted a licence etc. under section 42(5) of the Ordinance.
7. Rules 7 and 8 provide for the procedures relating to a reference by the Registrar of Designs to the court of an application for revocation of the registration of a design on the ground of public order or morality under section 44(3) of the Ordinance.
8. Rules 9 and 10 provide for the procedures relating to an application for revocation of the registration of a design under section 45 or 46 of the Ordinance.

9. Rule 11 provides for the procedures relating to an application for an order for the delivery up of infringing articles and anything designed or adapted for making those articles, or for their disposal under section 53(1) or 54(1) of the Ordinance.
10. Rule 12 deals with an application for the rectification of the Register of Designs (*the Register*) under section 66(1) of the Ordinance.
11. Rule 13 deals with the procedures for contesting the registration of a design in a defence and making a counterclaim for an order that the Register be rectified or the registration of a design be revoked.
12. Rule 14 provides for the service of an originating summons in respect of an application made under section 93(3) of the Ordinance for a declaration that exclusive privileges and rights in a design have not been acquired in Hong Kong under section 91 of the Ordinance.
13. Rule 15—
 - (a) empowers the court to appoint a scientific adviser, either of its own motion or on the application of any party;
 - (b) provides that Order 40, rules 2, 3, 4, 5 and 6 of the RHC apply to the scientific adviser so appointed and to the reports made by the adviser.
14. Rule 16 provides for the service of documents on the owner of a design, until the owner has provided an address for service under Order 12, rule 3(2) of the RHC.
15. Rule 17 provides for the filing of court orders, declarations or certificates with the Registrar of Designs.

Trade Marks (Amendment) Rules 2017

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Trade Marks (Amendment) Rules 2017

(Made by the Registrar of Trade Marks under section 91 of the Trade Marks Ordinance (Cap. 559))

1. Commencement

These Rules come into operation on [].

2. Trade Marks Rules amended

The Trade Marks Rules (Cap. 559 sub. leg. A) are amended as set out in sections 3 to 9.

3. Part 6, cross-headings amended

(1) Part 6, cross-heading before rule 36—

Repeal

“Procedure for revocation on grounds of non-use”

Substitute

“Division 1—Procedure for revocation on grounds of non-use”.

(2) Part 6, cross-heading before rule 40—

Repeal

“Procedure for revocation on grounds other than non-use”

Substitute

“Division 2—Procedure for revocation on grounds other than non-use”.

(3) Part 6, cross-heading before rule 46—

Repeal

“Procedure for declaration of invalidity”

Substitute

“Division 3—Procedure for declaration of invalidity”.

- (4) Part 6, cross-heading before rule 48—

Repeal

“Procedure for variation and rectification”

Substitute

“Division 4—Procedure for variation and rectification”.

- (5) Part 6, cross-heading before rule 51—

Repeal

“Interventions”

Substitute

“Division 5—Interventions”.

4. Rule 36 amended (application for revocation)

Rule 36—

Add

- “(4) On receiving the application, the Registrar must—
- (a) enter a notice of the application in the register; and
 - (b) advertise the fact of the application having been filed in the official journal.”.

5. Rule 40 amended (application for revocation)

Rule 40—

Add

- “(4) On receiving the application, the Registrar must—
- (a) enter a notice of the application in the register; and
 - (b) advertise the fact of the application having been filed in the official journal.”.

6. Rule 46 amended (application for declaration of invalidity)

Rule 46—

Add

- “(4) On receiving the application, the Registrar must—
- (a) enter a notice of the application in the register; and
 - (b) advertise the fact of the application having been filed in the official journal.”.

7. Rule 50 amended (procedure where application is made by a person other than the owner)

Rule 50—

Add

- “(2A) On receiving the application, the Registrar must—
- (a) enter a notice of the application in the register; and
 - (b) advertise the fact of the application having been filed in the official journal.”.

8. Part 6, Division 6 added

Part 6—

Add

“Division 6—Reference to court

51A. Procedure for reference to court

(s. 77(1)(b) of the Ordinance)

- (1) This section applies if—
- (a) the Registrar receives an application seeking the determination of the Registrar on a question

- concerning a registered trade mark or an application for registration of trade mark; and
- (b) the Registrar refers the application to the court under section 77(1)(b) of the Ordinance.
- (2) The Registrar must, as soon as practicable after so referring the application, give written notice of the reference to all of the following persons—
- (a) the applicant in the application;
 - (b) if the applicant is not the owner of the registered trade mark, the owner;
 - (c) the Registrar of the High Court;
 - (d) any other party to the application.
- (3) The Registrar must also send to the Registrar of the High Court—
- (a) a copy of the relevant entries in the register certified by the Registrar of Trade Marks; and
 - (b) a copy of the documents in the custody of the Registrar of Trade Marks that relate to the application.
- (4) The Registrar must also—
- (a) enter in the register a notice of the reference to the court; and
 - (b) advertise in the official journal the fact of the reference.”.

9. Rule 117 amended (filing of court orders, declarations and certificates)

Rule 117—

Repeal subrule (1)

Substitute

“(1) If the court has made or granted an order, declaration or certificate in favour of a person in any proceedings under the Ordinance, the person or, if there is more than one such person, the person directed by the court must file a sealed copy of the order, declaration or certificate with the Registrar.”.

Registrar of Trade Marks

2017

Explanatory Note

These Rules amend the Trade Marks Rules (Cap. 559 sub. leg. A) to—

- (a) provide for the procedures in relation to a reference by the Registrar of Trade Marks to the Court of First Instance of an application on a question concerning a registered trade mark or an application for registration of a trade mark under section 77(1)(b) of the Trade Marks Ordinance (Cap. 559);
- (b) provide that the Registrar of Trade Marks must enter a notice of certain applications in the register of trade marks and advertise the fact of the applications having been filed in the official journal of record; and
- (c) provide that where the court has made or granted an order, declaration or certificate in favour of more than one person, it is the person directed by the court who is to file the order, declaration or certificate with the Registrar of Trade Marks.

Patents (General) (Amendment) Rules 2017

(Made by the Registrar of Patents under section 149 of the Patents Ordinance (Cap. 514))

1. Commencement

These Rules come into operation on [].

2. Patents (General) Rules amended

The Patents (General) Rules (Cap. 514 sub. leg. C) are amended as set out in sections 3 to 10.

3. Section 37A added

Before section 38—

Add

“37A. References to court under section 44(5) of Ordinance

- (1) The Registrar must, as soon as practicable after deciding to refer an application made under section 44(4) of the Ordinance to the court for determination under section 44(5) of the Ordinance, give notice of the decision to each of the following persons—
 - (a) the person who made the application under section 44(4) of the Ordinance for revocation of the standard patent concerned;
 - (b) every person who is registered as the proprietor of the patent;
 - (c) every other person who is shown in the register as having a right in or under the patent;
 - (d) the Registrar of the High Court.

- (2) The Registrar must also send to the Registrar of the High Court—
 - (a) a copy of the relevant entries in the register certified by the Registrar; and
 - (b) a copy of the documents in the custody of the Registrar that relate to the application.
- (3) The Registrar must also—
 - (a) enter in the register a notice of the reference to the court; and
 - (b) advertise in the official journal the fact of the reference.”.

4. Section 40A added

After section 40—

Add

“40A. References to court under section 48(4) of Ordinance

- (1) The Registrar must, as soon as practicable after deciding to refer a matter to the court for determination under section 48(4) of the Ordinance, give notice of the decision to each of the following persons—
 - (a) the proprietor of the patent;
 - (b) any person who has filed a notice of opposition under section 40(2);
 - (c) the Registrar of the High Court.
- (2) The Registrar must also send to the Registrar of the High Court—
 - (a) a copy of the relevant entries in the register certified by the Registrar; and

- (b) a copy of the documents in the custody of the Registrar that relate to the application.
- (3) The Registrar must also—
 - (a) enter in the register a notice of the reference to the court; and
 - (b) advertise in the official journal the fact of the reference.”.

5. Section 41 substituted

Section 41—

Repeal the section

Substitute

“41. References to Registrar under section 49(1) of Ordinance

- (1) A reference to the Registrar under section 49(1) of the Ordinance of the question of whether, having regard to any of the matters specified in section 93(5) of the Ordinance, an invention is a patentable invention must be made by filing an application in the specified form.
- (2) The application must be accompanied by—
 - (a) a statement setting out—
 - (i) the question on which the applicant intends to seek the determination of the Registrar;
 - (ii) the determination and order that the applicant intends to seek in relation to the question; and
 - (iii) the full particulars of the grounds and facts on which the applicant relies; and
 - (b) the prescribed fee.
- (3) The applicant must, at the same time as the application is filed, send a copy of the application and of the

accompanying statement to the proprietor of the patent concerned.

- (4) The Registrar must—
 - (a) enter a notice of the application in the register; and
 - (b) advertise in the official journal the fact of the application having been filed.”.

6. Sections 41A to 41H added

After section 41—

Add

“41A. Notice of intention to oppose

- (1) A person (other than the proprietor of the patent concerned) who intends to oppose an application under section 41(1) may file with the Registrar a notice indicating an intention to oppose the application (***notice of intention to oppose***).
- (2) The notice of intention to oppose must—
 - (a) be in the specified form; and
 - (b) be filed within 28 days after the date on which the filing of the application is advertised in the official journal under section 41(4).
- (3) A person who files a notice of intention to oppose under subsection (1) (***intending opponent***) must, at the same time as the notice is filed, send a copy of the notice to—
 - (a) the applicant in the application being opposed; and
 - (b) the proprietor of the patent to which the application relates.

-
- (4) On receiving a notice of intention to oppose under subsection (3)(a), the applicant must, within 14 days after the expiry of the period specified in subsection (2)(b)—
 - (a) send a copy of the application and of the accompanying statement filed under section 41(1) to the intending opponent; and
 - (b) notify the Registrar that the copies have been sent.
 - (5) If the applicant fails to comply with subsection (4)(a), the applicant's application is treated as being abandoned.

41B. Notice of opposition by person other than proprietor of patent

- (1) A person who receives a copy of the application and of the accompanying statement sent under section 41A(4) (*intending opponent*) may, within 2 months after the expiry of the period for sending the copy under that section, oppose the application by filing a notice of opposition with the Registrar.
- (2) The notice of opposition must—
 - (a) be in the specified form;
 - (b) set out—
 - (i) the grounds on which the intending opponent relies in support of the opposition;
 - (ii) the facts alleged in the application that the intending opponent admits, denies or is unable to admit or deny; and
 - (iii) if the intending opponent denies any fact alleged in the application, the reasons for the denial; and
 - (c) be accompanied by the prescribed fee.

-
- (3) The intending opponent must, at the same time as the notice of opposition is filed under subsection (1), send a copy of the notice to—
 - (a) the applicant in the application being opposed; and
 - (b) the proprietor of the patent to which the application relates.
 - (4) If the intending opponent does not file a notice of opposition under subsection (1), the intending opponent is treated as having abandoned the intention to oppose the application.
 - (5) If the applicant receives more than one copy of notice of opposition sent under subsection (3), the applicant must, as soon as practicable after the expiry of the period for filing the notice under subsection (1)—
 - (a) send a copy of the notice received from an intending opponent to the other intending opponents; and
 - (b) notify the Registrar that the copies of the notices have been sent.

41C. Notice of opposition by proprietor of patent

- (1) The proprietor of a patent who receives a copy of the application and of the accompanying statement sent under section 41(3) may oppose the application by filing a notice of opposition with the Registrar—
 - (a) if a notice of intention to oppose sent under section 41A is received, within 2 months after the expiry of the period for sending a copy of those documents under section 41A(4);
 - (b) if no notice of intention to oppose is filed in respect of the application within the period specified in

section 41A(2)(b), within 2 months after the expiry of that period.

- (2) A notice of opposition must—
 - (a) be in the specified form; and
 - (b) set out—
 - (i) the grounds on which the proprietor of the patent relies in support of the opposition;
 - (ii) the facts alleged in the application that the proprietor admits, denies or is unable to admit or deny; and
 - (iii) if the proprietor denies any fact alleged in the application, the reasons for the denial; and
 - (c) be accompanied by the prescribed fee.
- (3) The proprietor of the patent must, at the same time as the notice of opposition is filed under subsection (1), send a copy of the notice of opposition to—
 - (a) the applicant in the application; and
 - (b) if the proprietor has received a copy of a notice of intention to oppose sent under section 41A(3) in respect of the application, the person who sent the copy of the notice.
- (4) If the proprietor of the patent does not file a notice of opposition under subsection (1), the application is treated as being unopposed by the proprietor.

41D. Evidence in support of application

- (1) The applicant in an application under section 41(1) must file evidence in support of the application with the Registrar within 3 months after the expiry of the period for filing a notice of opposition in respect of the

- application under section 41B(1) or 41C(1), whichever is applicable.
- (2) The applicant must, at the same time as the evidence is filed under subsection (1), send a copy of the evidence to—
 - (a) the proprietor of the patent to which the application relates; and
 - (b) if the applicant has received a copy of a notice of opposition sent under section 41B(3) in respect of the application, the person who sent the copy of the notice.
 - (3) If the applicant does not comply with subsection (1), the application is treated as being abandoned by the applicant.

41E. Evidence in support of opposition

- (1) This section applies if—
 - (a) a notice of opposition is filed under section 41B(1) or 41C(1) in respect of an application under section 41(1); and
 - (b) evidence is filed in support of the application under section 41D(1).
- (2) The party who files a notice of opposition must, within 3 months after the date of receiving a copy of the evidence under section 41D(2), file with the Registrar—
 - (a) evidence in support of the opposition; or
 - (b) a statement to the effect that the party does not intend to file evidence.
- (3) The party must, at the same time as the evidence or statement is filed under subsection (2), send a copy of it to—

-
- (a) the applicant in the application;
 - (b) any other party who has filed a notice of opposition under section 41B in respect of the application; and
 - (c) if the party is not the proprietor of the patent to which the application relates, the proprietor of the patent.

41F. Evidence in reply

- (1) If a party files evidence in support of the party's opposition under section 41E(2), the applicant in an application under section 41(1) to which the opposition relates may file additional evidence in support of the application.
- (2) The additional evidence must be filed within 3 months after the expiry of the period for filing evidence under section 41E(2).
- (3) The additional evidence must be confined to matters strictly in reply to the evidence filed under section 41E(2).
- (4) The applicant in the application must, at the same time as the additional evidence is filed under section (1), send a copy of the additional evidence to—
 - (a) the proprietor of the patent to which the application relates; and
 - (b) if the applicant has received a copy of a notice of opposition sent under section 41B(3) in respect of the application, the person who sent the copy of the notice.
- (5) If the applicant does not intend to file additional evidence, the applicant must, within 3 months after the expiry of the period for filing evidence under section 41E(2), file a

statement to the effect that the applicant does not intend to do so.

- (6) Except with the leave of the Registrar, no further evidence may be filed by any party to the proceedings.

41G. Directions on subsequent procedure

The Registrar may give any directions that the Registrar thinks fit relating to the subsequent procedures to be followed with regard to an application under section 41(1).

41H. References to court under section 49(2)(b) of Ordinance

- (1) This section applies if—
 - (a) the Registrar receives an application under section 41(1) seeking the determination of the Registrar on a question; and
 - (b) the Registrar decides to refer the question to the court for determination under section 49(2)(b) of the Ordinance.
- (2) The Registrar must, as soon as practicable after deciding to so refer the question, give notice of the decision to each of the following persons—
 - (a) the applicant in the application;
 - (b) the proprietor of the patent to which the application relates;
 - (c) a person who has filed a notice of intention to oppose under section 41A(1) in respect of the application;
 - (d) the Registrar of the High Court.
- (3) The Registrar must also send to the Registrar of the High Court—

- (a) a copy of the relevant entries in the register certified by the Registrar; and
 - (b) a copy of the documents in the custody of the Registrar that relate to the application.
- (4) The Registrar must also—
- (a) enter in the register a notice of the reference to the court; and
 - (b) advertise in the official journal the fact of the reference.”.

7. Section 52 substituted

Section 52—

Repeal the section

Substitute

“52. Filing of court orders, directions, declarations or certificates

- (1) If the court has made an order, a direction or declaration or has granted a certificate, under the Ordinance (except under section 46 or 102 of the Ordinance) in favour of a person, the person or, if there is more than one such person, the person directed by the court, must file a sealed copy of the order, declaration, direction or certificate with the Registrar.
- (2) If the court makes any order under section 46 or 102 of the Ordinance in favour of a person, the person or, if there is more than one such person, the person directed by the court must file with the Registrar—
 - (a) a copy of any documents referred to in the order that show the amendments to be made; and

- (b) the translations of those documents as may be required under section 56.
- (3) The documents and translations referred to in subsection (2) must be filed at the time when a copy of the order is filed with the Registrar in accordance with a provision of any order under section 46 or 102 of the Ordinance or a direction made by the court or rules of court.”.

8. Sections 92A and 92B added

Before section 93—

Add

“92A. References to court under section 133(1)(b) of Ordinance of questions referred to Registrar under section 13(1) of Ordinance

- (1) The Registrar must, as soon as practicable after deciding to refer a question referred to the Registrar under section 13(1)(a) or (b) of the Ordinance to the court for determination under section 133(1)(b) of the Ordinance, give notice of the decision to each of the following persons—
 - (a) the person who referred the question to the Registrar under section 13(1)(a) or (b) of the Ordinance, as the case may be (*applicant*);
 - (b) each person to whom the applicant has sent a copy of the reference and statement under section 3(2) or (3), as the case may be;
 - (c) the Registrar of the High Court.
- (2) If an application for a standard patent for an invention that is the subject of a reference under section 13(1)(a) or (b) of the Ordinance has been filed but the application has not been published before the reference is made, the Registrar

must also give notice of the decision of the reference to the court to each of the following persons (not being a party to the reference or a person to whom copies have been sent under section 3(2) or (3))—

- (a) the person who made the application for the patent;
- (b) each person who has given notice to the Registrar under section 46 of a transaction, instrument or event in relation to the application for the patent.

[c.f. s. 3(5) of Cap. 514C]

- (3) The Registrar must send a notice containing the names and addresses of all persons to whom the Registrar has given notice of the decision under subsection (2) to each of the persons to whom the Registrar has given notice under subsections (1) and (2).

[c.f. s. 3(6) of Cap. 514C]

- (4) If a copy of the reference and statement has not been sent under section 3(5) to any of the persons mentioned in subsection (2), the Registrar must also send a copy of the reference and statement to each of those persons .
- (5) The Registrar must also send to the Registrar of the High Court—
 - (a) a copy of the documents in the custody of the Registrar that relate to the reference to the Registrar under section 13(1) of the Ordinance; and
 - (b) a copy of the relevant entries in the register certified by the Registrar.
- (6) The Registrar must also—
 - (a) enter in the register a notice of the reference to the court; and

- (b) advertise in the official journal the fact of the reference.

92B. References to court under section 133(1)(b) of Ordinance of questions referred to Registrar under section 14(5) of Ordinance

- (1) The Registrar must, as soon as practicable after deciding to refer a question that is referred to the Registrar under section 14(5) of the Ordinance to the court for determination under section 133(1)(b) of the Ordinance, give notice of the decision to each of the following persons—
 - (a) the person who referred the question to the Registrar under section 14(5) of the Ordinance;
 - (b) each other person—
 - (i) in whose name the application for a standard patent is ordered to proceed under section 13(3) of the Ordinance; or
 - (ii) who claims to be entitled to be granted a licence under section 14(3) of the Ordinance;
 - (c) the Registrar of the High Court.
- (2) The Registrar must also send to the Registrar of the High Court—
 - (a) a copy of the documents in the custody of the Registrar that relate to the reference to the Registrar under section 14(5) of the Ordinance; and
 - (b) a copy of the relevant entries in the register certified by the Registrar.
- (3) The Registrar must also—
 - (a) enter in the register a notice of the reference to the court; and

- (b) advertise in the official journal the fact of the reference to the court.”.

9. Section 104A added

After section 104—

Add

“104A. Stay of proceedings

- (1) The Registrar may, if the Registrar considers it appropriate to do so, stay any proceedings before the Registrar involving 2 or more parties on any term that the Registrar thinks fit.
- (2) The Registrar may do so either on the initiative on the Registrar or on request of a party to those proceedings.”.

10. Schedule 2 amended (fees)

Schedule 2, item 2—

Repeal

“41(3)”

Substitute

“41B(1), 41C(1)”.

Registrar of Patents

2017

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg. C) to revise the legal proceedings for referring—

- (a) an application or matter to the Court of First Instance under section 44(5), 48(4) or 133(1)(b) of the Patents Ordinance (Cap. 514) (*Ordinance*);
- (b) the question of whether an invention is a patentable invention under section 49 of the Ordinance to—
 - (i) the Registrar of Patents; or
 - (ii) the Court of First Instance.

Registered Designs (Amendment) Rules 2017

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(Sections 12, 13, 18, 20 and 21 of Ordinance)

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(Sections 24, 25 and 26 of Ordinance)

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Registered Designs (Amendment) Rules 2017

(Made by the Registrar of Designs under sections 79, 80, 81 and 82 of the Registered Designs Ordinance (Cap. 522))

1. Commencement

These Rules come into operation on [].

2. Registered Designs Rules amended

The Registered Designs Rules (Cap. 522 sub. leg. A) are amended as set out in sections 3 to 17.

3. Headings amended

(1) Before section 1—

Repeal

“PRELIMINARY”

Substitute

“Part 1

Preliminary”.

(2) After section 2A—

Repeal

“REGISTRABLE DESIGNS

(SECTIONS 5, 9 AND 10 OF ORDINANCE)”

Substitute

“Part 2

Registrable Designs

(Sections 5, 9 and 10 of Ordinance)”.

- (3) After section 5—

Repeal

“APPLICATIONS FOR REGISTRATION

(SECTIONS 12, 13, 18, 20 AND 21 OF ORDINANCE)”

Substitute

“Part 3

Applications for Registration

(Sections 12, 13, 18, 20 and 21 of Ordinance)”.

- (4) After section 20—

Repeal

“EXAMINATION AND REGISTRATION

(SECTIONS 24, 25 AND 26 OF ORDINANCE)”

Substitute

“Part 4

Examination and Registration

(Sections 24, 25 and 26 of Ordinance)”.

- (5) After section 27—

Repeal

“DURATION OF REGISTRATION

(SECTIONS 28 AND 30 OF ORDINANCE)”

Substitute

“Part 5

Duration of Registration

(Sections 28 and 30 of Ordinance)”.

- (6) After section 32—

Repeal

“RIGHTS IN REGISTERED DESIGNS

(SECTIONS 34 AND 64 OF ORDINANCE)”

Substitute

“Part 6

Rights in Registered Designs

(Sections 34 and 64 of Ordinance)”.

(7) After section 36—

Repeal

“LEGAL PROCEEDINGS

(SECTIONS 44, 45, 46 AND 63 OF ORDINANCE)”

Substitute

“Part 7

Legal Proceedings

(Sections 44, 45, 46 and 63 of Ordinance)”.

(8) After section 49—

Repeal

“ADMINISTRATIVE AND MISCELLANEOUS PROVISIONS

(SECTIONS 66, 67, 68, 70, 71, 72, 73, 75, 76 AND 77 OF ORDINANCE)”

Substitute

“Part 8

Administrative and Miscellaneous Provisions

(Sections 66, 67, 68, 70, 71, 72, 73, 75, 76 and 77 of Ordinance)”.

(9) After section 74—

Repeal

“TRANSITIONAL PROVISIONS

(SECTION 92 OF ORDINANCE)”

Substitute

“Part 9

Transitional Provisions

(Section 92 of Ordinance)”.

4. Section added

Before section 37—

Add

“36A. Interpretation of Part 7

In this Part—

application (), except in sections 47 and 49, means an application under section 37;

application document (), in relation to an application, means—

- (a) an application form filed under section 37(1)(a); and
- (b) a statement filed under section 37(1)(b).”.

5. Section 37 amended (reference)

- (1) Section 37(1)—

Repeal paragraph (b)

Substitute

- “(b) a statement setting out—
- (i) the question on which the applicant intends to seek the determination of the Registrar;
 - (ii) the determination and order that the applicant intends to seek in relation to the question; and
 - (iii) the full particulars of the grounds and facts on which the applicant relies.”.

- (2) Section 37(2)—

Repeal

“and statement”

Substitute

“document”.

6. Section 37A added

After section 37—

Add

“37A. Notice of intention to oppose

- (1) A person (other than the registered owner of the design concerned) who intends to oppose an application may file with the Registrar a notice indicating the person’s intention to do so (*notice of intention to oppose*).

- (2) The notice of intention to oppose must—
 - (a) be in the specified form; and
 - (b) be filed within 28 days after the date on which the filing of the application is advertised in the official journal under section 37(3).
- (3) A person who files a notice of intention to oppose under subsection (1) (*intending opponent*) must, at the same time as the notice is filed, send a copy of the notice to—
 - (a) the applicant in the application being opposed; and
 - (b) the registered owner of the design to which the application relates.
- (4) On receiving a copy of a notice of intention to oppose sent under subsection (3)(a), the applicant must, within 14 days after the expiry of the period specified in subsection (2)(b)—
 - (a) send a copy of the application document for the application to the intending opponent; and
 - (b) notify the Registrar that the copy has been sent.
- (5) If the applicant fails to comply with subsection (4)(a), the application is treated as being abandoned.”.

7. Section substituted

Section 38—

Repeal the section

Substitute

“38. Notice of opposition by person other than registered owner

- (1) A person who receives a copy of the application document for an application sent under section 37A(4)(a) (*intending opponent*) may, within 2 months after the expiry of the

period for sending the copy under that section, oppose the application by filing a notice of opposition with the Registrar.

- (2) The notice of opposition must—
 - (a) be in the specified form; and
 - (b) set out—
 - (i) the grounds on which the intending opponent relies in support of the opposition;
 - (ii) the facts alleged in the application that the intending opponent admits, denies or is unable to admit or deny; and
 - (iii) if the intending opponent denies any fact alleged in the application, the reasons for the denial.
- (3) The intending opponent must, at the same time as the notice of opposition is filed under subsection (1), send a copy of the notice to—
 - (a) the applicant in the application; and
 - (b) the registered owner of the design to which the application relates.
- (4) If the intending opponent does not file a notice of opposition under subsection (1), the intending opponent is treated as having abandoned the intention to oppose the application.
- (5) If the applicant receives more than one copy of notice of opposition sent under subsection (3), the applicant must, as soon as practicable after the expiry of the period for filing the notice under subsection (1)—
 - (a) send a copy of the notice received from an intending opponent to the other intending opponents; and

- (b) notify the Registrar that the copies of the notices have been sent.”

8. Section added

After section 38—

Add

“38A. Notice of opposition by registered owner

- (1) A registered owner who receives a copy of the application document for an application sent under section 37(2) may oppose the application by filing a notice of opposition with the Registrar—
 - (a) if a notice of intention to oppose is filed in respect of the application within the period specified in section 37A(2)(b)—within 2 months after the expiry of the period for sending a copy of the application document under section 37A(4)(a);
 - (b) if no notice of intention to oppose is filed in respect of the application within the period specified in section 37A(2)(b)—within 2 months after the expiry of that period.
- (2) The notice of opposition must—
 - (a) be in the specified form; and
 - (b) set out—
 - (i) the grounds on which the registered owner relies in support of the opposition;
 - (ii) the facts alleged in the application that the registered owner admits, denies or is unable to admit or deny; and
 - (iii) if the registered owner denies any fact alleged in the application—the reasons for the denial.

- (3) The registered owner must, at the same time as the notice of opposition is filed under subsection (1), send a copy of the notice to—
 - (a) the applicant in the application; and
 - (b) if the registered owner has received a copy of a notice of intention to oppose sent under section 37A(3)(b) in respect of the application—the person who sent the copy of the notice.
- (4) If the registered owner does not file a notice of opposition under subsection (1), the application is treated as being unopposed by the registered owner.”.

9. Section 39 repealed (counter-statement)

Section 39—

Repeal the section.

10. Sections 40, 41 and 42 substituted

Sections 40, 41 and 42—

Repeal the sections

Substitute

“40. Evidence in support of application

- (1) The applicant in an application must file evidence in support of the application with the Registrar within 3 months after the expiry of the period for filing a notice of opposition in respect of the application under section 38(1) or 38A(1), whichever is applicable.
- (2) The applicant must, at the same time as the evidence is filed under subsection (1), send a copy of the evidence to—

- (a) the registered owner of the design to which the application relates; and
 - (b) if the applicant has received a copy of a notice of opposition sent under section 38(3)(a) in respect of the application—the person who sent the copy of the notice.
- (3) If the applicant does not comply with subsection (1), the application is treated as being abandoned by the applicant.

41. Evidence in support of opposition

- (1) This section applies if—
- (a) a notice of opposition is filed under section 38(1) or 38A(1) in respect of an application; and
 - (b) evidence is filed in support of the application under section 40(1).
- (2) The party who files the notice of opposition must, within 3 months after the date of receiving a copy of the evidence, file with the Registrar—
- (a) evidence in support of the opposition; or
 - (b) a statement to the effect that the party does not intend to file any evidence.
- (3) The party must, at the same time as the evidence or statement is filed under subsection (2), send a copy of it to—
- (a) the applicant in the application;
 - (b) any other person who has filed a notice of opposition under section 38(1) in respect of the application; and
 - (c) if the party is not the registered owner of the design to which the application relates—the registered owner.

42. Evidence in reply

- (1) If a party files evidence in support of the party's opposition under section 41(2), the applicant in the application to which the opposition relates may file additional evidence in support of the application.
- (2) The additional evidence must be filed within 3 months after the expiry of the period for filing evidence under section 41(2).
- (3) The additional evidence must be confined strictly to matters in the evidence filed under section 41(2).
- (4) The applicant must, at the same time as the additional evidence is filed under subsection (1), send a copy of the additional evidence to—
 - (a) the registered owner of the design to which the application relates; and
 - (b) if the applicant has received a copy of a notice of opposition sent under section 38(3)(a) in respect of the application—the person who sent the copy of the notice.
- (5) If the applicant does not intend to file any additional evidence, the applicant must, within 3 months after the expiry of the period for filing evidence under section 41(2), file a statement to the effect that the applicant does not intend to do so.
- (6) Except with the leave of the Registrar, no further evidence may be filed by any party to the application.”.

11. Section 43 amended (directions on subsequent procedure)

Section 43—

Repeal

“under section 37”.

12. Section 44 amended (notice of decision)

Section 44(1)—

Repeal

“under section 37”.

13. Section 45 amended (costs in unopposed cases)

Section 45—

Repeal

“under section 37”.

14. Section 46 substituted

Section 46—

Repeal the section

Substitute

“46. Reference to court under section 44(3) of Ordinance

- (1) This section applies if—
 - (a) the Registrar receives an application seeking the determination of the Registrar on a question of whether a design is a registrable design; and
 - (b) the Registrar refers the question to the court for determination under section 44(3) of the Ordinance.
- (2) The Registrar must, as soon as practicable after so referring the question, give written notice of the reference to all of the following persons—
 - (a) the applicant in the application;
 - (b) the registered owner of the design to which the application relates;

- (c) a person who has filed a notice of intention to oppose under section 37A(1) in respect of the application; and
 - (d) the Registrar of the High Court.
- (3) The Registrar must also send to the Registrar of the High Court—
 - (a) a copy of the relevant entries in the Register certified by the Registrar; and
 - (b) a copy of the documents in the custody of the Registrar that relate to the application.
- (4) The Registrar must also—
 - (a) enter in the Register a notice of the reference to the court; and
 - (b) advertise in the official journal the fact of the reference.”.

15. Section 48 amended (filing of court orders, declarations or certificates)

Section 48—

Repeal subsection (1)

Substitute

- “(1) If the court has made or granted an order, declaration or certificate in favour of a person in any proceedings under the Ordinance, the person or, if there is more than one such person, the person directed by the court must file a sealed copy of the order, declaration or certificate with the Registrar”.

16. Section 49A added

After section 49—

Add

“49A. Stay of proceedings

- (1) The Registrar may, if the Registrar considers it appropriate to do so, stay any proceedings before the Registrar under this Part involving 2 or more parties on any term that the Registrar thinks fit.
- (2) The Registrar may do so either on the initiative on the Registrar or on request of a party to those proceedings.”.

17. Schedule amended (fees)

Item 23, column 2—

Repeal

“39”

Substitute

“38A”.

Registrar of Designs

2017

Explanatory Note

These Rules amend the Registered Designs Rules (Cap. 522 sub. leg. A) to—

- (a) revise the provisions concerning the procedures for referring to the Registrar of Designs the question of whether a design is a registrable design under section 44 of the Registered Designs Ordinance (Cap. 522);
- (b) provide that, where the court has made or granted an order, declaration or certificate in favour of more than one person, it is the person directed by the court who is to file the order, declaration or certificate with the Registrar of Designs; and
- (c) provide that the Registrar of Designs may stay any proceedings before the Registrar under Part 7 of the Registered Designs Rules in certain circumstances.