

Patents Registry
Intellectual Property Department
Hong Kong SAR Government
Patents Examination Guidelines

Section 16: Amendments to Patent Applications and Patents

Overview

- 16.1 An amendment to the specification of a patent application or patent may be necessary to avoid or overcome an objection or challenge to the patent application or the validity of the patent on the basis of, for instances, lack of novelty and/or lack of inventive step in the underlying invention.

Pre-grant amendments

- 16.2 A pre-grant amendment takes effect from the time the amendment is made.
- 16.3 All applications for pre-grant amendments must be made to the Registrar (section 31(1) of the Ordinance and section 27(1) of the Rules (for standard patent (R) applications); section 37ZA(1) of the Ordinance and section 31ZT(1)(d) of the Rules (for standard patent (O) applications); section 120(1) of the Ordinance and section 75(1)(d) of the Rules (for short-term patent applications)).

Post-grant amendments

- 16.4 A post-grant amendment has effect as from the date of grant of the patent (sections 43(4) (for standard patents (R)), 46(9) (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued), 102(3) (for all types of patents in infringement and revocation proceedings before the court) and 127E(5) (for short-term patents for which requests for substantive examination have been made) of the Ordinance).
- 16.5 An application for post-grant amendment to a standard patent (R) must be made to the court (sections 46(2)(a) and 102 of the Ordinance) except for an application for post-grant amendment to a standard patent (R) following post-grant opposition proceedings in the EPO which must be made to the Registrar (section 43 of the Ordinance).
- 16.6 In respect of a standard patent (O), an application for post-grant amendment to the patent—

- (a) *(in infringement or revocation proceedings before the court)* must be made to the court (section 102 of the Ordinance);
 - (b) *(in other cases)* may be made either to the court or to the Registrar (section 46(2)(b) of the Ordinance).
- 16.7 In respect of a short-term patent, an application for post-grant amendment to the patent —
- (a) *(in infringement or revocation proceedings before the court)* must be made to the court (section 102 of the Ordinance);
 - (b) *(where the patent has not undergone post-grant substantive examination)* must be made to the Registrar together with filing a request for post-grant substantive examination with the Registrar (section 127B(1)(b) of the Ordinance; section 81P(2)(c) of the Rules);
 - (c) *(where the patent is under post-grant substantive examination by the Registrar)* must be made to the Registrar (section 127D(3) of the Ordinance; section 81P(2)(c) of the Rules);
 - (d) *(where a certificate of substantive examination has been issued for the patent)* may be made to the court or the Registrar (section 46(2)(c) of the Ordinance).
- 16.8 In respect of an application to the Registrar for post-grant amendment under section 46 of the Ordinance to a standard patent (O) or a short-term patent in respect of which a certificate of substantive examination has been issued, the Registrar may not allow such amendment where there are pending before the court proceedings in which the validity of the patent may be put in issue (section 46(6) of the Ordinance).

Applications for pre-grant/post-grant amendments to the Registrar

- 16.9 A patent applicant or proprietor may, in appropriate circumstances, file a request for amendment to a patent application or patent of his own volition or otherwise with the Registrar in accordance with the statutory requirements.
- 16.10 A request to the Registrar for a pre-grant amendment must be made in the specified form clearly identifying the proposed amendment and stating the reasons for such amendment (section 31(1) of the Ordinance and section 27 of the Rules (for standard patent (R) applications); section 37ZA(1) of the Ordinance and section 31ZT(1) of the Rules (for standard patent (O) applications); section 120(1) of the Ordinance and section 75(1) of the Rules (for short-term patent applications)).
- 16.11 A request to the Registrar for a post-grant amendment must be made in the specified form and be accompanied by:
- (a) a copy of the specification incorporating the requested amendment; and

- (b) *(except for a request for post-grant amendment to a short-term patent for which a request for substantive examination has been made)* the evidence furnished by the patent proprietor in the form of statutory declaration or affidavit to establish the circumstances underlying the requested amendment.

(section 46 of the Ordinance and section 38A(2) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); sections 127B(1)(b) and 127D(3) of the Ordinance and section 81P(2) of the Rules (for short-term patents for which requests for substantive examination have been made))

16.12 The following sub-sections explain about making requests for amendments to various types of patent applications and patents to the Registrar in details.

Pre-grant amendments to standard patent (O) applications

16.13 An applicant of a standard patent (O) application may make an application to the Registrar for amendment to the patent application—

- (a) once before the preparations for the publication of the application have been completed (section 37ZA(1) of the Ordinance and section 31ZT(2)(c) of the Rules);
- (b) when filing a request for substantive examination of the application (section 37ZA(1) of the Ordinance and section 31ZT(2)(a) of the Rules);
- (c) within 3 months from the date of the notice issued by the Registrar informing the applicant that the application has entered into the stage of substantive examination (section 37ZA(1) of the Ordinance and section 31ZT(2)(d) of the Rules); and/or
- (d) when responding to an office action during substantive examination of the application, notably filing a response to an examination notice, a response to a further examination notice, a request to review a provisional refusal notice of the Registrar, a response to a review opinion and/or a response to a further review opinion (sections 37V(3)(b)&(c) and 37ZA(1) of the Ordinance; sections 31ZI(3)(b) and 31ZT(2)(b) of the Rules), and

any such application for amendment must be made in Patents form P8.

16.14 If any of the proposed amendment is made to the description, claims or drawings in the specification contained in a standard patent (O) application, the Registrar may, if he thinks fit, require the filing of a clean copy of the amended specification incorporating the proposed amendment, and also a copy of the amended specification incorporating and indicating the proposed amendment within a specified period (section 37ZA(1) of the Ordinance and section 31ZT(3) of the Rules).

- 16.15 The amendment request to which the required copies relate will be regarded as being withdrawn if the required copies are not filed within the specified period (section 37ZA(1) of the Ordinance and section 31ZT(4) of the Rules).
- 16.16 An amendment of a standard patent (O) application must be prepared in compliance with the respective requirements under sections 31M(2)-(3) (specification), 31N (description), 31O (drawings), 31P (abstract), 31Q~~(1)~~(2)-(12) (size and presentation of documents), 31R (form of statements), and 31S (claims) of the Rules, as the case requires (section 37ZA(1) of the Ordinance and section 31ZT(5) of the Rules).

Post-grant amendments to standard patent (O)

- 16.17 A proprietor of a standard patent (O) may, at any time after grant and of his own volition, make an application to the Registrar for amendment to the specification of the patent (section 46(2)(b) of the Ordinance ~~and section 38A(2)(a) of the Rules~~).
- 16.18 Such application must be made in Patents form OP7 and accompanied by a copy of the specification containing the proposed amendment and also evidence in the form of statutory declaration or affidavit establishing the circumstances underlying the amendment (section 46(2)(b) of the Ordinance and section 38A(2)~~(a)~~(b)(i) and (ii) of the Rules; see sections 16.43 – 16.45 of the Guidelines below).
- 16.19 The proposed amendment must be indicated by striking through any text, figure or other matter to be replaced or deleted, and by underlining any replacement text, figure or other matter (section 46(2)(b) of the Ordinance and section 38A(2)(b)(i) of the Rules).
- 16.20 An amendment of a standard patent (O) must be prepared in compliance with the respective requirements under sections 31M(2)-(3) (specification), 31N (description), 31O (drawings), 31Q~~(1)~~(2)-(12) (size and presentation of documents) and 31S (claims) of the Rules, as the case requires (section 46(2)(b) of the Ordinance and section 38A(3)(a) of the Rules).

Pre-grant amendments to standard patent (R) applications

- 16.21 An applicant of a standard patent (R) application may, at any time before the preparations for publication of the specification of the patent to be granted have been completed and of his own volition, make an application to the Registrar for amendment to the patent application (section 31(1) of the Ordinance and section 27 of the Rules).
- 16.22 However, an application for amendment to the title of the invention, the abstract, a priority claim or any claim, description or drawing in a standard patent (R) application can only be made where the application has been published and such amendment is an amendment that has been made to the corresponding designated patent

application (section 31(2) of the Ordinance). Such application to amend must be made in Patents form P8 together with a verified copy of the amendment made to the corresponding designated patent application and (if applicable) a translation of that amendment (section 31 of the Ordinance and section 27 of the Rules).

Post-grant amendments to standard patent (R)

- 16.23 A proprietor of standard patent (R) has obligation to make an application to the Registrar for amendment to the patent on the basis that the same amendment to the specification of the corresponding designated patent has been made in the EPO following any post-grant opposition proceedings under or in accordance with Part V of the European Patent Convention (section 43 of the Ordinance; section 36 of the Rules).
- 16.24 Such application to amend must be made to the Registrar in Patents form OP7. The patent proprietor must also file with the Registrar a verified copy of the amended specification or the amending order, and such translations as may be required within 6 months beginning from the date of the amendment in the EPO or the date of grant of the standard patent (R), whichever is the later (section 43 of the Ordinance; sections 35 and 36 of the Rules).

Pre-grant amendments to short-term patent applications

- 16.25 An applicant of a short-term patent application may, at any time before the preparations for publication of the specification of the patent to be granted have been completed and of his own volition, make an application to the Registrar for amendment to the patent application (section 120(1) of the Ordinance ~~and section 75(1) of the Rules~~).
- 16.26 Such application to amend must be made to the Registrar in Patents form P8. If it is proposed to amend the description, claims or drawings in the specification of a short-term patent application, the Registrar may, if he thinks fit, require the filing of a clean copy of the amended specification incorporating the proposed amendment, and a copy of the amended specification incorporating and indicating the proposed amendment within a specified period (section 120(1) of the Ordinance and section 75(1)(a)&(2) of the Rules).
- 16.27 The amendment request to which the required copies relate will be regarded as being withdrawn if the required copies are not filed within the specified period (section 120(1) of the Ordinance and section 75(3) of the Rules).
- 16.28 An amendment of a short-term patent application must be prepared in compliance with the respective requirements under sections 58(2)-(3) (specification), 59 (description), 60 (drawings), 61 (abstract), 62(2)-(12) (size and presentation of

documents), 63 (form of statements) and 64 (claims) of the Rules, as the case requires (section 120(1) of the Ordinance and section 75(4) of the Rules).

Post-grant amendments to short-term patents

16.29 A proprietor of a short-term patent may make an application to the Registrar for amendment to the specification of the patent—

- (a) when filing a request for substantive examination of the patent (section 127B(1)(b) of the Ordinance and section 81P(2) of the Rules);
- (b) when responding to an office action during substantive examination of the patent, notably filing a response to an examination notice, a response to a further examination notice, a request to review a provisional revocation notice of the Registrar, a response to a review opinion and/or a response to a further review opinion (section 127D(3)(b)&(c) of the Ordinance; sections 81I(3)(b) and 81P(2) of the Rules); and/or
- (c) at any time after the issuance of a certificate of substantive examination (section 46(2)(c) of the Ordinance and section 38A(1)(b) of the Rules).

16.30 All applications for amending the specification of a short-term patent must be made to the Registrar in Patents form OP7 and accompanied by a copy of the specification containing the proposed amendment (sections 46(2)(c), 127B(1)(b) and 127D(3)(b)&(c) of the Ordinance; sections 38A(2) and 81P(2) of the Rules).

16.31 The proposed amendment must be indicated by striking through any text, figure or other matter to be replaced or deleted, and by underlining any replacement text, figure or other matter (sections 46(2)(c), 127B(1)(b) and 127D(3)(b)&(c) of the Ordinance; sections 38A(2)(b)(i) and 81P(2)(b) of the Rules).

16.32 An application to amend after the issuance of a certificate of substantive examination must also be accompanied by the official fee and evidence in the form of statutory declaration or affidavit establishing the circumstances underlying the amendment (section 46(2)(c) of the Ordinance and section 38A(2)(b) of the Rules; see sections 16.43 – 16.45 of the Guidelines below).

16.33 An amendment of a short-term patent must be prepared in compliance with the respective requirements under sections 58(2)-(3)(specification), 59 (description), 60 (drawings), 62~~(1)-(13)~~~~(2)-(12)~~ (size and presentation of documents) and 64 (claims) of the Rules, as the case requires (sections 46(2)(c), 127B(1)(b) and 127D(3)(b)&(c) of the Ordinance; sections 38A(3)(b) and 81P(3) of the Rules).

Amendments initiated by the Registrar to acknowledge a registered trademark

16.34 The Registrar may, on his own initiative, amend the specification and abstract contained in an application or the specification of a patent so as to acknowledge a registered trade mark when appropriate (sections 37ZA(2) (for standard patent (O) applications), 46(8) (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued) and 120(3) (for short-term patent applications) of the Ordinance).

Determination of pre-grant amendments by Registrar

16.35 Section 103(2) of the Ordinance provides that any amendment of an application for a patent is invalid to the extent that it extends the subject-matter disclosed in the application as filed. The test for added matter is discussed in sections 16.47 – 16.51 of the Guidelines below.

16.36 An amendment to a patent application to extend the scope of the claims in the application is permitted provided that the invention disclosed in the amended claims has been previously disclosed in the application when read as a whole. For instance, if something is disclosed in the description but not in the claims, the applicant is allowed to amend the claims before grant to include such matter, even if such amendment extends the scope of the claims.

16.37 Apart from compliance with the requirements under section 103 of the Ordinance on added matter, a request for amendment to a standard patent (O) application which is filed in response to an office action must enable the application to comply with the examination requirement(s) concerned (section 37W(a)(ii) of the Ordinance).

16.38 Although a request for amendment of a standard patent (O) application can be made before substantive examination, namely, once before preparations for publication of the application are completed (section 37ZA(1) of the Ordinance and section 31ZT(2)(c) of the Rules), such request are not considered by the Registrar to determine if the proposed amendment adds any subject-matter to the application until the Registrar carries out substantive examination of the application.

16.39 In the examination of a short-term patent application, the Registrar will mainly look at the formality requirements and not, amongst others, added matter which will only be examined during post-grant substantive examination (if any)(section 117(d) of the Ordinance).

Determination of post-grant amendments by Registrar

16.40 Any amendment of the specification of a patent is invalid to the extent that it extends the subject-matter disclosed in the application as filed (section 103(3)(a) of the Ordinance).

- 16.41 The test for deciding whether any amendment of the specification of a patent discloses an added matter is same as that for deciding whether a pre-grant amendment to a patent application discloses any added matter beyond the disclosure in the application as filed (see the test for added matter in sections 16.47 – 16.51 of the Guidelines below).
- 16.42 A post-grant amendment also cannot extend the protection conferred by the patent (section 103(3)(b) of the Ordinance). In other words, if the proposed amended claim covers something that would not have been covered by the granted claims, it is an indication that there is an extension of protection.
- 16.43 In Re Merck Sharp & Dohme Ltd. [2002] 3 HKLRD 221, the Court of Appeal of the Hong Kong SAR confirmed that the allowance of amendments under the then section 46(1) of the Ordinance (replaced by the current sections 46(1) and 46(5) of the Ordinance) is a matter of discretion. It follows that the Registrar may also exercise discretion to allow or to refuse a request for post-grant amendment under section 46 of the Ordinance.
- 16.44 In Smith Kline & French Laboratories Limited v. Evans Medical Limited [1989] FSR 561, Aldous J identified the following factors governing the discretion to allow post-grant amendments:
- (a) full disclosure should be made on all relevant factors;
 - (b) amendments will be allowed provided the amendments are permitted under the relevant patent legislation;
 - (c) the amendment(s) is / are sought promptly unless the patentee shows reasonable grounds for delay;
 - (d) the patentee who seeks to obtain an unfair advantage from a patent will not be allowed to amend; and
 - (e) the conduct of the patentee.
- 16.45 Smith Kline & French Laboratories Limited was cited with approval in the Hong Kong SAR cases Otter Controls Ltd v Registrar of Patents [2011] HKEC 1379 and Celltrion, Inc. v Genentech, Inc. [2016] 4 HKLRD 150. Following these cases, a request for post-grant amendment under section 46 of the Ordinance will be considered having regard to the factors set out in the decision of Smith Kline & French Laboratories Limited, in addition to the requirements under section 103 of the Ordinance. In this regard, to facilitate the assessment of the merits of a request for post-grant amendment to a patent by the Registrar, such request must be accompanied by evidence in the form of statutory declaration or affidavit establishing the circumstances underlying the requested amendments (section 46 of the Ordinance and section 38A(2)(b)(ii) of the Rules).
- 16.46 Apart from compliance with the requirements under section 103 of the Ordinance on added matter, a request to amend a short-term patent which is filed in response to

an office action must enable the patent to comply with the examination requirement(s) concerned (section 127E(1)(a)(ii) of the Ordinance).

The test for added matter for both pre-grant and post-grant amendments

- 16.47 In Canon Kabushiki Kaisha v Green Cartridge Co (Hong Kong) Ltd & Another [1995] 1 HKC 768, the then Hong Kong High Court adopted the three-step test as set out in the UK case Bonzel and Schneider (Europe) AG v Intervention Ltd [1991] RPC 553 for determining whether the specification of a patent would contain an added matter beyond the disclosure in the patent application as filed as a result of an amendment to the patent.
- 16.48 In Bonzel, Aldous J held that the decision on whether there was an extension of disclosure must be made on a comparison of the two documents read through the eyes of a skilled addressee. In this regard, the task of the court is threefold—
- (a) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the patent application as filed;
 - (b) to do the same in respect of the patent as granted;
 - (c) to compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition— such comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.
- 16.49 The approach to the test of added matter was encapsulated by Jacob J. in Richardson-Vicks Inc.'s Patent [1995] RPC 568: *“the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.”*
- 16.50 In order to determine the original teaching of the “application as filed”, the entire specification which was present on the filing date may be considered. The following are not taken into account when determining what the application has disclosed at filing:
- (a) Abstract: Although the abstract is part of the application, it shall only serve for use as technical information and may not be taken into account for any other purpose (section 79 of the Ordinance). The Patents Court in Abbott Laboratories Ltd. v Medinol Ltd [2010] EWHC 2865 (Pat) also held that the content of the abstract should be disregarded in determining whether an amendment adds matter.
 - (b) Priority document(s) (e.g. a previous application required for claiming priority): A priority document forms part of the application but matter disclosed in the

priority document but omitted from the specification as filed may not be subsequently added.

16.51 The Registrar may also consider any implicit disclosure in the application as filed. Implicit disclosure refers to matter which a person skilled in the art would inevitably consider to have been included in the application as filed. Implicit disclosure requires that the matter to be added is necessarily present in the application as filed, and that it would be recognized by the person skilled in the art. Implicit disclosure may not be established by probabilities or possibilities. The mere fact that a certain fact may result from a given set of circumstances is not sufficient. Further, a matter which is not disclosed, but which the skilled person would find it obvious to add, is not regarded as having been implicitly disclosed.

Examples of allowable and non-allowable amendments regarding added matter

16.52 Whether an amendment is allowable or not depends on the facts of the individual case. The following non-exhaustive examples illustrate certain amendments that would likely be allowed or refused by the Registrar.

Allowable amendments regarding added matter

- (a) introducing further information regarding prior art provided that it does not alter the construction of the claims of the patent application in suit
- (b) providing straightforward clarification of obscurity, or resolution of an inconsistency in the specification
- (c) adding to the description or claims any matter that has been disclosed in a drawing provided it does not go beyond what a skilled person would judge to be disclosed in the drawing.

Non-allowable amendments regarding added matter

- (a) changing indefinite terms into specific terms thereby introducing new contents into the claims, e.g. amending “higher temperature” to “temperature higher than 40°C”
- (b) broadening a technical feature such as “helical spring supports” in the description as filed to “resilient supports” that goes beyond the disclosure of the initial application as filed
- (c) amending an application which initially describes and claims apparatus “mounted on resilient supports” without disclosing any particular kind of resilient support to include specific information that the supports are, or could be, for example, helical springs, which would normally be regarded as going beyond the disclosure in the application as originally filed unless the applicant could, for instance, demonstrate that drawings, as interpreted by the person skilled in the art, showed helical springs

- (d) introducing further examples to illustrate a claimed invention, particularly in the chemical field, without good justification, as any such further examples may *prima facie* extend the disclosure of the application as originally filed
- (e) adding experimental data to illustrate the advantageous effects of the invention
- (f) making reference to features which are only disclosed in a particular context but which are not disclosed as having any inventive significance, and introducing such features into the claim deprived of that context (*Palmaz's European Patents (UK)* [1999] RPC 47)

Publication of allowable amendments

- 16.53 If the Registrar accepts any requested amendment to a standard patent (O) or short-term patent in respect of which a certificate of substantive examination has been issued in whole or in part as an allowable amendment under section 46 of the Ordinance, he must publish the allowable amendment of the patent specification and advertise the fact of the publication by notice in the official journal (section 46(3)(a)&(b) of the Ordinance and section 38A(6)(a) of the Rules).
- 16.54 In respect of any requested amendment to a short-term patent which the Registrar accepts in whole or in part as allowable amendment during post-grant substantive examination of the patent, the Registrar must also publish the allowable amendment of the patent specification and advertise the fact of the publication by notice in the official journal (section 127E(2)(a) of the Ordinance and section 81P(4)-(5) of the Rules).

Opposition to allowable amendments

- 16.55 Any person may oppose the allowable amendment published by the Registrar by filing with the Registrar an opposition notice in Patents form P2 together with the official fee within 1 month after the date on which the fact of the publication of the allowable amendment is advertised by the Registrar (section 46(3)(c) of the Ordinance and section 38B of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81Q of the Rules (for short-term patents for which requests for substantive examination have been made)). This time limit is extendible for 1 month if the time extension request is filed before the initial deadline for filing the opposition notice (section 100AAB(2)(a)&(3)(a) of the Rules).
- 16.56 The opposition notice must be accompanied by a statement setting out fully the facts on which the opponent relies and the relief sought (section 46(3)(c) of the Ordinance and section 38B(3)(b)(i) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been

issued); section 127E(2)(b) of the Ordinance and section 81Q(3)(b)(i) of the Rules (for short-term patents for which requests for substantive examination have been made)).

- 16.57 The opposition should be confined to the allowability of the proposed amendments, such as by raising an issue on whether the allowable amendment constitutes added matter (section 103(3)(a) of the Ordinance) or claim broadening (section 103(3)(b) of the Ordinance).
- 16.58 The opponent may not oppose the allowable amendment on the ground that the claims as amended would lack unity of invention (section 47 of the Ordinance). It is also not open to the opponent to advance arguments that challenge the validity of the patent in any way beyond that suggested by the patentee.
- 16.59 A copy of the opposition notice and the statement must be sent to the patent proprietor at the time of filing of the opposition notice and the statement (section 46(3)(c) of the Ordinance and section 38B(4) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81Q(4) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.60 The opponent must, within 3 days after the date of filing of the opposition notice and statement, notify the Registrar in writing that he has duly sent a copy of the same to the patent proprietor (section 46(3)(c) of the Ordinance and section 38B(5) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81Q(5) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.61 The opposition notice and the statement are to be regarded as not having been filed if the opponent fails to send a copy of them to the patent proprietor or notify the Registrar of having done so (section 46(3)(c) of the Ordinance and section 38B(6) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81Q(6) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.62 In response to an opposition notice, the patent proprietor may file a counter-statement in the Patents form P2 setting out fully the grounds on which the opposition is resisted, and such counter-statement must be accompanied by the official fee and filed within 1 month after the date on which the copy of the opposition notice is received by the patent proprietor (section 46(3)(c) of the Ordinance and section 38C of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81R of the Rules (for short-term patents for which requests for substantive examination have been made)). This time limit is

extendible for 1 month if the time extension request is filed before the initial deadline for filing the counter-statement (section 100AAB(2)(a)&(3)(a) of the Rules).

- 16.63 A copy of the counter-statement must be sent to the opponent at the time of the filing (section 46(3)(c) of the Ordinance and section 38C(4) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81R(4) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.64 If the patent proprietor fails to file a counter-statement with the Registrar, the application to amend the specification of the patent is regarded as being withdrawn (section 46(3)(c) of the Ordinance and section 38C(5) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81R(5) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.65 The patent proprietor and the opponent may request for a hearing, as the case requires (section 46(3)(c) of the Ordinance and section 38C(6) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81R(6) of the Rules (for short-term patents for which requests for substantive examination have been made)).
- 16.66 The Registrar may, on the initiative of the Registrar or on application of a party to the opposition proceedings, give directions that the Registrar thinks fit with regard to any part of the procedure including the subsequent procedure to be followed (section 46(3)(c) of the Ordinance and section 38D of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b) of the Ordinance and section 81S of the Rules (for short-term patents for which requests for substantive examination have been made)).

Final decision on allowability of amendments

- 16.67 The Registrar will make a final determination on whether to allow the allowable amendment in whole or in part or refuse the allowable amendment after taking the following into consideration—
- (a) the opposition notice and its supporting statement;
 - (b) the counter-statement;
 - (c) representations made by any party to the opposition proceedings at the hearing (if any); and

- (d) the evidence furnished by the patent proprietor to establish the circumstances underlying the proposed amendment (*inapplicable to a requested amendment to a short-term patent for which a request for substantive examination has been made*) and/or other evidence furnished in accordance with the directions given by the Registrar (if any) .

(section 46(3)(c)&(5) of the Ordinance and section 38E(1) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(b)&(c) of the Ordinance and section 81T(1) of the Rules (for short-term patents for which requests for substantive examination have been made))

16.68 If no opposition notice is filed against an allowable amendment, the Registrar must, having decided to allow the amendment in whole or in part, make a final decision to allow the amendment in whole or in part (section 46(5) of the Ordinance and section 38E(2) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(c) of the Ordinance and section 81T(2) of the Rules (for short-term patents for which requests for substantive examination have been made)).

16.69 If the Registrar makes a final decision to allow an allowable amendment in whole or in part as an allowed amendment, he must:

- (a) record and publish the allowed amendment;
- (b) advertise the fact of the publication by notice in the official journal; and
- (c) notify the proprietor and the opponent (if any) of the final decision.

(section 46(7) of the Ordinance and section 38E(3) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(4) of the Ordinance and section 81T(3) of the Rules (for short-term patents for which requests for substantive examination have been made))

16.70 If the Registrar makes a final decision to refuse an allowable amendment, he must:

- (a) notify the proprietor and the opponent (if any) of the final decision; and
- (b) advertise the fact of the final decision by notice in the official journal.

(section 38E(4) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(c) of the Ordinance and section 81T(4) of the Rules (for short-term patents for which requests for substantive examination have been made))

16.71 In some cases concerning a request for amendment to a short-term patent for which a request for substantive examination has been made, the Registrar, having ultimately decided not to allow any allowable amendment to the patent, may

continue to carry out the examination to determine whether the patent complies with the substantive examination requirements (section 81T(5) of the Rules).

16.72 The Registrar may refer the opposition proceedings to the court if he thinks fit (sections 46(3)(c) and 133(1)(b) of the Ordinance (for standard patents (O) and short-term patents in respect of which substantive examination certificates have been issued); section 127E(3) of the Ordinance (for short-term patents for which requests for substantive examination have been made)).

16.72A Where the Registrar has referred to the court the opposition proceedings concerning a request for amendment to a short-term patent for which a request for substantive examination has been made —

(a) If the court allows the allowable amendment in whole or in part as an allowed amendment by an order, the Registrar must upon receipt of the order:

(i) record and publish the allowed amendment;

(ii) advertise the fact of the publication by notice in the official journal; and

(iii) consider whether the patent with the allowed amendment would achieve compliance with the substantive examination requirements.

(sections 127C(2) and 127E(4) of the Ordinance and section 81TA(2)&(4) of the Rules)

(b) If the court makes an order to not allow the allowable amendment, the Registrar:

(i) must upon receipt of the order, advertise the order by notice in the official journal; and

(ii) may continue to carry out the examination to determine whether the patent complies with the substantive examination requirements.

(section 127C(2) of the Ordinance and sections 81TA(3)-(5) of the Rules)

Publication of allowable or allowed post-grant amendments

16.73 For the purpose of publication of any post-grant amendment to a patent, the Registrar may, if he thinks fit, require the patent proprietor to file the following documents within a specific period—

(a) a clean copy of the specification with the amendment incorporated into it; and

(b) a copy of the specification incorporating and indicating the amendment.

(section 46(3)(a)&7(a) of the Ordinance and section 38F(2) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(a)&(4)(a) of the Ordinance and section 81U(2) of the Rules (for short-term patents for which requests for substantive examination have been made))

16.74 The amendment request to which the required copies relate will be regarded as being withdrawn if the required copies are not filed within the specified period (section 46(3)(a)&7(a) of the Ordinance and section 38F(4) of the Rules (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued); section 127E(2)(a)&(4)(a) of the Ordinance and section 81U(4) of the Rules (for short-term patents for which requests for substantive examination have been made)).