HONG KONG

Patents (Transitional Arrangements) Rules

as amended by L.N. 29 of 2004

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Preliminary

Section 1 (omitted as spent)

Section 2 Interpretation

(1) In these Rules, unless the context otherwise requires--

(a) "corresponding 1949 Act or 1977 Act patent" means, in relation to a deemed standard patent, the 1949 Act or 1977 Act patent which constitutes the existing registered patent referred to in section 3(1);

"deemed standard patent" means a standard patent deemed to be granted by virtue of section 3(1);

"European patent" means a patent granted by virtue of the European Patent Convention;

"European Patent Convention" means the Convention on the Grant of European Patents done at Munich on 5 October 1973;

"European Patent Office" means the office of that name of the European Patent Organization established by the European Patent Convention;

"the Ordinance" and "the principal Ordinance" mean the Patents Ordinance (Cap 514);

"United Kingdom Patent Office" means the office established under the laws of the United Kingdom for the granting of patents for inventions;

(b) the expressions listed in the left-hand column below have the same meaning as in the provisions of the Ordinance listed in the right-hand column in relation to those expressions--

Expression	Relevant provision of the Ordinance
1949 Act	section 159(1)
1949 Act patent	section 159(1)
1977 Act	section 159(1)
1977 Act patent	section 159(1)
commencement date	section 159(1)
European patent (UK)	section 159(1)
existing 1949 Act or 1977 Act patent	section 159(1)
existing application for a 1949 Act patent	section 159(1)
existing registered patent	section 159(1)
pending application for registration of a patent under the repealed Ordinance	section 159(1)
published application for a 1977 Act patent	section 159(1)
the repealed Ordinance	section 159(1)
standard patent	section 2(1);

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(c) other expressions used in these Rules have the same meaning as in the Ordinance.

(2) Section 159(2)(a) and (b) of the Ordinance applies in relation to these Rules as if the words “In these Rules” were substituted for the words “In this Part” appearing in that section.

Transitional arrangements affecting persons having rights, or expectation of rights, under the repealed Ordinance

Section 3 Patents registered under the repealed Ordinance

(1) As from the commencement date, a standard patent is deemed to be granted under section 27(1)(b) of the principal Ordinance for the invention shown in the published specification of every 1949 Act or 1977 Act patent which immediately before the commencement date was registered under the repealed Ordinance and at the commencement date was in force in the United Kingdom (in these Rules referred to as an “existing registered patent”), and every such standard patent is deemed to be so granted pursuant to an application under the principal Ordinance by the person who was registered under the repealed Ordinance as the proprietor of the existing registered patent.

(2) Schedule 1 has effect for securing the application of certain provisions of the Ordinance on and after the commencement date in relation to every such deemed standard patent but, except as otherwise provided, the Ordinance does not apply in relation to any such patent.

(3) In subsection (1), reference to the published specification of an existing registered patent is a reference to that specification as amended or treated as amended according to the law of the United Kingdom at the commencement date, regardless of whether a request has been made to the Registrar under section 9 of the repealed Ordinance in relation to such amendment.

(4) For the purposes of the application of section 38 of the Ordinance in relation to deemed standard patents, the date of filing that applies in relation to a deemed standard patent for the purposes of section 4(1)(b) shall be treated as the deemed date of filing of the application for that deemed standard patent.

Section 4 Term of deemed standard patent having effect pursuant to section 3

(1) Every deemed standard patent having effect pursuant to section 3(1)--

(a) is deemed to have been granted on, and to take effect as from, the commencement date;

(b) subject to subsection (2), remains in force until the end of the period of 20 years beginning from--

(i) if the existing registered patent is a 1949 Act patent, the date of filing of a complete specification under the 1949 Act; or

(ii) if the existing registered patent is a 1977 Act patent, the date of filing of the application for that patent in the United Kingdom Patent Office or European Patent Office (as the case may be),
and so remains in force whether or not the 1949 Act or 1977 Act patent remains in force in the United Kingdom.

(2) If it is desired to keep a deemed standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subsection (3), the renewal fee prescribed for the purposes of section 39(2) of the Ordinance shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a deemed standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid.

(3) The date specified for the purposes of subsection (2) is the anniversary of the date specified in subsection (1)(b)(i) or (ii) in relation to the deemed standard patent first occurring after the commencement date.

(4) Section 39(4) of the Ordinance applies in relation to deemed standard patents as if--
(a) reference in that section to the period specified in section 39(2) of the Ordinance was a reference to the period specified in subsection (2) of this section;
(b) reference in that section to a standard patent was reference to a deemed standard patent.

(5) The Registrar may by notice published in the Gazette amend the period specified in subsection (2) by reference to which the earliest date for payment of a prescribed renewal fee in relation to a deemed standard patent is determined.

Section 5 Pending applications for registration under the repealed Ordinance

(1) If immediately before the commencement date an application had been made under section 3 of the repealed Ordinance to have a 1949 Act or 1977 Act patent registered under section 5 of the repealed Ordinance but no certificate of registration had been issued, then section 5 of the repealed Ordinance continues to apply in relation to that patent as if section 154 of the principal Ordinance had not been enacted, except that reference in section 5 of the repealed Ordinance to the Registrar shall be read as a

reference to the Registrar under the principal Ordinance.

(2) For the purposes of section 3, where by virtue of subsection (1) a certificate of registration under section 5 of the repealed Ordinance is issued on or after the commencement date in relation to a patent for an invention, the patent shall be deemed to have been registered under the repealed Ordinance on the day before the commencement date, and accordingly a standard patent shall be deemed to be granted for that invention by virtue of section 3(1).

(3) Where a deemed standard patent has effect by virtue of section 3(1) pursuant to the issue of a certificate by the Registrar as provided for in this section, no action shall lie for infringement of the deemed standard patent in respect of any act done before the date on which that certificate was issued.

Section 6 Existing 1949 Act or 1977 Act patent

(1) Subject to these Rules and to necessary modification, sections 23 to 27 of the Ordinance (which provide for the registration of a designated patent and the grant of a standard patent) apply in relation to--

(a) an existing 1949 Act or 1977 Act patent; and

(b) the grantee of such a patent or any person deriving rights from such grantee by assignment, transmission or other operation of law,

as they apply in relation to a patent granted in a designated patent office in pursuance of a designated patent application recorded in the register and to the applicant for a standard patent under Part II of the Ordinance or his successor in title.

(2) For the purposes of section 23(2) of the Ordinance as so applied, a request for registration and grant in relation to an existing 1949 Act or 1977 Act patent shall be made not later than the date occurring--

(a) 12 months after the commencement date; or

(b) 5 years after the date of grant of the existing patent,

whichever is the earlier, and in paragraph (b) “date of grant” means--

(i) in relation to an existing 1949 Act patent, the date of sealing of the patent under section 19 of the 1949 Act or the date upon which the patent takes effect in the United Kingdom pursuant to section 25 of the 1977 Act (as the case may be);

(ii) in relation to an existing 1977 Act patent other than a patent to which paragraph (iii) applies, the date upon which the patent takes effect in the United Kingdom pursuant to section 25 of the 1977 Act;

(iii) in relation to an existing 1977 Act patent that is a European patent (UK), the date upon which the patent takes effect in the United Kingdom pursuant to section 77 of the 1977 Act.

(3) Part I of Schedule 2 has effect for securing that sections 23 to 27 of the Ordinance as applying for the purposes of subsection (1) shall have effect subject to the modifications specified in that Part in relation to those sections.

(4) Parts II and III of Schedule 2 have effect for securing the application of certain provisions of the Ordinance on and after the commencement date in relation to any patent or patent application provided for in this section but, except as otherwise provided, the Ordinance does not apply in relation to any such patent or patent application.

Section 7 Published applications for 1977 Act patents

(1) Subject to these Rules and to necessary modification--

(a) sections 15 to 22 of the Ordinance (which provide for the recording in the register of a designated patent application as the first stage of an application for a standard patent) apply in relation to--

(i) an application for a 1977 Act patent published before the commencement date; and

(ii) the person named as applicant in such an application or any person deriving rights from such applicant by assignment, transmission or other operation of law,

as they apply in relation to an application in a designated patent office for a patent for an invention and a person entitled under section 12 of the Ordinance to apply for the grant of a standard patent for the invention; and

(b) sections 23 to 27 of the Ordinance (which provide for the registration of a designated patent and the grant of a standard patent) apply in relation to--

(i) a 1977 Act patent granted after the commencement date pursuant to a published application for a 1977 Act patent (whether that patent is a European patent (UK) or a patent granted under the 1977 Act); and

(ii) the grantee of such a patent or any person deriving rights from such grantee by assignment, transmission or other operation of law,

as they apply in relation to a patent granted in a designated patent office in pursuance of a designated patent application recorded in the register and to the applicant for a standard patent under Part II of the Ordinance or his successor in title.

(2) For the purposes of section 15(1) of the Ordinance as so applied, a request to record a published application for a 1977 Act patent may be made at any time within 18 months after the commencement date.

(3) Part I of Schedule 3 has effect for securing that sections 15 to 27 of the Ordinance as applying for the purposes of subsection (1) shall have effect subject to the modifications specified in that Part in relation to those sections.

(4) Part II of Schedule 3 has effect for securing the application of certain provisions of the Ordinance on and after the commencement date in relation to any patent or patent application provided for in this section but, except as otherwise provided, the Ordinance does not apply in relation to any such patent or patent application.

Section 8 Published applications for 1977 Act patents - alternative procedure where patent granted within 12 months after commencement date

(1) Subject to these Rules and to necessary modification, and without prejudice to section 7, sections 23 to 27 of the Ordinance (which provide for the registration of a designated patent and the grant of a standard patent) apply in relation to--

(a) a 1977 Act patent of the Kind specified in section 7(1)(b)(i) where the patent is granted within 12 months after the commencement date; and

(b) the grantee of such a patent or any person deriving rights from such grantee by assignment, transmission or other operation of law,

as they apply in relation to a patent granted in a designated patent office in pursuance of a designated patent application recorded in the register and to the applicant for a standard patent under Part II of the Ordinance or his successor in title.

(2) For the purposes of section 23(2) of the Ordinance as so applied, a request for registration and grant pursuant to subsection (1) shall be made within 6 months after the date of grant of the 1977 Act patent, and in this subsection “date of grant” means--

(a) in relation to a 1977 Act patent other than a patent to which paragraph (b) applies, the date upon which the patent takes effect in the United Kingdom pursuant to section 25 of the 1977 Act;

(b) in relation to a 1977 Act patent that is a European patent (UK), the date upon which the patent takes effect in the United Kingdom pursuant to section 77 of the 1977 Act.

(3) Part I of Schedule 4 has effect for securing that sections 23 to 27 of the Ordinance as applying for the purposes of subsection (1) shall have effect subject to the modifications specified in that Part in relation to those sections.

(4) Part II of Schedule 4 has effect for securing the application of certain provisions of the Ordinance on and after the commencement date in relation to any patent or patent application provided for in this section but, except as otherwise provided, the Ordinance does not apply to any such patent or patent application.

Section 9 Existing applications for 1949 Act patents, and patents granted after the commencement date pursuant to those applications

(1) Subject to these Rules and to necessary modification, sections 23 to 27 of the Ordinance (which provide for the registration of a designated patent and the grant of a standard patent) apply in relation to--

(a) a patent granted after the commencement date pursuant to an existing application for a 1949 Act patent; and

(b) the grantee of such a patent or any person deriving rights from such grantee by assignment, transmission or other operation of law,

as they apply in relation to a patent granted in a designated patent office in pursuance of a designated patent application recorded in the register and to the applicant for a standard patent under Part II of the Ordinance or his successor in title.

(2) For the purposes of section 23 of the Ordinance as so applied, any request for registration and grant in relation to any 1949 Act patent specified in subsection (1)(a) shall be made not later than the date occurring--

(a) 6 months after the date of grant of the patent; or

(b) 20 years after the date of filing the complete specification under the 1949 Act,

whichever is the earlier, and in paragraph (a) “date of grant” means the date upon which the patent takes effect in the United Kingdom pursuant to section 25 of the 1977 Act.

(3) Part I of Schedule 5 has effect for securing that sections 23 to 27 of the Ordinance as applying for the purposes of subsection (1) shall have effect subject to the modifications specified in that Part in relation to those sections.

(4) Part II of Schedule 5 has effect for securing the application of certain provisions of the Ordinance on and after the commencement date in relation to any patent or patent application provided for in this section but, except as otherwise provided, the Ordinance shall not apply in relation to any such patent or patent application.

Miscellaneous

Section 10 Amendment or revocation of existing registered patent not to have any effect

Except as provided in section 11 or in any other rules made for the purposes of section 158(3)(d) of the Ordinance, no amendment to or revocation of an existing registered patent in the United Kingdom by virtue of any order or other operation of law made or taking effect on or after the commencement date shall have any effect for the purposes of any standard patent granted or deemed to be granted under the Ordinance by virtue of these Rules, regardless of whether the amendment or revocation has or is treated as having effect in the United Kingdom as from a date prior to the commencement date.

Section 11 Amendment or revocation of 1949 Act patents in United Kingdom Patent Office following opposition or revocation proceedings

(1) This section applies to--

(a) deemed standard patents having effect under section 3 by virtue of an existing registered patent that is a 1949 Act patent;

(b) standard patents having effect under section 6 or 9 by virtue of an existing 1949 Act patent or a patent granted pursuant to an existing application for a 1949 Act patent.

(2) Sections 43, 44 and 91(1)(i) of the Ordinance shall apply in relation to a standard patent specified in subsection (1) as if--

(a) a reference in those sections to “corresponding designated patent” was a reference to the 1949 Act patent specified in subsection (1) in relation to that patent;

(b) a reference to “designated patent office” was a reference to the United Kingdom Patent Office;

(c) a reference to prescribed opposition or revocation proceedings was a reference to proceedings for amendment or revocation of the 1949 Act patent pursuant to the 1977 Act.

Section 12 Priorities as between patents and patent applications under 1949 Act and other patents and patent applications

(1) This section shall have effect for the purpose of resolving questions of priority arising as between--

(a) 1949 Act patents and applications for those patents; and

(b) 1977 Act patents and applications for those patents and patents and applications for patents under the Ordinance.

(2) A complete specification under the 1949 Act shall be treated for the purposes of section 94(3) of the Ordinance--
(a) if published under that Act, as a published application for a patent under the Ordinance;
(b) if it has a date of filing under that Act, as an application for a patent under the Ordinance having as its date of filing under the Ordinance that date of filing,
and in section 94(3) of the Ordinance as it applies by virtue of this subsection in relation to any such specification the words “as filed” shall be omitted.

Section 13 Entry in register
(1) As from the commencement date there shall be deemed to be entered in the register kept under the Ordinance details of every standard patent deemed to be granted under section 3(1).

(2) It shall be the duty of the Registrar to add to the register those details deemed to be entered in the register by virtue of subsection (1), and for this purpose the Registrar shall take such steps as are reasonably practicable to identify all those 1949 Act or 1977 Act patents registered under the repealed Ordinance which at the commencement date were in force in the United Kingdom, and the Registrar may for the purposes of this subsection assume in the absence of evidence to the contrary that--
(a) any 1949 Act or 1977 Act patent in force in the United Kingdom on 6 December 1996, other than a patent the term of which was due to expire before the commencement date; and
(b) any 1949 Act or 1977 Act patent granted in the United Kingdom since 6 December 1996,
is in force in the United Kingdom at the commencement date.

(3) The Registrar may delete from the register any details in relation to a deemed standard patent which he has added to the register in reliance on either of the assumptions stated in subsection (2) if it comes to his knowledge that the corresponding 1949 Act or 1977 Act patent was not in force in the United Kingdom at the commencement date.

(4) The Registrar may, upon application being made to him by any person under this subsection, delete from the register any details in relation to a deemed standard patent where it appears to him that the corresponding 1949 Act or 1977 Act patent was not in force in the United Kingdom at the commencement date.

(5) An application under subsection (4) shall be made in the prescribed manner.

(6) No details in relation to a deemed standard patent shall be deleted from the register under subsection (3) or pursuant to an application under subsection (4) unless notice of the Registrar's intention to delete those details or of the application (as the case may be) has been given in the prescribed manner to the person named in the register as the proprietor of the deemed standard patent.

(7) Details deleted from the register under subsection (3) or pursuant to an application under subsection (4) shall be deemed never to have been added to the register.

(8) The Registrar may, upon an application being made to him by the proprietor of a patent under this subsection, if the Registrar is satisfied that the patent is a deemed standard patent, add to the register any details deemed to be entered in the register pursuant to subsection (1) in relation to that patent.

Section 14 Protection of third-party rights where details are added to register under section 13

(1) This section applies where--

(a) details in relation to a deemed standard patent are added to the register pursuant to section 13(8); and

(b) at the commencement date the corresponding 1949 Act or 1977 Act patent had ceased to have effect in the United Kingdom by reason of the non-payment of any renewal fee, but subsequently is restored in the United Kingdom by virtue of an order for restoration made under the 1977 Act.

(2) Except as provided in subsection (3), the fact that the corresponding 1949 Act or 1977 Act patent had ceased to have effect shall not affect the rights of the proprietor of the deemed standard patent to prevent the use of the invention under Part X of the Ordinance or to bring proceedings under Part XI of the Ordinance in respect of any act of infringement, and in particular shall not affect those rights in relation to any act of infringement during the period when it was possible for the corresponding 1949 Act or 1977 Act patent to be renewed and to be treated for the purposes of the 1977 Act as if it had never expired.

(3) If, after it was no longer possible for the corresponding 1949 Act or

1977 Act patent to be so renewed in the United Kingdom, but before details of the deemed standard patent were added to the register pursuant to section 13(8), a person in Hong Kong--

(a) began in good faith to do an act which, but for this section would have constituted an infringement of the deemed standard patent; or

(b) made in good faith effective and serious preparations to do such an act,

he has the rights specified in subsection (4).

(4) The rights referred to in subsection (3) are--

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (3);

(b) if such act was done or preparations had been made to do it in the course of a business--

(i) in the case of an individual--

(A) the right to assign the right to do it or to transmit such right on death; or

(B) the right to authorize the doing of that act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body’s dissolution,

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

(5) The rights specified in subsection (4) shall not include the right to grant a licence to any person to do an act referred to in subsection (3).

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

Section 15 Registrar may amend Schedules

The Registrar may by notice published in the Gazette amend any of the Schedules.

SCHEDULE 1 APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 3 OF THESE RULES (Sections 3 & 15)

PART I APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 3(2) OF THESE RULES TO DEEMED STANDARD PATENTS WHICH ARE BASED ON EXISTING REGISTERED 1949 ACT PATENTS

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every deemed standard patent having effect pursuant to section 3(1) of these rules where the existing registered patent is a 1949 Act patent--
sections 2 to 7, 9, 38, 47 to 54, 62, 63, 104 to 107, 130 to 133, 135 to 143, 145 and 147 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	Paragraphs (i) to (iv) and (vi) have no application.
section 4	(a) For the definitions in subsection (1) read-- ““designated patent” means an existing 1949 Act patent; “designated patent application” means an application in the United Kingdom Patent Office for a 1949 Act patent the complete specification of which has been published under the law of the United Kingdom Patent Office; “designated patent office” means the United Kingdom Patent Office.”. (b) For subsection (2)(a) and (b) read-- “(a) to a “corresponding designated patent” in relation to a deemed standard patent is a reference to the corresponding 1949 Act patent; (b) to a “corresponding designated patent application” is a reference to an application for a corresponding designated patent.”.
section 5	(a) Subsection (1)(a) has no application. (b) For subsection (2)(d) read-- “(d) to a designated patent application being published is a reference to a complete specification of a 1949 Act patent being published under the law of the United Kingdom Patent Office;”.
section 6	Subsection (5) has no application.
section 104	In subsection (2), for “the official language in which an application for a patent is filed” read “the language in which an application for registration under the Registration of Patents Ordinance (Cap.42) was filed”.

3. Paragraphs 1 and 2 have effect--
(a) subject to sections 3, 11 and 13 of these rules;
(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

PART II APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 3(2) OF THESE RULES TO DEEMED STANDARD PATENTS WHICH ARE BASED ON EXISTING REGISTERED 1977 ACT PATENTS

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every deemed standard patent having effect pursuant to section 3(1) of these rules where the existing registered patent is a 1977 Act patent--
sections 2 to 7, 9, 40, 41, 46 to 56, 62 to 67, 76 to 79, 82 to 84, 91 to 107, 130 to 143 and 145 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	(a) Paragraphs (i) to (iii) have no application. (b) In paragraph (iv), for “publication of a request to record” read “grant of a standard patent”.
section 4	(a) For the definitions in subsection (1) read-- ““designated patent” means an existing 1977 Act patent; “designated patent application” means-- (a) an application in the United Kingdom Patent Office for a 1977 Act patent, which application has been published under the law of the United Kingdom Patent Office; (b) an application in the European Patent Office for a European patent (UK), which application has been published under the law of the European Patent Office; (c) an international application which has been published and which has validly entered its national phase in the United Kingdom Patent Office or the European Patent Office (as the case may be); “designated patent office” means-- (a) the United Kingdom Patent Office; or (b) the European Patent Office in relation to a European patent (UK) or an application for a European patent (UK).”. (b) For subsection (2)(a) and (b) read-- “(a) to a “corresponding designated patent” in relation to a deemed standard patent is a reference to the corresponding 1977 Act patent; (b) to a “corresponding designated patent application” is a

	reference to an application for a corresponding designated patent.”.
section 55	In subsection (7), for “date of the grant” read “date of grant of the corresponding 1977 Act patent”.
section 64	In subsection (1), for “date of grant of a standard patent” read “commencement date”.
section 91	In subsection (1)-- (a) in paragraph (d)-- (i) for “application for the patent” read “application for the corresponding 1977 Act patent”; (ii) for “application for a patent” read “application for a corresponding 1977 Act patent”; (b) in paragraph (e), for “application for the patent” read “application for the corresponding 1977 Act patent”; (c) paragraph (i) has no application.
section 92	(a) In subsection (1)(a), for “patent sought to be revoked” read “corresponding 1977 Act patent”. (b) In subsection (1)(b), for “date of the grant of the patent sought to be revoked” read “date of grant of the 1977 Act patent”.
section 94	In subsections (2)(a) and (3)(a), for “standard patent” read “corresponding 1977 Act patent”.
section 100	In subsection (3)-- (a) in paragraph (a), for “standard patent” where it twice appears read “corresponding 1977 Act patent”; (b) the passage beginning “but in the application” and ending “under this Ordinance” has no application.
section 101	In subsection (4)(b)(i), for “date of the grant of the patent” read “date of grant of the corresponding 1977 Act patent”.
section 103	In subsection (3)(a), for “application” read “application for a corresponding 1977 Act patent”.
section 104	In subsection (2), for “the official language in which an application for a patent is filed” read “the language in which an application for registration made under the Registration of Patents Ordinance (Cap.42) was filed”.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 3 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

SCHEDULE 2 APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 6 OF THESE RULES (Sections 6 & 15)

PART I MODIFICATION OF SECTIONS 23 TO 27 OF THE ORDINANCE AS APPLIED FOR PURPOSES OF SECTION 6(1) OF THESE RULES

The application of sections 23 to 27 of the Ordinance for the purposes of section 6(1) of these rules has effect subject to the following modifications--

(a) in sections 23 and 24 of the Ordinance, for “the designated patent office” wherever it appears read “the United Kingdom Patent Office or the European Patent Office (as the case may be)”;

(b) sections 23(3)(c) and 24(1)(d) of the Ordinance have no application;

(c) for section 24(2) of the Ordinance read--

“(2) If the earliest filing with the Registrar of any part of a request for registration and grant occurred after the earlier of--

(a) the date occurring 12 months after the commencement date; and

(b) the date occurring 5 years after the date of grant of the existing 1949 Act or 1977 Act patent (as the case may be),

then the request shall not be dealt with as an application for a patent.”.

PART II APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 6(4) OF THESE RULES WHERE THE PATENT OR PATENT APPLICATION IS BASED ON AN EXISTING 1949 ACT PATENT

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every application for a standard patent pursuant to section 6(1) of these rules where the existing patent is a 1949 Act patent and to every standard patent granted pursuant to any such application--

sections 2 to 7, 9, 11, 28 to 32, 36 to 38, 39(1), 47 to 54, 62, 63, 68 to 75, 80, 81, 85 to 87, 89, 90, 104 to 107, 130 to 133, 135 to 143, 145 and 147 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	(a) In paragraphs (i) and (ii), for “request to record” read “request for registration and grant”. (b) Paragraphs (iii) to (vi) have no application.

section 4	For the definitions in subsection (1) read-- ““designated patent” means an existing 1949 Act patent; “designated patent application” means an application in the United Kingdom Patent Office for a 1949 Act patent the complete specification of which has been published under the law of the United Kingdom Patent Office; “designated patent office” means the United Kingdom Patent Office.”.
section 5	(a) Subsection (1)(a) has no application. (b) For subsection (2)(d) read-- “(d) to a designated patent application being published is a reference to a specification of an application for a 1949 Act patent being published under the law of the United Kingdom Patent Office;”.
section 6	Subsection (5) has no application.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 5, 11 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

PART III APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 6(4) OF THESE RULES WHERE THE PATENT OR PATENT APPLICATION IS BASED ON AN EXISTING 1977 ACT PATENT

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every application for a standard patent pursuant to section 6(1) of these rules where the existing patent is a 1977 Act patent and to every standard patent granted pursuant to any such application--

sections 2 to 7, 9, 11, 28 to 32, 36 to 41, 43, 44, 46 to 56, 62 to 87, 89, 90 to 107, 130 to 143 and 145 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	(a) In paragraphs (i) and (ii), for “request to record” read “request for registration and grant”. (b) Paragraph (iii) has no application. (c) In paragraph (iv), for “publication of a request to record” read “grant of a standard patent”.
section 4	For the definitions in subsection (1) read-- ““designated patent” means an existing 1977 Act patent; “designated patent application” means

	(a) an application in the United Kingdom Patent Office for a 1977 Act patent, which application has been published under the law of the United Kingdom Patent Office; (b) an application in the European Patent Office for a European patent (UK), which application has been published under the law of the European Patent Office; (c) an international application which has been published and which has validly entered its national phase in the United Kingdom Patent Office or the European Patent Office (as the case may be); “designated patent office” means-- (a) the United Kingdom Patent Office; or (b) in relation to a European patent (UK) or an application for a European patent (UK), the European Patent Office.”.
section 91(1)	(a) In paragraph (d)-- (i) for “application for the patent” read “application for the corresponding 1977 Act patent”; (ii) for “application for a patent” read “application for a corresponding 1977 Act patent”. (b) In paragraph (e), for “application for the patent” read “application for the corresponding 1977 Act patent”.
section 94	In subsections (2)(a) and (3)(a), for “standard patent” read “corresponding 1977 Act patent”.
section 103	In subsection (3)(a), for “application” read “application for a corresponding 1977 Act patent”.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 6 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

SCHEDULE 3 APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 7 OF THESE RULES (Sections 7 & 15)

PART I MODIFICATION OF SECTIONS 15 TO 27 OF THE ORDINANCE AS APPLIED FOR PURPOSES OF SECTION 7(1) OF THESE RULES

The application of sections 15 to 27 of the Ordinance for the purposes of section 7(1) of these Rules has effect subject to the following modifications--

(a) in sections 15 to 17, 20 and 22 to 24 of the Ordinance, for “the designated patent office” wherever it appears read “the United Kingdom Patent Office or the European Patent Office (as the case may be)”;

(b) sections 15(6) and 16(a) of the Ordinance have no application;

(c) in section 15(2)(a) of the Ordinance, for “as published” read “as published by the United Kingdom Patent Office or the European Patent Office (as the case may be)”;

(d) in section 22(1)(b) and (3)(a) of the Ordinance, for “corresponding designated patent application” wherever it appears read “corresponding published application for a 1977 Act patent”;

(e) section 16 of the Ordinance has effect if, and only if, before the commencement date, the published application for a 1977 Act patent had been published in the United Kingdom Patent Office or the European Patent Office (as the case may be) following its valid entry into the national phase in that office;

(f) in section 17(2) of the Ordinance, for “6 months after the publication of the corresponding designated patent application” read “18 months after the commencement date”;

(g) in sections 23 and 24(1)(a) and (c) of the Ordinance, for “designated patent” wherever it appears read “1977 Act patent”.

PART II APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 7(4) OF THESE RULES

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every application for a standard patent pursuant to section 7(1) of these rules and to every standard patent granted pursuant to any such application--

sections 2 to 7, 9 to 11, 28 to 41, 43 to 56, 62 to 107, 130 to 143 and 145 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 4	For the definitions in subsection (1) read-- ““designated patent” means a 1977 Act patent; “designated patent application” means-- (a) an application in the United Kingdom Patent Office for a 1977 Act patent, which application has been published under the law of the United Kingdom Patent Office; (b) an application in the European Patent Office for a European patent (UK), which application has been published under the law of the European Patent Office; (c) an international application which has been published and which has validly entered its national phase in the United Kingdom Patent Office or the European Patent Office (as the case may be); “designated patent office” means-- (a) the United Kingdom Patent Office; or (b) in relation to a European patent (UK) or an application for a European patent (UK), the European Patent Office.”.
section 91	(a) In subsection (1)(d)-- (i) for “application for the patent” read “application for the corresponding 1977 Act patent”; (ii) for “application for a patent” read “application for a corresponding 1977 Act patent”. (b) In subsection (1)(e), for “application for the patent” read “application for the corresponding 1977 Act patent”.
section 94	In subsections (2)(a) and (3)(a), for “standard patent” read “corresponding 1977 Act patent”.
section 103	In subsection (3)(a), for “application” read “application for a corresponding 1977 Act patent”.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 7 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

SCHEDULE 4 APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 8 OF THESE RULES (Sections 8 & 15)

PART I MODIFICATION OF SECTIONS 23 TO 27 OF THE ORDINANCE AS APPLIED FOR PURPOSES OF SECTION 8(1) OF THESE RULES

1. The application of sections 23 to 27 of the Ordinance for the purposes of section 8(1) of these rules has effect subject to the following modifications--
(a) in sections 23 and 24 of the Ordinance, for “the designated patent office” wherever it appears read “the United Kingdom Patent Office or the European Patent Office (as the case may be)”;
(b) sections 23(3)(c) and 24(1)(d) and (2)(b) of the Ordinance have no application.

PART II APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 8(4) OF THESE RULES

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every application for a standard patent pursuant to section 8(1) of these rules and to every standard patent granted pursuant to any such application--
sections 2 to 7, 9, 11, 28 to 32, 36 to 41, 43, 44, 46 to 56, 62 to 87, 89 to 107, 130 to 143 and 145 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	(a) In paragraphs (i) and (ii), for “request to record” read “request for registration and grant”. (b) Paragraph (iii) has no application. (c) In paragraph (iv), for “publication of a request to record” read “grant of a standard patent”.
section 4	For the definitions in subsection (1) read-- ““designated patent” means a 1977 Act patent; “designated patent application” means-- (a) an application in the United Kingdom Patent Office for a 1977 Act patent, which application has been published under the law of the United Kingdom Patent Office; (b) an application in the European Patent Office for a European patent (UK), which application has been published under the law of the European Patent Office;

	(c) an international application which has been published and which has validly entered its national phase in the United Kingdom Patent Office or the European Patent Office (as the case may be); “designated patent office” means-- (a) the United Kingdom Patent Office; or (b) in relation to a European patent (UK) or an application for a European patent (UK), the European Patent Office.”.
section 91	(a) In subsection (1)(d)-- (i) for “application for the patent” read “application for the corresponding 1977 Act patent”; (ii) for “application for a patent” read “application for a corresponding 1977 Act patent”. (b) In subsection (1)(e), for “application for the patent” read “application for the corresponding 1977 Act patent”.
section 94	In subsections (2)(a) and (3)(a), for “standard patent” read “corresponding 1977 Act patent”.
section 103	In subsection (3)(a), for “application” read “application for a corresponding 1977 Act patent”.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 8 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).

SCHEDULE 5 APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 9 OF THESE RULES (Sections 9 & 15)

PART I MODIFICATION OF SECTIONS 23 TO 27 OF THE ORDINANCE AS APPLIED FOR PURPOSES OF SECTION 9(1) OF THESE RULES

The application of sections 23 to 27 of the Ordinance for the purposes of section 9(1) of these Rules has effect subject to the following modifications--

(a) in sections 23 and 24 of the Ordinance, for “the designated patent office” wherever it appears read “the United Kingdom Patent Office”;

(b) sections 23(3)(c) and 24(1)(d) of the Ordinance have no application;

(c) for section 24(2) of the Ordinance read--

“(2) If the earliest filing with the Registrar of any part of a request for registration and grant occurred--

(a) more than 6 months after the date of grant of the 1949 Act patent; or

(b) more than 20 years after the date of filing the completed specification under the 1949 Act,

then the request shall not be dealt with as an application for a patent.”.

PART II APPLICATION OF THE ORDINANCE FOR PURPOSES OF SECTION 9(4) OF THESE RULES

1. As from the commencement date, and subject to the modifications specified in paragraph 2, the following provisions of the Ordinance shall apply in relation to every application for a standard patent pursuant to section 9(1) of these rules and to every standard patent granted pursuant to any such application--

sections 2 to 7, 9, 11, 28 to 32, 36 to 38, 39(1), 47 to 54, 62, 63, 68 to 75, 80, 81, 85 to 87, 89, 90, 104 to 107, 130 to 133, 135 to 143, 145 and 147 to 153.

2. For the purposes of paragraph 1, the application of the provisions of the Ordinance specified in column 1 shall have effect subject to the modifications specified opposite those provisions in column 2--

Provision of the Ordinance	Modification
section 3	(a) In paragraphs (i) and (ii), for “request to record” read “request for registration and grant”. (b) Paragraphs (iii), (iv) and (vi) have no application.
section 4	For the definitions in subsection (1) read-- ““designated patent” means a 1949 Act patent; “designated patent application” means an application in the

	United Kingdom Patent Office for a 1949 Act patent the complete specification of which has been published under the law of the United Kingdom Patent Office; “designated patent office” means the United Kingdom Patent Office.”.
section 5	(a) Subsection (1)(a) has no application. (b) For subsection (2)(d) read-- “(d) to a designated patent application being published is a reference to a complete specification of a 1949 Act patent being published under the law of the United Kingdom Patent Office;”.
section 6	Subsection (5) has no application.

3. Paragraphs 1 and 2 have effect--

(a) subject to sections 9, 11 and 13 of these rules;

(b) without prejudice to sections 155 to 157 of the Ordinance (which apply, in certain circumstances, provisions of the Ordinance in relation to certain patents).