

[143.03] Definitions

For ‘application for a patent’, see s 2(1); for ‘patent’, see s 6(1).

144. Misuse of title ‘Patents Registry’

A person who uses on his place of business, or any document issued by him, or otherwise, the words *Patents Registry* or “專利註冊處” or any other words suggesting that his place of business is, or is officially connected with, the Patents Registry, commits an offence and is liable on summary conviction to a fine at level 4.

[cf. 1977 c. 37 s 112 U.K.]

[144.01] England

Cf s 112 of the Patents Act 1977 [Eng].

[144.02] General note

Section 144 is self-explanatory and makes it an offence for any person to suggest that his place of business is, or is officially connected with, the Patents Registry. The offence is punishable summarily.

[144.03] Definitions

For ‘patent’, see s 6(1); for ‘registry’, see s 2(1).

144A. Prohibition on use of certain titles and descriptions

- (1) A person must not, in the course of or in connection with the person’s business, trade or profession in Hong Kong, knowingly use or permit the use of a title or description specified in subsection (2).
- (2) The title or description is—
 - (a) certified patent agent;
 - (b) registered patent agent;
 - (c) certified patent attorney;
 - (d) registered patent attorney; or
 - (e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—

- (i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and
 - (ii) that is recognized by law or endorsed by the Government.
- (3) Subsection (1) does not prohibit a person from using, or from permitting the use of, a title or description that—
- (a) solely relates to the person's qualification for lawfully providing patent agency services in a jurisdiction outside Hong Kong; and
 - (b) clearly indicates the jurisdiction.
- (4) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine of \$500,000.

(Added 17 of 2016 s 129)

[144A.01] General note

As part of the evolution of the patent system in Hong Kong, a prime objective is to nature and regulate a strong patent profession as a complementary component of the new patent system. This would require the development of a full-fledged regulatory regime covering issues such as the establishment of a professional regulatory body, accreditation, use of titles, professional discipline, training, service monopoly and statutory backing. Pending resolution of these wide-ranging issues in the longer-term, s 144A is put in place, as an interim measure, to regulate local patent practitioners to prevent misuses of attractive titles that confuse service users or adversely affect the setting up of such regulatory regime.

Subsections (1) and (2)(a)–(d) stipulate that a person must not knowingly use or permit to be used certain specific titles and descriptions in the course of or in connection with the person's business, trade or profession in Hong Kong. The prohibitive scope also extends to any title or description which might reasonably cause anyone to believe that the person using or permitting the use of the title or description holds a qualification that is specifically granted for approving that person to provide patent agency services.

Subsection (3) provides an exemption allowing the legitimate and reasonable use of professional titles or descriptions that have been lawfully acquired outside Hong Kong. Such professional titles must solely relate to the member's qualification for lawfully providing patent agency services in the relevant jurisdiction outside Hong Kong.

Subsection (3)(b) requires also clear indication of the jurisdiction in such professional titles or descriptions. One may expect titles and descriptions such as 'Chinese Patent Attorney', 'UK Chartered Patent Attorney', and 'US Patent Attorney' to be exempted.

145. Offences by corporations or partners

- (1) Where an offence under this Ordinance committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- (2) The following provisions apply for the purposes of proceedings for an offence under this Ordinance alleged to have been committed by a body corporate—
 - (a) any rules of court relating to the service of documents;
 - (b) section 19A (plea by a corporation before a magistrate) and section 87 (procedure on charge of indictable offence against corporation) of the Magistrates Ordinance (Cap 227).
- (3) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.
- (4) Where a partnership is guilty of an offence under this Ordinance, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.
- (5) Without prejudice to any liability of the partners under subsection (4), proceedings for an offence under this Ordinance alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners.
- (6) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.
- (7) Where an offence under this Ordinance committed by a partner in a firm is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any other partner in the firm or any person concerned in the management of the firm, that partner or the person concerned in the management of the firm is also guilty of the offence and liable to be proceeded against and punished accordingly.

[145.01] General note

Section 145 deals with criminal liabilities of corporations and partnerships under the Ordinance. Pursuant to sub-s (1), where an offence under the Ordinance is committed by a body corporate with the consent, connivance or negligence of an officer of the corporation, the officer as well as the body corporate is guilty of the offence. The same rule applies where the affairs of the body corporate are managed by its members. Where an offence under the Ordinance is committed by the body corporate with the consent, connivance or negligence of a member in connection with his functions of management, the member as well as the body corporate is guilty of the offence: sub-s (3). In proceedings for an offence under the Ordinance committed by a body corporate, the provisions set out in sub-s (2) will apply.

Subsection (4) deals with situations where a partnership is guilty of an offence under the Ordinance. In such cases, every partner, other than a partner proved to have been ignorant of or have attempted to prevent the commission of the offence, is also guilty of the offence. However, proceedings for an offence under the Ordinance committed by a partnership must be brought against the partnership in the name of the firm and not that of the partners (sub-s (5)), and a fine imposed on a partnership in such proceedings will be paid out of the partnership assets (sub-s (6)).

Subsection (7) is concerned with situations where an offence under the Ordinance is committed by a partner rather than the partnership. If the offence is committed with the consent, connivance or negligence of any other partner, or any person concerned in the management of the firm, that partner or person is also guilty of the offence.

[145.02] Definitions

For 'court', see s 2(1).

PART 18**ADMINISTRATIVE PROVISIONS**

(Replaced 17 of 2016 s 130)

146. Correction of errors in patents and applications

- (1) The Registrar may, subject to the rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.
- (2) Where the Registrar is requested to correct such an error or mistake any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

[146.01] England

Cf s 117 of the Patents Act 1977 [Eng].

[146.02] General note

Section 146 applies to both standard and short-term patents and applications therefor. It is concerned with correction of errors in the specification and in any document filed in connection with a patent or patent application. The language of sub-s (1) suggests that the Registrar of Patents may make corrections on his own initiative, or upon the request of any person, who is not necessarily the patentee or the patent applicant. Note, however, that corrections allowed under the section are limited to errors of translation or transcription, clerical errors or mistakes. Such corrections must be distinguished from amendments to the specification, which are made under other provisions of the Ordinance: see, eg, ss 31, 37ZA, 43, 46, 102 and 120. Accordingly, unlike the case of an amendment (cf s 103), the question of whether additional matter has been disclosed, or whether the protection conferred by a patent has been extended, does not arise in the case of a correction. As confirmed by the United Kingdom Patent Office, correction of a patent or patent application takes effect *ex tunc*, ie the patent or patent application is deemed always to have been in the state after the correction: see *Manual of Patent Practice* (April 2019 edn, UK Patent Office), para 19.04.

Pursuant to s 48 of the Patents (General) Rules, a request for correction under s 146 must be in a specified form, clearly identify the proposed correction, and be accompanied by a prescribed fee. Where the request relates to a specification, no correction shall be made in the specification unless the correction is 'obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction'. Presumably the same test applies to corrections made by the Registrar on his own initiative.

By sub-s (2), where the Registrar is requested to make a correction under sub-s (1), any person may oppose the request by giving notice to the Registrar. In accordance with s 48 of the Patents (General) Rules, such notice must be in a specified form, accompanied by a supporting statement, and filed within 2 months after the request is advertised in the official journal by the Registrar. At the same time as he files the notice, the opponent must send a copy of the notice and the supporting statement to the person requesting the correction. If the person requesting the correction desires to proceed with the request, he must file a counter-statement within 3 months from the date the notice is received by him, pay the prescribed fee, and send a copy of the counter-statement to the opponent.

Note that by s 87 of the Patents (General) Rules, where the person who gives notice of opposition under s 146 neither resides nor carries on business in Hong Kong, the Registrar may require him to give security for the costs or expenses of the proceedings, and in default of such security being given may treat the notice as abandoned.