

LEGISLATIVE COUNCIL BRIEF

Patents Ordinance
(Chapter 514)

Registered Designs Ordinance
(Chapter 522)

INTELLECTUAL PROPERTY (MISCELLANEOUS AMENDMENTS) ORDINANCE 2001 (2 OF 2001) (COMMENCEMENT) NOTICE 2002

PATENTS (GENERAL)(AMENDMENT) RULES 2002

INTRODUCTION

This brief explains the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001) (Commencement) Notice 2002 ("the Notice") at Annex A and the Patents (General)(Amendment) Rules 2002 ("the Rules") at Annex B.

THE NOTICE

2. The Intellectual Property (Miscellaneous Amendments) Ordinance 2001 ("the Ordinance") was enacted on 7 February 2001. The Ordinance makes some technical improvements to the Patents Ordinance and the Registered Designs Ordinance.

3. The Notice will bring sections 1, 2(a), (b) and (c), 3 to 11, 13, 15 to 18, 21 to 24 and 28 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 into operation on 1 June 2002. The remaining provisions, which have yet to be commenced, concern the use of electronic means for publishing notifications and advertisements for patents

and designs. We will commence those provisions after a new computer system in the Intellectual Property Department becomes operational.

THE RULES

4. Under section 149 of the Patents Ordinance (Cap. 514), the Director of Intellectual Property, who is the Registrar of Patents (“the Registrar”), may make rules for regulating practice and procedure under the Patents Ordinance.

5. We propose that section 8(2)(c)(iv) of the Patents (General) Rules be amended by the Registrar to align the wording with section 17(1)(c)(ii) of the Patents Ordinance as amended by section 5 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001. By adding the words "if any" to the publication number and the date of publication, section 8(2)(c)(iv) will cater for cases where the designated patent application has no publication number or date of publication.

6. We further propose that section 58(2) of the Patents (General) Rules be amended by the Registrar to remove the restriction that an application for a short-term patent shall state the title of invention, description, claims and drawings in a particular order. There is no such requirement in relation to application for short-term patents under section 113(b) of the Patents Ordinance.

7. The relevant provisions of the Patents (General) Rules being amended are at Annex C.

CONSULTATION

8. The proposed amendments are technical and minor in nature. No consultation is considered necessary.

BASIC LAW IMPLICATIONS

9. The Department of Justice advises that the proposed Rules are consistent with the Basic Law.

HUMAN RIGHTS IMPLICATIONS

10. The Department of Justice advises that the proposed Rules have no human rights implications.

BINDING EFFECT OF THE RULES

11. The Department of Justice advises that the amendments will not affect the current binding effect of the Patents Ordinance.

FINANCIAL AND STAFFING IMPLICATIONS

12. There are no financial or staffing implications for Government.

LEGISLATIVE TIMETABLE

13. The Rules and the Notice will be published in the Gazette on 4 April 2002 and will be tabled at the Legislative Council on 10 April 2002.

ENQUIRIES

14. Enquiries on this brief should be referred to Mr. Philip Chan, Principal Assistant Secretary for Commerce and Industry, at telephone number 2918 7480.

Commerce and Industry Bureau
March 2002

**INTELLECTUAL PROPERTY (MISCELLANEOUS
AMENDMENTS) ORDINANCE 2001 (2 OF 2001)
(COMMENCEMENT) NOTICE 2002**

Under section 1(2) of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001, I appoint 1 June 2002 as the day on which sections 1, 2(a), (b) and (c), 3 to 11, 13, 15 to 18, 21 to 24 and 28 of the Ordinance shall come into operation.

Secretary for Commerce and Industry

2002

PATENTS (GENERAL) (AMENDMENT) RULES 2002

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

1. Commencement

These Rules shall come into operation on the day appointed for the commencement of section 5 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Request to record a designated patent application under section 15 of the Ordinance

Section 8(2)(c)(iv) of the Patents (General) Rules (Cap. 514 sub. leg.) is repealed and the following substituted –

“(iv) the publication number (if any) assigned to the designated patent application by the designated patent office, and the date (if any) of its publication by the designated patent office;”.

3. Applications for the grant of short-term patents under section 113 of the Ordinance

Section 58(2) is amended by repealing everything after “invention” and substituting –

“and include the following –

- (a) a description of the invention;
- (b) one or more claims but not exceeding one independent claim;
- (c) any drawings referred to in the description or the claim or claims.”.

Registrar of Patents

2002

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg.).

2. Section 8(2)(c)(iv) is amended to correspond to section 5 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001), in order to provide for cases where the designated patent application concerned has no publication number or date of publication.
3. Section 58(2) is amended to allow an invention's title, description, claims and drawings to be provided in any order in the specification on an application for the grant of a short-term patent.

Chapter: 514C Title: PATENTS (GENERAL) RULES Gazette Number:

Section: 8 Heading: Request to record a designated patent application under section 15 of the Ordinance Version Date: 30/06/1997

Request to record a designated patent application

(1) A request to record a designated patent application under section 15 of the Ordinance (or, in the case of a designated patent application that is the national phase of an international application under the Patent Cooperation Treaty, under that section as applied by section 16 of the Ordinance) shall be in the specified form.

(2) Further to section 15(2) of the Ordinance (including that section as applied by section 16 of the Ordinance)-

(a) the documents required under paragraph (a) of that subsection-

(i) shall be filed in duplicate, and one of those duplicate copies shall be in loose leaf form in accordance with section 12 of these Rules;

(ii) shall be exempted from any requirement under section 104(1) of the Ordinance to be filed in one of the official languages;

(b) the documents prescribed for the purposes of paragraph (d) of that subsection are those mentioned in section 9 of these Rules;

(c) the following particulars shall be set out in the request-

(i) the date of filing of the designated patent application;

(ii) the title of the invention;

(iii) the application number of the designated patent application;

(iv) the publication number, and date of publication, of the designated patent application;

(d) if the designated patent application is the national phase of an international application, the following particulars shall be set out on the request-

(i) the application number of the international application;

(ii) the filing date of the international application;

(iii) the date of publication of the international application by the International Bureau and its publication number;

(iv) the date of publication of the international application in the designated patent office indicating that the application has validly entered its national phase;

(v) in the case of an international application designating the Chinese Patent Office as published by the International Bureau in the Chinese language, the date of the issuance (發文日) of the National Application Notification (國家申請號通知書) by the Chinese Patent Office;

(e) in the case of a request to record a divisional designated patent application as provided for in section 22 of the Ordinance or a request to record in a new application

made pursuant to an order under section 55(4) of the Ordinance, the following particulars in relation to the earlier application for a standard patent shall be set out in the request to record-

- (i) the application number of the earlier application;
- (ii) the filing date of the earlier application;
- (iii) the date of publication of the request to record of the earlier application;
- (f) the request shall contain such translations of documents and transliteration of names as may be required under section 56 of these Rules;
- (g) the request shall contain a list of the documents comprising the request to record and an indication of the number of sheets of each such document.

Chapter: 514C Title: PATENTS (GENERAL) RULES Gazette Number:

Section: 58 Heading: Applications for the grant of short-term patents under section 113 of the Ordinance Version Date: 30/06/1997

PART IX

APPLICATIONS FOR SHORT-TERM PATENTS

- (1) An application for the grant of a short-term patent made under section 113 or 125 of the Ordinance shall be in the specified form.
- (2) The specification contained in an application for a short-term patent shall state the title of the invention and continue with the description and the claim or claims and drawings, if any, in that order.
- (3) The title shall be short and indicate the matter to which the invention relates.
- (4) The description shall include a list briefly describing the figures in the drawings, if any.
- (5) The application for the grant of a short-term patent shall contain-
 - (a) a search report as prescribed in section 72;
 - (b) the designation of the classification of the invention according to the International Patent Classification up to the subclass level or such other level as the Registrar may specify;
 - (c) in the case of an applicant claiming priority of a previous application under section 111 of the Ordinance, a statement of priority as prescribed by section 69 and a verified copy of the previous application;
 - (d) any request for deferral of the grant of a patent for a specified period under section 119 of the Ordinance;
 - (e) in the case of a claim regarding non-prejudicial disclosure of the invention as referred to in section 109(a) of the Ordinance, a statement to the effect that the invention has been displayed in accordance with that paragraph together with written evidence in support of the statement.
 - (f) any statement required by section 109 of the Ordinance in relation to non-prejudicial disclosure of the invention referred to in paragraph (b) of that section, together with written evidence in support of the statement as prescribed in section 70 of these Rules;
 - (g) the name and address of the inventor or inventors;
 - (h) a list of the documents comprising the application and an indication of the number of sheets of each such document.