

Legislative Council Panel on Commerce and Industry

Commencement Notice of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001, Patents (General) (Amendment) Rules 2004, Registered Designs (Amendment) Rules 2004, and Trade Marks (Amendment) Rules 2004

Introduction

A
B
C & D

This paper seeks Members views on the draft Commencement Notice of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (Annex A) to be made by the Secretary for Commerce, Industry & Technology, as well as the draft Patents (General) (Amendment) Rules 2004 (Annex B), Registered Designs (Amendment) Rules 2004 (Annex C), and Trade Marks (Amendment) Rules 2004 (Annex D), to be made by the Director of Intellectual Property.

Background

2. The Patents Ordinance (Cap. 514) and Registered Designs Ordinance (Cap. 522) with their subsidiary legislation were enacted on 27 June 1997. They established registration systems for patents and designs respectively.

3. In January 2003, the Intellectual Property Department (IPD) began the phased introduction of a new computer system to cater for electronic publication and on-line search of registered trade marks, patents and designs, as well as electronic filing of their corresponding applications and related documents. The first phase of the computer system, which allows on-line search and electronic publication of trade marks, commenced operation in April 2003 when the new Trade Marks Rules (Cap. 559A) came into effect. Electronic filing of documents relating to trade mark registration started in December 2003 in stages.

4. The part of the computer system relating to electronic filing of patent and design applications and related documents will be ready for operation in April/May 2004. It will make available to the public, in stages, the facilities of on-line search of the registers for patents and designs, electronic filing of applications and electronic publication of notifications and advertisements of accepted patents and designs. Similar to that for trade marks, the option to file applications on paper will be maintained for

as long as there remains a significant demand for the paper service. Before the introduction of electronic service, we need to effect some legislative amendments, namely -

- (a) to commence those provisions under the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (the Ordinance) relating to the use of electronic means for the publication of patents and designs and other related notifications; and
- (b) to amend the Patents (General) Rules and Registered Designs Rules (collectively referred to as “the Rules” hereafter) to set out the details concerning the use of electronic means. Under section 149 of the Patents Ordinance and section 79 of the Registered Designs Ordinance, the Registrar of Patents and the Registrar of Designs, (i.e. the Director of Intellectual Property) may make rules to regulate the practice and procedures governing patent and design registrations.

Proposal

5. We propose to commence the relevant sections of the Ordinance and make amendments to the Rules as mentioned in paragraph 4(a) and (b) above in order to enable the use of electronic means in matters related to registrations of patents and designs. We also propose to take the opportunity to amend the Rules to simplify or streamline some of the procedures related to patent and design registrations, and to introduce technical amendments to the Rules and the Trade Marks Rules. Details of the amendments are set out in paragraphs 7 to 16 below.

6. Implementation of electronic filing and processing for patent and design registrations and streamlining the related procedures will enable us to reduce substantially the relevant fees for processing applications for patent and design registrations. We hope that this substantial reduction would increase the incentive for Hong Kong enterprises to register their intellectual property rights, thus adding value to their business.

Commencement of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001

7. We propose to bring into force sections 2(d), 12, 14, part of 19*, 20, 25, 26 and part of 27* of the Ordinance on 7 May 2004. Following the commencement, the Registrar will be empowered to specify, through a gazette notice, an "official journal" for publication of advertisements and notices for patents and designs. The official journal will be in electronic form. At present, both the Patents Ordinance and Registered Designs Ordinance stipulate the Gazette as the only publication in which notifications and advertisements can be made.

Amendments to the Patents (General) Rules and the Registered Designs Rules

8. The proposed amendments to the Rules aim to facilitate electronic service delivery for patent and design registrations and to simplify or streamline some of the existing procedures. The amendments now proposed for electronic operation as well as those for procedural matters largely mirror the corresponding provisions of the new Trade Marks Rules.

9. In brief, the objectives of the present amendments are -
- (a) to provide a legal basis for the electronic filing of documents relating to patent and design registrations;
 - (b) to simplify procedures for filing of documents with the Registrar;
 - (c) to rationalize procedures for serving of documents between parties to proceedings before the Registrar;
 - (d) to reduce or remove the fees for processing applications and

* Sections 19 and 27 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 amend certain provisions of the Patents (General) Rules and Registered Designs Rules by repealing "Gazette" and substituting "Official Journal". The provisions to be amended by these sections include section 93(2) of the Patents (General) Rules and sections 37(2)(b) and 60(3) of the Registered Designs Rules. These three sections will however be amended in the present rules amendment exercise, making the amendments under the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 no longer relevant. Thus the references to these three sections in the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 will have to be excluded from commencement in the present Commencement Notice. We will remove the references from the Intellectual Property (Miscellaneous Amendments) Ordinance through the next omnibus bill of the Statute Law (Miscellaneous Provisions) Bill.

other related matters for patent and design registrations;

- (e) to introduce certain technical amendments to the Patents (General) Rules arising from an ongoing review (details of which are reported in Annex E); and
- (f) to make other technical amendments.

E

These objectives are explained further in the following paragraphs.

To provide a legal basis for the electronic filing of documents relating to patent and design registrations

10. The proposed amendments provide for electronic filing of documents as an alternative to paper filing. Under the proposed amendments, the Registrar will be empowered to specify the terms and conditions for electronic filing of applications for patents or designs, to designate electronic mail boxes which applicants may use to communicate with the Registry and to specify the manner in which documents shall be served on the Registrar. The proposed amendments will also allow the Registrar to determine the form and content of the Registry's documents and records, and the circumstances in which they may be kept or disposed of under the electronic environment.

To simplify procedures for filing of documents with the Registrar

11. A number of proposed amendments aim to simplify existing requirements regarding the number, size and presentation of documents filed to support applications. For instance, we propose to remove the need for an application of a design to be accompanied by six additional copies of the representation of the design. We also propose to relax the format governing how a statement of novelty should appear in a document containing the representation of a design. These requirements are considered no longer necessary in both electronic and paper filing of applications.

To rationalize the procedures for serving of documents between parties to proceedings before the Registrar

12. Under the existing Rules, in any proceedings before the Registrar, the parties involved have to file documents in duplicate or more with the Registrar who will send a copy to all interested parties. Similar to the practice under the new Trade Marks Rules, we propose that one copy of the

documents should be filed with the Registrar and that the person initiating any documents should serve the documents on all interested parties. In the case of unpublished patent applications where the names and addresses of parties having an interest in the application for a patent are notified to the Registrar but are not yet published, the Registrar will serve on such parties the first document filed in the proceedings, and he will also serve all other parties with a list of the names and addresses of those to whom he has sent the documents to facilitate subsequent serving of documents among them.

To reduce or remove the fees for processing applications and other related matters for patent and design registrations

13. Fees for patent and design registrations and other procedures are specified in the two fee schedules to the Rules. We propose to amend these schedules to reduce the fees and remove certain fee items. The table below shows that a successful applicant for a standard patent, short-term patent or design will have to pay much less than what he pays currently for registration. The substantial reduction is made possible by cost savings achieved through computerization and streamlining of procedures.

<i>Registration</i>	<i>Current fees</i>	<i>New fees</i>
<i>Standard patent</i>	\$5,340 (\$2,800 filing fee + \$2,540 advertisement fee in the Government Gazette)	\$896 (\$760 filing fee + \$136 advertisement fee in the e-Official Journal) (Reduced by 83%)
<i>Short-term patent</i>	\$4,070 (\$2,800 filing fee + \$1,270 advertisement fee in the Government Gazette)	\$823 (\$755 filing fee + \$68 advertisement fee in the e-Official Journal) (Reduced by 80%)
<i>Design</i>	\$3,420 (\$1,600 filing fee + \$1,820 advertisement fee in the Government Gazette)	\$940 (\$785 filing fee + \$155 advertisement fee in the e-Official Journal) (Reduced by 73%)

To introduce certain technical amendments to the Patents (General) Rules arising from an ongoing review

14. In *Merck Sharp & Dohme Ltd v Registrar of Patents [2002] 3 HKLRD 812*, the Court of Final Appeal has declared section 39(1) of the Patents (General) Rules to be ultra vires and of no legal effect. We therefore propose to repeal section 39 of the Patents (General) Rules. Arising from this court case, we have also undertaken to review some other provisions in the Patent Ordinance and the Patent (General) Rules, and report the outcome to the Legislative Council Panel on Commerce and Industry. As a result of the review, we have proposed certain amendments to the Patent (General) Rules. For details about the review and proposed amendments, please refer to the information note reporting on the progress of the review at Annex E.

To make other technical amendments

15. We propose to make a number of minor technical amendments to clarify the text of the Rules or to make them consistent with the new Trade Marks Rules. For instance, we propose to add to the Rules a new section which already exists in the Trade Marks Rules specifying that if a deadline expires on the day on which there is an interruption in the normal operations of the Registry, it shall be extended to the next business day. We also propose to amend the relevant provisions of the Rules to help enforce a requirement in the principal ordinances (i.e. the Patents Ordinance and Registered Designs Ordinance) that an agent must either reside or has a place of business in Hong Kong.

Amendments to the Trade Marks Rules

16. The requirement that an agent must either reside or has a place of business in Hong Kong also exists in the new Trade Marks Ordinance. We propose to make similar amendments to the new Trade Marks Rules to reflect this requirement.

Consultation

17. The relevant professional and legal organizations were consulted on a draft of the proposed Rules in October 2003. IPD also published the draft amendment rules on its website for public consultation and met with representatives of organizations which had given comments on the draft amendment rules. There was general support for the introduction of the proposed amendments. Some intellectual property (IP) practitioners have

commented on the wording of certain draft amendments. We have incorporated their comments where appropriate and the proposed rules are acceptable to them.

18. In the course of consultation, a number of IP practitioners raised a suggestion that a registration system be set up for trade mark, patent and registered design agents in the longer term. The suggestion has far-reaching implications and requires in-depth study. Practitioners have accepted that it is more appropriate to study the matter separately. IPD will take forward discussions with practitioners to assess the desirability and practicability of establishing such a regime.

Legislative Timetable

19. We intend to follow the following legislative timetable -

- (a) gazette the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001) (Commencement) Notice 2004 and the amendment rules on 12 March 2004;
- (b) table the Commencement Notice and the amendment rules at the Legislative Council on 17 March 2004; and
- (c) subject to the negative vetting of the Legislative Council, the Commencement Notice and the amendment rules will come into effect on 7 May 2004.

**Commerce and Industry Branch
Commerce, Industry and Technology Bureau
February 2004**

**INTELLECTUAL PROPERTY (MISCELLANEOUS
AMENDMENTS) ORDINANCE 2001 (2 OF 2001)
(COMMENCEMENT) NOTICE 2004**

Under section 1(2) of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001, I appoint 7 May 2004 as the day on which –

- (a) sections 2(d), 12, 14, 20, 25 and 26 of the Ordinance;
- (b) section 19 of the Ordinance, except in so far as it relates to section 93(2) of the Patents (General) Rules (Cap. 514 sub. leg. C); and
- (c) section 27 of the Ordinance, except in so far as it relates to sections 37(2)(b) and 60(3) of the Registered Designs Rules (Cap. 522 sub. leg. A),

shall come into operation.

Secretary for Commerce, Industry and
Technology

2004

PATENTS (GENERAL) (AMENDMENT) RULES 2004

CONTENTS

Section		Page
1.	Commencement	1
2.	Interpretation	1
3.	Section added	
	2A. Specified forms	2
4.	Sections substituted	
	3. References to the Registrar under section 13(1)(a) or (b) of the Ordinance	2
5.	Authorization under section 13(5) of the Ordinance	6
6.	Reference to the Registrar under section 14(5) of the Ordinance	6
7.	Request to record a designated patent application under section 15 of the Ordinance	7
8.	Documents supporting statement of derivation of entitlement to apply	7
9.	Size and presentation of documents	7
10.	Request for registration of designated patent and grant of patent under section 23(1) of the Ordinance	7
11.	Maintenance of application for standard patent under section 33 of the Ordinance	7
12.	Amendment of standard patent under section 43 of the Ordinance	8
13.	Revocation of standard patent under section 44 of the Ordinance	8
14.	Mention of inventor under section 45 of the Ordinance	9
15.	Amendment of specification after grant	9
16.	Surrender of patents	10

17.	Registrar’s power to revoke patent on grounds of “ordre public” or morality under section 49 of the Ordinance	10
18.	Section substituted	
	42. Address for service in respect of patents	10
	42A. Failure to file address for service	12
19.	Alteration of name or address	13
20.	Registration of transactions, etc., in relation to patents and patent applications	13
21.	Correction of errors in patents and applications under section 146 of the Ordinance	13
22.	Request as to payment of renewal fee	13
23.	Sections amended	14
24.	Section substituted	
	52. Order or direction by court	14
25.	The language of proceedings before the Registrar	14
26.	Applications for the grant of short-term patents under section 113 of the Ordinance	15
27.	Size and presentation of documents	15
28.	Procedure where applicant is not the inventor or sole inventor	15
29.	Rectification of deficiencies in short-term patent applications	15
30.	Claiming priority under section 111 of the Ordinance	15
31.	Agents	16
32.	Request for information under section 147 of the Ordinance	17
33.	Restriction on inspection of documents under section 147 of the Ordinance	17
34.	Bibliographic information for purposes of section 147(3) of the Ordinance	18

35.	Section substituted	
	93. Filing of documents with the Registrar	18
	93A. Electronic filing	19
	93B. Terms for electronic filing	19
	93C. Designation of electronic mail box	21
	93D. Service of documents	21
	93E. Form in which the records of the registry are kept, etc.	22
36.	Alteration of time limits	22
37.	Section added	
	100A. Extension of time limits in the case of an interruption in the registry's operations	23
38.	Section substituted	
	102. Verification of documents	23
39.	Application under section 13(4) of the Transitional Rules	23
40.	Section added	
	113. Transitional provision relating to the Patents (General) (Amendment) Rules 2004	24
41.	Micro-organisms	24
42.	Fees	24

PATENTS (GENERAL) (AMENDMENT) RULES 2004

(Made under section 149 of the Patents Ordinance (Cap. 514) with the consent of the Financial Secretary)

1. Commencement

These Rules shall come into operation on the day appointed for the commencement of sections 2(d), 12 and 14 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Interpretation

(1) Section 2(1) of the Patents (General) Rules (Cap. 514 sub. leg. C) is amended, in the definition of “International Patent Classification”, by adding “, as revised or amended from time to time” after “1971”.

(2) Section 2(1) is amended, in the definition of “send”, by adding “, and cognate expressions are to be construed accordingly” after “give”.

(3) Section 2(1) is amended by adding –

““digital signature” (數碼簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic record” (電子紀錄) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic signature” (電子簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“information system” (資訊系統) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);”.

(4) Section 2(2)(a) is repealed.

(5) Section 2(2)(b) is repealed and the following substituted –

“(b) reference to the filing of a document or other thing with the Registrar, or reference to the filing of a document or other thing without an indication of the place at which or person with whom it is to be filed, shall be construed as a

reference to the filing of the document or thing with the Registrar in accordance with sections 93, 93A, 93B and 93C;”.

3. Section added

The following is added immediately after section 2 –

“2A. Specified forms

A requirement to use a specified form is satisfied by the use of either –

- (a) a replica of the specified form; or
- (b) a form acceptable to the Registrar,

that contains the information required by the specified form and complies with any directions of the Registrar as to the use of the specified form or replicas of it.”.

4. Sections substituted

Sections 3 and 4 are repealed and the following substituted –

“3. References to the Registrar under section 13(1)(a) or (b) of the Ordinance

(1) A reference to the Registrar under section 13(1)(a) or (b) of the Ordinance shall –

- (a) be in the specified form;
- (b) be accompanied by a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or relief sought; and
- (c) be accompanied by the prescribed fee.

(2) In the case of a reference under section 13(1)(a) of the Ordinance, the person making the reference shall, at the same time as he

files it, send a copy of the reference and statement to each of the following persons (not being a party to the reference) –

- (a) each person who is alleged in the reference to be entitled to apply for the grant of a standard patent for the invention that is the subject of the reference;
- (b) each person whom the person making the reference believes to be the inventor or joint inventor of that invention; and
- (c) if an application for a standard patent for that invention has been published before the reference is filed, each person who is shown in the register as having a right in or under that application.

(3) In the case of a reference under section 13(1)(b) of the Ordinance, the person making the reference shall, at the same time as he files it, send a copy of the reference and statement –

- (a) to each joint proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order or the granting of the relief sought;
- (b) to each of the following persons (not being a party to the reference) –
 - (i) each person to whom it is alleged in the reference any right in or under the application should be transferred or granted; and
 - (ii) each person whom the person making the reference believes to be the inventor or joint inventor of the invention that is the subject of the reference; and
- (c) if an application for a standard patent for that invention has been published before the reference is

filed, to each person who is shown in the register as having a right in or under that application.

(4) The person making the reference shall attach to each copy of the reference and statement he sends under subsection (2) or (3), as the case may be, a notice containing the names and addresses of all persons to whom a copy of the reference and statement is being sent under that subsection, and he shall notify the Registrar of the names and addresses of those persons.

(5) In addition, if an application for a standard patent for the invention that is the subject of a reference under section 13(1)(a) or (b) of the Ordinance has been filed but the application has not been published before the reference is filed, the Registrar shall send a copy of the reference and statement to each of the following persons (not being a party to the reference or a person to whom copies have been sent under subsection (2) or (3), as the case may be) –

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

(6) The Registrar shall send a notice containing the names and addresses of all persons to whom copies of the reference and statement have been sent under subsection (5) to –

- (a) each person to whom copies have been sent under that subsection;
- (b) the person making the reference; and
- (c) each person whose name and address has been notified to the Registrar under subsection (4).

(7) Any person who is sent a copy of the reference and statement under subsection (2), (3) or (5) and who wishes to oppose the making of the

order or the granting of the relief sought ("the opponent") shall, within 3 months from the date on which the copies are sent to him, file a counter-statement which shall be in the specified form, shall set out fully the grounds of opposition and shall be accompanied by the prescribed fee.

(8) The opponent shall, at the same time as he files the counter-statement, send a copy of it to each of the following persons (not being a party to the counter-statement) –

- (a) the person making the reference;
- (b) each person whose name and address has been notified to him under subsection (4); and
- (c) each person whose name and address has been notified to him under subsection (6).

(9) The person making the reference and any other person to whom a copy of the counter-statement is sent under subsection (8) may, within 3 months from the date on which it is sent to him, file evidence in support of his case and, if he files such evidence, he shall send a copy of it –

- (a) to the opponent; and
- (b) where the evidence is filed by such other person, to the person making the reference.

(10) Within 3 months from the date on which a copy of evidence is sent to the opponent under subsection (9) or, if no such evidence is filed under that subsection, within 3 months from the expiry of the time within which evidence might have been filed, the opponent may file evidence in support of his case and, if he files such evidence, he shall send a copy of it to –

- (a) the person making the reference; and
- (b) any other person who has filed the evidence under subsection (9).

(11) The person making the reference and any other person to whom a copy of the opponent's evidence is sent under subsection (10) may, within 3 months from the date on which the copy is sent to him, file further evidence confined to matters strictly in reply to the opponent's evidence and, if he files such further evidence, he shall send a copy of it –

- (a) to the opponent; and
- (b) where the further evidence is filed by such other person, to the person making the reference.

(12) No further evidence shall be filed except by leave or direction of the Registrar.

(13) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.”.

5. Authorization under section 13(5) of the Ordinance

- (1) Section 6(1)(a) is amended by repealing “and be filed in duplicate”.
- (2) Section 6(1)(b) is amended by repealing “in duplicate”.
- (3) Section 6(2) is amended by repealing “The Registrar shall” and substituting “The applicant shall, at the same time as he files the application,”.

6. Reference to the Registrar under section 14(5) of the Ordinance

- (1) Section 7(1)(a) is amended by repealing “and be filed in duplicate”.
- (2) Section 7(1)(b) is amended by repealing “in duplicate”.
- (3) Section 7(2) is amended by repealing “The Registrar shall” and substituting “The person making the reference shall, at the same time as he files the reference,”.
- (4) Section 7(4)(a) is amended by repealing “, shall be filed in duplicate”.

(5) Section 7(4)(b) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “The recipient shall, at the same time as he files the counter-statement, send a copy of it”.

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

Section 8(2)(a)(i) is amended by repealing “in duplicate, and one of those duplicate copies shall be in loose leaf form”.

8. Documents supporting statement of derivation of entitlement to apply

Section 9(a)(i) is amended by repealing “certified”.

9. Size and presentation of documents

(1) Section 12(1)(a) is amended –

- (a) by repealing “direct”;
- (b) by adding “and” at the end.

(2) Section 12(5) and (6) is repealed.

(3) Section 12(7) is amended by repealing “; and such numbering shall be placed at the top of the sheet, in the middle, but not in the top margin”.

(4) Section 12(8) is repealed.

10. Request for registration of designated patent and grant of patent under section 23(1) of the Ordinance

Section 19(2)(a) is amended by repealing “loose leaf form” and substituting “accordance with section 12 of these Rules”.

11. Maintenance of application for standard patent under section 33 of the Ordinance

(1) Section 28(1) is amended by repealing “and be signed by the applicant”.

(2) Section 28(3) is amended by adding “供送達文件的” after “紀錄冊的”.

12. Amendment of standard patent under section 43 of the Ordinance

(1) Section 35(1) is amended by repealing “3 months” and substituting “6 months”.

(2) Section 35(2) is repealed and the following substituted –

“(2) A filing of documents with the Registrar for the purposes of section 43(1) of the Ordinance shall be made by filing –

(a) a verified copy of –

(i) the amended specification; or

(ii) the amending order;

(b) a notice of the amendment in the specified form; and

(c) such translations of the documents filed under paragraph (a) as may be required under section 56 of these Rules.”.

13. Revocation of standard patent under section 44 of the Ordinance

(1) Section 37(2)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 37(4) is repealed and the following substituted –

“(4) A person who files an application under section 44(4) of the Ordinance shall, at the same time, send a copy of the application and any evidence and translation accompanying the application to every person registered as proprietor of the patent and to every other person who is shown in the register as having a right in or under the patent.”.

(3) Section 37(5) is amended by repealing “in duplicate”.

(4) Section 37(6) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “The recipient shall, at the same time as he files the counter-statement, send a copy of it”.

14. Mention of inventor under section 45 of the Ordinance

(1) Section 38(2)(b) is amended by repealing “in duplicate”.

(2) Section 38(3) is repealed and the following substituted –

“(3) A person who files an application under subsection (1) or a request under section 45(2) of the Ordinance shall, at the same time, send a copy of the application or request and any statement accompanying it to –

- (a) every person registered as proprietor of the patent other than the applicant or person making the request;
- (b) every person who has been identified in the patent as the inventor or a joint inventor of the invention;
- (c) every person who has been identified in the statement referred to in subsection (2)(b) as the inventor or a joint inventor of the invention; and
- (d) every other person who is shown in the register as having a right in or under the patent.”.

(3) Section 38(5)(a) is amended by repealing “, shall be filed in duplicate”.

(4) Section 38(5)(b) is amended by repealing “The Registrar shall send a copy of the counter-statement” and substituting “A person who files a counter-statement shall, at the same time, send a copy of it”.

15. Amendment of specification after grant

Section 39 is repealed.

16. Surrender of patents

(1) Section 40(3)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 40(3)(b) is amended by repealing “in duplicate”.

(3) Section 40(3) is amended by repealing “Registrar shall” and substituting “opponent shall, at the same time as he files the notice,”.

(4) Section 40(4)(a) is amended by repealing “and be filed in duplicate”.

(5) Section 40(4) is amended by repealing “Registrar” and substituting “proprietor”.

17. Registrar’s power to revoke patent on grounds of “ordre public” or morality under section 49 of the Ordinance

(1) Section 41(1)(a) is amended by repealing “and be filed in duplicate”.

(2) Section 41(1)(b) is amended by repealing “in duplicate”.

(3) Section 41(2) is amended by repealing “The Registrar shall” and substituting “The applicant shall, at the same time as he files the reference,”.

(4) Section 41(3)(a) is amended by repealing “and be filed in duplicate”.

(5) Section 41(3) is amended by repealing “Registrar” and substituting “proprietor”.

18. Section substituted

Section 42 is repealed and the following substituted –

“42. Address for service in respect of patents

(1) Every person concerned in any proceedings before the Registrar shall file an address for service.

(2) The address for service must be a residential or business address in Hong Kong.

(3) A person may file an address for service –

(a) where the person files any specified form that requires the person who completes it to provide an address for service, by filing the specified form with the address for service stated on it; or

(b) in any other case, by notifying the Registrar in writing.

(4) Where a specified form referred to in subsection (3)(a) is filed in the name of 2 or more persons, the address for service stated on that form shall be treated as the address for service of each of those persons.

(5) An applicant for a patent or the proprietor of a patent may use only one address for service for the purposes of all proceedings before the Registrar concerning that application or patent.

(6) Subject to any filing to the contrary under this section, on the grant of an application for a patent, the address for service of the applicant shall be treated as the address for service of the proprietor of the patent for the purposes of all proceedings before the Registrar concerning that patent.

(7) Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings.

(8) Where, after a person has become a party to proceedings before the Registrar, the person appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file an address for service.

(9) No act required or authorized by the Ordinance or these Rules to be done by or to a person referred to in subsection (8) in connection with the proceedings in question may be done by or to the newly appointed agent before the date on which he files an address for service.

(10) Any person may withdraw his address for service by notifying the Registrar in writing.

42A. Failure to file address for service

(1) Where an address for service is not filed as required by section 42, or where the Registrar is satisfied that the address for service of the proprietor of a patent or a party to any proceedings before the Registrar is no longer valid, the Registrar may send to the person concerned, at any of the addresses referred to in subsection (2), a notice to file an address for service.

(2) For the purposes of subsection (1), the addresses are –

- (a) any previously filed address for service of the person;
- (b) any address of the person in Hong Kong that is shown in the register;
- (c) any residential or business address of the person in Hong Kong; and
- (d) any other address of the person that is known to the Registrar.

(3) If any person to whom a notice is sent under subsection (1) fails to file an address for service within 2 months after the date of the notice –

- (a) any application (other than an application for a patent), notice or request filed by that person shall be treated as abandoned or withdrawn; and
- (b) the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party (other than as an applicant for a patent).

(4) This section is without prejudice to the operation of sections 17 and 68.”.

19. Alteration of name or address

Section 45(3) is amended by repealing “in the specified form” and substituting “made in the specified form or by notice in writing”.

20. Registration of transactions, etc., in relation to patents and patent applications

Section 46(2)(a) is amended by adding “or on behalf of” before “the assignor”.

21. Correction of errors in patents and applications under section 146 of the Ordinance

(1) Section 48(5) is amended by repealing “and be filed in duplicate”.

(2) Section 48(6) is repealed and the following substituted –

“(6) The opponent shall, at the same time as he files the notice, send a copy of the notice and the statement to the person making the request.

(6A) If the person making the request desires to proceed with the request, he shall, within 3 months from the date of the sending of the copies to him –

- (a) file a counter-statement in the specified form setting out fully the grounds on which he contests the opposition;
- (b) pay the prescribed fee; and
- (c) send a copy of the counter-statement to the opponent.”.

22. Request as to payment of renewal fee

Section 49 is repealed.

23. Sections amended

Sections 51(3) and 90(2) are amended by repealing “rule” and substituting “section”.

24. Section substituted

Section 52 is repealed and the following substituted –

“52. Order or direction by court

(1) Where the court makes any order or gives any direction under any provision of the Ordinance except section 46 or 102 of the Ordinance, the person in whose favour the order or direction is made or given shall file a sealed copy of the order or direction with the Registrar.

(2) Where the court makes any order under section 46 or 102 of the Ordinance, the person in whose favour the order is made shall file with the Registrar a copy of any documents referred to in the order that show the amendments to be made, together with such translations of those documents as may be required under section 56 of these Rules.

(3) The document and translations referred to in subsection (2) shall be filed at such time as a copy of the order is filed with the Registrar in accordance with the order or directions made by the court or rules of court.”.

25. The language of proceedings before the Registrar

(1) Section 56(1) is amended by repealing “such translation to be certified to the satisfaction of the Registrar as corresponding to the original text” and substituting “and such translation shall state the name of the translator and his official capacity, if any”.

(2) Section 56(2)(c) is amended by adding “or in Chinese characters” after “if not in the Roman alphabet”.

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

- (1) Section 58(5)(b) is repealed.
- (2) Section 58(5)(c) is amended by repealing “verified”.

27. Size and presentation of documents

- (1) Section 62(1)(a) is amended by repealing “direct”.
- (2) Section 62(5) and (6) is repealed.
- (3) Section 62(7) is amended by repealing “and such numbering shall be placed at the top of the sheet, in the middle, but not in the top margin”.
- (4) Section 62(8) is repealed.
- (5) Section 62(15) is amended by repealing “rule” and substituting “section”.

28. Procedure where applicant is not the inventor or sole inventor

Section 65(b) is repealed and the following substituted –

- “(b) the Registrar shall send a copy of the statement to each inventor who is not one of the applicants.”.

29. Rectification of deficiencies in short-term patent applications

Section 68(1) is amended by repealing “verified”.

30. Claiming priority under section 111 of the Ordinance

- (1) Section 69(3) is repealed and the following substituted –

“(3) The copy of the previous application as referred to in section 111(1) of the Ordinance shall be accompanied by a copy of a certificate issued by the authority that received the application and that states the date of filing of the application.”.

(2) Section 69(5) is amended by repealing “, instead of filing a verified copy of the previous application,”.

31. Agents

Section 85(4) and (5) is repealed and the following substituted –

“(4) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, which notice shall be given in the specified form or in writing.

(5) If a person who has given notice under subsection (4) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing.

(6) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subsection (4).

(7) The Registrar may refuse to recognize as an agent in respect of any business under the Ordinance or these Rules –

- (a) a person who has been convicted of a criminal offence;
- (b) a person whose name has been struck off the roll of barristers or roll of solicitors kept under and in accordance with the Legal Practitioners Ordinance (Cap. 159) or any person who has been suspended from acting as a barrister or solicitor;
- (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar

could refuse to recognize as an agent under paragraph (a) or (b);

- (d) a person against whom a disqualification order has been made under section 168E, 168F, 168G, 168H, 168J or 168L of the Companies Ordinance (Cap. 32);
- (e) a person against whom an order has been made under section 23(1)(a) or 24(1) of the repealed Securities (Insider Dealing) Ordinance (Cap. 395); or
- (f) a person against whom an order has been made under section 214(2)(d), 257(1)(a), 258(1) or 303(2)(a) of the Securities and Futures Ordinance (Cap. 571).

Note: Section 140(4) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.”.

32. Request for information under section 147 of the Ordinance

Section 88(2) is amended by repealing “and shall be accompanied by the prescribed fee”.

33. Restriction on inspection of documents under section 147 of the Ordinance

Section 89(1) is amended –

- (a) in paragraph (d), by repealing “49, 50(2), 51(2) or 88” and substituting “50(2), 51(2) or 88 of these Rules”;
- (b) in paragraph (e), by repealing “and” at the end;
- (c) in paragraph (f), by repealing the full stop and substituting “; and”;
- (d) by adding –

“(g) subject to the restrictions prescribed in paragraphs (a) to (f), only documents kept by the registry shall be open to inspection.”.

34. Bibliographic information for purposes of section 147(3) of the Ordinance

Section 91 is amended by adding –

- “(ca) the address for service relating to the application;
- (cb) if the application has been filed by an agent, the name of the agent and the address in Hong Kong where he resides or carries on his business activities;
- (cc) the name and address of any person whose name and address the Registrar is required to communicate to any other person under section 3;”.

35. Section substituted

Section 93 is repealed and the following substituted –

“93. Filing of documents with the Registrar

(1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered by hand to the Registrar at the registry during the normal business hours of the registry or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the registry.

(3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the registry and is recorded as received.

93A. Electronic filing

(1) The Registrar may at his discretion permit, as an alternative to the filing of a document or other thing with the Registrar in a paper or other physical form, the filing of an electronic record of that document or thing.

(2) The Registrar may at his discretion permit, as an alternative to delivering or sending a document or other thing to the Registrar in the manner provided by section 93, the sending of an electronic record of that document or thing by electronic means to an information system designated by the Registrar.

(3) The filing of an electronic record, and the sending of an electronic record by electronic means to the information system designated under subsection (2), shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person desiring to file an electronic record or to send an electronic record to the Registrar by electronic means.

(4) Where, in accordance with this section, a document or other thing in the form of an electronic record is sent by electronic means to the information system designated under subsection (2), the filing of that document or thing shall be deemed to be effected at such time as that electronic record is accepted by the designated information system.

93B. Terms for electronic filing

(1) Without limiting the generality of section 93A(3), the Registrar may specify terms under that section –

- (a) providing for the approval by the Registrar of the process that must be used to make or send an electronic record;

- (b) providing for the approval by the Registrar of the format or media in which an electronic record must be recorded or stored;
- (c) respecting the manner of authenticating an electronic record in circumstances where the document or other thing in question is required to be signed or sealed or authenticated in any manner;
- (d) requiring any document or other thing sent to the Registrar in the form of an electronic record to include or be accompanied by the electronic signature or digital signature of the person who sends it; and
- (e) respecting the manner of filing a document or other thing in cases where there is an interruption in the operation of the information system designated under section 93A(2).

(2) Without limiting the generality of section 93A(3), the Registrar may refuse to accept or to register any document or other thing that is in the form of an electronic record if –

- (a) the information contained in the electronic record is not capable of being displayed in a legible form;
- (b) the electronic record is not capable of being stored in the information system designated under section 93A(2);
- (c) the electronic record appears to the Registrar to be altered, damaged or incomplete;
- (d) any electronic signature or digital signature or other kind of authentication accompanying or included with the electronic record appears to the Registrar to be altered or incomplete; or

- (e) any term specified by the Registrar under that section has been breached.

93C. Designation of electronic mail box

(1) On the request of any person, the Registrar may designate an electronic mail box within an information system designated by the Registrar which may be used by that person to communicate with the Registrar.

(2) The use by any person of an electronic mail box within the designated information system shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person for whom the electronic mail box is designated.

(3) Where the Registrar designates an electronic mail box for a person under this section, any document or other thing required or authorized by the Ordinance or these Rules to be sent by the Registrar to that person shall be deemed to be properly sent if it is sent in the form of an electronic record to that person's designated electronic mail box.

(4) Sending to a designated electronic mail box shall be deemed to be effected at such time as the electronic record is accepted by the designated information system.

(5) An electronic record sent to a designated electronic mail box shall be deemed to be received by the addressee at such time as the electronic record is accepted and recorded by that electronic mail box.

93D. Service of documents

(1) Except as provided by sections 93, 93A, 93B and 93C, where any document or other thing is required or authorized by the Ordinance or these Rules to be sent to any person –

- (a) the document or other thing may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document or other thing may be sent by post to his last known address.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the address for service of the person or, if he does not have an address for service, at his last known address, and unless the contrary is shown, the document or thing shall be deemed to have been received by that person at the time when the letter would be delivered in the ordinary course of post.

93E. Form in which the records of the registry are kept, etc.

(1) The Registrar shall determine the form in which the records of the registry are constituted and kept and may determine the period for which such records, or any document or other thing kept by the registry, shall be kept and the circumstances in which they may be destroyed or otherwise disposed of.

(2) Where the Registrar keeps a record of a document or other thing in a form that differs from that in which the document or thing was originally filed with, or originally generated by, the Registrar, the record of that document or thing shall be presumed, unless the contrary is shown, to accurately represent the information contained in the document or thing as originally filed or generated.”.

36. Alteration of time limits

Section 100(2) is amended by repealing “39(1),”.

37. Section added

The following is added –

“100A. Extension of time limits in the case of an interruption in the registry’s operations

(1) Where on any day there is an event or circumstances causing an interruption in the normal operation of the registry, the Registrar may notify the day as being one on which there is an interruption in the operations of the registry.

(2) Where any period of time specified in the Ordinance or these Rules, or as extended under these Rules, for the filing of any document or other thing with the Registrar expires on a day so notified, the period shall be extended to the first day next following (not being an excluded day) that is not so notified.

(3) Any notification given by the Registrar under this section shall be posted in the registry.

(4) In this section, “excluded day” (非辦公日) means a day that is not a business day of the registry.”.

38. Section substituted

Section 102 is repealed and the following substituted –

“102. Verification of documents

For the purposes of the Ordinance and these Rules, a filed copy of a document shall be treated as a verified copy if the person filing it confirms in writing to the Registrar that it is a true copy of a document issued by or kept at the relevant designated patent office.”.

39. Application under section 13(4) of the Transitional Rules

(1) Section 108(1) is amended by repealing “and shall be filed in duplicate”.

(2) Section 108(2) is amended by repealing “The Registrar shall send a copy of the application” and substituting “The applicant shall, at the same time as he files the application, send a copy of it”.

(3) Section 108(3) is amended by repealing “Registrar” and substituting “opponent”.

(4) Section 108(4) is amended by repealing “, shall be filed in duplicate”.

40. Section added

The following is added –

**“113. Transitional provision relating to the
Patents (General) (Amendment) Rules
2004**

The amendments to sections 3, 4, 6, 7, 35, 37, 38, 40, 41, 48 and 108 of these Rules effected by sections 4, 5, 6, 12, 13, 14, 16, 17, 21 and 39 of the Patents (General) (Amendment) Rules 2004 (L.N. of 2004) do not apply to proceedings pending before the Registrar on the commencement of those sections, which proceedings shall continue as if those amendments had not been made.”

41. Micro-organisms

(1) Schedule 1 is amended, in paragraph 2(1), by repealing “and shall be filed in quadruplicate”.

(2) Schedule 1 is amended, in paragraph 2(2), by repealing “copies of the forms” and substituting “a copy of the form”.

42. Fees

Schedule 2 is amended –

- (a) in Fee No. 1, in the third column, by repealing “700” and substituting “190”;
- (b) in Fee No. 2 –

- (i) in the second column, by repealing “3(4), 4(4)” and substituting “3(7)”;
 - (ii) in the second column, by repealing “48(5) or (6)” and substituting “48(5) or (6A)”;
 - (iii) in the third column, by repealing “1,200” and substituting “325”;
- (c) in Fee No. 3, in the third column, by repealing “700” and substituting “190”;
- (d) in Fee Nos. 4 and 5, in the third column, by repealing “1,400” and substituting “380”;
- (e) in Fee No. 6, in the third column, by repealing “2,800” and substituting “755”;
- (f) in Fee No. 7 –
 - (i) in the second column, by adding “, under section 15 or 23 of the Ordinance” after “grant”;
 - (ii) in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette.” and substituting “68”;
- (g) in Fee No. 8 –
 - (i) in the second column, by adding “under section 113 of the Ordinance” after “patent”;
 - (ii) in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette.” and substituting “68”;
- (h) in Fee No. 9 –
 - (i) in the second column, by adding “, under section 11 or 21” after “grant”;

- (ii) in the third column, by repealing “350” and substituting “95”;
- (i) in Fee No. 10 –
 - (i) in the second column, by adding “under section 68(6)” after “patent”;
 - (ii) in the third column, by repealing “350” and substituting “95”;
- (j) in Fee No. 11 –
 - (i) in the second column, by adding “under section 33 of the Ordinance” after “patent application”;
 - (ii) in the third column, by repealing “1,000” where it twice appears and substituting “270”;
- (k) in Fee No. 12, in the third column, by repealing “350” and substituting “95”;
- (l) in Fee No. 13 –
 - (i) in the second column, by adding “under section 39 of the Ordinance” after “patent”;
 - (ii) in the third column, by repealing “2,000” where it twice appears and substituting “540”;
- (m) in Fee No. 14, in the third column, by repealing “1,000” and substituting “270”;
- (n) in Fee No. 15 –
 - (i) in the second column, by adding “under section 126 of the Ordinance” after “patent”;
 - (ii) in the third column, by repealing “4,000” substituting “1,080”;
- (o) in Fee No. 16, in the third column, by repealing “1,000” and substituting “270”;
- (p) in Fee Nos. 17 and 18, in the third column, by repealing “1,500” wherever it appears and substituting “405”;

- (q) in Fee No. 19, in the third column, by repealing “500” and substituting “135”;
- (r) in Fee No. 20, in the third column, by repealing “700” where it twice appears and substituting “190”;
- (s) in Fee No. 21, in the third column, by repealing “1,200” and substituting “325”;
- (t) in Fee No. 22, in the third column, by repealing “500” and substituting “135”;
- (u) by repealing Fee Nos. 23 and 24;
- (v) in Fee No. 25, in the third column, by repealing “800” and substituting “215”;
- (w) in Fee Nos. 26 and 27, in the third column, by repealing “700” and substituting “190”;
- (x) in Fee Nos. 28 and 29, in the third column, by repealing “350” wherever it appears and substituting “95”.

Registrar of Patents

2004

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg. C) (“the principal Rules”) to facilitate the electronic filing and processing of patent applications, to streamline the procedures in the Patents Registry (“the registry”), to reduce the fees payable on the filing of documents with the registry and to delete obsolete provisions. The amendments relating to electronic filing and

processing are in furtherance of the amendments made to the Patents Ordinance (Cap. 514) (“the Ordinance”) by the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Section 2(1) and (2) makes technical amendments to the definitions of “International Patent Classification” and “send” in section 2(1) of the principal Rules. Section 2(3) adds the new definitions of “digital signature”, “electronic record”, “electronic signature” and “information system”. The terms are used in the new sections 93A, 93B and 93C which are added by section 35 of these Rules. Section 2(4) and (5) repeals section 2(2)(a) and amends section 2(2)(b) of the principal Rules in consequence of the addition of the new sections 93A, 93B and 93C.

3. Section 3 adds the new section 2A to the principal Rules which will enable the Registrar of Patents (“the Registrar”) to accept electronic forms.

4. Section 4 replaces sections 3 and 4 of the principal Rules with a new section that consolidates the provisions of the two existing sections, with revisions. The new section 3 omits the requirement for certain documents to be filed in duplicate and requires the party initiating the proceedings, instead of the Registrar, to serve certain documents on interested parties.

5. Sections 5, 6, 13, 14, 16, 17, 21 and 39 amend sections 6, 7, 37, 38, 40, 41, 48 and 108 of the principal Rules to delete the requirements for certain documents to be filed in duplicate and to require the party initiating the proceedings, instead of the Registrar, to serve certain documents on interested parties.

6. Section 7 amends section 8(2)(a)(i) of the principal Rules to delete the requirement for the documents required under section 15(2)(a) of the Ordinance to be filed in duplicate.

7. Sections 8, 9, 10 and 27 amend sections 9, 12, 19 and 62 of the principal Rules to delete obsolete provisions relating to the form of documents.

8. Section 11(1) amends section 28(1) of the principal Rules to delete the requirement for a maintenance application to be signed by the applicant. Section

11(2) makes a technical amendment to the Chinese text of section 28(3) of the principal Rules.

9. Section 12(1) changes the time limit in section 35(1) of the principal Rules from 3 months to 6 months. Section 12(2) amends section 35(2) of the principal Rules. The amended section consolidates the requirements under section 43(1) of the Ordinance and adds a new requirement that the documents filed under that section be accompanied by a specified form and with such translations as may be required under section 56 of the principal Rules.

10. Section 15 repeals section 39 of the principal Rules. Section 36 makes a related consequential amendment to section 100(2) of the principal Rules.

11. Section 18 replaces section 42 of the principal Rules with two new provisions relating to addresses for service. The new section 42 requires a person who is concerned in any proceedings before the Registrar to file an address for service, which must be a residential or business address in Hong Kong, and provides for the manner of filing or withdrawing an address for service and for related matters. The new section 42A deals with the failure to file an address for service.

12. Section 19 amends section 45(3) of the principal Rules to allow the person making the request the option of filing a notice in writing instead of a specified form.

13. Section 20 amends section 46(2)(a) of the principal Rules to allow the application or notice for registration to be signed by a person on behalf of the assignor.

14. Section 22 repeals section 49 of the principal Rules.

15. Section 23 makes a technical amendment to sections 51(3) and 90(2) of the principal Rules.

16. Section 24 replaces section 52 of the principal Rules with a new provision that requires a person in whose favour any order or direction has been made or given by the court under any provision of the Ordinance (except section 46 or 102 of the Ordinance) to file a sealed copy of the order or direction with the

Registrar and, in the case of an order made under section 46 or 102 of the Ordinance, a copy of other specified documents.

17. Section 25(1) amends section 56(1) of the principal Rules to delete the requirement for the translation to be certified and to require that the name and official capacity of the translator be given instead. Section 25(2) amends section 56(2)(c) of the principal Rules to delete the requirement for a transliteration of the name of the applicant if that name is in Chinese characters.

18. Section 26(1) repeals section 58(5)(b) of the principal Rules which requires an application for the grant of a short-term patent to contain the designation of the classification of the invention. Section 26(2) amends section 58(5)(c) of the principal Rules to delete the requirement for a verified copy of the previous application.

19. Sections 28 and 41 amend section 65(b) and paragraph 2 of Schedule 1 of the principal Rules, respectively, to delete the requirement for additional copies of the specified form.

20. Section 29 amends section 68(1) of the principal Rules to delete the requirement for a verified copy of the document.

21. Section 30 amends section 69(3) and (5) of the principal Rules to allow a copy of the certificate to be filed instead of the original and to delete the requirement for a verified copy of the previous application.

22. Section 31 amends section 85 of the principal Rules to require an agent to notify the Registrar of the address in Hong Kong where he resides or carries on his business activities and to revise the list of persons whom the Registrar may refuse to recognize as an agent.

23. Section 32 deletes the reference to the prescribed fee in section 88(2) of the principal Rules.

24. Section 33 adds section 89(1)(g) to the principal Rules to make clear that only documents that are kept by the registry are open to inspection. It also amends section 89(1)(d) in consequence of the repeal of section 49 of the principal Rules (see section 22 of these Rules).

25. Section 34 amends section 91 of the principal Rules to allow the Registrar to disclose under section 147(3) of the Ordinance the address for service and other specified bibliographic information relating to an unpublished application for a standard patent or short-term patent.
26. Section 35 replaces section 93 of the principal Rules with new provisions governing the filing and service of documents and the keeping of records by the Registrar. The new section 93 provides for documents to be delivered by hand or sent by post to the Registrar. The new sections 93A and 93B provide for the electronic filing of documents and enable the Registrar to specify the terms for electronic filing in the official journal. The new section 93C enables the Registrar to designate an electronic mail box which may be used by the person for whom it is designated to communicate with the Registrar. The new section 93D specifies the manner in which documents shall be served. The new section 93E allows the Registrar to determine the form and content of the registry's records and the circumstances in which records and documents may be disposed of.
27. Section 37 adds the new section 100A to the principal Rules which provides that if a deadline expires on the day on which there is an interruption in the normal operations of the registry, it shall be extended to the next business day.
28. Section 38 revises section 102 of the principal Rules to allow the person filing the document to confirm in writing to the Registrar that it is a true copy of a document issued by or kept at the relevant designated patent office.
29. Section 40 adds the new section 113 to the principal Rules which provides that the amendments to sections 3, 4, 6, 7, 35, 37, 38, 40, 41, 48 and 108 do not apply to proceedings pending on the commencement of those amendments.
30. Section 42 reduces certain fees set out in Schedule 2 to the principal Rules and makes technical amendments to some of the fee descriptions.

REGISTERED DESIGNS (AMENDMENT) RULES 2004

CONTENTS

Section		Page
1.	Commencement	1
2.	Interpretation	1
3.	Section added	
	2A. Specified forms	2
4.	Form and contents of applications	2
5.	Representations	2
6.	Statement of novelty	2
7.	Statement of priority, etc.	3
8.	Withdrawal of applications	3
9.	Transactions affecting rights in registered designs	3
10.	Reference	3
11.	Notice of opposition	3
12.	Counter-statement	3
13.	Evidence in support of opposition	4
14.	Sections amended	4
15.	Correction of errors in Register	4
16.	Inspection of Register	4
17.	Information and inspection of documents	4
18.	Section added	
	55A. Form in which the records of the Registry are kept, etc.	5
19.	Publication of business hours and business days of the Registry	5
20.	Subheading substituted	5
21.	Translation of documents	6

22.	Sections substituted	
	60. Filing of documents with the Registrar	6
	60A. Electronic filing	6
	60B. Terms for electronic filing	7
	60C. Designation of electronic mail box	8
	61. Service of documents	9
23.	Correction of errors in filed documents	10
24.	Section substituted	
	65. Address for service	10
	65A. Failure to file address for service	11
25.	Alteration or correction of address	12
26.	Recognition of agents	12
27.	Section added	
	73A. Extension of time limits in the case of an interruption in the Registry's operations	14
28.	Fees	14

REGISTERED DESIGNS (AMENDMENT) RULES 2004

(Made under section 79 of the Registered Designs Ordinance
(Cap. 522) with the consent of the Financial Secretary)

1. Commencement

These Rules shall come into operation on the day appointed for the commencement of sections 20, 25 and 26 of the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Interpretation

(1) Section 2(1) of the Registered Designs Rules (Cap. 522 sub. leg. A) is amended, in the definition of “send”, by adding “, and cognate expressions are to be construed accordingly” after “give”.

(2) Section 2(1) is amended by adding –

““digital signature” (數碼簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic record” (電子紀錄) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“electronic signature” (電子簽署) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);

“information system” (資訊系統) has the meaning assigned by section 2(1) of the Electronic Transactions Ordinance (Cap. 553);”.

(3) Section 2(2)(c) is repealed and the following substituted –

“(c) to the filing of a document or other thing shall, unless the context otherwise requires, be construed as a reference to the filing of the document or thing with the Registrar in accordance with sections 60, 60A, 60B and 60C.”.

3. Section added

The following is added immediately after section 2 –

“2A. Specified forms

A requirement to use a specified form is satisfied by the use of either –

- (a) a replica of the specified form; or
- (b) a form acceptable to the Registrar,

that contains the information required by the specified form and complies with any directions of the Registrar as to the use of the specified form or replicas of it.”.

4. Form and contents of applications

(1) Section 6(2)(b) is amended by repealing “sections 7 and 8” and substituting “section 7”.

(2) Section 6(3)(c) is repealed and the following substituted –

“(c) a statement of novelty, in accordance with section 8;”.

(3) Section 6(3)(e) is amended by adding “or in Chinese characters” after “letters”.

5. Representations

(1) Section 7(1) is repealed and the following substituted –

“(1) The representation of the design included with the application may be either a drawing or a photograph and shall be of a size of not more than 210 mm by 297 mm.”.

(2) Section 7(3) is repealed and the following substituted –

“(3) The Registrar may at any time require the applicant to file additional copies of the representation.”.

6. Statement of novelty

(1) Section 8(1) is amended by repealing “appear on each representation of the design filed under sections 6 and 7,” and substituting “be included in the application filed under section 6”.

(2) Section 8(2) and (3) is repealed.

7. Statement of priority, etc.

Section 11(2) is amended by adding “copy of a” before “certificate”.

8. Withdrawal of applications

Section 17 is amended by repealing “on the specified form” and substituting “in writing and shall state the application number of the application being withdrawn”.

9. Transactions affecting rights in registered designs

Section 33(3)(a) is amended by repealing “the assignee and”.

10. Reference

(1) Section 37(1) is amended by repealing “in duplicate”.

(2) Section 37(2) is repealed and the following substituted –

“(2) The applicant shall, at the same time as he files the application and statement, send a copy of it to the registered owner of the design.

(3) The Registrar shall enter a notice of the application in the Register and advertise the fact of the application having been filed in the official journal.”.

11. Notice of opposition

(1) Section 38(1) is amended by repealing “in duplicate”.

(2) Section 38(2) is repealed and the following substituted –

“(2) The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the applicant.”.

12. Counter-statement

(1) Section 39(1) is amended by repealing “duplicate” and substituting “copy”.

(2) Section 39(2) is repealed and the following substituted –

“(2) The applicant shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

13. Evidence in support of opposition

Section 40(1) is amended by repealing “duplicate” and substituting “copy”.

14. Sections amended

Sections 46(1), 47(1) and 50(1) are amended by repealing “certified”.

15. Correction of errors in Register

(1) Section 51(3) is amended by repealing “in duplicate”.

(2) Section 51(4) is repealed and the following substituted –

“(4) The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the person making the request.”.

(3) Section 51(5) is amended by repealing “duplicate” and substituting “copy”.

(4) Section 51(6) is repealed and the following substituted –

“(6) The person making the request shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

16. Inspection of Register

Section 52 is amended by repealing “and payment of the applicable fee”.

17. Information and inspection of documents

(1) Section 55(2) and (3) is amended by repealing “(4) to (6)” and substituting “(4), (5), (5A) and (6)”.

(2) Section 55(4) is amended by repealing “before payment of the applicable fee or”.

(3) Section 55 is amended by adding –

“(5A) The right of inspection under this section extends only to documents and information kept by the Registry.”.

18. Section added

The following is added –

“55A. Form in which the records of the Registry are kept, etc.

(1) The Registrar shall determine the form in which the records of the Registry are constituted and kept and may determine the period for which such records, or any document or other thing kept by the Registry, shall be kept and the circumstances in which they may be destroyed or otherwise disposed of.

(2) Where the Registrar keeps a record of a document or other thing in a form that differs from that in which the document or thing was originally filed with, or originally generated by, the Registrar, the record of that document or thing shall be presumed, unless the contrary is shown, to accurately represent the information contained in the document or thing as originally filed or generated.”.

19. Publication of business hours and business days of the Registry

Section 56 is amended by repealing “of the Registry and” and substituting “or”.

20. Subheading substituted

The subheading “**Documents**” immediately before section 58 is repealed and the following substituted –

“Filing and service of documents and related matters”.

21. Translation of documents

Section 59(1) is amended by repealing “must be verified to the satisfaction of the Registrar as corresponding to the original text” and substituting “shall state the name of the translator and his official capacity, if any”.

22. Sections substituted

Sections 60 and 61 are repealed and the following substituted –

“60. Filing of documents with the Registrar

(1) Any document or other thing required or authorized by the Ordinance or these Rules to be filed with the Registrar must be delivered by hand to the Registrar at the Registry during the normal business hours of the Registry or sent to the Registrar by post.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the Registrar at the office of the Registry; and the document or thing shall be deemed to have been received at the time when the letter is actually received by the Registrar at the Registry.

(3) The filing of a document or other thing with the Registrar shall be deemed to be effected at such time as it is received by the Registrar at the Registry and is recorded as received.

60A. Electronic filing

(1) The Registrar may at his discretion permit, as an alternative to the filing of a document or other thing with the Registrar in a paper or other physical form, the filing of an electronic record of that document or thing.

(2) The Registrar may at his discretion permit, as an alternative to delivering or sending a document or other thing to the Registrar in the manner provided by section 60, the sending of an electronic record of that

document or thing by electronic means to an information system designated by the Registrar.

(3) The filing of an electronic record, and the sending of an electronic record by electronic means to the information system designated under subsection (2), shall be subject to such terms as the Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person desiring to file an electronic record or to send an electronic record to the Registrar by electronic means.

(4) Where, in accordance with this section, a document or other thing in the form of an electronic record is sent by electronic means to the information system designated under subsection (2), the filing of that document or thing shall be deemed to be effected at such time as that electronic record is accepted by the designated information system.

60B. Terms for electronic filing

(1) Without limiting the generality of section 60A(3), the Registrar may specify terms under that section –

- (a) providing for the approval by the Registrar of the process that must be used to make or send an electronic record;
- (b) providing for the approval by the Registrar of the format or media in which an electronic record must be recorded or stored;
- (c) respecting the manner of authenticating an electronic record in circumstances where the document or other thing in question is required to be signed or sealed or authenticated in any manner;
- (d) requiring any document or other thing sent to the Registrar in the form of an electronic record to include

or be accompanied by the electronic signature or digital signature of the person who sends it; and

- (e) respecting the manner of filing a document or other thing in cases where there is an interruption in the operation of the information system designated under section 60A(2).

(2) Without limiting the generality of section 60A(3), the Registrar may refuse to accept or to register any document or other thing that is in the form of an electronic record if –

- (a) the information contained in the electronic record is not capable of being displayed in a legible form;
- (b) the electronic record is not capable of being stored in the information system designated under section 60A(2);
- (c) the electronic record appears to the Registrar to be altered, damaged or incomplete;
- (d) any electronic signature or digital signature or other kind of authentication accompanying or included with the electronic record appears to the Registrar to be altered or incomplete; or
- (e) any term specified by the Registrar under that section has been breached.

60C. Designation of electronic mail box

(1) On the request of any person, the Registrar may designate an electronic mail box within an information system designated by the Registrar which may be used by that person to communicate with the Registrar.

(2) The use by any person of an electronic mail box within the designated information system shall be subject to such terms as the

Registrar may specify either generally by notice published in the official journal or in any particular case by notice to the person for whom the electronic mail box is designated.

(3) Where the Registrar designates an electronic mail box for a person under this section, any document or other thing required or authorized by the Ordinance or these Rules to be sent by the Registrar to that person shall be deemed to be properly sent if it is sent in the form of an electronic record to that person's designated electronic mail box.

(4) Sending to a designated electronic mail box shall be deemed to be effected at such time as the electronic record is accepted by the designated information system.

(5) An electronic record sent to a designated electronic mail box shall be deemed to be received by the addressee at such time as the electronic record is accepted and recorded by that electronic mail box.

61. Service of documents

(1) Except as provided by sections 60, 60A, 60B and 60C, where any document or other thing is required or authorized by the Ordinance or these Rules to be sent to any person –

- (a) the document or other thing may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document or other thing may be sent by post to his last known address.

(2) Sending by post shall be deemed to be effected by properly addressing, preparing and posting a letter containing the document or other thing, with the postage on it prepaid, to the address for service of the person or, if he does not have an address for service, at his last known address, and unless the contrary is shown, the document or thing shall be deemed to

have been received by that person at the time when the letter would be delivered in the ordinary course of post.”.

23. Correction of errors in filed documents

(1) Section 62(4) is amended by repealing “in duplicate”.

(2) Section 62(5) is repealed and the following substituted –

“(5) The opponent shall, at the same time as he files the notice of opposition, send a copy of it to the person making the request.”.

(3) Section 62(6) is amended by repealing “duplicate” and substituting “copy”.

(4) Section 62(7) is repealed and the following substituted –

“(7) The person making the request shall, at the same time as he files the counter-statement, send a copy of it to the opponent.”.

24. Section substituted

Section 65 is repealed and the following substituted –

“65. Address for service

(1) Every person concerned in any proceedings before the Registrar shall file an address for service.

(2) The address for service must be a residential or business address in Hong Kong.

(3) A person may file an address for service –

(a) where the person files any specified form that requires the person who completes it to provide an address for service, by filing the specified form with the address for service stated on it; or

(b) in any other case, by notifying the Registrar in writing.

(4) Where a specified form referred to in subsection (3)(a) is filed in the name of 2 or more persons, the address for service stated on that form shall be treated as the address for service of each of those persons.

(5) An applicant for registration of a design or the registered owner of a design may use only one address for service for the purposes of all proceedings before the Registrar concerning that application or registered design.

(6) Subject to any filing to the contrary under this section, on the registration of a design, the address for service of the applicant for registration shall be treated as the address for service of the registered owner of the design for the purposes of all proceedings before the Registrar concerning that registered design.

(7) Where a person files an address for service for the purposes of any proceedings before the Registrar, that address shall be treated as being in substitution for any address for service previously filed by that person for the purposes of those proceedings.

(8) Where, after a person has become a party to proceedings before the Registrar, the person appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file an address for service.

(9) No act required or authorized by the Ordinance or these Rules to be done by or to a person referred to in subsection (8) in connection with the proceedings in question may be done by or to the newly appointed agent before the date on which he files an address for service.

(10) Any person may withdraw his address for service by notifying the Registrar in writing.

65A. Failure to file address for service

(1) Where an address for service is not filed as required by section 65, or where the Registrar is satisfied that the address for service of the registered owner of a design or a party to any proceedings before the Registrar is no longer valid, the Registrar may send to the person concerned,

at any of the addresses referred to in subsection (2), a notice to file an address for service.

- (2) For the purposes of subsection (1), the addresses are –
- (a) any previously filed address for service of the person;
 - (b) any address of the person in Hong Kong that is shown in the Register;
 - (c) any residential or business address of the person in Hong Kong; and
 - (d) any other address of the person that is known to the Registrar.

(3) If any person to whom a notice is sent under subsection (1) fails to file an address for service within 2 months after the date of the notice –

- (a) any application, notice or request filed by that person shall be treated as abandoned or withdrawn; and
- (b) the person shall be deemed to have withdrawn from any proceedings before the Registrar of which he is a party.

(4) This section is without prejudice to the operation of sections 21 and 22.”.

25. Alteration or correction of address

Section 66(1) is amended by adding “or by notice in writing” after “specified form”.

26. Recognition of agents

Section 67(3) and (4) is repealed and the following substituted –

“(3) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on

his business activities, which notice shall be given in the specified form or in writing.

(4) If a person who has given notice under subsection (3) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing.

(5) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subsection (3).

(6) The Registrar may refuse to recognize as an agent in respect of any business under the Ordinance or these Rules –

- (a) a person who has been convicted of a criminal offence;
 - (b) a person whose name has been struck off the roll of barristers or roll of solicitors kept under and in accordance with the Legal Practitioners Ordinance (Cap. 159) or any person who has been suspended from acting as a barrister or solicitor;
 - (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognize as an agent under paragraph (a) or (b);
 - (d) a person against whom a disqualification order has been made under section 168E, 168F, 168G, 168H, 168J or 168L of the Companies Ordinance (Cap. 32);
 - (e) a person against whom an order has been made under section 23(1)(a) or 24(1) of the repealed Securities (Insider Dealing) Ordinance (Cap. 395);
- or

- (f) a person against whom an order has been made under section 214(2)(d), 257(1)(a), 258(1) or 303(2)(a) of the Securities and Futures Ordinance (Cap. 571).

Note: Section 75(4) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person who neither resides nor has a place of business in Hong Kong.”.

27. Section added

The following is added immediately after section 73 –

“73A. Extension of time limits in the case of an interruption in the Registry’s operations

(1) Where on any day there is an event or circumstances causing an interruption in the normal operation of the Registry, the Registrar may notify the day as being one on which there is an interruption in the operations of the Registry.

(2) Where any period of time specified in the Ordinance or these Rules, or as extended under these Rules, for the filing of any document or other thing with the Registrar expires on a day so notified, the period shall be extended to the first day next following (not being an excluded day) that is not so notified.

(3) Any notification given by the Registrar under this section shall be posted in the Registry.

(4) In this section, “excluded day” (非辦公日) means a day that is not a business day of the Registry.”.

28. Fees

The Schedule is amended –

- (a) in Fee No. 1, in the third column, by repealing “\$1,600” and substituting “\$785”;

- (b) in Fee No. 2, in the third column, by repealing “\$3,200” and substituting “\$1,570”;
- (c) in Fee No. 3, in the third column –
 - (i) by repealing “\$1,600” and substituting “\$785”;
 - (ii) by repealing “\$1,200” and substituting “\$590”;
- (d) in Fee No. 4, in the third column –
 - (i) by repealing “\$3,200” and substituting “\$1,570”;
 - (ii) by repealing “\$2,400” and substituting “\$1,180”;
- (e) in Fee Nos. 5, 6 and 7, in the third column, by repealing “\$350” and substituting “\$170”;
- (f) in Fee No. 8, in the third column, by repealing “\$500” and substituting “\$245”;
- (g) in Fee No. 9, in the third column, by repealing “Such amount as is fixed by the Registrar with the approval of the Financial Secretary and published in the Gazette” and substituting “\$155”;
- (h) in Fee Nos. 10 and 11, in the third column, by repealing “\$350” and substituting “\$170”;
- (i) in Fee No. 14, in the third column, by repealing “\$2,500” and substituting “\$1,230”;
- (j) in Fee No. 15, in the third column, by repealing “\$3,800” and substituting “\$1,860”;
- (k) in Fee No. 16, in the third column, by repealing “\$5,600” and substituting “\$2,740”;
- (l) in Fee No. 17, in the third column, by repealing “\$8,500” and substituting “\$4,170”;
- (m) in Fee No. 18, in the third column, by repealing “\$2,500” and substituting “\$1,230”;
- (n) in Fee No. 19, in the third column, by repealing “\$1,000” and substituting “\$490”;

- (o) in Fee Nos. 20 and 21, in the third column, by repealing “\$1,200” and substituting “\$590”;
- (p) in Fee No. 22, in the third column, by repealing “\$700” and substituting “\$345”;
- (q) in Fee No. 23, in the third column, by repealing “\$1,200” and substituting “\$590”;
- (r) in Fee No. 24, in the third column, by repealing “\$350” and substituting “\$170”;
- (s) by repealing Fee Nos. 25 and 26;
- (t) in Fee No. 27 –
 - (i) in the second column, by adding “(for each design)” after “section 73”;
 - (ii) in the third column, by repealing “\$800” and substituting “\$390”.

Registrar of Designs

2004

Explanatory Note

These Rules amend the Registered Designs Rules (Cap. 522 sub. leg. A) (“the principal Rules”) to facilitate the electronic filing and processing of applications for registered designs, to streamline the procedures in the Designs Registry (“the Registry”) and to reduce the fees payable on the filing of

documents with the Registry. The amendments relating to the electronic filing and processing of documents are in furtherance of the amendments made to the Registered Designs Ordinance (Cap. 522) (“the Ordinance”) by the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001).

2. Section 2(1) makes a technical amendment to the definition of “send” in section 2(1) of the principal Rules. Section 2(2) adds the new definitions of “digital signature”, “electronic record”, “electronic signature” and “information system”. The terms are used in the new sections 60A, 60B and 60C which are added by section 22 of these Rules. Section 2(3) makes a consequential amendment to section 2(2)(c) of the principal Rules.

3. Section 3 adds the new section 2A to the principal Rules to enable the Registrar of Designs (the “Registrar”) to accept forms in an electronic format.

4. Sections 4(1) and (2), 5 and 6 amend sections 6, 7 and 8 of the principal Rules to delete the requirement for the statement of novelty to appear on the representation of the design and for 6 additional representations to be submitted with every application. The Registrar will instead be able to request additional copies of the representation when necessary.

5. Section 4(3) amends section 6(3)(e) of the principal Rules to delete the requirement for a transliteration of the name of the applicant if that name is in Chinese characters.

6. Section 7 amends section 11(2) of the principal Rules to allow a copy of the certificate to be filed instead of the original.

7. Section 8 amends section 17 of the principal Rules to delete the requirement for the notice of withdrawal to be filed in the specified form and to require the notice to contain the number of the application being withdrawn.

8. Section 9 amends section 33(3)(a) of the principal Rules to delete the requirement for the assignee to sign the application.

9. Sections 10(1), 11(1), 15(1) and 23(1) amend sections 37(1), 38(1), 51(3) and 62(4) of the principal Rules to delete the requirement for duplicate copies of certain documents to be filed with the Registrar. Sections 12(1), 13, 15(3) and

23(3) make consequential amendments to sections 39(1), 40(1), 51(5) and 62(6) of the principal Rules.

10. Sections 10(2), 11(2), 12(2), 15(2) and (4) and 23(2) and (4) amend sections 37(2), 38(2), 39(2), 51(4) and (6) and 62(5) and (7) of the principal Rules to require the party initiating the proceeding to serve certain documents on the other side.

11. Section 14 amends sections 46(1), 47(1) and 50(1) of the principal Rules to delete the requirement for the copy of the document to be certified.

12. Sections 16 and 17(2) repeal the references to fees in sections 52 and 55(4) of the principal Rules.

13. Section 17(3) adds the new section 55(5A) to the principal Rules to make clear that the right of inspection only extends to information and documents kept by the Registry. Section 17(1) makes a consequential amendment to section 55(2) and (3) of the principal Rules.

14. Section 18 adds the new section 55A to the principal Rules to allow the Registrar to determine the form and content of the Registry's records and the circumstances in which records and documents may be disposed of.

15. Section 19 amends section 56 of the principal Rules to clarify the text.

16. Section 20 amends the subheading preceding section 58 of the principal Rules as a consequence of the addition of the new sections 60A, 60B and 60C.

17. Section 21 amends section 59(1) of the principal Rules to delete the requirement for the translation to be verified and to require that the name and official capacity of the translator be given instead.

18. Section 22 replaces sections 60 and 61 of the principal Rules with new provisions governing the filing and service of documents. The new section 60 provides for documents to be delivered by hand or sent by post to the Registrar. The new sections 60A and 60B provide for the electronic filing of documents and enable the Registrar to specify the terms for electronic filing in the official journal. The new section 60C enables the Registrar to designate an electronic mail box which may be used by the person for whom it is designated to

communicate with the Registrar. The new section 61 specifies the manner in which documents shall be served.

19. Section 24 replaces section 65 of the principal Rules with two new provisions relating to addresses for service. The new section 65 requires a person who is concerned in any proceedings before the Registrar to file an address for service, which must be a residential or business address in Hong Kong, and provides for the manner of filing or withdrawing an address for service and for related matters. The new section 65A deals with the failure to file an address for service.

20. Section 25 amends section 66(1) of the principal Rules to allow the person making the request or the agent the option of filing a notice in writing instead of a specified form.

21. Section 26 amends section 67 of the principal Rules to require an agent to notify the Registrar of the address in Hong Kong where he resides or has his place of business, to notify the Registrar of any changes in that address and to revise the list of persons whom the Registrar may refuse to recognize as an agent.

22. Section 27 adds the new section 73A to the principal Rules which provides that if a deadline expires on the day on which there is an interruption in the normal operation of the Registry, it shall be extended to the next business day.

23. Section 28 reduces certain fees set out in the Schedule to the principal Rules.

TRADE MARKS (AMENDMENT) RULES 2004

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

1. Commencement

These Rules shall come into operation on 7 May 2004.

2. Proof of authorization of agent may be required, etc.

(s. 88 of the Ordinance)

Rule 103 of the Trade Marks Rules (Cap. 559 sub. leg. A) is amended by adding –

“(3) A person who is authorized by another person to act as his agent shall, on or before the first occasion on which he acts as agent, notify the Registrar of the address in Hong Kong where he resides or carries on his business activities, which notice shall be given in the specified form or in writing.

(4) If a person who has given notice under subrule (3) changes the address in Hong Kong where he resides or carries on his business activities, he shall notify the Registrar of the change as soon as practicable thereafter, which notice shall be given in the specified form or in writing.

(5) No act required or authorized by the Ordinance or these Rules to be done by or to any person may be done by or to an agent of that person before the date on which the agent notifies the Registrar in accordance with subrule (3).”.

3. Registrar may refuse to deal with certain agents

(s. 88 of the Ordinance)

(1) Rule 104(e) is amended by adding “repealed” before “Securities”.

(2) Rule 104 is amended by adding –

“Note: Section 88(3) of the Ordinance provides that the Registrar shall refuse to recognize as an agent a person having neither residence nor a place of business in Hong Kong.”.

Registrar of Trade Marks

2004

Explanatory Note

These Rules amend rule 103 of the Trade Marks Rules (Cap. 559 sub. leg. A) (“the principal Rules”) to require an agent to notify the Registrar of Trade Marks of the address in Hong Kong where he resides or carries on his business activities. These Rules also make a technical amendment to rule 104 of the principal Rules and insert a note at the end of that rule regarding the Registrar’s powers under section 88 of the Trade Marks Ordinance (Cap. 559).

Legislative Council Panel on Commerce and Industry

Review on certain provisions of the Patents Ordinance and Patents (General) Rules

Purpose

This paper briefs Members on the progress of an ongoing review on certain provisions of the Patents Ordinance (“the Ordinance”) and the Patents (General) Rules (“the PGR”).

Background

2. Section 39(1) of the PGR requires the proprietor of a patent, in respect of which the specification has been amended by court order under section 46 of the Ordinance, to file with the Registrar notice of the amendment within one month of the making of the court order. This time limit is not extendible because of section 100(2) of the PGR. In October 2002, we introduced the Patents (General) Amendment No.2 Rules (the amendment rules) to amend section 39 to remove this time limit. A copy of section 39 of the PGR is at Appendix A.

3. When the amendment rules were being examined by the Legislative Council (LegCo), the Court of Final Appeal (CFA) handed down a judgment (*Merck Sharp & Dohme Ltd v Registrar of Patents [2002] 3 HKLRD 812*) in December 2002 which declared that section 39(1) of the PGR and that part of section 100(2) of the PGR which refers to section 39(1) of the PGR to be ultra vires and of no legal effect.

4. During subsequent discussions with Members on the amendment rules, the Administration undertook to review the procedures for amending patent specifications under section 39 of the PGR to ensure that they are not potentially ultra vires. We also undertook to review other time limits which are related to the amendment of patent specifications and have given rise to concern among intellectual property (IP) practitioners. To facilitate thorough consideration, we repealed the amendment rules by a Legislative Council Resolution in December 2002.

Progress of the Review

5. We report the progress of the review in the following paragraphs.

Section 46 of the Ordinance

6. In its judgment of the *Merck Sharp's* case, the CFA holds that the rule-making power relating to how a court order granted under section 46 of the Ordinance is carried into effect is not given to the Registrar but to the Rules Committee of the High Court under section 46(7) of the Ordinance (section 46 of the Ordinance is at Appendix B). Section 46(7) states, among other things, that rules of court may provide for giving effect to any order of the court made upon a section 46 application. The CFA considers that this power clearly covers such matters as the setting of time limits for the filing of relevant court orders. The original section 39(1) of the PGR, being a rule made by the Registrar instead of the Rules Committee, is therefore ultra vires. The CFA also considers that once the court has granted an order, the patent specification is deemed to have been amended. Entry of that order on the register is merely the means for publishing and providing *prima facie* evidence of the fact of such amendment. The role of the Registrar in recording, publishing and advertising the amendment is purely administrative and he has no power to qualify the duty upon him.

7. In light of the CFA judgment, we have decided to repeal section 39 of the PGR. Correspondingly, we have proposed to the Rules Committee of the High Court to transpose from the PGR to the Rules of the High Court all rules relating to matters that govern the filing of court order under section 46 of the Ordinance. We have also suggested to the Rules Committee that the original one-month time limit for filing of the court order to the Registrar be provided for in the court rules but this time limit may be extendible. We have so proposed because when the amendment rules were examined in LegCo, some Members had suggested that there was indeed merit in keeping a time limit to ensure that a court order would be filed expeditiously. After further consideration, we agree with Members' suggestion and propose an extendible time-limit. Patent owners who are not able to meet the time limit may apply to the court for extension of the time limit. The court may consider the application on a case by case basis. With an extendible time limit, we believe that the right balance would be struck between providing flexibility to patent owners on the one hand and allowing members of the public to have prompt access to an up-to-date patent register on the other. The proposed extendible one-month time limit has been included in the current draft Rules of the High Court (Amendment) Rules which are being studied by the Rules Committee of the High Court. The CFA in its judgment of December 2002 states that, pending the making of new rules, a court making a section 46 order may

consider giving ancillary directions regarding the implementation of the court order, such as directing that notice of its order amending the patent should be filed with the Registrar within a stated period, with leave to parties to apply to the court for further directions.

8. Currently, section 46(5) of the Ordinance stipulates that upon receipt of a court order and supporting documents filed in the prescribed manner, the Registrar shall record the amendments to the specification of the patent and shall advertise such fact. We propose to set out in clear terms the type of supporting documents required by the Registrar. Since these documents are reasonably necessary for the Registrar to perform his administrative duties and do not concern how a court order is carried into effect, we are of the view that the requirement for filing such documents may be provided for in the PGR. Hence, we have included in the draft Patents (General) (Amendment) Rules 2004 a new section 52 in the PGR which provides that where a court order granted under section 46 of the Ordinance makes reference to other documents which show the amendments to be made to a patent, the patent proprietor has to file such documents with the Registrar, together with any translation as necessary. The proposed section 52 also specifies that those documents shall be filed at the same time as the court order is filed.

Section 102 of the Ordinance

9. Section 102 of the Ordinance deals with matters of amendment of patents in infringement or revocation proceedings before the court where the validity of a patent is challenged. We have reviewed section 102 because section 102(4) shares the same wording as section 46(7). Both subsections state that rules of court may provide for giving effect to the relevant orders of the court. Currently, there is no rule in the PGR which prescribes time limits for filing of section 102 orders and therefore the vires issue in *Merck Sharp's* case should not arise in this context. Nonetheless, we see merit in setting out in clear terms the arrangements for matters related to section 102. We have hence recommended to the Rules Committee of the High Court that rules of court should provide for matters of filing of court order and amendment of patent with the Registrar under section 102, including the prescription of an extendible one-month time limit for the filing of the court order and amendments with the Registrar. As regards the filing of supporting documents under section 102, the same considerations in paragraph 8 above regarding section 46 applies. We have therefore included in the proposed section 52 of the PGR references to section 102 of the Ordinance.

The 3-month time limit in section 35 of the PGR

10. Section 43 of the Ordinance requires the owner of a standard patent to seek amendments to the specifications of such patent where the specifications of the designated patent have been amended in the designated patent office following specific opposition or revocation proceedings. Section 35 of the PGR stipulates that such application for amendment should be made within a period of three months from the date of amendment in the designated patent office, or the date of grant of the standard patent, whichever is the later. IP practitioners have suggested that this be extended from three months to six months.

11. We have considered this request and agreed to change the time limit to six months. Accordingly, we have included an amendment to section 35 of the PGR in the draft Patents (General) (Amendment) Rules 2004.

Other matters relating to the regime of patent registration

12. In response to comments received from IP practitioners, we have also reviewed certain time limits stipulated in the Ordinance. For instance, the time limit governing the request for registration and grant of a standard patent under section 23(2) of the Ordinance is currently specified as six months after the date of grant of that patent by a designated patent office overseas, or publication of the request to record in Hong Kong, whichever is the later. IP practitioners regard six months too short and have requested that the time limit be made extendible. Since those time limits are laid down in the Ordinance instead of the PGR, we have agreed with the practitioners to discuss the matter separately and not deal with it in the current Patents (General) (Amendment) Rules exercise, which is primarily concerned with allowing electronic filing of documents. We shall continue to discuss with IP practitioners and report to the LegCo Commerce and Industry Panel on the outcome in due course.

**Commerce and Industry Branch
Commerce, Industry and Technology Bureau
February 2004**

CAP. 514 *Patents (General) Rules*

39. Amendment of specification after grant

(1) The proprietor of a patent in respect of which the specification has been amended by court order under section 46 of the Ordinance shall, within 1 month of the making of such a court order, file with the Registrar notice of such amendment.

(2) A notice under subsection (1) shall be in the specified form and shall be accompanied by a verified copy of the court order together with any supporting documents.

(3) The Registrar may, if he thinks fit, require—

- (a) the amendment be shown on a copy of the specification of which amendment has been made by the court order; or
- (b) the filing, within the time specified by the Registrar, of a new specification as amended, which shall be prepared in accordance with section 12.

(L.N. 157 of 2002; L.N. 235 of 2002)

46. General power to amend specification after grant

(1) Subject to section 103, the proprietor of a patent granted under this Ordinance may apply to the court to amend the specification of the patent and the court may by order allow any such amendment subject to such conditions as it thinks fit.

(2) No such amendment shall be allowed if there are pending before the court proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect as from the grant of the patent.

(4) Any person wishing to oppose an application under this section may, in accordance with rules of court, give to the court notice of opposition; and the court shall consider the opposition in deciding whether to grant the application.

(5) Upon receipt of the court order and supporting documents filed in the prescribed manner the Registrar shall record the amendments to the specification of the patent and shall publish this and advertise the fact by notice in the Gazette.

(6) The Registrar may, without any application being made to the court or to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark.

(7) Rules of court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the court on the application.

[*cf.* 1977 c. 37 s. 27 U.K.]