



立法會秘書處 法律事務部  
LEGAL SERVICE DIVISION  
LEGISLATIVE COUNCIL SECRETARIAT

來函檔號 YOUR REF :  
本函檔號 OUR REF : LS/S/23(2)/18-19  
電 話 TELEPHONE : 3919 3511  
圖文傳真 FACSIMILE : 2877 5029  
電 郵 EMAIL : [cwkip@legco.gov.hk](mailto:cwkip@legco.gov.hk)

**URGENT**

By Fax (2840 1621)

29 March 2019

Miss Alice CHOI  
Principal Assistant Secretary for Commerce and  
Economic Development (Commerce and Industry)<sup>3</sup>  
Commerce and Economic Development Bureau  
23/F, West Wing  
Central Government Offices  
2 Tim Mei Avenue  
Tamar, Hong Kong

Dear Miss CHOI,

### **Patents (General) (Amendment) Rules 2019**

We are scrutinizing the legal and drafting aspects of the Patents (General) (Amendment) Rules 2019 (L.N. 35 of 2019) ("L.N. 35"). We should be grateful if you could clarify the following matters.

#### **References to "State Intellectual Property Office"**

2. It is noted that the term "State Intellectual Property Office" ("SIPO") is used in L.N. 35 (see its sections 12 and 56). The same term has also been used in the Patents Ordinance (Cap. 514) and the Patents (Designation of Patent Offices) Notice (Cap. 514A). However, it appears that the English name of that office has changed from SIPO to "China National Intellectual Property Administration" (with its name in Chinese unchanged, i.e. "國家知識產權局"). Please clarify whether and when Cap. 514, Cap. 514A and the Patents (General) Rules (Cap. 514C) would be amended accordingly.

**Section 19 of L.N. 35 – "Example" located after new section 31O of the Patents (General) Rules (Cap. 514C)**

3. The new section 31O(2)(b)(xvi)(A) of Cap. 514C (as added by section 19 of L.N. 35) provides that the drawings in relation to an application for standard patent by original grant ("standard patent (O) application") must not contain any textual matter, except—if required for a clear understanding of the drawings—the textual matter is a single word or words or the equivalent Chinese characters, as appropriate. It is noted that there is an "example" immediately after the new section 31O(2)(b)(xvi)(A) to the effect that examples of the single word or words are "water", "steam", "open", "close" and "section on AA". Please clarify:

- (a) whether this "example" is part of the text of L.N. 35 and has legislative effect;
- (b) why the content of this "example" is not stated in the provision itself, as in the existing section 60(2)(k) of Cap. 514C with very similar content without the use of an example; and
- (c) with reference to the papers issued by the Law Drafting Division of the Department of Justice entitled "Drafting of Legislation — Use of "Examples" and "Notes" in legislation; Numbering System for Bill clauses" dated May 2011 (LC Paper No. CB(2)1781/10-11(01)), and ""Notes" and "Examples" in the Companies Bill" dated 13 March 2012 (LC Paper No. CB(1)1295/11-12(02)), whether and why the example as stated above is necessary and appropriate in the context of L.N. 35.

**Sections 19 and 40(16) of L.N. 35 – "Notes" located after new sections 31O and 60(3) of the Patents (General) Rules (Cap. 514C)**

4. It is noted that at the end of the new section 31O of Cap. 514C (as added by section 19 of L.N. 35), there is a "note" to the effect that section 31Q(13) of Cap. 514C provides for exemption from the new section 31O. There is no provision in L.N. 35 or Cap. 514C clarifying the status of this "note" (in comparison, section 2(6) of the Companies Ordinance (Cap. 622) provides that a note located in the text of that Ordinance is provided for information only and has no legislative effect). Please clarify whether the stated "Note" in L.N. 35 is part of the text of the subsidiary legislation and has legislative effect.

5. Please also clarify the status and effect of a similar "Note" after section 60(3) of Cap. 514C (as added by section 40(16) of L.N. 35).

**Section 19 of L.N. 35 – "Request to review" in new section 31ZI etc. of the Patents (General) Rules (Cap. 514C)**

6. It is stated in the new section 31ZI(5) of Cap. 514C (as added by section 19 of L.N. 35) that if no "request to review" is filed after the Registrar of Patents ("Registrar") has issued the "provisional refusal notice" regarding a standard patent (O) application, then the Registrar must make a final decision of refusal to grant the standard patent (O). Please clarify whether the Registrar (a) may nonetheless grant the standard patent (O) if the Registrar on his or her own initiative considers that all the requirements as stated in section 37X(1) of Cap. 514 are satisfied, after the provisional refusal notice has been issued incorrectly, and (b) has the power to review the issue of the provisional refusal notice in the absence of a request to review.

7. Please also clarify a similar situation as regards the new section 31ZM(4) of Cap. 514C (as added by section 19 of L.N. 35).

**Section 19 of L.N. 35 – "Review opinion" in new section 31ZJ of the Patents (General) Rules (Cap. 514C)**

8. It is noted that under the new sections 31ZF(3) and 31ZL(3) of Cap. 514C, the Registrar may give "further examination notice more than once" and "further review opinion more than once" respectively. Please clarify whether the Registrar may issue a "review opinion" more than once under the new section 31ZJ of Cap. 514C in the absence of an express provision to that effect.

**New section 31N(3) and existing section 59(2) of the Patents (General) Rules (Cap. 514C)**

9. It is noted that in the new section 31N(3) of Cap. 514C (as added by section 19 of L.N. 35), the phrase "a more economical presentation" (rendered as "較為簡約的呈示" in the Chinese text) is used. However, the phrase "a more economic presentation" (rendered as "較為省儉的呈示" in the Chinese text) has been used in the existing section 59(2) of Cap. 514C. Please clarify why different phrases (in both the English and Chinese texts) are used in Cap. 514C as stated above, and whether they have the same meaning.

**Section 143(1)(b) of the Patents Ordinance (Cap. 514) and new sections 31ZH and 31ZN of the Patents (General) Rules (Cap. 514C)**

10. Under section 143(1)(b) of Cap. 514, a person, who represents that a patent has been applied for in respect of any article disposed of for value by him when in fact the relevant application has been "refused", commits an offence. Please clarify whether that provision would apply after a "provisional refusal notice" has been issued under the new section 31ZH of Cap. 514C, but before the issue of a "final refusal notice" under the new section 31ZN of Cap. 514C.

We shall be grateful if you could let us have your reply in both English and Chinese as soon as practicable, and in any event before the second meeting of the Subcommittee on Patents (General) (Amendment) Rules 2019.

Yours sincerely,



(Cliff IP)

Assistant Legal Adviser

c.c. Department of Justice  
(Attn: Mr Jonathan LUK, Senior Government Counsel (Fax: 2536 8129))  
Legal Adviser  
Senior Assistant Legal Adviser 1  
Clerk to Subcommittee