

**立法會**  
**Legislative Council**

LC Paper No. LS14/02-03

**Paper for the House Committee Meeting  
on 8 November 2002**

**Legal Service Division Further Report on  
Patents (General) (Amendment) (No. 2) Rules 2002  
(L.N. 157 of 2002)**

Members may recall that the Legal Service Division made a report on the Patents (General) (Amendment) (No. 2) Rules 2002 (L.N. 157 of 2002) at the House Committee meeting on 1 November 2002. To recap, the Amendment Rules amend section 39 of the Patents (General) Rules (Cap. 514 sub. leg.) to remove the one-month time limit for filing with the Registrar of Patents notice of an amendment of specification of a patent, and to provide that the notice shall be accompanied by a sealed copy of the court order allowing the amendment. The Amendment Rules will come into operation on 20 December 2002. Any amendments to the Amendment Rules are required to be made by 27 November 2002, or by 18 December 2002 if extended by resolution.

2. At the meeting, Hon Margaret NG asked for the rationale of the one-month time limit in the existing section 39(1) of the Patents (General) Rules and the specific problems or difficulties in the operation of the existing provision which made the Administration consider it necessary to remove the time limit. Members agreed to defer their decision on the Amendment Rules.

3. We have subsequently found out that there is a pending appeal to the Court of Final Appeal on issues relating to section 39(1) of the Patents (General) Rules. In *Re Merck Sharp & Dohme Ltd (Amendment of Patent)* [2002] 2 HKC 475, the Court of Appeal upheld the decision of the Court of First Instance that the court had no power, either under the Rules of the High Court or under its inherent jurisdiction, to extend the one-month time limit provided under section 39(1) of the Patents (General) Rules if the notice of amendment of specification of a patent was not filed within the statutory time limit. The Court of Final Appeal has granted leave to the patent proprietor concerned to appeal against the Court of Appeal's decision on the ground that a point of great general or public importance has arisen in relation to the question whether section 39(1) of the Patents (General) Rules and that part of section 100(2) of those Rules which provided that the Registrar of Patents could not extend the time limit provided under section 39(1) of those Rules were *ultra vires* (FAMV No. 18 of 2002). Leave was also granted to the Registrar of Patents to intervene and to participate in the appeal as a respondent.

4. In the light of the pending appeal, we have asked the Administration to clarify the following matters:

- (a) whether the Administration was aware of the court proceedings when making the Amendment Rules, and if so, whether there are any reasons for not making the amendments to section 39(1) of the Patents (General) Rules until after the appellate proceedings have been concluded; and
- (b) as there is nothing in the judgments at first instance and on appeal which suggests that the provision of the one-month time limit under the existing law is problematic, whether there is any reason which makes the Administration consider it more appropriate to remove the time limit altogether instead of giving the court or the Registrar of Patents a statutory power to extend the one-month time limit based on the merits of individual cases.

5. The Administration's reply to Hon Margaret NG's queries is set out in paragraphs (a) and (b) in the enclosure to the Administration's letter dated 5 November 2002, which is annexed for Members' information. The letter also states that the Administration is aware of the court proceedings relating to section 39(1) of the Patents (General) Rules but considers that the time limit should be removed regardless of the outcome of those proceedings.

6. The Administration's response appears to raise policy issues of whether the amendment is pre-mature in the light of the court proceedings relating to section 39(1) of the Patents (General) Rules and whether adequate considerations have been given to possible practical implications of removing the statutory time limit. Members may wish to form a Subcommittee to examine these issues.

Encl.

Prepared by

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6 November 2002

**Annex**

Our ref. : CIB 06/08/7  
Your ref. : LS/S/4/02-03

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5 November 2002

Ms Connie Fung  
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8 Jackson Road, Central  
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Dear Ms Fung

**Patent (General) (Amendment) (No. 2) Rules 2002  
(L.N. 157 of 2002)**

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I enclose our responses (in both English and Chinese version) to the questions raised in your letters of 1 and 2 November.

Yours sincerely,

( Philip Chan )  
for Secretary for Commerce, Industry and Technology

c.c. IPD (Attn: Mrs Teresa Grant, Miss Finnie Quek)

- (a) The original rationale for providing the one-month time limit in section 39(1) of the Patent (General) Rules (“the Rules”) is to ensure that the patent owner files with the Registrar of Patents promptly a court order made under section 46(1) of the Patents Ordinance (“the Ordinance”) allowing an amendment to the specification of a patent. Under section 46(5) of the Ordinance, upon receipt of the court order and supporting documents in the prescribed manner, the Registrar will record such amendment in the Register and arrange to advertise the fact by notice in the Gazette. As the amendment will take retrospective effect from the grant of the patent, it is important to ensure that the Register disseminates up-to-date and reliable patent information to the public.
- (b) The one-month time limit is problematic. Section 81(5) of the Ordinance provides that no damages shall be awarded in any proceedings for an infringement of the patent in question committed after the date the court order is made and before a copy of the order is filed with the Registrar. If the patent owner fails to file within the time limit, the Registrar cannot accept the filing of the court order thereafter and will have no legal authority to record the amendment even though the court order remains valid. The patent owner cannot recover damages for any infringement of the patent because the court order is not filed with the Registrar. The patent owner has no recourse to remedy this situation.

Notwithstanding the removal of the one-month time limit, we believe that section 81(5) of the Ordinance should provide sufficient incentive for the patent owner to file the notice of amendment promptly.

- (c) The Administration is aware of the proceedings referred to in the letter of 2 November 2002. Owing to paragraph (b) above, it is considered that the time limit should be removed regardless of the outcome of those proceedings.
- (d) To allow the Registrar of Patents the power to extend the one-month time limit based on the merits of individual cases would not solve the problem. This is because a power to extend the time limit must include the power not to extend it. If the Registrar were to exercise the power not to extend the time limit in any particular case, the result would still be that the relevant court order is not given its full effect and the patent owner has no recourse to remedy the situation set out in paragraph (b). It is not meaningful to provide for discretion to extend the time limit when the intention is to accept the filing even though the

time limit has been exceeded in order to avoid the aforementioned situation.