

**Response to
List of follow-up actions arising from
Subcommittee meeting on 14 November 2002**

- (1) We have carefully considered the matter. We maintain that the time limit is problematic and should be removed even if the court rules that the time limit is not ultra vires. If the court rules that the time limit is ultra vires, we still need to remove the time limit provision from the Rules as a matter of practice. We therefore do not consider it necessary to wait for the outcome of the court case.

The Registrar is entitled to make amendments to the Patent (General) Rules by virtue of section 149 of the Patents Ordinance (Cap. 514). The Amendment Rules do not have any retrospective effect and do not affect the rights of the parties to the appeal case before the commencement of the Amendment Rules. The Amendment Rules are therefore legally in order.

The Administration is aware of the impending court case. As we explained at the Subcommittee meeting on 14 November 2002, it is not necessary to mention the court case in the LegCo brief because the amendments should be made regardless of the outcome of the court case and, to this extent, the court case is irrelevant. Neither is it appropriate to mention the details of an on-going appeal case in the LegCo Brief. We agree that the Administration should mention in the LegCo Brief that there is a pending court case where it is relevant to the legislative amendment in question.

- (2) We note the suggestion of the Subcommittee that with the removal of the one-month time limit, measures should be mapped out to encourage patent proprietors to file the notice of amendment as soon as practicable. We believe that the concern of the Subcommittee is to ensure that the Register disseminates up-to-date and reliable patent information to the public. To this extent, we share the same objective.

Our view is that, notwithstanding the removal of the one-month time limit, section 81(5) of the Ordinance already provides sufficient incentive for the patent proprietor to file the notice of amendment promptly. This section provides that a patent proprietor loses the right to damages for any infringement of the patent committed after he obtains the court order and before he files the notice of amendment with the Registrar.

The Subcommittee has suggested that the Registrar should be given the discretion to extend the one-month time limit. We have in fact carefully considered this option before making the amendments. Our conclusion is that this cannot solve the problem. This is because a power to extend the time limit must include the power not to extend it. If the Registrar exercises the power not to extend the time limit in any particular case, the patent proprietor cannot file the relevant court order. The patent proprietor therefore cannot recover damages from any infringement of the patent committed after the court order is made. In addition, the court order is still valid but cannot be given full effect. The patent proprietor has no recourse to remedy this situation. 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.