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Secretary for Commerce, Industry and Technology
(Attention: Mr. Donald CHEN,
Principal Assistant Secretary
(Commerce and Industry))
Commerce, Industry and Technology Bureau
Level 29 One Pacific Place
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Hong Kong

6 December 2002

URGENT BY FAX
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Dear Mr Chen

Patents (General) (Amendment) (No. 2) Rules 2002

In the light of the Court of Final Appeal's judgment in *Merck Sharp & Dohme Limited v The Registrar of Patents* (FACV No. 11 of 2002), I should be grateful if you would consider the following matters in respect of the above Amendment Rules:

- (a) In view of the Court of Final Appeal's findings set out in paragraph 38 of the judgment, it is important that any rules to be made by the Registrar of Patents for the purposes of section 46 of the Patents Ordinance (Cap. 514) should not have the purpose or effect of regulating how court orders made under section 46(1) of the Ordinance are carried into effect; otherwise, the Registrar would be acting *ultra vires*. It would appear that the new section 39(1) of the Patents (General) Rules (Cap. 514 sub. leg.), as proposed by the above Amendment Rules, could be construed as having such purpose or effect as it purports to impose a duty or obligation on the proprietor of a patent to file with the Registrar a notice of the court order in order to give effect to the court order. According to the Court of Final Appeal, filing a notice of the court order made under section 46(1) of the Ordinance should be directed by the courts. In the circumstances, will the Administration consider making appropriate amendments to the Amendment Rules to confine section 39 of the Patents (General) Rules to prescribing the manner of filing the court order and supporting documents?

- (b) It would appear that the Court of Final Appeal's judgment also throws doubt on the *vires* of section 39(3) of the Patents (General) Rules. It seems clear that the provision is not concerned with the manner of filing the court order made under section 46(1) of the Ordinance. Further, it is doubtful whether the provision relates to the manner of filing the supporting documents which the Registrar is empowered to prescribe under the Patents Ordinance. Even if it can be argued that the document required to be filed under section 39(3) is a supporting document for the purposes of section 46(5) of the Ordinance, there will arise the question as to whether the requirement under section 39(3)(b) of the Patents (General) Rules for the patent proprietor to file the relevant document within the time specified by the Registrar would be *ultra vires* in the light of the Court of Final Appeal's judgment. In the circumstances, will the Administration consider repealing section 39(3) of the Rules?

I would appreciate it if you could let me have your reply in both languages on or before the next Subcommittee meeting to be held at 10:45 a.m. on 9 December 2002.

Yours sincerely,

(Connie Fung)
Assistant Legal Adviser

cc: DoJ (Attention: Miss Leonora IP, SGC) Fax No. 2536 8109
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