

LEGISLATIVE COUNCIL BRIEF

Patents (General) Rules
(Cap. 514 sub. leg.)

PATENTS (GENERAL)(AMENDMENT)(NO.2) RULES 2002

INTRODUCTION

----- This brief explains the Patents (General) (Amendment) (No.2) Rules 2002 (“the Rules”) at Annex A.

THE RULES

2. We propose that section 39 of the Patents (General) Rules be amended to remove the time limit in sub-section (1), and to align the wording with section 46 of the Patents Ordinance (“the Ordinance”).

3. Section 39(1) of the Patents (General) Rules requires the proprietor of a patent to file with the Registrar of Patents (“the Registrar”) notice of an amendment of specification of a patent within one month of the making of the relevant court order.

4. The time limit of one month is unnecessary, as the provisions of section 81(5) of the Ordinance should provide sufficient incentive for the proprietor of a patent to do so promptly. That section provides that where such an order has been made by the court, no damages shall be awarded in any proceedings for an infringement of the patent committed after the date on which the order is made and before a copy of the order is

filed with the Registrar.

5. The one-month time limit is also problematic, as it is non-extendible. If the patent proprietor fails to file notice of the court order within the time limit, the Registrar of Patents will have no legal authority to record the amendment to the specification and make it public. The proprietor of the patent has no recourse to remedy the situation even though the court order remains valid. This defeats part of the purpose of the public Register as a tool for disseminating up-to-date and reliable patent information.

6. The opportunity is also taken to amend the wording of section 39 of the Patents (General) Rules to align it with section 46(1) of the Patents Ordinance.

7. The Director of Intellectual Property, who is the Registrar of Patents, is empowered under section 149 of the Ordinance to make rules for regulating practice and procedure under the Ordinance.

8. Copies of the empowering provisions and the provisions being
----- amended are at Annexes B and C.

PUBLIC CONSULTATION

9. The proposed amendments are technical and minor in nature. No consultation is considered necessary.

IMPLICATIONS OF THE PROPOSAL

10. The proposed amendments are in conformity with the Basic Law, including the provisions concerning human rights. They will not affect the current binding effect of the principal Ordinance. The proposed amendments have no financial or economic implication and do not involve staffing implication for the Government.

LEGISLATIVE TIMETABLE

11. The legislative timetable will be -

Publication in the Gazette	25 October 2002
Tabling at the Legislative Council	30 October 2002
Commencement	20 December 2002

PUBLICITY

12. A press release will be issued on 25 October 2002 and a spokesman will be available to handle enquiries.

ENQUIRIES

13. Enquiries on this brief shall be referred to Mr. Philip Chan, Principal Assistant Secretary for Commerce, Industry and Technology (Commerce and Industry) at telephone number 2918 7480.

Commerce and Industry Branch
Commerce, Industry and Technology Bureau
October 2002

PATENTS (GENERAL) (AMENDMENT) (NO. 2) RULES 2002

(Made under section 149 of the Patents Ordinance (Cap. 514))

1. Commencement

These Rules shall come into operation on 20 December 2002.

2. Amendment of specification after grant

(1) Section 39(1) of the Patents (General) Rules (Cap. 514 sub. leg.) is repealed and the following substituted –

“(1) The proprietor of a patent in respect of which an amendment of the specification has been allowed by a court order under section 46(1) of the Ordinance shall file with the Registrar a notice of the court order.”.

(2) Section 39(2) is amended by repealing “verified” and substituting “sealed”.

(3) Section 39(3)(a) is amended by repealing “made” and substituting “allowed”.

3. Alteration of time limits

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

Registrar of Patents

2002

Explanatory Note

These Rules amend the Patents (General) Rules (Cap. 514 sub. leg.) to –

- (a) clarify that the proprietor of a patent in respect of which an amendment of the specification has been allowed by a court order under section 46(1) of the Patents Ordinance (Cap. 514) shall file with the Registrar of Patents a notice of the court order and the notice shall be accompanied by a sealed copy of the court order;
- (b) remove the time limit of one month for filing a notice; and
- (c) make minor amendments to bring the wording of section 39 of the Patents (General) Rules (Cap. 514 sub. leg.) into line with section 46 of the Patents Ordinance (Cap. 514).

Annex B

Chapter: **514** Title: **PATENTS ORDINANCE** Gazette Number:

Section: **149** Heading: **Rules** Version Date:
30/06/1997

- (1) The Registrar may make rules-
 - (a) for the purposes of any provision of this Ordinance authorizing the making of rules (other than rules of court) with respect to any matter; and
 - (b) for prescribing anything authorized or required by an provision of this Ordinance to be prescribed, and generally for regulating practice and procedure under this Ordinance.
- (2) Without prejudice to the generality of subsection (1), rules may make provision-
 - (a) in connection with applications for patents and other documents which may be filed with the Registrar-
 - (i) prescribing the form and contents of any such documents;
 - (ii) requiring copies of such documents to be furnished;
 - (iii) prescribing the manner of filing of such documents;
 - (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or in the registry and authorizing the rectification of irregularities of procedure;
 - (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the registry and providing for the remission of fees in the prescribed circumstances;
 - (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
 - (e) requiring the Registrar to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;
 - (f) providing for the appointment of advisers to assist the Registrar in any proceedings before him;
 - (g) prescribing time limits for doing anything required to be done in

connection with any such proceeding by this Ordinance or the rules and providing for the alteration of any period of time specified in this Ordinance or the rules;

- (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
 - (i) without prejudice to any other provision of this Ordinance, requiring and regulating the translation of documents in connection with a patent or an application for a patent into the language of the proceedings or into one or both official languages and the filing and verification of any such translations;
 - (j) providing for the publication and sale of documents by the registry and of information about such documents;
 - (k) prescribing opposition or revocation proceedings in designated patent offices for the purposes of sections 43 and 44.
- (3) Rules may make different provision for different cases.
- (4) Rules made under this section-
- (a) authorizing the rectification of irregularities of procedure; or
 - (b) providing for the alteration of any period of time, may authorize the extension or further extension of any period of time notwithstanding that the period has already expired.
- (5) Rules prescribing fees, including any penalty fee under section 104(5)(b), shall not be made except with the consent of the Financial Secretary.
- (6) Any rules made under subsection (2)(c) may-
- (a) prescribe fees fixed at; or
 - (b) provide for fees to be fixed at, levels that provide for the recovery of expenditure incurred or likely to be incurred by the Government or other authority in the exercise of any or all functions under this Ordinance, and shall not be limited by reference to the amount of administrative or other costs incurred or likely to be incurred in the exercise of any particular function.
- (7) Rules may provide for arrangements to be made by the Registrar for the publication of reports of cases relating to patents decided by the Registrar and of cases relating to patents (whether under this Ordinance or otherwise) decided by any court or body (whether in Hong Kong or elsewhere).

[cf. 1977 c. 37 s. 123 U.K.]

Chapter: **514C** Title: **PATENTS (GENERAL) RULES**
Section: **39** Heading: **Amendment of specification after grant**

Version Date: 30/06/1997

- (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.

Chapter: **514C** Title: **PATENTS (GENERAL) RULES**
Section: **100** Heading: **Alteration of time limits**

Version Date: 30/06/1997

- (1) The times or periods prescribed by these Rules for doing any act or taking any proceeding under the Rules, other than times or periods prescribed in the provisions mentioned in subsection (2), may be extended by the Registrar if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted even though the time or period for doing such act or taking such proceeding has expired.

- (2) The provisions referred to in subsection (1) are sections 11, 16, 17, 21, 23, 24, 29, 35(1), 39(1), 40(2), 48(4), 53, 57, 67, 68 and 69.