

**立法會**  
**Legislative Council**

LC Paper No. LS57/03-04

**Paper for the House Committee Meeting  
on 19 March 2004**

**Legal Service Division Report on  
Subsidiary Legislation gazetted on 12 March 2004**

**Date of tabling in LegCo** : 17 March 2004

**Amendment to be made by** : 24 March 2004 (or 5 May 2004 if extended by resolution)

**PART I SUBSIDIARY LEGISLATION RELATING TO INTELLECTUAL PROPERTY**

**Patents Ordinance (Cap. 514)**  
**Patents (General) (Amendment) Rules 2004** (L.N. 37)

**Registered Designs Ordinance (Cap. 522)**  
**Registered Designs (Amendment) Rules 2004** (L.N. 38)

The purposes of these two Rules are -

- (a) to provide a legal basis for the electronic filing of documents relating to patent and design registrations;
- (b) to reduce or remove the fees for processing applications and other related matters for patent and design registrations;
- (c) to repeal section 39 and to amend section 35 of the Patents (General) Rules in light of a court judgment;
- (d) to provide that a person filing documents with the Registrar of Patents or the Registrar of Designs should also serve the documents on all interested parties;
- (e) to simplify procedures for filing of documents with the Registrar; and
- (f) to make some technical amendments.

2. On items (a) and (b), it is noted that through computerization, some of the fees will be substantially reduced. For instance, the fees for the registration of a standard patent will be reduced from the current \$5,340 to \$896, while for short term patents, the cost will be reduced from \$4,070 to \$823. As for the registration of a design, the cost will be reduced from \$3,420 to \$940. The reduction is made possible largely because applicants for registration will not be required to advertise in the Government Gazette but is allowed to advertise in the "e-Official Journal". For those persons who do not wish to file documents by electronic means, they may still have the option to file on paper.

3. On item (c), members may recall that in October 2002, the Administration made the Patents (General) (Amendment) (No. 2) Rules 2002 (L.N. 157 of 2002) (the Amendment Rules) deleting the one-month time limit in section 39 of the Amendment Rules. The section provides that a proprietor of a patent, in respect of which the specification has been amended by court order under section 46 of the Patents Ordinance, shall file with the Registrar notice of the amendment within one month of the making of the court order. The one-month time limit is not to be extended.

4. A Subcommittee was formed to study the Amendment Rules. During scrutiny of the Amendment Rules by the Subcommittee, the Court of Final Appeal handed down a judgment (*Merck Sharp & Dohme Limited v. Registrar of Patents [2002] 3HKLRD 812*) which declared that section to be ultra vires and of no legal effect. The Court held that the rule-making power relating to how a court order is carried into effect resides with the Rules Committee of the High Court and not with the Registrar. It also stated that pending the making of new rules, a court making a court order allowing amendment of specifications of a patent may give ancillary directions such as directing that notice of the amendment should be filed with the Registrar within a stated period, with leave to parties to apply to the court for further directions.

5. In light of the judgment, members urged the Administration to review section 39 and other relevant provisions on time limits. The Administration agreed to conduct a comprehensive review on this issue and repealed the Amendment Rules.

6. Having conducted a review, the Administration proposed to the Panel on Commerce and Industry at the meeting on 9 February 2004 (vide LC Paper No.: CB(1)933/03-04(04), Annex E) that the relevant provision would be transposed to the Rules of the High Court and that the one-month time limit would be extensible. The proposal has been included in the draft Rules of the High Court (Amendment) Rules which is being studied by the Rules Committee of the High Court.

7. On the review of other provisions on time limits such as section 35 of the Patents (General) Rules, the Administration agreed to the intellectual property practitioners' request to amend the 3-month time limit by extending it to 6 months. Members of the Panel did not object to these proposals and they have been included in this legislative exercise.

8. As for other amendments mentioned in items (d), (e) and (f), they are mostly technical in nature.

**Trade Marks Ordinance (Cap. 559)**

**Trade Marks (Amendment) Rules 2004 (L.N. 39)**

9. These Rules amend Rule 103 of the Trade Marks Rules by requiring an agent to notify the Registrar of Trade Marks of the address in Hong Kong where he resides or carries on his business. This amendment is to reflect a requirement under the Trade Marks Ordinance.

**Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001)**

**Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (2 of 2001)  
(Commencement) Notice 2004 (L.N. 40)**

10. By virtue of the Commencement Notice, all the remaining sections of the Ordinance which have not yet commenced relating to the use of electronic means for the publication of patents and designs and other related notifications will come into operation on 7 May 2004. The other three pieces of subsidiary legislation, i.e. L.N. 37, 38 and 39, will also come into operation on the same day.

11. Members may refer to the LegCo Brief (File Ref.: CIB 06/08/8) issued by the Commerce, Industry and Technology Bureau in March 2004 for details of the above four pieces subsidiary legislation. According to paragraph 20 of the LegCo Brief, the relevant legal and professional organizations were consulted on a draft of the proposed Rules in October 2003. Some intellectual property practitioners have commented on the wording of certain Amendment Rules and the Administration has incorporated their comments where appropriate. The proposed amendments are acceptable to them.

12. The Administration submitted the subsidiary legislation in draft form to the Panel on Commerce and Industry at the meeting on 9 February 2004 for discussion. Members present at the meeting supported the proposals which would help reduce business cost. They considered that if necessary, a Subcommittee may be formed to study the subsidiary legislation.

13. We have then taken the opportunity to review the legal and drafting aspects of the subsidiary legislation in draft form and have raised some queries with the Administration. The Administration has taken into account most of our suggestions and has made some amendments to the drafts before gazetting the subsidiary legislation such as that to abide by the rule-making power, the Registered Designs (Amendment) Rules are to be made under sections 79, 80, 81 and 82 of the Registered Designs Ordinance (Cap. 522) and not just under one of the sections. (Please refer to the correspondences between our Division and the Administration attached at **Annex**).

14. The legal and drafting aspects of the subsidiary legislation are in order.

## **PART II COMMENCEMENT NOTICE**

### **Mutual Legal Assistance in Criminal Matters Ordinance (Cap. 525) Mutual Legal Assistance in Criminal Matters (Philippines) Order (Cap. 525 sub. leg. K) (Commencement) Notice 2004 (L.N. 41)**

15. The Order incorporating an Agreement between the Government of the Hong Kong Special Administrative Region of the People's Republic of China and the Government of the Republic of the Philippines concerning mutual legal assistance in criminal matters was approved by this Council on 19 December 2001. It had been examined by the Subcommittee on Mutual Legal Assistance in Criminal Matters (Canada) Order, Mutual Legal Assistance in Criminal Matters (Philippines) Order and Mutual Legal Assistance in Criminal Matters (Portugal) Order.

16. Under Article 21 of the Agreement, it shall enter into force thirty days after the date on which the Parties have notified each other in writing that their respective requirements for the entry into force of the Agreement have been complied with. The HKSAR Government has received a notice from the Philippines Government that the Order may come into force.

17. The Secretary for Security appoints 24 March 2004 as the day on which the Order is to come into operation.

Encl.

Prepared by

HO Ying-chu, Anita  
Assistant Legal Adviser  
Legislative Council Secretariat  
15 March 2004

LS/B/13/02-03  
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2877 5029

Secretary for Commerce, Industry and Technology  
(Attn: Mr Donald CHEN, Principal Assistant Secretary  
(Commerce and Industry))  
Commerce, Industry and Technology Bureau  
8/F West Wing  
Central Government Offices  
Ice House Street, Central  
Hong Kong

1 March 2004

**BY FAX**

Fax No. : 2869 4420  
Total No(s) of Page(s): (15)

Dear Mr. Chen,

**Draft Patents (General) (Amendment) Rules 2004,  
Registered Designs (Amendment) Rules 2004 and  
Trade Marks (Amendment) Rules 2004**

I refer to the above-mentioned draft Rules which were submitted to the Panel on Commerce and Industry on 9 February 2004 for discussion. I have taken the opportunity to review the legal and drafting aspects of the three draft Rules.

2. On the draft Patents (General) (Amendment) Rules, I have discussed with Miss Finnie Quek, Senior Solicitor of Intellectual Property Department and I have received the revised section 52 of the Rules.

3. On the draft Registered Designs (Amendment) Rules, please confirm that the proposed Rules are made under section 79 of the Ordinance and not under any other sections. I note that the existing Rules are made under sections 79, 80, 81 and 82 of the Ordinance.

4. While the English version of many of the provisions in the three draft Rules are the same, the Chinese versions differ. Should there be consistency in the Chinese versions as well? Enclosed please find the pages that I have marked up for your consideration.

Looking forward to your early reply.

Yours sincerely,

(Anita HO)  
Assistant Legal Adviser

Encl.

c.c. DoJ (Attn: Mr Jeffrey GUNTER, SALD and Ms Marie SIU, SGC)  
IPD (Attn: Miss Finnie Quek)  
LA

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Our Ref. : CIB 06/08/8  
Your Ref. : LS/B/13/02-03

4 March 2004

Miss Anita Ho  
Assistant Legal Adviser  
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Legal Service Division  
Legislative Council Building  
8 Jackson Road  
Central  
Hong Kong

Dear Ms Ho,

**Draft Patents (General) (Amendment) Rules 2004,  
Registered Designs (Amendment) Rules 2004, and  
Trade Marks (Amendment) Rules 2004**

Thank you for your letter of 1 March 2004.

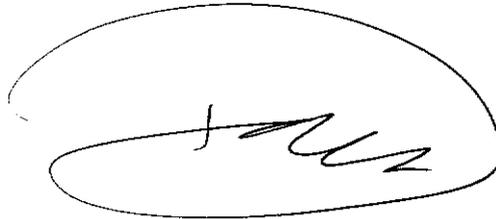
2. On your suggestion to review clause 24 of the draft Patents (General) (Amendment) Rules 2004 which amends section 52 of the Patents (General) Rules, we shall incorporate your suggestion to tidy up the grammatical presentation of the draft section. On your second suggestion to review the rule-making sections of the Registered Designs (Amendment) Rules 2004, we agree to include references to sections 80, 81 and 82 of the Registered Designs Ordinance as the rule-making sections for the subject amendment rules. A copy of these amendments in mark-up form is attached at Annex A for your reference.

3. As regards your third suggestion on aligning the Chinese text of the captioned amendment rules highlighted in your letter, the Law Draftsman and we have conducted a review on those sections. We have come up with a summary (Annex B) on the approach we propose to adopt. In the main, we shall align the Chinese text as you have suggested except in a few areas where the Chinese rendition is derived from other provisions of the same Rules or the principal ordinance concerned. For these, we shall have to adopt different Chinese text in order to maintain internal consistency between the head legislation and its subsidiary rules.

4. In view that the captioned amendment rules have to be issued next Tuesday (9 March) for printing in the Gazette, we shall be most pleased to discuss the above with you over the phone, and Ms Marie Siu, the Law Draftsman, will contact you in this regard. She will prepare a mark-up copy on the changes suggested under Annex B for your reference upon confirmation that the proposed changes are acceptable.

5. We look forward to your early reply.

Yours sincerely,

A handwritten signature in black ink, enclosed within a hand-drawn oval. The signature appears to be 'Donald Chen'.

( Donald Chen )

for Secretary for Commerce, Industry and Technology

Encl.

c.c. DoJ (Attn: Mr Jeffrey Gunter and Ms Marie Siu)  
IPD (Attn: Mrs Teresa Grant and Ms Sandra Hui)

**24. Section substituted**

Section 52 is repealed and the following substituted –

**“52. Order or direction by court**

(1) Where the court makes any order or gives any direction under any provision of the Ordinance except section 46 or 102 of the Ordinance, the person in whose favour the order or direction is made or given shall file a sealed copy of the order or direction with the Registrar.

(2) Where the court makes any order under section 46 or 102 of the Ordinance, the person in whose favour the order is made shall file with the Registrar a copy of any documents referred to in the order that show the amendments to be made, together with such translations of those documents as may be required under section 56 of these Rules.

→ (3) The ~~document~~documents and translations referred to in subsection (2) shall be filed at such time as a copy of the order is filed with the Registrar in accordance with the order or ~~directions~~direction made by the court or rules of court.”

**40. Section added**

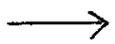
The following is added –

**“113. Transitional provision relating to the Patents (General) (Amendment) Rules 2004**

The amendments to sections 3, 4, 6, 7, 35, 37, 38, 40, 41, 48 and 108 of these Rules effected by sections 4, 5, 6, 12, 13, 14, 16, 17, 21 and 39 of the Patents (General) (Amendment) Rules 2004 (L.N. of 2004) do not apply to proceedings pending before the Registrar on the commencement of those sections, which proceedings shall continue as if those amendments had not been made.”



**REGISTERED DESIGNS (AMENDMENT) RULES 2004**



(Made under sections 79, 80, 81 and 82 of the Registered Designs Ordinance  
(Cap. 522) with the consent of the Financial Secretary)

**TRADE MARKS (AMENDMENT) RULES 2004**

1. **Clause 2 – new section 103**

(a) Subsection (3) :

- (i) The expression “authorized to act as an agent” is rendered as “獲授權以代理人身份行事” in subsection (1). For the sake of internal consistency, we did not follow the expression used in clause 31 of the Patents (General) (Amendment) Rules 2004 which amends rule 85 of the Patents (General) Rules.
- (ii) In the last phrase, we could add “而” before “該通知”, and add “須” before “是” for consistency with the corresponding sections of the other two Rules.

(b) Subsection (4) :

- (i) In rule 85(2) of Trade Marks Rules, “notice ... given” is rendered as “發出...通知”. For the sake of internal consistency, the Chinese rendition is adopted.
- (ii) In section 57(5) of Trade Marks Ordinance, “change” is rendered as “改變”. For the sake of internal consistency, the Chinese rendition is adopted.
- (iii) In section 29(4)(b) of Trade Marks Ordinance, “as soon as practicable thereafter” is rendered as “在其後在切實可行範圍內盡快”. For the sake of internal consistency, the Chinese rendition is adopted.
- (iv) We shall move the word “如” at the beginning of the subsection to after “人” and add the word “而” before “該通知” and add “須” before “是” for consistency with the corresponding sections of the other two Rules.

- (c) Subsection (5) : For the sake of internal consistency, we followed the sentence structure adopted in rule 105(10) of the Trade Marks Rules.

**REGISTERED DESIGNS (AMENDMENT) RULES 2004**

2. **Clause 3 – new section 2A(b)**

We shall amend the new section 2A(b) of the Patents (General) (Amendment) Rules 2004 to achieve consistency with the above provision.

3. **Clause 5 – new section 7(3)**  
“additional” is rendered as “額外” in rule 8(2) of the Trade Marks Rules which is appropriate in the context.
4. **Clause 7 – amendment to section 11(2)**  
The word “verifying” qualifies “certificate” and there is no need to make any amendment.
5. **Clause 18 – new section 55A**  
This will be amended to follow section 93E of the Patents (General) (Amendment) Rules 2004.
6. **Clause 22 – new section 60(1)**  
The word “予” will be added after “交付” to follow section 93 of the Patents (General) (Amendment) Rules 2004.
7. **New section 60B**
  - (a) “對” will be deleted from section 93B(1)(c) of the Patents (General) (Amendment) Rules 2004.
  - (b) “附同” will be used in section 60B(1)(d) and (2)(d) to follow section 93B of the Patents (General) (Amendment) Rules 2004.
  - (c) “會” will be replaced with “已” in section 60B(2)(d) to follow section 93B of the Patents (General) (Amendment) Rules 2004.
8. **New section 60C**
  - (a) Subsection (1) : We shall replace “要求” with “請求” to follow section 93C of the Patents (General) (Amendment) Rules 2004.
  - (b) Subsection (2) : Section 93C(2) of the Patents (General) (Amendment) Rules 2004 will be amended to follow section 60C(2).
9. **New section 61**  
This will be amended to follow section 93D of the Patents (General) (Amendment) Rules 2004.
10. **Clause 24 – New section 65**
  - (a) Subsection (1) : We shall adopt “關涉” to replace “與” and “有關” to follow section 42 of the Patents (General) (Amendment) Rules 2004.
  - (b) Subsection (3): “Where” is rendered as “如” in sections 53, 59(1) and 67(3) of the Registered Designs Rules, whereas it is rendered as “凡” in

section 65 of the Patents (General) Rules. Therefore, we have not adopted the same wording.

- (c) Subsection (4) : “的” will be added before “名義” to follow section 42 of the Patents (General) (Amendment) Rules 2004.
- (d) Subsections (5) and (6) :
  - (i) We shall replace “在處長席前” with “於處長席前” to follow section 42 of the Patents (General) (Amendment) Rules 2004, and
  - (ii) “concerning” is rendered as “關於” in section 25(2)(d) of the Registered Designs Rules and as “關乎” in section 18(2) of the Patents (General) Rules. Therefore, we have not adopted the same wording.
- (e) Subsections (7) and (8) : please see our comments on subsection (3) above.
- (f) Subsection (9) : “in connection with” is rendered as “關乎” in section 83(1)(a) of the Patents (General) Rules, and as “與.....有關連” in section 74 of the Registered Designs Ordinance. Therefore, we have not adopted the same wording.
- (g) Subsection (10) : “以” will be deleted as “by notice in writing” is rendered as “藉書面通知” in section 67(1) of the Registered Designs Rules.

11. New section 65A

Subsection (3) : section 42A of the Patents (General) (Amendment) Rules 2004 will be amended to follow section 65A(3).

12. Clause 26 – new section 67

- (a) Subsection (4) : We shall retain “更改” here, and amend new section 85(5) of the Patents (General) (Amendment) Rules 2004 for “更改” to replace “改變”.
- (b) Subsection (6) : Thanks for pointing out the missing word “者”. We shall ensure no same technical slippage in the Gazette version.

13. Clause 27 – New section 73A

Subsection (2): We would prefer retaining “限期”. The corresponding section 100A of the Patents (General) (Amendment) Rules 2004 uses “期間” instead because there is the need to achieve internal consistency with the Patents Ordinance - under section 149(2)(g), “period of time” is rendered as “期間”.