



中華人民共和國香港特別行政區  
Hong Kong Special Administrative Region of the People's Republic of China



立法會秘書處 法律事務部  
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2 Tim Mei Avenue, Tamar  
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Dear Ms TAM,

### **Patents (Amendment) Bill 2015**

I am scrutinizing the legal and drafting aspects of the Bill and should be grateful for your clarification on the issues set out below.

#### **Part I: Legal Issues**

##### Clause 11 of the Bill

New section 9F of Cap. 514 is modelled upon the current section 45 of Cap. 514. Under the current section 45(2) of Cap. 514, if the Registrar makes a finding that a person ought not to have been mentioned as sole or joint inventor, the Registrar shall accordingly amend the register and any undistributed copies of the patent, and may issue a certificate to the effect of the Registrar's finding. It is noted that the requirement to amend any undistributed copies of the patent is omitted from new section 9F of Cap. 514. Instead, the Registrar is required to advertise the fact of the amendment by notice in the official journal. Please explain.

### Clauses 34(5) and 35(7) of the Bill

Both the existing sections 28(3) and 29(5) of Cap. 514 contain references to the current section 25(3) of Cap. 514. Under clause 30 of the Bill, the matters provided for in the current section 25(3) of Cap. 514 are set out in the amended section 25(2) and (4) of Cap. 514. However, the amended section 25(2) of Cap. 514 is only referred to in the amended section 28(3) but not in the amended section 29(5) of Cap. 514. Please clarify.

## **Part II: Drafting Issues**

### Clause 5(8) of the Bill

With respect to the expression "Application for a standard patent (標準專利的申請)" under section 2(2) of Cap. 514, should "standard patent (R) application" and the corresponding Chinese rendition be added in view of the amendment made to section 3 of Cap. 514 under clause 6(2) of the Bill, in addition to the amendment made under clause 5(8) of the Bill?

### Clauses 7 and 13 of the Bill

Both the existing sections 4(1) and 10 of Cap. 514 contain the definitions of "designated patent" and "designated patent application". Please consider to provide for a consolidated definition for each term in Cap. 514 to avoid any confusion as to which is the correct definition.

### Clause 24(1) of the Bill

Please consider to replace ("the formal requirements") with "*(formal requirements)*" in the English text of section 19(1) of Cap. 514 under clause 24(1) of the Bill to align with its Chinese text. We note that the same kind of amendment is also made to section 18(1)(a) of Cap. 514 under clause 23(1) of the Bill.

### Clause 26 of the Bill

The English text of section 22(1)(b) of Cap. 514 contains an expression "a divisional corresponding designated patent application". Though defined, it has not been used in Cap. 514. Should it be "a divisional designated patent application" instead?

Clause 35 of the Bill

Section 29(4) of Cap. 514 provides that the Registrar may by regulation amend the periods specified in section 29(2)(a) of Cap. 514 within which a notice under section 29 of Cap. 514 shall be filed. Should "a notice" be "an application" instead?

I would be grateful if you could let me have your reply in bilingual form as soon as possible.

Yours sincerely,



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Assistant Legal Adviser

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