

香港特別行政區政府
商務及經濟發展局
工商及旅遊科

香港添馬添美道二號
政府總部西翼二十三樓



COMMERCE, INDUSTRY AND TOURISM BRANCH
**COMMERCE AND ECONOMIC
DEVELOPMENT BUREAU**

GOVERNMENT OF THE HONG KONG
SPECIAL ADMINISTRATIVE REGION

23/F, WEST WING
CENTRAL GOVERNMENT OFFICES
2 TIM MEI AVENUE
TAMAR, HONG KONG

Our Ref : CITB 06/18/23
Your Ref : LS/B/2/15-16

Tel : (852) 2810 2862
Fax : (852) 2147 3065

1 February 2016

Ms Wendy KAN
Assistant Legal Adviser 6
Legal Service Division
Legislative Council Secretariat

Dear Ms KAN,

Patents (Amendment) Bill 2015

Thank you for your letter of 8 January 2016. Our responses are set out below.

Part I: Legal Issues

Clause 11 of the Bill

2. Section 45(2) of the Patents Ordinance (“PO”) currently requires the Registrar to amend, amongst others, “undistributed copies of the patent” upon making a finding that a person who has been mentioned in the patent as sole or joint inventor ought not to have been so mentioned. This specific requirement is modelled on the corresponding section in the Patents Act 1977 of the United Kingdom.

3. In re-enacting this provision as the new section 9F, we, having reviewed the practice of the Registrar, note that “undistributed copies of the patent” is no longer a class of documents that would be generated by the Registrar for distribution. As such, to reflect the Registrar’s contemporary practice, we consider it appropriate to omit the reference to “unpublished copies of the patent” in the new section 9F(3) which replaces section 45(2). To enhance transparency, the new section 9F(3) also requires the Registrar to advertise the notice of his or her amendment to the register in the official journal.

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

4. Clause 34(5) seeks to amend section 28(3) of the PO by specifying the provisions in the PO to which section 28, i.e. in cases of an application for reinstatement of an application for standard patent (R) which has been refused or deemed to be withdrawn as a result of the applicant's failure to comply with a prescribed time limit, does not apply.

5. The amended section 25(2) refers to refusal of an application for standard patent (R) on the basis of deficiencies that cannot be corrected. The proposed inclusion of the amended section 25(2) into section 28(3) is mainly for the avoidance of doubt. It makes clear that the refusal of an application for standard patent (R) under the amended section 25(2) cannot be subject to an application for reinstatement under section 28.

6. On the other hand, Clause 35(7) seeks to amend section 29(5) of the PO by specifying the provisions in the PO to which section 29, i.e. in cases of an application for restoration of rights in an application for standard patent (R) as a result of the applicant's failure to comply with a prescribed time limit, does not apply.

7. Given that the deficiencies underlying the refusal of an application for standard patent (R) under the amended section 25(2) cannot be corrected, there is no "right" to correct such deficiencies in the first place. As such, there is no right to be restored for the purpose of section 29. Accordingly, it is not necessary to refer to the amended section 25(2) in the amended section 29(5) and such reference is therefore omitted.

Part II: Drafting Issues

Clause 5(8) of the Bill

8. We have no objection to adding the reference to "standard patent (R) application (轉錄標準專利申請)" in section 2(2) of Cap. 514.

Clauses 7 and 13 of the Bill

9. We have not dealt with this issue in the Bill given that the main focus of this legislative exercise is to introduce an "original grant" patent ("OGP") system in Hong Kong while retaining the current "re-registration system" for standard patents, and that we consider it preferable for the proposed amendments to Part 2 of the Ordinance to focus on the necessary amendments which are consequential to the introduction of the OGP system. We note your observation on the definitions and are considering the most appropriate channel for dealing with it.

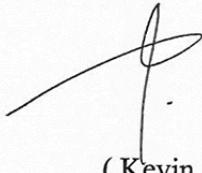
Clauses 24(1) of the Bill

10. We have no objection to replacing “(“the formal requirements”)” by “(*formal requirements*)” for alignment with its Chinese text.

Clauses 26 and 35 of the Bill

11. For the reason explained in paragraph 9, we have not dealt with this issue in the Bill. We note your observation on the expression and are considering the most appropriate channel for dealing with it.

Yours sincerely,



(Kevin LI)

for Secretary for Commerce and Economic Development

c.c. DoJ (Attn: Ms Mabel CHEUNG, Sr Asst Law Draftsman (Ag.))
Mr Gary LI, Govt Counsel)

IPD (Attn: Miss S K LEE, DDIP)