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商務及經濟發展局
工商及旅遊科



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Your Ref : LS/S/23(2)/18-19

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8 April 2019

Dear Mr Ip,

Patents (General) (Amendment) Rules 2019

Thank you for your letter of 29 March 2019 and the list of follow-up actions arising from the discussion at the meeting on 2 April 2019. Our response is set out below.

References to “State Intellectual Property Office”

2. We are aware that the patent authority in the Mainland has changed its official English title from “State Intellectual Property Office” to “China National Intellectual Property Administration” since 28 August 2018 whereas its official Chinese title (i.e. “國家知識產權局”) has remained unchanged. Both the titles “State Intellectual Property Office” and “國家知識產權局” have been used in the *Patents Ordinance*, Cap. 514 (“**PO**”) (e.g. section 125) and its subsidiary legislation (e.g. sections 2 and 3 of the *Patents (Designation of Patent Offices) Notice*, Cap. 514A, and sections 2, 15 and 78 of the *Patents (General) Rules*, Cap. 514C (“**PGR**”). We will update the references to the aforesaid English official title in the PO and its subsidiary legislation in one go as early as possible.

Section 19 of L.N. 35 of 2019 – "Example" located after new section 31O of PGR

3. The examples used in the new section 31O(2)(b)(xvi)(A) governing drawings in applications for standard patent by original grant (“**standard patent (O) applications**”) are the same as those examples listed in the current section 60(2)(k) governing the same subject matter in short-term patent applications. These two provisions mirror each other to provide for the same substantive requirements on drawings in standard patent (O) applications and in short-term patent applications. The examples given in both provisions (which are by no

means exhaustive in nature) seek to better illustrate how these provisions work in practice. The format and location of the examples used in section 31O(2)(b)(xvi)(A) reflect the current drafting practice. Like the examples given in the current section 60(2)(k), the examples given in the new section 31O(2)(b)(xvi)(A) are part of PGR and have the same illustrative effect.

4. Generally speaking, the purpose of using an example is to facilitate the reader in gaining a better understanding of the law. A complex concept or a technical provision, e.g. a provision governing drawings in patent applications, can be understood more easily if illustrated by an example showing how it works in practice. Given the highly technical nature of patent applications, and the fact that the same examples have been used in the current section 60(2)(k) for governing the same subject matter, we consider it appropriate (and consistent with the existing approach adopted by PGR) to use examples in the new section 31O(2)(b)(xvi)(A).

Sections 19 and 40(16) of L.N. 35 of 2019 – "Notes" located after new sections 31O and 60(3) of PGR

5. The respective notes at the end of the new section 31O and the current section 60(3) are intended to guide the reader to another relevant provision in PGR.

6. Generally speaking, under the current drafting practice, the use of notes in legislation is a widely adopted plain language technique. In providing signposts or other factual information, such notes help the reader to understand the legislation more quickly and get a clearer picture of it. A note that is used for the purpose of giving information to the reader would not affect the interpretation of the legislation.

7. In the present case, the purpose of the notes as the reader's aids is clear from the context and does not require further express clarification.

Section 19 of L.N. 35 of 2019 – "Request to review" in new section 31ZI etc. of PGR

8. If the Registrar of Patents ("**Registrar**") is aware that a provisional refusal notice has been issued incorrectly, and the Registrar is also satisfied that the standard patent (O) application has complied with all examination requirements specified in section 37U(3) of PO as amended by the *Patents (Amendment) Ordinance 2016*, the Registrar has power to withdraw the provisional refusal notice on his own initiative under section 94(1) of PGR to

rectify such irregularity in procedure, and then proceed to grant the standard patent (O).

9. The same statutory power of rectification of irregularity in procedure under section 94(1) of PGR is likewise exercisable by the Registrar on his own initiative in the similar situation under the new section 31ZM(4) of PGR for rectifying incorrect issuance of a final refusal notice by the Registrar in a standard patent (O) application.

Section 19 of L.N. 35 of 2019 – “Review opinion” in new section 31ZJ of PGR

10. The Registrar will, where appropriate, issue an examination notice under the new section 31ZD of PGR or a review opinion under the new section 31ZJ of PGR only once throughout the substantive examination of a standard patent (O) application. If the applicant has filed a response to the examination notice or a response to the review opinion under the new section 31ZE or 31ZK of PGR respectively, and the Registrar considers that elaboration, revision or clarification of any matter set out in such response is required, the Registrar will issue a further examination notice or a further review opinion under the new sections 31ZF(2) and 31ZL(2) of PGR. Such further examination notice or further review opinion may be issued for more than once in appropriate cases.

New section 31N(3) and existing section 59(2) of PGR

11. The phrase "a more economical presentation" (rendered as "較為簡約的呈示" in the Chinese text) is used in the new section 31N(3), whereas the phrase "a more economic presentation" (rendered as "較為省儉的呈示" in the Chinese text) has been used in the existing section 59(2) which was made in 1997. The two formulations carry substantively the same meaning in the context of the relevant provisions, though the pair of “economical” and “簡約” is more commonly used and easily understood nowadays (when compared with the pair of “economic” and “省儉”) in describing the manner and order of a presentation, and is therefore used in the new section 31N(3). We are prepared to consider updating section 59(2) to align the wording between the relevant provisions when the next opportunity arises.

Section 143(1)(b) of PO and new sections 31ZH and 31ZN of PGR & list of follow-up actions arising from the discussion at the meeting on 2 April 2019

12. We consider that the reference to “any [patent] application has been refused” in section 143(1)(b) of PO as amended by the *Patents (Amendment)*

Ordinance 2016 should logically be construed as the final decision of the Registrar on refusal to grant a patent, which covers issuance of a final refusal notice by the Registrar under the new section 31ZN(2) of PGR regarding a standard patent (O) application. If the Registrar has merely made a provisional decision on refusal to grant a standard patent (O) and issued a provisional refusal notice under the new section 31ZH of PGR, such provisional decision and such provisional refusal notice is still subject to the applicant's entitlement to file a request to review the Registrar's opinion within 2 months after the date of the provisional refusal notice under the new section 31ZH(2)(c) and 31ZI(1) of PGR. Accordingly, such standard patent (O) application is still, objectively and logically speaking, considered as pending before the Registrar, and section 143(1)(b) is not applicable to such a pending application.

13. We note your remarks at the meeting on 2 April 2019 on the above reference in PO. However, in our view, the meaning of section 143(1) is clear enough and the formulation of the provision, when being read as a whole, is unlikely to give rise to any misinterpretation. In any event, any amendment to better reflect the meaning of section 143(1), if required, will have to be made to the principal ordinance itself by another bill. Having said the above, we are prepared to review the need of refining section 143(1) so as to bring out its underlying policy intent as per paragraph 12 above more explicitly in our next review exercise for PO.

14. In addition, the Intellectual Property Department, which conducts public education or promotion campaigns from time to time for enhancing public awareness of and respect for intellectual property, will consider how best the respective scope of section 143 and the other offence provisions in PO can be clearly drawn to the public attention through such education/promotion channels as appropriate.

Yours sincerely,



(Vivian Chan)

for Secretary for Commerce and Economic Development

c.c. Clerk to Subcommittee

Director of Intellectual Property (Attn: Mr Thomas Tsang)

Department of Justice (Attn: Mr Jonathan Luk)