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Secretary for Commerce, Industry & Technology
(Attention: Ms Priscilla TO, PAS(C&I)3)
Commerce, Industry & Technology Bureau
Level 29 One Pacific Place
88 Queensway
Hong Kong

7 May 2007

BY FAX
Fax No. : 2869 4420

Dear Ms TO,

Patents (Amendment) Bill 2007

I am scrutinizing the legal and drafting aspects of the above Bill. I would be most grateful if you could clarify the following matters:-

Proposed section 72H

It is noted that the following acts are mentioned under the proposed section 72C:-

- (a) importing, putting on the market, stocking or using the patented pharmaceutical product; and
- (b) any other act which would, apart from section 72C, amount to an infringement of the patent concerned.

However, under the proposed 72H(1), the above mentioned (b) is not included. It would assist Members if reason(s) for this difference are stated for their information.

It is expressly stated in the proposed section 72H(2) that a person to whom a patented pharmaceutical product is disposed of in accordance with an import compulsory licence shall not export or cause to export the product out of Hong Kong (which shall be a term and condition of the import compulsory licence under the proposed section 72D). Please confirm whether other terms and conditions of the import compulsory licence are also applicable to the person to whom a patented pharmaceutical product is disposed of.

Proposed section 72I

It would assist Members if you could give examples of the type of persons under the proposed section 72I(2) who is not a party to any agreement reached on the amount of remuneration under the proposed section 72E(2)(a) but is entitled to claim remuneration payable under the proposed section 72E(2).

Under the proposed section 72I(6), any person aggrieved by any of the matters under subparagraph (a) to (d) may, within 28 days after the date of the advertisement of the notice under the proposed section 72F(1)(b) or (2)(a)(i) or the date of the termination of the licence or such further period as may be allowed by the court, apply to the court for a review. It is noted that the date of the termination of the licence is used in this proposed subsection instead of the date of the advertisement of the notice under the proposed section 72G(2)(b). It would assist Members if the rationale behind this arrangement could be elaborated.

Proposed section 72K(2)(b)(iii)

According to the proposed section 72K(2)(b)(iii), it is a mandatory requirement for an application for an export compulsory licence to be accompanied by a copy of notice of the intended application given to the proprietor of the patent concerned under the proposed subsection (4)(b)(i) or (5)(a)(i). However, it appears that there is a third possibility under the proposed subsection (5)(a)(ii) for the applicant to give the proprietor of the patent concerned notice of the application as soon as practicable after the application is made (where the eligible importing member has notified the TRIPS Council that it is faced with a national emergency or other circumstances of extreme urgency). In such circumstances, the applicant would not be able to comply with the mandatory requirement under the proposed section 72K(2)(b)(iii). It would be helpful to Members if reason(s) for this arrangement are stated for their information.

Proposed section 72N

It is noted that unlike the situation for an import compulsory licence (under the proposed section 72F(2)), there is no requirement on the Director of Health to advertise in the official journal a notice in relation to the amount of remuneration in respect of an export compulsory licence under the proposed section 72N. It would assist Members if the rationale behind this arrangement could be elaborated.

Proposed section 72Q

Under the proposed section 72Q(1), any person aggrieved by any of the matters under subparagraph (a) to (c) may, within 28 days after the date of the advertisement of the notice under the proposed section 72N(b) or the date of the termination of the licence or such further period as may be allowed by the court, apply to the court for a review. It is noted that the date of the termination of the licence is used in this proposed subsection instead of the date of the advertisement of the notice under the proposed section 72P(2)(b). It would also assist Members if the rationale behind this arrangement could be elaborated.

I shall be most grateful if you could let me have your response in both Chinese and English on the above queries at your earliest convenience.

Yours sincerely,

(Timothy TSO)
Assistant Legal Adviser

cc. DoJ (Attn.: Ms. Carmen CHU, SGC and Ms. Amy CHAN, GC)
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