

Patents (Amendment) Bill 2015
Debate and voting arrangements

Main object of the Bill : To amend the Patents Ordinance (Cap. 514) (“the Ordinance”) to provide for standard patents by original grant and substantive examination of short-term patents; to prohibit the use of certain titles and descriptions in providing patent agency services; to make technical and miscellaneous amendments to improve the operation and presentation of the Ordinance; and to provide for related and transitional matters.

First debate	: Clauses with no amendment	– Clauses 1 to 4, 6, 7, 8, 10, 11, 12, 14 to 23, 25, 27 to 30, 32, 33, 34, 36 to 44, 46 to 77, 79 to 95, 97 to 105, 107 to 113, 115 to 119, 121, 122, 124 to 128, and 130 to 134
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Voting	: To vote on the above clauses standing part of the Bill
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Second debate	: Clauses with amendments proposed by the Secretary for Commerce and Economic Development	– Clauses 5, 9, 13, 24, 26, 31, 35, 45, 78, 96, 106, 114, 120, 123 and 129
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Joint debate on the original clauses and the amendments thereto.

Debate theme: Amendments to the above clauses of the Bill on various matters

Clauses 5, 9, 13, 24, 26, 31, 35, 45, 114 and 120

- To amend the above clauses to improve the clarity and drafting of the relevant provisions, or to achieve consistency of the references in or the Chinese and English texts of the relevant provisions.

Clauses 45, 96 and 106

- To amend the definition of *non-Hong Kong application* in the proposed section 37A in clause 45 and the proposed section 108A in clause 96 to specify that the definition does not cover patent applications under the Ordinance; and
- to amend the definition of *specified application* in the proposed section 37M(6) in clause 45 and the proposed section 114(7) in clause 106 to specify that the definition does not cover patent applications under the Ordinance.

Clause 78

- To amend the proposed section 89A(2)(a), (b) and (c) to specify the circumstances under which a plaintiff is not entitled to relief claimed in relief proceedings where a threat alleged an infringement of a short-term patent in respect of which a certificate of substantive examination has not been issued;

- to add section 89A(2A) to specify that for the purposes of section 89A(2)(c) as amended:
 - (i) the period for provision of patent information by a defendant in relief proceedings (i.e. a patent owner) will be extended from 7 days to 14 days from the date of delivery of the request for information or any longer period agreed to by the requestor of such information;
 - (ii) the request for information should be made in writing and accompanied by a copy of section 89A as amended to alert the defendant of the relevant statutory requirements for defending a claim on groundless threats (including the need to comply with the request for patent information); and
 - (iii) the request for information is taken to have complied with if a plaintiff in relief proceedings has already been provided with the relevant patent information on or before the request date; and
- to replace the definition of *patent documents* with the definition of *patent information*, and to add the definition of *request date* in the proposed section 89A(5).

Clause 120

- To add section 127B(3A) to specify the circumstances under which no request for substantive examination of a short-term patent may be made to avoid abuse of the system. If a short-term patent has been substantively examined or a request for examination has been made and no order on termination of the substantive examination is made by the court, the proprietor of the short-term patent or a third party may not request substantive examination of the patent again.

Clause 123

- To amend the proposed section 129(2) in clause 123, and consequentially delete clause 123(4) and make consequential technical amendments to the proposed section 129(3) in clause 123(5) to:
 - (i) provide that in any enforcement proceedings, it is for the proprietor of a short-term patent to establish the validity of the patent;
 - (ii) specify the types of evidence adduced by the proprietor; and
 - (iii) provide that the patent is to be presumed valid in the absence of evidence to the contrary by the party challenging the patent validity.

Clause 129

- To amend the proposed section 144A(2)(e) and consequentially delete the proposed section 144A(4) and (6) to clarify whether the use of certain titles and descriptions would fall within the scope of the proposed prohibition on the qualification for providing patent agency services under the proposed section 144A(2)(e), as well as the relevant criminal threshold.

Voting : To vote on the above amendments together, and then vote on the original clauses or the clauses as amended standing part of the Bill

Secretary for Commerce and Economic Development's amendments
 (Printed in LC Paper No. CB(3) 629/15-16 issued on 25 May 2016)

Council Business Division 3
 Legislative Council Secretariat
 31 May 2016