

立法會
Legislative Council

LC Paper No. CB(1)1233/18-19
(These minutes have been seen
by the Administration)

Ref : CB1/SS/12/18

Subcommittee on Patents (General) (Amendment) Rules 2019

Minutes of first meeting
on Tuesday, 2 April 2019, at 11:00 am
in Conference Room 2 of the Legislative Council Complex

Members present : Hon CHUNG Kwok-pan (Chairman)
Hon WONG Ting-kwong, GBS, JP
Hon Paul TSE Wai-chun, JP
Hon WU Chi-wai, MH
Hon Charles Peter MOK, JP
Ir Dr Hon LO Wai-kwok, SBS, MH, JP
Hon Holden CHOW Ho-ding

Member absent : Dr Hon Elizabeth QUAT, BBS, JP

**Public officers
attending :** Agenda Item II

Commerce and Economic Development Bureau

Miss Alice CHOI
Principal Assistant Secretary for Commerce & Economic
Development (Commerce & Industry)³

Ms Vivian CHAN
Assistant Secretary for Commerce & Economic
Development (Commerce & Industry)^{3B}

Intellectual Property Department

Mr Thomas TSANG
Assistant Director of Intellectual Property (Patents &
Designs)

Mr Derek LAU
Senior Solicitor (Patents & Designs)2

Mr Frederick KWOK
Solicitor (Patents & Designs)2

Department of Justice

Mr Jonathan LUK
Senior Government Counsel

Mr Salvador TSANG
Government Counsel

Clerk in attendance : Mr Desmond LAM
Chief Council Secretary (1)3

Staff in attendance : Mr Cliff IP
Assistant Legal Adviser 8

Mr Joey LO
Senior Council Secretary (1)8

Miss Zoe YIP
Clerical Assistant (1)3

Action

I. Election of Chairman

Mr WONG Ting-kwong, the Member who had the highest precedence among members of the Subcommittee present at the meeting, presided at the election of the chairman of the Subcommittee. Mr WONG invited nominations for the chairmanship of the Subcommittee.

2. Mr CHUNG Kwok-pan was nominated by Mr Holden CHOW and the

nomination was seconded by Mr Paul TSE. Mr CHUNG accepted the nomination.

3. There being no other nomination, Mr CHUNG Kwok-pan was elected Chairman of the Subcommittee. Mr CHUNG then took the chair.

4. Members agreed that it was not necessary to elect a Deputy Chairman.

II. Meeting with the Administration

(L.N. 35 of 2019 -- Patents (General) (Amendment) Rules 2019

LC Paper No. CB(1)816/18-19(01) -- Marked-up copy of the Patents (General) (Amendment) Rules 2019 prepared by the Administration (Restricted to members only)

File Ref: CITB 06/18/23 -- Legislative Council Brief issued by the Commerce and Economic Development Bureau

LC Paper No. LS59/18-19 -- Legal Service Division Report

LC Paper No. CB(1)816/18-19(02) -- Background brief prepared by the Legislative Council Secretariat

LC Paper No. CB(1)816/18-19(03) -- Assistant Legal Adviser's letter dated 29 March 2019 to the Administration)

5. The Subcommittee deliberated (Index of proceedings attached at **Annex**).

Follow-up action by the Administration

6. Given that the general public might regard a "provisional refusal notice" issued by the Registrar of Patents under the new section 31ZH of the Patents (General) Rules (Cap. 514C) (as added by section 19 of the Patents (General) (Amendment) Rules 2019 (L.N. 35 of 2019) ("PGAR")) as a refusal for the purposes of section 143(1)(b) of the Patents Ordinance (Cap. 514) ("PO") (as amended by the Patents (Amendment) Ordinance 2016 (Ord. No. 17 of 2016), the Administration was requested to consider whether to amend the relevant provision(s) so as to better reflect its policy intent regarding whether section 143(1)(b) of PO applied to a recipient of that notice.

(Post-meeting note: The response provided by the Administration was circulated to members on 8 April 2019 (LC Paper No. CB(1)849/18-19(02)).)

II. Any other business

Invitation of views

7. Members agreed that it was not necessary to invite the public and relevant organizations to give oral representations or written submissions on PGAR.

Legislative timetable

8. The Subcommittee noted that the Chairman would move a proposed resolution at the Council meeting of 17 April 2019 to extend the scrutiny period of PGAR to the Council meeting of 8 May 2019. If the scrutiny period was extended, the deadline for giving notice to move amendments to PGAR would be 30 April 2019, and the Chairman would report the deliberations of the Subcommittee to the House Committee on 26 April 2019.

Date of next meeting

9. The Chairman said that the next meeting would be held on Tuesday, 9 April 2019.

10. There being no other business, the meeting ended at 12:26 pm.

**Proceedings of the first meeting of
the Subcommittee on Patents (General) (Amendment) Rules 2019
on Tuesday, 2 April 2019, at 11:00 am
in Conference Room 2 of the Legislative Council Complex**

Time marker	Speaker	Subject(s)	Action required
Agenda Item II – Meeting with the Administration			
000432 – 000604	Chairman Mr WONG Ting-kwong Mr Holden CHOW Mr Paul TSE Mr CHUNG Kwok-pan	<u>Election of Chairman</u> Mr CHUNG Kwok-pan was elected Chairman of the Subcommittee.	
000605 – 000826	Chairman Administration	Opening remarks by the Chairman.	
000827 – 001633	Chairman Administration	Briefing by the Administration on the Patents (General) (Amendment) Rules 2019 (L.N. 35 of 2019) ("PGAR").	
001634 – 002057	Chairman Mr Holden CHOW Administration	<p>The Chairman and Mr Holden CHOW enquired about the manpower resources to cope with the anticipated increase in workload upon the implementation of the original grant patent ("OGP") system and the refined short-term patent ("STP") system (collectively known as the "new patent system").</p> <p>The Administration advised that:</p> <p>(a) under the existing re-registration system for the grant of standard patents and also the existing STP system, as the examiners of the Patents Registry ("Registry") of the Intellectual Property Department ("IPD") were only required to conduct formality examination of patent applications, they were not required to possess any academic background, knowledge or working experience in any scientific/technological field ("relevant credentials");</p> <p>(b) to prepare for the implementation of the new patent system, IPD acquired additional resources to expand the establishment of the Registry by recruiting patent examiners with the relevant credentials (covering broadly the most common scientific/technological fields of Chemistry, Electricity and Mechanical Engineering for patent</p>	

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		<p>applications) who would be assigned to carry out the new statutory duties, notably for processing patent cases involving substantive examination under the new patent system;</p> <p>(c) additional provisions had been acquired by IPD for running the Registry under the new patent system;</p> <p>(d) at the launch of the new patent system, the Registry would have a total of six patent examiners (three at the rank of Senior Intellectual Property Examiner and the remaining three at the rank of Intellectual Property Examiner I) to handle cases involving substantive examination under the new patent system; and</p> <p>(e) IPD would monitor the nature, volume and growth of caseload after rolling out the new patent system and, where necessary, might seek additional resources in accordance with the established mechanism.</p>	
002058 – 002251	Chairman Administration	<p>In response to the Chairman's concern about the fairness of the review mechanism for the provisional decisions of the Registrar of Patents ("Registrar") on refusal to grant OGP applications, the Administration advised that:</p> <p>(a) the examination procedures for OGP applications would provide sufficient opportunities for an OGP applicant to respond to the Registrar's provisional decision on refusal to grant an application. In essence, the applicant would be entitled to request a review of the Registrar's provisional decision on refusal by filing written representation and taking up an opportunity given by the Registrar to request a hearing so as to address each review opinion or any further review opinion issued by the Registrar during the review procedure. A similar review mechanism was in place in the procedure for application of trade mark registration;</p>	

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		<p>(b) although the statutory power to issue a provisional refusal notice or a final refusal notice rested with the Registrar, appropriate internal administrative arrangements would be in place to ensure the fairness of the review mechanism for all OGP applications; and</p> <p>(c) the applicant would be entitled to appeal to the Court of First Instance against the final decision of the Registrar on the refusal to grant a patent.</p>	
002252 – 003015	Chairman Administration	<p>In response to the Chairman's enquiry about the review mechanism in patent offices in the Mainland and in other jurisdictions, the Administration advised that in the Mainland, the China National Intellectual Property Administration ("CNIPA") had set up a Patent Reexamination Board to handle review cases. In Hong Kong, the examination of a patent inclusive of a review would be conducted by the Registry, but the Registry would generally deploy different officer(s) to conduct the review so as to ensure fairness and impartiality of the review.</p>	
003016 – 003713	Chairman Mr Holden CHOW Mr WU Chi-wai Administration	<p>Mr Holden CHOW and Mr WU Chi-wai were of the view that setting up the Patent Prosecution Highway ("PPH") or having related bilateral or multilateral arrangements with the patent offices in other jurisdictions would expedite the examination of corresponding patent applications and facilitate applicants to seek patent protection in those jurisdictions of the participating patent offices thereby reducing the overall processing time and costs. They enquired about the other advantages of having such bilateral or multilateral arrangements for expediting examination of patent applications and whether the Administration had made any progress on establishing PPH with other patent offices.</p> <p>The Administration advised that:</p> <p>(a) setting up PPH with the patent offices in other jurisdictions could help sustain the long-term development of the new patent system in Hong Kong;</p>	

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		<p>(b) although patent rights would remain territorial in nature and there was no international patent protection with universal recognition which could be obtained in one go, PPH would facilitate the examination of corresponding patent applications filed in the participating patent offices in different jurisdictions by sharing information about examination of patent applications such as search findings and reports among these offices;</p> <p>(c) that said, under PPH, a participating patent office was not obliged to follow the decision of another participating office on the grant or refusal of a corresponding patent application but was entitled to consider whether to grant or refuse the patent application based on its own applicable laws and practices;</p> <p>(d) the Administration had already commenced the discussion with CNIPA to explore the possibility of putting in place arrangements for expediting examination of patent applications in the Mainland based on the search and examination results of the corresponding OGP applications upon the implementation of the new patent system in Hong Kong;</p> <p>(e) as regards the setting up of PPH with patent offices in overseas jurisdictions, it was essential for the Registry to first build up its credentials in substantive examination so that it would be in a better position to explore PPH with other patent authorities; and</p> <p>(f) the present top priority for the Administration was to complete all preparatory tasks for the implementation of the new patent system as soon as possible, and the Registry would also endeavour to build up its necessary knowledge, track records and credentials in substantive examination.</p>	

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003714 – 004723	Chairman Administration	<p>In response to the Chairman's enquiry about the arrangements in relation to a patent after the expiry of its protection term, the Administration advised that the maximum protection term of an OGP would be 20 years. After that, the invention concerned would fall in the public domain. In essence, the patent system would entitle a patent proprietor to exclude others from exploiting the invention concerned thereby safeguarding the proprietor's lawful interest to generate economic gains derived from the exploitation of the invention within a limited timeframe.</p> <p>In response to the Chairman's enquiry about the convertibility of an STP to an OGP, the Administration advised that:</p> <ul style="list-style-type: none"> (a) an STP was granted under another system for protecting relatively simple inventions with a shorter commercial life cycle for a maximum term of eight years; (b) an STP could not be "converted" to an OGP. Moreover, a patent proprietor would not be allowed to hold two separate patents, namely an OGP and an STP, for the same invention made by the same inventor; and (c) under the new patent system, an applicant would have a choice of seeking an OGP or an STP based on his/her own business considerations. For the new OGP system, it would offer an alternative route for seeking standard patent protection by enabling direct filing of standard patent applications in Hong Kong, without the prior need for filing any corresponding patent application with any designated patent offices outside Hong Kong, which was a pre-requisite for seeking standard patent protection in Hong Kong under the existing re-registration system. 	
004724 – 005938	Chairman Administration	As regards the provisions on non-prejudicial disclosure under new sections 31A and 31ZR of the Patents (General) Rules (Cap. 514C) ("PGR") (as added by section 19 of PGAR), the Chairman enquired why prior disclosure of an	

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		<p>invention even by the subject patent applicant would undermine the patentability of the invention.</p> <p>The Administration advised that:</p> <p>(a) as an international standard, novelty of an invention was one of the patentability requirements under new sections 9A to 9D of PO (as added by the Patents (Amendment) Ordinance 2016 (Ord. No. 17 of 2016) ("Amendment Ordinance");</p> <p>(b) a patent application for an invention was normally filed before the invention had been publicly disclosed, because otherwise any prior disclosure of the invention would render the invention to form part of the state of the art. In that case, the applicant would not be able to obtain a valid patent for the reason that such prior disclosure rendered the invention not new at the time of filing; and</p> <p>(c) prior disclosure of an invention might however under certain circumstances be regarded as non-prejudicial in nature, which would not destroy the novelty of the invention. For example, under the new section 37B of PO (as added by the Amendment Ordinance), prior disclosure of an invention would be regarded as non-prejudicial if it occurred no earlier than six months before the date of filing of the application, and also if it was due to (a) an evident abuse in relation to the patent applicant or proprietor of the invention; or (b) the fact that the applicant or proprietor of the invention had displayed the invention at a prescribed exhibition or meeting.</p>	
005939 – 011219	Chairman Mr WU Chi-wai Administration	In response to Mr WU Chi-wai's enquiry on whether the late Professor Charles KAO's disclosure of his research and development ("R&D") findings on fiber optics in a scientific journal without filing any prior patent applications would be regarded as a prejudicial disclosure should he opt for filing any patent	

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		<p>application later, the Administration advised that the fact that Professor KAO did not opt to file any patent applications for the invention relating to fiber optics before disclosing the invention in his R&D findings might be an indication that he had chosen to forfeit his right to apply for patent of the invention.</p> <p>In response to Mr WU's enquiry on whether different applications of the same invention, for example, the application of fiber optics in minimally invasive surgery rather than telecommunications, would be patentable under the new patent system, the Administration advised that any patent applications for an invention which utilized a known technology in the state of art might still be patentable if the invention had fulfilled the patentability requirements, i.e. it was new, involved an inventive step and was capable of industrial application.</p>	
011220 – 012154	Chairman Mr Holden CHOW Administration	<p>Noting that under section 143(1)(b) of PO (as amended by the Amendment Ordinance) ("amended section 143(1)(b) of PO"), a person, who represented that the person had applied for a patent when in fact the relevant application had been refused or withdrawn, would commit an offence, Mr Holden CHOW observed that Assistant Legal Adviser 8 ("ALA8") had sought clarification from the Administration as to whether that provision would apply after a provisional refusal notice had been issued under the new section 31ZH of PGR (as added by section 19 of PGAR), but before issuance of a final refusal notice under the new section 31ZN of PGR (as added by section 19 of PGAR). Mr CHOW sought further clarification from the Administration on this matter.</p> <p>The Administration advised that:</p> <p>(a) the reference to "any [patent] application had been refused" under the amended section 143(1)(b) of PO should logically be construed as the final decision of the Registrar on the refusal to grant a patent, which covered the issuance of a final refusal notice by the Registrar regarding an OGP application under the new</p>	

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		<p>section 31ZN(2) of PGR;</p> <p>(b) if the Registrar had merely made a provisional decision on the refusal to grant an OGP and had issued a provisional refusal notice under the new section 31ZH of PGR, such provisional decision was still subject to the applicant's entitlement to file a request to review the Registrar's opinion within two months after the date of the provisional refusal notice under the new sections 31ZH(2)(c) and 31ZI(1) of PGR; and</p> <p>(c) accordingly, such OGP application was still, objectively and logically speaking, considered as pending before the Registrar, and the amended section 143(1)(b) of PO was not applicable to such a pending application.</p> <p>Noting that it might take months or even a year to go through all the necessary procedures for processing a request to review, Mr CHOW urged the Administration to step up efforts to educate the public on the applicability of section 143 of PO, so as to guard against possible abuse of the review procedures by persons trying to mislead the public by exploiting the representation of a pending patent application for other intended purposes.</p> <p>The Administration advised that IPD, which conducted public education or promotion campaigns from time to time for enhancing public awareness of and respect for intellectual property, would consider how best the respective scope of section 143 and the other offence provisions of PO could be drawn to the public's attention through such education/promotion channels as appropriate.</p>	
012155 – 012653	Chairman ALA8 Administration	Despite the Administration's explanation and having regard to ALA8's view that the general public might regard a provisional refusal notice (given the word "refusal") issued by the Registrar as a refusal for the purposes of the amended section 143(1)(b) of PO, the Chairman requested the Administration to consider amending the relevant provision(s) so as to better	The Administration to follow up as stated in paragraph 6 of the minutes.

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		<p>reflect its policy intent regarding whether the amended section 143(1)(b) of PO applied to a recipient of that notice.</p> <p>In response to the Chairman's enquiry, the Administration clarified that PGAR, which introduced detailed requirements and procedures into PGR for the implementation of the new patent system, did not introduce any legislative amendment to the existing statutory provisions on criminal offences. In other words, the existing offences stipulated under sections 141 to 145 of PO, such as falsification of register, unauthorized claim of patent rights and unauthorized claim that a patent had been applied for, remained unchanged.</p>	
012654 – 012718	Chairman Administration	<p><u>Invitation of views</u></p> <p>Members agreed that it was not necessary to invite public views on PGAR.</p>	
012719 – 013020	Chairman	Legislative timetable and meeting arrangement.	