

立法會
Legislative Council

LC Paper No. CB(1)1234/18-19
(These minutes have been seen
by the Administration)

Ref : CB1/SS/12/18

Subcommittee on Patents (General) (Amendment) Rules 2019

Minutes of second meeting
on Tuesday, 9 April 2019, at 10:45 am
in Conference Room 3 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 Charles Peter MOK, JP
Dr Hon Elizabeth QUAT, BBS, JP
Ir Dr Hon LO Wai-kwok, SBS, MH, JP
Hon Holden CHOW Ho-ding

Member absent : Hon WU Chi-wai, MH

Public officers attending : Agenda Item I
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. Meeting with the Administration**
(LC Paper No. CB(1)849/18-19(01) -- List of follow-up actions arising from the discussion at the meeting on 2 April 2019
- LC Paper No. CB(1)816/18-19(03) -- Assistant Legal Adviser's letter dated 29 March 2019 to the Administration

LC Paper No. CB(1)849/18-19(02) -- Administration's response to Assistant Legal Adviser's letter dated 29 March 2019 and issues raised at the meeting on 2 April 2019

Relevant papers

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)

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

II. Any other business

Legislative timetable

2. The Chairman said that the Subcommittee had completed the scrutiny of the Patents (General) (Amendment) Rules 2019 (L.N. 35 of 2019) ("PGAR"). Both the Administration and the Subcommittee would not propose amendments to PGAR. Members noted that the Chairman would move a proposed resolution at the Council meeting of 17 April 2019 to extend the period for amending PGAR to the Council meeting of 8 May 2019. If the scrutiny period was extended, the deadline for giving notice of amendments would be 30 April 2019, and the Chairman would report the Subcommittee's deliberations to the House Committee on 26 April 2019.

(Post-meeting note: The proposed resolution to extend the period for amending PGAR was passed at the Council meeting of 17 April 2019.)

3. There being no other business, the meeting ended at 12:49 pm.

Council Business Division 1
Legislative Council Secretariat
27 June 2019

**Proceedings of the second meeting of
the Subcommittee on Patents (General) (Amendment) Rules 2019
on Tuesday, 9 April 2019, at 10:45 am
in Conference Room 3 of the Legislative Council Complex**

Time marker	Speaker	Subject(s)	Action required
000355 – 000556	Chairman Administration	Opening remarks by the Chairman.	
000557 – 001455	Chairman Administration	The Administration's briefing on its response to Assistant Legal Adviser 8's ("ALA8") letter dated 29 March 2019 and issues raised at the meeting on 2 April 2019 (LC Paper No. CB(1)849/18-19(02)).	
<p><i>Section-by-section examination of the Patents (General) (Amendment) Rules 2019</i> [Marked-up copy of the Patents (General) (Amendment) Rules 2019 prepared by the Administration (LC Paper No. CB(1)816/18-19(01))]</p>			
001456 – 002545	Chairman Administration	<p>The Administration took members through the Chinese version of the Patents (General) (Amendment) Rules 2019 ("PGAR") section by section.</p> <p><u>Section 1 – Commencement</u></p> <p><u>Section 2 – Patents (General) Rules amended</u></p> <p><u>Section 3 – Part 1A added</u> <u>Part 1A: Mention of Inventor</u></p> <p><u>Section 4 – Part 2, Division 1A added</u> <u>Division 1A—Novelty</u></p> <p><u>Section 5 – Section 3 amended (references to the Registrar under section 13(1)(a) or (b) of the Ordinance)</u></p> <p><u>Section 6 – Section 5 amended (orders under section 13 of the Ordinance)</u></p> <p><u>Section 7 – Section 6 amended (authorization under section 13(5) of the Ordinance)</u></p> <p><u>Section 8 – Section 7 amended (reference to the Registrar under section 14(5) of the Ordinance)</u></p> <p><u>Section 9 – Section 8 amended (request to record a designated patent application under section 15 of the Ordinance)</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>Section 10 – Section 10 amended (details relating to the previous disclosure of the invention)</u></p> <p><u>Section 11 – Section 11 substituted</u></p> <p><u>Section 12 – Sections 15, 16 and 17 substituted</u></p> <p>Members raised no query.</p>	
002546 – 002752	Chairman Mr Holden CHOW Administration	<p><u>Section 13 – Section 19 amended (request for registration of designated patent and grant of patent under section 23(1) of the Ordinance)</u></p> <p><u>Section 18 – Section 31 amended (restoration of application for standard patent under section 34 of the Ordinance)</u></p> <p>Mr Holden CHOW enquired about the rationale for the amendments to the Patents (General) Rules (Cap. 514C) ("PGR") under sections 13 and 18 of PGAR which did away with the requirement for the applicant to sign on the specified form for a patent application.</p> <p>The Administration advised that under the existing sections 19(1) and 31(1) of PGR, a request to register a designated patent, grant a patent and restore an application for a standard patent should be made in the corresponding specified forms and be signed by the applicant. With a view to encouraging filing of applications through electronic means, the amendments were made to do away with the existing requirement of signing the specified forms. Applicants might choose to file their applications through electronic means or by paper.</p> <p><u>Section 14 – Section 21 substituted</u></p> <p><u>Section 15 – Section 23 amended (communication following examination on filing under section 25(1) of the Ordinance)</u></p> <p><u>Section 16 – Section 24 substituted</u></p> <p><u>Section 17 – Section 29 amended (rectification of deficiencies and removal of doubts in maintenance documents)</u></p>	

Time marker	Speaker	Subject(s)	Action required
		Members raised no query.	
002753 – 004245	Chairman Mr Holden CHOW Administration	<p><u>Section 19 – Part 3A added</u> <u>Part 3A: Standard Patents by Original Grant</u></p> <p>The Subcommittee noted that new sections 31A to 31ZX were added to PGR under section 19 of PGAR.</p> <p>In response to the enquiries by Mr Holden CHOW and the Chairman about the operational arrangements for the filing of a reference with the Registrar of Patents ("Registrar") mentioned in the new section 31G, and the local and overseas precedents of such filing, the Administration advised that:</p> <p>(a) a "reference" mentioned in the new section 31G referred to the reference of a question to the Registrar under the new section 37H(1)(a) of the Patents Ordinance (Cap. 514) ("PO") (as added by the Patents (Amendment) Ordinance 2016 (Ord. No. 17 of 2016) ("Amendment Ordinance")) as to (i) the entitlement of the applicant(s) to apply for an original grant patent ("OGP") or (ii) any right in or under the application should be transferred or granted to any other person;</p> <p>(b) the existing referral procedures under PGR for determination of the same entitlement issues by the Registrar under the current re-registration system of applications for standard patents would be adopted for the corresponding reference procedures under the new OGP system. Since the re-registration system was put into place in 1997 upon the enactment of PO, there was no record of any such reference filed with the Registrar. Similar procedures were in place overseas for the filing of reference with the relevant patents office, e.g. the Intellectual Property Office of the United Kingdom; and</p> <p>(c) as an alternative of filing a reference with the Registrar, a referrer was also entitled to file a reference with the court. Although</p>	

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		<p>the Administration was not aware of any rulings made by the court on such references, it could not rule out whether any references had ever been filed with the court but were subsequently settled before substantive trial and ruling of the court.</p>	
004246 – 005130	Chairman ALA8 Administration	<p>ALA8 said that under the new section 31N(3) of PGR (as added by section 19 of PGAR), the phrase "a more economical presentation" (rendered in Chinese as "較為簡約的呈示") was used. Yet, the phrase "a more economic presentation" (rendered in Chinese as "較為省儉的呈示") had been used in the existing section 59(2) of PGR, which was made in 1997. ALA8 sought clarification from the Administration on the reasons for the different phrases (in both the English and Chinese texts) used in PGR and on whether the two phrases above had the same meaning.</p> <p>The Administration advised that:</p> <p>(a) the two formulations carried substantively the same meaning in the context of the relevant provisions, though the pair of "economical" and "簡約" was 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 was therefore used in the new section 31N(3) of PGR (as added by section 19 of PGAR); and</p> <p>(b) the Administration was prepared to update section 59(2) of PGR to align the wording between the relevant provisions when the next suitable opportunity arose.</p>	
005131 – 005500	Chairman ALA8 Administration	<p>ALA8 referred to the amendment to section 59(1)(f) of PGR under section 39 of PGAR which substituted the phrase "capable of exploitation in industry" with "industrially applicable" and was of the view that the amendment was solely textual in nature. He enquired why the Administration had been selective in making such and other textual amendments under PGAR.</p>	

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		<p>The Administration advised that:</p> <ul style="list-style-type: none"> (a) in addition to providing for the requirements and procedures as necessary for the operation of the new patent system, PGAR also incorporated a number of other amendments to PGR which were consequential or technical in nature; (b) although the Administration aimed to introduce the textual amendments as comprehensive as possible, such amendments could not be exhaustive to align all the phrases, terms and references in PGR. Nevertheless, the Administration was prepared to consider updating the relevant provisions as identified by the Subcommittee when the next opportunity arose; and (c) the Administration was aware that the English title of the patent authority in the Mainland had been changed from State Intellectual Property Office ("SIPO") to the China National Intellectual Property Administration ("CNIPA") (while its Chinese title remained unchanged, i.e. "國家知識產權局"). Both the titles "SIPO" and "國家知識產權局" had been used in PO (e.g. section 125) (as amended by the Amendment Ordinance 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 PGR). The Administration would update the references to the aforesaid English official title in all the relevant provisions in PO and its subsidiary legislation in one go as early as possible. 	
005501 – 005700	Chairman Administration	<p>The Chairman was not convinced by the Administration's explanation, and urged the Administration to take this opportunity to propose amendments to PGAR to update in a timely manner all inconsistent and outdated phrases, terms and references as identified. He enquired whether the Administration had formulated a timetable for conducting the legislative exercise</p>	

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		<p>to propose miscellaneous amendments to PO and its subsidiary legislation.</p> <p>The Administration advised that:</p> <p>(a) while one of the prime objectives of PGAR was to introduce the necessary new statutory provisions into PGR for implementing the new patent system, it had taken this legislative exercise as an opportunity to introduce some miscellaneous textual amendments and refinements to PGR but such textual amendments were by no means meant to be exhaustive to align all the relevant textual expressions with the latest drafting approach and convention;</p> <p>(b) without compromising the implementation timetable for the new patent system which was expected to be rolled out in 2019 at the earliest, the Administration had to take a pragmatic approach in this legislative exercise by selecting to take on board certain essential amendments to PGR while leaving the other less essential items for consideration in subsequent legislative exercises;</p> <p>(c) the Administration would engage the Department of Justice ("DoJ"), which had been undertaking legislative exercises from time to time for introducing miscellaneous amendments to various provisions of the laws of Hong Kong so as to keep their textual expressions, formats and styles up-to-date; and</p> <p>(d) while the exact legislative timetable was not available for the time being, the Administration would touch base with DoJ with a view to identifying a suitable occasion for initiating the miscellaneous textual amendments identified, as early as practicable.</p>	
005701 – 010811	Chairman ALA8 Administration	ALA8 sought clarification from the Administration as to:	

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		<p>(a) whether the "example" located immediately after the new section 31O(2)(b)(xvi)(A) of PGR (as added by section 19 of PGAR) (the example was to the effect that examples of the single word or words were "water", "steam", "open", "close" and "section on AA"), was part of the text of PGAR and had legislative effect;</p> <p>(b) why the content of the mentioned "example" was not stated in the provision itself, as in the existing section 60(2)(k) of PGR with very similar content without the use of an example; and</p> <p>(c) with reference to the papers issued by DoJ's Law Drafting Division entitled "Drafting of Legislation — Use of 'Examples' and 'Notes' in legislation; Numbering System for Bill clauses" dated May 2011, and "'Notes' and 'Examples' in the Companies Bill" dated 13 March 2012, whether and why the example as stated above was necessary and appropriate in the context of PGAR.</p> <p>The Administration advised that:</p> <p>(a) the purpose of using examples was to facilitate the readers in gaining a better understanding of the law. A complex concept or a technical provision, such as a provision governing drawings in patent applications, could be more easily understood if illustrated by an example showing how it worked in practice; and</p> <p>(b) given the highly technical nature of patent applications, and the fact that the same examples had been used in the current section 60(2)(k) of PGR for governing the applications for the grant of short-term patents, the Administration considered it appropriate and consistent with the existing approach adopted by PGR to use examples in the new section 31O(2)(b)(xvi)(A).</p> <p>Noting that in the current section 60(2)(k) of PGR, the same examples were given as part of the</p>	

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		<p>provision whereas the examples under the new section 31O of PGR (as added by section 19 of PGAR) were given under a different heading entitled "Example", ALA8 enquired about the rationale for such a difference in the drafting style.</p> <p>The Administration advised that the format and location of the examples used in the new section 31O of PGR reflected the current drafting practice, and they were intended to enhance readability of the provisions.</p> <p>The Chairman was of the view that a consistent format should better be adopted so as to avoid misinterpretation of the provisions concerned.</p> <p>The Administration advised that:</p> <ul style="list-style-type: none"> (a) it had taken note of the Chairman's view and agreed that it would be the best for all the provisions to be aligned in style and format; (b) that said, given the tight timeframe for the current legislative exercise to implement the new patent system, the Administration had to adopt a pragmatic approach in determining whether amendments were essential to update the provisions which had been enacted for some time and contained expressions in a relatively older style and format; and (c) it was prepared to conduct a comprehensive review on the drafting aspects of the provisions concerned in the next review exercise for PO and its subsidiary legislation. 	
010812 – 012424	Chairman ALA8 Administration	<p>ALA8 enquired whether the respective notes located after new sections 31O and 60(3) of PGR (section 60(3) of PGR as added by section 40(16) of PGAR) formed part of the text of the subsidiary legislation and had any legislative effect. Noting that there was no provision in PGAR or PGR clarifying the status of the notes, the Administration was requested to draw reference to other statutory provisions such as</p>	

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		<p>section 2(6) of the Companies Ordinance (Cap. 622), which provided that a note located in the text of that ordinance was provided for information only and had no legislative effect, and to consider proposing amendments to add a similar provision in PGAR to clarify the status and legislative effect of the notes.</p> <p>The Administration advised that:</p> <p>(a) under the current drafting practice, the use of notes in legislation was a widely adopted plain language technique. In providing signposts or other factual information, such notes helped the reader to understand the legislation more quickly and get a clearer picture of it. A note that was used for the purpose of giving information to the reader would not affect the interpretation of the legislation; and</p> <p>(b) the notes concerned formed part of the subsidiary legislation, and they were intended to guide the readers to another relevant provision in PGR. Since the purpose of the notes as the reader's aids was clear from the context, amendments were not required to make express clarification.</p> <p>The Chairman was not convinced by the Administration's explanation, and requested the Administration to further clarify the purposes of the notes located in the text of PGR.</p> <p>The Administration reiterated that the notes served as a quick pointer to another relevant provision in PGR for cross-referencing purpose so as to facilitate the readers to be aware of the circumstances under which the requirements stated in section 31O (and section 60) of PGR could be exempted.</p>	
012425 – 013430	Chairman ALA8 Administration	ALA8 noted that under the new section 31ZI(5) of PGR (as added by section 19 of PGAR), if no request to review was filed after the Registrar had issued the provisional refusal notice regarding an OGP application, the Registrar must then make a final decision of refusal to grant	

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		<p>the OGP. ALA8 sought clarification from the Administration as to whether the Registrar (a) might nonetheless grant the OGP if the Registrar on his own initiative considered that all the relevant requirements under PO (as amended by the Amendment Ordinance) were satisfied, after the provisional refusal notice had been issued incorrectly; and (b) had the power to review the issuance of the provisional refusal notice in the absence of a request to review. The Administration was also requested to clarify a similar situation as regards the new section 31ZM(4) of PGR.</p> <p>The Administration advised that:</p> <p>(a) if the Registrar was aware that a provisional refusal notice had been issued incorrectly due to irregularity in procedure, and the Registrar was also satisfied that the OGP application had complied with all examination requirements specified in the new section 37U(3) of PO (as added by the Amendment Ordinance), the Registrar had the power to withdraw the provisional refusal notice on his own initiative under section 94(1) of PGR so as to rectify such irregularity in procedure, and then proceed to grant the OGP; and</p> <p>(b) the same statutory power of rectification of irregularity in procedure under section 94(1) of PGR was 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 an OGP application due to irregularity in procedure.</p> <p>In response to ALA8's further enquiry, the Administration was of the view that section 94(1) of PGR might not be applicable in the case of an irregularity in substance (vis-à-vis procedure).</p>	
013431 – 015631	Chairman Administration	<u>Section 20 – Section 34 amended (restoration of lapsed standard patents under section 40 of the Ordinance)</u>	

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		<p><u>Section 21 – Section 36 substituted</u></p> <p><u>Section 22 – Section 37 amended (revocation of standard patent under section 44 of the Ordinance)</u></p> <p><u>Section 23 – Section 38 repealed (mention of inventor under section 45 of the Ordinance)</u></p> <p><u>Section 24 – Sections 38A to 38F added</u></p> <p><u>Section 25 – Section 40 amended (surrender of patents)</u></p> <p><u>Section 26 – Section 41 amended (Registrar's power to revoke patent on grounds of "ordre public" or morality under section 49 of the Ordinance)</u></p> <p><u>Section 27 – Section 41A added</u></p> <p><u>Section 28 – Section 42A amended (failure to file address for service)</u></p> <p><u>Section 29 – Section 43 amended (entries in the register)</u></p> <p><u>Section 30 – Section 44 amended (entries relating to section 13(1) of the Ordinance)</u></p> <p><u>Section 31 – Section 48 amended (correction of errors in patents and applications under section 146 of the Ordinance)</u></p> <p><u>Section 32 – Section 50 amended (inspection of register)</u></p> <p><u>Section 33 – Part 6A added</u> <u>Part 6A : Single Inventive Concept</u></p> <p><u>Section 34 – Section 54 substituted</u></p> <p><u>Section 35 – Section 55 repealed (exhibition or meeting under section 95(1)(b) of the Ordinance)</u></p> <p><u>Section 36 – Section 56 amended (the language of proceedings before the Registrar)</u></p> <p><u>Section 37 – Sections 56A to 56D added</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>Section 38 – Section 58 amended (applications for the grant of short-term patents under section 113 of the Ordinance)</u></p> <p><u>Section 39 – Section 59 amended (description)</u></p> <p><u>Section 40 – Section 60 amended (drawings)</u></p> <p><u>Section 41 – Section 61 amended (the abstract)</u></p> <p><u>Section 42 – Section 62 amended (size and presentation of documents)</u></p> <p><u>Section 43 – Section 64 amended (claims)</u></p> <p><u>Section 44 – Section 67 substituted</u></p> <p><u>Section 45 – Sections 67A and 67B added</u></p> <p><u>Section 46 – Section 68 substituted</u></p> <p><u>Section 47 – Sections 68A and 68B added</u></p> <p><u>Section 48 – Section 69 substituted</u></p> <p><u>Section 49 – Section 69A added</u></p> <p><u>Section 50 – Section 70 amended (claim regarding non-prejudicial disclosure under section 109(b) of the Ordinance)</u></p> <p><u>Section 51 – Section 73 substituted</u></p> <p><u>Section 52 – Section 73A added</u></p> <p><u>Section 53 – Section 74 amended (divisional short-term patent application under section 116 of the Ordinance)</u></p> <p><u>Section 54 – Section 74A added</u></p> <p><u>Section 55 – Section 75 substituted</u></p> <p><u>Section 56 – Section 78 substituted</u></p> <p><u>Section 57 – Section 79A added</u></p> <p><u>Section 58 – Part 9, Divisions 5 and 6 added</u> <u>Division 5 — Substantive Examination of</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>Short-term Patents</u> <u>Division 6 — Amendment of Short-term Patents after Grant</u></p> <p><u>Section 59 – Section 82 amended (Registrar's discretionary powers)</u></p> <p><u>Section 60 – Section 82A added</u></p> <p><u>Section 61 – Section 83 amended (hearings in public)</u></p> <p><u>Section 62 – Section 87 amended (security for costs)</u></p> <p><u>Section 63 – Section 88 amended (request for information under section 147 of the Ordinance)</u></p> <p><u>Section 64 – Section 89 amended (restriction on inspection of documents under section 147 of the Ordinance)</u></p> <p><u>Section 65 – Section 90 amended (confidential documents)</u></p> <p><u>Section 66 – Section 91 amended (bibliographic information for purposes of section 147(3) of the Ordinance)</u></p> <p><u>Section 67 – Section 94 amended (correction of irregularities)</u></p> <p><u>Section 68 – Section 98A added</u></p> <p>Members raised no query.</p>	
015632 – 015649	Chairman Administration	The Chairman extended the meeting by 15 minutes.	
015650 – 020548	Chairman Administration	<p><u>Section 69 – Section 100 substituted</u></p> <p><u>Section 70 – Sections 100AA to 100AAD added</u></p> <p><u>Section 71 – Section 106 amended (entries in the register)</u></p> <p><u>Section 72 – Section 113 amended (transitional provision relating to the Patents (General) (Amendment) Rules 2004)</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>Section 73 – Section 114 added</u></p> <p><u>Section 74 – Schedule 1 amended (micro-organisms)</u></p> <p><u>Section 75 – Schedule 2 amended (fees)</u></p> <p><u>Section 76 – Schedule 4 added</u></p> <p><u>Schedule 1 – Minor Amendments to Patents (General) Rules Relating to Replacement of "standard patent" or "patent" by "standard patent (R)"</u></p> <p><u>Schedule 2 – Amendments Relating to Headings of Provisions</u></p> <p>Members raised no query.</p> <p>Members and ALA8 raised no further query on the English version of PGAR, the drafting of which was taken as in order.</p>	
020549 – 020600	Chairman Administration	The Chairman concluded that the Subcommittee had completed the scrutiny of PGAR and that no further meeting of the Subcommittee would be held.	
020601 – 020756	Chairman	Legislative timetable.	