

**立法會**  
**Legislative Council**

LC Paper No. CB(1)375/02-03  
(These minutes have been seen  
by the Administration)

Ref: CB1/SS/2/02/1

**Subcommittee on Patents (General) (Amendment) (No. 2) Rules 2002**

**Minutes of meeting**  
**held on Thursday, 14 November 2002, at 10:45 am**  
**in the Chamber of the Legislative Council Building**

- Members present** : Hon Margaret NG (Chairman)  
Hon Cyd HO Sau-lan  
Dr Hon LUI Ming-wah, JP  
Hon Mrs Selina CHOW LIANG Shuk-ye, GBS, JP  
Hon HUI Cheung-ching, JP  
Hon CHAN Kam-lam, JP  
Hon SIN Chung-kai  
Hon Miriam LAU Kin-ye, JP  
Hon Audrey EU Yuet-mee, SC, JP
- Public officers attending** : Mr Philip CHAN  
Principal Assistant Secretary for Commerce, Industry  
and Technology (Commerce and Industry)
- Mrs Teresa GRANT  
Assistant Director of Intellectual Property
- Clerk in attendance** : Mr S C TSANG  
Senior Assistant Secretary (1)7
- Staff in attendance** : Miss Connie FUNG  
Assistant Legal Adviser 3
- Ms Cindy CHENG  
Senior Assistant Secretary (1)4

## **I Election of Chairman**

Ms Cyd HO, the member who had the highest precedence in the Council among members who joined the Subcommittee, presided at the election of the Chairman. Ms HO invited nominations for the chairmanship.

2. Miss Margaret NG was nominated by Ms Audrey EU and the nomination was seconded by Mr SIN Chung-kai. Miss NG accepted the nomination. There being no other nominations, Miss Margaret NG was declared Chairman of the Subcommittee.

## **II Meeting with the Administration**

(LC Paper No. CB(1) 276/02-03(02) -- Marked-up copy of the Patents (General) (Amendment) (No. 2) Rules 2002

LC Paper No. CB(1) 276/02-03(03) -- Copies of the relevant provisions of the Patents Ordinance (Cap. 514)

LC Paper No. CB(1) 276/02-03(04) -- Copies of the relevant court judgment/determination relating to section 39(1) of the Patents (General) Rules:

(i) *Re Merck Sharp & Dohme Ltd (Amendment of Patent)* [2002] 2 HKC 475; and

(ii) Court of Final Appeal's determination granting leave to appeal (FAMV No. 18 of 2002))

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

Admin 4. The Administration was requested to take the following follow-up actions:

(a) The Administration should re-consider the propriety of introducing the Amendment Rules at this stage given the impending court case where one of the major legal arguments was whether the provisions under section 39(1) of the Patents (General) Rules ("the Rules") were *ultra vires*. The Administration should also undertake to avoid recurrence of similar incidents in future; and

(b) The Administration should re-examine the proposed removal of the one-month time limit under section 39(1) of the Rules as this would defeat the purpose of requiring the proprietor of a patent to file notice

of amendment of specification of a patent in order to update the Register in a timely manner. Such a removal might have impact on the entire patent regime where time was a crucial factor. It might also cause unnecessary loss to those who were not aware of any amendment of specification of a patent due to failure of the patent proprietor in filing the relevant notice of amendment and put in resources in developing a similar product. To this end, measures should be mapped out to encourage patent proprietors to file the notice of amendment as soon as practicable. Consideration should also be given to vesting the Registrar of Patents with the discretion to extend the time limit.

### **III Date of next meeting**

5. Members agreed that the next meeting would be held on Wednesday, 4 December 2002, at 10:45 am to hear views from deputations.

*(Post-meeting note: With the concurrence of the Chairman, the meeting was advanced to **Friday, 29 November 2002, at 4:30 pm.**)*

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

Council Business Division 1  
Legislative Council Secretariat  
27 November 2002

**Proceedings of the meeting of the  
Subcommittee on Patents (General) (Amendment) (No. 2) Rules 2002  
on Thursday, 14 November 2002 at 10:45 am  
in the Chamber of the Legislative Council Building**

<b>Time marker</b>	<b>Speaker</b>	<b>Subject(s)</b>	<b>Action required</b>
000000 - 000244	Ms Cyd HO Ms Audrey EU Mr SIN Chung-kai Miss Margaret NG	Election of Chairman	
000244 - 000715	Chairman	Recapitulation of previous discussion on the Patents (General) (Amendment) (No.2) Rules 2002 ("the Amendment Rules") at the meetings of the House Committee on 1 and 8 November 2002	
000715 - 000858	Administration Chairman	Briefing on the Amendment Rules by the Administration	
000858 - 001213	ALA3	Briefing on LC Paper Nos. CB(1) 276/02-03(02) to (04)	
001213 - 001319	Chairman Administration	Whether the Administration was aware of an impending appeal to the Court of Final Appeal on issues relating to section 39(1) of the Patents (General) Rules ("the Rules") when making the Amendment Rules	
001319 - 002308	Ms Miriam LAU Administration Chairman	Legislative intent behind the introduction of the one-month time limit under section 39(1) of the Rules. Rationale for not giving the Registrar of Patents ("the Registrar") a discretionary power to extend the time limit as in the case of the Land Registration Ordinance (Cap. 128)	
002308 - 002715	Chairman Administration	The effect of an amendment under section 46(3) of the Patents Ordinance (Cap. 514) ("the	

Time marker	Speaker	Subject(s)	Action required
		Ordinance")	
002715 - 003717	Ms Cyd HO Mrs Selina CHOW Administration Chairman ALA3	The propriety of introducing the Amendment Rules given an impending court case	The Admin to seriously re-consider the propriety of introducing the Amendment Rules given the impending court case, and to undertake to avoid recurrence of similar incidents in future
003717 - 004101	Mr HUI Cheung-ching Administration	Enquiry on the hearing date and expected end date of the impending court case	
004101 - 004415	Chairman Administration	Section 81(5) of the Ordinance provided sufficient incentive for the patent proprietor to file the notice of amendment of a patent promptly. The time limit of one month under section 39(1) of the Rules was considered unnecessary.	
004415 - 005526	Ms Audrey EU Chairman Administration	Whether section 39(1) of the Rules which provided no extension of time was ultra vires	
005526 - 005753	Chairman ALA3	Provisions for infringement of patent under section 80 of the Ordinance	
005753 - 010127	Chairman Ms Miriam LAU Administration	Effect of an amendment on the validity of a patent	
010127 - 010340	Chairman Mrs Selina CHOW	Removal of time limit under section 39(1) of the Rules might defeat the purpose of requiring patent proprietor to file notice of amendment in order to update the register in a timely manner, and	The Admin to re-examine the proposed removal of the one-month time limit under the

Time marker	Speaker	Subject(s)	Action required
		undermine the balance of the entire patent regime where time was a crucial factor. Need to consult the trade on the Amendment Rules	section
010340 - 011207	Ms Miriam LAU Chairman Administration	Unnecessary loss to those who were not aware of any amendment of specification of a patent due to failure of the patent proprietor in filing the relevant notice of amendment and put in resources in developing a similar product	The Admin to map out measures to encourage patent proprietors to file the notice of amendment as soon as practicable. Consideration should be given to vesting the Registrar with the discretion to extend the time limit.
011207 - 012120	Chairman Ms Miriam LAU Mrs Selina CHOW	Invitation of views from deputations and legislative timetable	
012120 - 012732	Ms Cyd HO Chairman Ms Miriam LAU Mrs Selina CHOW	Date of next meeting	

**Note: The audio records of the above proceedings are kept at the Legislative Council Library.**

Council Business Division 1  
Legislative Council Secretariat  
 27 November 2002