

立法會
Legislative Council

LC Paper No. CB(1) 642/02-03
(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 Friday, 29 November 2002, at 5:00 pm
in the Chamber of the Legislative Council Building

- Members present** : Hon Margaret NG (Chairman)
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
- Members absent** : Hon Cyd HO Sau-lan
Dr Hon LUI Ming-wah, 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
- Ms Finnie QUEK
Senior Solicitor (Registration), Intellectual Property
Department

- Attendance by invitation** : Mr C K KWONG
Hong Kong Group President, Asian Patent Attorneys Association/Member of Intellectual Property Committee, Law Society of Hong Kong
- Mrs Peggy CHEUNG
President of The Hong Kong Institute of Trade Mark Practitioners
- Mr Graeme HALL
Immediate past President of The Hong Kong Institute of Trade Mark Practitioners
- 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
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Action

- I Confirmation of minutes**
(LC Paper No. CB(1) 375/02-03 -- Minutes of meeting on 14 November 2002)
- The minutes of the meeting held on 14 November 2002 were confirmed.
- II Meeting with deputations and the Administration**
(LC Paper No. CB(1) 373/02-03(01) -- Submission from The Hong Kong Institute of Trade Mark Practitioners
- LC Paper No. CB(1) 373/02-03(02) -- Submission from the Asian Patent Attorneys Association Hong Kong Group (also endorsed and adopted by The Law Society of Hong Kong)

Action

- LC Paper No. CB(1) 398/02-03(01) -- An extract of submission previously made by the Hong Kong Bar Association to the Bills Committee on Patents Bill
- LC Paper No. CB(1) 416/02-03 -- Submission from the Hong Kong Bar Association
- LC Paper No. CB(1) 373/02-03(03) -- List of follow-up actions arising from the discussion at the meeting on 14 November 2002
- LC Paper No. CB(1) 373/02-03(04) -- Administration's response to CB(1) 373/02-03(03))

2. The Subcommittee received representations from the Hong Kong Institute of Trade Mark Practitioners, Asian Patent Attorneys Association Hong Kong Group and The Law Society of Hong Kong. The Subcommittee also noted the written submission from the Hong Kong Bar Association which had not attended the meeting.

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

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

- (a) to provide information on overseas practices as to how they would ensure timely registration of amendment of patent specification by patentees and whether there was a time limit for registration and the consequences in the event of failure to do so;
- (b) to critically review the policy intent behind and the need for a time limit under section 39(1) of the Patents (General) Rules (the Rules) to ensure timely registration of amendment of patent specification, and to advise whether any proposal to reasonably extend the time limit would be considered ultra vires; and
- (c) to respond to the submissions made by deputations, and to advise on the progress of the review of section 35 of the Rules and Order 103 of the Rules of High Court, which should be made in consultation with the trade.

Action

III Any other business

5. There being no other business, the meeting ended at 6:50 pm.

Council Business Division 1
Legislative Council Secretariat
7 January 2003

**Proceedings of the meeting of the
Subcommittee on Patents (General) (Amendment) (No. 2) Rules 2002
on Friday, 29 November 2002 at 5:00 pm
in the Chamber of the Legislative Council Building**

Time marker	Speaker	Subject(s)	Action required
000000 - 000220	Chairman	Confirmation of minutes of meeting on 14 November 2002 (LC Paper No. CB(1) 375/02-03)	
000220- 000807	The Hong Kong Institute of Trade Marks Practitioners (HKITMP)	Presentation of views on the Patents (General) (Amendment) (No.2) Rules 2002 (the Amendment Rules) (LC Paper No. CB(1) 373/02-03(01))	
000807 - 001732	The Asian Patent Attorneys Association (APAA) & The Law Society of Hong Kong (LSHK)	Presentation of views on the Amendment Rules (LC Paper No. CB(1) 373/02-03(02))	
001732 - 002143	Chairman Administration	Latest development of the pending appeal to the Court of Final Appeal (CFA) on issues relating to section 39(1) of the Patents (General) Rules (the Rules)	
002143 - 002844	Chairman Mrs Selina CHOW Administration	Consequences if CFA ruled that section 39(1) of the Rules was ultra vires	
002844 - 003424	Chairman Administration Mrs Selina CHOW	Practical difficulties encountered by patentees to timely register the amendment of patent specification under the Rules	
003424 - 004005	Ms Miriam LAU Chairman Administration	Problems relating to other provisions, such as section 35 of the Rules and Order 103 of the Rules of the High Court, for processing amendment of patent specification	

Time marker	Speaker	Subject(s)	Action required
004005 - 004356	Ms Audrey EU Chairman Administration ALA3	Propriety and implications of legislative amendment before the conclusion of a pending court case	
004356 - 005832	APAA & LSHK Ms Miriam LAU Mrs Selina CHOW Chairman Administration ALA3	Effect on patentees if the Amendment Rules were not passed by the legislature	
005832 - 011956	Mrs Selina CHOW Ms Audrey EU Mr CHAN Kam-lam HKITMP APAA & LSHK Chairman Administration	Proposed extension of the time limit under section 39(1) of the Rules	The Admin to advise whether any proposal to reasonably extend the time limit would be considered ultra vires
011956 - 013135	Mr HUI Cheung-ching Mrs Selina CHOW HKITMP APAA & LSHK Chairman Administration	Remedies for patentees against any infringement committed before the registration of the amendment of patent specification	
013135 - 013422	Ms Miriam LAU Administration Chairman	Measures adopted by overseas jurisdictions to ensure timely registration of amendment of patent specification	The Admin to provide information on overseas practices as to how they would ensure timely registration of amendment of patent specification by patentees and whether there was a time limit for registration and the consequences in the event of

Time marker	Speaker	Subject(s)	Action required
			failure to do so.
013422 - 014700	Chairman Mr CHAN Kam-lam Mrs Selina CHOW Ms Miriam LAU Administration	Policy intent behind the need for a time limit under section 39(1) of the Rules	The Admin to critically review the policy intent behind and the need for a time limit under section 39(1) of the Rules to ensure timely registration of amendment of a patent specification
014700 - 014854	APAA & LSHK Chairman Administration	Review of section 35 of the Rules and Order 103 of the Rules of the High Court should be conducted in consultation with the trade.	The Admin to advise on the progress of the review of section 35 of the Rules and Order 103 of the Rules of the High Court
014854 - 015046	Chairman	Clause-by-clause examination of the Amendment Rules	

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

Council Business Division 1
Legislative Council Secretariat
7 January 2003