

Bills Committee on Copyright (Amendment) Bill 2006
Exemption for the legal profession

Purpose

This paper briefs Members on the Administration's response to comments received recently from the Bar Association about the exemption provision under section 118(2E)(a) and (aa) in the Copyright (Amendment) Bill 2006.

Comments from the Law Society of Hong Kong and the Hong Kong Bar Association

2. At the request of the Bills Committee, we have earlier sent section 118(2E)(a) and (aa) to the Law Society of Hong Kong ("the Law Society") and the Hong Kong Bar Association ("the Bar Association") for comments. The Law Society has no objection to the provision.

3. The Bar Association has recently reverted to us. It comments that the exemption of "giving legal advice" in section 118(2E) is too narrow as a legal professional may possess an infringing copy for the purposes of drafting, appearing in courts etc. Further, a legal professional may be given possession of infringing copies for the purposes of considering whether he would accept instructions to provide the legal services required. The Bar Association therefore suggests that the exemption should apply to possession for the purposes of providing legal services.

4. The Bar Association considers that the extension of the exemption to pupil barristers is appropriate. However, it points out that there may be other categories of persons who are not qualified legal professionals but who may come into possession of the infringing copies in the course of assisting the legal professionals. Such persons include trainee solicitors, clerks and secretaries, etc. It suggests extending the exemption to persons who possess the infringing copy for the purpose of assisting legal professionals in providing legal services.

5. As a related issue, the Bar Association is concerned that civil and criminal liabilities may arise if a legal professional makes and distributes copies of copyright works to his legal team or to the client for the purpose of providing legal services. It proposes that the Administration should consider providing general exemption from the civil and criminal liabilities to legal professional for the purpose of providing legal services and for persons assisting or facilitating a legal professional in providing legal services.

The Administration's response

(a) Section 118(2E)(a) and (aa) (paragraph 3 above)

6. Having considered the Bar Association's comments that an exemption tied to "giving legal advice" may be too narrow to cover all legal services that legal professionals may provide, we agree to revise the new section 118(2E)(a) and (aa) so that it applies to the possession of an infringing copy for the purpose of providing legal services in relation to the infringing copy. The revised section 118(2E)(a) and (aa) is attached at Annex.

(b) Section 118(2E)(aa) (paragraph 4 above)

7. Trainee solicitors are not qualified to act as solicitors under the Legal Practitioners Ordinance (Cap. 159). Hence, they are not allowed by their principals to give legal advice independently to clients. However, they may be asked by their employers to assist in giving legal advice in the course of their employment. When a solicitor is requested by his client to give legal advice pertaining to an infringing copy of copyright work, a trainee solicitor working in the same firm may possess the copy for the purpose of assisting his employer to give legal advice. Under the above scenario, the trainee solicitor shall be regarded as possessing the copy (which was provided to him by his employer) in the course of his employment. Furthermore, the trainee solicitor is not in a position to make or influence the decision of his employer regarding the use of the infringing copy in the course of provision of legal advice pertaining to that copy. Hence, he should be able to rely on the employee's defence under section 118(3A). The same also applies to secretaries, clerks and other staff working in legal firms to provide assistance or facilitate lawyers to provide legal advice.

8. On the other hand, persons serving a pupillage under the Barrister (Qualification for Admission and Pupillage) Rules (Cap. 159 sub. leg. AC) are not employees of their masters. The employee's defence is not available to such persons. Hence, a separate exemption provision for pupil barristers is required as has been proposed under the new section 118(2E)(aa).

(c) General exemption for providing legal services (paragraph 5 above)

9. We have consulted the book publishing industry on the general exemption provision suggested by the Bar Association. The industry is concerned that if lawyers are exempted from the new business end-user copying/distribution offence for the reason that they have operational need to

make and distribute copies of copyright works in the course of their business, other business end-users would ask for the same exemption based on the same reason. The industry cannot see any strong reason for giving the exemption. As regards a broad exemption from both the civil and criminal liabilities for the provision of legal services, book publishers have strong reservation as there is already a permitted act for judicial proceedings under section 54 of the Copyright Ordinance. They cannot see any strong reason to expand the permitted act to cover all legal services provided by a legal professional in the course of business since a legal professional provides such services for reward. That said, the industry is prepared to discuss with the legal profession and work out a licensing scheme which meets the operational needs of the profession.

10. We remain of the view that the permitted act for judicial proceedings should be able to cover most of the business activities that legal professionals are engaged in. Legal professionals who need to make copies of copyright works for distribution or distribute such copies on a regular or frequent basis in the course of their practice under circumstances not related to judicial proceedings are encouraged to acquire licences from copyright owners. The Administration stands ready to facilitate the discussion between the concerned copyright licensing bodies and the legal profession with a view to securing the availability of appropriate and user-friendly licensing schemes to address the legitimate needs of the legal profession for use of copyright works.

Commerce and Industry Branch
Commerce, Industry and Technology Bureau
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22. Criminal liability for making or dealing with infringing articles, etc.

(3) Section 118 is amended by adding -

".....

(2E) Subsection (2A) does not apply if -

(a) the person who possesses an infringing copy does so for the purpose of ~~giving legal advice in the professional capacity of a solicitor or barrister~~providing legal service in relation to the infringing copy, ~~to his client and~~ -

(i) the person is enrolled on the roll of solicitors or the roll of barristers kept under the Legal Practitioners Ordinance (Cap. 159); or

(ii) the person has been admitted as a legal practitioner in a jurisdiction other than Hong Kong;

(aa) the person who possesses an infringing copy is serving a pupillage under the Barristers (Qualification for Admission and Pupillage) Rules (Cap. 159 sub. leg. AC) and he possesses the infringing copy for the purpose of assisting the barrister with whom he serves the pupillage in providing legal service in

relation to the infringing copy;

- (b) the person who possesses an infringing copy does so for the purpose of providing investigation service in relation to the infringing copy to the copyright owner or exclusive licensee of the copyright work concerned; or
- (c) the person who possesses an infringing copy does so on his client's premises and the infringing copy is provided to him by his client."