

立法會
Legislative Council

LC Paper No. CB(1)758/15-16
(These minutes have been seen
by the Administration)

Ref : CB1/BC/2/15

Bills Committee on Patents (Amendment) Bill 2015

**Minutes of the third meeting
on Tuesday, 12 January 2016, at 10:45 am
in Conference Room 2A of the Legislative Council Complex**

Members present : Hon Martin LIAO Cheung-kong, SBS, JP (Chairman)
Hon WONG Kwok-hing, BBS, MH
Hon Jeffrey LAM Kin-fung, GBS, JP
Hon WONG Ting-kwong, SBS, JP
Hon Paul TSE Wai-chun, JP
Hon Alan LEONG Kah-kit, SC
Hon Charles Peter MOK, JP
Hon Dennis KWOK
Hon SIN Chung-kai, SBS, JP
Ir Dr Hon LO Wai-kwok, SBS, MH, JP
Hon CHUNG Kwok-pan

Members absent : Hon Andrew LEUNG Kwan-yuen, GBS, JP
Hon WONG Yuk-man

**Public officers
Attending** : Agenda Item I

Commerce and Economic Development Bureau

Mr David WONG, JP
Deputy Secretary for Commerce and Economic
Development (Commerce and Industry)2

Mr Amor WONG
Assistant Secretary
for Commerce and Economic Development
(Commerce and Industry)3B

Mr Kevin LI
Assistant Secretary
for Commerce and Economic Development
(Commerce and Industry)3B (Des)

Intellectual Property Department

Miss S K LEE
Deputy Director of Intellectual Property

Mr Thomas TSANG
Assistant Director of Intellectual Property (Patents)

Department of Justice

Ms Mabel CHEUNG
Acting Senior Assistant Law Draftsman
(Professional Development)

Mr Gary LI
Government Counsel

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

Staff in attendance : Ms Wendy KAN
Assistant Legal Adviser 6

Ms Connie HO
Senior Council Secretary (1)3

Ms May LEUNG
Legislative Assistant (1)3

Action

I. Meeting with the Administration

(LC Paper No. CB(1)404/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 22 December 2015

LC Paper No. CB(1)404/15-16(02) -- Administration's paper entitled "Patent application statistics in selected economies" in response to the list of follow-up actions arising from the discussion at the meeting on 22 December 2015)

Clause-by-clause examination of the Bill

(LC Paper No. CB(3)101/15-16 -- The Bill

LC Paper No. CB(1)219/15-16(01) -- Mark-up copy of the Bill prepared by the Legal Service Division (Restricted to members only)

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

LC Paper No. LS9/15-16 -- Legal Service Division Report

LC Paper No. CB(1)413/15-16(01) -- Assistant Legal Adviser's letter dated 8 January 2016 to the Administration)

1. The Bills Committee deliberated (Index of proceedings attached at **Annex**).

Follow-up actions to be taken by the Administration

2. The Administration was requested to –

- (a) consider whether the terms "standard patent (O)" and "standard patent (R)" in the English text of the Bill should be amended to enhance clarity;

Action

- (b) consider whether the drafting of the amendment to the Chinese text of section 6(5) of the Patents Ordinance ("the Ordinance") (Cap. 514) (i.e. "指定專利申請內或在任何原授標準專利申請內或在任何專利或指定專利的說明書內，") under clause 9(2) of the Bill should be improved to enhance the clarity of the relevant section;
- (c) advise the Bills Committee of the textual amendments made to new sections 9A to 9F of the new Part 1A under clause 11 of the Bill, which were based on existing sections 45, 93, 94, 96, 97 and 100 of the Ordinance;
- (d) consider whether the term "主體申請" under relevant clauses in the Chinese text of the Bill should be amended to avoid confusion and better align with the respective term in the English text; and
- (e) provide citation of court cases where possible for members' reference in relation to –
 - (i) the patentability criteria of an invention, namely, "novelty", "inventive step" and "industrial application"; and
 - (ii) the use of "Swiss-type claim" in Hong Kong to seek protection of inventions relating to second medical uses.

(Post-meeting note : The Administration made an oral response to the issues raised in paragraphs 2(a) and (d) at the Bills Committee meeting on 2 February 2016. Moreover, the Administration's written response in respect of the issue raised in paragraph 2(b) was circulated to members vide LC Paper No. CB(1)700/15-16(02) on 18 March 2016. The information provided by the Administration in response to the Bills Committee's requests made in paragraphs 2(c) and (e) were circulated to members vide LC Paper No. CB(1)505/15-16(02) on 1 February 2016.)

II. Any other business

Date of next meeting

3. The Chairman reminded members that the next meeting would be held on Tuesday, 2 February 2016 at 10:45 am.

Action

4. There being no other business, the meeting ended at 12:42 pm.

Council Business Division 1
Legislative Council Secretariat
8 April 2016

**Proceedings of the third meeting of
the Bills Committee on Patents (Amendment) Bill 2015
on Tuesday, 12 January 2016, at 10:45 am
in Conference Room 2A of the Legislative Council Complex**

Time marker	Speaker	Subject(s)	Action required
Agenda Item I – Meeting with the Administration			
000334 – 001029	Chairman Administration	<p>Opening remarks.</p> <p>Briefing by the Administration on its response (LC Paper No. CB(1)404/15-16(02)) to the issues raised in paragraph 3 of the list of follow-up actions arising from the discussion at the meeting on 22 December 2015 ("the List"). Referring to the Bills Committee's request for the patent filing statistics of Singapore before the setting up of the "original grant" patent ("OGP") system in 1995, the Administration's response that there was no statistics available for Singapore about its patent filing volume after mid-1980 up to 1994.</p> <p>The Administration's remarks that its responses to the deputations' written submissions received and views expressed at the meeting on 22 December 2015 (paragraphs 1 and 2 of the List) would be provided to the Bills Committee as soon as practicable.</p> <p>There being no further questions about policy issues raised by Members of the Bills Committee.</p>	The Administration to follow up.
<i>Clause-by-clause examination of the Patents (Amendment) Bill 2015 ("the Bill")</i> [Mark-up copy of the Bill (LC Paper No. CB(1)219/15-16(01))]			
001030 – 001211	Chairman	<p>The Bills Committee commenced clause-by-clause examination of the Bill.</p> <p>The Chairman's remarks that the Legal Advisor to the Bills Committee ("ALA 6") had sent a letter to the Administration on 8 January 2016 raising enquiries on several legal and drafting issues relating to the Bill (LC Paper No. CB(1)413/15-16(01)). The Bills Committee would deliberate on the relevant issues at a future meeting during clause-by-clause examination of the Bill after receiving the Administration's response.</p>	
001212 – 001533	Chairman Administration	<p><u>Long title</u></p> <p><i>Briefing by the Administration on the legislative intent</i></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><i>of the Bill</i></p> <p>The Administration's advice that –</p> <p>(a) the Bill was to establish an "original grant" patent ("OGP") system for grant of standard patents with pre-grant substantive examination, whilst retaining the current re-registration system for grant of standard patents. No substantive changes were made to the provisions of the Patents Ordinance (Cap. 514) ("the Ordinance") in respect of the existing re-registration system. It also sought to refine the short-term patent system by introducing new provisions in the Bill to, amongst others, provide for the mechanism and related procedures for post-grant substantive examination of short-term patents;</p> <p>(b) the provisions relating to the establishment of the new OGP patent system mainly dealt with procedural matters, including statutory procedures for the filing as well as formality and substantive examination of OGP patent applications. Such provisions were technical and procedural in nature; and</p> <p>(c) in formulating the legislative proposals, the Administration had taken into account the patent systems, practices and procedures generally established internationally, including Australia, the Mainland, Singapore and the United Kingdom, as well as several major regional and international patent treaties, such as the European Patent Convention and its Implementing Regulations, the Patent Co-operation Treaty and the Patent Law Treaty, and also the views of local professional bodies of legal and patent practitioners.</p>	
001534 – 002008	Chairman Mr SIN Chung-kai Administration	<p><u>Clause 1: Short title and commencement</u> <u>Clause 2: Patents Ordinance amended</u> <u>Clause 3: Long title amended</u></p> <p>Members raised no query on the above clauses.</p> <p><u>Clause 4: Part I heading substituted</u></p> <p>The Administration's response to Mr SIN Chung-kai's enquiry on whether all the headings/sub-headings in Roman numerals of the Ordinance should be replaced</p>	

Time marker	Speaker	Subject(s)	Action required
		by Arabic numbers to align with the prevailing drafting practice.	
002009 – 003737	Chairman Mr SIN Chung-kai Mr CHUNG Kwok-pan Administration	<p><u>Clause 5: Section 2 amended (interpretation)</u></p> <p>The Chairman's and Mr SIN Chung-kai's views that the English terms "standard patent (O)" and "standard patent (R)" did not appear to align with the corresponding Chinese terms (i.e. "原授標準專利" and "轉錄標準專利"), and their suggestion that the relevant English terms be amended as "original standard patent" and "recorded standard patent" respectively to make clearer the meaning of the terms under the Ordinance.</p> <p>The Administration's undertaking to consider whether the terms "standard patent (O)" and "standard patent (R)" in the English text of the Bill should be amended or not to enhance clarity.</p> <p>Mr CHUNG Kwok-pan's enquiry on the difference between the expressions "application for a patent" and "patent application". His suggestion that the Administration should enhance the clarity of the provisions of the Ordinance so as to make it easier for the business sector to understand the detail of the arrangements and procedures for filing patent applications. The Administration's response that –</p> <p>(a) both expressions held the same meaning. They had been commonly used in the existing provisions of the Ordinance, and were already familiar to patent practitioners;</p> <p>(b) public education would be enhanced to facilitate the public understanding about the operation of the new OGP system; and</p> <p>(c) the detailed patent application procedures would be set out in the related subsidiary legislation which would be submitted to the Legislative Council for negative vetting in due course.</p>	The Administration to follow up as stated in paragraph 2(a) of the minutes.
003738 – 004016	Chairman Administration	<p><u>Clause 6: Section 3 amended (meaning of <i>application for a standard patent</i>)</u></p> <p><u>Clause 7 : Section 4 amended (meaning of <i>designated patent, etc.</i>)</u></p> <p><u>Clause 8 : Section 5 amended (meaning of <i>published</i>)</u></p>	

Time marker	Speaker	Subject(s)	Action required
		Members raised no query on the above clauses.	
004017 – 004550	Chairman Mr SIN Chung-kai Mr Paul TSE Administration	<p><u>Clause 9: Section 6 amended (other references)</u></p> <p>At Mr SIN Chung-kai's and Mr Paul TSE's request, the Administration's undertaking to consider improving the drafting of the amendment to the Chinese text of section 6(5) (i.e. "指定專利申請內或在任何原授標準專利申請內或在任何專利或指定專利的說明書內，") under clause 9(2) to enhance the clarity of the relevant section.</p>	The Administration to follow up as stated in paragraph 2(b) of the minutes.
004551 – 004612	Chairman Administration	<p><u>Clause 10: Section 9 amended (special provision regarding invention covered by 2 or more patents)</u></p> <p>Members raised no query on the above clause.</p>	
004613 – 004956	Chairman Mr SIN Chung-kai Administration	<p><u>Clause 11 : Part 1A added</u></p> <p><i>Patentability, Right to Patent and Mention of Inventor</i></p> <p>The Administration's advice that new sections 9A to 9F of the new Part 1A replaced existing sections 45, 93, 94, 96, 97 and 100 of the Ordinance. These new sections set out the main principles of the patent system that had been adopted since enactment of the Ordinance in 1997, including "Patentability" (i.e. Division 1: new sections 9A to 9D) and "Right to Patent" and "Mention of Inventor" (i.e. Division 2: new sections 9E and 9F). They should be set out at the beginning of the Ordinance to enhance readability and facilitate readers' understanding of the subsequent provisions. The amendments made to the relevant existing provisions in re-enacting new sections 9A to 9F were mainly textual.</p> <p>At the request of Mr SIN Chung-kai, the Administration's undertaking to advise the Bills Committee of the textual amendments made to sections 9A to 9F.</p> <p><u>Division 1 – Patentability</u> <u>Section 9A – Patentable inventions</u></p> <p>Members raised no query on new section 9A.</p>	The Administration to follow up as stated in paragraph 2(c) of the minutes.

Time marker	Speaker	Subject(s)	Action required
004957 – 010141	Chairman Mr SIN Chung-kai Mr Paul TSE Mr WONG Ting-kwong Administration	<p><u>Section 9B – Novelty</u> <u>Section 9B(2), (3) and (4)</u></p> <p>Mr SIN Chung-kai, Mr Paul TSE and Mr WONG Ting-kwong's query that the use of the term "主體申請" in the Chinese text of new section 9B might not be clear enough. The Administration's undertaking to consider a better alternative, if any.</p>	The Administration to follow up as stated in paragraph 2(d) of the minutes.
010142 – 012124	Chairman Mr Paul TSE Mr SIN Chung-kai Administration	<p><u>Section 9B(5) to (8)</u></p> <p>The Administration's advice that –</p> <p>(a) New section 9B(5) to (8) introduced new provisions which addressed novelty of inventions consisting of substances or compositions for specific use in methods for treating or diagnosing human or animal bodies. These provisions sought to clarify the policy intent that inventions relating to second or further medical uses (collectively "second medical uses") could be regarded as new and thus patentable in terms of its novelty; and</p> <p>(b) while the existing statutory provisions on novelty did not expressly cover inventions relating to second medical uses, the local court (Court of First Instance) had recognized that such inventions could be patentable through the use of an indirect drafting approach known as the "Swiss-type claim". There were merits in updating the law to make clear the policy intention and to enable patent applicants to seek protection of inventions relating to second medical uses in Hong Kong through a simpler and more direct form of claim drafting.</p> <p>In response to the Chairman's and Mr SIN Chung-kai's enquiries, the Administration's explanation that new section 9B(6) to (8) were transitional provisions. Instead of including such provisions in a separate Schedule to the Ordinance, such as the existing Part XIX of the Ordinance entitled "Repeals and Transitional Arrangements", such provisions were included in new section 9B so that the section would be self-contained. This would facilitate reading and enhance comprehension of the relevant provisions by users.</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>Mr Paul TSE's enquiry on the impact of the patents of second medical uses of a substance or composition on the patentee of the first medical use.</p> <p>The Administration's response that –</p> <p>(a) new section 9B(5) to (8) sought to clarify the concept of novelty for inventions relating to second medical uses; and</p> <p>(b) these new provisions would provide for a simpler way for patent practitioners to draft the patent claims for inventions relating to second medical uses. Such provisions did not mean to change the three fundamental patentability criteria of an invention under the existing law (i.e. novelty, inventive steps and industrial application) or the rights of the concerned patentees.</p>	
012125 – 013116	Chairman Mr WONG Ting-kwong Mr CHUNG Kwok-pan Administration	<p>In response to Mr WONG Ting-kwong's enquiry on whether the patentee of the first medical use of a substance or composition could prohibit another inventor to apply for patent protection for second medical uses of that substance or composition, the Administration's explanation that –</p> <p>(a) whether an invention of second medical uses could be patented would be subject to assessment and determination of the patentability criteria of an invention under the Ordinance, namely, "novelty", "inventive steps" and "industrial application". An invention would not be patentable merely on the basis of "novelty"; and</p> <p>(b) the practice of enabling patent applicants to seek patent protection of inventions relating to second medical uses through a simpler and more direct form of claim drafting had been adopted in the United Kingdom's Patent office and the European Patent Office and similar provisions had already been introduced into their patent laws to provide for such arrangements.</p> <p>The Chairman's view that –</p> <p>(a) a patent offered protection for an invention by giving the patent owner an exclusive right to prevent others from, amongst others, manufacturing, using, selling or importing the product being the subject matter of the patent, or</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>using the process being the subject matter of the patent; and</p> <p>(b) the patent owner of the first medical use of a substance or a composition could apply to revoke the patent of an invention relating to the second medical uses of that substance or composition on the ground that the latter patent did not fulfill any of the patentability criteria of an invention, namely, "novelty", "inventive steps" or "industrial application".</p>	
013117 – 013836	Chairman Mr Paul TSE ALA6 Administration	<p>In response to Mr Paul TSE's enquiry, the Administration's explanation that –</p> <p>(a) an invention relating to second medical uses would not be patentable if it did not satisfy the other two fundamental patentability requirements (such as it did not involve an inventive step) notwithstanding that the patentability criterion of "novelty" could be met; and</p> <p>(b) patent practitioners and pharmaceutical companies had been consulted on the proposed introduction of the new provisions concerning novelty of inventions relating to second medical uses into the Ordinance. They welcomed the proposal.</p> <p>At Mr Paul TSE's request, the Administration's undertaking to provide citation of court cases where possible for members' reference in relation to –</p> <p>(a) the patentability criteria of an invention, namely, "novelty", "inventive step" and "industrial application"; and</p> <p>(b) the use of "Swiss-type claim" in Hong Kong to seek protection of inventions relating to second medical uses.</p> <p>ALA6's request for the Administration to further elaborate on the transitional arrangements provided for in new section 9B(6) and (7). The Chairman's advice that the Bills Committee would revisit the relevant sections at the next meeting in the light of Mr SIN Chung-kai's concern about the handling of transitional provisions under the Bill.</p>	<p>The Administration to follow up as stated in paragraph 2(e) of the minutes.</p> <p>The Administration to follow up.</p>

Time marker	Speaker	Subject(s)	Action required
013837 – 014403	Chairman Mr SIN Chung-kai Administration	<p><u>9C. Inventive step</u></p> <p>In response to Mr SIN Chung-kai's query, the Administration's explanation that the existing term "inventive step" in the Ordinance was commonly adopted in the statutory provisions of a number of jurisdictions overseas as well as in international treaties.</p> <p>At Mr SIN Chung-kai's request, the Administration's elaboration of the meaning of "obvious" under the new section 9C(1).</p>	
014404 – 015620	Chairman Mr Paul TSE Administration	<p>Mr Paul TSE's enquiry on the interpretation of the patentability criterion of "inventive step", and on the patentability of an old drug that was subsequently discovered to have new medical uses in terms of the criteria of "novelty" and "inventive step".</p> <p>The Administration's response that whether an old drug with discovery of new medical uses (which might involve change of composition or formula) could satisfy the patentability criteria of "novelty" and "inventive step" would have to be assessed and determined on a case by case basis.</p>	
015621 – 015805	Chairman Administration	<p><u>9D. Industrial application</u></p> <p><u>Division 2 – Right to Patent and Mention of Inventor</u></p> <p><u>9E. Right to patent belongs to inventor</u></p> <p><u>9F. Mention of inventor</u></p> <p>Members raised no query on the above new sections.</p> <p>The Chairman's advice that in the light of members' concerns expressed at the meeting, the Bills Committee would revisit the relevant provisions under clause 11 at the next meeting.</p>	The Administration to follow up.
015806 – 015829	Chairman	<p>Meeting arrangements.</p> <p>Closing remarks.</p>	