

立法會
Legislative Council

LC Paper No. CB(1)1094/15-16
(These minutes have been seen
by the Administration)

Ref : CB1/BC/2/15

Bills Committee on Patents (Amendment) Bill 2015

**Minutes of the fourth meeting
on Tuesday, 2 February 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 Andrew LEUNG Kwan-yuen, GBS, JP
Hon WONG Ting-kwong, SBS, JP
Hon Paul TSE Wai-chun, JP
Hon Alan LEONG Kah-kit, SC
Hon WONG Yuk-man
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

**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

Miss Fabia TAM
Principal Assistant Secretary
for Commerce and Economic Development
(Commerce and Industry)3

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

Intellectual Property Department

Mr Thomas TSANG
Assistant Director of Intellectual Property (Patents)

Ms Winnie MAK
Senior Solicitor (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)505/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 12 January 2016

LC Paper No. CB(1)505/15-16(02) -- Administration's responses to issues raised at the meeting on 12 January 2016

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

LC Paper No. CB(1)505/15-16(03) -- Administration's responses to enquiries raised by the Assistant Legal Adviser in the letter dated 8 January 2016)

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) reconsider improving the drafting of the amendment to the Chinese text of section 6(5) of the Patents Ordinance (Cap. 514) ("the Ordinance") under clause 9(2) of the Bill to enhance the clarity of that section;

Action

- (b) review the use of punctuation in the Chinese text of the Bill, including new section 9A(1) of the new Part 1A under clause 11 of the Bill, and note a member's suggestion of creating a dedicated chapter on the use of punctuation in the Chinese and English texts of legislation in "Drafting Legislation in Hong Kong: A Guide to Styles and Practices" issued by the Department of Justice to ensure accuracy and consistency in using punctuation in bilingual law drafting;
- (c) consider whether there was a need to substitute "must" for "may" and "須" for "可" respectively in the English and Chinese texts of new section 9F(3)(c) under clause 11 of the Bill;
- (d) report to the Bills Committee as soon as the Administration had considered how best to deal with the drafting issues about clauses 7, 13, 26 and 35 of the Bill as raised by the legal adviser to the Bills Committee in her letter dated 8 January 2016 to the Administration (LC Paper No. CB(1)413/15-16(01)) to which the Administration had given a written response in its letter dated 1 February 2016 (LC Paper No. CB(1)505/15-16(03)); and
- (e) consider revising the Chinese text of the heading before section 28 of the Ordinance under clause 33 of the Bill from "第 6 分部 — 進一步的處理及權利的恢復" to "第 6 分部 — 進一步處理及權利的恢復" to align with the relevant expression used in the Chinese text of the heading of section 28 of the Ordinance under clause 34 of the Bill.

(Post-meeting note: The information provided by the Administration was issued to members vide LC Paper No. CB(1)700/15-16 (02) on 18 March 2016.)

II. Any other business

Date of next meeting

3. The Chairman reminded members that the next meeting would be held on Tuesday, 23 February 2016 at 10:45 am.

4. There being no other business, the meeting ended at 12:48 pm.

Council Business Division 1
Legislative Council Secretariat
4 July 2016

**Proceedings of the fourth meeting of
the Bills Committee on Patents (Amendment) Bill 2015
on Tuesday, 2 February 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			
000000 – 000751	Chairman Administration	<p>Opening remarks.</p> <p>Briefing by the Administration on its response (LC Paper No. CB(1)505/15-16(02)) to the issues set out in paragraph (e) of the list of follow-up actions arising from the discussion at the meeting on 12 January 2016 ("the List") (LC Paper No. CB(1)505/15-16(01)).</p>	
000752 – 001401	Chairman Mr WONG Kwok-hing Administration	<p>Mr WONG Kwok-hing's view that "susceptible of industrial application", being one of the patentability criteria of an invention as provided for in the new section 9A(1)(c) of the new Part 1A under clause 11 of the Patents (Amendment) Bill 2015 ("the Bill"), might have narrowed down the scope of patentable inventions, given that some medical inventions were not intended for industrial uses.</p> <p>The Administration's response that –</p> <p>(a) the new section 9A(1) under clause 11 of the Bill re-enacted section 93(1) of the Patents Ordinance (Cap. 514) ("the Ordinance") which provided for the patentability criteria of an invention, i.e. an invention was patentable if it was new (novel), involved an inventive step, and was susceptible of industrial application. The Bill did not change the patentability criteria of an invention as currently provided for in the Ordinance;</p> <p>(b) the relevant patentability criteria were in line with the established standard as enshrined in the international treaties on patent protection, and were also adopted by the major patent offices outside Hong Kong; and</p> <p>(c) an invention was regarded as susceptible of industrial application if it could be made or used in any kind of industry. As noted by the UK Patents Court, the notion "industry", which should be construed broadly, included</p>	

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		all manufacturing, extracting and processing activities of enterprises that were carried out continuously, independently and for commercial gain. The Administration added that medical and biotech inventions used in the production of pharmaceuticals could also be regarded as susceptible of industrial application.	
001402 – 001545	Chairman Mr SIN Chung-kai Administration	The Administration's response to Mr SIN Chung-kai's enquiry that the new section 9A of the new Part 1A under clause 11 of the Bill re-enacted section 93 of the Ordinance on "Patentable inventions".	
001546 – 002948	Chairman Mr SIN Chung-kai Mr Jeffrey LAM Kin-fung Mr WONG Yuk-man Administration	<p>The Administration's response to issues set out paragraphs (a), (b), (c) and (d) of the List.</p> <p><u>Paragraph (a): the Administration was requested to consider whether the terms "standard patent (O)" and "standard patent (R)" in the English text of the Bill should be amended to enhance clarity.</u></p> <p>The Administration's advice that –</p> <p>(a) definitions of the terms "standard patent (O)" and "standard patent (R)" were provided in section 2(1) of the Ordinance under clause 5(7) of the Bill and the meaning of these terms was clear;</p> <p>(b) the Ordinance was already lengthy given its technical nature. Amending the defined terms would likely increase the number of words to be used in the English text (e.g. by amending the term "standard patent (O)" to "standard patent original grant") of the Ordinance, thereby inevitably increasing the length of the text. It should be noted that there were over 120 references to the term "standard patent (O)". The Administration considered the proposed terms (i.e. "standard patent (O)" and "standard patent (R)") in the Bill appropriate for maintaining the conciseness of the Ordinance; and</p> <p>(c) given the differences between the Chinese and English languages in terms of word structure and grammar, there were cases in existing legislation where certain terms were expressed differently in the Chinese and English text. For example, the term "SWK draft plan" (and not Southwest Kowloon draft plan) was the English term of</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>"西南九龍草圖" under the West Kowloon Cultural District Authority Ordinance (Cap. 601).</p> <p>Mr SIN Chung-kai said that he might consider proposing Committee stage amendments to "standard patent (O)" and "standard patent (R)" in the English text to better align with the corresponding Chinese text (i.e. "原授標準專利" and "轉錄標準專利").</p> <p><u>Paragraph (b): the Administration was requested to consider whether the drafting of the amendment to the Chinese text of section 6(5) of the Ordinance (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</u></p> <p>The Administration's advice that the amendment to the Chinese text of section 6(5) of the Ordinance under clause 9(2) of the Bill, which primarily added the corresponding reference to the term "or standard patent (O) application" in the English text (i.e. "或在任何原授標準專利申請內"), did not introduce substantive changes to the original provision and its meaning was clear.</p> <p>Members' views that the amendment to the Chinese text of section 6(5) of the Ordinance under clause 9(2) of the Bill was clumsy. The Administration was requested to re-consider improving the drafting of the amendment to the Chinese text of section 6(5) of the Ordinance to enhance the clarity of that section.</p>	<p>The Administration to follow up as stated in paragraph 2(a) of the minutes.</p>
002949 – 004346	<p>Chairman Mr WONG Yuk-man Mr SIN Chung-kai Mr Jeffrey LAM Kin-fung Administration</p>	<p><u>Paragraph (c): The Administration was requested to 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 (Annex A to LC Paper No. CB(1)505/15-16(02))</u></p> <p><u>Section 9A – Patentable inventions</u></p> <p>Mr WONG Yuk-man's views and suggestion that –</p> <p>(a) the use of punctuation in the Chinese text of the new section 9A(1) was questionable; and</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>(b) the Administration should review the use of punctuation in the Chinese text of the Bill and consider creating a dedicated chapter on the use of punctuation in the Chinese and English texts of legislation in "Drafting Legislation in Hong Kong: A Guide to Styles and Practices" ("the Guide") issued by the Department of Justice to ensure accuracy and consistency in using punctuation in bilingual law drafting.</p> <p><u>Section 9A(6)(b)</u></p> <p>The Administration's response to Mr SIN Chung-kai's enquiry that the amendments made to the Chinese text of the new section 9A(6)(b) were to enhance the conciseness of the provision and it would not narrow down the scope of exceptions that had been provided for in the original provision.</p>	<p>The Administration to follow up as stated in paragraph 2(b) of the minutes.</p>
004347 – 005124	Chairman Mr CHUNG Kwok-pan Administration	<p><u>Section 9B – Novelty</u></p> <p>In respect of the new section 9B(6) and (7), the Administration's response to Mr CHUNG Kwok-pan's enquiry on under what circumstances should the existing section 94 of the Ordinance and the new section 9B under clause 11 of the Bill be applied in the validity proceedings in relation to a pre-existing patent –</p> <p>(a) the existing section 94 of the Ordinance should apply in validity proceedings in connection with a pre-existing patent which were commenced before the date on which the Patents (Amendment) Ordinance 2015 ("the Amendment Ordinance") came into operation; and</p> <p>(b) vice versa, in cases where the validity proceedings relating to a pre-existing patent were commenced after the Amendment Ordinance came into operation, the new section 9B under clause 11 of the Bill should apply.</p>	
005125 – 005326	Chairman Administration	<p><u>Section 9C – Inventive step</u> <u>Section 9D – Industrial application</u> <u>Section 9E – Right to patent belongs to inventor</u></p> <p>Members raised no query on the above new sections.</p>	

Time marker	Speaker	Subject(s)	Action required
005327 – 010312	Chairman Administration	<p><u>Section 9F – Mention of inventor</u></p> <p>Discussion on the Administration's response (paragraphs 2 and 3 in LC Paper No. CB(1)505/15-16(03)) to the issue relating to the new section 9F raised by the legal adviser to the Bills Committee ("ALA6") in her letter dated 8 January 2016 (LC Paper No. CB(1)413/15-16(01)).</p> <p>At the Chairman's request, the Administration would consider whether there was a need to substitute "must" for "may" and "須" for "可" respectively in the English and Chinese texts of the new section 9F(3)(c).</p>	The Administration to follow up as stated in paragraph 2(c) of the minutes.
010313 – 010402	Chairman Administration	<p><u>Paragraph (d): the Administration was requested to 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 corresponding term in the English text</u></p> <p>The Administration's advice that the term "主體申請" was used in the new section 9B only. Members raised no further query on the issue.</p>	
<p><i>The Bills Committee continued clause-by-clause examination of the Bill</i> [The Bill (LC Paper No. CB(3)101/15-16)] [Marked-up copy of the Bill prepared by the Legal Service Division (LC Paper No. CB(1)219/15-16(01))]</p>			
010403 – 010522	Chairman Administration	<p><u>Clause 12: Headings before section 10 substituted</u></p> <p>Members raised no query on the above clause.</p>	
010523 – 010817	Chairman ALA6 Administration	<p><u>Clause 13: Section 10 amended (general provision regarding applications for standard patents)</u></p> <p>The Administration's response (paragraph 9 in LC Paper No. CB(1) 505/15-16(03)) to the drafting issues raised in ALA6's letter dated 8 January 2016 in connection with clauses 7 and 13 of the Bill (LC Paper No. CB(1)413/15-16(01)).</p> <p>At the request of the Chairman, the Administration undertook to report to the Bills Committee as soon as it had considered how best to deal with the relevant drafting issues.</p>	The Administration to follow up as stated in paragraph 2(d) of the minutes.

Time marker	Speaker	Subject(s)	Action required
010818 – 011155	Chairman Administration	<u>Clause 14: Section 11 amended (formality examination of applications for standard patent)</u> <u>Clause 15: Part 2, Division 2 added</u> Members raised no query on the above clauses.	
011156 – 012050	Chairman Mr WONG Yuk-man Administration	Mr WONG Yuk-man's query on whether the use of cross-references in section 10(b) and (d) were in line with the principle stated in section 9.1.7 of the Guide which stated that a cross-reference should be used only if its absence would create an ambiguity taking in view that cross-references would interrupt the flow of sentences and the reader's chain of thought. The Administration's advice that the Ordinance was enacted in 1997 with over 100 sections. Taking into consideration that an overall revision of the provisions of the Ordinance to bring them in line with the latest drafting requirements as stated in the Guide would greatly enlarge the scope of amendments, the Administration considered it appropriate to focus on the necessary amendments for implementing the policy objectives of the current legislative exercise. Mr WONG Yuk-man raised no further query.	
012051 – 012737	Chairman Administration	<u>Clause 16: Heading before section 12 substituted</u> <u>Clause 17: Section 12 amended (who may apply)</u> <u>Clause 18: Section 13 amended (determination before grant of questions as to who may apply)</u> <u>Clause 19: Section 14 amended (effect of transfer of application under section 13)</u> <u>Clause 20: Heading before section 15 substituted</u> <u>Clause 21: Section 15 amended (filing of request to record)</u> Members raised no query on the above clauses.	
012738 – 013019	Chairman Mr WONG Yuk-man Administration	<u>Clause 22: Section 17 amended (date of filing of request to record)</u> Mr WONG Yuk-man's view that the amendment made to section 17(2) was appropriate to enhance clarity of the section.	
013020 – 013626	Chairman Administration	<u>Clause 23: Section 18 amended (examination on filing of request to record)</u> <u>Clause 24: Section 19 amended (examination as to formal requirements of request to record)</u> <u>Clause 25: Section 20 amended (publication of request</u>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>of record)</u></p> <p>Members raised no query on the above clauses.</p>	
013627 – 013936	Chairman ALA6 Administration	<p><u>Clause 26: Section 22 amended (provision for request to record in the event of a divisional designated patent application)</u></p> <p><u>Section 22(1)(b)</u></p> <p>The Administration's response (paragraph 11 in LC Paper No. CB(1) 505/15-16(03)) to the drafting issue raised in ALA6's letter dated 8 January 2016 (LC Paper No. CB(1)413/15-16(01)) in connection with clause 26 of the Bill. At the request of the Chairman, the Administration undertook to report to the Bills Committee as soon as it had considered how best to deal with the relevant drafting issue.</p>	The Administration to follow up as stated in paragraph 2(d) of the minutes.
013937 – 014644	Chairman Administration	<p><u>Clause 27: Heading before section 23 substituted</u></p> <p><u>Clause 28: Section 23 amended (filing of request for registration and grant)</u></p> <p><u>Clause 29: Section 24 amended (date of filing request for registration and grant)</u></p> <p><u>Clause 30: Section 25 amended (examination on filing of request for registration and grant)</u></p> <p><u>Clause 31: Section 26 amended (examination as to formal requirements of the request for registration and grant)</u></p> <p><u>Clause 32: Section 27 amended (registration of designated patent and grant of patent)</u></p> <p>Members raised no query on the above clauses.</p>	
014645 – 015652	Chairman Mr WONG Yuk-man Administration	<p><u>Clause 33: Heading before section 28 substituted</u></p> <p><u>Clause 34: Section 28 amended (further processing of application for standard patent)</u></p> <p>At the request of Mr WONG Yuk-man, the Administration would consider revising the Chinese text of the heading before section 28 of the Ordinance under clause 33 of the Bill from "第 6 分部 — 進一步的處理及權利的恢復" to "第 6 分部 — 進一步處理及權利的恢復" to align with the relevant expression used in the Chinese text of the heading of section 28 of the Ordinance under clause 34 of the Bill.</p>	The Administration to follow up as stated in paragraph 2(e) of the minutes.

Time marker	Speaker	Subject(s)	Action required
015653 – 020332	Chairman Administration	<u>Clause 35: Section 29 amended (restoration of rights)</u> <i>(The Chairman extended the meeting for five minutes)</i> The Administration briefed members on the amendments made to section 29 of the Ordinance under clause 35 of the Bill. The Chairman advised that the Bills Committee would continue with the deliberation of clause 35 at the next meeting.	
020333 – 020353	Chairman	The Chairman announced that the next meeting would be held on 23 February 2016 at 10:45 am.	

Council Business Division 1
Legislative Council Secretariat
4 July 2016