

立法會
Legislative Council

LC Paper No. CB(1)1095/15-16
(These minutes have been seen
by the Administration)

Ref : CB1/BC/2/15

Bills Committee on Patents (Amendment) Bill 2015

**Minutes of the fifth meeting
on Tuesday, 23 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 SIN Chung-kai, SBS, JP
Ir Dr Hon LO Wai-kwok, SBS, MH, JP
Hon CHUNG Kwok-pan

Member absent : Hon Dennis KWOK

**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)

Mr Derek LAU
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

I. Confirmation of minutes of meeting

(LC Paper No. CB(1)576/15-16 -- Minutes of meeting held on 1 December 2015)

The minutes of the meeting held on 1 December 2015 were confirmed.

II. Meeting with the Administration

(LC Paper No. CB(1)575/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 2 February 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

LC Paper No. CB(1)575/15-16(03) -- Assistant Legal Adviser's letter dated 17 February 2016 to the Administration)

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

Matters arising from discussion at the last meeting

3. The Chairman informed members that the Administration would provide a written response to the list of follow-up actions arising from discussion at the last meeting on 2 February 2016 before the next meeting of the Bills Committee.

Follow-up actions to be taken by the Administration

4. The Administration was requested to consider revising the Chinese text of the proposed new heading of Part 3 (under clause 45 of the Patents (Amendment) Bill 2015 ("the Bill")) to be added after section 37 of the Patents Ordinance (Cap. 514) from "原案授予的標準專利" to "原授標準專利" to align with the Chinese term of "原授標準專利" used in other provisions of the Bill.

(Post-meeting note: The Administration's written responses to the lists of follow-up actions arising from discussion at the meetings of the Bills Committee on 2 and 23 February 2016 were circulated to members vide LC Paper No. CB(1)700/15-16(02) on 18 March 2016.)

III. Any other business

Date of next meeting

5. The Chairman reminded members that the next meeting would be held on Thursday, 31 March 2016 at 10:45 am.

(Post-meeting note : At the request of the Administration and with the concurrence of the Chairman of the Bills Committee, the next meeting had been rescheduled to be held on Wednesday, 23 March 2016, at 10:45 am in Conference Room 2B of the Legislative Council Complex.)

6. There being no other business, the meeting ended at 12:43 pm.

**Proceedings of the fifth meeting of
the Bills Committee on Patents (Amendment) Bill 2015
on Tuesday, 23 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 – Confirmation of minutes of meeting			
000000 – 000530	Chairman	Confirmation of minutes of meeting held on 1 December 2015	
Agenda Item II – Meeting with the Administration			
000531 – 001115	Chairman Assistant Legal Adviser 6 ("ALA6") Administration	<p>Opening remarks by the Chairman</p> <p><u>Discussion on the drafting issue in relation to clause 35 and the legal issues in relation to clauses 34(5) and 35(7) of the Patents (Amendment) Bill 2015 ("the Bill") raised by ALA6 in her letter dated 8 January 2016 to the Administration (LC Paper No. CB(1) 413/15-16(01))</u></p> <p><u>Clause 35: Section 29 amended (restoration of rights)</u></p> <p>The Administration's response that it would report to the Bills Committee as soon as it had considered the most appropriate channel for dealing with the issues raised by ALA6 on clauses 7, 13, 26 and 35 of the Bill (paragraph (d) of the "List of follow-up action arising from the discussion at the meeting on 2 February 2016" (LC Paper No. CB(1)575/15-16(01)).</p> <p><i>(Post-meeting note : The Administration would introduce Committee Stage amendments to deal with the drafting issues on clauses 7, 13, 26 and 35. The relevant draft CSAs were circulated to members vide LC Paper No. CB(1)867/15-16(01) on 3 May 2016)</i></p> <p><u>Clauses 34(5) and 35(7)</u></p> <p>The Administration's response (paragraphs 4 to 7 in LC Paper No. CB(1)505/15-16(03)) to the legal issues raised by ALA 6 in respect of the above clauses.</p>	
<p><i>The Bills Committee continued clause-by-clause examination of the Bill</i> <i>[The Bill (LC Paper No. CB(3)101/15-16)]</i> <i>[Marked-up copy of the Bill prepared by the Legal Service Division (LC Paper No. CB(1)219/15-16(01))]</i></p>			

Time marker	Speaker	Subject(s)	Action required
001116 – 001245	Chairman Administration	<u>Clause 36: Section 30 amended (effect of restoration of rights under section 29)</u> Members raised no query on the above clause.	
001246 – 001414	Chairman ALA6 Administration	<u>Clause 37: Heading before section 31 substituted</u> The Administration's advice that it would provide a written response to the list of legal and drafting issues, including the one regarding the accuracy of the heading of Division 7 of Part 2 of the Patents Ordinance (Cap. 514) ("the Ordinance") added by the above clause, raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)).	see LC Paper No. CB(1)757/15-16 (03)
001415 – 002252	Chairman Administration	<u>Clause 38: Section 31 amended (amendment of application for standard patent)</u> <u>Clause 39: Section 32 amended (withdrawal of application)</u> <u>Clause 40: Section 33 amended (maintaining application for standard patent)</u> <u>Clause 41: Section 34 amended (restoring application for standard patent)</u> <u>Clause 42: Section 35 amended (effect of restoration order under section 34)</u> <u>Clause 43: Section 36 amended (limitation on withdrawal, amendment, etc. of application)</u> <u>Clause 44: Section 37 amended (Registrar may refuse to record under section 20 or to register and grant under section 27)</u> Members raised no query on the above clauses.	
002253 – 003748	Chairman Mr WONG Yuk-man Administration	<u>Clause 45: Part 3 added</u> The Administration's advice that the new sections 37A to 37ZD were added under Part 3 of the Ordinance to provide for the legal and procedural framework for the application for, examination and grant of "original grant" patent ("OGP"). The Administration's response to Mr WONG Yuk-man's enquiry in relation to the use of the Chinese term "原案授予的標準專利" in the heading of the newly added Part 3 that – (a) there was no material difference in meaning	

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		<p>between the Chinese terms "原案授予的標準專利" used in the heading of the new Part 3 and "原授標準專利" used in other provisions of the Bill; and</p> <p>(b) the use of the Chinese term "原案授予的標準專利" in the heading of the new Part 3 which was slightly different from the one used in other provisions (i.e. "原授標準專利") of the Bill would not affect the interpretation of OGP under the Ordinance or create any ambiguity of its statutory meaning.</p> <p>However, at the request of Mr WONG, the Administration would consider revising the Chinese text of the proposed new heading of Part 3 to be added after section 37 of the Ordinance from "原案授予的標準專利" to "原授標準專利" to align with the Chinese term of "原授標準專利" used in other provisions of the Bill.</p> <p>Part 3 Standard Patents by Original Grant Division 1 – Novelty and Priority</p> <p><u>Section 37A – Interpretation of Division 1 of Part 3</u></p> <p>Referring to her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)), ALA6's enquiry on the reasons for not carving out Hong Kong from the meaning of "a Paris Convention country" in the definition of "non-Hong Kong application" as in the new section 11B(6) of the Ordinance to make it clear that a non-Hong Kong application did not include an application made in Hong Kong.</p> <p>The Administration's advice that it would furnish the Bills Committee with a written response to the above legal issue raised by ALA6.</p> <p>Mr WONG Yuk-man's query on the credibility of the State Intellectual Property Office in Mainland China ("SIPO") from which the Intellectual Property Department would seek technical assistance in the substantive examination of patent applications filed under the OGP route during the initial stage of the setting up of the new patent system and whether the</p>	<p>The Administration to follow up as stated in paragraph 4 of the minutes.</p> <p>see LC Paper No. CB(1)757/15-16 (03)</p>

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		<p>Administration had given enough thoughts to such an arrangement. The Administration's advice that –</p> <p>(a) one of the recommendations of the Advisory Committee on Review of the Patent System in Hong Kong was for IPD to outsource substantive examination of OGP applications to a reputable and authoritative patent office outside Hong Kong at the initial stage of the OGP system. This recommendation was made after a thorough study having regard to the views received in the public consultation exercise conducted in 2011; and</p> <p>(b) being one of the top five patent offices in the world, and having regard to its expertise and capacity in handling the largest number of national patent applications since 2011, and its status as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty, SIPO had been internationally recognized as a credible and reputable office for patent search and examination.</p>	
003749 – 004519	Chairman Mr WONG Yuk-man Administration	<p><u>Section 37B – Non-prejudicial disclosure</u></p> <p>The Administration's response to the legal issue in relation to the new section 37B(2)(b)(ii) of the Ordinance raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)) and the Administration's advice that a written reply on the relevant issue would be provided to the Bills Committee in due course.</p> <p>Members raised no query on the above section.</p> <p>In response to Mr WONG Yuk-man's enquiry, the Administration's reiteration of the purpose of introducing the new Part 3 comprising new sections 37A to 37ZD into the Ordinance.</p> <p>The Administration's response to the Chairman's enquiries that –</p> <p>(a) the reason for not referring to standard patent (R) application in the new section 37A of the Ordinance was that the proposed new provision was relevant to priority right issues relating to</p>	see LC Paper No. CB(1)757/15-16 (03)

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		<p>OGP applications while such issues in respect of applications under the re-registration system were to be dealt with under sections 11B and C; and</p> <p>(b) the retention of the re-registration system alongside the new OGP system would not violate any provision concerning fairness under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights under the World Trade Organization.</p>	
004520 – 005505	Chairman ALA6 Administration	<p><u>Section 37C – Priority right</u></p> <p>The Administration's response to the legal issue in relation to the new section 37C raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)) and the Administration's advice that a written reply on the relevant issue would be provided to the Bills Committee in due course.</p> <p><u>Section 37D – Restoration of priority right</u> <u>Section 37E – Claiming priority</u> <u>Section 37F – Effect of priority right</u></p> <p>Members raised no query on the above new sections.</p>	see LC Paper No. CB(1)757/15-16 (03)
005506 – 010134	Chairman Administration	<p>Division 2 – Who may Apply for Standard Patent (O)</p> <p><u>Section 37G – Application may be made alone or jointly</u> <u>Section 37H – Determination before grant of questions as to who may apply</u> <u>Section 37I – Powers of Registrar and court if standard patent (O) application has been filed</u> <u>Section 37J – Registrar and court may order new standard patent (O) application under certain circumstances</u> <u>Section 37K – Effect of transfer of application on licences and other rights in or under application etc.</u></p> <p>Members raised no query on the above new sections.</p>	
010135 – 010809	Chairman ALA6 Administration	<p>Division 3 – Application for Standard Patents (O)</p> <p><u>Section 37L – Requirements of standard patent (O) application</u></p>	

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		<p><u>Section 37M – Date of filing of standard patent (O) application</u></p> <p>ALA6 referred to the enquiry made in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)) on whether Hong Kong should be carved out from the meaning of "a Paris Convention country" in the definition of "specified application" under the new section 37M(6).</p> <p>The Administration's advice that a written response to the above legal issue would be provided to the Bills Committee in due course.</p> <p><u>Section 37N – Filing of missing description or missing drawing</u></p> <p><u>Section 37O – Missing description or missing drawing not filed or withdrawn</u></p> <p>Members raised no query on the above new sections.</p>	<p>see LC Paper No. CB(1)757/15-16 (03)</p>
010810 – 011136	Chairman ALA6 Administration	<p>Division 4 – Examination on Formal Requirements and Publication of Standard Patent (O) Application</p> <p><u>Section 37P – Examination on formal requirements</u></p> <p><u>Section 37Q – Publication of application</u></p> <p>The Administration's advice that it would provide a written response to the legal issue in respect of the new section 37Q(3)(b)(i) of the Ordinance raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)).</p> <p><u>Section 37R – Observations by third parties on patentability of invention</u></p> <p>Members raised no query on the above new sections.</p>	<p>see LC Paper No. CB(1)757/15-16 (03)</p>
011137 – 011825	Chairman ALA6 Administration	<p>Division 5 – Substantive Examination of Standard Patent (O) Applications and Grant of Standard Patents (O)</p> <p><u>Section 37S – Interpretation of Division 5 of Part 3</u></p> <p><u>Section 37T – Request for substantive examination of standard patent (O) application</u></p> <p><u>Section 37U – Substantive examination by Registrar</u></p> <p><u>Section 37V – Applicant may file representations and requests for amendment, etc.</u></p>	

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		<p>The Administration's response to the legal issue in respect of the new section 37V(2) of the Ordinance raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16 (03)) and the Administration's advice that a written reply on the relevant issue would be provided to the Bills Committee in due course.</p> <p><u>Section 37W – Registrar must consider representations and requests for amendment, etc.</u> <u>Section 37X – Grant of standard patent (O)</u> <u>Section 37Y – Refusal to grant standard patent (O)</u></p> <p>Members raised no query on the above new sections.</p>	<p>see LC Paper No. CB(1)757/15-16 (03)</p>
011826 – 012359	Chairman ALA6 Administration	<p>Division 6 – Provisions on Standard Patent (O) Applications before Grant</p> <p><u>Section 37Z – Divisional standard patent (O) application</u> <u>Section 37ZA – Amendment of standard patent (O) application before grant</u> <u>Section 37ZB – Withdrawal of standard patent (O) application</u> <u>Section 37ZC – Effect of withdrawal and refusal of standard patent (O) application</u> <u>Section 37ZD – Further processing of, and restoration of rights in respect of, standard patent (O) application</u></p> <p>The Administration's advice that it would furnish the Bills Committee with a written reply on the legal issue in respect of the new section 37ZD of the Ordinance raised by ALA6 in her letter dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)).</p> <p>Members raised no query on the above new sections.</p>	<p>see LC Paper No. CB(1)757/15-16 (03)</p>
012400 – 012859	Chairman ALA6 Administration	<p><u>Clause 46: Headings before section 38 substituted</u></p> <p>Part 4 Provisions on Patents after Grant Division 1 – Standard Patents</p> <p><u>Clause 47: Section 38 amended (deemed date of filing where standard patent has been granted)</u> <u>Clause 48: Section 39 amended (term of standard patent)</u> <u>Clause 49: Section 42 amended (determination after</u></p>	

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		<p><u>grant of questions referred before grant)</u> <u>Clause 50: Section 43 amended (amendment of standard patent following opposition or revocation proceedings in the designated patent office)</u> <u>Clause 51: Section 44 amended (revocation of standard patent following opposition or revocation proceedings in the designated patent office)</u></p> <p>The Administration's response to ALA6's enquiry that written responses to submissions received by the Bills Committee on the Bill, including a written submission dated 30 December 2015 from a member of the public expressing views on the proposed amendments to section 44 of the Ordinance (LC Paper No. CB(1)376/15-16(01)), as well as the views expressed by deputations at the meeting on 22 December 2015, would be provided to the Bills Committee in due course.</p> <p><u>Clause 52: Section 45 and cross-heading before it repealed</u></p> <p>Members raised no query on the above clauses.</p>	<p>see LC Paper No. CB(1)710/15-16 (01)</p>
012900 – 013139	Chairman Administration	<p><u>Clause 53: Part 4, Division 2 heading added</u></p> <p>Division 2 – Patents Generally</p> <p><u>Clause 54: Section 46 substituted</u> <u>Clause 55: Section 49 amended (Registrar's power to revoke patent on grounds of "ordre public" or morality)</u></p> <p>Members raised no query on the above clauses.</p>	
013140 – 013422	Chairman Administration	<p><u>Clause 56: Part V heading substituted</u></p> <p>Part 5 Property in Patents and Applications; Registration</p> <p><u>Clause 57: Section 54 amended (co-ownership of patents and applications for patents)</u> <u>Clause 58: Section 55 amended (determination of right to patent after grant)</u> <u>Clause 59: Section 56 amended (effect of transfer of patent under section 55)</u></p> <p>Members raised no query on the above clauses.</p>	

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013423 – 013507	Chairman Administration	<u>Clause 60: Part VI heading substituted</u> Part 6 Employees' Inventions <u>Clause 61: Part VII heading substituted</u> Part 7 Contracts as to Patented Products etc. <u>Clause 62: Part VIII heading substituted</u> Part 8 Compulsory Licences for Standard Patents Members raised no query on the above clauses.	
013508 – 013547	Chairman Administration	<u>Clause 63: Part IX heading substituted</u> Part 9 Government Use of Patented Inventions <u>Clause 64: Section 69 amended (Government use of patents during a period of extreme urgency)</u> Members raised no query on the above clauses.	
013548 – 013604	Chairman Administration	<u>Clause 65: Part IXA heading substituted</u> Part 9A Import Compulsory Licences for Patented Pharmaceutical Products <u>Clause 66: Section 72A heading amended (interpretation of Part IXA)</u> Members raised no query on the above clauses.	
013605 – 013710	Chairman Administration	<u>Clause 67: Part IXB heading substituted</u> Part 9B Export Compulsory Licences for Patented Pharmaceutical Products <u>Clause 68: Section 72K amended (interpretation of Part IXB)</u> Members raised no query on the above clauses.	

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013711 – 013856	Chairman Administration	<p><u>Clause 69: Part X heading substituted</u></p> <p>Part 10 Effects of Patent and Patent Application</p> <p><u>Clause 70: Section 78 substituted</u> <u>Clause 71: Section 79 amended (the abstract)</u></p> <p>Members raised no query on the above clauses.</p>	
013857 – 014647	Chairman Administration	<p><u>Clause 72: Part XI heading substituted</u></p> <p>Part 11 Infringement</p> <p><u>Clause 73: Section 80 amended (proceedings for infringement of patent)</u> <u>Clause 74: Section 81 amended (restrictions on recovery of damages for infringement)</u> <u>Clause 75: Section 83 amended (right to continue use begun before priority date)</u> <u>Clause 76: Section 88 amended (infringement of rights conferred by publication of application for standard patent)</u> <u>Clause 77: Section 89 amended (remedy for groundless threats of infringement proceedings)</u> <u>Clause 78: Section 89A added</u></p> <p>The Administration's undertaking to provide a written response to the views on the provisions relating to short-term patents under the new section 89A of the Ordinance expressed in the submissions of the Law Society of Hong Kong (CB(1)347/15-16(02)) and the Asian Patent Attorneys Association (CB(1)347/15-16(01)) at the next meeting.</p> <p>Members raised no query on the above clauses.</p>	see LC Paper No. CB(1)710/15-16 (01)
014648 – 015009	Chairman Administration	<p><u>Clause 79: Part XII heading substituted</u></p> <p>Part 12 Revocation of Patents</p> <p><u>Clause 80: Cross-heading before section 91 repealed</u> <u>Clause 81: Section 91 amended (power to revoke patents on application)</u> <u>Clause 82: Section 92 amended (application for revocation)</u> <u>Clause 83: Section 93 to 100 and cross-headings</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<u>repealed</u> <u>Clause 84: Cross-heading before section 101 repealed</u> <u>Clause 85: Section 101 amended (proceedings in which validity of patent may be put in issue)</u> Members raised no query on the above clauses.	
015010 – 015851	Chairman Mr Paul TSE Administration	<u>Clause 86: Section 101A added</u> The Administration's response to Mr Paul TSE's enquiry that the provisions under the proposed new section 101A of the Ordinance sought to clearly set out the powers of the court in validity proceedings in relation to short-term patents. These provisions were not meant to affect or substitute the court's powers under its inherent jurisdiction.	
015852 – 015940	Chairman	Meeting arrangements.	