

立法會
Legislative Council

LC Paper No. CB(1)1139/15-16
(These minutes have been seen
by the Administration)

Ref : CB1/BC/2/15

Bills Committee on Patents (Amendment) Bill 2015

**Minutes of the sixth meeting
on Wednesday, 23 March 2016, at 10:45 am
in Conference Room 2B of the Legislative Council Complex**

Members present : Hon Martin LIAO Cheung-kong, SBS, JP (Chairman)
Hon WONG Kwok-hing, BBS, MH
Hon Andrew LEUNG Kwan-yuen, GBS, JP
Hon WONG Ting-kwong, SBS, JP
Hon Paul TSE Wai-chun, JP
Hon Charles Peter MOK, JP
Hon Dennis KWOK
Hon CHUNG Kwok-pan

Members absent : Hon Jeffrey LAM Kin-fung, GBS, JP
Hon Alan LEONG Kah-kit, SC
Hon WONG Yuk-man
Hon SIN Chung-kai, SBS, JP
Ir Dr Hon LO Wai-kwok, SBS, MH, JP

**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

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)575/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 2 February 2016
- LC Paper No. CB(1)700/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 23 February 2016
- LC Paper No. CB(1)700/15-16(02) -- Administration's responses to issues raised at the meetings on 2 and 23 February 2016
- LC Paper No. CB(1)710/15-16(01) -- Administration's responses to written submissions received and views expressed by deputations 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) -- Marked-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

Action

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

LC Paper No. CB(1)700/15-16(03) -- Assistant Legal Adviser's letter dated 16 March 2016 to the Administration)

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

Follow-up action to be taken by the Administration

2. The Administration was requested to review the proposed criminal sanction as stipulated in the new section 144A(5) (i.e. a fine of \$500,000) under clause 129 of the Patents (Amendment) Bill 2015, which was benchmarked at the penalty levels of comparable offences under the Legal Practitioners Ordinance (Cap.159), for a person who committed an offence by using the prohibited titles or descriptions under the new section 144A(2).

(Post-meeting note: The information provided by the Administration was issued to members vide LC Paper No. CB(1)757/15-16(02) on 8 April 2016.)

II. Any other business

Date of next meeting

3. The Chairman reminded members that the next meeting would be held on Monday, 11 April 2016 at 2:30 pm.

4. There being no other business, the meeting ended at 12:23 pm.

Council Business Division 1
Legislative Council Secretariat
18 July 2016

**Proceedings of the sixth meeting of
the Bills Committee on Patents (Amendment) Bill 2015
on Wednesday, 23 March 2016, at 10:45 am
in Conference Room 2B of the Legislative Council Complex**

Time marker	Speaker	Subject(s)	Action required
Agenda Item I – Meeting with the Administration			
000000 – 001003	Chairman Mr WONG Kwok-hing Mr CHUNG Kwok-pan Administration	<p>Opening remarks</p> <p>The Chairman's advice that –</p> <p>(a) the Bills Committee would continue clause-by-clause examination of the Patents (Amendment) Bill 2015 ("the Bill") at the meeting; and</p> <p>(b) to allow sufficient time for members to study the relevant papers, the Administration would brief members on its responses to the Lists of follow-up actions arising from the discussion at the meetings on 2 and 23 February 2016 (LC Paper No. CB(1)700/15-16(02)) and to the written submissions and deputations' views expressed at the meeting on 22 December 2015 (LC Paper No. CB(1)710/15-16(01)) at the next meeting to be held on 11 April 2016.</p> <p>Mr WONG Kwok-hing's advice that the Administration should, prior to resumption of the Second Reading debate on the Bill, lobby for the support of Members from different political parties for the Bill to facilitate its passage by the end of this session.</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>			
001004 – 001236	Chairman Administration	<p>The Chairman informed members that –</p> <p>(a) the Administration planned to issue response to the second letter of the Legal Adviser to the Bills Committee ("ALA6") dated 17 February 2016 to the Administration (LC Paper No. CB(1)575/15-16(03)) shortly; and</p> <p>(b) ALA6 had issued the third letter on the Bill to the Administration on 16 March 2016 (LC Paper No. CB(1)700/15-16(03)), and the</p>	

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		<p>issues raised therein would be discussed during clause-by-clause examination of the Bill at the meeting.</p> <p><u>Clause 87: Part XIII heading substituted</u></p> <p>Part 13 General Provisions on Amendment of Patents and Patent Applications</p> <p><u>Clause 88: Section 102 amended (amendment of patent in infringement or revocation proceedings)</u> <u>Clause 89: Section 103 amended (amendments of applications and patents not to include added matter)</u></p> <p>Members raised no query on the above clauses.</p>	
001237 – 001310	Chairman Administration	<p><u>Clause 90: Part XIV heading substituted</u></p> <p>Part 14 Language of Proceedings and Authentic Text</p> <p><u>Clause 91: Section 104 amended (language of proceedings before Registrar)</u> <u>Clause 92: Section 106 amended (authentic text of standard patent and standard patent application)</u></p> <p>Members raised no query on the above clauses.</p>	
001311 – 001406	Chairman Administration	<p><u>Clause 93: Part XV heading substituted</u></p> <p>Part 15 Short-term Patents</p> <p><u>Clause 94: Section 108 and cross-heading before it repealed</u> <u>Clause 95: Cross-heading before section 109 repealed</u></p> <p>Members raised no query on the above clauses.</p>	
001407 – 001938	Chairman Administration	<p><u>Clause 96: Part 15, Division 1 heading and section 108A added</u></p> <p>Division 1 – Novelty and Priority 108A. Interpretation of Division 1 of Part 15</p> <p><u>Clause 97: Section 109 amended (non-prejudicial disclosure)</u> <u>Clause 98: Cross-heading before section 110 repealed</u> <u>Clause 99: Section 110 amended (priority right)</u></p>	

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		<u>Clause 100: Section 110A added</u> <u>Clause 101: Section 111 amended (claiming priority)</u> <u>Clause 102: Section 112 amended (effect of priority right)</u> Members raised no query on the above clauses.	
001939 – 002047	Chairman Administration	<u>Clause 103: Part 15, Division 2 heading and section 112A added</u> Division 2 – Applications for Short-term Patents 112A. Application may be made alone or jointly <u>Clause 104: Cross-heading before section 113 repealed</u> Members raised no query on the above clauses.	
002048 – 002701	Chairman Administration	<u>Clause 105: Section 113 amended (requirements of short-term patent application)</u> The Administration's response to the Chairman's enquiry about the proposed amendment made to section 113(4) of the Patents Ordinance (Cap. 514) ("the Ordinance").	
002702 – 003412	Chairman Administration	<u>Clause 106: Section 114 substituted</u> 114. Date of filing of short-term patent application Members raised no query on the above clause. <u>Clause 107: Sections 114A and 114B added</u> The Administration's response to the Chairman's enquiry on the impact of the arrangements provided for under section 114A(3) and (5) of the Ordinance regarding the priority right of a short-term patent application. <u>Clause 108: Section 115 amended (examination as to formal requirements)</u> <u>Clause 109: Section 116 amended (divisional short-term patent application)</u> Members raised no query on the above clauses.	

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003413 – 003909	Chairman Administration	<p><u>Clause 110: Section 117 amended (formality examination only)</u></p> <p>The Administration's response to the Chairman's enquiry that the proposed amendments to section 117(d) of the Ordinance sought to update the cross-references to the relevant applicable provisions and bring the provision in line with the drafting convention, and that such amendments would not introduce substantive changes to the meaning of the original provision from the legal aspect.</p>	
003910 – 004154	Chairman Administration	<p><u>Clause 111: Heading before section 118 substituted</u></p> <p>Division 3 – Procedures up to and Including Grant</p> <p><u>Clause 112: Section 118 amended (grant of short-term patent and publication)</u></p> <p>In response to the Chairman's comment, the Administration's confirmation that the proposed amendments made to section 118(1) of the Ordinance were merely textual.</p>	
004155 – 004647	Chairman Administration	<p><u>Clause 113: Section 120 amended (amendment of application for short-term patent before grant)</u></p> <p><u>Clause 114: Section 121 amended (withdrawal of application)</u></p> <p><u>Clause 115: Section 123 amended (further processing of, and restoration of rights in respect of, short-term patent applications)</u></p> <p><u>Clause 116: Section 124 amended (Registrar may refuse to grant short-term patent)</u></p> <p>Members raised no query on the above clauses.</p>	
004648 – 004914	Chairman Administration	<p><u>Clause 117: Section 125 amended (short-term patent application based on international application)</u></p> <p>The Administration's response to the Chairman's enquiry that the amended provision would allow the applicant of an international application seeking a patent for an invention (i.e. a standard patent) or a patent for a utility model designating the People's Republic of China ("PRC") which had entered its national phase in the PRC to apply for a short-term patent for the invention disclosed in that international application.</p>	

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004915 – 005105	Chairman Administration	<p><u>Clause 118: Heading before section 126 substituted</u></p> <p>Division 4 – Provisions on Short-term Patents after Grant</p> <p><u>Clause 119: Section 126A added</u></p> <p>Members raised no query on the above clauses.</p>	
005106 – 005216	Chairman Administration	<p><u>Clause 120: Part 15, Division 5 added</u></p> <p>Division 5 – Substantive Examination of Short-term Patents</p> <p>The Administration's advice that clause 120 added new sections 127A to 127G to provide for the legal and procedural framework for post-grant substantive examination of short-term patents.</p> <p><u>Section 127A – Interpretation of Division 5 of Part 15</u></p> <p>Members raised no query on the above new section.</p>	
005217 – 010203	Chairman ALA6 Administration	<p><u>Section 127B – Request for substantive examination of short-term patents</u></p> <p>The Chairman's comment that the term "legitimate business interests" in the new section 127B(2)(b) was too general and the Administration's response that when formulating the policy underlying the new section 127B(2)(b), reference had been made to the relevant provisions of the lesser patent systems of Australia and Ireland.</p> <p>The Administration's response to the Chairman's enquiry that the rationale for not allowing withdrawal of a request for substantive examination of a short-term patent under the new section 127B(4) was to prevent abuse of the post-grant substantive examination of short-term patent.</p> <p>The Administration's response to ALA6's enquiry that the views expressed by the Hong Kong Bar Association ("HKBA") relating to the new section 127B in its submission (LC Paper No. CB(1)334/15-16(03)) were in line with the relevant policy objective and that the Administration would consider amending the section to clarify that the right to request post-grant substantive examination of a short-term patent should be limited in certain circumstances in order to avoid abuse of the system.</p>	

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010204 – 010458	Chairman Administration	<p><u>Section 127C – Substantive examination by Registrar</u> <u>Section 127D – Proprietor may file representations and requests for amendment, etc.</u></p> <p>Members raised no query on the above new sections.</p>	
010459 – 010818	Chairman Administration	<p><u>Section 127E – Registrar must consider representations and requests for amendment, etc.</u> <u>Section 127F– Certificate of substantive examination</u> <u>Section 127G– Revocation of short-term patents</u></p> <p>Members raised no query on the above new sections.</p>	
010819 – 010907	Chairman Administration	<p><u>Clause 121: Heading before section 128 substituted</u></p> <p>Division 6 – Miscellaneous</p> <p><u>Clause 122: Section 128 repealed (disclosure of invention by specification; availability of samples of micro-organisms)</u></p> <p>Members raised no query on the above clauses.</p>	
010908 – 011705	Chairman Administration	<p><u>Clause 123: Section 129 amended (court proceedings in relation to short-term patents)</u></p> <p>The Administration's advice that clause 123 sought to amend section 129 of the Ordinance to provide that in certain cases, a request for post-grant substantive examination of a short-term patent was a prerequisite for commencing enforcement proceedings in relation to the patent.</p> <p>The Chairman's concern about the difficulties encountered by the proprietor of a short-term patent in satisfying the requirements set out under section 129(3) of the Ordinance when making an application for an injunction under section 80(1)(a) of the Ordinance in interlocutory proceedings and the Administration's response that the stakeholders' views on the actual practice of seeking an interlocutory injunction had already been taken into account in drafting the relevant provisions.</p>	
011706 – 011806	Chairman Administration	<p>The Administration's response that HKBA's views and the related recommendations in respect of section 129(2) of the Ordinance under clause 123 of the Bill as set out in its submission (LC Paper No. CB(1)334/15-16(03)) were in line with the relevant</p>	

Time marker	Speaker	Subject(s)	Action required
		policy objective. The Administration would consider proposing appropriate amendments to the relevant provision.	
011807 – 011910	Chairman Administration	<p><u>Clause 124: Part XVI heading substituted</u></p> <p>Part 16: Miscellaneous</p> <p><u>Clause 125: Section 138 amended (licences granted by order of the court or Registrar or by Director of Health)</u></p> <p><u>Clause 126: Section 139A amended (protection of Government and public officers)</u></p> <p>Members raised no query on the above clauses.</p>	
011911 – 012011	Chairman Administration	<p><u>Clause 127: Part XVII heading substituted</u></p> <p>Part 17 – Offences</p> <p><u>Clause 128: Section 143 amended (unauthorized claim that patent has been applied for)</u></p> <p>Members raised no query on the above clauses.</p>	
012012 – 013319	Chairman Administration ALA6	<p><u>Clause 129: Section 144A added</u></p> <p>The Administration's advice that clause 129 sought to add a new section 144A to prohibit the use of certain titles and descriptions as the interim regulatory measures for local patent practitioners.</p> <p>The Administration was requested to review the proposed criminal sanction as stipulated in the new section 144A(5) (i.e. a fine of \$500,000) which was benchmarked at the penalty levels of comparable offences under the Legal Practitioners Ordinance (Cap.159) for a person who committed an offence by using the prohibited titles or descriptions under the new section 144A(2). Members considered that the proposed penalty might be too harsh for patent practitioners, taking into consideration that as compared to legal practitioners, the relevant offence in the case of patent practitioners would create a lesser impact on the public.</p> <p>ALA6 referred to an enquiry made in her letter dated 16 March 2016 to the Administration (LC Paper No. CB(1)700/15-16(03)) on the reason(s) for using the</p>	The Administration to follow up as stated in paragraph (2) of the minutes.

Time marker	Speaker	Subject(s)	Action required
		<p>expression "would be likely to give the impression", an expression which had not been used in the offense provisions in other legislation governing professionals, under the new section 144A(2)(e). The Chairman's view that the Administration should enhance the clarity of the relevant provision to provide for more legal certainty.</p> <p>The Administration's response that the new section 144A(2)(e) was drafted with reference to section 100(2)(a) of the Companies Ordinance (Cap. 622) where a similar expression was used. Nevertheless, the Administration would consider making refinements to the relevant provision as appropriate.</p>	
013320 – 013431	Chairman Administration	<p><u>Clause 130: Part XVIII heading substituted</u></p> <p>Part 18 – Administrative Provisions</p> <p><u>Clause 131: Section 147 amended (information about patent applications and patents, and inspection of documents)</u></p> <p><u>Clause 132: Section 149 amended (rules)</u></p> <p>Members raised no query on the above clauses.</p>	
013432 – 013505	Chairman Administration	<p><u>Clause 133: Part XIX heading substituted</u></p> <p>Part 19 – Repeals and Transitional Arrangements</p> <p><u>Clause 134: Section 159 heading amended (interpretation (Part XIX))</u></p> <p>Members raised no query on the above clauses.</p>	
013506 – 013912	Chairman CHUNG Kwok-pan Administration	<p>The Bills Committee completed clause-by-clause examination of the Bill.</p> <p>Members agreed that the Bills Committee would deliberate on the following papers at the next meeting –</p> <p>(a) the Administration's responses to the follow-up actions arising from the discussion at the meetings on 2 and 23 February 2016 (LC Paper No. CB(1)700/15-16(02));</p> <p>(b) the Administration's responses to written submissions received by the Bills Committee and views of deputations expressed at the meeting</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>on 22 December 2015 (LC Paper No. CB(1)710/15-16 (01)); and</p> <p>(c) the Administration's responses to ALA6's letters dated 17 February 2016 (LC Paper No. CB(1)757/15-16(03)) and 16 March 2016 (LC Paper No. CB(1)757/15-16 (04)).</p> <p>The Chairman announced that the next meeting would be held on 11 April 2016 at 2:30 pm.</p>	

Council Business Division 1
Legislative Council Secretariat
18 July 2016