

立法會
Legislative Council

LC Paper No. CB(1)1140/15-16
(These minutes have been seen
by the Administration)

Ref : CB1/BC/2/15

Bills Committee on Patents (Amendment) Bill 2015

**Minutes of the seventh meeting
on Monday, 11 April 2016, at 2:30 pm
in Conference Room 2 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 Paul TSE Wai-chun, JP
Hon Alan LEONG Kah-kit, SC
Hon Dennis KWOK
Hon SIN Chung-kai, SBS, JP
Ir Dr Hon LO Wai-kiwok, SBS, MH, JP
Hon CHUNG Kwok-pan

Members absent : Hon WONG Yuk-man
Hon WONG Ting-kwong, SBS, JP
Hon Charles Peter MOK, JP

**Public officers
attending** : Agenda Item II

Commerce and Economic Development Bureau

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

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

Miss Zoe YIP
Clerical Assistant (1)3

Action

- I. Confirmation of minutes of meeting**
(LC Paper No. CB(1)758/15-16 -- Minutes of meeting held on
12 January 2016)

The minutes of the meeting held on 12 January 2016 were confirmed.

Action

II. Meeting with the Administration

Matters arising from previous meetings

- (LC Paper No. CB(1)710/15-16(01) -- Administration's responses to submissions received and views expressed by deputations at the meeting on 22 December 2015
- 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)757/15-16(01) -- List of follow-up actions arising from the discussion at the meeting on 23 March 2016
- LC Paper No. CB(1)757/15-16(02) -- Administration's response to issues raised at the meeting on 23 March 2016

Other relevant papers

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

Action

- 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
- LC Paper No. CB(1)757/15-16(03) -- Administration's responses to enquiries raised by the Assistant Legal Adviser in the letter dated 17 February 2016
- LC Paper No. CB(1)700/15-16(03) -- Assistant Legal Adviser's letter dated 16 March 2016 to the Administration
- LC Paper No. CB(1)757/15-16(04) -- Administration's responses to enquiries raised by the Assistant Legal Adviser in the letter dated 16 March 2016
- 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

Committee stage amendments

- LC Paper No. CB(1)757/15-16(05) -- Draft Committee stage amendments proposed by the Administration
- LC Paper No. CB(1)778/15-16(01) -- Marked-up version of the draft Committee stage amendments proposed by the Administration)

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

Action

Follow-up actions to be taken by the Administration

3. The following issues were raised at the meeting for response by the Administration –

- (a) in relation to the new section 89A(2) under clause 78 of the Patents (Amendment) Bill 2015 ("the Bill"), the Administration was requested to take into account the comments from deputations and consider the room for possible refinements such as the proposed timeframe for responding to a request by the aggrieved party, bearing in mind that the party threatening enforcement proceedings should be well-prepared to substantiate its claim; and
- (b) in relation to the Administration's draft Committee stage amendments ("CSAs") to clause 120 of the Bill (LC Paper No. CB(1)757/15-16(05)), the Administration was requested to consider replacing the Chinese term "爭議" under the proposed new section 127B(3A)(b) with "抗辯" to align with the relevant expression used in the current section 84 of the Patents Ordinance (Cap. 514).

(Post-meeting note: The information provided by the Administration was issued to members vide LC Paper No. CB(1)833/15-16(01) on 22 April 2016.)

III. Any other business

Legislative timetable

4. Members noted that the Administration intended to resume the Second Reading debate on the Bill at the Council meeting of 1 June 2016. The Chairman informed members that the Bills Committee would submit a written report to the House Committee at its meeting on 20 May 2016. He also reminded members that the deadline for giving notice to move CSAs to the Bill would be 23 May 2016.

5. The Chairman said that Mr WONG Yuk-man had indicated his intention to propose CSAs to the Bill. He advised that members who intended to propose CSAs to the Bill were invited to forward their CSAs to the Secretariat on or before Monday, 18 April 2016.

Action

Date of next meeting

6. The Chairman said that the next meeting of the Bills Committee would be held on Monday, 25 April 2016 at 2:30 pm.
7. There being no other business, the meeting ended at 4:16 pm.

Council Business Division 1
Legislative Council Secretariat
18 July 2016

**Proceedings of the seventh meeting of
the Bills Committee on Patents (Amendment) Bill 2015
on Monday, 11 April 2016, at 2:30 pm
in Conference Room 2 of the Legislative Council Complex**

Time marker	Speaker	Subject(s)	Action required
Agenda Item II – Meeting with the Administration			
000000 – 002306	Chairman Mr Dennis KWOK Administration	<p>Opening remarks</p> <p>Briefing by the Administration on its responses (LC Paper No. CB(1)700/15-16(02) and CB(1)757/15-16(02)) to the issues raised in the lists of follow-up actions arising from the discussion at meetings on 2 February, 23 February and 23 March 2016.</p> <p><u>LC Paper No. CB(1)700/15-16(02)</u> The Administration's advice that it would propose Committee stage amendments ("CSAs") to deal with the drafting issues relating to clauses 9(2), 7, 13, 26, 35 and 45 of the Patents (Amendment) Bill 2015 ("the Bill").</p> <p><u>LC Paper No. CB(1)757/15-16(02)</u> The Chairman's view that the proposed criminal sanction as stipulated in the new section 144A(5) (i.e. a fine of \$500,000) under clause 129 of the Bill, which was benchmarked at the penalty levels of comparable offences under the Legal Practitioners Ordinance (Cap. 159), might be too harsh for patent practitioners, taking in view that there were no statutory qualifications for the patent profession at present.</p> <p>The Chairman and Mr Dennis KWOK sought clarification on the scope of the proposed prohibition under the new section 144A. They asked whether a person could claim that he or she was "a patent attorney providing patent agency services in Hong Kong" or whether a Hong Kong lawyer could describe himself/herself as an "attorney" in provision of patent agency services pursuant to relevant provisions under the new section 144A.</p> <p>The Administration's response that –</p> <p>(a) the proposed interim regulatory measures under the new section 144A only regulated the use of certain titles in connection with the provision of</p>	

Time marker	Speaker	Subject(s)	Action required
		<p>patent agency services without regulating or restricting the provision of patent agency services as such;</p> <p>(b) CSAs to the new section 144A would be proposed to clarify the scope of the proposed prohibition under the new section 144A(2)(e), as well as the criminal threshold. The new section 144A(2)(e) sought to prohibit the use of a title or description which might reasonably cause anyone to believe that the person using or permitted to use the title or description held a qualification that was specifically granted for approving that person to provide patent agency services in Hong Kong and that was recognized by law or endorsed by the Government; and</p> <p>(c) the new section 144A(2)(e) did not seek to bar the use of "attorney" on its own by qualified legal practitioners. Furthermore, use of the description "Hong Kong patent attorney" / "Hong Kong patent agent" <i>per se</i> was not prohibited by the new section 144A(2). That said, even if a title or description was not specifically prohibited, it should not be used in such a manner (e.g. together with other words or description) as to reasonably cause anyone to believe that the person using it or permitted to use it held a qualification for providing patent agency services which was officially recognized/endorsed in Hong Kong.</p>	
002307 – 002932	Chairman Administration	<p>The Administration briefed members on its responses (LC Paper No. CB(1)757/15-16(03)) to the enquiries raised by the Legal Adviser to the Bills Committee ("ALA6") in her letter dated 17 February 2016 (LC Paper No. CB(1)575/15-16(03)).</p> <p>Legal issues</p> <p><u>New Sections 37A and 37M(6) of the Patents Ordinance (Cap. 514) ("the Ordinance")</u></p> <p>The Administration advised that it would propose CSAs to clause 45 (new sections 37A and 37M(6)) to exclude patent applications under the Ordinance from the definitions of "non-Hong Kong application" and "specified application".</p> <p><u>New Section 37B(2)(b)(ii) of the Ordinance</u></p> <p><u>New Section 37C of the Ordinance</u></p>	

Time marker	Speaker	Subject(s)	Action required
		Members raised no query on the Administration's response.	
002933 – 003333	Chairman Mr WONG Kwok-hing Administration	<p><u>New Section 37Q(3)(b)(i) of the Ordinance</u></p> <p>The Administration's response to Mr WONG Kwok-hing's enquiry that –</p> <p>(a) the Registrar of Patents ("Registrar") currently had power to determine the question as referred by a party to the Registrar of whether the publication or working of an invention underlying a patent grant would be contrary to public order or morality. The Registrar, if she considered it fit, might further refer such question to the court for determination; and</p> <p>(b) during the conduct of substantive examination under the new patent system, should the Registrar take the view that the publication or working of an invention underlying an original grant patent application or short-term patent would be contrary to public order or morality, the concerned applicant could file a representation or a request to amend the application or the patent specification with a view to overcoming the Registrar's objection. Should the Registrar decide to maintain her objection, the Registrar's final decision would be subject to appeal to the court by the applicant.</p>	
003334 – 003641	Chairman Administration	<p><u>"Public Order (ordre public)" under New Section 9A(5) of the Ordinance</u></p> <p>Members raised no query on the Administration's response.</p>	
003642 – 004106	Chairman Administration	<p><u>New Section 37V(2) of the Ordinance</u></p> <p>The Administration's response to the Chairman's enquiry that although the new section 37V did not expressly require the Registrar to give reason(s) for her opinion with regard to the non-compliance of a standard patent (O) application with the examination requirements in her written notice to the applicant, such requirement to give reason(s) was already implicit in the statutory scheme, and that reason(s) would be given in practice.</p>	

Time marker	Speaker	Subject(s)	Action required
004107 – 004642	Chairman Administration	<u>New Section 37ZD of the Ordinance</u> Members raised no query on the Administration's response.	
004643 – 004823	Chairman Administration	Drafting issues <u>Heading of Division 6 of new Part 3 of the Ordinance</u> <u>Heading of Division 7 of Part 2 of the Ordinance</u> Members raised no query on the Administration's response.	
004824 – 005152	Chairman Administration	The Administration briefed members on its responses (LC Paper No. CB(1)757/15-16(04)) to enquiries raised by ALA6 in her letter dated 16 March 2016 (LC Paper No. CB(1)700/15-16(03)). Legal issues <u>Clauses 96 and 106 of the Bill</u> The Administration's advice that it would propose CSAs to clauses 96 and 106 (new sections 108A and 114(7)) of the Bill to exclude patent applications under the Ordinance from the definitions of "non-Hong Kong application" and "specified application". <u>Clauses 116 and 120 of the Bill</u> <u>Clause 129 of the Bill</u> The Administration advised that it would propose CSA to the new section 144A under clause 129 of the Bill to clarify the scope of the proposed prohibition under new section 144A(2)(e) in light of ALA6's enquiry in respect of the expression "would be likely to give the impression" in the provision. Drafting issues <u>Clause 120 of the Bill</u> Members raised no query on the Administration's response.	

Time marker	Speaker	Subject(s)	Action required
005153 – 005918	Chairman Administration	<p>The Administration briefed members on its responses (LC Paper No. CB(1)710/15-16(01)) to written submissions received by the Bills Committee on the Bill and views of deputations expressed at the meeting on 22 December 2015.</p> <p><u>Introducing an "original grant" patent route for standard patents (Part A of LC Paper No. CB(1)710/15-16(01))</u></p> <p><u>Retaining the current "re-registration" system for standard patents (Part B of LC Paper No. CB(1)710/15-16(01))</u></p> <p>Members raised no query on the Administration's response.</p>	
005919 – 011857	Chairman Administration	<p><u>Refining the short-term patent system (Part C of LC Paper No. CB(1)710/15-16(01))</u></p> <p>In relation to the new section 89A(2) under clause 78 of the Bill, the Administration was requested to take into account the comments from deputations and consider the room for possible refinements such as the proposed timeframe for responding to a request by the aggrieved party, bearing in mind that the party threatening enforcement proceedings should be well-prepared to substantiate its claim.</p> <p>The Chairman's view that the proposed 7-day time frame under the new section 89A(2) for a short-term patentee to provide documents relating to the patent on request when making a threat of infringement proceedings was reasonable at least in cases where the patentee intended to apply for an interlocutory injunction.</p> <p>The Administration advised that CSAs would be proposed to the new section 127B under clause 120 of the Bill and to section 129 of the Ordinance under clause 123 of the Bill to address the drafting issues raised by the Hong Kong Bar Association in its submission (LC Paper No. CB(1) 334/15-16(03)).</p>	The Administration to follow up as stated in paragraph 3(a) of the minutes.
011858 – 012436	Chairman Administration	<p><u>Implementing an interim measure for regulating local patent practitioners pending establishment of a full-fledged regulatory regime (Part D of LC Paper No. CB(1)710/15-16(01))</u></p>	

Time marker	Speaker	Subject(s)	Action required
		<p><u>Other issues (Part E of LC Paper No. CB(1)710/15-16(01))</u></p> <p>Members raised no query on the Administration's response.</p>	
<p><i>Examination of the Administration's proposed CSAs to the Bill</i> [Draft CSAs proposed by the Administration (LC Paper No. CB(1)757/15-16(05))] [Marked-up version of the draft CSAs proposed by the Administration (LC Paper No. CB(1)778/15-16(01))]</p>			
012437 – 014307	Chairman Administration ALA6	<p>Briefing by the Administration on its proposed draft CSAs.</p> <p><u>Clause 5(8): Section 2(2) of the Ordinance</u> <u>Clause 9(2): The Chinese text of section 6(5) of the Ordinance</u> <u>Clause 13: Section 10 of the Ordinance</u> <u>Clauses 24(1) and 31(1): Sections 19(1) and 26(1) of the Ordinance</u> <u>Clause 26: Section 22 of the Ordinance</u> <u>Clause 35: Section 29(4) of the Ordinance</u> <u>Clause 45: The Chinese text of the heading of the proposed Part 3 of the Ordinance</u> <u>Clauses 45, 96, and 106: New sections 37A, 37M, 108A and 114(7) of the Ordinance</u></p> <p><u>Clause 120: New section 127B of the Ordinance</u> With respect to the Chinese rendition "爭議" under the proposed new section 127B(3A)(b), ALA6 suggested the Administration to consider adopting a consistent Chinese rendition in view of the use of the Chinese rendition "抗辯" under the current section 84 of the Ordinance.</p> <p><u>Clause 123: Section 129 of the Ordinance</u> <u>Clause 129: New section 144A of the Ordinance</u></p> <p>Members raised no objection to the CSAs proposed by the Administration.</p> <p>The Administration was requested to furnish the Bills Committee with a full set of the proposed CSAs as soon as practicable.</p>	The Administration to follow up as stated in paragraph 3(b) of the minutes.

Time marker	Speaker	Subject(s)	Action required
014308 – 014659	Chairman Administration	<p>The Chairman's remark that Mr WONG Yuk-man had indicated his intention to propose CSAs to the Bill and that members who intended to propose CSAs to the Bill were invited to forward their CSAs to the Secretariat on or before 18 April 2016.</p> <p>Legislative timetable and meeting arrangement</p>	

Council Business Division 1
Legislative Council Secretariat
18 July 2016