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BY FAX (2978 7569) & BY EMAIL (bc_02_15@legco.gov.hk)

Clerk to Bills Committee on Patents (Amendment) Bill 2015
[Att. Ms. May LEUNG]
Legislative Council
Hong Kong

Dear Sir/Madam

Patents (Amendment) Bill 2015

Thank you for your letter of 4 December 2105 sent to Mr. Tim Hancock. Mr. Hancock has stepped down from the office of President of the Hong Kong Group of the Asian Patent Attorneys Association and the undersigned has taken over from Mr. Hancock.

The Asian Patent Attorneys Association ("APAA") is an International Non-Governmental Organisation recognised by the World Intellectual Property Organisation as having an Accredited Observer status. (Please see: http://www.wipo.int/members/en/organizations.jsp?type=NGO_INT.) APAA is dedicated to promoting and enhancing intellectual property protection in the Asian region (including Australia and New Zealand). APAA Hong Kong Group is one of the Recognised Groups of APAA. Our members consists of Hong Kong barristers and solicitors engaged in intellectual property work as a substantial part of their practice, as well as Foreign Registered Patent Agents qualified by examination and training and regulated by professional bodies in their home jurisdictions (including without limitation UK, Australia and New Zealand).

We have studied the Patents (Amendment) Bill 2015 and have the following comments:-

Proposed Section 89A(2)

We draw the Committee's attention to the unnecessarily harsh and, in our view, misconceived sanction of making a patentee liable for "groundless threats of infringement proceedings" simply because he failed to provide patent documents within 7 days of a request for documents, even though he is able to

justify his threats of patent infringement by proving that his patent is valid and that the act complained of did constitute infringement of his patent.

The proposed S89(2) provides that, subject to section 89A, the plaintiff of a threats action "shall, if he proves that the threats were so made and satisfied the court that he is a person aggrieved by them, be entitled to the relief claimed."

The way the proposed S.89A(2) is written means that the technical failure to provide patent documents within 7 days will lead to liability for groundless threat even though the patent is valid and the person threatened did infringe the patent. We have a particular concern that many SME companies which own unexamined short-term patent (and may not be represented by a lawyer) will be unaware of the requirement to provide documents within 7 days of receiving a request and will be inadvertently caught out by this provision.

In such a case, the court will end up granting a declaration against the patentee to the effect that the threats are unjustifiable, grant an injunction against the continuation of the threat, award damages to the party being threatened, and order the patentee to bear costs of the threats action (all because he had failed to supply the required documents within 7 days); and at the same time grant an injunction against the plaintiff of the threats action for infringing the patent, order him to pay damages for loss caused by the infringements and order him to pay costs of the infringement proceedings.

We submit that the objective of discouraging the owner of an unexamined short-term patent from making empty threats is already covered by the existing law on threats and the requirement to provide the patent documents referred to in the proposed Section 89A(5) can be more appropriately achieved by making this a precondition for bringing infringement proceedings (as part of the proposed amendments to Order 103 of the Rules of the High court). The patentee's failure to supply these patent documents may also be sanctioned by an adverse costs order.

Proposed Section 144A

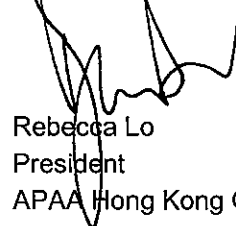
We appreciate the need to prevent unqualified persons from using misleading titles, but we submit that as an offence-creating section, Section 144A lacks clarity.

For example:

- "Patent agency services" is not defined.

- Subsection 2(e) is unclear. It is unclear whether a person who says he is "a patent agent/attorney providing patent agency services in Hong Kong" will commit an offence under Subsection (5).
- The effect of Subsection (3), particularly 3(a), is unclear. Does it mean, for example, that a UK Registered Patent Agent can use that title to say he can provide patent agency services in UK only, but he cannot say he can provide patent agency services in Hong Kong? For decades, many UK Registered Patent Agents, Australia Registered Patent Agents, New Zealand Registered Patent Agents etc. have been working in Hong Kong and providing patent-related services in Hong Kong.
- It is also not clear whether a Hong Kong lawyer providing patent-related services (for example, advising on infringement and validity of patent) can describe him/herself as an "attorney" providing patent agency services. The term "attorney" is used in a number of countries, such as the US, Japan, South Africa, the Philippines, etc. to describe lawyers and clients from those countries are familiar with and understand that the term "attorney" refers to a lawyer. Will Section 144A stop a Hong Kong lawyer who does patent work calling him or herself "a Hong Kong attorney" providing patent-related services? English solicitors are expressly permitted to describe themselves as "Patent Attorneys"(sec 278 Copyright Designs and Patents Act 1988), so it would be strange if a Hong Kong solicitor who is dual qualified in Hong Kong and in England can, in connection with patent agency work, describe himself as "an English Patent Attorney" (which would be allowed under the proposed section 144A(3)), but not as a "Hong Kong attorney". We submit that Hong Kong legal practitioners (who hold a qualification recognised by Hong Kong law) should not be prevented from describing themselves as being qualified under Hong Kong law to provide patent-related services, whether this is done in general terms or by using terms such as "attorney", "legal practitioner", etc.

Yours faithfully



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APAA Hong Kong Group