



中華人民共和國香港特別行政區  
Hong Kong Special Administrative Region of the People's Republic of China

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2 Tim Mei Avenue, Tamar  
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17 February 2016

Dear Ms TAM,

### **Patents (Amendment) Bill 2015**

Further to my letter of 8 January 2016, I would like to seek clarification on the issues set out below.

#### **Part I: Legal Issues**

##### New sections 37A and 37M(6) of the Patents Ordinance (Cap. 514)

The new section 37A defines "Hong Kong application" and "non-Hong Kong application". Please explain the reason(s) 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) to make it clear that a non-Hong Kong application does not include an application made in Hong Kong.

Similarly, should Hong Kong be carved out from the meaning of "a Paris Convention country" in the definition of "specified application" under the new section 37M(6)?

New section 37B(2)(b)(ii) of Cap. 514

It appears that new section 37B(2)(b)(ii) is taken from section 55(a) of the Patents (General) Rules (Cap. 514C) for the purpose of a standard patent (O) application. Please clarify the ground(s) for not including the exhibition or meeting set out in section 55(b) of Cap. 514C as in the case of the current re-registration system under Cap. 514.

New section 37C of Cap. 514

Please explain the reasons(s) for the different approaches adopted in determining a priority right under the new section 11B(5)(b) (in respect of a standard patent (R) application) and the new section 37C(3)(b) and (c) and (4)(b) and (c) (in respect of a standard patent (O) application). In the latter case, a subsequent application is considered as the first application only if certain conditions are met but there are no such requirements in the former case.

New section 37Q(3)(b)(i) of Cap. 514

The new section 37Q(3) provides that the Registrar may, in publishing a standard patent (O) application, omit certain matters from the specification contained in the application. It appears that this new section is modelled upon, with modifications, the current section 89(2) of Cap. 514C and section 16(2) of the Patents Act 1977 of the United Kingdom, both of which do not contain the requirement specified in the new section 37Q(3)(b)(i), namely, a matter the publication or working of which, in the Registrar's opinion, would be contrary to public order ("ordre public") or morality. Please explain the need for having such requirement in the new section 37Q(3), particularly in view of the requirement that the Registrar has to examine whether the invention, which is the subject of the application, is patentable under the new section 9A(5) (whether the invention the publication or working of which would be contrary to public order ("ordre public") or morality) under the new section 37U.

Please also clarify whether the working of an invention is not to be regarded as contrary to public order ("ordre public") or morality only because it is prohibited by any law in force in Hong Kong for the purposes of the new section 37Q(3)(b)(i), as in the new section 9A(5).

Further, in view of the Court of Final Appeal's view set out in paragraph 174 of *Leung Kwok Hung and Others v Hong Kong Special Administrative Region* (FACC Nos. 1 & 2 of 2005) that the expression "ordre

public" is imprecise and elusive, please review whether the expression should be used in Cap. 514 (including new sections 9A(5) and 37Q(3)(b)(i)).

#### New section 37V(2) of Cap. 514

To enable the applicant to respond to the notice given by the Registrar that the standard patent (O) application does not comply with any examination requirement, should new section 37V(2) expressly require that the Registrar has to specify in the notice the reason(s) of the Registrar's opinion?

Please make similar amendment to the current section 37(2) in case where the Registrar gives a written notice to the applicant of a standard patent (R) application for refusing to record a designated patent application or register a designated patent.

#### New section 37ZD of Cap. 514

The new section 37ZD applies the current sections 28(1) and (2), 29(1), (2) and (3) and 30 to an application for a standard patent (O), subject to necessary modifications. Please clarify the reason(s) for –

- (a) not applying the current sections 28(4) and 29(4) in the new section 37ZD; and
- (b) not including in the new section 37ZD(3) the new sections 37L(5) and (6) (the comparable provision of the current section 15(4)), 37M(5) (the comparable provision of the current section 18(3) and 25(4)), 37P (the comparable provision of the current section 19) and 37T(2)(b) (the comparable provision of the current section 23(5)), as in the current section 29(5) in respect of a standard patent (R) application.

## **Part II: Drafting Issues**

#### Heading of Division 6 of new Part 3 of Cap. 514

Under the new section 37X(2), the Registrar must, amongst other things, publish the specification of the standard patent (O) as soon as practicable after the standard patent (O) is granted. The heading of Division 6 of new Part 3 is "Provisions on Standard Patent (O) Applications before Grant".

Please review the accuracy of this heading as that Division contains provisions, such as the new section 37ZB, which appear to deal with matters after a standard patent (O) has been granted.

Please also review the accuracy of the heading of Division 7 of Part 2 of Cap. 514 in the case of standard patent (R) for the same reason.

I would be grateful if you could let me have your reply in bilingual form as soon as possible.

Yours sincerely,

A handwritten signature in black ink, appearing to be 'Wendy KAN', written over a light grey dotted rectangular background.

(Wendy KAN)

Assistant Legal Adviser

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