

Bills Committee on the Patents (Amendment) Bill 2015

**Follow-up actions arising from the discussion
at the meeting on 2 and 23 February 2016**

Purpose

At the meeting on 2 and 23 February 2016, the Government was requested to —

Meeting on 2 February 2016

- (a) reconsider improving the drafting of the amendment to the Chinese text of section 6(5) of the Patents Ordinance (“the Ordinance”) (Cap. 514) under clause 9(2) of the Bill to enhance the clarity of the relevant section;
- (b) review the use of punctuation in the Chinese text of the Bill, including new section 9A(1) of the new Part 1A under clause 11, and note a member's suggestion of creating a dedicated chapter on the use of punctuation in the Chinese and English texts of laws in the relevant guidelines on law drafting by the Department of Justice to ensure accuracy and consistency in using punctuation in bilingual law drafting;
- (c) consider whether there is a need to substitute “must” for “may” and “須” for “可” respectively in the English and Chinese texts of new section 9F(3)(c) under clause 11 of the Bill;
- (d) report to the Bills Committee as soon as the Administration has considered how best to deal with the drafting issues about Clauses 7, 13, 26 and 35 of the Bill raised by the Legal Adviser to the Bills Committee in her letter dated 8 January 2016 to the Administration (LC Paper No. CB(1)413/15-16(01)) to which the Administration has given a written response in its letter dated 1 February 2016 (LC Paper No. CB(1)505/15-16(03));
- (e) consider revising the Chinese text of the heading before section 28 of the Ordinance under clause 33 of the Bill from "第 6 分部 — 進一步的處理及權利的恢復" to "第 6 分部 — 進一步處理及權利的恢復" to align with the relevant expression used in the Chinese text of

the heading of section 28 of the Ordinance under clause 34 of the Bill;
and

Meeting on 23 February 2016

- (f) consider revising the Chinese text of the proposed new heading of Part 3 (under clause 45 of the Bill) 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.

2. The ensuing paragraphs set out the Government’s responses.

Item (a) - Clause 9(2) of the Bill

3. The main purpose of clause 9(2) is to add a reference to “standard patent (O) application” (原授標準專利申請) to section 6(5) of the Ordinance. The amendment is consequential to the introduction of the Original Grant Patent (OGP) system. In view of members’ concerns, we propose to amend the relevant clause as follows —

“指定專利申請內或在任何原授標準專利申請內，或在任何專利或指定專利的說明書內，”

Item (b) – Use of Punctuation in the Chinese Text of the Bill

4. Chapter 11 of the Department of Justice’s publication: Drafting Legislation in Hong Kong: A Guide to Styles and Practices (“the Guide”) is dedicated to the use of punctuation in drafting legislation. This Bill follows the conventions and practices set out in that chapter.

5. For example, paragraph 11.2.6 of the Guide provides that if a provision contains a list of definitions or a series of paragraphs or subparagraphs, a semicolon is to be used at the end of each definition, paragraph or subparagraph. The last one in the list or series, however, should end with a full stop or, according to paragraph 11.2.7, with a comma if the sentence continues after the last paragraph or subparagraph.

6. The Chinese text of the new section 9A(1) is divided into 3 paragraphs and the whole sentence continues after paragraph (c). Thus, following the Guide, semicolons are added after paragraphs (a) and (b), and a comma is added after paragraph (c).

Item (c) – Clause 11 of the Bill

7. The new section 9F seeks to replace the existing section 45 of the Ordinance concerning the right of an inventor to be mentioned as the sole or a joint inventor. Under the existing section 45(2), where the Registrar of Patents (“the Registrar”), upon request, makes a finding to the effect that a person who has been mentioned as the sole or a joint inventor in a patent ought not to be so mentioned (“the finding”), the Registrar, amongst others, “*may issue a certificate to the effect of his finding*”.

8. The use of “*may*” instead of “*must*” in referring to the Registrar’s power to issue a certificate of the finding under the new section 9F(3) adopts the current position under section 45(2). This also aligns with the Registrar’s practice in adjudicating a request under the provisions -

- (a) the Registrar’s decision on whether or not the finding should be made is in writing for setting out the grounds of her findings, which is also made available to the parties. As such, a successful party does not always need a certificate issued by the Registrar as proof of the finding;
- (b) where a successful party needs a certificate of the finding, e.g. as supporting evidence in court proceedings, he is required to, in addition to paying the prescribed fee for initiating the request for the finding¹, incur an additional fee for issuance of the certificate²; and
- (c) accordingly, the issuance of a certificate of the finding by the Registrar under the current section 45(2) or the new section 9F(3) is entirely optional at the request of a successful party.

¹ The prescribed chargeable fee is HK\$135 – Fee No. 19 under Schedule 2 of the *Patents (General) Rules*.

² The prescribed chargeable fee is HK\$95 – Fee No. 28 under Schedule 2 of the *Patents (General) Rules*.

9. As such, we consider it appropriate to retain the use of “may” in the new section 9F(3).

Item (d) – Various Drafting Issues

10. We are considering how best to deal with the drafting issues about Clauses 7, 13, 26 and 35 of the Bill raised by the Legal Adviser in her letter dated 8 January 2016 and will revert to the Bills Committee and the Legal Advisor once ready.

Item (e) – Clause 33 of the Bill

11. The heading of proposed Division 6 only contains two noun phrases, namely “Further Processing / 進一步的處理” and “Restoration of Rights / 權利的恢復”. If the word “的” is deleted in “進一步的處理”, the phrase will be “進一步處理”, which would appear as a verb phrase and fail to mirror the English text as well as the other noun phrase, i.e. “權利的恢復”, in the heading.

12. On the other hand, “轉錄標準專利的申請的” appears before “進一步處理” in the heading of section 28 (after amendment). The qualifier “轉錄標準專利的申請的” already dictates that “進一步處理” is a noun phrase. If we use “進一步的處理” here, the character “的” will appear three times altogether and render the heading clumsy.

13. In addition, “Further processing” (進一步(的)處理) is not a defined term in the Ordinance. The headings of proposed Division 6 of Part 2 and section 28 are also different in meaning. It is not necessary to use “進一步處理” as the standardized expression in the headings. Taking into account the above, we consider it appropriate to retain the existing construct of the Division and section headings.

Item (f) - Clause 45 of the Bill

14. We have no objection to replacing “原案授予的標準專利” by “原授標準專利” in the heading of the proposed Part 3 (see clause 45 of the Bill).

Presentation

15. Members are invited to note the information above.

**Commerce and Economic Development Bureau
Intellectual Property Department
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