

**The Government's Responses to a Member's Proposal for Committee Stage Amendments ("CSAs") to the  
Patents (Amendment) Bill 2015**

	<b>Relevant Clause (Section)</b>	<b>The Government's Response</b>
1.	Clause 11 (Section 9B(6)) (Section 9B(7)) (Section 9B(8)) (Section 9B(8))	“ <b>Validity proceedings</b> ” (有效性法律程序) is a defined term under the proposed new section 9B(8) which means legal proceedings in which <u>the validity of a patent</u> is put in issue under section 101(1). The proposed CSAs would change the defined term to become “有效法律程序” which means “valid proceedings”. This does not reflect the intended meaning in terms of the nature of proceedings in question, and is also inconsistent with the English text.
2.	Clause 14 (Section 11)	The original text “除有明文相反規定外”, as the Chinese equivalent of “Except as expressly provided to the contrary.....”, expresses the intended meaning clearly and concisely. The CSA is therefore not necessary.
3.	Clause 45 (Section 37T(2)(b))	The original text “規則訂定” is sufficiently clear in referring to provision of “grace period” in the rules which the Registrar of Patents is entitled to make pursuant to section 149 of the Patents Ordinance. The CSAs does not make the provision clearer and is therefore unnecessary.  That said, we see that the drafting of the Chinese text relating to non-payment of the prescribed fee can be improved. We suggest replacing “沒有訂明費用就該審查而獲繳付” with “須就該項審查繳付的訂明費用，未獲繳付”.
4.	Clause 45 (Section 37U(3)(d)(ii))	The original text “所提交的較早的原授標準專利申請所披露的事項” refers to a standard patent (O) application filed earlier than the standard patent (O) application to be examined by the Registrar. On the other hand, the CSA “所提交的原授標準專利申請(較早申請)所披露的事項” simply refers to a standard patent (O) application which has been filed and then labels it as a “較早申請”. The CSA does not reflect the intended meaning and is inconsistent with the English text. We understand Hon WONG's concern. To

	<b>Relevant Clause (Section)</b>	<b>The Government's Response</b>
		enhance readability of the provision, and having taken into account the earlier CSA proposed by Hon WONG, we will amend the text as follows: “較早前提交的原授標準專利申請所披露的事項”. Corresponding amendment will also be introduced into the same text in the proposed new section 127C(2)(e)(ii) under Clause 120 for consistency.
5.	Clause 45 (Section 37U(3)(e))	Paragraph 12.1.1 of Department of Justice's "A Guide to Styles and Practices" suggests that numbers should be written in figures in Arabic numerals. The use of "2" is in line with DoJ's current drafting convention.
6.	Clause 45 (Section 37U(4))	The comma between “在審查一項原授標準專利申請” and “以決定該項申請是否符合第(3)(a)款指明的規定” divides the long sentence into two shorter clauses and enhances readability. Taking it away will render the sentence much less reader-friendly.
7.	Clause 45 (Section 37U(6)(a)) (Section 37U(6)(b)) (Section 37U(6) (c))	We agree to adopt the proposed CSAs. We will also make corresponding amendments to the proposed new section 127C(5) under Clause 120.
8.	Clause 45 (Section 37ZA (2))	The choice of word is appropriate and there is no need to change. In addition, the term “撮錄” has been consistently used in several existing provisions under the Patents Ordinance (such as s.15(2)(a), s.20(3)(a), s.31(2)(b), 79 and 120(3)) since the enactment of the Ordinance in 1997, and is also adopted in several relevant provisions under the Bill. Replacing “撮錄” with “摘要” in the proposed section 37ZA(2) will create inconsistency and render cross-referencing between sections difficult. Further, given that “撮錄” has already become a commonly understood term in the local patent practice for a number of years, the proposed change of the term may cause unnecessary confusion amongst practitioners.

	<b>Relevant Clause (Section)</b>	<b>The Government's Response</b>
9.	Clause 45 (Section 37ZC(b))	<p>By repositioning the words “申請人繼續享有” to the latter part of paragraph (b), the meaning of the whole paragraph becomes ambiguous. It cannot convey the meaning intended i.e. on the basis of the application (which is now withdrawn etc), the applicant will continue to enjoy a right of priority under section 37C or 110.</p> <p>We understand Hon Wong's concern and propose to amend paragraph (b) as follows: “申請人繼續基於該項申請，而根據第 37C 或 110 條，享有優先權利，以在其後提交原授標準專利申請或短期專利申請；及”。 Corresponding amendments will also be made to section 121(2) under Clause 114.</p>

**Commerce and Economic Development Bureau**  
**Intellectual Property Department**  
**Department of Justice**  
**April 2016**

## Patents (Amendment) Bill 2015

### Committee Stage

#### Amendments to be moved by the Secretary for Commerce and Economic Development

<u>Clause</u>	<u>Amendment Proposed</u>
45	In the Chinese text, in the proposed section 37T(2)(b), by deleting “沒有訂明費用就該審查而” and substituting “須就該項審查繳付的訂明費用，未”.
45	In the Chinese text, in the proposed section 37U(3)(d)(ii), by deleting “所提交的較早” and substituting “較早前提交”.
45	In the Chinese text, in the proposed section 37U(6), in the definition of <i>specified new application</i> , by deleting “新的” (wherever appearing) and substituting “新”.
45	In the Chinese text, in the proposed section 37ZC, by deleting paragraph (b) and substituting— “(b) 申請人繼續基於該項申請，而根據第37C或110條，享有優先權利，以在其後提交原授標準專利申請或短期專利申請；及”.
114	In the Chinese text, by deleting subclause 2 and substituting— “(2) 第121(2)條— 廢除(a)段 代以 “(a) 申請人繼續基於該項申請，而根據第37C

或110條，享有優先權利，以在其後提交原授標準專利申請或短期專利申請；”。

120 In the Chinese text, in the proposed section 127C(2)(e)(ii), by deleting “所提交的較早” and substituting “較早前提交”.

120 In the Chinese text, in the proposed section 127C(5), in the definition of *specified new application*, by deleting “新的” (wherever appearing) and substituting “新”.