

Patents (Amendment) Bill 2015

Committee Stage Amendments proposed by the Government

Purpose

At its meeting on 25 April 2016, the Bills Committee considered and supported Committee Stage Amendments (CSAs) proposed by the Government (LC Papers No. CB(1)833/15-16(01) and CB(1)842/15-16(02)).

2. For Members' reference, we consolidate at **Annex** the whole set of CSAs¹ that the Government plans to move following resumption of the Second Reading.

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

¹ Subject to final checking and textual or format editing as may be required.

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> |
|---------------|---|
| 5 | By deleting subclause (8) and substituting— “(8) Section 2(2)— Repeal “standard patent (標準專利的申請)” Substitute “standard patent (R) (轉錄標準專利的申請) and standard patent (R) application (轉錄標準專利申請)”.”. |
| 9(2) | In the Chinese text, by deleting “內或在任何原授標準專利申請內” and substituting “或原授標準專利申請內，”. |
| 13 | By adding— “(3) Section 10(a)— Repeal everything after “designated patent office” Substitute a semicolon. (4) Section 10(c)— Repeal everything after “designated patent application” Substitute “; and”.”. |

- 24 In the English text, by deleting subclause (1) and substituting—
- “(1) Section 19(1)—
- Repeal**
everything after “the Registrar”
- Substitute**
“must examine the request to ascertain whether the requirements of section 15(2) and (3) (*formal requirements*) have been satisfied.”.”.
- 26 By adding—
- “(2A) Section 22(1)(b)—
- Repeal**
““a divisional corresponding designated patent application””
- Substitute**
“*divisional designated patent application*”.”.
- 31 In the English text, by deleting subclause (1) and substituting—
- “(1) Section 26(1)—
- Repeal**
everything after “the Registrar”
- Substitute**
“must examine the request to ascertain whether the requirements of section 23(3) and (4) (*formal requirements*) have been satisfied.”.”.
- 35 By adding—
- “(6A) Section 29(4)—
- Repeal**
“a notice”
- Substitute**
“an application”.”.

- 45 In the proposed Part 3, in the Chinese text, in the heading, by deleting
“原案授予的” and substituting “原授”.
- 45 In the proposed section 37A, in the definition of *non-Hong Kong application*, by adding “, other than a patent application under this Ordinance” after “or area”.
- 45 In the proposed section 37M(6), in the definition of *specified application*, in paragraph (a), by adding “, other than a patent application under this Ordinance” after “or area”.
- 45 In the proposed section 37T(2)(b), in the Chinese text, 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 proposed section 37U(3)(d)(ii), in the Chinese text, by deleting
“所提交的較早” and substituting “較早前提交”.
- 45 In the proposed section 37U(6), in the Chinese text, in the definition
of *指明新申請*, by deleting “新的” (wherever appearing) and
substituting “新”.
- 45 In the proposed section 37ZC, in the Chinese text, 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”.

78 By deleting the proposed section 89A(2)(a), (b) and (c) and substituting—

- “(a) the act in respect of which the threat was made constitutes or, if done, would constitute an infringement of the patent;
- (b) the patent is valid in the relevant respect; and
- (c) the defendant has complied with any access request for patent information made by the plaintiff before commencing the relief proceedings.”.

78 In the proposed section 89A, by adding—

- “(2A) For subsection (2)(c)—
 - (a) a request is taken to be an access request only if it is made in writing and is accompanied by a copy of this section;
 - (b) the defendant is taken to have complied with an access request only if the defendant provides the patent information as at the request date to the plaintiff, without charge, within 14 days from the request date or any longer period agreed to by the plaintiff; and
 - (c) the defendant is taken to have complied with an access request in relation to any patent information that the defendant has already provided to the plaintiff on or before the request date.”.

78 In the proposed section 89A(5), by deleting the definition of *patent documents*.

78 In the proposed section 89A(5), by adding in alphabetical order—

“*patent information* (專利資料), for a short-term patent, means—

- (a) the number assigned by the Registrar to the

certificate of grant issued in respect of the patent under section 118(2)(b); and

- (b) a copy of any requested amendment to the specification of the patent that has been filed with the Registrar or the court, but not yet been published;

request date (請求日期) means the date of delivery of a request;”.

96 In the proposed section 108A, in the definition of *non-Hong Kong application*, by adding “, other than a patent application under this Ordinance” after “or area”.

106 In the proposed section 114(7), in the definition of *specified application*, in paragraph (a), by adding “, other than a patent application under this Ordinance” after “or area”.

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 proposed section 127B, by adding—

“(3A) No request for substantive examination of a short-term patent may be made if—

(a) a previous request for substantive examination of the patent has been made, and—

(i) the outcome of the substantive examination is still pending; or

(ii) that request has resulted in the issue of a certificate of substantive examination of the patent or in the revocation of the patent; or

(b) the patent has been found by the court to be wholly valid in any proceedings in which the validity of the patent is contested.”.

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

120 In the proposed section 127C(5), in the Chinese text, in the definition of 指明新申請, by deleting “新的” (wherever appearing) and substituting “新”.

120 In the proposed section 127E(4), in the English text, by deleting “are allowed” and substituting “is allowed”.

123 By deleting subclauses (3) and (4) and substituting—

“(3) Section 129—

Repeal subsection (2)

Substitute

“(2) In any enforcement proceedings—

(a) it is for the proprietor of the short-term patent to establish the validity of the patent or a relevant respect of the patent (as the case requires) and the fact that the patent has been granted is of no account in that regard; and

(b) in the absence of evidence to the contrary, any of the following is sufficient proof of the validity of the patent or a relevant respect of the patent—

- (i) the certificate of substantive examination of the patent;
- (ii) a certificate referred to in subsection (1)(c);
- (iii) any evidence which is sufficient to establish prima facie the validity of the patent or that respect of the patent (as the case requires).”.”.

123 By deleting subclause (5) and substituting—

“(5) After section 129(2)—

Add

“(3) In any enforcement proceedings, an application by the proprietor of the short-term patent for an injunction under section 80(1)(a) in interlocutory proceedings must be accompanied by a certificate or evidence referred to in subsection (2)(b)(i), (ii) or (iii).”.”.

129 By deleting the proposed section 144A(2)(e) and substituting—

- “(e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—
- (i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and
 - (ii) that is recognized by law or endorsed by the Government.”.

129 By deleting the proposed section 144A(4) and (6).