

Proposal for Hong Kong Patent System Reform

in response to

Consultation Paper

on

Review of the Patent System in Hong Kong

Submitted by

The Hong Kong Institute of Patent Practitioners

30 Dec 2011

Proposal for Hong Kong Patent System Reform

Executive Summary

The Hong Kong Institute of Patent Practitioners (HIPP) is established back in 2009 by a group of enthusiasm Hong Kong solicitors and foreign patent agents/attorneys practicing in Hong Kong. HIPP aims to promote Hong Kong as an international hub for the acquisition and commercialization of and respect for rights in technology, inventions, patents and other intellectual assets. HIPP also aims to provide training and recognizing patent practitioners in Hong Kong.

This submission addresses the government's call for opinion with regard to the reform of the Hong Kong standard and short-term patent system, as well as to the regulation of patent agency service in Hong Kong.

1 Standard Patent

We are of the view that Hong Kong should develop its own original grant patent system *with a full team of functional examiners*. We do **NOT** support an “outsource model” in the original grant patent system. In the meanwhile the current re-registration system may be kept for smooth transition.

2 Short-Term Patents

We are of the view that the short-term patent system should be retained. A number of modifications can be introduced to enhance the efficacy of the system. Possible modifications include:

- 2.1 Introduce a requirement for substantive examination before the patentee can commence infringement proceeding.
- 2.2 Relax the restriction of only one independent claim
- 2.3 Clarify the patentability standard for short-term patents

3 Regulation of Patent Agency Services

Patent Agencies need to be regulated through the regulation of patent practitioners in Hong Kong. The regulation should apply to the provision of service in relation to drafting of patent specification, providing patentability and invalidity opinions. HIPP has already put in place a certification program and we propose that this program be used as a model for registering Patent Agents/Attorneys in HK.

Chapter 1

Standard Patent

Introduction of FOGP system in Hong Kong

1.1 We are strongly supportive towards the development of an original grant patent system as long as the system uses a ***full*** team of functional patent examiners in Hong Kong (referred to as the ***Full OGP system*** or FOGP in this submission). We do ***NOT*** support an “outsource model” as a permanent part of the new patent system.

1.2 A FOGP system in Hong Kong allows a local inventor to obtain 20 years of patent protection in Hong Kong without having to go through the patent application and examination procedures in UK, EPO or China.

1.3 Hong Kong will benefit from its FOGP system in the preparing itself as a regional hub for IP trading. In particular, the FOGP system will help Hong Kong to develop its own patent professionals which is essential for all the supporting services required for IP trading.

1.4 The training brought in to build up the patent profession in Hong Kong can also be utilised by inventors and researchers to increase their knowledge and awareness of patent law. This will increase successes on commercialisation and monopolization thereby provides a stimulating effect on research and development in line with the government’s policy to promote the six industries as emphasized in the policy address from 2009.

Timeline for Introducing the FOGP

1.5 We propose a timeline wherein the FOGP system is introduced in 5 years. This will provide sufficient time for the Hong Kong government to build the Examination Division/system and Examiners Corp and certify patent attorneys and other related professions.

1.6 The current re-registration system will continue to run for 5 years after the commencement of the FOGP system.

1.7 The co-existence of an FOGP and the re-registration system in the transition period ensures sufficient time for inventors and patent applicants to adapt to the new FOGP system. Further, the availability of the re-registration system while the FOGP system is being set up reduce the work load under the FOGP system by allowing some of the patent applications to grant via the re-registration route.

1.8 We also proposed to conduct an evaluation for both the FOGP and re-registration system at 5 years after the introduction of the FOGP system.

Sustainability of a patent search and examination division in Hong Kong

1.9 We are of the view that a patent search and examination division should be set up in Hong Kong to examine the patent applications under the FOGP system. We do NOT support an outsource model in the FOGP system.

1.10 We recognize it takes time for engineers and scientists to develop the skills required for operation of the patent search and examination unit and therefore we propose that at the initial stage of the FOGP system IPD can work with SIPO to train up HK examiners.

1.11 The HK patent search and examination division should be built with the assistance of WIPO and SIPO as a WIPO accredited International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).

1.12 As an ISA and IPEA, the patent search and examination division can be financially self-sustainable after the initial setup phase. In addition to conducting search and examination for local patent applications filed under the FOGP route, the search and examination division may receive inbound work from other patent offices worldwide.

1.13 The HKIPD may act as a satellite office for SIPO in the same way as the Austrian Patent Office assists the EPO in conducting search and examination. The Austrian Patent Office is an accredited ISA and IPEA under the PCT. The Austrian Patent office offers a range of prior art, patentability and infringement search service to the public. (See Annex 1)

1.14 The substantive aspects of the SIPO Examination Guideline can be used as the guideline for substantive examination.

1.15 Hong Kong does not have to adopt a patent system that is exactly identical to China. In fact, this is not possible, as our legal system, including evidence, discovery, case law, common law etc are well known to be vastly different from China. However, we have to start somewhere, especially in the substantive law issues, we suggest that HK adopt the substantive aspects of the SIPO examination guideline and work with SIPO examiner's as a start. Once the system has run for a few years, we can fine-tune the Examination Guideline and develop our own body of law as and when the Patent Re-examination Board (see Chapter 4) and the Courts issue decisions. This "hybrid" approach will allow us to harmonise with the China market while maintaining

international best practices.

1.16 Further, the Hong Kong patent search and examination office may participate in the Patent Prosecution Highway (PPH) agreement between the USPTO and SIPO, thereby assisting both patent office in examining patent applications filed in US and China. (See Annex 2)

1.17 Therefore, the search and examination division of IPD is self-sustainable through the incomes generated from its capacity as ISA and IPEA, by acting as a satellite office of SIPO and participating in the PPH agreement between USPTO and SIPO.

1.18 We also suggest that HKIPD act as a PCT Receiving Office.

1.19 We also propose that a working team be set up to communication with WIPO, SIPO and USPTO and to study the feasibility of (1) accrediting the Hong Kong patent search and examination office as ISA and IPEA and (2) acting as a satellite office of SIPO.

Reciprocity under the re-registration system

1.20 The current re-registration system relinquishes the granting authority of HK patents to the designated jurisdiction. This is an unfair situation that needs to be reconsidered. We propose that the IPD negotiate for reciprocity of re-registration with SIPO, EPO and UK Patent office. If a patent granted by any of these three patent offices is grantable under the re-registration system of Hong Kong, these patent offices should also allow a Hong Kong patent granted under the FOGP system to be registered in their jurisdiction.

Chapter 2

Short-Term Patent

Retaining of short-term patent system

- 2.1 We are of the view that the short-term patent should be retained.
- 2.2 The short-term patent system is especially useful for protecting simple inventions with short product life cycle. The system therefore offers inventors a fast and inexpensive way of protecting their IP.
- 2.3 We agree that the current system of granting short term patent without the need to go through substantive examination reduces the cost for applicant.

Modification – substantial examination

- 2.4 We recommend that before a patentee of a short-term patent may commence infringement proceedings, the patentability of the short-term patent should be examined by the search and examination division.
- 2.5 Any claims that are rejected in the substantial examination should not form the basis of the infringement proceeding.
- 2.6 The patentee should bear the cost of the substantial examination.

Modification – number of claims

- 2.7 The restriction that only one independent claim is allowed in a short-term patent should be relaxed.
- 2.8 We recommend that a total of 10 claims, which may be independent or dependent claims, should be allowed in a short-term patent application. Additional claims should also be allowed upon payment of excess claim fees.

Modification – patentability

- 2.9 The government and IPD should layout clear guidelines for the patentability of a short-term patent and a standard patent.
- 2.10 In this regard, we recommend that the government and IPD produce a complete guideline for the examination of both standard and short-term patents in Hong Kong. Having a clear examination manual would also help Hong Kong to compete for outsource work from patent offices of other jurisdictions.

Chapter 3

Regulation of Patent Agency Services

Need for regulation

3.1 There is a strong need for regulation of patent practitioners in Hong Kong, in addition to regulation of agency services.

3.2 Patent applications contain highly proprietary information that the inventor has to disclose to the service provider. There must be high ethical standards for the service provider and insurance coverage to protect inventors and applicants. Currently, due to the lack of regulations, the public is not protected in any way.

3.3 In legal proceedings, the proprietary information of a patent owner/applicant/inventor needs to be protected. The work of a patent agent/attorney should therefore be privileged. Currently, no such privileges are accorded due to a lack of recognition of patent professionals and agencies.

3.4 The drafting of patent specification requires special techniques and knowledge both in the technical area of the invention and in patent law. This is a skill that can only be developed by proper training and continual practice.

3.5 The current position in law that any person may act as a patent agent results in there lacking any reliable standard among the practice of patent agents.

3.6 The general public of Hong Kong does not have sufficient knowledge in Intellectual Property law. Therefore local inventors and applicants are often unable to assess the works of a patent agent and statutory regulation is required to protect citizens from unqualified practitioners.

3.7 We also recommend regulating the service for provision of patentability, invalidation and infringement opinions admissible in court. These areas are closely related to patent law and the provision of such service requires the patent agent to have been properly trained in the interpretation of substantive patent law.

3.8 Given the government has implemented legislations for regulating a large number of professions, even including travel agents, there is no reason that the patent attorney profession should be exempted from such regulation given its crucial role to the development of the innovative industries in Hong Kong.

3.9 The regulation of patent agent will exclude unqualified person from the profession.

Qualified patent agents will still be competing with each other thereby keeping the price at a reasonable level.

The unique situation in Hong Kong

3.10 Hong Kong's patent practice is unique in the sense that inventors tend to file abroad rather than locally. The most common jurisdictions of patent filing for local inventors are China and the US.

3.11 Therefore patent agents in Hong Kong have to acquaint themselves with patent law and practice in China and US, and possibly other jurisdictions like Europe.

3.12 There needs to be a certification programme to equip candidates for the necessary knowledge of Chinese and US patent law. Similar to the requirements abroad, candidates should be required to pass a qualifying examination before they could be admitted into the profession.

3.13 Given the technical nature of the subject matters in patent applications, it should be a prerequisite that a patent agent should have a technical degree.

Patent attorney/agent requirement – technical degree

3.14 Annexes 3 and 4 show the requirement for admission as patent attorney/agent in various jurisdictions. To be admitted as a patent agent/attorney in all the jurisdictions listed in Annex 4, the candidate is required to possess a university level technical degree.

3.15 Although the exact meaning of a technical degree may differ slightly among jurisdictions, it is a common requirement that during the tertiary education leading to the technical degree the candidates acquires certain minimum knowledge in science or technology.

3.16 For example in the US if the candidate holds a degree not within the scope of the recognized technical subject approved by the USPTO (which includes common science and engineering subjects such as biology, biochemistry, chemistry, physics and various kinds of engineering), the candidate is required to have pursued a minimum study hours of 24-40 hours in physics or chemistry subjects in university.

3.17 The Australian IP office also requires that a university degree obtained abroad should be in a field that contains potentially patentable subject matter.

3.18 Therefore it is essential that Hong Kong adopts a standard that requires a patent agent to possess substantial technical knowledge in a university level science, engineering or technology subject.

Patent agent requirement – examination and certification

3.19 In all the jurisdictions listed in Annex and 4, a candidate has to pass a qualifying examination to become a patent agent.

3.20 We propose to set up a certification programme in Hong Kong to train local candidate for the profession of patent agent.

3.21 Our Institute has adopted a set of rules for certifying patent agents in Hong Kong. The rule is attached as Annex 5.

3.22 We recommend that the government adopts our rules as the basis for certification of patent agents in Hong Kong.

3.23 Our rule requires a person to pass a qualifying examination before he may be admitted as a patent agent. During the interim period when a patent examination system in Hong Kong is yet to be developed, we recognize the Australia, Canada, China, New Zealand, UK and US patent attorney/agent qualifying examinations. Eventually Hong Kong should develop its own examination system for patent agents.

3.24 Our rule also allows for foreign patent agents with sufficient local experience to become registered when they decide the practice in HK. This ensures those qualified patent agents who are practicing in Hong Kong will be able to continue their practice.

Chapter 4

Patent Re-examination Board

Setting Up of a Patent Re-examination Board

4.1 We recommend that a Patent Re-examination Board (PRB) be set up to handle re-examination request arising under the FOGP system. The PRB may also review the search and examination division's examination decision of a short-term patent.

4.2 The PRB should provide patentability opinion based on invention disclosure or patent specification submitted to the board. This service is especially beneficial to applicants of short-term patent since the application will not go through a substantive examination before grant (See Chapter 2). Further, the cost of patent disputes in cases involving short-term patents will also be reduced by having an authority to assess the patentability of the short-term patent.

4.3 The PRB may also act as a designated authority for resolving IP disputes by functioning as a patent mediation or arbitration center. The disputes to be resolved may involve local and/or international entities.

4.4 The PRB may review complaints relating to the application and grant of patent.

4.5 Examples from the UK and Singapore are found in Annex 6.

Submitted by

The Hong Kong Institute of Patent Practitioners

E-mail: mail@hipp.org.hk

Address: 13/F, Bright Way Tower, 33 Mong Kok Road, Kowloon, Hong Kong SAR

President: Dr. Jacqueline Lui (Managing Director, Eagle IP Limited)

Vice-President: Dr. Kam W. Law (Associate, Jones Day)

Treasurer: Mr. Taiky Ong (Senior Trademark & Patent Attorney, TrademarkCN Company Ltd)

Secretary: Dr. Stanley Ng (Patent Executive, Eagle IP Limited)

Council Members: Mr. Larry Lai (Patent Attorney, Sit, Fung, Kwong & Shum)

Dr. Ho Chung Lui (Director, Eagle IP Limited)

Mr. Kenneth Choy (Partner, Lister Lo Lui & Choy)

Dr. Toby Mak (Patent Attorney, Tee & Howe Intellectual Property Attorneys)

Annex 1

The Austrian Patent Office

The Austrian Patent Office is an accredited ISA and IPEA under the PCT. This means the Austrian Patent Office is capable of issuing International Search Report (ISR) and International Preliminary Report on Patentability (IPRP) for PCT application. Acting as an ISA and IPEA, the Austrian Patent Office charges a fee for conducting the patent search and writing the patentability opinion.

(http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)

For PCT applications that designated the European Patent Office (EPO) as the IPEA, the Austrian Patent Office is a competent ISA. (<http://www.wipo.int/pct/en/appguide/index.jsp#E>) By assisting the EPO to conduct search, the Austrian Patent Office helps to reduce the workload of EPO and earns an income through receiving outsourced work from EPO.

The Austrian Patent Office also offers a range of prior art, patentability and infringement search service to the public. Indeed, the Administrative Council of the European Patent Organisation has decided on 28 June 2007 that the European Patent Office will cease to perform standard and special searches and the work will be dedicated to the national patent offices. (http://archive.epo.org/epo/pubs/oj007/08_07/08_4777.pdf)

The search service available from the Austrian Patent Office is listed at <http://www.epo.org/searching/subscription/special-search/at-po.html>.

Annex 2

Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) speeds up the examination process for corresponding applications filed in participating countries by allowing examiners to reuse search and examination results.

Under the PPH program, an applicant receiving a ruling from the Office of First Filing (OFF) that at least one claim is patentable may request that the Office of Second Filing (OSF) fast track the examination of corresponding claims in corresponding applications filed in the OSF. The PPH will leverage fast-track examination procedures already available in the OSF to allow applicants to obtain patents faster and more efficiently. For example, the OSF can use the OFF's work products – such as allowances or search reports – to streamline patent processing.

The USPTO has PPH arrangements with the following intellectual property offices: Australia, Austrian, Canada, China, Denmark, EPO, Finland, Germany, Hungary, Iceland, Israel, Japan, Korea, Mexico, Nordic Patent Institute, Norway, Russia, Singapore, Spain, Sweden, Taiwan and UK.

The following USPTO director's blog shows the increasing close collaboration between USPTO and SIPO under the PPH programme.

(http://www.uspto.gov/blog/director/entry/our_growing_partnership_with_china)

USPTO Director's Forum Blog

Our Growing Partnership with China

Guest blog by Deputy Director Teresa Stanek Rea

I find it hard to believe that I have been at the USPTO for almost ten months. When I started here at the USPTO, I knew I would be a part of a great organization – one that I worked with as a practitioner for many years. But I had no idea I would be a part of history as we implement the most significant patent reform legislation in history. What amazes me more, however, is that the America Invents Act is just one of many

efforts we work on for our stakeholders.

Tomorrow (December 1, 2011), the USPTO and SIPO (State Intellectual Property Office - China) will begin a landmark work sharing initiative. The two new Patent Prosecution Highway (PPH) pilot programs will apply to qualifying applications filed under the Paris Convention and the Patent Cooperation Treaty (PCT).

I had the honor of representing the USPTO at a ceremony in Beijing on November 8, where I signed the Joint Statement of Intent with SIPO Deputy Commissioner Yang Tiejun to launch these PPH work sharing initiatives. This trip marked my second time visiting China as the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the USPTO. You can read about my first trip here (http://www.uspto.gov/blog/director/entry/report_from_china_and_a)

This PPH agreement is a milestone in bilateral cooperation between the USPTO and SIPO. PPH programs, such as this one, permit each office to benefit from work previously done by the other office, reducing the examination workload in each office, aiding patent examiners and improving patent quality. The one-year pilot program will end on November 30, 2012. The trial program will gauge the interest of applicants and evaluate the programs for patent quality, efficiency and the reduction of the workload at the USPTO and SIPO. Both offices may extend the one year trial period upon mutual agreement. We believe the PPH Program has been overwhelmingly successful and it's my pleasure to contribute to the program's success by joining my counterpart in China and signing such an important document.

During this past trip I also spoke at the US-China Joint Commission on Commerce and Trade (JCCT) Intellectual Property (IP) Working Group Vice Minister level meeting. The USPTO, along with the Office of the United States Trade Representative, is co-chair of the JCCT IP Working Group, the main bilateral mechanism by which IP experts from the US and China seek to resolve IP concerns to US businesses. This meeting was a prelude to the recent 22nd Session of JCCT plenary meeting in Chengdu, China that newly appointed US Secretary of Commerce John Bryson attended.

One thing I've discovered in my time at the USPTO is that when I travel to a place like China, there is never a shortage of people who want to hear about what we do. So while in China, I also spoke about the America Invents Act at two Chinese universities, Renmin University and Nanjing University of Science and Technology. I

also met with IP officials from various provincial level IP agencies of Jiangsu province, one of the most prosperous provinces of China. During our meetings, we discussed how we can collaborate to improve the IP protection and enforcement environment in Jiangsu province for the benefit of US and Chinese rights holders.

Our China team, a group of attorneys with specific expertise on China IP matters in the USPTO's Office of Policy and External Affairs, will be busy following up on the USPTO-SIPO PPH pilot. I look forward to working with members of this Office and our business community in the coming months as we continue to develop this and other initiatives.

Annex 3

Requirement for Admission as Patent Agent in Various Jurisdictions – Qualifying Examination

Jurisdiction	Title	Citizenship	Law Degree Requirement	Qualifying Exam	Working experience	Other requirement
Australia	Patent Attorney	Resident of Au	No	Yes (See Note 1)	2 years in Patent	
China	Patent attorney	CN / TW/ HK/Macao	No	Yes	2 years in any related field	
Europe	Patent Attorney	Any contracting state of EPO	No	Yes	3 years in patent	
United Kingdom	Patent Agent/Attorney	No	No	Yes	2 years in patent	“Patent Attorney” may be <i>either</i> a Patent Agent <i>or</i> solicitor
US	Patent Agent	Yes	No	Yes	No	“Patent Attorney” must have both Patent Agent <i>and</i> lawyer qualifications
	Patent Attorney	Yes	Yes	Yes	No	
India	Patent Agent	Yes	No	Yes	No	
Malaysia	Patent Agent	Yes	No	Yes	No	

Hong Kong (HIPP certification)	Patent Agent	Resident of HK	No	Yes	2 years in patent	
--------------------------------------	--------------	----------------	----	-----	-------------------	--

Note 1

Since the Australian Professional Standard Board for Patent and Trade Marks Attorneys has stopped holding examination in the recent years, the knowledge requirement is usually satisfied by passing accredited course of study conducted by an appropriate tertiary institution.

Annex 4

Requirement for Admission as Patent Agent in Various Jurisdictions – Technical Degree

Jurisdiction	Technical requirement for admission as patent agent/attorney
Australia	<ul style="list-style-type: none">● degree, diploma, advanced diploma or graduate diploma● in a field of technology that contains potentially patentable subject matter● awarded in the Higher Education Sector● Ref: http://www.psb.gov.au/patreg.htm
China	<ul style="list-style-type: none">● University-level science or technical undergraduate degree● Full list of recognized technical degree at http://www.sipo.gov.cn/zldlg/zgks/200808/P020100512570621911261.doc
Europe	<ul style="list-style-type: none">● University-level scientific or technical bachelor's degree● Biology, biochemistry, chemistry, construction technology, electricity, electronics, information technology, mathematics, mechanics, medicine, pharmacology or physics● From a university in one of the contracting states.● Ref: http://www.patentepi.com/downloads/Regulations/413_EQE_Implementing_Provisions.pdf
US	<p>Bachelor's degree or in a recognized technical subject. Please refer to Note 2 for full details. Ref: http://www.uspto.gov/ip/boards/oed/grb.pdf</p>
India	<ul style="list-style-type: none">● Degree in science, engineering or technology● Ref: http://wbbs.gov.in/Legislations/rules/TheIndianPatentAct1970.pdf, Chapter XXI, S.126

Malaysia

- A degree or its equivalent in engineering or science
- Ref: http://www.myipo.gov.my/images/services_myipo/forms_pt/PF18.pdf

Note 2:

An applicant applying for the examination must demonstrate to the Director of the Office of Enrollment and Discipline (OED) that he or she possesses the scientific and technical training necessary to provide valuable service to patent applicants.

CATEGORY A: Bachelor's Degree in a Recognized Technical Subject. An applicant will be considered to have established to the satisfaction of the OED Director that he or she possesses the necessary scientific and technical training if he or she provides an official transcript showing that a Bachelor's degree was awarded in one of the following subjects by an accredited United States college or university, or that the equivalent to a Bachelor's degree was awarded by a foreign university in one of the following subjects:

Biology	Pharmacology	Electrochemical Engineering
Biochemistry	Physics	Engineering Physics
Botany	Textile Technology	General Engineering
Computer Science	Aeronautical Engineering	Geological Engineering
Electronics Technology	Agricultural Engineering	Industrial Engineering
Food Technology	Biomedical Engineering	Mechanical Engineering
General Chemistry	Ceramic Engineering	Metallurgical Engineering
Marine Technology	Chemical Engineering	Mining Engineering
Microbiology	Civil Engineering	Nuclear Engineering
Molecular Biology	Computer Engineering	Petroleum Engineering
Organic Chemistry	Electrical Engineering	

i. Bachelor's Degrees In Other Subjects: An applicant with a Bachelor's degree in a subject not listed above, such as Biological Sciences, Pharmacy, Mechanical Technology, or a Computer Science degree from an institution that was not accredited by the CSAC of the CSAB or by the CAC of ABET on or before the date the degree was awarded must establish to the satisfaction of the OED Director that he or she possesses the necessary scientific and technical training under either Category B or Category C below.

ii. Graduate Degrees: An applicant who has a Master's or higher level degree in

one of the subject areas listed above, but does not have a Bachelor's degree in such subject, must establish to the satisfaction of the OED Director that he or she possesses the necessary scientific and technical training. Possession of the necessary scientific and technical training may be satisfactorily established in the manner set forth under either Category B or Category C below.

CATEGORY B: Bachelor's Degree in another Subject. An applicant with a Bachelor's degree in a subject other than one of those listed in Category A, must establish to the satisfaction of the OED Director that he or she possesses scientific and technical training equivalent to that received at an accredited U.S. college or university for a Bachelor's degree in one of the subjects listed in Category A. To establish such equivalence to the satisfaction of the OED Director, an applicant can satisfy one of the following four options, other training, or other education listed below. The applicant must submit the necessary documentation and objective evidence showing satisfaction of one of the options or other means of qualifying.

i. Option 1: 24 semester hours in physics. Only physics courses for physics majors will be accepted.

ii. Option 2: 32 semester hours in a combination consisting of the following: 8 semester hours of chemistry or 8 semester hours of physics, and 24 semester hours in biology, botany, microbiology, or molecular biology.

The 8 semester hours in chemistry or 8 semester hours of physics must be obtained in two sequential courses, each course including a lab. Only courses for science or engineering majors will be accepted.

iii. Option 3: 30 semester hours in chemistry. Only chemistry courses for chemistry majors will be accepted.

iv. Option 4: 40 semester hours in a combination consisting of the following: 8 semester hours of chemistry or 8 semester hours of physics, and 32 semester hours of chemistry, physics, biology, botany, microbiology, molecular biology, or engineering. (For Computer Science, see other acceptable course work.)

The 8 semester hours of chemistry or 8 semester hours of physics must be obtained in two sequential courses, each course including a lab. Only courses for science or engineering majors will be accepted. For Computer Science, see other "Other

Acceptable Course Work."

All acceptable coursework for Options 2 and 4 must be for science or engineering majors.

Only courses with a grade of C- or better will be accepted. To speed the review process, please highlight the courses to be considered on the transcripts and course descriptions submitted.

CATEGORY C: Practical Engineering or Scientific Experience. An applicant relying on practical engineering or scientific experience or who does not qualify under Category A or B above may establish the required technical training by demonstrating that he or she has taken and passed the Fundamentals of Engineering (FE) test. The FE test is a test of engineering fundamentals. The FE test is developed and administered by a State Board of Engineering Examiners in each State or comparable jurisdiction. Neither the USPTO nor any other U.S. Government agency administers the test. An applicant desiring to take the FE test should direct inquiries to the Secretaries of the appropriate State Boards. Official results of the FE test must be submitted to establish qualification under this category. An applicant attempting to qualify under Category C must submit an official transcript showing the award of a Bachelors degree.

Annex 5

Requirement for admission as Certified Patent Agents by The Hong Kong Institute of Patent Practitioners

Hong Kong Institute of Patent Practitioners

Requirement for admission as Certified Patent Agents

In these requirements,

“Institute” means the Hong Kong Institute of Patent Practitioners;

“Council” means the council of the Hong Kong Institute of Patent Practitioners;

“Foreign Patent Agent” means a person entered on any list or register of persons qualified to practice before a regional or national intellectual property office of a Recognized country or region;

“Rules of Examination” means the Rules of Examination as approved by the Institute.

“Recognized jurisdiction” means a jurisdiction of the following country or region: Australia, Canada, China, EP, New Zealand, UK and US.

The following persons should be eligible for admission as Certified Patent Agent under Art 58 of the Article of Association of the Institute:

1. A Foreign Patent Agent from a Recognized Jurisdiction who is
 - a. residing in Hong Kong or is a permanent resident of Hong Kong; and
 - b. has been practicing patent law in Hong Kong for at least one year.

2. A technical degree holder who
 - a. has been working continuously for 3 years in the area of patent in Hong Kong under the supervision of a Foreign Patent Agent;
 - b. has been certified by the Foreign Patent Agent under 2(a) above as having the knowledge and skills to draft and handle patent applications in a substantive context;

- c. applied to the Institute before the 3rd anniversary of the Institute, and
- d. satisfies the drafting requirement as set forth in Schedule 1.

OR

3. An Ordinary Member of the Institute who
 - a. has passed or is deemed to have passed the qualifying Examinations as set forth in the Rules of Examination; and
 - b. has been working continuously for 2 years in the area of patent in Hong Kong under the supervision of a Certified Patent Agent.

Schedule 1

Drafting requirement for a technical degree holder to be admitted as Certified Patent Agent

For the purpose of admission as Certified Patent Agents under requirement 2, a technical degree holder should provide the following drafting samples:-

1. No less than ten (10) samples of original drafted patent applications, and sign a Declaration declaring that the drafting samples are so independently written. If the samples are drafted under supervision, the supervisor should be a Foreign Patent Agent and a recommendation letter signed by the Foreign Patent Agent should be submitted together with the sample to indicate the extent of the supervision and the level of skills of the candidate.
2. Of the ten (10) samples, at least 3 specimens should be granted patents in the Recognized Jurisdictions.
3. The 10 samples should not fall within the same family of invention (as defined under a patent search in Delphion, WIPS or any other database as may be determined by the Council from time to time).

The Council may form an Admission Panel conduct a review of the submitted samples and/or an interview with the applicant and/or Foreign Patent Agent who wrote the recommendation letter to determine the suitability of the applicant to be admitted as a Certified Patent Agent.

RULES OF EXAMINATION

The following degree(s) or examinations are accepted as the knowledge requirement for a Certified Patent Agent:

1. Masters of Intellectual Property (MIP) from University of Technology Sydney to fulfill the knowledge requirement to qualify as an Australian Patent Attorney
2. CIPA examinations or equivalent course to qualify as Chartered Patent Attorney
3. SIPO examinations to qualify as Chinese Patent Attorney
4. NZ examinations to qualify as New Zealand Patent Attorney
5. USPTO examinations to qualify as US Patent Agent
6. Canadian Patent Office examination to qualify as Canadian Patent Agent
7. Any other degree or examination as may be approved by at least 75% of the Council and majority of the Certified Patent Agents as from time to time.

Annex 6

1. UK Comptroller can hear patent cases including infringement

The following link shows that UK Comptroller hears almost all patent cases including infringement:

<http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-dispute/pro-p-proceedings.htm>

Please referred to the brochure published by the UK Patent Office here:

<http://www.ipo.gov.uk/decidingpatentdisputes.pdf>

All the decisions of the Comptroller are published, e.g.

<http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results-gen.htm?YearFrom=2010&YearTo=2010>

Note that the UK Patent Court is not the same as the UK Patent Office. They both hear cases. Patent agents have right to appear before the Comptroller **and** also the Patents Court.

Hearing before the Comptroller is generally encouraged as it is faster and cheaper, and may be appealed.

Alternative dispute resolution services is also provided by the UK patent office:

<http://www.ipo.gov.uk/disputeresolutionservices.pdf>

The supporting sections of the UK Patents Act are

A) Proceedings for infringement of patent

*61.-(1) Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the **court***

(c) for damages in respect of the infringement;

(e) for a declaration or declarator that the patent is valid and has been infringed by him.

*(3) The proprietor of a patent and any other person may by agreement with each other refer to **the comptroller** the question whether that other person has*

infringed the patent and on the reference the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e) above.

(4) Except so far as the context requires, in the following provisions of this Act -

*(a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) -
[referring to Comptroller]*

(5) If it appears to the comptroller on a reference under subsection (3) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if

B) Power to revoke patents on application

72.-(1) Subject to the following provisions of this Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say

2. The Singapore Registrar is entitled to hear patent cases including infringement

Singapore has exactly the same provisions in the UK but referring to the Registrar instead of the Comptroller. (Singapore Patents Act Chapter 221)

In Singapore, communication with patent agents enjoys privilege status (S95 of SG Patents Act).