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31/12/2011 09:28

Please respond to [redacted]

To "patent_review@citb.gov.hk" <patent_review@citb.gov.hk>

cc

bcc

Subject Respond to Consultation of Review of the Patent System in Hong Kong

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Dear Sirs,

I am a Hong Kong solicitor practising in IP and patent law. I am also seeking to qualify as a UK patent attorney by studying the qualification examinations. My personal views to the captioned consultation are set out below.

Standard Patents

1) Whether an OGP system should be introduced in Hong Kong

My view is that in order to promote innovation, it is necessary to establish a home patent office. For Hong Kong, a home patent office provides an image of innovation as well as playing a practical role. Moreover, the patent office would play an important role for driving and supporting other technology/innovation related initiatives in Hong Kong, such as development of a patent equity index. Without the support of a home patent office and a recognised profession, Hong Kong is already lagging behind in areas of technological innovations.

2) Whether the current re-registration should be maintained

Re-registration is a cost effective way for patent owners/applicants having originating UK, EP(GB) and PRC patents to obtain a Hong Kong patent. This system should be maintained subject to that a modification is required for introduction of a security clearance procedures for Hong Kong resident applicants. A security clearance approval should be obtainable quickly to avoid delays.

Further, if the re-registration system and OGP system are available, market forces will decide whether one or both systems should be maintained. There is no harm to initially maintain a dual OGP and re-registration system.

3) Whether the patent system should be expanded to recognize the patents patented by other jurisdiction

The laws on patentibility are complex area of laws and are different in different jurisdictions. For example, the US allows for business methods patents, which are not patentable under the EPC and in China. A broad recognition of foreign patents would cause confusions to the users and often a false sense of security of having a patent that may not be patentable in the first place. I do not agree with the Singaporean approach of putting the burden of proof of validity of a patent on the applicant. Hong Kong ought to only recognise patents of other jurisdictions which have similar patentability laws. This will avoid unnecessary patent rights to be granted. My view is that the current practice of recognising UK, EP(GB) and PRC

patents ought to be maintained.

Regulation of Patent Agency Services

My view is that disregard whether an OGP system is to be implemented in Hong Kong, a regulated patent agency/attorney profession is required to be implemented.

First, the patent agent profession requires persons who have acquired specific training its his/her technical field (for most jurisdictions, an undergraduate degree in science and engineering) and additional training and knowledge in patent law and drafting. Moreover, since both English and Chinese are official languages in Hong Kong, patent agents ought to be bilingual. Hong Kong currently provides little means in developing or training the patent agent profession. Due to the unique nature of the profession, it generally would take years of study and training to train up a qualified person. Hence, the development of a patent agent profession is expected to take years, and according to the experience of other jurisdictions, the first batch of trained and qualified persons probably will not be available after several years. A regulated profession would promote development of the profession and is necessary disregard whether Hong Kong opts to create an OGP system.

More importantly, a regulated profession would provide assurance to the quality of the practisioners and protect the interests of all stakeholders, including the users as well as the profession as a whole.

Restrict to persons meeting certain qualifications

It is a globally accepted and fundamental requirement for a patent agent/attorney to have acquired trainings in science and engineering. It means an undergraduate degree in science and engineering. Persons who have only acquired a postgraduate degree in science and engineering without an undergraduate degree in such fields would not be considered as qualified. My view is that the education system in Hong Kong readily produces high calibre engineers and scientists, and there is no reason to lower the technical qualification requirement of patent agents/attorneys. Such technical qualification requirement is absolutely necessary for a patent agent/attorney.

I object allowing top up studies for persons who do not meet the minimum technical qualification requirement as a substitute. From a policy perspective, this is necessary for maintaining the standard of patent agents/attorneys. It is crucial for a patent agent/attorney to be fluent in the art of the inventors and have a solid technical background. It is submitted that any patent agents/attorneys whether registered or not must have attained an undergraduate degree in science or engineering.

Title of patent agent or patent attorney

For this, I propose to adopt the UK system where the titles "Registered Patent Agent/Attorney" are reserved for persons who have passed the relevant patent agent qualification examinations, and solicitors who practise in patent law may use the title "Patent Agent/Attorney".

Since the tasks of patent drafting and amendments demand a good grasp and understanding of the technical invention sought to be claimed in the patent, patent drafting is a specialised task that requires persons who are technically trained in the underlying technical field as well as in patent law and drafting. A good patent draftman must have the skills and ability to claim and protect the invention, which is the hardest skill to acquire in patent drafting. My view is that only persons who are qualified as Registered Patent Agent/Attorney ought to be allowed to draft patents and prosecute patents.

I would like to remain anonymous in this consultation.

Regards,