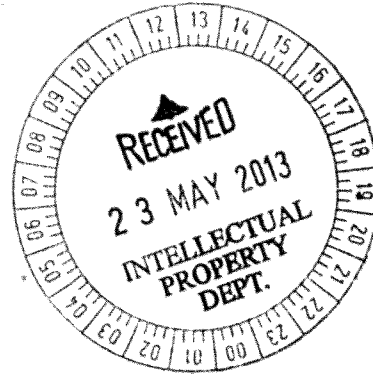


Ref.: ED-2013015

EXECUTIVE DIRECTOR
總裁

21 May 2013

Mr. Peter K. F. CHEUNG
Director of Intellectual Property
Intellectual Property Department
25/F, Wu Chung House
213 Queen's Road East
Hong Kong



Dear Mr. Cheung,

Re: Consultation on Regulation of Patent Agency Services

Referring to the Consultation Paper on Regulation of Patent Agency Services, enclosed please find the document for your reference.

Thank you for your kind attention.

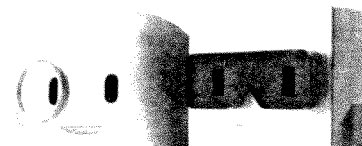
Yours sincerely,

A handwritten signature in black ink, appearing to be "Agnes Mak".

Mrs. Agnes MAK, MH, JP
Executive Director
Hong Kong Productivity Council



HKPC[®]



Regulation of patent agency services

4. Possible interim measures

(a) The interim measures should have regard to the early building and recognition of a regulated patent agency profession through increasing the awareness of users of the relevant qualifications and experience of patent agents. In this connection –

(i) Should we draw up and publish a list or register of patent agents with their qualifications for public information as a first step?

➤ The list of patent agents with their qualifications should be published to allow consumers to have a choice in selecting the service provider.

(ii) If so, what are the criteria for inclusion in the proposed list or register and what specific information should be provided? Should the provision of information be entirely voluntary?

➤ The listed patent agent must be qualified by an authorized organisation recognized by Hong Kong.

➤ The specific information may include name, qualifications, affiliation of professional bodies and contact details.

➤ The provision of information should be made compulsory.

(iii) Which party should administer the list or register? What could be the means of publication? Should this be an administrative arrangement or backed up by the law?

➤ It could be a professional body “Patent Attorney Accreditation Council” (the “Council”) with representatives from the Law Society of Hong Kong, the Hong Kong Bar Association and other relevant professional bodies to administer the list.

➤ The list could be published on paper and website of the Council.

➤ It is appropriate to have the administrative arrangement backed up by the law

(b) The interim measures may also take the form of controlling the use of titles.

(i) Should we in the first instance seek to control the use of titles, or should this be implemented in the next stage after putting in place the list or register in sub-paragraph (a) above?

➤ The use of title should be controlled to maintain the professional standard and reputation of the profession.

- (ii) What specific titles should be controlled?
- The generally used titles in other countries/regions that have this profession are patent attorney or patent agent.

- (iii) What are the criteria to be adopted in determining qualified persons or firms? For example, should qualifications (foreign or local), passing accredited examinations, or taking accredited courses be adopted as the criteria?

Determining qualified persons

- By recognizing professional qualifications accredited by designated countries but those foreign qualified professionals are required to register to the Council in order to practice in Hong Kong.
- By passing a recognized examination provided by the Council.

Determining qualified firms

- For registration of firms, they should have a minimum number of qualified patent attorney/agents.

- (iv) Should we rely on foreign qualifications and accreditation, or should we establish an indigenous system

- As the HKSAR government has already announced the way forward for development of an OGP system, while relying on foreign qualifications and accreditation may be necessary in the transition period; an indigenous system is necessary in a long run.
- Therefore, we should establish a indigenous system in the long run.

- (c) If we were to establish an indigenous system to verse the use of titles, qualifications and other professional matters (which may be seen as a pre-requisite to implementing the ultimate goal of permitting only qualified persons or firms to provide patent-related services), we need to think through the various implications.

- (i) How to administer the conferral of qualifications and accreditation of examinations and courses, and put in place the necessary education programmes?

- The Council should be responsible for the conferral of qualification and accreditation of examinations and courses.
- As for putting in place necessary education programmes, the Council should collaborate with universities in designing the education programmes.

- (ii) What mechanism is required to uphold service quality and professional discipline (for example, under what conditions should a patent practitioner be disqualified from using the title)?
- With the set up of the Council, it is the professional regulatory body to monitor and uphold the service quality of the service providers.
 - The Council should formulate relevant rules and regulations regulating the professional conduct of the patent attorneys/agents, and in case a patent attorney/agent is in violation of the code of conduct, he/she is subject to disciplinary actions by the Council.
 - In respect of details of regulating practitioners and the regulation system, reference can be made to the practice of regulating Chinese Medicine Practitioners by the Chinese Medicine Council of Hong Kong.
- (iii) What party or parties should be entrusted to oversee the profession and all these qualification, service and title matters?
- As mentioned above, the Council should be entrusted to oversee the profession and all the qualification, service and title matters.
- (d) The interim measures should also have regard to the existing patent agency services.
- (i) Should there be any grandfathering arrangement for existing service providers to facilitate their transition to the new regulatory regime? Are there any other alternatives to grandfathering?
- To ensure a smooth transition from current system to the new OGP system, and to ensure the service quality; it is our view that a grandfathering arrangement for existing service providers is necessary.
- (ii) Regarding the grandfathering arrangement, what are the criteria to be adopted, such as working experience, qualifications and training?
- In terms of criteria, to be qualified for the grandfathering arrangement, one should be a qualified practitioner as patent attorney or patent agent in his/her respective jurisdiction of practice.
- (iii) Should the parties benefiting from the grandfathering arrangement be allowed to use the same or different titles as qualified persons or firms, or to provide a full or limited range of the regulated services?
- The parties should be allowed to use the same title and be allowed to

practice patent law in Hong Kong in full capacity.

(iv) Should the grandfathering arrangement be provided only for a finite period to encourage the beneficiaries to obtain the necessary qualifications under the new regime? If so, how long should the period be?

- It is our view that such arrangement should be provided only for 3 years from the establishment of the OGP.

(e) Considerable time is needed to build up the local patent agency profession, nurture the human resources and expertise required and, if needed, establish an indigenous system overseeing the profession. But this should not hold back the introduction of an OGP system.

(i) Of the possible interim measures identified above, which of them can be introduced before the OGP system? Can a list or register of patent agents with their qualifications be drawn up at an earlier stage?

- Of the possible interim measure identified above, the "Patent Attorney Accreditation Council" should be set up first before the OGP system to carry out such ground works as formulating grandfathering arrangement policy; collaborating with universities in designing education programmes; designing the qualifying examinations and related arrangements; publishing and maintaining the list of the patent agents and etc.

(ii) Should the control of the use of particular titles be introduced before the OGP system? Would it be different if we go for the establishment of an indigenous system to oversee the use of titles?

- With the establishment of the Council, the use of particular titles should be introduced before the OGP system and it should be regulated by the Council, and it would not be different if an indigenous system is to be established to oversee the use of title.

(iii) As for the ultimate goal of regulating the provision of services, should this be only considered until there is sufficient experience in the operations and requirements of the new OGP system?

- In our view, there is no need to wait until there is sufficient experience in the operations and requirements of the new OGP system to regulating the provision of services; one function of the Council is to regulate the provision of services.

Regulation of patent agency services

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