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2013/05/28 上午 01:00

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bcc

Subject Consultation on the Regulation of Patent Agency Services

Urgent Return receipt Sign Encrypt

Dear Sirs,

Thank you for your letter dated 20th March 2013 and your invitation of expression of my views on the above matter.

Residency requirement

In most jurisdictions, the core requirement to be registered as the patent agent/ attorney is the ordinary resident of that jurisdictions and basically, the applicants are required to have a local residential address/ business address for legal communication. In my view, it would be applied in our Hong Kong system.

Possible interim measures

It is advised to bring public awareness on the qualification and experience of patent agent/ attorney in order to protect the patent right of the applicant derived from the patent registrations of Hong Kong. Through the transparency of the qualifications and experience of the agents who handle the drafting and prosecution of patent applications, the applicant is able to make his own choice to find a right person to draft the patent specification in order to illustrate the correct patentable technical features in the specification. As such, I support to draw up and publish a list or register of patent agents with their qualifications for public information. And the list is required to include the educational and professional qualifications of the agents. It is further suggested that the governmental department is the body to administer the above list which could be publish through the website of the Intellectual Property Department of HKSAR.

In most jurisdictions (such as UK, USA and Australia), the professional titles of "patent agent" and/or "patent attorney" are strictly controlled by domestic laws. People who use the above titles are required to meet certain requirements made by patent related laws of that jurisdiction. Generally, the qualified patent agent/ attorney is requested to fully understand the description of the invention and normally, he/she ought to have an engineering or science qualification. I hardly believe that an agent without engineering or science background is able to sort out any technical features of the inventions. If it has any unsuitable independent or dependant claims appeared in the specifications, loss of patent rights will be arise due to unskilled patent drafting.

Knowledge requirement

The fact is that Singapore has a similar economic scale with Hong Kong and Singapore has its own patent agent registration system a long time ago. Singapore now plans to become a Asian IP Hub by restructuring the Singaporean IP Academy and IP Office. However, in Hong Kong, qualified patent agents/ attorneys having competent patent knowledge and experience are inadequate in the market. The grandfathering arrangement for existing service providers are advised to be applied in our patent agent system in order to maintain adequate number of service providers to provide IP services to

serve the increasing number of applicants. However, I discovered it has much unqualified service providers in the market and will affect the quality of the patent services in Hong Kong. In my view, as I mentioned above, the patent agent/ attorney is required to have a engineering or science background. Moreover, legal qualification is also required to help the client to resolve the legal matters about his invention, such as validity of patent specification and patent infringement analysis. Frankly speaking, all patent prosecutions involve legal matters and most patent matters are not restricted to Hong Kong laws. As such, we can take Australian early patent agent registration as our reference, people who hold engineering degree and having the ordinary residency status are the core requirements to become a patent attorney in Australia. In other commonwealth jurisdictions, a qualified lawyer is the only requirement to become a patent agent/ attorney of that jurisdiction.

To conclude most commonwealth patent agent registration requirements, my view is that a responsible government shall protect the applicant to get the suitable legal protection of his invention. As such, it is suggested that common law legal and engineering (or science) qualifications are the main requirement for the registration of patent agent/ attorney of HKSAR. On the other hand, by considering the immaturity of the Hong Kong patent agent registration, it is not possible to impose any supervised practice requirement (supervised by Hong Kong registered patent agent/attorney) on patent agent/ attorney registration at this stage. The example of working experience requirement of the early Australian patent agent registration system can be referred. Under the above requirement, the working experience requires the applicant to have 2 years working experience on the filing and prosecution of patent applications or registrations in a law firm or technical company only.

The above recommendations are only my suggestions on the patent agent registration system which would be applied in our future Hong Kong patent agent system and you are pleased to contact me if you have any comments on my suggestions.

Regards,

Danny Chan