THE LAW SOCIETY OF HONG KONG 香港律師會

CONSULTATION ON REGULATION OF PATENT AGENCY SERVICES

THE LAW SOCIETY'S SUBMISSION

This is a response by the Law Society's Intellectual Property Committee to the issues raised in a letter dated 20 March 2013 from the Intellectual Property Department relating to *Regulation of Patent Agency Services*. We note that any related views on the implementation of the Original Grant Patent ("OGP") system and refinements to the short-term patent system may also be provided. We wish to note that we do have some comments on the Advisory Committee's recommendations which we will submit separately and understand that there is no immediate deadline for this.

Consultation Questions on Possible Interim Measures

(a) List or register.

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

(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?

(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?

Law Society's response:

We are firmly of the view that there is no merit in introducing interim measures as outlined in IPD's Consultation Paper and are not in favour of drawing up an interim list or register of patent agents which is tantamount to conferring an interim official recognition. Put simply, this is putting the cart before the horse. As noted in our original submission (17 January 2012), the title of "patent agent" and "patent attorney" typically carry some expectation of training, experience and specialty in relation to patents, whether in terms of technical scientific knowledge in the case of a patent agent, or legal knowledge in the case of a patent attorney. These titles are protected by law in a number of jurisdictions with very specific meaning, for example in the US where the Patent and Trademark Office registers: (i) lawyers - attorneys at law ("patent attorneys") who are also able to practice in the courts; and (ii) persons who are not lawyers ("patent agents"), are entitled to appear before the United States Patent and Trademark Office).

The misuse of such titles in jurisdictions such as Hong Kong before any such protection is in place will likely lead to public misconception as to the qualifications of the persons concerned, in particular persons calling themselves "patent attorneys" who are *not lawyers* and are not conversant with patent matters.

Our strongly held view, therefore, is that the Administration should first introduce a comprehensive system before conferring any interim official recognition of such titles.

As a matter of record, solicitors, barristers and overseas patent agents who practice intellectual property in Hong Kong to a substantial extent are recognised by the Hong Kong Group of the Asian Patent Attorneys Association ("APAA") and belong to recognised regulated professions. Under the Law Society's *Practice Promotion Code*, a solicitor must not: "*make any claim or imply that the solicitor is, or that his practice is or includes an expert in any field of practice or generally. It is permissible, however, to refer to his knowledge, qualifications, experience or area(s) of practice provided that such a claim can be justified*". Accordingly any claim by a solicitor to be a "patent attorney" must be justified.

In the absence of a domestic regulated patent agency profession, it would be, at best, meaningless and, at worst, misleading to have a list or register of "patent agents" who are not so regulated. Accordingly, we do not see any justification or urgency for introducing an interim system, which is likely to create more uncertainty on the part of the public and be open to abuse by persons who do not have relevant qualifications or experience.

On this basis we do not find it necessary to answer the other questions above.

(b) 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?

(ii) *What specific titles should be controlled?*

(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?*

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

Law Society's response:

Since we are of the view that the Administration should first introduce a comprehensive system before conferring any interim official recognition of titles, we again regard this as premature.

We do, however, support the adoption of high standards, to include the recognition of credible overseas qualifications and the adoption of indigenous criteria, for persons seeking to be recognised as "patent agents" and "patent attorneys".

Furthermore, consideration should be given to reciprocal recognition of such qualifications, which will necessarily involve suitably high standards being set

(c) ***Implications.***

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

(iii) *What party or parties should be entrusted to oversee the profession and all these qualification, service and title matters?*

Law Society's response:

We agree that these are important considerations, but not as interim measures. We believe the Administration should itself give consideration to the appropriate standards which should include relevant technical drafting skills, legal and procedural knowledge, analytical experience and specific competence in the fields of patent law and practice. Any professional recognition should carry with it adequate levels of training, insurance, professional codes of conduct, disciplinary measures and such like commensurate with those observed by members

of the Law Society. We also foresee that there should be an umbrella organisation that oversees the profession and recognises solicitors practising as patent attorneys (which could be based on the existing or tightened up criteria for APAA membership).

The Administration may explore cooperation with long established and well recognised international organizations (e.g. WIPO, FICPI, APAA) to provide educational programmes, professional publications and professional training.

(d) ***Grandfathering of 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?*

(ii) *Regarding the grandfathering arrangement, what are the criteria to be adopted, such as working experience, qualifications and training?*

(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?*

(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?*

Law Society's response:

Whilst the new regime should include grandfathering, it is again too soon to say what form this should take. However, we believe that it should carry with it some level of technical or legal competence in relation to patents. We note in this respect that whatever title may be conferred, under existing practice, both the re-registration of patents granted by designated patent offices and the prosecution of short terms patents are open to anyone. Also under the existing practice, some solicitors use the title "*agents for patents*", a term that may need to be reviewed under any new protected title scheme.

The proposed OGP system, however, will necessarily focus on drafting skills, an issue which has not been addressed specifically in the consultation. Most Hong Kong solicitors do not wish to draft patents and it is likely that any recognition of "patent agents" will have to include appropriate scientific knowledge and technical skills to qualify for the right to draft original patents. Accordingly, the current re-registration practice may well be grandfathered, without resolving who may be qualified to act under the new system.

In this connection, we note paragraph 5.13 of the Advisory Committee's Report which states:

"On the above issues, the Advisory Committee considered the following options –

"(a) Option A:
To regulate the provision of either --

(i) all patent-related services (including services for re-registration); or

(ii) only services that involve technical expertise (mainly under the OGP system e.g. drafting patent specification and claims, conducting clearance search, advising on responding to the queries on patentability raised by examiners, giving advice on the validity or infringement of patents)

so that only qualified persons or firms may provide such services; and/or

(b) Option B:
To limit the use of particular titles such as "patent agents" and "patent attorneys" to qualified persons or qualified firms."

The recommended Option A (ii) to regulate only services that involve technical expertise (rather than all services) should, if pursued, further distinguish between drafting and prosecution of patent applications (which are traditionally handled by overseas qualified patent agents) on the one hand, and matters such as conducting searches, advising on validity or infringement and "freedom to operate" opinions (which may be handled by suitably knowledgeable solicitors) on the other hand.

We would wish to be closely consulted further on these issues as any new system of accreditation emerges.

(e) Timetable

(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?

(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?

(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?

Law Society's response:

Whilst, as indicated in our previous response, we do support a regulatory regime whether or not an OPG system is eventually implemented, we do not favour any list or register being drawn up in advance of suitable standards being set. The timetable for that can and most likely will be independent of the introduction of the OGP system since there are already indications that the public is confused under the present unregulated regime, which encourages the establishment of spurious self-serving "qualifications" or titles. The horse must come before the cart.

The Law Society of Hong Kong
28 May 2013
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