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To <patent_agency_consultation@ipd.gov.hk>

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Subject Re: Consultation on Regulation of Patent Agency Services

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Dear Sirs,

In response to Consultation on Regulation of Patent Agency Services, my personal views are set out below.

List of patent attorney

It is inevitable that it takes time to build up a local patent profession in Hong Kong with locally trained and qualified patent attorneys. There are a number of foreign qualified patent attorneys, such as UK, New Zealand, Australian and PRC attorneys, practising in Hong Kong. In the interim before a local profession is established, the first step is to recognise those who have practised Hong Kong patent law in Hong Kong. For further comments, please see below with regard to Grandfathering.

In order to provide transparency, I view that those who provide patent services as patent attorneys must list themselves in a publicly available register.

The register should provide basic information in relation to the background and relevant qualifications of the patent attorney. Similar to patent agent registers of other jurisdictions, person listed on the register should provide the following information:

1. technical qualification, such as degree in engineering and science plus main area of technical expertise, such as mechanical engineering, electrical engineering, chemistry, etc
2. professional qualifications, such as solicitor or barrister with qualified or admitted jurisdiction if such person is also a Hong Kong solicitor or barrister
3. working language, either Chinese, English or both. This is Hong Kong specific as both English and Chinese are official languages and patent attorneys apt to work in one language may not be equally competent in the other language.
4. contact information, such as address and email
5. firm name of which the patent attorney is associated, if any

In line with international practices, the patent attorney register should be maintained by a professional patent attorney body or regulator with power back up by legislations. However, the register can be set up according to administration regulations of the professional body or regulator conferred by law.

Use of titles

According to international practices, the titles patent agent, patent attorney, registered patent agent and registered patent attorney should be reserved titles to qualified person on the register only.

Control of use of title should commence as soon as the relevant law regulating the patent attorney profession is enacted, and regulation of use of titles will be possible when the patent attorney /agent register is available.

Grandfathering

A grandfathering arrangement will be necessary to allow the first batch of practitioners to be recognised. However, grandfathering should be limited and must align with the basic qualification requirements of qualified patent attorneys. In Hong Kong, solicitors who are competent in patent law are allowed to practise patent law, and they will continue to practise patent law. I view that it will not be necessary to convert lawyers who do not have substantive patent experience to patent attorneys. The grandfathering scheme should only recognise those who have technical competence and patent knowledge. Otherwise, this will simply open up a flood gate. I do not think that a grandfathering scheme that allows lawyers without substantive patent drafting and prosecution competence to qualify would be justified. I view that patent attorneys to be grandfathered must have the technical competency and legal knowledge in patent law.

With regard to technical competency, patent attorneys must have acquired and completed tertiary education in relevant science and engineering degrees. With regard to knowledge in patent law, in order to maintain the quality of patent services, I view that the grandfathering scheme can only recognise the qualification of or passes in examinations for patent attorneys of reputable offices, such as UKIPO, EPO and SIPO, providing that such candidate also has at least 2 years of experience in Hong Kong patent law. Any person who are grandfathered must satisfy the above.

Accreditation and qualifications

In general, I support an accreditation system similar to that of the UK, EPO and Singapore with 2 levels of examinations. The first level of qualification can be obtained through examinations or attending courses covering the book work. The second level of qualification, similar to the CIPA Advanced Level papers, is for assessing the professional skill of the candidate.

In the early stage of development of the profession, it may not be cost effective or practicable to set up a local qualification and examination body. However, Hong Kong may adopt a similar accreditation system as Singapore where the IPO of Singapore recognises passes of certain papers in some foreign jurisdictions, such as the UK, New Zealand and EPO, as passes of the corresponding paper in Singapore. Currently, the UK CIPA Advanced Level Examinations are held in Singapore annually, and the examinations are administered by the British Council of Singapore with the paper scripts marked by the Joint Examination Board. It will be beneficial to the profession if a similar arrangement can be made in Hong Kong to allow candidates to sit the examinations in Hong Kong.

The structure of qualification examinations for PRC patent agents are very different, I view that a pass in the drafting paper in the PRC Patent Agent Qualification Examination cannot be deemed equivalent to a pass in drafting, response to official action or infringement/validity paper in Hong Kong. It is because in the UK and EPO, the same skill is assessed through 4 papers as opposed to one paper in China. Further, the PRC Patent Agent Qualification Examination can be taken by non-professionals who are interested in entering the profession without actual patent experience, and the CIPA or EPO examinations are sat by patent attorneys who have at least 2 to 3 years of actual working experience. Having said that, I view that a pass in the drafting paper of PRC Patent Agent Qualification Examination should qualify a person to conduct patent work in Chinese provided that such person is a qualified patent attorney of Hong Kong.

Time table

I view that the purpose of grandfathering is for providing formal recognitions of

existing practitioners in Hong Kong, and any grandfathering scheme should be limited in time. I view that the grandfathering scheme can be made available for application for no more than 1 year. Any person who only meet part of the grandfathering requirements will be required to acquire the qualification through the proper qualification route and will not be automatically grandfathered.

I would like to remain anonymous in the consultation.

Regards,