

By email only

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May 31st, 2013

Dear Sir

Consultation on Regulation of Patent Agency Services

We understand that the Government is seeking views on how best to move forward with regulation of patent agency services. We also understand that a letter dated March 20, 2013 from the Intellectual Property Department has issued in this regard seeking such views. The following is in response to the specific issues raised in your letter. For ease of reference the same numberings in your letter are used below.

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4. It is agreed that a sufficient talent pool of patent professionals is needed for an OGP system to work. However, there are actually quite a number of patent professionals who have been practicing in Hong Kong for many years.

Possible interim measures

- (a) As pointed out in your letter, before an OGP system can be developed and implemented interim measures would be needed.
 - (i) With a view to provide users of the patent system with information of existing patent practitioners residing in Hong Kong whom they can look to for patent assistance, a list or a register of patent practitioners should be drawn up.
 - (ii) Patent practitioners (as individuals) who choose to be listed in the register can submit concise details of their qualification for listing purpose. Since patent practitioners should have the freedom to be listed or not, the provision of

information should be entirely voluntary. For example, patent practitioners who are in private practice would more likely choose to be listed; while patent practitioners who are working in in-house capacity might choose not to be listed.

The register should include concise details of patent practitioners. Currently, typical patent practitioners in Hong Kong have a first academic degree in a science or an engineering discipline and at least one patent qualification from an overseas jurisdiction. Accordingly, patent practitioners who choose to be listed should provide information concerning these credentials. Other information that may be shown in the register would include the number of years engaged in the patent practice, language used, specialization and of course contact information.

- (iii) A neutral body should be set up *or* appointed to administer the register. The reason that a neutral body should be used is to ensure fair and partial operation for maintenance of the register. In many jurisdictions, for example, the United States, Australia, such register is maintained by the Patent Office which is often seen as neutral. Similarly, the Hong Kong Intellectual Property Department is suitable to take up this role. To save time, it is best that the Hong Kong Intellectual Property Department is to prepare and administer the list.

The register should conveniently be accessible by the Department's website.

The maintenance of the register should merely be an administration arranged. After all, the register at its initial stage is one of the interim measures. If the preparation and provision of the list were to be backed by up by the law then it would take too long to come up with the list and the public would not benefit from information of such register in the near future. Further, such register would hardly qualify as an interim measure. Eventually when the relevant legislation has passed, a more elaborate register can be prepared and backed by the relevant legislation at that time.

- (b)
 - (i) There should be no control to the use of titles in the first instance as interim measures for a number of reasons. First, there would be no statutory foundation on which such control could be relied. Second, there are indeed many patent practitioners in the industry who have been providing quality patent services to users as genuine service providers or patent attorneys for years. It would be contrary to natural justice to impose restrictions on these practitioners. Further, many patent practitioners in Hong Kong hold one or more patent qualifications from overseas, have practiced on patent matters for many years, and are experienced in the Hong Kong patent system. It would not be reasonable to control the use of their titles which they have used for many years.
 - (ii) At least as interim measures, no control over use of titles should be placed. Thus, this issue is moot.

However, the titles of "patent agent" and "patent attorney" are worth discussing. While these two titles entail same or different qualifications in different jurisdictions, one would agree that a simple and easy to understand titling system should be used in Hong Kong. Accordingly, there should not be two different

categories of patent qualification in the interim measures stage or in the end. For example, under UK law patent agent and patent attorney refers to same professional, and this arrangement would minimize confusion.

There are suggestions in the market for creating and regulating further titles such as patent paralegal, etc. Such suggestions are neither logical nor understandable.

- (iii) In determining the criteria for qualified patent practitioners, one would agree that a patent practitioner should have a background in at least one discipline in science or engineering. Accordingly, one of the criteria for a qualified patent practitioner should be in possession of a first degree in science or engineering. This is actually one of the criteria in the UK before a candidate would be accepted as a patent attorney trainee.

Since many skills of patent practitioners are fairly international and transferrable in a relatively large extent, foreign patent qualification should be one of the criteria. In fact, many law firms and intellectual property firm in Hong Kong do hire patent practitioners with foreign qualification (from UK, Australia, USA, etc.), and this is indicative that practitioners with such credentials are suitable patent practitioners or patent attorneys.

In summary, as interim measures, the following criteria can be used.

- 1) Permanent Hong Kong residence (since the qualification is a Hong Kong residence after all)
- 2) First degree in one discipline of science or engineering
- 3) Patent qualification from at least one jurisdiction of common law system
- 4) Having practice in patent and in Hong Kong for a reasonable length of time, e.g. at least 3-5 years
- 5) With substantive patent experience, e.g. in drafting patent specification. A Declaration in support of the experience may be used in supporting this experience.

- (iv) Taking accredited course might be one of the criteria used in an indigenous system in the future, if such system were to materialize eventually. However, as interim measures the above criteria 1)-5) will be suitable. Taking accredited course should not be applicable to those who have been practicing substantively.

(c)

- (i) If an indigenous qualification system were to be implemented, a neutral and independent body should be set up to oversee the use of title, qualification and other professional matters including arranging education programmes. For example, the Chiropractors Council of Hong Kong was specifically set up to regulate the medical chiropractor profession.
- (ii) In order to uphold service quality, a disciplinary board would be needed. Arrangement similar to other professional bodies can be adopted. The board would come under an appropriate Council such as the Patent Attorneys Council set up by the relevant Ordinance in the future.

(iii) The neutral independent body as discussed above should be entrusted to over the profession.

(d)

(i) Yes, grandfathering arrangement should be provided. Criteria 1)-5) as set forth above can be used.

Any other arrangement would be disruptive and detrimental to the exiting qualified practitioners and to the provision of service to users.

(ii) Please see item (d)(i) above.

(iii) Yes. Creating different categories would introduce confusion to the public.

(iv) Yes. For example within 24 months from the date the indigenous system is in place.

(e)

(i) The provision of the register of existing patent practitioners.

(ii) No.

(iii) The regulation of the patent services and the OGP go hand in hand. They should be implemented at the same time.

In response to point 7 in your letter, we do not to disclose our identity indicating these views. Please make note of this.

Yours sincerely,