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Dear Sir,

Response to Consultation on Regulation of Patent Agency Service

It has been brought to my attention that submissions are being sought in relation to regulation of Patent Agency service in Hong Kong. I write from both standpoints as a User of Intellectual Property in Hong Kong, and also as a Professional who is subject to strict and appropriate professional regulation.

A. Patent Service Providers in Hong Kong

I have previously surveyed several firms in Hong Kong who were "Agents for Patents and Trade Marks" or "Patent Agent", as well as firms having Foreign Qualified Patent Attorneys.

However, upon quizzing and questioning people at several firms, I discovered that this is how drafting of patent specifications was done at different firms:

- (a) by China Patent Agents on site in Hong Kong at some Chinese patent firm
- (b) by foreign qualified Patent Attorneys on site in Hong Kong
- (c) by persons with no patent attorney qualifications at all and no university degree in technology
- (d) by simply outsourcing the work to China

I found out that all the people in group (a) and (b) Chinese Patent Agents and foreign qualified Patent Attorneys have proper tertiary university, degrees in science and/or engineering.

I also found out that these people in group (a) and (b) are required by law to have these technical degrees, take written exams in patent law and also undergo formal training under the supervision of another qualified practitioner for some years in order to become qualified and registered. But some had some different requirements.

B. Quality of Information and Advice

Regarding advising on registered designs and patents and answering my initial enquiries, only those persons having proper formal qualifications could give proper advice.

It became very apparent to me that those in groups (c) and (d) were clearly giving incorrect advice and information after I spoke with persons in groups (a) or (b).

Also those in groups (c) and (d) tried to tell me that there was no need for any qualification or university degrees in technology when I challenged them, and were defensive of their practices. I was also told that solicitors can draft patents in Hong Kong and that there is no need to be a Patent Agent or a Patent Attorney to do it in Hong Kong.

Although group (a) did not provide the level of professional insight that group (b) provided, at least group (a) had given correct procedural information and nothing was obviously incorrect.

C. Observations and Concerns

My personal surveying has shown that firms advertising as being "Agents for Patents and Trade Marks" in group (c) and (d) who did not have properly qualified persons are clearly not up to the job, and should not advertise to perform patent services to the public.

As a registered professional in another industry I am shocked that persons without any formal patent agent or patent attorney qualifications or training are undertaking patent work in Hong Kong with no regard to the complexities of the issues.

Also, I am very surprised that persons without any university degree in technology have told me that there is no need for these qualifications. However I know that group (a) and (b), the China Patent Agents and qualified foreign patent attorneys must have these strict requirements to become qualified and registered.

Also, it is very disturbing that persons without these technical qualifications are either drafting patents and providing poor or incorrect advice, or sending patent drafting to be done on the cheap in China.

It is so important that the person drafting patents have these qualifications in technology so they can understand the client's technology and discuss the issues when assisting the client face to face. If a person does not have these technical degrees, they cannot possibly understand a client's invention and should not be trying to do stuff they are not qualified to do.

A client's technology is very important, and people advertising as "Agents for Patents and Trade Marks" simply outsourcing the work to China is completely irresponsible.

D. More Comments

In Hong Kong there is not an examination office for examination of patents yet, Hong Kong clients still need their patents drafted properly and still need proper and correct advice, their inventions handled as they will continue their patent applications onto other countries.

Therefore, anyone practicing patent work must be properly qualified, and Hong Kong needs a proper listing of persons who are qualified patent agents or patent attorneys, and persons without university technical degrees.

The public need protection from these people in groups (c) and (d), and the government should put in proper safety measures to try and stop persons giving incorrect advice and trying to draft patents without any university degree in technology.

Therefore a publicly available list should be made which states a person's qualifications as well as what technical discipline they got their degree in, so the public can pick an appropriate person to carry out their patent work.

QUESTIONS

(A) Possible Interim Measures

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?

YES.

Even before any formal qualification for a patent agent or patent attorney in Hong Kong is created, the public need to know who really has a proper patent qualification and what degrees in what technologies they have.

(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 information required is name, patent qualifications and what country from, degree in what technology, contact details. I can't see how practitioners could be forced to be on a register so voluntary seems right.

(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?

The IPD seems an obvious choice. Publication can just be on the IPD website. It could be an administration arrangement by the IPD, but also perhaps later backed up by law then

(B) The Implementation 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 firms advertising as "Agents for Patents and Trade Marks" who are not really patent agents or patent attorneys, like in group (c) and (d), are a real problem to the public in Hong Kong.

These people pose a high risk as the public may not know they aren't real patent agents or patent attorneys and also might not know they don't even have university degrees in technology or how important this is to understand the inventions. This is very concerning

Therefore, on the list can only be persons who are qualified patent agents or patent attorneys like group (a) and (b). Definitely not people in group (c) or (d).

(ii) What specific titles should be controlled?

The titles "Patent Agent" and "Patent Attorneys" are international titles, and these should be controlled and only used by the persons on the register.

(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?

First of all, any qualified person must have a technical university degree, like how the China Patent Agents and the foreign qualified patent attorneys must have. This is very important and is a fundamental requirement for a patent agent or patent attorney. Without this, any title is completely meaningless and won't let the public know if the person can really handle the patent work.

I can't see how a firm can be qualified; it has to be a person like for other professions of course.

For qualification, it would have to be like for the foreign qualified patent attorneys, formal and thorough.

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

Reliance on foreign qualifications for now, and then indigenous when a strong qualification system is developed.

(C) If we were to establish an indigenous system to oversee 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?

Perhaps a government education program.

(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)?

This would need to be a professional body, like how other professions such as for solicitors, doctors, architects, etc.

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

Government administration most likely is appropriate.

(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?

Only those with professional qualifications such as group (a) or (b) could be subject to grandfathering.

It is important that only persons who would satisfy any new regulatory regime could be grandfathered.

It is important that those from groups (c) and (d) are not subject to grandfathering, as those persons are already a problem to the public and they should be definitely excluded.

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

The grandfathering can only be applicable to those who already meet the formal requirements like what a foreign qualified patent attorney has, including a university degree in a technology area for patents, passed formal exams, and training under another qualified person. Otherwise it is meaningless.

(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?

If the grandfathered persons have to meet the same requirements, then obviously the title should be the same.

- (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?*

Again, if they must meet the same formal requirements, there can't be any advantage. In other words, grandfathered persons must meet any subsequent regime so it makes no difference.

Implementation timetable

(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?*

YES, see answer at A (i)

- (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?*

YES

- (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?*

NO

Clients need properly qualified persons to assist them whether or not there is an OGP.

For and on behalf of
CHICKEN CREATIVE LIMITED
出奇事務所有限公司


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Authorised Signature(s)

Joyce Tung