



30 May 2013

Your Reference: IPD/1009/29

Our Reference: NAMI/L/1776/13

Director of Intellectual Property
Intellectual Property Department
25/F, Wu Chung House
213 Queen's Road East
Hong Kong

Dear Sir/Madam,

Consultation on Regulation of Patent Agency Services

With reference to your letter dated 27 May 2013, please could you refer to our comments on the subject at attachment.

Thank you for your attention in this matter.

Yours truly,

Grace Leung

Department of Operations

Comments from NAMI on Regulation of Patent Agency Services

Possible Interim Measures

Regulated Patent agency profession

It is considered necessary to draw up and publish a list or register of patent agents with their qualifications for public information as inventors/owners of inventions can select the most suitable and qualified patent agents or attorney. Inventors will need the comfort that the list is reliable, and eventually backed by regulations and professional ethics.

These patent agents or attorneys should be registered or accredited from the designated patent offices from UK (The United Kingdom Patent Office), Europe (European Patent Office) or China (State Intellectual Property Office of China at the interim stage. The information to be provided should include Name, Offices(s) Location(s), Registration Number, Technical background and specialties etc. The provision of such information can be entirely voluntary at this preliminary stage.

It is considered appropriate for the Intellectual Property Department to administer the patent agency list and the information to be published on the web such as the homepage of the Intellectual Property Department. However, it is considered appropriate to have an administrative arrangement at this stage. The issue whether it should be backed by law will be subject to experience from the trial preliminary stage, prevailing relevant ordinance such as those regarding protection of personal data.

Control on use of titles

Like other overseas jurisdictions, there should be control over the use of titles without restricting the provision of service. However, it must be apparent to users who is a registered agency and who is not.

Qualified persons or firms should be registered or accredited through examinations from legal patent offices in China or other parts of the world and Hong Kong (eventually). It is also considered that during the interim stage, foreign qualifications and accreditation can serve as reference while for the longer term, there should be an indigenous system in Hong Kong.

Indigenous System

The indigenous system should be administered by bodies like the Institute of Engineers, the Hong Kong Institute of Certified Public Accountants etc. Setting up educational programs can be done through various educational institutes etc.

The relevant institute may set up code of ethics to monitor the service and professional discipline. The use of the registration renewal system may serve as a safeguard for standards.

Patent attorneys being the subject of numerous complaints on integrity, failing to observe confidentiality, accused of overcharging etc. should be disqualified. Perhaps a scoring system can be established in this regard.

Interim measures : existing patent attorney services:

It is considered necessary to have a grandfathering arrangement for existing service providers to facilitate their transition to the new regulatory regime. The criteria to be adopted will be service history and qualifications. The parties benefiting from the grandfather arrangement should be allowed to use the same titles as qualified persons or firms and provide a full range of regulated service since their qualifications are equivalent to the parties being accredited under the new system.

It is also considered that the grandfathering arrangement may only be existent for a certain period of time say, around 5 years after the new indigenous system is in place.

Implementation Timetable:

The list or register of patent agents with qualifications can be introduced before the OGP system. Indeed, the ultimate goal of regulating the provision of services should only be considered until there is sufficient experience in the operations and requirements of the new OGP system so that any Ordinance so enacted for the purpose could be more comprehensive and meaningful.

Other considerations

It is considered that the patent application fees for Hong Kong patents should be affordable for most of the applicants. An effective patent system for Hong Kong should be user friendly and in alignment with the established patent protection system of other economies such as China and US. The quality and professional discipline of patent attorney services should also be monitored and upheld through the use of a registration system as well as accredited examinations.

NAMI Secretariat
May 2013