

Dear Mr. Cheung,

**RE: Consultation on Regulation of Patent Agency Services**

It is very encouraging to realize that the HKSAR Government is not only taking a proactive approach to further improve the current patent system in Hong Kong, but also willing to listen to the community.

Regarding OGP and short-term patent system, I am delighted to hear that the HKSAR Government is going to introduce OGP and keep the short-term patent system. I believe that the Advisory Committee has many foreign examples that can follow for introducing OGP. Therefore, I am not going to discuss further here.

For matters in relation to the regulation of patent agency services, the interest of the Hong Kong business communities and residents should be above those who are providing patent services and those who want to provide patent services in the future. In my opinion, the biggest challenges for Hong Kong business communities and residents in filing patents are cost and quality.

The more patent service providers are available in Hong Kong, the lower patent cost should be. The HKSAR Government should encourage more people to join the patent industry. However, quality should be improved. Given the unique business environment in Hong Kong, patent service providers should be able to master Chinese and English languages in order to help the Hong Kong business communities and residents to file patent applications in China, the US and EU. Patent professionals should have at least a university degree in science and technology.

Below is my response to each specific question raised in the letter issued by IPD on 20 March 2013.

4.a. i.	Should we draw up and publish a list of register patent agents with qualifications for public information as a first step?	Yes
4.a. 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?	Entirely voluntary. As for interim stage, let the market decide who is providing what.
4.a. 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?	Intellectual Property Department. Should be an administrative arrangement in order to have this list be published as soon as possible.
4.b.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?	If time permits (before 2016), the use of titles should be controlled. Otherwise, this should be implemented in the next stage.

4.b.ii	What specific titles should be controlled?	“Patent Attorney”, “Patent Lawyer”, “Patent Solicitor”, “Patent Agent”, and “Patent Engineer”.
4.b.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?	<p>Should be examination based in Hong Kong patent law and Patent Cooperation Treaty (“PCT”). This is because under the new regime, it is very likely for Hong Kong inventors and patent assignees to file a Hong Kong or PCT application first. When filing for foreign and/or mainland patent applications, the patent applications will be passed to foreign patent attorneys/agents to handle.</p> <p>The idea of accredited courses is a good one. But will be likely to subject to abuse and controversy when it is found that quality of courses cannot be maintained.</p> <p>For example, for doctors, teachers, real-estate agents and insurance agents, they are required to pass specific examinations. I do not see any reason why Hong Kong patent professionals should be treated differently from other professionals.</p> <p>The examination should be conducted in both Chinese and English due to unique needs of the business communities in Hong Kong.</p>
4.b.iv	Should we rely on foreign qualifications and accreditation, or should we establish an indigenous system?	<p>I believe the term “foreign” does not exclude mainland China. Unless (i) HKSAR Government is certain that foreign patent professionals are familiar with Hong Kong cases, Patents Ordinance (Cap 514) and Registered Design Ordinance (Cap. 522) and (ii) foreign countries are going to provide reciprocal recognition of future Hong Kong patent qualifications, HKSAR Government should not rely on foreign qualifications and accreditation.</p> <p>Just an example, will HKSAR Government recognize qualification of a real-estate agent based on the agent’s foreign real-estate qualifications and accreditation?</p>
4.c.i	How to administer the conferral of qualifications and accreditation of examinations and courses, and put in place the necessary education programmes?	<p>The HKSAR Government should only be responsible for the conferral of qualifications and accreditation of examinations. Patent professionals are mature adults and have received years of university educations. They know how to choose courses for the examinations or they may even study by themselves without taking courses. The HKSAR Government should concentrate its limited resources in the quality of the examinations.</p> <p>Just an example, does the EDB regulate what a tutoring center can teach?</p>
4.c.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)?	There are ample of precedents from foreign patent systems and local professional industries that IPD can follow. There is no need for me to discuss here.
4.c.iii	What party or parties should be entrusted to oversee profession and all these qualification, service and title matters?	IPD. There is no other body that has the expertise and reputation comparable to IPD in Hong Kong.
4.d.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?	I do not see any reason why such grandfathering should be allowed. A bad grandfather can still be a grandfather under the new regulatory regime. Even worse, if such grandfathering is allowed, a bad grandfather is deemed to be a good grandfather overnight. This may cause more harm. The alternative is examination because it is transparent and fair.

4.d.ii	Regarding the grandfathering arrangement, what are the criteria to be adopted, such as working experience, qualifications and training?	The grandfathering arrangement is subject to abuse, corruption and favour trading.
4.d.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?	A good grandfather may be deemed to be a bad grandfather and vice versa if there is such arrangement.  The saga of registration of traditional Chinese medical doctor in Hong Kong is a good example.
4.d.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, the grandfathering arrangement is subject to abuse, corruption and favour trading.
4.e.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?	The publication of list can be introduced before the OGP system.
4.e.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?	I would like to see OGP to be introduced as soon as possible and hopefully before 2016.  I do not see a strong correlation or dependency between the time to introduce OGP and the time to have an indigenous system to oversee the use of titles.
4.e.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.

Please feel free to contact if you or the Advisory Committee have any question.

Yours faithfully,



Kenneth Yip