The Hong Kong Institute of Trade Mark Practitioners
香港商標師公會

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Date: 31 May 2013

Our Ref: Our Ref: HTT:HKITMP:Patent 310513 (P)

CONFIDENTIAL

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

BY FAX & BY EMAIL & BY HAND

FAX No.:<2838-6276>
Email to: < patent_agency_consultation@ipd.gov.hk >

Dear Sirs

Re: **Consultation on Regulation of Patent Agency Services**
Hong Kong Institute of Trade Mark Practitioners ("HKITMP")

We refer to the letter issued by the Intellectual Property Department dated 20 March 2013, inviting the submission of views on how to take forward recommendations of the Advisory Committee in the Review of the Patent System in Hong Kong. Our comments are provided below.

HKITMP - BACKGROUND

1. Our institute, HKITMP, was formed in 1988 with the aim of protecting the interests of those who are engaged in the trade mark profession in Hong Kong. However, as many of our members are general intellectual property practitioners, who on a day-to-day basis engage in not only trade mark matters, but also copyright, patents and designs, the HKITMP's membership and its interests have evolved to cover all of these areas.

2. The HKITMP also has regular meetings with the Intellectual Property Department ("**IPD**") in Hong Kong, to exchange views and ideas on everyday practice, and to pass on recommendations for any changes in Hong Kong's intellectual property laws that may be required out of the practical issues arising in day-to-day practice.

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3. The HKITMP regularly circulates amongst its members with information about meetings with the IPD, IPD circulars on practice, details of seminars, and welcomes comments from its members about intellectual property law and practice in Hong Kong. The HKITMP acts as a conduit and sounding board, and helps to air views of the professionals in Hong Kong who actually engage in hands on trade mark, patent, copyright and other intellectual property works.

4. The HKITMP has previously been invited by the Government to provide comments on its paper on the Review of the Patent System.

5. This submission on behalf of the HKITMP has been prepared by the HKITMP's Patent Committee, who have particular expertise and practice in the field of Patents.

6. The views expressed are from a legal and policy perspective in our capacity as solicitors and intellectual property law practitioners, acting independently without regard to the views of any particular body or organization. Whilst restricted in the scope of our ability to comment, the comments we do have appear below.

Comments below are according to the enumerated paragraphs in the IPD letter, which have been extracted below for ease of reference.

REGULATION OF PATENT AGENCY SERVICES - POSSIBLE INTERIM MEASURES

(A) 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?

Provided clear, transparent and unambiguous criteria are formulated which govern the inclusion of "Patent Agents" or "Patent Attorneys" on the Register, an interim Register of Patent Agents/ Patent Attorneys could be prepared.

However, as the term "Patent Attorney" or "Patent Agent" is not presently a defined term or reserved title in Hong Kong, the Government needs to have certainty as to the meaning and interpretation of the relevant terms, and which title concerns eligibility to be on the register. This is because the terms "Patent Attorney" and "Patent Agent" can be used in different jurisdictions intechangeably for certain professionals, but there is some ambiguity in this practice in Hong Kong at present.

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However, creating an interim register before this important issue as to title, relevant qualifications and experience for persons holding themselves out to have such a title, experience requirements and work performed by persons having such title is decided is clearly undesirable.

Subject to the above, we have the following observations.

Having a list or register would allow members of the public to identify which individuals using the title/term "Patent Attorney" or "Patent Agent" have technical backgrounds, appropriate training under senior practitioners and additional qualifications in substantive aspects of patent practice.

A similar register is found in most countries, (see e.g.

- Europe http://www.epo.org/applying/online-services/representatives.html)
- China (see e.g. http://www.acpaa.cn/search_agent.asp)
- USA (see e.g. https://oedci.uspto.gov/OEDCI/query.jsp)

(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?

Once the Government has decided upon the designation of the relevant terms, and a register to run alongside it, we will provide substantive comments upon the format for the register. Some initial comments are below.

Hong Kong should have criteria for inclusion on the proposed list or register no lesser than those of major international trading partners such as the United States and China, and in view of shared law, similar to those of Commonwealth Common Law Jurisdictions such as Canada, Australia and United Kingdom whose law and precedent are directly applicable to Hong Kong.

In the interests of the public, and to ensure the integrity of the list, the standard required for inclusion should be no less stringent than for Patent Attorneys or Agents of the above jurisdictions. Furthermore, for Hong Kong to take the lead in the region for demonstrated competency and proficiency of its Patent Practitioners, it is submitted that a high standard be required for inclusion upon the list.

Subject to the above, we have the following observations.

Public Interest in having a high standard for inclusion on any proposed list or register is accentuated in view of the inherently "international" application of patent law, including

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the requirements that the law and practice of each country in respect of patents is compliant with the requirements under TRIPS and WTO.

It is appreciated by all parties involved with the patent process that a crucial aspect of patent practice for "Patent Attorneys" or "Patent Agents" is establishment of clients' rights in jurisdictions of commercial relevance to the client, not just one's own jurisdiction.

A qualified Patent Attorney or Patent Agent therefore must be in a position to advise on foreign filing strategy, which includes knowledge of allowable subject matter in different jurisdictions, relevant deadlines for effecting filing in different jurisdictions, knowledge of grace periods and translation deadlines, knowledge of types of patents in different jurisdictions, knowledge of examination criteria and prevailing practice in examination criteria for foreign jurisdictions, knowledge as to how to progress patents to grant using accelerated examination methodology where required, foreign legal requirements such as ownership, entitlement, assignment, certification of documents, legalization, notarization and apostillization where necessary, and be aware of deadlines required for furnishing of such documents.

Thus, patent law being "international" requires that "Patent Attorneys" or "Patent Agents" to have knowledge and experience in conducting patent matters in other jurisdictions, not only their own.

As such, the law which "Patent Attorneys" or "Patent Agents" practice has many international aspects and appropriate qualifications, knowledge, education and experience are paramount for "Patent Attorney" or "Patent Agent" practice.

Information demonstrating qualifications, experience and corresponding registrations should be mandatory, as optional provision of such information would dilute the effectiveness of the register.

Regardless of terms used to describe qualified patent practitioners, for people working in Intellectual Property, and for experienced members of the public and industry, throughout the world, in particular in the more developed jurisdictions the terms "Patent Attorney" and "Patent Agent" are generally understood by the public to connote the following:

(a) a person who is professionally competent to prepare patent specifications and secure patent rights;
(b) a person who has undertaken extensive training and supervision for qualification into the profession;
(c) a person who has qualifications to manage prosecution of patent applications in foreign jurisdictions;
(d) a person who has knowledge of foreign patent law and practice;

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(e) a person who can advise on aspects of patent practice, in particularly patent filing strategies, enforcement issues;
(f) a person who is formally qualified to perform the scope of work for which they practice;
(g) a person who is technically competent and professionally qualified in the areas of science or engineering;
(h) a person who has satisfied the registration requirements so as to be licensed to practice patent law within the area of professional and technical competency ;
(i) a person who is entered onto the relevant register of Patent Attorneys/Agents;
(j) a person who is a member or eligible for membership of the relevant Professional body of Patent Attorneys/Agents;
(k) a person who is eligible to act on behalf of clients before the national patents office in the jurisdiction in which qualification and registration has been obtained.

Whilst the scope of work performed by Patent Attorneys/Agents is determined by their professional and qualification standing, and may vary to an extent dependent upon which jurisdiction, due to the international aspect of patent practice by Patent Attorneys/Agents in comparison with generally local domestic practice conducted by solicitors, the above are key common skills and areas of professional competency held by professionally qualified Patent Attorneys/Agents in the large jurisdictions having the most established and advanced patent laws and practice.

Fees

It would also be useful to levy a fee for inclusion on the register. This fee could be set at an appropriate level so that it deters people who do not actually practice as Patent Attorneys or who do not have the necessary background, skills or experience from holding themselves out as such.

Details of Proposed Criteria

Accordingly, in view of the international aspect of patent practice, the highly technical nature of patent documents, international expectations as to competencies and in order to best serve the public and members of industries seeking patent protection from Hong Kong, Patent Attorneys or Agents included on any list should be required to have a high standard.

This is in keeping with the standard required in referable jurisdictions such as China, Europe and Australia.

Membership of a professional body of patent attorneys or patent agents must be viewed as connoting that a member is suitably qualified and experienced in the area of patent attorney practice, in particular patent specification drafting and preparation.

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The following provides an overview of the qualification in Europe to become a Patent Attorney. It is an onerous process, and requires candidates to have a high degree of knowledge as set out above.

*"To become a European Patent Attorney, you must **first** obtain a suitable qualification in the field of science and technology. Having obtained his/her qualification, the candidate must subsequently undergo a period of professional activity under the supervision of a professional representative or an employee, dealing with patent matters, of a European industrial concern. **The period for professional activity is three years.***

*Having completed the required period of professional activity candidates may then enrol to take the European qualifying examinations. These examinations comprise **four** written papers of between 3 ½ and 5+ hours long, held over a period of three days.*

Passing the examinations, either all at the same time or by passing individual papers over a period of several sittings, will then allow the individual to be qualified as a European Patent Attorney."[1]

It is worthwhile noting that it is necessary for candidates in Europe, BEFORE they even sit the Examinations in drafting to demonstrate they hold:

(a) scientific/technical qualification; and
(b) have completed 3 years training under a qualified European Attorney.

In passing the written examinations, European candidates are expected to demonstrate the following:

Article 13: Examination syllabus[2]

The examination shall establish whether a candidate has:
(1) a thorough knowledge of:
(a) European patent law as laid down in the EPC and any legislation relating to Community patents
(b) the Paris Convention (Articles 1 - 5 quarter and Article 11)
(c) the Patent Cooperation Treaty
(d) all decisions of the Enlarged Board of Appeal and EPO case law as specified in the IPREE, and

(2) a general knowledge of the national laws of:
(a) the contracting states to the extent that they apply to European patent applications and European patents

[1] http://www.patentepi.com/patentepi/en/EQE-and-Training/eqe-background-information.php
[2] http://www.patentepi.com/patentepi/en/EQE-and-Training/ree.php

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(b) the United States of America and Japan to the extent that they are of importance in connection with proceedings before the EPO.

China

Similar to the process in Europe, in China, candidates are required to

(a) first obtain a suitable qualification in the field of science and technology (generally a suitable qualification should be an at least four-year full-time degree in Science or Engineering);
(b) second undergo a two-year period of professional activity (in either technical industry or law service field); and
(c) subsequently: Pass Chinese Patent Agent Examinations.

Only once the above requirements are met can the candidates qualify as a Chinese Patent Attorney/Agent- (专利代理人).

In order to become a **Registered Chinese Patent Attorney/Agent**, the qualified Chinese Patent Attorney/Agent, after passing the Examinations, must undergo **another one-year period of patent training** under supervision of registered patent attorneys in a registered Chinese patent firm (this rule came into force as of April 2011).

The one-year period of training is required to be supported by a Statement of Skill by their supervising attorney and their patent firm.

During the one-year period of training, the qualified Chinese Patent Attorney/Agent is required to attend a **40-hour intensive patent training course** by All China Patent Attorney Association **followed by another exam of the course**.

To retain the registration, the Chinese Patent Attorney/Agent must practice in a registered Chinese patent firm. The registration will be cancelled when the individual is absent from the registered Chinese patent firm.

Again, it is worth noting that in China, as with Europe, the candidates must meet the following requirements, BEFORE they sit the Examinations:

(a) hold a full time four-year bachelor degree in science/engineering;
(b) have completed at least 2 years profession activity in technical or legal area.

In passing the examinations candidates are expected to demonstrate they have the following knowledge:

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(a) A thorough knowledge of:
  (i) China Patent Law;
  (ii) Patent and Design System and Process;
  (iii) Patent Filing and Patent Prosecution;
  (iv) Re-examination and Invalidation;
  (v) Enforcement and Projection;
  (vi) Patent Search and Patent Classification;

(b) A sound knowledge of:
  (vii) the Paris Convention;
  (viii) the Patent Cooperation Treaty;
  (ix) Locarno Agreement;
  (x) Strasbourg Agreement;

(c) A sound knowledge of the national IP laws of:
  (xi) Trademark Law;
  (xii) Copyright Law;
  (xiii) Anti-Unfair Competition Law;
  (xiv) Regulations on the protection of new varieties of plants;
  (xv) Regulations on the Protection of Layout-Designs of Integrated Circuits;
  (xvi) Regulation on the Customs Protection of Intellectual Property Rights;

(d) A general knowledge of the national laws of:
  (xvii) General Principles of the Civil Law;
  (xviii) Contract Law;
  (xix) Civil Litigation Law;
  (xx) Administration Law
  (xxi) Tort Law;
  (xxii) Criminal Law.

In addition to the knowledge test above, candidates are required to demonstrate the skills in patent drafting, patent prosecution, and patent invalidation in written examinations.

<u>Australia</u>

Turning to Commonwealth Common Law jurisdictions, Australia provides another applicable example of how individuals become qualified "Patent Attorneys" including technical qualifications, knowledge requirements, written examinations, employment and residency, as set out below. It is submitted that these requirements reflect the European requirements, and are easily separated into the various "head" outlined below.

In order to be able to use the term "Patent Attorney" in Australia, it is necessary for many requirements to be met. These requirements are set out in detail below, with further information and details available at the following URL: http://www.psb.gov.au/patreg.htm.

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- **Australia- Knowledge Requirements**

In order to become a Registered Australian Patent Attorney, it is necessary that the following knowledge be demonstrated, usually through examination by an accredited organisation or training facility.

"Foundation Papers"

(a) Legal Process and Overview of Intellectual Property;
(b) Professional Conduct;
(c) Trade Mark Law;
(d) Trade Mark Practice.

"Final Papers"

(e) Patent Law;
(f) Patent System;
(g) Drafting Patent Specifications;
(h) Interpretation and Validity of Patent Specifications;
(i) Designs.

Evidence that these knowledge requirements have been satisfied can be provided by accredited university post graduate courses, endorsed by relevant professional bodies of relevant jurisdictions.

- **Australia - Technical Qualifications**

In order to become registered as a Patent Attorney in Australia or China, it is mandatory that applicants have a recognised technical qualification in a field of patentable subject matter- typically in science or engineering. Inherently, patents are technical and legal documents with a highly specialised approach to interpretation and language.

In the absence of a technical qualification, an individual would likely experience difficulty in drafting and interpretation and validity of the patent specification, which are both fundamental skills of the patent attorney and the inverse of each other.

These skills are essential for the preparation and prosecution of substantive specifications to grant before substantively examining Patent Offices of various countries and which could potentially claim priority to a Hong Kong first filing specification.

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- **Australia - Employment Requirements**

Similar to lawyers, accountants, and other professional service providers, it is considered essential for the development of skills and understanding of any individuals specified as Patent Attorneys that they have a period of training and supervision under appropriately qualified attorneys.

In Australia, this period is a period of 2 years, and is supported by a Statement of Skill by their supervising Attorney.

- **Australia - Residency requirements**

All Australian Patent Attorneys should be demonstrably ordinarily resident in Australia.

Similar requirements should be applied in Hong Kong, to restrict the inclusion on the register of people who do not practice in Hong Kong, or who are absent from Hong Kong for an extended period.

A period of one or two years of continuous residency could be required, in order to demonstrate an ongoing commitment to working as a Patent Attorney in Hong Kong.

- **Australia Personal requirements**

To qualify for registration as an Australian Attorney, it is necessary to tender a statement of good fame and character.

Overall

As set out above, it can be seen that the qualification process in comparable and referable jurisdictions is a prolonged, intensive and intellectually demanding pathway.

A technical qualification is a pre-requisite, followed by demonstrable knowledge in patent law, practice, drafting, interpretation (passing a difficult examination) together with a period of supervised work placement, and ongoing training. There is no easy pathway in China, Europe or Australia to becoming a Patent Attorney/Agent.

Patents are technical and legal documents, with international aspects. As such, it is submitted that any Hong Kong Patent Attorney/Agent should be able to produce work as good as a practitioner from any other referable jurisdiction, such as Europe, China or Commonwealth Common Law countries such as Australia.

Finally, it is important to note that virtually all of the above jurisdictions require (practically and in some cases legally) demonstrated insurance cover. In order to ensure that the public are adequately protected and services are provided only by appropriately

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qualified persons, insurance cover may be an appropriate consideration.

(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?

In keeping with experiences of other countries, the IPD may be an appropriate body to administer the register. The major trading partners of Hong Kong (Europe, USA, China) each have relevant registers which are maintained by the respective patent offices of each country (as noted above).

Specific statutory or professional bodies (Professional Standards Board) in Australia and CIPA (Chartered Institute of Patent Attorneys) in the United Kingdom may also be responsible for maintaining and hosting the list or register at a national level.

Typically the register is maintained so as to be publicly accessible on the internet site of a hosting entity. However, the register should (ultimately) be backed up by legislation in order to provide credibility to the register. If the register is not supported/ restricted by legislation and is a purely administrative arrangement, then potentially such an arrangement would be open to abuse.

Accordingly, it is submitted that the legislation specify that only upon meeting of certain requirements which are fundamental to practice as a patent attorney, should an individuals' name be entered on the register.

Each year, members on the register could be required to pay a fee, confirm professional development has been undertaken and have appropriate insurance cover.

(B) The interim 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 (A) above?

To avoid confusion to the public, and enhance the quality of service delivery, it is proposed that titles should be controlled at the same time as the list or register is prepared.

In view of time for finalizing the criteria for inclusion on the register, and making the necessary legislative arrangements, it could be appropriate to restrict the usage of certain titles to individuals qualified by appropriate examination in overseas jurisdictions of relevance at least on an initial basis.

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Care must be taken to avoid inclusion of persons not appropriately qualified on the register, as this will result in a diminished worth to the overall register. In addition, it is submitted that "grandfathering" of practitioners onto the register should only be permitted where such individuals can demonstrate their skills are of an appropriate standard, through written examination, training, supervision and qualification in a referable jurisdiction.

To avoid confusion to the public, it is suggested it is preferable that the control over the use of titles, and the development of any register should be decided upon and proceed simultaneously. If either proceeds independently it will lead to uncertainty and potentially reduce the credibility of the overall register.

(ii) What specific titles should be controlled?

It is necessary to delineate between individuals qualified and experienced to conduct substantive drafting and procedural patent matters (who should be properly qualified and on any register) ("Patent Attorneys", "Patent Agents", "Agents for Patents" etc.) and those familiar with procedural and advisory aspects, who already (usually) have legal qualifications and are Hong Kong solicitors.

Whatever framework is adopted, the register should clearly specify details of the qualification, technical background, experience, jurisdiction of qualification and firm to enable the public to make an informed choice when working with a professional for their patent services, and to assist in distinguishing between the type of professional they are seeking.

(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?

This may depend on the nature of the register that the Government decides to implement, having regard to the patent system it wishes to maintain and/or implement. Nevertheless, it should allow for recognition of overseas qualifications and of local experience to a recognizable high standard, possibly through indigenous criteria.

It is noted that firms are not qualified to practice patents per se, however the individuals of the firms may be qualified patent practitioners.

It is presumed that in the absence of an appropriately registered and qualified practitioner potential liability could restrict firms wishing to engage in substantive

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patent services who do not retain appropriately qualified and registered practitioners. In any event, it would not be appropriate to enter firms on the register.

Hong Kong law is based upon Commonwealth Common Law, and this law, and relevant international common law precedents are likely to be applied in determination of infringement and validity issues which may come before Hong Kong Courts. However, Hong Kong is also a Special Administrative Region of China, under the "One Country, Two Systems" arrangement.

Accordingly, applicable qualifications could be found from Commonwealth Common Law Jurisdictions, and other jurisdictions where there are written drafting examinations such as Europe, Canada or so forth.

China qualified attorneys could be included on the register, however, due to significant differences in law practice between China and Hong Kong, it may be necessary to consider additional accreditation requirements for Chinese qualified attorneys.

It is of note that the United States requires patent attorneys to complete a multiple choice examination for qualifications, and does not require written drafting examination. In practice, however, insurance requirements and professional negligence liability ensures that individuals do not tend to practice substantive patent attorney drafting and prosecution without a long period of supervised training and experience under seasoned practitioners.

However, it is of paramount importance that should a regulatory regime be introduced that the standard in respect of such substantive services be of world class in keeping with Hong Kong's world class legal system and in keeping with the body of authoritative case which underpins the Hong Kong patents law and system.

Accordingly, if a regulatory regime is introduced in Hong Kong, for entry as a qualified person, it is paramount that:

(a) Practitioners have a professional tertiary technical degree in the engineering or science disciplines, in keeping with the requirements with Hong Kong's major trading partners, China, Europe and the US, all of which have stringent requirements in this matter. Such tertiary technical degrees must be awarded by merit and be at a high standard so as to enable practitioners to appropriately handle complex technologies, and not be honorary type degrees and not be simple post-graduate nominal technical courses. Any undergraduate engineering degrees or the like relied upon must at least meet the minimum requirement for entry into the recognised local professional engineering body.

(b) Practitioners must undergo stringent written patent drafting examinations, similarly as in the relevant Commonwealth common law jurisdictions, and not be

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of a compromised standard. The UK, Australia or New Zealand standard of examination is appropriate and in keeping with the law relevant to Hong Kong. Multiple guess drafting type examination must not be implemented.

(c) Practitioners providing substantive patent agency services must undergo a minimum training period of 2 years under the supervision of an appropriately trained and professionally qualified patent attorney/agent. This is paramount such that (i) the practical and vocational skills may be obtained; and (ii) so as not to expose the public to the risk of unqualified or inexperienced persons acting on their behalf.

(d) Any regulatory regime for substantive patent agency services introduced be supported by patent practitioners who:

(i) have established reputable, both locally and internationally, substantive patent agency practices;
(ii) are professionally qualified in jurisdictions having the patent law applicable to Hong Kong;
(iii) have qualifications in keeping with the above, importantly including appropriate tertiary technical qualifications;
(iv) have undergone substantial professional training; and
(v) have substantial experience in substantive patent matters on behalf of Hong Kong applicants for numerous year.

Actual qualified professional users of the existing patent system having substantial practical experience and knowledge in substantive patent matters in Hong Kong and internationally must be consulted, as the Hong Kong patent system and professionals acting in relation to the Hong Kong system must also act in keeping with established international standards of patent practitioners in the developed counties and major trading jurisdictions

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

See reply to **B(iii)**.

At first, it would be necessary to rely on foreign qualifications and accreditations, due to the relatively limited number of practitioners in Hong Kong.

It is important not to allow the register to only have a low barrier to inclusion merely to increase the numbers of practitioners on the register. If there is only a low barrier to inclusion on the register, it is anticipated that this will actually increase the danger to the

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public by being misled through the inclusion of inappropriate persons on the register. This is because any register lends authenticity to persons entered on that register, in view of the difficulties that public may have in assessing the skills and competency of persons drafting and prosecuting patents.

By nature of the profession itself, Patent Attorneys/Agents who draft and prosecute patent applications are highly skilled, trained and qualified by examination, and have a unique set of specialized skills. Typically, there is not a large number of practitioners in most jurisdictions.

It may be possible to establish an indigenous system, although it would require a significant investment of resources in training, appropriate regulation and examinations. If such a system were established, where courses were offered, such courses would need experienced practitioners to provide feedback and development of candidates, to ensure that the standard of practitioners are comparable on an international stage.

As patents are inherently international technical/legal documents, it is important that any indigenous pathway to qualification prepares candidates to the level expected on the international stage. If candidates assessed through a low quality examination system are held out to be of an appropriate standard, then this will have highly detrimental effects for the persons engaging such applicants to prepare patents on their behalf in Hong Kong and internationally.

In addition, the limited number of experienced practitioners available to provide on the job training could pose some difficulty to applicants attempting to develop their skills.

Just as solicitors are required to complete a period of apprenticeship to develop their skills, Patent Attorneys must complete a period of time in which they are supervised in all aspects of their work. Claim drafting is a process which takes many years to gain confidence and familiarity, and to avoid claims of inappropriate scope.

Even seasoned practitioners must regularly practice their claim drafting skills, through prosecution, amendment and the actual preparation of specifications. Ongoing development through peer review of claims is also an essential part of the learning process for all attorneys.

It is anticipated that it may take some time for a sufficient number of candidates of appropriate quality to develop to justify indigenous training program, particularly in view of the timeline envisaged for the proposed introduction of an Originally Granted Patent ("**OGP**").

In the interim, there are a multitude of options available to persons wishing to become Patent Attorneys/Agents, including obtaining qualifications from other jurisdictions, including Europe, UK, China and Australia.

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As such, if appropriately qualified persons of relevant jurisdictions, having the requisite experience and technical foundations are able to be entered onto a register in Hong Kong, this may provide a more rigorous, higher quality register than attempting to implement an indigenous system at the outset.

The process of becoming a Patent Attorney/Agents requires many years of training, including on the job experience and a unique set of skills. The output of the exercise of these skills can and is judged internationally by Patent Attorneys/Agents qualified in other jurisdictions. Accordingly, it is important that practitioners qualified in Hong Kong can demonstrably meet international standards in substantive aspects of patent prosecution and drafting.

It may be possible to establish an indigenous qualification system in due course, depending on the uptake of the OGP. If there is a demonstrable need, with a significant number of local filings for the OGP, then it may be opportune to consider establishment of an indigenous qualification system.

However, establishing a second rate qualification for a limited number of candidates, solely to increase the numbers of people on the register to a certain number or quota will compromise the effectiveness of any register. Inclusion of persons without adequate qualifications/experience/training/ apprenticeship on the register will give the public the impression that such persons reach the minimum standard for the highly international profession of Patent Attorney/Agents, which they do not.

This could have serious consequences for the public, including potential loss of rights, compromised and inadequate intellectual property protection, and a dilution of Hong Kong's reputation for its service industries.

(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?

It is assumed the conferral of qualifications and titles, being part of the goal of ensuring only "qualified" persons or firms provide certain patent services, is part of a wider goal of maintaining a minimum standard for the provision of patent services for the protection of the public.

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Assuming that a minimum standard is to be upheld, any minimum standard can only be met by ensuring only appropriately qualified, experienced and insured professionals are accredited.

These are important issues to be addressed but are entirely inappropriate to be dealt with as "interim" measures.

In deciding whether to implement education programmes, regard must be had to the anticipated level of demand for such programmes. It is likely that unless there is significant uptake of the Hong Kong originating patent, there would be insufficient demand to justify the level of investment required to produce appropriately qualified professionals.

It would be important to ensure if overseas universities were engaged to provide courses in conjunction with local institutions, that current graduates from the overseas universities are accepted by the local patent attorney profession as reaching an appropriate standard. There are universities that purport to offer courses, which are not recognized by professional organisations of Patent Attorney/Agent professionals in their own jurisdictions. It would be dangerous for Hong Kong to allow such universities to develop its patent practitioners with sub-par skills, which are below the standard of their own jurisdiction.

In jurisdictions such as Europe, United States, Australia and Canada there are university level postgraduate programmes offering courses for applicants. Typically, these courses are offered to candidates already working or training as patent attorneys or agents in organisations, although individual stand-alone programmes may also be offered.

(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)?

In reputable jurisdictions, this is largely self regulating through various professional associations which can exclude members from that organization for breaches of rules of ethics or codes of conduct. Typically, senior members of the profession hear complaints which may be raised against practitioner members of the organization.

If the complaints are egregious in nature, further professional sanctions may apply to the individuals who are in breach of ethics/standards.

Demonstrably negligent advice, preparation of specifications without reasonable care or skill, misrepresentation as to competency, failure to manage conflict of interest or discharge of professional advice without reasonable care or skill could be examples of

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conditions which could lead to a patent practitioner being estopped from using a (regulated) title.

Such sanctions could only be imposed after rules of natural justice observed, before an appropriate body, including members of the legal profession and professionally qualified Patent Attorneys or Agents able to guide the body in the determination of an appropriate professional standard.

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

A committee formed by representatives of the leading patent firms in Hong Kong, solicitors and barristers working in the intellectual property area, an IPD representative could be formed as an ethics or disciplinary committee. They could meet on an annual/ bi-annual basis (or as needed) to consider any complaints raised in respect of persons included on the register.

The decisions of such a committee would be inherently administrative in nature and appeal could lie to the appropriate courts.

Any umbrella organization overseeing the profession with input from the appropriately qualified persons of such umbrella organization could potentially be involved in this oversight.

(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?

To ensure that the register has an integrity, it is important that the extent of grandfathering (if there is any) is limited. If there is grandfathering, the persons grandfathered should be of a high standard, which should be maintained by rigorous examination processes and assessment for any indigenous qualifications. It is inappropriate to set the bar low initially, and raise it subsequently.

It is important to ensure that only appropriately experienced, qualified and trained individuals who draft and prosecute applications are entered on any register related to such services – and any grandfathering be limited to those individuals who can demonstrably meet appropriate criteria of training (and usually foreign accreditation).

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Guidance should be sought from the experiences in jurisdictions such as Singapore which initially provided a "grandfathering" arrangement for people who did not have appropriate tertiary technical qualifications and whose standard of patent drafting would not meet the requisite level for the above Commonwealth common law jurisdictions. Experience has shown confusion to public regarding level of competency as well as unqualified persons holding out to draft patent specifications, thus placing the public at risk.

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

If any grandfathering is permitted, it must be fair, defensible and accept practitioners who have appropriate technical qualifications, experience, knowledge of the appropriate law and possibly who have passed an examination for drafting. As noted above, it is critical that any register for these with patent drafting skills, for example, is not used to lend false authenticity to persons who are not appropriately skilled, qualified or experienced.

(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?

As has been identified, there is confusion on the use of the terms "Patent Agent" and "Patent Attorney". What these terms mean needs to be determined first, and if there is to be a register of "Patent Agents"/"Patent Attorneys" for that term to be clear as to its meaning. The grandfathering can then be determined.

(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?

This can be commented upon once further details are known.

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.

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(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 - A list of Patent Attorneys/Agents and qualifications could be drawn up at an early stage, but only if appropriate framework is implemented as noted above.

(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 - Control of the titles should be introduced before the OGP system, in order to avoid confusion to the public and unqualified persons holding out to be Patent Attorneys/Agents.

(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?

The OGP system and regulation are not necessarily interlinked, and are separate questions which should be addressed separately.

FURTHER VIEWS ON THE OGP SYSTEM AND REFINEMENTS TO THE SHORT TERM PATENT SYSTEM (Item 6 of IPD's letter of 20 March 2013)

As set out in our earlier submission, it is the opinion of the members of the institute that there are a number of factors which should be considered in the implementation of OGP system.

As previously stated, legal requirements of other countries, motivation, timing and costs considerations may significantly impede any uptake of the OGP system, and it remains to be seen if there is sufficient demand to justify the expense of implementation and consultative process.

Yours faithfully

The Hong Kong Institute of Trade Mark Practitioners