SUBMISSION

IN RESPONSE TO

CONSULTATION ON REGULATION OF PATENT AGENCY SERVICES (HK IPD LETTER IPD/1009/29 OF 20 MARCH 2013)

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31 May 2013

This submission is in response to the HK IPD letter IPD/1009/29 of 20 March 2013 titled Consultation on Regulation of Patent Agency Services ("the IPD letter").

I will deal with item 4(b) of the IPD letter first since the information in response to this item provides background to item 4(a).

4(b)(i) and (ii) – Control of Titles

The titles of "patent attorney" and "patent agent" should be controlled. All of the major jurisdictions including China, the EPC member states, US, UK, Australia, New Zealand, and Singapore, control the use of these titles.

Furthermore, these titles are understood by most as defining a specific profession having a particular set of technical skills. This is especially the case for clients (including applicants and foreign patent attorneys/agents) seeking patent attorney/agent services from jurisdictions where these titles are controlled. Where this is not the case, such as with some members of the public in jurisdictions where the titles are not controlled (e.g. Hong Kong), it is at least generally assumed that the titles denote a specific type of professional with certain skills, even if it is not known what these skills are exactly. In any case, a quick internet search will reveal details.

At the very least, it would be expected that a practitioner holding such titles would possess technical skills in substantive patent law, procedure, and practice, including specification and claim drafting, rendering validity and infringement opinions, dealing with examination reports and other prosecution tasks leading to the grant of patent rights. Importantly, it would also be expected that title holders would have a technical degree or equivalent qualification in an area of technology subject to patenting.

If these titles are not controlled, then those practitioners without the appropriate skills would be free to use these titles. The result would be that clients seeking the services of patent attorneys/agents could end up engaging practitioners without appropriate skills even though the practitioners represented themselves as holding these titles.

The concerns regarding a decrease in choice and an increase in fees resulting from a regime where these titles are controlled are unfounded in my opinion, as these can be mitigated depending on how the regime is structured and introduced. In any case, the concerns and additional costs involved in having an unregulated regime and inappropriately qualified practitioners far outweigh the perceived concerns of implementing a controlled regime.

The above titles should be controlled from some point before the eventual move to an OGP system. Sufficient lead time is required to educate the public of the exact scope of skills of professionals holding these titles before the OGP system commences, at which time it will be too late to do so.

However, it is too early at this immediate point in time to do so. As discussed in the response below to 4(b)(iii) and (iv) of the IPD letter, ultimately, the criteria for qualified persons should be set by an indigenous system for qualifying practitioners to use the titles of "patent attorney" and "patent agent". As such, this will depend on the final form of Hong Kong patent law, since as discussed below, practitioners should be qualified by examination in the context of substantive Hong Kong patent law. The final form of Hong Kong patent law is at present unknown in view of the intended move to an OGP system. It would also be inefficient and cause confusion to the public to put in place a regime for controlling titles at this point if this regime needed to be changed later due to changes in the law.

Nevertheless, if a decision is made to proceed immediately with interim measures for controlling titles, then the section below titled "Possible Interim Measures" provides views on such measures.

4(b)(iii) and (iv) – Criteria for Qualification under Controlled Titles

Ultimately, the criteria for qualified persons should be set by an indigenous system for qualifying practitioners to use the titles of "patent attorney" and "patent agent".

Patent attorneys/agents should possess technical skills in substantive patent law, procedure, and practice, including specification and claim drafting, searching, rendering validity and infringement opinions, dealing with examination reports and other prosecution tasks leading to the grant of patent rights, and advising on enforcement, ownership issues, filing and prosecution strategy, and any other issue under Hong Kong patent law. Patent attorneys/agents should also have at least a working knowledge of patent law, procedure, and practice in the major overseas jurisdictions and be able to advise in this regard where appropriate.

As a minimum, the criteria should include:

- a tertiary degree or equivalent qualification in an area of technology subject to patenting, such as a tertiary degree in engineering or science;
- written examinations (not multiple-choice type tests) in substantive patent law, patent procedure and practice (including prosecution), patent specification and claim drafting (including amendments during prosecution), rendering validity and infringement opinions, foreign patent systems;
- practical experience in the work of a patent attorney/agent under the supervision of a currently registered patent attorney/agent for a prescribed period of time, say, 3 years.

Hong Kong intends to eventually move to an OGP system which will require changes to Hong Kong patent law. Therefore, the final form of Hong Kong patent law is unknown at present, and as such, it is not possible to settle on the details of the criteria for qualification at the present stage. However, although the detailed content of the criteria cannot be settled, my view is that the broad scheme described above for the minimum criteria would apply regardless.

"Patent Attorney" vs "Patent Agent"

The criteria for qualification as a patent attorney/agent define a separate and distinct class of professional. Whether the title is "patent attorney" or "patent agent", the practitioner will need to meet the criteria, such as those set out in the response to 4(b)(iii) and (iv) above, to achieve qualification. My view is that only one title should be adopted. (My preference would be "patent attorney" since the term "attorney" more accurately describes a practitioner who actively advocates for a client, including for example presenting argument to secure a broad claim scope, rather than an "agent" which may be seen as one who facilitates the meeting of formalities in an administrative-type process.)

As such, practitioners who hold other qualifications, such as solicitors and barristers, will also need to meet the same criteria. Such practitioners will in essence be dual-qualified. A solicitor who also qualifies as a patent attorney/agent will be able to practice as both a solicitor and a patent attorney/agent. This is the case in most major jurisdictions.

In the US, the titles are used in a slightly different way but the effect is the same as above. A US "patent attorney" must satisfy the same criteria as a US "patent agent", including the

possession of a tertiary degree or equivalent in an area of technology, such as an engineering or science degree. The only difference is that a US "patent attorney" also holds a law degree and bar membership. This clarification is important since there may be a misconception that a US "patent attorney" qualifies based on different criteria.

It would not make much sense to prescribe different criteria based on a practitioner's other qualifications. Nor would it make sense to carve up the scope of work of a patent attorney/agent as set out in the response to 4(b)(iii) and (iv) above. For example, it would not make sense to restrict patent attorney/agent work to say drafting, and to have lawyers advising on validity and infringement. The scope of work of a patent attorney/agent as set out in the response to 4(b)(iii) and (iv) above is intertwined and based on an integrated body of knowledge of patent law, procedure and practice. Drafting is undertaken with the knowledge of legal tests for validity and infringement. Validity and infringement opinions cannot be formulated without technical knowledge of the field of technology of the subject matter of the patent specification. Therefore, a lawyer without having met the criteria for a patent attorney/agent, such as those set out in the response to 4(b)(iii) and (iv) above, including having a tertiary degree such as an engineering or science degree, would not be properly qualified to give validity and infringement advice in the scheme set out above.

Having prior standing in one of the criteria is a separate matter. For example, a foreign qualified patent attorney/agent may meet one or more criteria if he/she has been qualified to the same or higher standard in respect of equivalent criteria overseas. In particular, present Hong Kong patent law is based on UK patent law and follows UK patent case law precedent. Therefore, a qualified patent attorney in a Commonwealth common law country which also has a UK patent law heritage could meet the examination criteria and be exempt from taking some local examinations based on prior standing if Hong Kong patent law were to still rely on UK patent case law. As another example, if a local lawyer has undertaken a Hong Kong law degree course that sufficiently covers substantive Hong Kong patent law, then the local lawyer could be exempt from taking the substantive patent law examination based on prior standing. However, exemptions based on prior standing do not change the requirement that a patent attorney/agent must meet the single set of criteria for qualification, such as those set out in the response to 4(b)(iii) and (iv) above.

Possible Interim Measures

As stated above, my view is that is too early at this stage to put in place a regime to control titles.

However, if the decision were made to put in place interim measures immediately, then the titles should be reserved for those practitioners who closely match the criteria set out in the response to 4(b)(iii) and (iv) above.

The present Hong Kong patent law finds its roots in UK patent law and follows UK patent case law. Amongst the many specific examples, the UK case Catnic Components Ltd. and Another v. Hill & Smith Ltd. [1982] RPC 183 provides authority in Hong Kong cases for the principles of claim construction. The UK case Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd [1985] RPC 59 provides authority in Hong Kong for the determination of inventive step.

As well as being examined and proficient in UK patent case law, UK qualified patent attorneys must have a tertiary degree in an area of technology. Therefore, UK qualified patent attorneys would closely meet the criteria set out in the response to 4(b)(iii) and (iv) above provided they have the required period of practical experience.

Qualified patent attorneys/agents from other "Commonwealth" common law jurisdictions, such as Australia, New Zealand, Singapore, are also examined and proficient in UK case law. For example, Australian patent attorneys must undertake formal courses in patent law which cover much of the UK case law, including the examples above, relied upon by Hong Kong courts. Patent attorneys/agents in Australia, New Zealand, and Singapore must all have a tertiary degree in an area of technology. Therefore, patent attorneys from these jurisdictions would closely meet the criteria set out in the response to 4(b)(iii) and (iv) above provided they have the required period of practical experience.

Therefore, if use of the titles "patent attorney" and "patent agent" were to be controlled then practitioners holding the above foreign qualifications could be qualified to use the titles.

A dominant majority of the Hong Kong IP industry has historically been made up of Hong Kong qualified lawyers. However, since the Hong Kong patent system is predominantly a re-registration system, most of the work undertaken by Hong Kong lawyers has been re-registration of patents from the designated foreign patent offices. Part of any immediate interim measure could be to exclude this type of re-registration work from the scope of work prescribed under the controlled titles, such as set out in the response to 4(b)(iii) and (iv) above. Those who have undertaken re-registration work would therefore be able to continue to do so. Importantly, however, substantive patent work such as drafting and validity and infringement advice would be restricted to those using the controlled titles, thereby ensuring a high level of competence is applied to this substantive work.

Notwithstanding this proposal, all work including re-registration work should eventually fall under the scope of those qualified to use the controlled titles in a fully-fledged system. Although, re-registration work normally only involves issues of formality, substantive issues sometimes arise. For example, during enforcement, validity and infringement advice would be sought. Therefore, only appropriately qualified practitioners, such as those qualifying under the criteria set out in the response to 4(b)(iii) and (iv) above, should undertake re-registration work. It would be incongruous for an unqualified practitioner to perform the initial re-registration work and then expect the client to then seek out another practitioner when substantive work arises.

4(a) – Interim List/Register

There should be a published register of patent attorneys/agents.

However, until there is a settled definition of a patent attorney/agent, how would it be possible to compile such a register in the interim?

4(a)(ii) poses the question of what criteria should be used for inclusion on the interim list/register. However, the process of resolving this question would necessarily be the same as the process of resolving the questions under 4(b)(iii) and (iv). That is, the resolution of the issues under item 4(b) will lead to a definition of patent attorney/agent and facilitate the drawing up of a register.

Otherwise, how could the interim list/register proposed under 4(a) be a list/register of "patent agents"?

If the interim list/register simply lists practitioners with their qualifications, it is questionable as to what value that may provide. In fact, such a list may lead the public to believe that those practitioners are somehow qualified to practice as patent attorneys/agents in Hong Kong, unless it is explicitly noted that this is not the case. Then you would still have the issue of what criteria will be used to determine inclusion on the interim list/register. This may

cause difficulties later if the criteria formulated for the interim list/register is different to the criteria that is eventually settled for the titles of “patent attorney” and/or “patent agent”.

4(c) and (d) – Implications and “Grandfathering”

The questions under items 4(c) and (d) have been addressed under the section above titled “Possible Interim Measures”, provided that it is decided to put in place immediate interim measures.

Otherwise, if we are to wait until there is more clarity regarding the proposed changes to Hong Kong patent law in the context of a move to an OGP system, then I am in general agreement with the views set out in the submission by APAA Hong Kong in response to the IPD letter in respect of items 4(c) and (d).

4(e) – Implementation Timetable

The issues under item 4(e) of the IPD letter in respect of timing have been addressed above.

Additional Comments

I strongly support the establishment of a regulatory regime for patent agency services of a high international standard in line with the views expressed above.

Over the years of working as a patent attorney in Hong Kong, I have had a number of clients come to me with concerns regarding patent work undertaken by practitioners without formal qualifications in patent law, procedure, and practice, including practitioners that are Hong Kong solicitors. This includes the drafting of patent specifications where claims include a large number of unnecessary features and limitations, that is, the claims were drafted so narrowly as to provide no practical commercial value. Other common issues include drafting that does not take into account patent practice in overseas jurisdictions where, for example, the requirements for support for claims and claim amendments are different. There have also been instances where practitioners unfamiliar with patent procedure locally and overseas have failed to advise of deadlines resulting in an irrevocable loss of rights.

A regulatory regime should avoid these unfortunate situations and ensure that the public is provided with patent agency services of world’s best practice.

Such a regulatory regime will also provide strong support for the development of Hong Kong as a knowledge economy and IP trading hub based on robust IP rights.

- END OF SUBMISSION -