

I am a trainee patent attorney working at Deacons since 2010. I have an engineering background (advance diploma of Electrical and Computer Engineer with 3 years technical experience in engineering industry), and completed a Postgraduate Certificate of Intellectual Property at Bournemouth University in the U.K. which exempts me from the JEB Foundations Exams (P1, P5, P7, Law, Designs & Copyrights). I am currently enrolled as an Associate member of The Chartered Institute of Patent Attorney - a professional body of Patent Attorneys/Agents in U.K.

It has been brought to my attention that the Hong Kong government is inviting and consulting the views on how to take forward recommendations of the Advisory Committee in the Review of the Patent System in Hong Kong.

The term "patent attorney" or "patent agent" is not quite defined in Hong Kong, the Government needs to ascertain the meaning and interpretation of the relevant terms before concerning the eligibility to be on the register.

In seeking the best interest to the public, a register shall include the patent practitioners having (i) solid technical tertiary education (i.e. degree of engineering or natural science), and technical experience as optional, (ii) adequate and appropriate training under a professional patent attorney (iii) additional qualifications in substantial patent practice. All three pre-requisites shall be considered collectively in order to be qualified as a patent attorney.

Current Scope of Work

- (i) Review technical specification/publications in field of electrical and mechanical engineering.
- (ii) Formulate technical response to the Office Action issued by Examiners in the U.S., and China.
- (iii) Understand the invention objections and the commercial interest/considerations from clients in order to provide appropriate advice on patent portfolio.
- (iii) Assist in cases regarding Freedom to Operate by conducting relevant patent searches.
- (iv) Advise on aspects of patent and design practice, in particular filing strategies.
- (v) Technical translation review and interpretation.

In view of the substantially technical nature of work that a patent attorney performs, together with routine legal consideration while handling cases, it is paramount pre-requisite for a person being technically competent in the areas of real science or engineering prior to pursuing to be patent attorney.

The person is then required to receive appropriate and adequate training through specialised IP coursework AND practice in patent field under supervision of a Senior patent attorney. There is no shortcut in pursuing to be a professional patent attorney.

Due to the historical origins, Hong Kong is based upon common law inherent from British supremacy, which such a legal system provides relevant international common law precedents for Hong Kong judiciary to follow in deciding infringement and validity cases coming forth.

And in the meantime Hong Kong is also a Special Administrative Region of China, under the practice of "One County, two systems".

Accordingly, we could have looked upon the professional qualification in both Common law jurisdictions, and in China when determining accreditation requirements in order to define Patent Attorney/Agent applicable in Hong Kong.

Please refer to the link below:

UK Patent Attorney qualification (refer to CIPA)

<http://www.cipa.org.uk/pages/about-careers>

Chinese Patent Attorney (refer Hong Kong IPD)

http://www.ipd.gov.hk/eng/news/news/national_qualification_exam_arrangements_hk_macao.pdf

In developing Hong Kong as a regional innovation and technology hub in Asia, we need to align with the international standard in both the aspects of patent law and the regulatory regime for the patent practitioners. It is of paramount importance to keep Hong Kong's legal system, in terms of patent practice, with world class standard.