

**Marks&Clerk Hong Kong**  
**麥仕奇 香港**

Patent and Trade Mark Attorneys

Level 9, Cyberport 1, 100 Cyberport Road, Pok Fu Lam, Hong Kong

Tel: +852 2526 6345 Fax: +852 2810 0791

Tel: +852 2526 5654 Fax: +852 2868 5438

hongkong@marks-clerk.com www.marks-clerk.com



The Director of Intellectual Property  
 Intellectual Property Department, the  
 HKSAR Government  
 25<sup>th</sup> Floor, Wu Chung House  
 213 Queen's Road East  
 Wanchai  
 Hong Kong

**BY EMAIL ONLY**

**Your Email:** patent\_agent\_consultation@ipd.gov.hk  
**Our Email:** hongkong@marks-clerk.com

This email letter is intended for the stated recipient only. If you have received this email in error, please destroy it and inform us by return email: hongkong@marks-clerk.com

7 June 2013

Dear Sir,

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

This is a response to the letter of 20 March 2013 from the Director of Intellectual Property seeking views in relation to the regulation of patent attorney services in Hong Kong.

*Brief introduction to Marks & Clerk*

Marks & Clerk is the leading and largest firm of patent and trade mark attorneys in the UK and one of the leading firms in Europe. We have 90 partners and 600 people in 19 offices worldwide. We have been consistently ranked a top tier firm for patent and trade mark services in the UK by Managing Intellectual Property's (MIP) independent worldwide IP survey and the Legal 500 Chambers directories.

The Hong Kong office of Marks & Clerk was established in 1984 and is one of the oldest specialist intellectual property practices in Hong Kong. In November 2007, Marks & Clerk merged its business with the Lloyd Wise Group giving the combined firms unparalleled representation and IP resources in Hong Kong and South-East Asia. We have been ranked as a leading firm in Hong Kong for patent-related service.

*Marks & Clerk's response to the Director's letter*

*(a) Early recognition of a regulated patent attorney profession*

Marks & Clerk fully supports the regulation of patent agency services in Hong Kong and the establishment a register of patent agents. However, we do not support the establishment of an interim register.

An important feature of any register or regulated profession is protection of the public. The public must be able to have confidence that persons appearing on any register of patent agents,

especially one established or promoted by a Government agency, are competent to handle patent applications and patent-related services and are subject to regulation as to their competence and conduct. We fail to see how such public interest can be met until appropriate qualification criteria and a regulatory framework are established.

Furthermore, in the absence of appropriate criteria and a regulatory framework any list of patent agents supported by the Administration must inevitably have very board criteria for inclusion otherwise it could be open to allegations of unfairness, discrimination or cronyism. Such a list could be more open to misuse and might have the consequence of weakening public confidence in future permanent measures.

It is difficult to see how an interim register would work without adequate regulation or what benefits it might confer ahead of the establishment of a permanent register. Indeed, an interim register is likely to have more drawbacks than benefits.

*(b) Controlling the use of titles*

We believe that for the protection of the public the use of titles that infer or imply competency in the handling of patent applications and patent-related services should be restricted to suitably qualified persons.

The terms 'patent attorney' and 'patent agent' are controlled and used differently in different jurisdictions to denote persons having specialised qualifications to handle patent applications and patent-related services. The different controls on the use of such titles in the UK and USA have been cited by some quarters in relation to the current Government review. However, such comments and comparisons are open to misunderstanding due to the different regulatory regimes in these two countries.

In the UK anyone may act as an "agent" for another person in applying for a patent; however, only persons on the register of patent agents may describe themselves as a "patent agent" or a "patent attorney". The term "patent attorney" may also be used in reference to a solicitor.

In the USA, only persons registered to practice before the United States Patent and Trade Mark Office (USPTO) may act as an "agent" for another person in applying for a patent. To be registered with the USPTO a candidate must hold a relevant technical qualification and pass a qualifying examination. Anyone meeting these requirements may be registered as a "patent agent". Anyone meeting these requirements and who is also an attorney (a lawyer) may be registered as a "patent attorney".

It is, in our view, too early to judge how such titles should be controlled in Hong Kong as this will follow directly from the form of the regulatory framework that is implemented here.

However, we do not believe that any control or prohibition on the use of titles should be introduced as an interim measure, but rather should be established together with a full set of appropriate qualification criteria and a regulatory framework.

*(c) Establishing an indigenous qualification system*

Marks & Clerk has engaged in the training of numerous local university graduates and supported them in their quest to become registered patent attorneys in foreign jurisdictions. Messrs Eric Lam and Chin Wah Tsang of our firm were respectively the first and second Hong Kong people to qualify as registered patent attorneys in the UK. Other trainees of our firm have gained patent attorney qualifications in Mainland China, the UK and Australia.

We fully support the establishment of an internationally credible indigenous patent attorney qualification. We foresee that any indigenous patent attorney qualification will go hand-in-hand with a register of patent agents and will set a baseline for inclusion on the register. Accordingly, an indigenous patent attorney qualification should set minimum criteria for establishing competency to handle patent applications and patent-related services for other people.

Given the complexity of patent documents and the technical and legal skills required to competently handle patent applications and patent-related services we foresee that, in common with many relevant foreign jurisdictions, such criteria must include, *inter alia*:-

- a minimum level of academic qualification or experience in a relevant technical field;
- the passing of a minimum set of qualifying examinations in subjects, such as domestic and foreign patent law, design law, copyright law, trademark law, patent drafting, patent interpretation, and patent attorney practice.
- satisfactory completion of a minimum period of full-time practice in the field of intellectual property, including substantial experience in patent attorney work, under the supervision of suitably qualified person.

It will take considerably longer to establish a proficient local qualification system than it will to establish a register of patent agents. We are of the view that any new regime should therefore include a transitional period in which local trainees qualifying as registered patent attorneys in a relevant foreign jurisdiction could be entered onto a register of patent agents in Hong Kong.

*(d) Matters relating to existing patent agencies services*

It is inevitable that any new system for the regulation of patent agents will include grandfathering. There will be differing views among stakeholders as to what form such grandfathering should take. We foresee that, like control of titles, grandfathering will follow directly from the form of the regulatory framework that is implemented in Hong Kong, and therefore it is difficult at this stage to predict what form grandfathering should take or what criteria should apply.

Whatever form grandfathering does take, we are of the firm view that for the protection of the public only persons who are able to demonstrate that they have attained the necessary qualifications and experience to handle competently all aspects of patent applications and patent-related services for others should be suitable candidates for grandfathering onto a register of patent agents. A person should not be eligible to be grandfathered merely because

they hold, for example, a qualification as a general legal practitioner with no specialised patent related knowledge or experience.

*(e) Timetable*

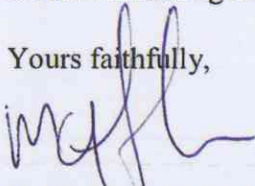
We disagree with the Director's comment that "considerable time is needed to build up a local patent agency profession".

The Hong Kong Group of the Asian Patent Attorneys Association (APAA) was established in 1974 and has many local members. Marks & Clerk opened its office in Hong Kong in 1984. There are now numerous patent firms and foreign qualified patent attorneys in Hong Kong who together with APAA and the Hong Kong legal profession have been providing Hong Kong with professional patent agency services for at least 30 years.

Hong Kong is already well served with patent practitioners and we do not believe that the introduction of the regulatory regime for patent agency services must be linked to the introduction of an original grant patent (OGP).

The patent attorney profession has expanded rapidly in Hong Kong in recent years and the unregulated environment has led to the establishment of several different self-governing associations that purport to be representative of sections of the profession. This is already giving rise to confusion with the public and with some overseas patent professionals. The introduction of an OGP might simply exacerbate the confusion in the currently unregulated environment. Our view is that the government should fully consider the regulatory regime before embarking on any changes to the patent grant system itself.

Yours faithfully,



**MARKS & CLERK HONG KONG**