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20 March 2013

Dear Sir/Madam,

Consultation on Regulation of Patent Agency Services

In February 2013, the Government announced the way forward for the development of the patent system in Hong Kong after accepting a report¹ (the “Report”) submitted by the Advisory Committee on Review of the Patent System in Hong Kong (the “Advisory Committee”). I am writing to invite your views on how best we could take forward the recommendations regarding the regulation of patent agency services.

Overview

2. The main recommendations of the Report are -

- (a) to introduce an “original grant” patent (“OGP”) system with substantive examination outsourced to other patent office(s) whilst retaining the current re-registration system (Chapter 3);
- (b) to retain the short-term patent system with suitable refinements (Chapter 4); and
- (c) to develop a full-fledged regulatory regime on patent agency services in the long run, which has to be achieved in stages, with possible interim measures (Chapter 5).

3. Based on the recommendations, the Government would work out the detailed implementation plan in consultation with the Advisory Committee. We welcome early views from stakeholders to help the Advisory Committee in its ensuing deliberations. The input will be particularly important for mapping out the way forward to introduce measures to regulate patent agency services, bearing in mind the ultimate goals of

¹ A copy of the Report can be viewed at or downloaded from the website of the Intellectual Property Department (www.ipd.gov.hk).

permitting only qualified persons or firms to provide patent-related services² and use particular titles such as “patent agents” and “patent attorneys”³.

Regulation of patent agency services

4. The proposed regulation of patent agency services should help build a local patent profession and nurture a talent pool to complement the introduction of an OGP system and refinements to the short-term patent system. The considerations and recommendations are set out in Chapter 5 of the Report (excerpt enclosed). To implement the recommendations we need to address a number of issues, in particular, the following -

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?
 - (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?
 - (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?
- (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 sub-paragraph (a) above?
 - (ii) What specific titles should be controlled?
 - (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?
 - (iv) Should we rely on foreign qualifications and accreditation, or should we establish an indigenous system?
- (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.

² Option A in Chapter 5. Given the recommendation to retain the re-registration system, the Advisory Committee is of the view that regulating only services involving technical expertise is preferred to regulating all patent-related services in the first instance.

³ Option B in Chapter 5.

- (i) How to administer the conferral of qualifications and accreditation of examinations and courses, and put in place the necessary education programmes?
- (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)?
- (iii) What party or parties should be entrusted to oversee the profession and all these qualification, service and title matters?
- (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?
 - (ii) Regarding the grandfathering arrangement, what are the criteria to be adopted, such as working experience, qualifications and training?
 - (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?
 - (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?

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.
 - (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?
 - (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?
 - (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?

How to respond

5. You are invited to provide your views on or before 31 May 2013 through post, email or fax -

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6. Meanwhile, if you have related views on the implementation of the OGP system and refinements to the short-term patent system, you may also let us know by the same deadline.

7. We may publish your submission or a summary in response to this consultation for public viewing, together with your name or your affiliation (or both). If you do not wish to disclose your identity in such a way, please state so when making your submission.

8. Any party providing personal data in the submission will have the rights of access and correction with respect to such personal data. Any requests for data access or correction should be made in writing.

9. We look forward to hearing from you soon.

Yours faithfully,



(Peter K F CHEUNG)
Director of Intellectual Property