

**Submissions in respect of  
Consultation Paper Regarding  
Review of the Patent System in  
Hong Kong**

**PROFESSIONALLY QUALIFIED  
PATENT ATTORNEYS  
CURRENTLY PRACTICING  
IN HONG KONG**

**30 DECEMBER 2011**

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## **Introduction**

### **A. RESPONSE TO REQUEST FROM GOVERNMENT**

This is the response and submission from a group of Professionally Qualified and Registered Patent Attorneys practicing substantive patent law in Hong Kong to the Request from the Government of the Special Administration Region of Hong Kong on Review of the Patent System in Hong Kong.

The signatories of this submission are Professionally Qualified and Registered Patent Attorneys who have practiced substantive patent law for a number of years in Hong Kong in firms in Hong Kong having longstanding substantive patent attorney/agent services in Hong

The signatories of this submission, as with the significant majority of Professionally Qualified Patent Attorneys in Hong Kong, are members of the Hong Kong Chapter of Asian Patent Attorneys Association, the officially recognised group in Hong Kong in respect of patent services and regarding representation and assistance to the Hong Kong Intellectual Property Department.

The signatories of this submission are in substantial agreement with submissions provided by Hong Kong Asian Patent Attorneys Association (APAA) in respect of Standard Patent System (Chapter 1) and Short-Term Patent System (Chapter 2) regarding the Request from the Government. As such, the predominant focus of this submission is in respect of Chapter 3 "Regulation of Patent Agency Services in Hong"

Whilst the views presently submitted are in a personal capacity by the signatories, in view of the professional standing of the signatories in the Hong Kong Patent Attorney Profession, it is considered that the views as submitted are in keeping with those having established and reputable substantive patent practices in Hong Kong.

### **B. CURRENT AND PAST PATENT ATTORNEY PRACTICE IN HONG KONG**

Although there has been some suggestions by some that there does not exist a patent professional services industry in Hong Kong, this is not the case and such comments are not reflective of the true nature of professional patent agency / Patent attorney services currently present and historically in Hong Kong.

Professionally qualified Patent Attorneys currently practicing in Hong Kong and the firms in which they practice, have acted for Hong Kong entities in respect of patent agency services for several decades in Hong Kong

The publicly available records, both in respect of local patent practice as well as records in respect of patent rights pursued in foreign jurisdictions, clearly

demonstrate that this is not the case and demonstrate that Hong Kong entities have indeed been served locally for many years in relation to professional patent services.

Although no formal qualification of a "Hong Kong Patent Attorney" exists at present, for many years professional patent attorney services have been provided in Hong Kong to local industry, local Hong Kong universities, government organizations and foreign clients, by professionally qualified and registered Patent Attorneys. Again, such information is freely and publicly available.

Such patent attorneys historically have generally held formal professional qualifications in commonwealth /common law jurisdictions, the patent law directly applicable to that of Hong Kong, have the requisite tertiary technical qualifications and have undertaken several years of professional training under qualified patent attorneys.

The majority of professionally qualified Patent Attorneys, upon meeting the requisite membership requirements, are members of Asian Patent Attorneys Association (APAA) Hong Kong chapter, along with the majority of other established Intellectual Property (IP) practitioners in Hong Kong, including IP lawyers, IP litigators, trade mark practitioners, IP licensing lawyers and the like.

APAA has various sub-committees, including the patents sub-committee of which all members are qualified patent attorneys, and regularly meets with the Hong Kong Intellectual Property Department (IPD) as the recognised industry representative group. As such APAA Hong Kong has historically been considered the professional representative body of qualified patent attorneys in Hong Kong.

### **C. CONCERNS REGARDING PROPONENTS FOR CHANGES TO PATENTS LEGISLATION AND REGULATION OF PATENT AGENCY SERVICES**

The signatories of this submission have concerns as to the level of understanding, qualifications, experience and understanding of some proponents who advocate changes to patents legislation and regulation of patent agency services in Hong Kong, and appropriateness and correctness of comments and suggestions which have been made publicly leading up to the present submission.

Patent law and the patent system are international in nature, and any patent system must be in keeping with international patent treaties including WTO and TRIPS, and a local patent system must correctly interface with the locally applicable jurisprudence which supports the patent system, as well as interface with the international patent system and prevailing trends from a global standpoint.

In the years 2009 and 2010, other smaller societies claiming to be the representative groups of Patent Attorneys in Hong Kong have formed, and also hold out to be professional bodies involved in qualification and regulation of the patent attorney profession in Hong Kong.

Some such societies are clearly not representative of the patent profession in Hong Kong, and many of the council members and members of such societies:

- (i) do not hold any formal professional qualification as patent attorneys in commonwealth/common law jurisdictions,
- (ii) have not undertaken formal qualifications or training as patent attorneys of patent agents,
- (iii) do not have the requisite tertiary technical qualifications as required in the major jurisdictions such as Europe, US and China, and
- (iv) do not have sufficient experience or knowledge in patent practice either locally or internationally so as to hold views which could be considered representative of the Hong Kong patent agency profession.

Regardless, such societies hold themselves out to be representative of the Hong Kong professional patent services providers both locally and internationally, and unlike in other jurisdictions whereby members of a patent professional body member must be suitably qualified and experienced, such societies do not require such a standard.

Accordingly, confusion exists as to the actual qualifications, experience and importantly competency of members exists. This poses serious risks to the public.

The majority of professionally qualified Patent Attorneys who are members of APAA have not joined these societies for reasons including concern of substandard membership requirements.

Further, professionally qualified Patent Attorneys of APAA have expressed concern in respect of these societies from a public policy standpoint, both locally and internationally, in that persons not suitably qualified, trained or experienced would be holding out to the public as being patent attorneys, a misrepresentation and risk that association with such societies in their current form is deemed inappropriate.

#### **D. CREDIBILITY AND AUTHORITY OF PRESENT VIEWS SUBMITTED**

The signatories of this submission are all Professionally Qualified Patent Attorneys who practice substantive patent law in Hong Kong on behalf of both Hong Kong and foreign entities.

The signatories of this submission are considered leading Professionally Qualified Patent Attorneys in Hong Kong, and whose views are representative of those having established and reputable substantive patent practices in Hong Kong.

The signatories of these submissions are Professionally Qualified Patent Attorneys who:

- (a) have received their Qualifications and Registrations in jurisdictions having the applicable patent law to that of Hong Kong, that being the common law system

- (b) have practiced substantive patent practice in Hong Kong for a number of years, and have much experience in substantive patent practice in Hong Kong
- (c) practice patent law at the firms in Hong Kong having the long established reputable patent practices in Hong Kong
- (d) practice patent law at the firms in Hong Kong having the greatest entries in the Hong Kong Patents Register as "Address for Service", due to the volume of foreign originating patent applications, due to the recognition of the professional competency of such practitioners
- (e) act on behalf of the majority of Hong Kong universities, government and semi-government research organisations, Hong Kong proprietors and manufactures, and private organisations
- (f) are members of the Hong Kong Chapter of Asian Patent Attorneys Association (APAA), the organisation to which the majority of professionally qualified patent attorneys belong
- (g) are or have been on representative committees of recognised professional institutes and societies including APAA, Hong Kong Institute of Trade Mark Practitioners
- (e) are regularly invited to speak and provide seminars at professional and research organisations in Hong Kong
- (f) practice patent law at the firms on the Open Tender awarded panels of various universities and research organisations in Hong Kong
- (g) practice patent law at the Hong Kong firms which have had Professionally Qualified Patent Attorneys "on staff" in Hong Kong servicing Hong Kong clients for some thirty years
- (h) practice at firms which have for many years been committed to training and education of Hong Kong people as patent practitioners in Hong Kong
- (i) practice at firms who are routinely identified as firms having the leading substantive patent practices in Hong Kong by the Internationally most credible rankings and annual surveys by entities such as "Managing Intellectual Property", a Euromoney publication.

#### **E. PROFESSIONAL QUALIFICATIONS & EXPERIENCE OF SIGNATORIES**

The signatories of the present submission are Professionally Qualified and Registered Patent Attorneys who have gained Qualification and Registration as Professional Patent Attorneys and have earned their professional qualification by way of at least:

- (i) mandatory award of a recognised tertiary technical degree from a recognised university, in the technical fields of engineering or science

- (ii) passed written examination (not multiple choice) in relation to national patent law applicable to Hong Kong, in relation to International patent law and in relation to national patent law in major trading jurisdictions
- (ii) passed written examination (not multiple choice) in respect of the paramount skills of “Patent Specification Drafting” and “Validity and Infringement of Patent Specifications”
- (iv) undertaken intensive trainee apprenticeship / articles under the direct supervision of a qualified and Registered Patent Attorney in a jurisdiction having the law applicable to that of Hong Kong for several years prior to their own Registration
- (v) having received requisite recommendation for Registration and entry onto the official Registers in their jurisdictions of registration, by a Qualified and Registered Patent Attorney.

#### **F. SIGNATORIES OF SUBMISSION**

The Signatories of this submission are the following professionally qualified Patent Attorneys:

Timothy J. Letters, Laurence Thoo, Jeffrey McLean, James Wan, Michael Flint, Owen Gee, Michael Lin, Tsang Chin Wah

A summary of the professional qualifications of the signatories are provided as attached at **Annexure A**, as well as brief resume summarising skills, qualifications and experience.



# **CHAPTER 1**

## **Standard Patent System**

### **SUMMARY**

#### **A. EXISTING HONG KONG PATENT SYSTEM**

The Hong Kong patent system, by basing patents as “re-registrations” of UK, European and Chinese patents which have undergone full substantive examination, offers a high degree of presumption of validity of patents on the patents Register.

Internationally, the Hong Kong patent system is respected, due to the significant body of case law upon which the patent law is based, coupled with the high presumption of validity of patents.

Further, the Hong Kong patents system affords applicants the right to “first file” in Hong Kong by way of the Hong Kong Short-term patent, so as to establish priority for foreign application.

#### **B. RECENT CHANGES TO CHINESE LAW – INFLUENCE IN HONG KONG**

The recently introduced codified national security requirements under Chinese patent law stipulates that patent applications for inventions completed in China must be first filed at the Chinese Patent Office.

Many Hong Kong entities perform a portion of their research and development in China, as well as collaborative research projects. Such applicants must now effect “first filing” in China.

#### **C. CHANGES TO HONG KONG PATENT SYSTEM AND PRACTICE**

Changes to the Chinese law is likely to result in less “first filings” in Hong Kong, and hence less importance of establishment of a “20 year first filing” patent in Hong Kong accordingly.

Furthermore, with the growing trend of national patent offices looking more to “International Examination” as well as the “Patent Prosecution Highway”, even less need exists for substantive examination to be conducted on patents in Hong Kong.

Expansion of the patent system could include a “20 year patent” which could be a “first filing”, “convention filing” or “national phase filing”, however in view of the reputation of the Hong Kong patent system as it currently stands, inclusion and expansion of “Modified Examination” would be more appropriate and maintain the high presumption of validity.

In any event, any changes to the Hong Kong patent system which reduced the presumption of validity and increased pollution of the Register with invalid patents such as an over prevalence of Utility Models, would lose the well established international respect of the Hong Kong patent system.

## **1. Current Hong Kong Patent Registration System**

At present, the Hong Kong patent system is a re-registration system based upon a designated patent, the designated patent being defined as a UK, European or Chinese patent.

### **1.1 EXAMINATION AND PRESUMPTION OF VALIDITY**

As Hong Kong is a "re-registration" system based upon jurisdictions which typically have a high level of requirement for substantive examination, the UK, European and Chinese Patent Offices all having a high requirement for substantive matters, in particular those pertaining to support and enablement requirements, result in a high presumption of validity of Hong Kong patents due to substantive (i.e. novelty and inventiveness) issues being examined by experienced and credible

The applicable body of case law in Hong Kong is that of traditional UK patent law, and an extensive and expansive body of law exists and is applicable to Hong Kong patents. Furthermore, the Hong Kong legal system, common law, in conjunction with the sophistication of the relevant body, affords patentees with confidence should validity and/or enforcement issues arise.

### **1.2 CURRENT "FIRST FILING" IN HONG KONG AND SHORT-TERM PATENTS**

At present, Hong Kong does not offer a "first filing" for a standard 20-year patent, however a "first filing" so as to establish priority in Hong Kong exists by way of a Hong Kong short-term patent, this patent having a maximum term of 8 years.

As such, Hong Kong patentees may establish priority in their own jurisdiction expeditiously and inexpensively, and the Hong Kong application can serve the basis of filing either foreign applications or a PCT international type application.

Although Hong Kong patent protection is generally obtained by way of a re-registered designated patent, the opportunity also exists to pursue patent rights by way of a convention application into Hong Kong as a Hong Kong short-term patent, thus providing intermediate protection for patentees between the time of filing the Hong Kong short-term patent up until when a full-term standard patent of the same patent family ultimately is pursued in Hong Kong.

### **1.3 ADVANTAGES OF CURRENT HONG KONG PATENT SYSTEM**

In view of the above, the Hong Kong patent system, as it presently stands:-

- (i) provides Hong Kong applicants with the opportunity to expeditiously and inexpensively establish priority in their own jurisdiction, in both the English and Chinese languages;
- (ii) offers a patent system which provides a high presumption of validity, of patents;
- (iii) offers a credible and well-established body of case law a credible patent system *per se*, to foreign and commercial applicants;

- (iv) provides the possibility to obtain intermediate protection until a standard patent is granted in Hong Kong for foreign applicants.

#### 1.4 PRESUMPTION OF VALIDITY COMPARISON WITH CHINA (PRC)

By comparison, the Chinese patent system includes a "utility model" patent (unlike other major jurisdictions such as US and Europe), this utility model not undergoing substantive examination (i.e. not being assessed for novelty and/or inventiveness) and proceeding to registration relatively quickly.

Problems with such a utility model include:-

- (i) a large volume of very poorly drafted patents on the Chinese Register (drafted by both applicant and patent agents), which introduces uncertainty in interpretation and/or scope;
- (ii) a large volume of patents for which the validity is questionable, as well as patents which are invalid for at least lack of novelty;
- (iii) uncertainty to the public, both local and foreign, as to what patent rights may or may not exist in China.

However, by contrast, the Hong Kong patent system, by relying on grant and thus validity from credible substantive examination, ensures that the Hong Kong Patents Registry:-

- (a) is not polluted by poorly drafted patent specifications
- (b) is not polluted by a large volume of invalid patents
- (c) provides good and reliable information as to proprietary rights in Hong Kong.

## 2. Potential Future Hong Kong Patent System

It has been suggested that it may be convenient for Hong Kong applicants to be able to "first file" a "standard" (i.e. 20-year) patent application in Hong Kong so as to (a) establish priority conveniently and (b) have full 20-year patent rights in Hong Kong.

Such a "first filing" system would generally only be utilized by Hong Kong applicants, as foreign applicants generally would not obtain any legal or commercial gain by establishing priority in Hong Kong.

However, whether such a patent system would, in practical terms, be utilized to the extent some may suggest, requires some consideration in light of how the patent system works, as well as conflict with codified provisions in Chinese patent legislation.

### 2.1 HONG KONG "FIRST FILING" 20-YEAR PATENT

Furthermore, a "first filing" Hong Kong patent would need to undergo substantive examination (i.e. examination for novelty and inventiveness), to progress to grant. However, any such substantive examination, if so required, would need to be at a

standard not lower than the standard of examination for which the existing re-registration system is based upon.

Thus, should a Hong Kong "first filing" patent system be established, it would be imperative that the purity of the register be maintained so as to maintain a high presumption of validity as currently offered by the existing Hong Kong re-registration system. This is very much in the public interest, for both local and foreign entities.

It must be understood that the vast majority of Hong Kong patents are not first filing originating patents, but are national applications based upon foreign originating multi-jurisdictional patent portfolios.

At present, there is a high presumption of validity of these patents and a high respect for (a) the validity of Hong Kong patents and (b) the applicable body of law associated with such patents. This, at all costs, must not be jeopardized.

## **2.2 MODIFIED EXAMINATION**

Many jurisdictions, either formally or informally, provide a "modified examination" patent system which essentially allows applicants to designate a foreign patent upon which a local patent is to be pursued, and upon grant of that foreign patent, the local patent also progresses to grant.

Jurisdictions which either formally or informally have a "modified examination" generally base the approved patents on specific jurisdictions in which a high quality or level of substantive examination is conducted.

Countries typically relied upon for modified examination include UK, Europe, US, Japan, Australia, Canada and New Zealand, as these Patent Offices have substantial experience in conducting substantive examination.

## **2.3 POTENTIAL LOCAL SUBSTANTIVE EXAMINATION IN HONG KONG**

The requirement for establishment of a Patent Office which conducts substantive examination, is a very onerous and large task. Typically, Patent Offices which conduct substantive examination, have numerous Examiners who undergo vigorous and detailed training, and such Patent Offices are very long-established in relation to this matter.

Furthermore, jurisdictions in which substantive examination is conducted, generally are those with a relatively large population and large customer base for the patent system.

Jurisdictions, such as Singapore, established "substantive examination" almost 10 years ago, however in reality, the examination is either based upon the examination report of an international PCT application, or the substantive examination (if local examination is in fact requested by applicant) is outsourced to the Australian Patent Office predominantly in any event.

Other jurisdictions in Asia which conduct substantive examination, ultimately are persuaded quite readily by the grant of a patent in a jurisdiction in which substantive examination has been conducted and sufficient experience exists, and in fact is a de facto modified examination in any event.

Furthermore, several Patent Offices which hold out to conduct substantive examination, particularly those in the Asia region, will not conduct examination until they see progression of an application in examination in another jurisdiction and simply base the examination report on that of the European, UK or US Patent Office.

#### 2.4 PRACTICAL IMPLICATIONS OF HONG KONG "FIRST FILING"

Typically, a Hong Kong "first filing" patent would only be utilized by Hong Kong applicants, as there is no commercial or legal advantage in a foreign applicant establishing priority in Hong Kong.

To what extent a Hong Kong "first filing" system would be used, there is significantly doubt for the following reasons:-

- (a) Under the amended Chinese patent law, as of 1 October 2010, it has been clarified that "*an invention completed in China*" must satisfy the national security technology clearance requirements, thus must effectively be first filed in China. Jail terms may apply for breach of this requirement under the national security legislation.
- (b) As to what "*invention completed in China*" means, it is considered that any invention research or development, for which a substantial or reasonable portion was done in China, must effectively be first filed in China. Please note, non-compliance with this law is a breach of national security legislation in China, and may result in prison sentence.
- (c) Typically, Hong Kong applicants who manufacture in China, although a portion of the invention may be conceived or derived in Hong Kong, will have a substantial or reasonable portion of the invention contributed to in their manufacturing and research facilities in China. As such, Hong Kong proprietors will still have to effect filing first in China effectively, irrespective of whether a "first filing" or OGP system applied in Hong Kong.
- (d) Collaborative research conducted between hospitals, universities and the like in China and Hong Kong, will require the "first filing" to be effected in China so as to satisfy the national security clearance requirements.

Thus, for a "first filing" only Hong Kong applicants whose invention has not at all received an input in PRC would be able to legally utilize such a system for "first filing". In any event, Hong Kong applicants who may fall into this category can already utilize the Hong Kong short-term for establishing priority in any event.

Thus, in view of all of the above, in practical terms it is difficult to consider that a prevailing reason for having a Hong Kong stand alone 20-year patent is for the purpose of “first filing”.

## 2.5 FURTHER COMMENTS

As to whether substantive examination is conducted in Hong Kong, in view of the above foreshadowed limited utilization of a 20-year Hong Kong “first filing” patent in Hong Kong, and in view of the relatively small population of Hong Kong (i.e. those who would be likely to request substantive examination in Hong Kong of a first filed patent), it would not seem logistically plausible or economic to have the Hong Kong Patents Registry conducted substantive examination.

Whilst a “stand alone” 20-year patent for Hong Kong may be of use and of commercial interest to both local applicants, but most likely also foreign applicants, such a patent may possibly be able to be utilized as a “convention” or a “PCT national phase” application.

However, in respect of the substantive examination aspect, this would have to be outsourced similarly as in the relatively recently introduced Singaporean patent examination system.

A logical suggestion to the Hong Kong patent system, which would not undermine the integrity and respectability of the Registry from a substantive standpoint, may be as follows:-

- (i) introduction of a full 20-year Hong Kong standard patent, which may be filed either as a “first filing”, Paris Convention filing, or PCT national phase filing;
- (ii) have such a patent as a “modified examination” patent, utilizing the existing “designated” patent jurisdictions of China, UK and Europe, and in addition include further jurisdictions which are considered of creditability from substantive aspects of examination of patents. The above would maintain the respectability and creditability of the Hong Kong patent system, would satisfy local applicants’ requirements (if indeed practically possible) to effect first filing in Hong Kong, and be more in line with other jurisdictions such as Singapore.

It should be noted that jurisdictions are tending to base examination more on the results of searches and reports of “international PCT applications” and as such, movement towards a reliance on local examination system in a small jurisdiction would in fact be contrary to trends of other PCT and WTO member countries, and would appear counter-productive, counter-intuitive, and potentially lowering of the standard, integrity and credibility of the Hong Kong patents register in respect of the validity of the patents thereon.

**(a) *What benefits will an OGP system bring to Hong Kong? Will an OGP system promote local innovation and enhance patent quality?***

An OGP system in Hong Kong is likely to be used by few Hong Kong entities for who such a first filing is allowable and also of any commercial relevance.

Those who draft and prosecute patents on behalf of Hong Kong entities will appreciate that Hong Kong rights are not necessarily applicable to every applicant's commercial objectives.

The benefits which an OGP system could potentially provide could be enhanced public awareness of patents and Intellectual Property Rights, which could in some manner remind the public of "innovation".

**However an OGP alone would not promote local innovation.**

The introduction of an OGP system in Hong Kong would not increase the quality of Hong Kong patents.

Currently Hong Kong patents are granted based upon the grant from three internationally respectable patent offices, the European Patent Office, the UK Patent Office, and in more recent times the State Intellectual Property Office.

If there was OGP and examination was outsourced to another patent office, such an office would therefore have to be of superior quality that the European Patent Office, the UK Patent Office, or the Chinese Patent Office (SIPO).

In view of these offices providing high quality examination, and in view of to the signatories' knowledge no founded criticism of the quality of Hong Kong patents (actually the opposite), **it is impossible to see how OGP could conceivably increase the quality of Hong Kong patents.**

**(b) *Will there be sufficient demand to support an OGP system in Hong Kong? Will it be a cost-effective system?***

In view that only local entities likely to use OPG (provided re-registration is maintained in some form), restrictions on filing and Hong Kong being a small population and many Hong Kong entities not having commercial interest in Hong Kong, **it is very unlikely that OGP would be extensively utilised.**

***Sufficient Demand?***

Again, although some in Hong Kong are representing the necessity of OGP, the signatories in their substantial experience over many years acting for Hong Kong entities as Professionally Qualified Patent Attorneys:

- (i) are yet to have any Hong Kong local clients who pursue patent rights suggest that OGP would be of any benefit to them.
- (ii) are yet to hear any foreign clients suggesting OGP would be of benefit to foreign applicants of Hong Kong patents.
- (iii) are yet to hear any Professionally Qualified Patent Attorneys provide any coherent argument as to how OGP could help Hong Kong applicants from a commercial or financial standpoint.

By contrast, those advocating for changes to the Hong Kong patent system do not appear to be practitioners having any substantive patent practice, are not professionally qualified patent attorneys, and are not Hong Kong entities having any real substantial IP or patent portfolio experience.

### ***Cost Effective System?***

The signatories of this submission have much experience and knowledge on the real costs of patent prosecution under substantive examination.

The signatories are also well aware of the expense of OGP in jurisdictions which outsource examination, such as Singapore.

Regarding cost effectiveness, if an OGP system was introduced so as to replace the existing "re-registration" system:

- (i) costs would increase significantly
- (ii) number of filings would decrease.

Any suggestion that the number of patent applications filed in Hong Kong would be maintained if (a) OGP was introduced and (b) re-registration was abolished and hence Hong Kong would then financially benefit by suggesting this would create a substantive patent profession in Hong Kong, should not be seriously considered.

### ***(c) Should we introduce an OGP system in Hong Kong with substantive examination outsourced to other patent office(s), and, if so, which office(s) and why?***

If introduced in Hong Kong, substantive examination would need to be outsourced to other patent offices from a practical standpoint.

If re-registration still existed, then there would be so little demand for OGP that Hong Kong could not viably set up a substantive examining division.

If such outsourcing was to offices other than those currently utilised for "re-registration", then the strength of a Hong Kong patent would decrease.



The patent offices which could be used are the USPTO, European Patent Office, SIPO, UK Patent Office, Australian Patent Office and Japanese Patent Office.

However, in view that:

- (i) three of these are effectively used already giving high presumption of validity,
- (ii) the Australian Patent Office won't do it as it has already cut off Singapore, &
- (iii) new establishment of OGP is not an international trend,

It seems unlikely that such examination would alter the Hong Kong patent worth.

- (d) ***Irrespective of the answers to (c) above, should the current "re-registration" system be maintained, and, if so, should the system be modified as appropriate, including expansion to recognize the patents granted by other jurisdiction(s), and, if so, which jurisdiction(s)?***

With the growing trend of national patent offices looking more to "International Examination" as well as the "Patent Prosecution Highway", even less need exists for substantive examination to be conducted on patents in Hong Kong.

Expansion of the patent system could include a "20 year patent" which could be a "first filing", "convention filing" or "national phase filing", however in view of the reputation of the Hong Kong patent system as it currently stands, inclusion and expansion of "Modified Examination" would be more appropriate and maintain the high presumption of validity.

In any event, any changes to the Hong Kong patent system which reduced the presumption of validity and increased pollution of the Register with invalid patents such as an over prevalence of Utility Models, would lose the well established international respect of the Hong Kong patent system.

# CHAPTER 2

## Short-Term Patent System

- (f) Should we retain the current short-term patent system in its existing form, or should we introduce changes to the system? If the latter, what sort of changes should be introduced?**

A Hong Kong Short-term patent should be retained within the Hong Kong patent system.

The Short-term patent, when utilised professionally with the guidance of a Professionally Qualified Patent Attorney, offers several advantages including:

- (i) early enforcement
- (ii) ease and cost effectiveness of establishment of priority
- (iii) defensive purposes
- (iv) customer confidence
- (v) use effectively as a “provisional patent application”

It should be noted that the signatories of this submission have not seen any evidence of any widespread abuse of the Hong Kong Short-term patent in contrast to the system abuse of the “Chinese Utility Model” patent in China.

It is also noted that some Hong Kong patentees are surprised to discover that their Hong Kong Short-term patent is not valid or enforceable. This is clearly due to such patentees not being correctly advised by a qualified patent attorney as to how the Short-term patent system works.

Further enhancement could be provided to the Short-term patent system to gain further usage and public confidence.

- (1) Should we introduce substantive examination? If so, when should it be carried out? Should it be a mandatory requirement or optional? Should it be a condition for commencement of infringement proceedings? Should the question of whether a substantive examination be carried out be left to the choice of the patent owner or a third party, and who should bear the costs?**

It would be counter intuitive to introduce mandatory substantive examination for a Hong Kong Short-term patent, in view of:

- (i) the time required for full substantive examination of a patent which can be several years,
- (ii) the universal purposes of "lesser" patents
- (iii) the cost of full substantive examination and prosecution being i a significant amount

The delay in publication of the claims as ultimately granted following substantive examination and thus maintaining the pendency of a Hong Kong Short-term patent as an "application" for an extended period of time, irrespective of whether there was pre-grant publication or not, would cause uncertainty to the public, and in addition would also be a mechanism for abuse, thus not meeting the purpose (c) above.

Accordingly, substantive examination for a Hong Kong Short-term patent is not suitable.

However, similar to some other jurisdictions, prior to enforcement a technical opinion could be obtained, or some substantive examination opinion.

**(2) *Should we extend the current term of protection? If so, how long should the term of protection be?***

The Hong Kong Short-term patent, if extended in term, could be up to 10 years instead of 8, so as to be more in keeping with international standards.

**(3) *Should we relax the present restriction on the number of claims that may be included in each patent application? If so, how many claims should be allowed in each patent application or should there be no restriction at all?***

As Hong Kong Short-term patent does not have restrictions on types of claim and subject matter, it is appropriate that the number of independent claims not be restricted to 1.

However a maximum number of 3 or 5 independent claims and a total of no more than 25 or 30 claims would not be too limiting on patentees or too much of a burden on the public.

**(4) *Should we lower the threshold for patentability for short-term patents? If so, what alternative threshold should be applied?***

Lowering of the threshold of inventiveness is not considered appropriate, as such changes would be moving in the direction of the overly abused Chinese Utility Model.

There is no evidence or suggestion that the current threshold of inventiveness stifles innovation.

It is important the Hong Kong Register does not become polluted with invalid second-tier patents like the Chinese Utility Models.

**(5) *What other changes are required?***

If there was a “technical opinion” requirement prior to enforcement and “groundless threats” provisions introduced if the patent is asserted without the technical opinion, this may help reduce the perceived possibility of abuse.

**(g) Should we discontinue the short-term patent system altogether?**

For reasons are discussed above, the Hong Kong Short-term patent must not be discontinued. Doing so would deprive Hong Kong patentees of the benefits afforded by the Short-term patent.

# CHAPTER 3

## **Regulation of Patent Agency Services in Hong Kong**

### **3.1 Introduction – Patent Law and Patent Agency Services**

The patent attorney profession is one of the longer established professional services professions, having origins and professional registration requirements outside of the legal practitioners profession.

It must be understood and appreciated that Patent Law is “international” and that the law of each country must be compliant with the requirements under TRIPS and WTO.

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.

Thus, as must be appreciated and be understood, unlike most aspects of law, 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.

The term “Patent Attorney” and the term “Patent Agent” are terms used throughout the world often interchangeably due to different practices in different countries.

Also, it must be understood that some aspects of Patent Agency Services are not “substantive” (i.e. requiring the skills and knowledge of Professionally Qualified Patent Attorneys), whilst other aspects are “substantive”.

Thus, for any consideration of “regulation” of patent agency services, the following must be considered and understood:

- (i) what are patent agency services?
- (ii) what aspects of patent agency services are “substantive” and what aspects are not substantive?
- (iii) what is the law applicable to Hong Kong in respect of patent practice?
- (iv) what qualifications are required in order to act in substantive aspects of patent practice in jurisdictions having the same law applicable to Hong Kong?
- (v) what is the regulatory regime in jurisdictions having the same law applicable to Hong Kong?
- (vi) are there limitations on types of patent agency work in jurisdictions having the same law applicable to Hong Kong?

- (vii) what is the international understanding of the title “patent attorney” or “patent agent”?
- (viii) are there restrictions on such titles?
- (ix) how much training is required in other jurisdictions for those providing patent agency services?

Accordingly, and in view of differing opinions by various groups in respect of Patent Attorney and Patent Agency Services, a comprehensive survey / questionnaire was prepared and forwarded to experienced and credible patent attorneys/agents providing patent agency services in numerous jurisdictions.

The survey was designed to extract information from professionals in various jurisdictions such that valid authoritative results could be procured and contrasted between the various jurisdictions.

The detailed queries included numerous questions in relation to the following aspects of law, regulation and system:

- (1) Law/Legislation
- (2) Patent Protection and Examination
- (3) Law, Profession, Restrictions of Scope of Practice
- (4) Patent Practitioner, Professional Body and Scope of Work
- (5) Patent Practitioner Registration Requirements

Text of the survey conducted is shown in **Annexure B**, and a summary of the results of the survey are shown in **Annexure C**, which is referred to within the following comments.

### **3.2 International Understanding of Patent Attorney / Agent Professional**

Regardless of terms used to describe qualified patent practitioners, Professionally Qualified and Registered Patent Attorneys/ Agent, industry and public throughout the world, in particular in the more economically advanced countries, the terms “Patent Attorney” and “Patent Agent” are generally understood by the public to connote at least 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;

- e) a person who can advice 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 there 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, there are several 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.

### **3.3 Use of Term “Patent Attorneys” and “Patent Agents”**

In many jurisdictions, the terms “Patent Attorney” and “Patent Agent” are reserved terms, and only those with professional qualifications and associated practicing certificates, may use such titles, and criminal penalties may be applied to mis-used and mis-representation.

Although in some jurisdiction, the term “Patent Attorney” or “Patent Agent” is not an excluded term *per se* under the local patents legislation, and in some jurisdictions the use of such titles by solicitors who are not on a Register of “Patent Attorneys” or “Patent Agents” is excluded from being a contravention of the legislation, this does not necessarily connote:

- (A) that such persons are qualified in respect of matters (a) – (k) at item 3.2 above,
- (B) that such persons can competently engage in work typical of Qualified Patent Attorneys/Agents

- (C) that such persons legal practicing certificate and insurance pertaining thereto, would cover such works.

In order to mitigate the confusion caused to the public by use of the titles "patent attorney" and "patent agent" by persons whose usage is not a contravention of the legislation yet who do not qualify for entry onto the Registers Patent Attorneys or Patent Agents, Patent Agents, local professional registration bodies in leading and established jurisdictions have adopted titles including the following:

- (a) Chartered [*jurisdiction*] Patent Attorney
- (b) Chartered [*jurisdiction*] Patent Agent
- (c) Registered [*jurisdiction*] Patent Attorney
- (d) Registered [*jurisdiction*] Patent Agent

The above mitigates any confusion as to whether a practitioner is indeed a person suitably qualified to be entered onto the local Register.

However, depending upon the jurisdiction of qualification, there may be:

- (I) limitations on the scope of work by patent attorneys/agents,
- (II) variations in professional registration requirements, and
- (III) variations in professional competency.

### **3.4 Professional Patent Attorney Mandatory Skills**

A patent is a statutory right, a patent specification being comprised of a document which is both a legal document as well as a technical document.

In order for patent rights to be obtained, it is necessary that a patent specification is prepared which is suitable for subsequent filing in numerous jurisdictions throughout the world in which patent rights are required to be pursued.

Different jurisdictions have different thresholds of particular aspects and content of a patent specification, such as a level of support and basis required in support of ranges of integers of inventions, such as concentrations, as well as limitations on manner in which a patent specification and claim structure is prepared.

Furthermore, different jurisdictions have limitations on allowable subject matter, either by way of being "excluded" subject matter or matter which is considered "unpatentable". Technologies applicable to such limitations are often those in the medical/pharmaceutical and medical treatment areas, as well as computer based and internet based/software type applications.

Thus, it is paramount that a "first filing" patent specification is prepared by a patent attorney or patent agent with at least the following skills and knowledge:-

- (i) knowledge as to allowable or excluded subject matter;



- (ii) thorough technical professional knowledge and understanding of the technology for which patent rights are to be pursued;
- (iii) knowledge of prevailing practices in claim drafting style from practical experience;
- (iv) knowledge of patent specification "support" and "enablement and sufficiency" requirements for subsequent prosecution in multiple jurisdictions;
- (v) knowledge of applicable patent claim drafting requirements and style with knowledge of (a) requirements in other jurisdictions, (b) knowledge of interpretation techniques and law in foreign jurisdictions and (c) knowledge and experience in applicable language and terminology utilized in foreign patent offices.

Further, a qualified patent attorney or patent agent must also 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.

Other fundamental skills that are expected of qualified patent attorneys or patent agents, preparation and prosecution of arguments suitable for prosecution in foreign jurisdictions, including the requirements for such arguments in the relevant foreign jurisdictions.

Patent attorneys are expected to have technical qualification and knowledge of the technology at hand, so that professional prior art analysis and inventive step arguments and submissions may be conducted, in view of the prior art cited and objections raised by Examiners in foreign jurisdictions during substantive examination.

Whilst patent attorneys and patent agents may have some varying scope of work depending upon the jurisdiction in which they are qualified and upon the type of practising certificate they may hold, a properly qualified professional patent attorney or patent agent must be competent, experienced and qualified in at least the following:-

- (a) professional preparation of patent specifications for establishing priority and subsequent prosecution in multiple jurisdictions in accordance with foreign law,
- (b) have technical skills and knowledge required to analyse prior art for subsequent prosecution of patent applications in foreign jurisdictions,

- (c) be competent and qualified to conduct validity and infringement analysis and opinion in one's jurisdiction of registration or in jurisdictions of applicable law/jurisprudence.
- (d) provide advice on types of patents and requirements for such patents in multiple jurisdiction filing programmes.

Above all, the requirement of "technical competency" is paramount for preparation of patent specifications suitable for establishment of priority and subsequent prosecution so as to pursue patent rights in foreign jurisdictions.

It is expected that a practitioner engaging in patent specification drafting, is suitably skilled, educated, qualified and experienced in this practice, such that applicants' rights will be best pursued from both commercial and intellectual property standpoints.

It is also expected that a person who holds themselves out as being a "Patent Attorney" or a "Patent Agent" is:-

- (i) suitably qualified and experienced
- (ii) undertaken professional training by a qualified patent attorney or patent agent
- (iii) be a member of a professional body to which membership is only admitted to qualified practitioners.

Thus, membership to 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.

Thus, all members of such professional bodies or association must be suitably qualified and experienced so as to maintain the integrity and reputation of the patent attorney or patent agent profession in the jurisdiction accordingly.

### **3.5 Jurisdictions Having Patent Law Applicable To Hong Kong**

Based upon the Hong Kong patents law, the origin of the Hong Kong Patents Ordinance and the applicable jurisprudence, jurisdictions having the patent legislation based upon the UK patents legislation and patent system, have the most applicable law and practice pertaining to Hong Kong patent law.

From above, as will be understood, Patent Attorneys and Patent Agents interpreting claim scope and claim features for Hong Kong patents must be suitably qualified in jurisdictions having the requisite legal principles of claim constructions as to traditional UK patent law.

Furthermore, Patent Attorneys and Patent Agents providing advice in respect of interpretation of the Hong Kong patents legislation (Hong Kong Patents Ordinance)

must be suitably trained and have backgrounds and experience in applicable jurisdictions.

Many sections of the Hong Kong Patents Ordinance are very similar to the 1977 UK Patent Act, the principle and provisions of which are by and large within the legislation of the major common law jurisdictions, having ultimately codified upon many years of (often) UK case law.

Accordingly, the interpretation of patent claims in Hong Kong is strongly influenced by that in the UK, and as discussed previously, upon such principles in Australia, New Zealand and Canada upon departure from traditional UK principles or position.

Furthermore, as the development of the patent system of the United Kingdom was essentially implemented in the major colonies or commonwealth members over the years, much case law is common, and thus the style of patent drafting and the interpretation of patent claims can also be said to have adopted a British approach.

Still further, as well as the administration of the patent professional body, many of the first generation patent agents (and subsequent migrants) in Australia, New Zealand and Canada were originally from the Chartered Patent Attorney Association in the United Kingdom, much of the professional training and practical principles were implemented. Indeed, there are many UK qualified patent agents today practising in Australia, New Zealand and Canada.

Patent attorneys of these relevant jurisdictions of UK, Australia, New Zealand and Canada practicing substantive law are generally required to hold tertiary technical qualifications, similarly as is required in Hong Kong's major trading jurisdictions including China, US and Europe.

In particular, jurisdictions having precedent based upon traditional UK case law, such as interpretation and validity and the relevant cases thereto, are those to which Hong Kong is considered likely to look to upon the UK position departing from its traditional and established position and to also look to for judicial guidance in relation to patent matters.

Furthermore, such jurisdictions have codified patent legislations originally based upon the UK patents acts and as such, provisions and mechanisms as codified are applicable to the relevant sections of the Hong Kong Patents Ordinance.

Key jurisdictions having such codified patent law and case law are typically those which are or were formally British colonies or Commonwealth Countries, having both a patent system and general legal system based upon the British common law, similarly as the origins of the Hong Kong patent law system and legal system.

Such major countries having applicable legal backgrounds, patents legislation and jurisprudence are the United Kingdom, Australia, New Zealand and Canada.

### **3.6 Background of Patent Attorney /Agency Practice in Hong Kong**

Patent agency practice is not new to or absent from Hong Kong. Indeed, there are a substantial number of professionally qualified patent attorneys providing professional patent attorney/agency services in Hong Kong, and firms in which such patent attorneys practice have provided such services for several decades in Hong Kong.

Historically, several firms in Hong Kong have been the main providers of substantive patent services to both local and foreign clients, in particular substantive patent practice including patent specification drafting, prosecution of patent applications in numerous foreign jurisdictions on behalf of local Hong Kong clients, and providing professional patent attorney services pertaining to validity and infringement, freedom-to-operate opinions and strategic foreign patent filing and prosecution works.

In the main, such firms have retained on staff and located in Hong Kong, registered and qualified patent attorneys from jurisdictions having long-term established patent systems and law being based upon the Commonwealth common law patent system and practice, as in Hong Kong. Such patent attorneys include those from United Kingdom, Australia and New Zealand.

Whilst several firms in Hong Kong have held out to have patent attorneys, many in fact do not have such patent attorneys located and domiciled in Hong Kong, and rather act in a consultant capacity or as an outsourced arrangement. As such, such firms cannot be considered to have an established patent attorney practice in Hong Kong acting on behalf of Hong Kong clients.

Firms which have engaged in professional patent attorney services in Hong Kong and have had qualified patent attorneys on staff for several decades include Marks & Clerk/Lloyd Wise, Deacons , Wilkinson and Grist and Sit Fung Kwong Shum, Ella Cheong and historically Johnson Stokes & Master.

Such firms have, over an extended period of time, acted on behalf of local industry, local Hong Kong universities and government organizations to provide substantive patent services, in particular patent specification drafting in Hong Kong.

It may be said that firms with long established substantive patent practices having registered and qualified patent attorneys, suitably trained and skilled in the art of patent specification drafting, have been the corner stone of the Hong Kong patent profession as it is today.

Such firms have provided supervised training by qualified patent attorneys for Hong Kong people and assisted such people in undertaking applicable foreign patent attorney/agent examinations in jurisdictions applicable to the law in Hong Kong, for example, Hong Kong people who have gained the qualification as a UK patent agent who passing the requisite written substantive examinations as well as undertaking the requisite professional training and mentoring over several years as is required for registration as a Chartered Patent Agent.

### **3.7 Leading Firms Having Substantive Patent Practice in Hong Kong**

Several Hong Kong firms have invested in retaining qualified patent attorneys on staff in Hong Kong and those which have invested in professional substantive patent services over a long period of time notably have a greater number of such patent attorneys on staff.

Firms having registered patent attorneys include Marks & Clerk having 8 patent attorneys with qualifications from UK, Europe, New Zealand and Australia, Deacons having 5 patent attorneys with qualifications from Australia, New Zealand and Canada, Wilkinson & Grist - having 2 patent attorneys, including qualifications from Australia.

Other firms in Hong Kong having qualified patent attorneys on staff and have done so for an extended period of time include Sit Fung Kwong Shum and Ella Cheong, and historically Johnson Stokes Masters.

The publicly available records of the Hong Kong IPD clearly show that the firms having the greater number of registered patent attorneys and substantive patent practices, and those having historically invested in patent practices, also dominate in use of the Hong Kong patent system.

The vast majority of Hong Kong patent filings for standard patents are from foreign originating patents and as such, Hong Kong firms with substantive patent attorney practices are shown as being those with the greatest foreign firm recognition.

**Annexure D** shows the number of patent filings for the years 2007, 2008, 2009 and 2010, which shows a clear correlation between the firms who have:

- (i) invested in patent attorney / agency services for a long period of time, and
- (ii) professionally qualified patent attorneys "on staff".

### **3.8 Observations from Survey / Questionnaire**

The following observations are directly obtained from the detailed survey / questionnaire, and as summarised at **Annexure C**:

#### **A. JURISDICTIONS HAVING LAW APPLICABLE TO HONG KONG PATENT LAW**

The jurisdictions having applicable law and jurisprudence to Hong Kong, that is the Commonwealth common law body of law, are the United Kingdom, Australia, New Zealand and Canada.

- (I) these jurisdictions all have the requirement of all registered Patent Attorneys / Agents to sit and pass full written patent specification drafting exams, a skill of paramount importance in patent attorney/agent practice
- (II) these jurisdictions also have codified a requirement of two or three years minimum apprenticeship/training, or such training is practically required in order for candidates to pass such onerous examination

- (III) the ministry responsible for administration of the legislation and guidance in regulation is not a Ministry of Law, but rather Ministries of Business and Innovation; Industry, Science and Research, Economic Development; and Industry
- (IV) each of these jurisdictions have well established and reputable professional bodies and internationally respected reputations of practitioners
- (V) each of these jurisdictions requires a technical qualification, either codified or in practical terms
- (VI) in each of these jurisdictions, the Patent Attorney/Agent profession is separate from solicitors

**B. MAJOR TRADING JURISDICTIONS WITH HONG KONG**

The major trading jurisdictions with Hong Kong are China (PRC), Europe and US

- (I) each of these jurisdictions requires patent attorneys/agents to have an appropriate technical degree
- (II) China has a minimum trainee internship of 1 year and Europe has a 3 year traineeship which must be under the direct supervision of a qualified European Patent Attorney. A traineeship is not codified in the US, however in practical terms reputable and competent US patent attorneys have undergone several years of training
- (III) Patent Attorneys and agents undergo formal examination for registration, and in China and the United states some aspects of the examination are multi-guess in addition to some written component
- (IV) in each of these jurisdictions, the Patent Attorney/Agent profession is separate from solicitors, except for in the US where a US Patent Attorneys also must hold a state bar solicitor's practicing certificate, in addition to the US Patent Agent requirement of having passed the US Patent and Trade Mark Office Bar.
- (V) the ministry responsible for administration of the legislation and guidance in regulation is not a Ministry of Law, but rather Ministries of Business and Innovation; Industry, Science and Research or the like

**C. OTHER MAJOR JURISDICTIONS**

Other major jurisdictions include India, Japan, Singapore and Korea:

- (I) In India it is currently a requirement that a technical degree is held, however some of the older attorneys may not.

In Japan and Korea a requirement of a technical degree is not codified however it is expected and those without practice trade marks.

In Singapore a technical degree is a codified requirement unless "grandfathered", however on the Register it is noted who is transitional and

who actually holds a technical degree and in any event practically all substantive practice is performed by those holding technical qualifications. In fact, there are suggestions that those without a technical qualification should be barred from performing substantive work in Singapore.

- (II) In each of these jurisdictions, the Patent Attorney/Agent profession is separate from solicitors
- (III) The ministry responsible for administration of the legislation and guidance in regulation is not a Ministry of Law except Singapore, but rather Ministries of Business and Innovation; Industry, Science and Research or the like

#### D. OTHER ASIAN JURISDICTIONS

Other neighbouring jurisdictions include Philippines, Vietnam, Taiwan, Malaysia, Thailand and Indonesia:

- (I) in each of these jurisdictions, the Patent Attorney/Agent profession is separate from solicitors
- (II) these jurisdictions vary in qualification requirements from a technical standpoint and a training standpoint
- (III) the ministry responsible for administration of the legislation and guidance in regulation is not a Ministry of Law except Indonesia, but rather Ministries of Business and Innovation; Industry, Science and Research or the like.

### 3.9 Substantive and Non-Substantive Patent Agency Services - Comments

It must be understood and acknowledged that Patent Agency services may be considered to generally and broadly fall within the two categories of:

- (a) SUBSTANTIVE
- (b) NON-SUBSTANTIVE

Examples of substantive works include patent specification drafting, providing validity and infringement opinions, patent application prosecution, multinational filing strategies and multi-jurisdictional patent portfolio management and prosecution, prior art analysis.

Examples of non-substantive works include re-registration recordal of patent applications, Assignment recordal, renewal portfolio management, licensing related issues and the like.

**(h) Should Hong Kong have a regulatory regime for professionals providing patent agency services? Should the promulgation of a regulatory regime or otherwise be made dependent on whether an OGP system is to be implemented in Hong Kong?**

Hong Kong should have a regulatory regime for professionals providing patent agency services. Such a regulatory regime should be primarily in respect of those providing substantive patent agency services, universally known as "patent attorney" services.

However, it is of paramount importance that should a regulatory regime be introduced that the standard in respect of such substantive services be first 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:

- (i) 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 (PRC), 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.
- (ii) "Grandfathering" of persons not satisfying (i) must not be allowed. Guidance should be sought from the experiences in jurisdictions such as Singapore which initially provided a "grandfathering" arrangement for those who (a) 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.
- (iii) Practitioners must undergo stringent written patent drafting examinations, similarly as in the relevant Commonwealth common law jurisdictions, and not be 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.
- (iv) Practitioners providing substantive patent agency services must undergo a minimum training period of 2 years under the supervisions of an appropriately trained and professionally qualified patent attorney/agent. This is paramount such that (a) the practical and vocational skills may be obtained and (b) so as



not to expose the public to the risk of unqualified or inexperienced persons acting on their behalf.

- (v) It is paramount that any regulatory regime for substantive patent agency services introduced be supported by patent practitioners who:
- (a) have established and reputable both locally and internationally substantive patent agency practices
  - (b) are professionally qualified in jurisdictions having the patent law applicable to Hong Kong
  - (c) have qualifications in keeping with the above, importantly including appropriate tertiary technical qualifications,
  - (d) have undergone substantial professional training, and
  - (c) have substantial experienced in substantive patent matters on behalf of Hong Kong applicants for numerous years, and

(vi) Actual qualified professional users of the existing patent system having substantial practical experience and knowledge in substantive patent matters in Hong Kong and internationally 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 countries and major trading jurisdictions.

Irrespective of whether or not an OGP system is introduced in Hong Kong, regulation of substantive aspects of patent agency work is likely to be in Hong Kong's interest both locally and internationally. However, any regime must be appropriately defined and not be contrary to regimes in the jurisdictions having a corresponding patent law to Hong Kong.

In any event, no regulation is a preferable option to poor, ambiguous or sub-standard regulation and/or regulation requirements.

**(i) If a regulatory regime is to be introduced for providers of patent agency services,**

- (1) should we restrict the provision of such services to persons meeting certain qualifications or requirements only? Or should we limit the use of particular titles only but allow the provision of such services by any person?**

**(2)**

The practice of substantive aspects of patent agency practice should be restricted to those who indeed are suitably qualified and experienced. Restriction should not be in respect of non-substantive aspects.

Use of the term “registered” preceding “patent attorney” or “patent agent” should be restricted to those appropriately professionally qualified.

- (3) should the regulation apply to all types of patent agency services or only to certain services e.g. the drafting and amendment of patent specifications under an OGP system?**

Any restrictions should not apply to all aspects of patent agency services.

### **Other Suggestions**

- (j) How else should we position our system for the purposes of encouraging local innovation and attracting investors to use Hong Kong as a launching pad for their research and development operations?**

Other manners in which innovation and investment could be encouraged, could be by way of taxation incentives for IP related aspects of businesses. Grants may be utilised, however this should be reviewed very carefully and appropriate milestones and disincentives for abuse be implemented.

## **CLOSING COMMENTS**

Patent law and the patent system are international in nature, and any patent system must be in keeping with international patent treaties including WTO and TRIPS, and a local patent system must correctly interface with the locally applicable jurisprudence which supports the patent system, as well as interface with the international patent system and prevailing trends from a global standpoint.

Many comments by those who advocate changes to patents legislation and regulation of patent agency services in Hong Kong which have been made publicly prior to this submission do not consider the true international nature of patent systems, and in the main have been of a myopic nature and focussed on narrow aspects of patent systems and patent practice.

The signatories have not heard any public policy or national policy related comments from such advocates, and have concerns that such advocates' opinions are not representative of the true nature of patent practice both locally and internationally.

Interesting, more important topics of patent law discussed on a global scale by experienced and qualified patent practitioners such as Bolar provisions, Supplementary Protection Certificates, parallel imports, protection for "business methods" type of inventions, off-shore contributory infringement and extra-territorial infringement to mention a few, have not received any comment or interest by such advocates.

Furthermore, it is noted that generally advocates for changes to patents legislation and regulation of patent agency services in Hong Kong:

- (a) are not professionally qualified patent attorneys in keeping with the requirements with other major and legally relevant jurisdictions,
- (b) do not represent the views of local Hong Kong entities who indeed use the local and international patent systems,
- (c) do not represent the views of foreign entities who currently utilise the Hong Kong patent system, and
- (d) have not demonstrated knowledge or awareness of "big picture" issues in respect of international patent practice.

By clear and stark contrast, the signatories in conjunction with APAA Hong Kong, have much experience and knowledge in relation to regulatory regimes both internationally and from requirements in their own home jurisdictions. Furthermore, the signatories have substantial experience in the training of Hong Kong people to be substantive patent practitioners. Accordingly, the signatories would be happy to provide any further professional input and comments in relation to any of the above three Chapters.

In any event, for any changes to the Hong Kong patent system and introduction of a regulatory regime for patent services,

- (i) the system must be in keeping with the body of law appropriate for Hong Kong and in keeping with international practice
- (ii) substantive examination issues must be considered in view of internationally prevailing practice and trends
- (iii) the system must not result in a patent with a lesser presumption of validity as afforded by the present re-registration system
- (iv) the system must be appropriate and credible on both local and international levels
- (v) regulation and qualification of practitioners must be in keeping with requirements in jurisdictionally appropriate and major trading jurisdictions, in that at least the following are required:
  - (a) strong tertiary technical qualifications,
  - (b) professional training over several years , and
  - (c) thorough written examination in respect of skills based aspects of patent practice such as patent specification drafting.

It is of paramount importance that all of the above are considered such that should any changes to the patent system in Hong Kong or a regulatory regime be implanted, that Hong Kong does not lose its fine international reputation and standard in relation to the quality of its patent system.

# **ANNEXURE A**

## **Summary of Professional Qualifications of Signatories**

| Name               | Patent Professional Registration       | Tertiary Technical Degrees              | Patent Attorney Professional Body  | Years of Experience of Substantive Patent Practice in Hong Kong | Member of Asian Patent Attorneys Association - Hong Kong | Other Tertiary Degrees                 | Other Professional Registrations                           |
|--------------------|--|---|--|---|--|--|--|
| Timothy J. Letters | Registered Australian Patent Attorney  | Bachelor of Engineering (Hons)          | Fellow of Institute of Patent and Trade Mark Attorneys of Australia                              | 6   | Yes  | Master of Intellectual Property Law    | Registered Australian Trade Mark Attorney                  |
|                    | Registered New Zealand Patent Attorney | Masters of Engineering                  | Member of Intellectual Property Society of Australia and New Zealand                             |   |  |  |  |
|                    |  | Doctor of Philosophy - Engineering      | Intellectual Property Office of New Zealand for Commissioner of Patents, Trade Marks and Designs |   |  |  |  |
| Laurence Thoo      | Registered Australian Patent Attorney  | Bachelor of Electrical Engineering      | Fellow of Institute of Patent Attorneys of Australia   | 5   | Yes  | Bachelor of Laws (Hons)                | Registered Australian Trade Mark Attorney                  |
|                    |  |   | Member of Intellectual Property Society of Australia and New Zealand                             |   |  | Master of Intellectual Property Law    | Solicitor, New South Wales, Australia                      |
|                    |  |   | Intellectual Property Office of New Zealand for Commissioner of Patents, Trade Marks and Designs |   |  | Graduate Diploma in Legal Practice     |  |
|                    |  |   | IP Australia   |   |  |  |  |
| Jeffrey McLean     | Registered Australian Patent Attorney  | Bachelor of Science (Biochemistry)      | Member of Intellectual Property Society of Australia and New Zealand                             | 5   | Yes  | Bachelor of Laws (Hons)                | Registered Australian Trade Mark Attorney                  |
|                    |  | Master of Information Technology        | Intellectual Property Office of New Zealand for Commissioner of Patents, Trade Marks and Designs |   |  | Master of Intellectual Property Law    | Solicitor, New South Wales and Queensland (non-practicing) |
|                    |  |   | IP Australia   |   |  |  |  |
| James Wan          | Registered Australian Patent Attorney  | Bachelor of Science (Computing Science) | Institute of Patent and Trade Mark Attorneys of Australia  | 5   | Yes  | Bachelor of Laws                       | Registered Australian Trade Mark Attorney                  |
|                    | Registered New Zealand Patent Attorney |   | Association of Singapore Patent Agents   |   |  | Master of Intellectual Property Law    |  |
|                    | Registered Singapore Patent Agent      |   |  |   |  | Graduate Certificate in Legal Practice |  |

|                       |   |   |  |    |     |  |  |
|-----------------------|---|---|--|----|-----|--|--|
| <b>Michael Filint</b> | Registered Australian Patent Attorney<br>Registered New Zealand Patent Attorney | Bachelor of Engineering (Hons)  | Member of New Zealand Institute of Patent Attorneys  | 10 | Yes |  | Registered New Zealand Trade Mark Attorney |
| <b>Owen Gee</b>       | Registered Australian Patent Attorney<br>Registered New Zealand Patent Attorney | Bachelor of Engineering (Hons)<br>Bachelor of Science (Computer Science)                          | Member of Institute of Patent and Trade Mark Attorneys Australia<br>Member of Intellectual Property Society of Australia and New Zealand | 3  | Yes | Master of Industrial Property (IP Law) | Registered Australian Trade Mark Attorney  |
| <b>Michael Lin</b>    | Registered US Patent Attorney   | Bachelor of Arts (Biochemistry)<br>Professional Diploma in Company Secretaryship & Administration | US Patent Attorney Register (administered by the USPTO)  | 1  | No  |  | Chic, USA, Attorney                        |
| <b>Tsang Chin Wan</b> | Chartered UK Patent Attorney  |   | Fellow of the Chartered Institute of Patent Attorneys  | 24 | Yes |  |  |

# Professional Profile

## Timothy Letters – Patent Attorney

Registered Patent Attorney  
Fellow of the Institute of Patent and Trade Mark Attorneys, Australia

### Academic Qualifications

Doctor of Philosophy (*Biomedical Engineering*), The University of New South Wales  
Master of Intellectual Property Law, University of Technology, Sydney  
Master of Engineering, Research (*Orthopaedic Engineering*), The University of Sydney  
Bachelor of Engineering, Honours (*Mechanical Engineering*) The University of Sydney

### Admission

Registered Australian Patent Attorney  
Registered New Zealand Patent Attorney  
Registered Australian Trade Mark Attorney

### Jurisdictional Experience

United States, Canada  
Australia, New Zealand  
Europe – UK, Germany  
Asia – Hong Kong, China, Japan, Korea, Thailand, Taiwan, Malaysia, Singapore, Philippines

### Principal Practices

Advising on patent infringement under Hong Kong patent law, advising on freedom-to-operate under Hong Kong patent law,

Advising on enforcement issues in relation to patent and design infringement, under Hong Kong Patent and Design law.

Advising in relation to pharmaceutical based technologies, proprietary rights and generic supply of drugs in Hong Kong.

Drafting and prosecuting patent specifications, advising upon patent and Design IP strategies, advising on infringement and validity issues.

Supervising and overseeing of patent and Design filing and prosecution in the fields of general electrical and mechanical engineering, biomedical engineering, pharmaceuticals, chemical engineering, Information Technology, and manufacturing devices and processes.

### Experience

- Advising on infringement and freedom to operate of patents and Designs; advising on patent validity and enforceability; pre-litigation advice; litigation support; evidence preparation; Design revocation actions

Non contentious issues including drafting and prosecution of patent and Design applications; advising on filing and drafting strategies; IP portfolio management and due diligence, Registered Design advice, formulating search strategies and advising on patent and Design searches

### Areas of Technical Competency and Technical Expertise

- Biomedical and biomechanical engineering including medical devices and hardware; medical instrumentation and diagnosis hardware, surgical techniques and instruments; orthopaedic implants and implantation procedures;
- Ophthalmic devices and procedures, cosmetic surgical devices and techniques, methods of medical treatment; orthotics, drug delivery devices and systems; cardio-vascular and stent technology; and biological and biomaterials.
- General mechanical and electro-mechanical engineering including mechanical and hydraulic devices and systems, processes and apparatus; electro-mechanical devices and systems; mining equipment and processes; materials handling and packaging and engineering materials.



- Manufacturing processes and apparatus; materials handling and packaging; materials engineering and materials science including polymeric materials, metal and metal alloys, composite materials, manufacturing processes and techniques and processes.

**Membership/Appointments**

- Conveynor of Patents Review Committee of Asian Patent Attorneys Association (Hong Kong)
- Committee Member of Asian Patent Attorneys Association (Hong Kong) Patents Sub-Committee
- Fellow, Institute of Patent and Trade Mark Attorneys, Australia
- Member, Intellectual Property Society of Australia and New Zealand
- Member, Asian Patent Attorneys Association (APAA) Hong Kong

**Languages**

English

**Contact Details**

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# Professional Profile

## **Laurence Thoo – Patent Attorney**

Patent Attorney Hong Kong

### **University**

Master of Intellectual Property Law, University of Technology, Sydney  
Graduate Diploma in Legal Practice (College of Law, Sydney)  
Bachelor of Laws (Hons), University of Wollongong  
Bachelor of Electrical Engineering, University of Sydney

### **Admission**

Registered Australian Patent Attorney  
Registered Australian Trade Mark Attorney  
Solicitor, New South Wales, Australia

### **Jurisdictional Experience**

Australia  
New Zealand  
United States of America  
China  
Europe

### **Principal Practices**

Patent Drafting and Prosecution  
Infringement and Validity Opinions  
Intellectual Property Due Diligence  
Patent Portfolio Management

### **Patent Expertise**

- Drafting and prosecuting patent applications with a particular focus on electronics, electro-mechanical, e-commerce business methods and computer-related inventions.
- Providing commercially-focused advice in relation to patent filing and prosecution strategies both locally and internationally.
- Patent prosecution of Australian, New Zealand, US, European, Chinese and International PCT applications.
- Conducting novelty and freedom-to-operate searches in order to provide advice in relation to the patentability of new inventions and the likelihood of patent infringement arising.
- Advising in respect to contentious patent and design matters in Hong Kong and China involving infringement and revocation actions.
- Advising in relation to patent and design infringement matters
- Conducting intellectual property audits in order to identify and protect potentially valuable intellectual property assets.
- Presenting educational seminars and conducting interactive intellectual property workshops for entrepreneurs and academic institutions at both introductory and intermediate levels.

### **Areas of Technical Competency and Technical Expertise**

#### *Primary Areas of Experience:*

- Business methods, e-commerce systems, telecommunications software and hardware, compression and encryption technologies, digital audio and image processing systems, optical devices, digital storage media, semiconductors, smart card devices and systems and automated payment systems, electro-mechanical devices, and military reconnaissance and sensor technologies.
- Tamper-proof packaging for pharmaceutical industry products, hydro-electric systems, scaffolding and building construction related inventions, vehicle suspension systems, mining technologies including hydraulic jacking systems and excavation systems.

### **Memberships / Appointments**

Fellow of the Institute of Patent and Trade Mark Attorneys Australia  
Member of the Intellectual Property Society of Australia and New Zealand

Member of the Asian Patent Attorneys Association (Hong Kong)

**Languages**

English

**Contact Details**

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# Professional Profile

## **Jeffrey McLean – Patent Attorney**

Patent Agent, Hong Kong

### **University**

Bachelor of Science (Biochemistry), University of Queensland  
Master of Information Technology, Queensland University of Technology  
Master of Intellectual Property Law, University of Technology Sydney  
Bachelor of Laws (Honours) University of Queensland

### **Admission**

Registered Australian Patent Attorney  
Registered Australian Trade Mark Attorney  
Solicitor, New South Wales and Queensland (non-practicing)

### **Jurisdictional Patent Prosecution Experience**

United States, Canada  
Australia, New Zealand  
Europe – European Patent Office, UK, German Patent Office  
Asia – China, Japan, Korea, Thailand, Taiwan, Malaysia, Singapore, Philippines, Indonesia

### **Experience**

Jeff is a Registered Australian Patent Attorney who practised in Australia before joining Deacons. He holds a B Sc. and a LLB (Hons) from the University of Queensland, as well as a Master of Information Technology from Queensland University of Technology and a Master of IP Law from University of Technology Sydney. Jeff is also admitted as a solicitor in Queensland and NSW and has practised with a leading national firm.

He has previously worked as a Patent Examiner with the Australian Patent Office, examining and conducting searches on patent applications as an examiner in the electronics and computing section.

Jeff's practice includes patent specification drafting and prosecution, advising on multi-jurisdictional filing strategies, providing freedom-to-operate advice and general patent portfolio and renewals management.

His areas of technical competency include aspects of information technology including network technologies, software development and various programming languages as well as electro-mechanical inventions.

Jeff's experience includes:

- Drafting and prosecution of patents in China, Europe, United States, Hong Kong, Australia and other substantive jurisdictions across wide range of technologies including photonics, general optics, network security protocols, mechanical devices, consumer electrical devices, plastics, small household appliances, gaming machine technology, computer data structures, genetic technologies, bioinformatics.
- Strategic advice on filing and prosecution strategies in various jurisdictions.
- Coordination and Management of Renewals for Patents and Designs application in Hong Kong, China and jurisdictions including Europe, United States and other jurisdictions.

### **Areas of Technical Competency and Technical Expertise**

- Prosecution of patents in diverse technologies including household appliances, gaming machines, network security, minesweeping technology, photonics applications, USB protocols, , imaging devices, household fittings, edge moldings, manufacturing processes including paper production, optical fibre fabrication and electrolysis.

### **Membership/Appointments**

- Member, The Asian Patent Attorneys Association
- Affiliate Member, The Hong Institute of Trade Mark Practitioners

- Member of Patents Sub-Committee of The Hong Kong Institute of Trade Mark Practitioners

#### **Publications/Articles**

- Author of the Patents and Utility Models in Hong Kong section of "Rubicon Personal IP" Online Manual published by Rubicon Publishers
- Contributing author of Hong Kong Chapter of "International Licensing" published by BNA International Inc.

#### **Further Legal Experience**

In addition to his experience as a Patent Attorney, Jeff has worked as a Patent Examiner with the Australian Patent Office (IP Australia) where he examined patent applications in Electronics and Information Technology disciplines to ensure that they complied with substantive and technical requirements.

Jeffrey is also an admitted Solicitor, having previously worked in a Corporate Law Firm in Projects in Australia where he has been involved in international sale of large infrastructure assets.

#### **Languages**

English

#### **Contact Details**

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# Professional Profile

## **James Wan – Patent Attorney**

### **Admission**

Australia, New Zealand & Singapore Patent Attorney

### **University and Education**

B Sc in Computing Science (University of Technology, Sydney, 2000), Bachelor of Laws (Hons) (University of Technology, Sydney, 2001), Graduate Certificate in Legal Practice (University of Technology, Sydney, 2001), Master of IP Law (University of Technology, Sydney, 2003), Qualified Australian Trade Marks Attorney (2001), Qualified Australian Patent Attorney (2003), Admitted Solicitor in the Supreme Court of NSW (2002), Admitted Solicitor in the Federal & High Courts of Australia (2003), Qualified New Zealand Patent Attorney (2004), Qualified Singapore Patent Agent (2005), registered Foreign Lawyer in Hong Kong (2006).

### **Practice Areas**

Patent drafting and prosecution; Patentability advice and prior art searching; Patent infringement and validity opinions; Patent litigation and revocation proceedings; IP due diligence studies; Software IT, and business method inventions.

### **Membership/Appointments**

- Member, The Asian Patent Attorneys Association
- Member, Institute of Patent and Trade Mark Attorneys of Australia

### **Contact Details**

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# Professional Profile

## **Michael Flint – Patent Attorney**

### **Admission**

New Zealand & Australian Patent Attorney

### **University**

Bachelor of Engineering (Honours I) - Electrical & Electronic Engineering

### **Practice Areas and Specialisation**

Michael has considerable experience in electrical, electronics and telecommunications patents. He has also prepared and prosecuted patent applications in such fields as semiconductor technologies, wireless networking, computer software, Internet and business method inventions, medical devices, automation and industrial systems, USP and battery management systems. He advises clients on all aspects of patent, design and copyright protection. Michael also has experience in the prosecution of chemical and pharmaceutical patent applications in the PRC.

Michael graduated from the University of Canterbury in New Zealand with a first-class honors degree in Electrical & Electronic Engineering. He worked in the engineering sector before training as a patent and trade mark attorney with a leading Australasian intellectual property firm. He joined Marks & Clerk in Hong Kong in 2001 and became a partner in 2005. Michael is a member of the Asian Patent Attorneys Association.

### **Membership/Appointments**

- Member, New Zealand Institute of Patent Attorneys
- Member, The Asian Patent Attorneys Association

### **Contact Details**

Marks & Clerk  
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Hong Kong  
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# Professional Profile

## **Chin-Wah TSANG - Patent Attorney**

### **Admission**

Chartered Patent Attorney (UK)

### **Education**

Kong Polytechnic - Professional Diploma in Company Secretary and Administrator

### **Practice Areas and Specialisation**

Patents, Registered Designs, Trade marks

Mechanical and chemical inventions; industrial designs, and trade marks registration.

Chin Wah has gained experience in patents in a wide range of subject matter, including electronics, electrical appliances, stationery items, household appliances, toys, telecommunications, home automation, material treatment, RFID technology, and basic chemistry. Chin Wah also handles trade mark and design applications around the world.

Chin Wah graduated from the Hong Kong Polytechnic with a Professional Diploma in Company Secretary and Administrator, and qualified as a UK Chartered Patent Attorney in 1997. Chin Wah is a member of the Hong Kong Institute of Trade Mark Practitioners and the Asian Patent Attorneys Association.

Chin Wah is fluent in English and Chinese (including Mandarin and Cantonese).

### **Membership/Appointments**

- Member, The Asian Patent Attorneys Association

### **Contact Details**

Marks & Clerk

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Pok Fu Lam

Hong Kong

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# Professional Profile

## **Owen GEE - Patent Attorney**

### **Admission**

Registered Patent Attorney – Australia  
Registered Patent Attorney – New Zealand  
Registered Trade Marks Attorney - Australia

### **Education**

BEng(Hons),  
BSc (Comp. Sci.),  
Master IP Law

### **Practice Areas and Specialisation**

Specialisation: Patents/Registered Designs  
Sector: Mechanical and computer-implemented inventions, including industrial, manufacturing, chemical process, biomedical, electrical and software inventions.

Owen Gee is an Australian and New Zealand Registered Patent Attorney. His practice is supported by a previous career of many years as a project engineer and manager in industries including petrochemical, manufacturing, biomedical, chemical process, papermilling, commercial and industrial construction, giving him field knowledge of the wide variety of technologies found in those industries. Owen has a BE and BSc (Computer Science) from the University of Sydney, a Masters in Industrial Property from the University of Technology Sydney, and has held Cisco qualifications in computer networking. Before Marks & Clerk, Owen was with a leading Australian intellectual property firm for a number of years. He is a member of the Institute of Patent and Trade Mark Attorneys Australia and the Intellectual Property Society of Australia and New Zealand. Owen has spoken on the topic of intellectual property at seminars and has lectured with the industrial design faculty of the University of Technology Sydney.

### **Membership/Appointments**

- Member, The Asian Patent Attorneys Association
- Member, Institute of Patent and Trade Mark Attorneys of Australia
- Member, Institute of Engineering Australia (IEAust),

### **Contact Details**

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# Professional Profile

## **Michael LIN - Patent Attorney**

### **Admission**

Patent Attorney (USPTO, OHIO)

### **Education**

BA(Biochem), JD

### **Practice Areas and Specialisation**

Patents / Registered Designs, Biochemical And Chemical inventions, including Biotechnology

Michael graduated from the University of California at Berkeley and worked for a biotech start up in Silicon Valley before going to Boston University Law School. After graduating Michael was admitted to the Ohio Bar in 1996 and the USPTO Bar in 1997. Michael worked as a Patent Attorney at a large multinational FMCG Company, where he specialised in Asian patent matters in the chemical and mechanical fields.

Michael specialises in international holistic IP strategy work, especially those involving both the US and Asia.

### **Membership/Appointments**

- Member, The Asian Patent Attorneys Association

### **Contact Details**

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# **ANNEXURE B**

**Text of Survey / Questionnaire**

## **Patent Practitioner Questionnaire**

The following is a survey relating to patent practitioner, attorney and agents, in particular scope of practice and professional registration requirements.

Whilst some questions may appear repetitive, the questions have been framed so as to account for differences in various jurisdictions and requirements.

Answers should be concise, however explanatory comments are encouraged so that a thorough understanding and appreciation of professional requirements and activities in various jurisdictions may be made.

### **1. Jurisdiction**

Name of jurisdiction

### **2. Law/Legislation**

What provisions/law does your jurisdiction have for the protection of patent rights?

Is your country a WTO member state?

Is your country a PCT member signatory?

Is your legislation based upon TRIPS requirements for IPRS

### **3. Patent Protection and Examination**

Does your legislation have provisions for:

(i) Utility Model protection?

(ii) "modified examination" or re-registration" type patents, and if so, what foreign jurisdictions are such patents based upon?

If so, which countries are such patents based upon and under what grounds are such patents allowable (eg. Based only on novelty/inventiveness) Further, are there then requirements under local law for which the validity of a patent may later be challenged?

(iii) patents which undergo substantive examination?

If substantive examination exists, does your country conduct substantive examination within the jurisdiction, or is it out-sourced to other examining jurisdiction and if so, which countries. Further, if examination is conducted externally, are there limitations on the grounds of examination (e.g. on novelty/inventiveness, and not local requirements such as support, sufficiency and support

(iv) grant of patents based upon IPRP?

If so, are there then requirements under local law for which the validity of a patent may later be challenged? Further, is there a burden/onus system of that a patentee must maintain a patent to the best of their knowledge that is valid?

(v) Does your jurisdiction have reciprocal rights arrangements between other local jurisdictions?

(vi) Is your patent system originally based upon UK commonwealth patent system?

(vii) Is your legal system a common law based legal system?

(vii) What body of law does your jurisdiction draw upon for precedent (if precedent applies)?

#### **4. Law, Profession, Restrictions of Scope of Practice**

(i) Does your jurisdiction have a recognized professions of Patent Attorney or Patent Agent?

(ii) What is the title utilized for such practitioners?

(iii) What is the scope of work for which such patent practitioners may practice?

(iii) If there are both “patent attorneys” and “patent agents” in your jurisdiction, are the differences in the scope of work that each may conduct?

(iv) Is the patent practitioner profession regulated in your jurisdiction, or may any person hold out to conduct patent work?

(v) Is there separation between the “patent practitioner” profession and the local solicitor/lawyer profession?

(vi) Are there overlaps in work that is done by a “patent practitioner” profession and the local solicitor/lawyer profession?

(vi) Are there aspects of patent practice that a “patent practitioner” and local solicitor/lawyer are prohibited from conducting by way of statute/law? If not, are there requirements that a practitioner may only act with his/her areas of competency?

#### **5. Patent Practitioner, Professional Body and Scope of Work**

(i) What are the types of work that a “patent practitioner” (Agent or Attorney) may conduct (e.g. patent drafting, providing freedom-to-operate/non-infringement opinions, prosecution of patents, ownership rights)

(ii) Does a patent practitioner’s work extend to which of the following: patents, registered Designs, trade marks, circuit layout, plant breeders rights, copyright, confidential information, trade secret?

(iii) Does your jurisdiction have a local professional body for patent practitioners? If so, is it separate from the local solicitor/lawyer professional body?

(iv) Under what ministry/department is the Register of patent practitioners fall (i.e. commerce, trade, industry)?

(v) What body maintains the Register of patent practitioners? Is this separate from the local professional representation body? How may disciplinary actions be taken against patent practitioners?

(vi) May a patent practitioner represent a client before the local Patent Office/Regional patent office?

(vii) If there exists Opposition/Appeal provisions in your patent legislation, may a patent practitioner represent a client accordingly?

(viii) Does your country have specific/designated patent courts?

(ix) May a patent practitioner represent clients before a court, or particular types of courts

(x) Is a local solicitor/lawyer precluded from representing clients before (a) patent office? (b) court, in relation to substantive aspects of patent law?

## **6. Patent Practitioner Registration Requirements**

(i) What are the general requirements for a person to become a patent practitioner in your jurisdiction?

(ii) Must a patent practitioner hold a local solicitor/lawyer practicing certificate?

(iii) Must a patent practitioner hold a recognized tertiary technical degree? Are there any limitations on this? If there is no codified technical tertiary degree requirement, then is there a limitation on scope of work? If there is no codified technical degree requirement, in practical terms (a) are there any/few practitioners who do not have technical qualifications

(iv) Must a patent practitioner undergo a requisite number of years of training/articles, prior to becoming registered? What does such training comprise of and must it be under another locally qualified patent practitioner of a requisite level of experience/seniority?

(v) What examinations must a patent practitioner undertake to become registered (e.g. general law, trade mark law, design law, validity & infringement, local patent law, foreign law, patent drafting, patent system)

(vi) What is the format of examination? (e.g. written examination, multiple choice)

(vii) What body is responsible for conducting examinations, and what qualifications do examiners possess for professional registration examinations?

(viii) What would be the average number of years a patent practitioner undergoes training/supervision and becomes registered as a Registered Practitioner?

(ix) Are there other requirements/skills in order to become a Registered practitioner?

(x) Are there residency requirements in order to (a) become registered and (b) maintain registration?

(x) To what extent does the local professional body have involvement in the practitioner registration process/training and the like?

(xi) Does your jurisdiction have reciprocal “registration” of practitioners between similar or neighbouring jurisdictions?

## **7. Further Comments**

(i) Under the patent practitioner system in your country, does the title of a patent practitioner, either patent attorney or agent, denote that a person has attained a requisite level of technical and practical experience in order to handle patent matters at a level of competency?

(ii) Does there exist ambiguity in titles of patent practitioners such that the public do not know whether a practitioner is of a sufficient level of competency to engage in substantive aspects of patent practice (e.g. specification drafting, validity provisions, freedom-to-operate and the like)?

(iii) Must a patent practitioner hold requisite minimal professional indemnity insurance, in order to practice?

(iv) Are there any other/special requirements for a patent practitioner to be permitted to engage in private practice?

(v) Are there any obvious deficiencies in the patent practitioner registration process/title of practitioner that may create confusion/ambiguity as to the level of competency of a practitioner to the public?

(vi) Does the local professional body have complaints/disciplinary provisions for practitioners?

(vii) Any other comments?

# **ANNEXURE C**

**Summary of Results of  
Survey / Questionnaire**



**Patent Attorney Qualifications and Practice in Relevant, Major Trading and Asia Jurisdictions**

| <b>Jurisdiction</b>  | <b>Common<br/>Wealth/Common<br/>Law</b> | <b>Ministry</b>  | <b>Separate<br/>Patent<br/>Attorney<br/>Profession<br/>From<br/>Solicitors</b> | <b>Restriction<br/>On<br/>Substantive<br/>Work</b> | <b>Qualification<br/>By<br/>Examination<br/>For<br/>Skills/Drafting</b> | <b>Technical<br/>Degree</b>                            | <b>Minimum<br/>Apprentice<br/>Ship /<br/>Articles</b>                           | <b>Residency<br/>Requirement</b> | <b>Title</b>                          |
|--|---|--|--|--|---|--|---|----------------------------------|---------------------------------------|
| <b>JURISDICTIONS<br/>WITH PATENT<br/>LAW<br/>APPLICABLE<br/>TO HONG<br/>KONG</b> |   |  |  |  |   |  |   |                                  |                                       |
| United Kingdom   | Yes                                     | Department of<br>Business<br>Innovation and<br>Skills    | Yes  | unrestricted                                       | full written drafting<br>exams  | not codified,<br>but in<br>practical<br>terms yes      | yes, two<br>years<br>supervised<br>directly by<br>qualified<br>attorney         | yes                              | Chartered<br>Patent<br>Agent/Attorney |
| Australia  | Yes                                     | Dept innovation,<br>Industry,<br>science and<br>research | Yes  | unrestricted                                       | full written drafting<br>exams  | yes  | yes, two<br>years<br>supervised<br>directly by<br>qualified<br>attorney         | yes                              | Patent<br>Attorney                    |
| New Zealand  | Yes                                     | Ministry of<br>Economic<br>Development                   | Yes  | unrestricted                                       | full written drafting<br>exams  | undergoing<br>codification                             | yes, three<br>years<br>supervised<br>directly by<br>qualified<br>attorney       | yes                              | Patent<br>Attorney                    |
| Canada   | Yes                                     | Dept Industry  | Yes  | unrestricted                                       | full written drafting<br>exams  | not codified,<br>but need<br>"technical<br>background" | yes, at least<br>one year<br>supervised<br>directly by<br>qualified<br>attorney | yes                              | Patent Agent                          |

| Jurisdiction                       | Common Wealth/Common Law | Ministry                | Separate Patent Attorney Profession From Solicitors | Restriction On Substantive Work                                      | Qualification By Examination For Skills/Drafting  | Technical Degree   | Minimum Apprenticeship / Articles                       | Residency Requirement | Title                           |
|------------------------------------|--------------------------|-------------------------|---|--|---|--|---|-----------------------|---------------------------------|
| <b>MAJOR TRADING JURISDICTIONS</b> |                          |                         |   |  |   |  |   |                       |                                 |
| China                              | No                       | N/A SIPO                | yes   | unrestricted   | multi-guess and some written. Drafting not always examined but when it is not full drafting, and is more claim drafting for CN practice, not client/foreign based | yes  | 1 year supervised internship                            | yes                   | Patent Agent                    |
| Europe                             | No                       | N/A - Intergovernmental | yes   | unrestricted   | full written drafting exams   | yes  | not codified, but practically yes                       | yes                   | European Patent Attorney /Agent |
| United States                      | To a large extent        | Department of Commerce  | yes, dual attorney and agent                        | patent agents cannot do validity or non-infringement, only attorneys | multi-guess and some written, no drafting exam  | yes  | 1 year fully supervised under qualified patent attorney | yes                   | Patent agent & patent attorney  |
| Singapore                          | Yes                      | Ministry of law         | yes   | unrestricted   | full written exams  | yes, unless grandfathered, which causes problems as older ones are |   | yes                   | Patent Agent                    |

|       |     |   |     |              |   |   |                                   |         |                                 |
|-------|-----|---|-----|--------------|---|---|-----------------------------------|---------|---------------------------------|
| India | Yes | Ministry of Commerce and Trade          | yes | unrestricted | full written drafting exams and viva-voce       | yes, but older ones may not<br>no, but generally expected Most patent attorneys/agents hold a technical qualification/degree and those who have not a technical qualification, do not undertake patent specification. | not codified, but practically yes | citizen | Patent agent or patent attorney |
| Japan | No  | Ministry of Economy, Trade and Industry | yes | unrestricted | multi-guess, written and oral, no drafting exam | do not undertake patent specification.  | under 7 year qualified attorney   | yes     | Patent Attorney                 |
| Korea | No  | Ministry of Knowledge and Economy       | yes | unrestricted | multi-guess and written, IQ drafting exam       | not codified, about 10% do not have tech degree generally the non-techs would settle into the trademark practice  | yes                               | yes     | patent Attorney                 |

| Jurisdiction                        | Common Wealth/Common Law             | Ministry  | Separate Patent Attorney Profession From Solicitors | Restriction On Substantive Work | Qualification By Examination For Skills/Drafting                              | Technical Degree  | Minimum Apprenticeship / Articles | Residency Requirement | Title  |
|-------------------------------------|--------------------------------------|---|---|---------------------------------|---|---|-----------------------------------|-----------------------|--|
| <b>JURISDICTIONS IN ASIA REGION</b> |                                      |   |   |                                 |   |   |                                   |                       |  |
| Philippines                         | No                                   | Department of Trade and Industry                          | yes   | unrestricted                    | written basic drafting exam, <u>not</u> full drafting                         | no, little drafting done in PH and not by non-tech qualified.                                 | 60hrs or 4 years as examiner      | yes                   | patent attorney, patent agent, patent consultant |
| Vietnam                             | No                                   | Ministry of Science and Technology                        | yes, dual agent and attorney                        | unrestricted                    | drafting exam, which may be full draft or partial                             | yes, must have. Not codified, however newer members entering the profession hold tech degree. | 5 years                           | yes                   | patent agent, patent attorney                    |
| Thailand                            | No, but based on UK patents Act 1977 | Department of Property, Ministry of Commerce              | yes   | unrestricted                    | Multi-guess and a simple drafting exercise, <u>not</u> full drafting          |   | no                                | yes                   | patent attorney or patent agent                  |
| Taiwan                              | No                                   | Ministry of Economic Affairs                              | yes   | unrestricted                    | multi-guess and written, <u>no</u> drafting exam                              | no  | no                                | no                    | patent attorney or patent agent                  |
| Malaysia                            | yes                                  | Ministry of Domestic Trade, Co-operatives and Consumerism | yes   | unrestricted                    | written exam, <u>not</u> full drafting  | legal or tech, but ones without tech don't do the drafting                                    | no                                | yes                   | patent agent                                     |
| Indonesia                           | No                                   | Ministry of Law and Human Rights                          | yes   | unrestricted                    | multi-guess and written, <u>claim</u> drafting only, <u>not</u> full drafting | not codified, but most have   | 4-5 months                        | yes                   | IP Consultant                                    |

# **ANNEXURE D**

**Ranking of Hong Kong Patent  
Filings 2007, 2008, 2009 and 2010**

|                              | Year  |       |       |      |
|------------------------------|-------|-------|-------|------|
|                              | 2007  | 2008  | 2009  | 2010 |
| <b>Total</b>                 | 13915 | 13570 | 11931 | 9898 |
| <b>China Patent Agent</b>    | 2246  | 2240  | 1987  | 1620 |
| <b>Marks &amp; Clerk</b>     | 1407  | 1122  | 968   | 850  |
| <b>Deacons</b>               | 550   | 595   | 510   | 466  |
| <b>Ella Cheong</b>           | 230   | 264   | 282   | 250  |
| <b>Wilkinson</b>             | 395   | 350   | 266   | 234  |
| <b>Wenping</b>               | 496   | 459   | 302   | 229  |
| <b>Mayer Brown</b>           | 337   | 354   | 276   | 188  |
| <b>Vivien Chan</b>           | 333   | 287   | 167   | 154  |
| <b>Sit Fung</b>              | 194   | 161   | 113   | 93   |
| <b>Robin Bridge</b>          | 103   | 47    | 44    | 62   |
| <b>Benny Kong</b>            | 62    | 41    | 92    | 58   |
| <b>Bird &amp; Bird</b>       | 29    | 54    | 66    | 54   |
| <b>Eagle</b>                 | 74    | 64    | 56    | 41   |
| <b>Hastings &amp; Co</b>     | 69    | 66    | 59    | 30   |
| <b>Victor Chu</b>            | 59    | 50    | 55    | 30   |
| <b>Simmons &amp; Simmons</b> | 39    | 42    | 54    | 28   |
| <b>Onc Lawyers</b>           | 8     | 46    | 59    | 27   |
| <b>Stephenson Harwood</b>    | 40    | 65    | 47    | 23   |
| <b>Ruby Yeung</b>            | 8     | 8     | 9     | 13   |
| <b>Haldanes</b>              | 17    | 11    | 16    | 12   |
| <b>Baker &amp; Mckenzie</b>  | 7     | 5     | 8     | 11   |
| <b>Hogan Lovells</b>         | 31    | 84    | 7     | 8    |
| <b>Benjamin Au</b>           | 0     | 0     | 1     | 5    |
| <b>Rebecca Lo</b>            | 19    | 33    | 9     | 3    |
| <b>Oldham</b>                | 6     | 26    | 7     | 2    |
| <b>Norton Rose</b>           | 1     | 1     | 1     | 1    |
| <b>Woo, Kwan</b>             | 1     | 0     | 0     | 1    |
| <b>Jones day</b>             | 30    | 55    | 4     | 0    |
| <b>P.C.Woo</b>               | 0     | 0     | 0     | 0    |
| <b>Rouse</b>                 | 0     | 0     | 0     | 0    |