For Bills Committee meeting on 22 December 2015

Attn: Hon Martin LIAO Cheung-kong
Chairman of the Bills Committee on patents (Amendment) Bill 2015

December 11, 2015

Opinions
of
Hong Kong Chinese Patent Attorneys Association

In general, our Association very much appreciates and supports the Bill.

Below are our further recommendations:

Relevant Sections	***Opinions of our Association***
127C (2) (about substantive examination of a short-term patent) (2) The requirements are— (a) the invention, which is the subject of the patent, is patentable under section 9A	This requirement for Short-term Patent is identical to that for Standard Patent (*cf.* Section 37U (3)(a)). There is nothing wrong for this provision, and perhaps further details will be set forth in Rules or Examination Guidelines. But anyway, our opinion is that the public may expect a Short-term Patent normally as a "petty" invention, as compared with invention of a Standard Patent; thus, the criteria of inventivity should be different too; i.e., inventivity height for a petty invention should be lower than that of a standard patent. (*Cf.* Chinese Patent Law Art. 22(3))
144A (2) (e) Prohibition on use of certain titles and descriptions (1) A person must not, in the course of or in connection with the person's business, trade or profession in Hong Kong, knowingly use or permit the use of a title or description specified in subsection (2).	1) This new section restricts use of certain titles. We agree with the restriction in general, but section 144A (2)(e) might be too harsh, because patent practitioners in Hong Kong could easily fall within the 144A(2)(e). For example, since Re-registration route stays, Chinese or UK/EP patent attorneys of course can tell their clients that they are able to obtain also Hong Kong patents by extension, and this make them criminal under section 144A (2)(e).

(2) The title or description is— … … (e) a title or description that would be likely to give the impression that the person holds a qualification, recognized by law or endorsed by the Government, for providing patent agency services in Hong Kong	2) Besides, the wording "**likely to give the impression**" is *not* an objective judgment and is actually subjected to how the clients construe the title or description., Furthermore, if punishment is criminal, in the spirit of Criminal Law, exact conditions must be defined clearly.
144A (4) Subsection (1) does not prohibit a qualified person from using, or from permitting the use of, the title solicitor, barrister, foreign lawyer, lawyer or counsel (as the case may be) in the course of or in connection with providing patent agency services in Hong Kong.	1) This section exempts HK lawyers from the above restriction, which is inappropriate. The issue to be clarified first is that, like a doctor and a dentist, so are a lawyer and a patent attorney. A doctor can not claim him/herself as being able to provide dental service, neither could a dentist, *vice versa*. To be qualified as a patent attorney, a sound **technical/science background is a prerequisite or a must**. If the Bill allows HK lawyers to describe their service as including "patent", the public may be misled - wrongly believing the lawyers could provide also technical service involved in patent issues. We suggest that HK lawyers when describing their service must specify that the patent service they provide is confined to *procedures*. For substantive matters like patentability, the public should be reminded that the capable ones are technically educated patent attorneys. 2) As said, since Re-registration route stays, Chinese or UK/EP patent attorneys of course can inform their clients that they are able to obtain also Hong Kong patents by extension, our

	Association suggests that the exemption should be revised as above (in this box under 1)) and include also the following: 144A (4) Subsection (1) does not prohibit a qualified person from using, or from permitting the use of, the title solicitor, barrister, foreign lawyer, lawyer or counsel (as the case may be) in the course of or in connection with providing patent agency services in Hong Kong; however, said patent agency services are confined to *procedural* issues; and Subsection (1) does not prohibit a Chinese, EP and UK chartered patent attorneys residing in Hong Kong from providing patent agency services in Hong Kong. Of course, patent litigation in Hong Kong remains monopoly of HK solicitors/barristers, though we would like to see that the HK solicitors/barristers should handle the litigation together with a HK patent attorney.
144A (5) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine of $500,000.	We believe that the punishment is too harsh – violation is regarded as "Offence", and a huge fine entails. We suggest the punishment be confined to "administrative punishment." For example, HKIPD may issue a warning first. If no correction is undertaken, he/she will be liable on conviction to a fine which should be far less than the HKD500,000.
	Besides, the Bill defers a concrete scheme of regulation of HK patent attorneys to a later stage. Our Association suggests that this be done as soon as possible. In other words, we suggest including a Grandfathering Scheme within the present Bill 2015 because:

	1) Nowadays it is so difficult to pass a law due to e.g. "*filibuster*", so we need to save time; and 2) Hong Kong public needs qualified patent attorneys for the patent services. As to how the Grandfathering should be, we propose the followings which should be in line with the **precedent** case - regulation of Traditional Chinese Medicine (TCM) Practitioners: - allowing Chinese, EP/UK patent attorneys who reside in Hong Kong, and have been practicing in Hong Kong for obtaining Hong Kong patents to become a HK Patent Attorney. HK lawyers (solicitors, barristers) can become HK Patent Attorneys too if they have record (for example, a tertiary education in natural science) of **technical** expertise. As said, patent litigation in Hong Kong remains monopoly of HK solicitors/barristers, though we would like to see that the HK solicitors/barristers should handle the litigation together with a HK patent attorney. As a note, our Association suggests that the title formally should read "Patent Attorney" so as to be consistent with most jurisdictions. (Some argue that "attorney" means lawyer. However, "Patent Attorney" **collectively** is ONE term, and thus, it should not be construed alone. In addition, attorney means also "agent" as can be checked in dictionaries.)
	Lastly, our Association suggests that the new system includes a "*security check*", following which, a patent application for an invention substantively completed in HK should normally be filed in HK first. This additional "*security check*" encourages local applicants to use OGP.

LAM, Sum
Chairman
of Hong Kong Chinese Patent Attorneys Association