

Hon Martin LIAO Cheung-kong

Chairman of the Bills Committee on patents (Amendment) Bill 2015

HIPP

THE HONG KONG INSTITUTE OF
PATENT PRACTITIONERS LIMITED

Dear Mr. Liao,

Thank you very much for inviting Hong Kong Institute of Patent Practitioners (HIPP) to give our view on the patents (Amendment) Bill 2015. The bill proposes:

- (A) introducing an original grant patent (“OGP”) system for granting standard patents;
- (B) refining the short-term patent system;
- (C) Implementing an interim measure for regulating local patent practitioners pending establishment of a full-fledged regulatory regime; and
- (D) other technical amendments.

The following are our views on proposals (A)-(C) above:

I. HIPP strongly supports the new OGP system and the refinements to the short-term patent system because it will provide many advantages such as those mentioned in paragraph 2 of Annex C of the Legislative Council Brief. Furthermore, we believe the new OGP system will increase patent filings by local individuals and entities and provide job opportunities to Hong Kong graduates with a science or engineering degree. HIPP urges the government to develop full searching and examining capability in-house for a full spectrum of technology as soon as possible, and ensure that the quality of the indigenous search and examination meets WIPO standards.

II. HIPP also strongly supports regulating local patent practitioners to make sure all future Hong Kong patent practitioners are well qualified to practice Hong Kong patent laws. Currently, there is generally no regulation of local patent practitioners. Any local patent practitioner is generally free to use the title of “patent agent”, “patent attorney” or the like to provide patent services in Hong Kong. Since there is no regulation, some of the local patent practitioners may not meet professional standards required to support the patent needs of local patent applicants and inventors. Therefore, there is an urgent need for the development of a full-fledged regulatory regime covering aspects such as the establishment of a professional regulatory body, accreditation, use of titles, professional discipline and training.

III. Clause 129 of the Bill adds a new Section 144A to Cap. 514 for prohibiting any person from using or from permitting the use of certain titles and descriptions 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, with certain exemptions provided. Although Section 144A provides four examples of prohibited titles, it does not provide a clear guideline to determine what other titles are or would be likely to give the impression that the person holds a qualification, recognized by law or endorsed by the Government. This in particular leaves doubt as regards those already qualified in Hong Kong and overseas who may legitimately call themselves "attorney" or "patent attorney". In our view, the new Section 144A lacks clarity, and we therefore urge the government and the legislature to enact legislation to regulate the patent agent/attorney profession as soon as possible.

IV We also have concerns that under proposed S89(2) a person (who may or may not be represented) who owns a short term patent may be deemed liable under a threats action without any possibility of cure by simply failing to provide documents (patent documents and search report) which are in any event available on the IPD website

The way S.89A(2) is drafted means that any failure to provide such documents within 7 days will make the issuer of threats (which can be done by simply asking for a licence or writing a standard letter before action) liable for groundless threats even though it may otherwise be possible to justify the same. This goes far beyond what the threats provisions are intended to achieve. Even in the absence of such provision a person unjustifiably threatening proceedings (e.g. because the patent is invalid) will still be liable. There is no need for the additional hurdle of providing documents, although such could be made a precondition of bringing proceedings and the courts could well deal with the issue by way of an adverse costs order or striking out.

Thank you for your kind attention.

Yours sincerely,

Dr. Jacqueline Lui
President

Dr. Kam Law
Vice President

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Patent Practitioners Limited