

Practice Guidance on the Use of Professional Titles and Descriptions (PG2017/1)

The notes below are produced on behalf of the Hong Kong Institute of Patent Attorneys (HKIPA) as guidance to members on the use of professional titles and descriptions in relation to patent practice. The HKIPA is in the course of seeking approval from the Hong Kong Intellectual Property Department (HKIPD) on this practice guidance. It is important to note that, prior to the approval by the HKIPD, these notes only set out common practice within the patent professions but cannot guarantee that such practice will be acceptable to the Intellectual Property Department in all circumstances.

If you have questions or comments regarding the content of these notes, or suggestions for future topics, please contact the HKIPA Council (info@hkipa.org.hk).

1. Under the current Hong Kong Patents Ordinance, there is no statutory regulation of professional requirements/qualification on provision of patent agency services (including the use of “patent agent”, “patent attorney” or other similar titles). While the Hong Kong Government has recognized the need of a full-fledged regulatory regime for the patent profession in the long run, including the establishment of a professional regulatory body, accreditation, use of titles, professional discipline, training, service monopoly and statutory backing, interim measure was proposed to reserve certain specific titles which may likely be conferred on qualified patent practitioners exclusively under the future full-fledged regulatory regime.
2. On 2nd June, 2016, the Legislative Council passed the Patents (Amendment) Bill 2015 (the “Bill”). Amongst other reforms, section 144A of the Bill introduces an interim measure for regulating Hong Kong patent practitioners, reserving certain specific titles and descriptions which would likely give the misleading impression that a person's qualification for providing patent agency services is endorsed by the Government or recognized by Hong Kong law.
3. Specifically, as an interim measure, section 144A subsection 2(a)-(d) stipulates that certain specific titles and descriptions, i.e. "registered patent agent", "registered patent attorney", "certified patent agent" and "certified patent attorney" (the "Prohibited Titles") must not be used in Hong Kong.
4. The prohibitive scope of the interim measure under section 144A subsection 2(e) also extends to any title or description which might reasonably cause anyone to believe that the person using or permitting the use of the title or description holds a qualification that is specifically granted for approving that person to provide patent agency services.
5. Any person who violates the foregoing provisions commits an offence and is liable on conviction to a fine of \$500,000. Particular care is therefore needed when using professional titles in Hong Kong patent practice.
6. HKIPA therefore does not permit its members to use the Prohibited Titles in the course of or in connection with their business, trade or profession in Hong Kong as from 1 October 2017.
7. Where members hold a foreign patent attorney/patent agent qualification, they should note that section 144A subsection 3 of the Bill further provides an exemption allowing the legitimate and reasonable use of professional titles that have been lawfully acquired outside Hong Kong. Nevertheless, such professional titles must solely relate to the member's qualification for lawfully providing patent agency services in the relevant jurisdiction outside Hong Kong. It is also required by the provision to clearly indicate the jurisdiction in such professional titles. HKIPA recognizes that such exempted professional titles include "Chinese Patent Attorney", "Chinese Patent Litigator", "UK Chartered Patent Attorney", "US Patent Attorney"

Exhibit I

Section 144A of Patents (Amendment) Ordinance 2016

“144A. 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).
- (2) The title or description is—
 - (a) certified patent agent;
 - (b) registered patent agent;
 - (c) certified patent attorney;
 - (d) registered patent attorney; or
 - (e) a title or description which may reasonably cause anyone to believe that the person using or permitted to use the title or description holds a qualification—
 - (i) that is specifically granted for approving that person to provide patent agency services in Hong Kong; and
 - (ii) that is recognized by law or endorsed by the Government.
- (3) Subsection (1) does not prohibit a person from using, or from permitting the use of, a title or description that—
 - (a) solely relates to the person’s qualification for lawfully providing patent agency services in a jurisdiction outside Hong Kong; and
 - (b) clearly indicates the jurisdiction.
- (4) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine of \$500,000.”