

Patents Registry
Intellectual Property Department
Hong Kong SAR Government
Patents Examination Guidelines

Section 1: Novelty

Meaning of novelty

- 1.1. Section 9A(1) of the Ordinance sets out that the first condition for patentability of an invention is its novelty which means that no invention will be granted a patent if it is not new. The question of novelty is further addressed under section 9B(1) of the Ordinance, which states that an invention shall be considered new if it does not form part of the state of the art.

State of the art

- 1.2. Section 9B(2) of the Ordinance defines the term “state of the art” as everything made available to the public (whether in the Hong Kong Special Administrative Region (the Hong Kong SAR) or elsewhere) by means of a written or oral description, by use, or in any other way-
 - (a) before the date of filing of the corresponding designated patent application in relation to an application for a standard patent (R) for the invention or, if priority is claimed, the date of priority; or
 - (b) before the date of filing of an application for a standard patent (O) for the invention or, if priority is claimed, the date of priority; or
 - (c) before the date of filing of an application for a short-term patent for the invention or, if priority is claimed, the date of priority.
- 1.3. Additionally, pursuant to section 9B(3) of the Ordinance, the state of the art shall be considered as comprising the contents of all

(3) (if the first disclosure of the invention did not take place on the opening date of such exhibition or meeting) the date of such first disclosure

(sections 11A(3)(b) and 15(2)(f) of the Ordinance; section 10 of the Rules).

Priority right

- 1.51. Paris Convention as applied to the Hong Kong SAR, among other things, entitles an applicant of a patent application for an invention first filed in or for one signatory state to make a priority claim based on the first application in one or more subsequent patent application(s) for the *same invention* in other signatory states ~~so that the subsequent application(s) is/are treated as having the same date of filing of the first application~~, provided that the subsequent application(s) is/are filed within 12 months after the date of filing of the first application.¹
- 1.52. In respect of a patent granted in the Hong Kong SAR by virtue of a patent application for an invention in respect of which the patent proprietor enjoys a right of priority, the effect of the right of priority is that the patent cannot be invalidated only because any subject-matter disclosed in the earlier corresponding patent application for the same invention was made available to the public after the date of filing of the earlier application (see sections 11C(2) (for standard patent (R) applications), 37F(2) (for standard patent (O) applications), and 112(2) (for short-term patent applications) of the Ordinance).
- 1.53. During substantive examination of a standard patent (O) application or a short-term patent, our examiners will determine the patentability of an invention underlying the patent application or patent having regard to whether the applicant or proprietor is entitled to any priority claim (sections 37U(4)(a) (for standard patent (O) applications) and 127C(3)(a) (for short-term patents) of the Ordinance). In this connection, the priority right is of particular importance when there is a potential prior art that is published on

¹ Article 4 of the Paris Convention.