

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

standard and short-term applications as filed in the Hong Kong SAR as well as all designated patent applications as filed in the designated patent offices which are regarded as earlier in time but which were published on or after the date of filing of the application (or date of filing of the corresponding designated patent application in relation to application for the standard patent (R)) or, if priority is claimed, the date of priority.

- 1.4. It is important to note that the state of the art comprising contents of the applications falling within section 9B(3) of the Ordinance is only applicable for the assessment of novelty. Those applications are not to be considered in deciding whether there has been an inventive step (see section 9C(2) of the Ordinance and section 2.4 of these Guidelines - “Inventive Step- State of the art”).
- 1.5. The state of the art covers everything disclosed in the Hong Kong SAR or elsewhere in the world. Disclosure by means of a written or oral description, or by use is explicitly included in section 9B(2) of the Ordinance. In practice, the majority of the prior art will consist of written disclosures in books, technical journals and patent specifications. Non-written disclosures may include sound recordings, videos, and public use (such as demonstrations, displays and trial samples of a product).
- 1.6. There is no time limit on the age of the disclosure.
- 1.7. The meaning of “made available to the public” was explained in Bristol-Myers Co’s Application [1969] RPC 146 as communication of information, whether in documentary form or in the form of the invention itself, to a single member of the public without inhibition. This phrase was also considered in PLG Research Ltd. v Ardon International Ltd. [1993] FSR 197 in the context of prior use where it was confirmed that “*to form part of the state of the art, the information given by the use must have been made available to at least one member of the public who was free in law and equity to use it.*”
- 1.8. Further guidance on the question of “made available to the public” can be obtained from Pall Corporation v Commercial Hydraulics (Bedford) Ltd. (1990) FSR 329 in which the court held that the sending out of samples under confidence to recipients who knew that they were experimental and secret did not make them available to the public.

- 1.9. Therefore, if disclosure is made in confidence, either expressed or implied, the disclosure will not be regarded as forming part of the prior art base.
- 1.10. Internal documentation may, however, become public by its subsequent use. In Monsanto Co (Brignac's) Application [1971] RPC 153, the court held that there was prior disclosure when the company published a document by supplying to its salesmen who were expected to distribute it to potential customers. For discussion on disclosure that is made against the wish of the patentee, please refer to sections 1.46 – 1.50 of these Guidelines - “Non-prejudicial disclosure”.

Test for novelty

- 1.11. Novelty is a question of whether the invention has been anticipated in a previous disclosure. It follows that a claim that is not new is said to be anticipated. In SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] RPC 10, the House of Lords held there were two requirements for anticipation: prior disclosure and enablement, both of which were distinct concepts.

Prior disclosure

- 1.12. The courts of the Hong Kong SAR have affirmed the English case of General Tire & Rubber Co. v Firestone Tyre & Runner Co. Ltd. [1972] RPC 457 as a leading case when considering novelty (see Octopus Cards Limited v Odd HK Limited, unrep., HCMP 104/2007, 17 March 2009, L. Chan DHCJ; and Environmental Systems Product Holdings Inc v DPC Technology Ltd. [2010] 3 HKLRD 212). In General Tire, the English Court of Appeal set out a “reverse infringement” test in determining whether or not a claim has been anticipated by a prior disclosure:

“If the prior inventor’s publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee’s claim if carried out after the grant of the patentee’s patent, the patentee’s claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated. The prior inventor, however, and the patentee may have approached the same device from different starting points and may for this

reason, or it may be for other reasons, have so described their devices that it cannot be immediately discerned from a reading of the language which they have respectively used that they have discovered in truth the same device; but if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated."

- 1.13. A disclosure which contains directions that are capable of being carried out in different manners, some of which fall within the claim in question and others do not, does not anticipate the claim. This was discussed in *General Tire* as follows:

"If, on the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least as likely to be carried out in a way which would not do so, the patentee's claim will not have been anticipated, although it may fail on the ground of obviousness. To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented ... A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentees."

- 1.14. Further guidance can be obtained from *SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent* [2006] RPC 10 where Lord Hoffmann explained as follows:

"But the infringement must not merely be a possible or even likely consequence of performing the invention disclosed by the prior disclosure; it must be necessarily entailed. If there is more than one possible consequence, one cannot say that performing the disclosed invention will infringe. The flag has not been planted on the patented invention, although a person performing the invention disclosed by the prior art may carry it there by accident or (if he is aware of the patented invention) by design."

- 1.15. A prior disclosure must be construed as it would have been understood by the person skilled in the art at the date of the

disclosure and not in the light of the subsequent patent (see SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] RPC 10). Although, as noted at section 2.7 of these Guidelines when considering the question of inventive step, the common general knowledge should be determined at the priority date of the invention. For discussion on "person skilled in the art", please refer to sections 2.14 to 2.20 of these Guidelines.

- 1.16. The House of Lords in SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent also affirmed the reasoning of Lord Westbury LC in Hill v Evans (1862) 31 LJ(NS) 457, 463 who said that the person skilled in the art must be able practically to apply the discovery "*without the necessity of making further experiments and gaining further information before the invention can be made useful.*" This is different when considering the question of enablement in which the person skilled in the art may be assumed to be willing to make trial and error experiments before the invention can be made useful (see section 1.19 below).
- 1.17. It is now settled law that anticipation requires prior disclosure of subject-matter which, when performed, must *necessarily* infringe the patented invention. Lord Hoffman in Smithkline Beecham Plc's (Paroxetine Methanesulfonate) Patent further distinguished it from the test of inventive step as follows:

"it is this requirement that performance of an invention disclosed in the prior art must necessarily infringe the patent which distinguishes novelty from obviousness. If performance of an invention disclosed by the prior art would not infringe the patent but the prior art would make it obvious to a skilled person how he might make adaptations which resulted in an infringing invention, then the patent may be invalid for lack of an inventive step but not for lack of novelty."

Enablement

- 1.18. Enablement is the second requirement for anticipation (as held in SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] RPC 10 and also as discussed by the House of Lords in Asahi Kasei Kogyo KK's application [1991] RPC 485). This means that the

disclosure must have disclosed sufficient information to enable the person skilled in the art to perform the invention. For example, a disclosure of the existence of a chemical substance is not enabling if the skilled person would not know from the information available how to produce or obtain it.

- 1.19. For enablement, the person skilled in the art is assumed to carry out reasonable experimentation and error correction to put the disclosed invention to work (Research in Motion v Inpro [2006] RPC 20). Applying this principle to the facts of the case in SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] RPC 10, Lord Hoffman concluded that Synthon's application had disclosed the existence of the crystalline form of paroxetine methanesulfonate even though the wrong infrared spectrum was provided by Synthon and the procedure for making it would not work as stated, because some experimentation with solvents by a person skilled in the art would have produced the crystalline form.
- 1.20. As a general conclusion, a prior art is novelty-destroying prior art for an invention under a patent application if such prior art discloses not only clear and unmistakable directions to do something which would inevitably infringe the patent for the invention (if granted), but also sufficient information for a person skilled in the art to reproduce the invention.

Means of disclosure

- 1.21. By section 9B(2) of the Ordinance, the state of the art may include disclosure by means of a written or oral description, by use, or in any other way.

Disclosure by means of a written or oral description

- 1.22. Ordinarily, lack of novelty may be apparent from what is explicitly stated in a published document. A document may form part of the state of the art if it can be inspected as of right by the public, whether on payment of fee or not. There is no requirement to prove that anybody, including the applicant, actually saw or read the disclosure provided the relevant disclosure was in public, e.g. in

a remote library (see Lux Traffic Controls Ltd. v Pike Signals [1993] RPC 107).

- 1.23. There is no restriction in the language of the disclosure. Prior publication in a foreign language will suffice.
- 1.24. A publication date which appears on a document is assumed to be the date on which publication actually took place. Where only a specific month or year is indicated as the printing date, the examiner will assume the last day of the month or the year as the date of disclosure.
- 1.25. Similarly, a date in connection with a web page may be considered as its actual date of publication. The date of playing or showing of a film, broadcast or cable programme is assumed to be the date of disclosure.
- 1.26. Where the date of disclosure is disputed by the applicant, evidence adduced by the applicant to establish otherwise is required.
- 1.27. Disclosure by oral description, which is explicitly included in section 9B(2), is subject to evidential proof of what has been disclosed/said.
- 1.28. It is not permissible to demonstrate lack of novelty on a mosaic of documents (see British Ore Concentration Syndicate Ltd v Mineral Separation Ltd, 26 RPC 124). Therefore, the prior art disclosure must be entirely comprised within a single document (as distinct from inventive step, see sections ~~2.17 and~~ 2.28 and 2.28A of these Guidelines). However, where a cited document makes cross-reference to a disclosure in another document in such a way as to indicate that this disclosure is intended to be included in that of the cited document, then it is possible that these documents could be combined to be read together as though they were a single document (Sharp & Dohme Inc. v Boots Pure Drug Co Ltd. [1927] 44 RPC 23).

Disclosure by prior use

- 1.29. The state of the art as set out by section 9B(2) of the Ordinance includes everything that is made available to the public by use. The ability of a public prior use to destroy novelty was affirmed in the Hong Kong SAR case of SNE Engineering Co. Ltd. v Hsin Chong Construction Co. Ltd. [2014] 2 HKLRD 822:

"... a person skilled in the art would be able to work out the method if he observed what happened at the Site from the public area. The court is not concerned whether there was actually anyone who witnessed the whole process from the public podium or the public car park."

1.30. Novelty is destroyed by prior use of a product, for example, sale of a product, if an analysis of the product using available techniques is sufficient to inform a person skilled in the art that it falls within the scope of the claims; a complete analysis of a prior used product is not necessary (see T 952/92). Further guidance can be obtained from Milliken Denmark AS v Walk Off Mats Ltd and Anr [1996] FSR 292 which was a case of infringement of a patent relating to the use of perforations in the backing of mats. In this case the court held that the supplying of mats before the priority date to customers who were under no fetter of confidence amounted to prior use even though the perforations in the mats were not visible to the naked eye for their function. The perforations in the plaintiff's mats would have been revealed by an easy and ordinary investigative technique. The knowledge of the perforations would enable the skilled person to perform the invention.

1.31. It is relevant when considering prior use to determine whether the public had an article in their possession to handle, measure and test or whether they could merely look at it. Some useful guidance on the nature of the information disclosed by a prior use can be obtained from Lux Traffic Controls Ltd. v Pike Signals [1993] RPC 107 where Aldous J stated the following:

"There is a difference between circumstances where the public have an article in their possession to handle, measure and test and where they can only look at it. What is made available to the public will often differ in the circumstances. In the latter case it could be nothing material; whereas in the former the public would have had the opportunity of a complete examination."

1.32. In Merrell Dow Pharmaceuticals Inc v N H Norton & Co Ltd [1996] RPC 76 the invention was the making of the metabolite within the human body by the ingestion of the known anti-histamine drug terfenadine. Lord Hoffmann held in this case that the use of a product makes an invention part of the state of the art only so far

as that use makes available the necessary information. Therefore, when volunteers in the clinical trial took terfenadine for the sole purpose of swallowing them (that is, it was not open to them to analyze the terfenadine to discover its composition), there was no anticipation by use even though the volunteers had made the metabolite in their livers.

- 1.33. Similarly, when a demonstration or display of a product offers no possibility to analyze its contents, the demonstration or display will not amount to a disclosure by use.
- 1.34. The required standard of proof in dealing with evidence relating to alleged prior use is the balance of probabilities (applied in SNE Engineering Co. Ltd. v Hsin Chong Construction Co. Ltd. [2014] 2 HKLRD 822).

Implicit disclosure

- 1.35. Implicit features which are derived directly and unambiguously by a person skilled in the art from a prior art document may also be taken into account in the assessment of novelty. For example, where the elastic properties of rubber are relied upon in a document that does not explicitly state that rubber is an “elastic material,” a claim to an “elastic material” is anticipated because the rubber taught in the prior art inherently is an “elastic material”.
- 1.36. It is important to note the limitation to subject-matter “derivable directly and unambiguously” from the prior art. Difficulties may arise in determining what would have been understood by the skilled person when the prior disclosure consists of photographs and drawings. A useful guidance can be obtained from C. Van der Lely N.V. v Bamfords Ltd. [1963] RPC 61, 71 where Lord Reid stated that the question to ask, assisted where necessary by evidence, when considering photographs is “*what the eye of the man with appropriate engineering skill and experience would see in the photograph*”. He further explained that “*where the evidence is contradictory the judge must decide. But the judge ought not, in my opinion, to attempt to read or construe the photographs himself; he looks at the photograph in determining which of the explanations given by the witnesses appears to be most worthy of acceptance.*”

- 1.37. In examining whether there is support for a feature in a drawing without any written description, the contents or measurements inferred from the drawing may not be taken by the examiner as prior disclosure.
- 1.38. An invention will also lack novelty if following the teaching in the prior art will inevitably result in something being made or done which falls within the claims provided the teaching is clear and unambiguous. Thus, in Merrell Dow Pharmaceuticals Inc v N H Norton & Co Ltd [1996] RPC 76 (see section 1.32 above), which related to a claim to a metabolite formed in the body after ingestion of the known anti-histamine drug terfenadine, the metabolite was held to be anticipated not by prior use but by prior disclosure. The terfenadine specification taught that the ingestion of terfenadine would produce a chemical reaction in the body and for the purposes of working the invention in this form, this was considered to be a sufficient description that led to the inevitable result of making the metabolite. In other words, the metabolite was part of the state of the art under the description.
- 1.39. In Kirin-Amgen Inc. v Roche Diagnostics GmbH [2002] RPC 1, it was held that “*the law of patents is ultimately concerned with practicality*”, and so a prior art experiment which reliably produced a particular result on “*more than 99 percent of the occasions on which it is conducted*” would be regarded as “*inevitably*” leading to the result in question.

Errors in prior art documents

- 1.40. Prior art documents may contain errors. Some useful guidance can be obtained from Dr. Reddy's Laboratories (UK) Ltd v Eli Lilly and Co Ltd. [2008] EWHC 2345 (Pat), [2009] FSR 5 where it was held that where the skilled person would have recognised that there were errors in a prior disclosure, the question to be considered was whether there was a clear and unambiguous disclosure of the invention, not whether the person skilled in the art would, on balance, have concluded that the document was disclosing the invention. Therefore, if, using common general knowledge, the skilled person would have recognized that the disclosure of a relevant prior art document contained errors, and would have

identified what the only possible correction should be, the corrected material forms part of the state of the art.

Selection inventions

- 1.41. An invention that involves the selection of individual elements, sub-sets, or sub-ranges from a broader class which has been disclosed only in general terms is generally referred to as a “selection invention”.
- 1.42. The general principle in the evaluation of a selection invention is that a disclosure of a generalised class may not take away the novelty of a subsequent claim to a member of the class. For example, a disclosure of a “metal coil spring” is not a disclosure of a “coil spring made of copper”, and thus may not be used to attack the novelty of such claim.
- 1.43. On the other hand, prior disclosure of a specific term may take away the novelty of a subsequent claim to a generalised class. For example, a disclosure of “coil spring made of copper” may take away the novelty of “metal coil spring”.
- 1.44. Prior disclosure of a comparatively small and restricted number of possible alternatives may be taken to be a disclosure of each and every member of the class. For example, in Norton Healthcare Ltd v Beecham Group Plc (BL C/62/95) Jacob J held that a prior suggestion of a combination of sodium or potassium clavulanate with amoxycillin or ampicillin trihydrate was a disclosure of each of the four possible combinations.
- 1.45. In determining the novelty of a technical feature defined by a range of values, such as the dimensions of a component, temperature, pressure, and the content of components in a composition, the Registry will adopt the following approach:
 - (a) Where the values or numerical range disclosed in a prior art document fall entirely within the range of a claimed technical feature, the prior art document deprives the claimed feature of novelty.

Example 1

The claimed feature is a copper-based shape memory alloy, comprising 10-35% (weight) zinc, 2-8% (weight) aluminium, and copper as the remainder. If the prior art document discloses a copper-based shape memory alloy comprising 20% (weight) zinc and 5% (weight) aluminium, it will take away the novelty of the claimed feature.

Example 2

The application claims a trolley oven for heat treatment, and its arch liner has a thickness of 100-400 mm. If the prior art document discloses a trolley oven for heat treatment with the arch liner having a thickness of 180-250 mm, it will take away the novelty of the claimed feature.

- (b) Where the numerical range disclosed in a prior art document and that of a claimed feature partially overlap with each other or have at least a common end point, the prior art document deprives the claimed feature of novelty.

Example 1

The claimed feature is a process for making silicon nitride ceramics with a calcination time in the range of 1-10 hours. If the prior art document discloses a process for making silicon nitride ceramics with a calcination time in the range of 4-12 hours, overlapping the calcination time of 4-10 hours, it will take away the novelty of the claimed feature.

Example 2

The claimed feature is a process for plasma-sprayed coating using the power of the spray gun in the range of 20-50 kW. If the prior art document discloses a plasma-sprayed coating process using the power of the spray gun in the range of 50-80 kW with a common end point of 50kW, the prior art document will take away the novelty of the claimed feature.

- (c) The two end points of a numerical range disclosed in a prior art document take away the novelty of a claimed feature defined by discrete numerical values including any of the two disclosed end points, but does not take away the novelty of a claimed

feature defined by discrete values that fall between the two disclosed end points.

Example

The claimed feature is a process for making titanium dioxide photocatalyst with a drying temperature of 40°C, 58°C, 75°C, or 100°C. If the prior art document discloses a process for making titanium dioxide photocatalyst with a drying temperature of 40°C -100°C, it will take away the novelty of the claimed feature with a drying temperature of 40°C or 100°C, but not if it is 58°C or 75°C.

- (d) Where the numerical values or numerical range of a claimed feature fall within the range disclosed in a prior art document, and do not have any common end point with it, the prior art document does not take away the novelty of the claimed feature.

Example 1

The claimed feature is a piston ring for internal combustion engine and it has a diameter of 95 mm. If the prior art document discloses a piston ring of 70-105 mm in diameter for internal combustion engine, it will not take away the novelty of the claimed feature.

Example 2

The claimed feature is an ethylene-propylene copolymer with a polymerization degree in the range of 100-200. If the prior art document discloses an ethylene-propylene copolymer with a polymerization degree in the range of 50-400, it will not take away the novelty of the claimed feature.

Non-prejudicial disclosure

- 1.46. “Non-prejudicial disclosure” means, in relation to an invention, a disclosure of the invention which is not to be taken into consideration for the purposes of determining whether or not the invention forms part of the state of the art (as defined in section 2(1) of the Ordinance) provided that the following conditions are satisfied—

- (a) the disclosure occurred no earlier than 6 months before
 - (i) *(as regards standard patent (O) or short-term patent applications)* the date of filing of a patent application for the invention; or
 - (ii) *(as regards standard patent (R) applications)* the date of filing of the corresponding designated patent application for the invention; and
- (b) the disclosure was due to or in consequence of either—
 - (i) an evident abuse in relation to the applicant or a proprietor of the invention for the time being, or
 - (ii) a display of the invention by the applicant or a proprietor of the invention for the time being at a specified exhibition or meeting.

(see sections 37B (for standard patent (O) applications), 11A (for standard patent (R) applications) and 109 (for short-term patent applications) of the Ordinance)

Disclosure due to evident abuse

1.47. In the absence of any statutory definition, the term “evident abuse” generally refers to disclosure of an invention against the wish of the patent applicant or the proprietor of the invention. Some useful guidance can be obtained from T 585/92 where the EPO Technical Board of Appeal held that for a disclosure to be an “evident abuse” in relation to the patentee, the alleged abuser must have made the disclosure with actual intent to cause harm to the patentee, or with actual knowledge that some of such harm would or could reasonably be expected to result from the disclosure.

1.48. For the purposes of making a claim on non-prejudicial disclosure that was due to, or in consequence of, an evident abuse in relation to a standard/short-term patent application or a short-term patent, the patent applicant or proprietor must, when filing the patent application or during formality or substantive examination, file—

- (a) a statement stating that there has been an evident abuse; and

(b) written evidence, in the form of statutory declaration or affidavit, supporting the statement.

(see sections 31ZR (for standard patent (O) applications) and 74A (for short-term patent applications) of the Rules)

Disclosure at exhibitions or meetings

1.49. Disclosure of an invention at any of the following exhibitions or meetings can be claimed as non-prejudicial—

(a) For standard patent (O) or short-term patent application for the invention (see sections 37B(2)(b)(ii) (for standard patent (O) applications) and 109(b) (for short-term patent applications) of the Ordinance)

(i) an official or officially recognized international exhibition within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to the Hong Kong SAR

(b) For standard patent (R) application for the invention (see section 11A(2)(b)(ii) of the Ordinance and section 2D of the Rules)

(i) an official or officially recognized international exhibition within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 as applying to the Hong Kong SAR; or

(ii) an international exhibition sponsored or recognized by the Central People's Government; or

(iii) an academic or technological meeting organized by –

(1) a competent agency of the Central People's Government; or

(2) a national academic or technological association recognized by the Central People's Government.

1.50. A patent applicant must comply with the following filing requirements in support of a claim on non-prejudicial disclosure

based on display of the invention at a qualified exhibition or meeting—

(a) For a standard patent (O) or short-term patent application for the invention, the applicant must provide in the application as filed—

- (i) a statement to the effect that the invention had been so displayed (section 37B(3)(a) (for standard patent (O) applications) or 109 (for short-term patent applications) of the Ordinance); and
- (ii) the following evidence in support of the statement:
 - (1) a certificate, issued by the authority responsible for holding the exhibition, stating that the invention was displayed at the exhibition and the date of the first disclosure of the invention at the exhibition; and
 - (2) an identification of the invention duly authenticated by the authority.

(see section 31A (for standard patent (O) applications) or 70 (for short-term patent applications) of the Rules)

(b) For a standard patent (R) application for the invention, the applicant must—

- (i) *(at the time of filing the corresponding designated patent application)* state in accordance with the law of the designated patent office relating to non-prejudicial disclosure that the invention had been so displayed (section 11A(3)(a) of the Ordinance);
- (ii) *(in the request to record the designated patent application)* provide a statement indicating—
 - (1) the name and place of the exhibition or meeting at which the invention was first disclosed;
 - (2) the opening date of such exhibition or meeting; and

(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, 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 or after the priority date claimed but before the date of filing of the patent application that is being examined.

¹ Article 4 of the Paris Convention.

Claiming priority: standard patent (O) applications and short-term patent applications

1.54. An applicant for a standard patent (O) or short-term patent for an invention can claim a right of priority based on—

- (a) a previous Hong Kong SAR standard patent (O) or short term patent application for the same invention; or
- (b) a previous non-Hong Kong SAR application for a patent or other protection for the same invention in or for a Paris Convention country or a WTO member country, territory or area,

provided that the subsequent standard patent (O) or short-term patent application is filed within 12 months after the date of filing of the previous application (see sections 37C(2) (for standard patent (O) applications) and 110(1A) (for short-term patent applications) of the Ordinance).

1.55. If a standard patent (O) or short-term patent application is filed more than 12 months after the date of filing of the previous application, the applicant may, on compliance with the relevant requirements and filing within the prescribed time limit, apply to the Registrar for restoring the priority right of the patent application (sections 37D (for standard patent (O) applications) and 110A (for short-term patent applications) of the Ordinance; for details, please refer to sections 14.35 to 14.40 of these Guidelines).

1.56. An applicant of a standard patent (O) or a short-term patent application who claims priority must file with the Registrar a statement of priority with the following particulars of the previous application based on which the priority is claimed, and copies of supporting documents relating to the previous application (see section 1.58 below)—

- (a) the date of filing of the previous application;
- (b) the application number of the previous application; and
- (c) the country, territory or area in or for which the earlier application was filed.

(sections 31C(6) (for standard patent (O) applications) and 69(6) (for short-term patent applications) of the Rules)

1.57. The statement of priority must be filed with the Registrar either at the time of filing the patent application under Patents form OP1 (for standard patent (O) applications) or Patents form P6 (for short term patent applications), or within 16 months from the earliest priority date claimed under Patents form OP5 provided that the conditions set out in section 31C(5) (for standard patent (O) applications)² or 69(5) (for short-term patent applications)³ of the Rules are complied with.

1.58. If the previous application is a non-Hong Kong SAR application, the statement of priority must be accompanied by—

- (a) a copy of the previous application; and
- (b) a copy of the certificate issued by the authority that received the previous application stating the date of filing of the previous application.

(sections 31C(7)(for standard patent (O) applications) and 69(7) (for short-term patent applications) of the Rules)

1.59. If the previous application is a Hong Kong SAR application, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time (sections 31C(8)(for standard patent (O) applications) and 69(8) (for short-term patent applications) of the Rules).

1.60. If the previous application is not in one of the official languages, the Registrar may require filing of the following documents during

² The conditions are that—

- (a) the statement of priority is accompanied by the prescribed fee; and
- (b) either one of the following—
 - (i) the applicant has not made a request for early publication of the subsequent application;
 - (ii) if the applicant has made the request—the request is withdrawn before preparations for publication of the subsequent application are completed.

³ The conditions are that—

- (a) the statement of priority is accompanied by the prescribed fee; and
- (b) preparations for publication of the specification of the short-term patent have not been completed.

substantive examination (unless they are filed by the patent applicant or proprietor at the earlier stage)—

- (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent, as the case requires; or
- (b) if the standard patent (O) application or the short-term patent for which priority is claimed is a translation of the previous application – a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate (see section 13.92 of these Guidelines – “Translation of documents”).

(section 56B(5) of the Rules)

Claiming priority: standard patent (R) applications

1.61. Pursuant to section 11B(3) of the Ordinance, the proprietor or the proprietor’s successor in title of a designated patent application for an invention enjoys, for the purpose of filing a standard patent (R) application for the same invention, the same right of priority as the proprietor enjoys in respect of the designated patent application. Such a right of priority may be claimed where an earlier application for a patent or other protection for the same invention was filed within 12 months before the date of filing of the designated patent application in or for a Paris Convention country or a non-Paris Convention country, territory or area that fulfills the conditions set out in section 1.62 below (see sections 11B(1) – (3) of the Ordinance).

1.62. If the earlier application was filed in or for a non-Paris Convention country, territory or area, the following conditions must be met for the purpose of establishing a priority right in a standard patent (R) application—

- (a) the right of priority granted by the designated patent office is consequent on an international agreement that applies to the Hong Kong SAR; and

- (b) the agreement provides for the grant of such priority on the basis of a first filing made in or for that non-Paris Convention country, territory or area subject to conditions equivalent to those laid down in the Paris Convention.

(see section 11B(2) of the Ordinance)

1.63. An applicant for a standard patent (R) who wishes to claim priority must provide the statement of priority in the Patents form P4 for a request to record by stating—

- (a) the date of priority claimed; and
- (b) the country in which the earlier application was filed.

(see section 15(2)(e) of the Ordinance)

1.64. Any priority claim in a standard patent (R) application must be made *at the time of filing* the request to record a designated patent application (see sections 11B(4) and 15(2)(e) of the Ordinance).

The requirement on “the same invention” for the purpose of claiming priority in standard patent (O) or short-term patent applications

1.65. The expression "the same invention" in sections 37C(2) (for standard patent (O) applications) and 110(1A) (for short-term patent applications) of the Ordinance means that the subject-matter of a claim in a patent application in which a priority claim is made by virtue of an earlier application must be explicitly or inherently disclosed in the priority document, including any features implicit to a person skilled in the art.

1.66. When claiming priority in a standard patent (O) or short-term patent application, it is not necessary that all elements of the invention for which priority is claimed appear among the claims formulated in the previous application. Priority may still be granted for the subsequent patent application for an invention if the documents of the previous application as a whole has specifically disclosed the elements of the invention (sections 37E(5) (for standard patent (O) applications) and 111(5) (for short-term patent applications) of the Ordinance).

- 1.67. The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely implied or referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. On the other hand, exact correspondence is however not required. It is enough that, on a reasonable assessment, there is in substance a disclosure of the combination of all the important elements of the claim.

Multiple Priorities

- 1.68. Multiple priorities may be claimed in respect of a patent application, and where appropriate, multiple priorities may be claimed for any one claim (sections 11B(5)(c) (for standard patent (R) applications), 37E(2) (for standard patent (O) applications) and 111(2) (for short-term patent applications) of the Ordinance).
- 1.69. If multiple priorities are claimed in respect of a standard patent (O) application or a short-term patent application, a time limit that runs from the date of priority is to run from the earliest date of priority (sections 37E(3) (for standard patent (O) applications) and 111(3) (for short-term patent applications) of the Ordinance).
- 1.70. If one or more priorities are claimed in respect of a standard patent (O) application or a short-term patent application, the right of priority shall cover only those elements of the application that are included in the previous application(s) based on which the priority is claimed (sections 37E(4) (for standard patent (O) applications) and 111(4) (for short-term patent applications) of the Ordinance).

For instance, if the present patent application describes and claims two embodiments (A and B) of an invention, A being disclosed in an earlier application X and B in a another earlier application Y, the applicant may claim priority for the appropriate parts of the present application based on both earlier applications, i.e. embodiment A is claimed to have the priority date of application X and embodiment B is claimed to have the priority date of application Y.

1.71. However, it is generally not permitted to make a mosaic of the priority documents.

For instance, if the priority claim in the present patent application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, but neither of the earlier applications disclosed the combination of C and D, then a claim to that combination in the present patent application will be entitled only to the date of filing of the present application itself.