

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

Section 7: Kinds of claims

Product and process claims

7.1 There are two basic kinds of claim, viz. claim to a physical entity (product, apparatus), aka "*product claim*" and claim to an activity (process, use), aka "*process claim*".

(a) The subject matter of a product claim includes a substance or composition (e.g. a chemical compound or a mixture of compounds) and any physical entity (e.g. a(n) object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill.

Examples:

- "*a steering mechanism incorporating an automatic feedback circuit ...*";
- "*a woven garment comprising ...*";
- "*an insecticide consisting of X, Y, Z*";
- "*a communications system comprising a plurality of transmitting and receiving stations*"

(b) A process claim is applicable to all kinds of activities in which the use of some material products for effecting the process is implied. Such activities may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things. The protection conferred by a process claim extends to products directly obtained by the process (see section 73(c) of the Ordinance).

Independent and dependent claims

- 7.2 A set of claims in a patent specification may include—
- (a) multiple independent (or main) claims (except for a short-term patent application in which the total number of independent claims must not exceed two (see section 113(1A)(b)(ii) of the Ordinance and section 58(2)(b) of the Rules)); and
 - (b) multiple dependent or subsidiary claims (or sub claims) which depend on one or more preceding independent claim(s).
- 7.3 An independent claim stating the essential features of an invention may be followed by one or more dependent claims concerning particular embodiments of the invention (sections 31S(4) (for standard patent (O) applications) and 64~~(2)~~(4) (for short-term patent applications) of the Rules).
- 7.4 A dependent claim that includes all the features of any other claim must —
- (a) contain a reference to that other claim, at the beginning if possible; and
 - (b) state the additional features that the dependent claim seeks to protect
- (sections 31S(5)(a)&(b) (for standard patent (O) applications) and 64~~(3)~~(5)(a)&(b) (for short-term patent applications) of the Rules).
- 7.5 Dependent claims referring to a single or several previous claims must be grouped together according to the previous claims in the most appropriate way (sections 31S(6) (for standard patent (O) applications) and 64~~(3)~~(c)(6) (for short-term patent applications) of the Rules).
- (a) The arrangement of claims must therefore enable the association of related claims to be readily determined and their meaning in association to be readily construed.
 - (b) Our examiners would request the patent applicant to make a suitable amendment if the arrangement of claims creates obscurity in the definition of the subject matter to be protected.

7.6 A claim which has the form of a dependent claim is not necessarily a dependent claim in substance. Examples include:

- a claim referring to another claim of a different category

Example 1: "An apparatus for carrying out the process of claim 1, ..."

Example 2: "A process for the manufacture of the product of claim 1, ..."

- a claim to one part referring to another co-operating part

Example: "A plug for co-operation with the socket of claim 1, ..."

Omnibus claims

7.7 Omnibus claims are those that contain a reference to the description or the drawings in respect of the technical features of the invention without providing any specific limitations.

Example:

- "A juice machine as shown in Figure 4."

7.8 Pursuant to sections 31S(9) (for standard patent (O) applications) and 64~~(5)~~(9) (for short-term patent applications) of the Rules, omnibus claims are only allowable when they are absolutely necessary.

(a) More specifically, a claim containing references to, e.g. "*as described in part...of the description*", or "*as illustrated in figure...of the drawings*" is objectionable.

(b) Our examiners may raise an objection to omnibus claims for lack of clarity (see sections 8.1 to 8.9 of these Guidelines – "Clarity"). In that case, the onus is upon the applicant to show that it is "absolutely necessary" to rely on the relevant reference to the description or drawings in appropriate cases, e.g. the invention involves some peculiar shapes as illustrated in the relevant drawings that cannot be defined by words or a formula, the invention involving sequence listings or chemical products

whose features can be defined only by means of graphs or diagrams.