

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

Section 8: Requirements for claims

Clarity

- 8.1 Section 78(1)(b) of the Ordinance requires that the claims contained in the specification of a patent application or of a patent must, among others, be clear. This requirement applies not only to the claims as a whole but also to individual independent and dependent claims.
- 8.2 The test for clarity of a claim is whether the claim is clear to a person skilled in the art, and it does not matter whether something clearer and shorter could have been drafted (see *Strix Ltd. v Otter Controls Ltd* [1995] RPC 607).
- 8.3 The wording of the claim should leave no doubt as to its kind/category. Therefore, the claim should, as far as possible, indicate clearly whether the claim is a product claim or a process claim.
- 8.4 A claim should not include terms of a vague, relative or subjective nature (e.g. “thin”, “wide”, “small”, “pure” or “strong”). Such terms on their own do not enable readers to ascertain or determine the exact scope of a feature of an invention. If any such term appears in a claim, it is usually necessary to have it defined or excised.
- 8.5 No objection to use of a term in the claim arises, however, if the term has a distinct and accepted meaning in the particular art (e.g. “high-frequency amplifier”), and the claim containing reference to such term intends to refer to such meaning. Alternatively, use of an equivocal term may be allowable without further clarification if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to

novelty and inventive step. The appropriateness of using equivocal terms has to be determined on a case-by-case basis.

- 8.6 Particular attention should be paid to use of any generalizing word (e.g. “*about*”, “*approximately*” or “*substantially*”) or expression in a claim. Such word/expression may be applied, for example, to refer to a particular value (e.g. “*about 200°C*”) or to a range (e.g. “*about x to about y*”). Our examiners would raise an objection to the use of any such word/expression in a claim if the word/expression renders the scope of the claim ambiguous or indeterminate.

For examples –

- (a) The generalizing expression “*wherein the second temperature is substantially higher*” would be inappropriate if the second temperature of a certain higher degree is an important feature of the invention. In such case, the difference of the temperature in question should be stated in more precise terms.
- (b) The use of the generalizing expression “*an alkyl group containing about five carbon atoms*” is objectionable because a more precise definition is usually expected in the chemical field.
- 8.7 Terms related to “optional features” (e.g. “*preferably*”, “*for example*”, “*such as*” or “*more particularly*”) should be used carefully to ensure that they do not cast doubt on the scope of a claim. If our examiners consider that any such term in a claim renders the scope of the claim vague, an objection will be raised accordingly.
- 8.8 Words that appear in brackets (e.g. “*(concrete) molded brick*”) may not be permitted unless the bracketed expression has a generally accepted meaning, e.g. “*(meth)acrylate*” – a chemical abbreviation for “*acrylate and methacrylate*”.
- 8.9 A claim should not contain any internal contradiction or inconsistency that casts doubt on the exact scope of the invention claimed as illustrated in the following examples:

(a) Simple inconsistency

- There is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not so limited.
- In addition, the description places no particular emphasis on a feature of the invention and there is no reason for believing that the feature is essential for the performance of the invention.
- The aforesaid inconsistency can be removed either by broadening the description or by limiting the claims.

(b) Inconsistency regarding apparently essential features

- It appears, either from common general knowledge or from what is stated or implied in the description, that a certain technical feature not mentioned in an independent claim is essential to the performance of the invention or, in other words, is necessary for the solution of the problem to which the invention relates.
- In such case, the independent claim normally needs to be amended to include such technical feature, or alternatively, the applicant may show that such feature is inessential and amend the description where necessary.

(c) Part of the subject-matter of the description and/or drawings is not covered by the claims

- The claims all specify an electric circuit employing semiconductor devices but one of the embodiments in the description and drawings employs electronic tubes instead.
- In such a case, the inconsistency can normally be removed either by broadening the claims (provided that the description and drawings as a whole provide adequate support for such broadening) or by removing the excess subject-matter from the description and drawings.
- However, if an example in the description and/or a drawing which is not covered by the claims is presented, not as an embodiment of the invention but as a background art or example which is useful for

understanding the invention, such example may be retained.

Conciseness

8.10 Section 78(1)(b) of the Ordinance requires that the claims contained in the specification of a patent application or of a patent must, among others, be concise. Sections 31S(7) (for standard patent (O) applications) and 64~~(4)~~(7) (for short-term patent applications) of the Rules require that the number of the claims must, having regard to the nature of the invention claimed, be reasonable, even though there is no specific limitation on the total number of independent and dependent claims contained in a patent application (save for a short-term patent application, the specification must not contain more than 2 **independent** claims to which the short-term patent applicant must conform (see section 113(1A)(b)(ii) of the Ordinance and section 58(2)(b) of the Rules)). In this regard, an objection may be raised if there is a multiplicity of claims of a trivial nature.

8.11 Undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the dependent claim form (see sections 7.2 – 7.6 of these Guidelines – “Independent and dependent claims”). Our examiners may also raise objections where there is a multiplicity of alternatives within a single claim which renders it unduly burdensome to determine the matter for which protection is sought.

Supported by description

8.12 The examples cited in section 8.9(c) above also reflect the requirement under section 78(1)(c) of the Ordinance that the claims contained in the specification of a patent application or of a patent must be supported by the description in the specification, i.e. there must be a basis in the description for the subject-matter of every claim, and the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art.

- 8.13 To determine whether the invention in the claims is supported by the description, the claims and the description in the specification have to be considered through the eyes of the skilled man in the art to—
- (a) ascertain what is the invention being specified in the claims; and
 - (b) compare the findings as per point (a) above with the invention which has been described in the specification (see Schering Biotech Corp's Application [1993] RPC 249 where Aldous J further explained that merely mentioning in the specification of features appearing in the claim would not necessarily be sufficient for compliance with the statutory requirement since “(t)he word ‘support’ means more than that and requires the description to be the base which can fairly entitle the patentee to a monopoly of the width claimed.”)
- 8.14 Most claims are generalizations from one or more particular examples. The extent of generalization permissible is a matter which our examiners shall judge in each particular case in the light of the relevant prior art. For instance, an invention which opens up a whole new field is typically entitled to more generality in the claims than one which is concerned with advances in a known technology.
- 8.15 A fair statement of a claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant is allowed to cover all obvious modifications of, equivalents to, and uses of that which he has described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, he should be allowed to draw his claims accordingly.