Patents Registry

Intellectual Property Department

Hong Kong SAR Government

Patents Examination Guidelines

Section 9: Sufficiency of disclosure

General principles

9.1 Section 77 of the Ordinance requires that the application for and specification of a patent for an invention must disclose the invention to which it relates in a manner sufficiently clear and complete for it to be performed by a person skilled in the art.

9.2 The leading case in the Hong Kong SAR on sufficiency of disclosure is *SNE Engineering Co. Ltd. v Hsin Chong Construction Company Ltd*. [2014] 2 HKLRD 822 which affirmed the general principles as set out by Kitchin J in *Eli Lilly v Human Genome Sciences* [2008] RPC 29:

"The specification must disclose the invention clearly and completely enough for it to be performed by a person skilled in the art. The key elements of this requirement … are these:

(i) the first step is to identify the invention … by reading and construing the claims;

(ii) in the case of a product claim[,] that means making or otherwise obtaining the product;

(iii) in the case of a process claim, it means working the process;

(iv) sufficiency of the disclosure must be assessed on the basis of the specification as a whole including the description and the claims;

(v) the disclosure is aimed at the skilled person who may use his common general knowledge to supplement the information contained in the specification;

(vi) the specification must be sufficient to allow the invention to be performed over the whole scope of the claim;

(vii) the specification must be sufficient to allow the invention to be so performed without undue burden."

9.3 Sufficiency of disclosure is assessed by reference to what information would have been provided to the person skilled in the art at the filing date of the patent application (*Biogen Inc v Medeva plc* [1997] RPC 1).

9.4 The person skilled in the art is not expected to be inventive but he is expected to be competent.

"[The person skilled in the art] is the ordinary addressee of the patent. He must be assumed to be possessed of the common general knowledge in the art and the necessary skill and expertise to apply that knowledge. He is the man of average skill and intelligence, but is not expected to be able to exercise any invention. In some arts he may have a degree, in others he will be a man with practical experience only. Further, in circumstances where the art encompasses more than one technology, the notional skilled person will be possessed of those technologies which may mean that he will have the knowledge of more than one person." (*Mentor Corporation v Hollister Inc.* [1991] FSR 557 as per Aldous J at 562, as applied in *SNE Engineering Co. Ltd. v Hsin Chong Construction Company Ltd.* [2014] 2 HKLRD 822)

9.5 The description must describe in detail at least one way of carrying out the invention, using examples where appropriate and referring to the drawings, if any (see sections 31N(2)(g) (for standard patent (O) applications) and 59~~(1)(e)~~(2)(f) (for short-term patent applications) of the Rules). Where the claims cover a broad field, a single example may not be sufficient and further clarification by the applicant may be necessary.

Examples of insufficiency of disclosure

9.6 The following examples illustrate insufficiency of disclosure of inventions in the descriptions:

(a) the description sets forth only a task and/or an assumption, or simply expresses a wish and/or a result, providing no technical means that a person skilled in the art can implement;

(b) the description sets forth a technical means, but the means is so ambiguous and vague that a person skilled in the art cannot concretely implement it according to the contents of the description;

(c) the description sets forth a technical means, but a person skilled in the art cannot solve the technical problem of the invention by adopting the said means;

(d) the subject matter of an application is a technical solution consisting of several technical means, but one of the means cannot be implemented by a person skilled in the art according to the contents of the description; and

(e) the description sets forth a concrete technical solution but without experimental evidence, while the solution can only be established upon confirmation by experimental result.