

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

Section 12: Construction of claims

Purposive construction

- 12.1 Pursuant to section 76(1) of the Ordinance, an invention in respect of which a patent application has been filed or an invention for which a patent has been granted must, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the patent application or the patent, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by the patent application or the patent must be determined accordingly.
- 12.2 Each claim should be read giving the words the ordinary meaning and scope to which a person skilled in the relevant art would attribute, unless in particular cases where it is clear from a reading of the claim alone that the words used in the claim are given a special meaning, by explicit definition or otherwise.
- 12.3 Section 76(3) of the Ordinance provides further guidance on the construction of the claims in the specification of a patent, i.e. section 76(1) of the Ordinance should not be interpreted in either of the following senses, namely-
- (a) in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims, on the one hand; or
 - (b) in the sense that the claims serve only as a guidance and that the actual protection conferred by a patent may extend to what, from a consideration of the description and drawings by a

person skilled in the art, the patentee has contemplated, on the other hand,

but rather is to be interpreted as defining a position between these extremes which combines a fair protection for the proprietor of the patent with a reasonable degree of certainty for third parties.

12.4 The Registrar of Patents considers that the interpretation approach as set out in section 76(3) of the Ordinance is also applicable to the construction of claims in the specification of a patent application. Accordingly, our examiners will give the specification of a patent application/patent a purposive construction, bearing the purpose or function of the invention in mind, rather than a purely literal one (see the House of Lords' decision in Catnic Components Ltd. v Hill & Smith [1982] RPC 183 as cited with approval in the subsequent Hong Kong SAR cases of Improver Corporation and another v. Raymond Industrial and another [1990] 2 HKC 28 and SNE Engineering Co. Ltd. v. Hsin Chong Construction Co Ltd. and another [2014] HKCFI 552 (upheld and affirmed on appeal)). Such specification will also be construed according to the meaning as understood by the audience to whom the specification was directed as set out in the House of Lords' decision in Kirin-Amgen v Hoechst Marion Rousell [2005] RPC 9 as quoted and approved by the Court of First Instance of the Hong Kong SAR in its decision of SNE Engineering:

“In the case of a patent specification, the notional addressee is the person skilled in the art ...[who]... comes to a reading of the specification with common general knowledge of the art ...[and]... reads the specification on the assumption that its purpose is to both to describe and to demarcate an invention – a practical idea which the patentee has had for a new product or process – and not to be a textbook in mathematics or chemistry or a shopping list of chemicals or hardware. It is this insight which lies at the heart of “purposive construction”.”

Open and closed claims

12.5 In evaluating novelty or inventive step of an invention, our examiners will consider which type of transition phrases, such as

“consisting of”, “comprising”, “characterized by” or “consisting essentially of”, is used in the claims of the invention.

12.6 There are two types of transitional phrases: open-ended and closed phrases.

(a) Open-ended phrases do not exclude any additional, unrecited elements or method steps, i.e. they are inclusive, not exclusive (e.g. if a claim recites *“a product comprising A, B and C,”* it is construed as including, and lacks novelty over, a prior art that discloses a product having A, B, C and D, as well as any additional feature or element). Transitional phrases such as *“comprising,” “including,” “containing,” “consisting essentially of,”* and *“characterized by”* are generally interpreted as being open-ended.

(b) Closed phrases, being the opposite of open-ended phrases, limit the claim to nothing more than the specifically-recited elements, i.e. the claim covers only the elements named and nothing more (e.g. if a claim recites *“a product consisting of A, B and C,”* it cannot be construed as including, and is novel over, a prior art that discloses a product having A, B, C and D, or any other additional feature or elements). Transitional phrases such as *“consisting of,” “be composed of,”* and *“be balanced with”* are generally interpreted to be close-ended.

Product-by-process claims

12.7 A product-by-process claim defines a product in terms of the process by which the product is made (e.g. *“Product X obtained by process Y”*). Such claim should be construed as a claim to the product *per se* that possesses the characteristics derived from the manufacturing process stated in the claim but not as a claim to the manufacturing process itself, irrespective of whether the term *“obtained”, “obtainable”, “directly obtained”* or an equivalent wording is used.

12.8 Therefore, a product-by-process claim is allowable only if the product as such fulfills the patentability requirements and it is impossible to define the claimed product other than in terms of a

process of manufacture, i.e. there is no physical, chemical or biological means for distinguishing that product from the prior art.

12.9 On the other hand, a product-by-process claim defining the product by reference to its method of manufacture is considered to lack clarity if there is a satisfactory alternative (i.e. a physical, chemical or biological means) of defining the product. Such product-by-process claim is also not rendered novel merely by the fact that the product is produced by means of a new process.