

Prior art

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/prior_art.pdf, pages 2 and 3)

1. Everything made available to the public by means of a written or oral description, by use, or in any other way before the filing date (priority date).
2. Contents of any Hong Kong patent applications and designated patent applications as filed in the designated patent offices with an earlier filing date (priority date) published on or after the filing date of the application (or filing date of the corresponding designated patent application) or the priority date.

Novelty

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/novelty.pdf, page 3)

The invention does not form part of the state of the art. The state of the art consists of:

1. everything made available to the public by means of a written or oral description, by use or in any other way before the filing date (priority date); and
2. the contents of any Hong Kong patent applications and designated patent applications as filed in the designated patent offices with an earlier filing date (priority date) published on or after the filing date of the application (or filing date of the corresponding designated patent application) or the priority date.

Inventive step (obviousness)

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/inventive.pdf, page 3)

The invention is not obvious to a person skilled in the art having regard to the state of the art. The state of the art consists of everything made available to the public by means of a written or oral description, by use or in any other way before the filing date (priority date).

Grace period

(Link:

https://www.wipo.int/export/sites/www/scp/en/national_laws/grace_period.pdf,
page 4)

Disclosure of the invention not to be taken into consideration if it occurred no earlier than 6 months before the filing date (or filing date of the corresponding designated patent application) due to:

1. an evident abuse in relation to the applicant or any proprietor of the invention for the time being; or
2. the fact that the applicant or any proprietor of the invention for the time being has displayed the invention at a prescribed exhibition or meeting.

Sufficiency of disclosure

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/disclosure.pdf, page 2)

The application for and specification of a patent for an invention shall 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

Exclusions from Patentable Subject Matter

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/exclusions.pdf, page 7)

1. A discovery, scientific theory or mathematical method.
2. An aesthetic creation.
3. A scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer.
4. The presentation of information.
5. A method for treatment of the human or animal body by surgery or therapy, or a diagnostic method practised on the human or animal body (but not including a product, and in particular a substance or composition, for use in any such method).
6. An invention the publication or working of which would be contrary to public order (ordre public) or morality shall not be a patentable invention. However, the working of an invention shall not be deemed to be so contrary merely because it is prohibited by any law in force in Hong Kong, China.
7. A plant or animal variety or an essentially biological process for the production of plants or animals, other than a microbiological process or the products of such a process.

Exceptions and Limitations of the Rights

(Link: https://www.wipo.int/export/sites/www/scp/en/national_laws/exceptions.pdf, pages 6 to 7)

1. Acts done privately for non-commercial purposes.
2. Acts done for experimental purposes.
3. Preparation for prescribed medicine in a pharmacy.
4. Certain uses concerning vessels, aircraft, hovercraft or land vehicles which temporarily or accidentally enter Hong Kong, China.
5. Continued prior use by a person who in Hong Kong, China before the filing date (priority date) had in good faith, done an act which would constitute an infringement of the patent if it were in force, or made effective and serious preparations to do such act.
6. Compulsory licenses for patented pharmaceutical products.
7. Government use of patents during a period of extreme urgency.

Confidentiality of Communications between Clients and their Patent Advisors

(Link:

https://www.wipo.int/export/sites/www/scp/en/confidentiality_advisors_clients/docs/03_hongkong_china.pdf)

Patent advisors in Hong Kong, China

There is currently no qualification requirement for patent advisors or patent agents in Hong Kong, China. However, pursuant to section 140(4) of the Patents Ordinance (Cap. 514), the Registrar must refuse to recognize a person who neither resides nor has a place of business in Hong Kong, China. The Registrar may also refuse to recognize a person as an agent in respect of any business under certain circumstances, such as where the person has been convicted of a criminal offence, or where the person has been struck off the roll of barristers or solicitors (section 85(7) of the Patents (General) Rules (Cap. 514C)).

The government of Hong Kong, China has decided to develop a full-fledged regulatory regime on patent agent services in the long run, which has to be achieved in stages. As part of the interim measures, the use in business, trade or profession of titles or descriptions such as “registered patent agent”, “certified patent agent”, “registered patent attorney” and “certified patent attorney” is prohibited in Hong Kong, China. On the other hand, the use of a title or description that solely relates to a person’s qualification for lawful provision of patent agency services in a jurisdiction outside Hong Kong, China is permissible (see section 144A of the Patents Ordinance).

By practice, it is not uncommon that solicitors are retained as patent agents in Hong Kong, China.

Duty of confidence and privileged communication

The right of Hong Kong residents to have confidential legal advice is enshrined in Article 35 of the Basic Law of Hong Kong, China. However, there are no statutory provisions under the Patents Ordinance regarding the confidentiality of communications between clients and their patent advisors/agents.

Communications between clients and their patent advisors who are solicitors may qualify as confidential information according to common law and the Hong Kong

Solicitors' Guide to Professional Conduct.