1. INTRODUCTION

Pre-1997:

- UK or European patents (designating UK) could be registered under Registration of Patents Ordinance (Cap 42) and got protected in HK "as though the patent had been granted in UK with an extension to HK"

Post-1997:

- Under Patents Ordinance (Cap 514, comm. June 1997), HK Patents Registry (i.e. IPD) has the authority to grant patents
- **BUT this "granting" of patents is notional**

Two types of patents:

(1) Standard patents (max duration 20 years)

- Before one can apply for a standard patent in HK [i.e. 2nd stage], he must have made a patent application with one of the designated patent offices
  - **S.8, PO:** CE in Council may for the purposes of this Ordinance by notice published in the Gazette designate a patent office.
  - Under s.3, Patents (Designation of Patent Offices) Notice (Cap 514A): State Intellectual Property Office of China; European Patent Office; UK Patent Office

(2) Short-term patents (max duration 8 years): Apply directly with HK Patents Registry; NOT dependent on any other application

2. Details for Application

(1) Standard Patents

- **1st stage: Designated Patent Application**
  - The designated patent application can be (i) local application under the national laws of the designated office; or (ii) an international application under the Patent Cooperation Treaty (PCT)
    - The PCT: Concluded in 1970; administered by WIPO
    - It provides for filing of one patent application with effect in several States
    - Two phases: "international phase" and "national phase"

S.16, PO: *Where the designated patent application is the national phase of an international application under the Patent Cooperation Treaty (PCT), the date of publication of the designated patent application shall be*

(i) the date of such publication in the designated patent office as serves to indicate that the international application has validly entered its national phase in the designated patent office; or

(ii) such other date as may be prescribed in rules

S.15(1), Patents (General) Rules:

The date of publication of the designated patent application based on an international application under s16 of the Ordinance shall be -

(a) [for application with European Patent Office] *the date of publication by the European Patent Office in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the European Patent Office;*

(b) [for application with UK European Patent Office] *the date of publication by the United Kingdom Patent Office in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the United Kingdom Patent Office;*

(c) [for application with State IPO] *the date of publication by the State Intellectual Property Office in its Patent Gazette of the relevant bibliographical data showing that the international application has entered the national phase in the State Intellectual Property Office.*

- **2nd stage: Local Application**
  - Applicant defined in **S.12(1), PO:**

    The person who may apply for the grant of a standard patent for an invention is -

    (a) the person named as applicant in a designated patent application for a patent for the invention, or his successor in title to the rights under the designated patent application in Hong Kong; or

    [BUT (a) overridden by (b)…]

    (b) in preference to the person mentioned in para (a), the person who is entitled to the property in the invention in Hong Kong.

    [e.g. employees as inventor in the course of employment]

    - ***Markem Corp v Zipher*** [2005]: Such entitlement would usually arise by reason of the operation of some independent rule of law, e.g. contract, breach of confidence
  - **NB:** Determination of questions as to who may apply under **s.13**

    (1) At any time BEFORE a standard patent has been granted, any person may refer to the Registrar or the court the question of whether he is entitled under s.12 (alone or with other persons) to apply for the grant of a standard patent

    (2) The Registrar or the court may make such order as he or it thinks fit to give effect to a determination under this section

    (3) Where a question is referred after an application for a standard patent has been filed but before a standard patent is granted, the Registrar or the court may, unless the application is withdrawn before the reference is disposed of by the Registrar or the court, order that the application for a standard patent shall proceed in the name of that person, either solely or jointly with that of any other applicant

    [See also **s.55** for determination of right to patent AFTER grant]

(a) 1st Stage: Recording in HK of designated patent application
- **S.15, PO:** Filing of request to record within 6 months after date of publication of an application in a designated patent office for a patent for the invention
- Manner of filing request to record stated under **s.15(2), PO:**
  - *(a) a photocopy of the designated patent application as published, that is to say, including any description, claims, drawings, search report or abstract published together with the designated patent application;*
  - *(b) where the designated patent application does not contain the name of any person as being the inventor, a statement identifying the person or persons whom the applicant believes to be the inventor or inventors;*
  - *(c) the name and address of the person making the request;*
  - *(d) where the person filing the request is a person other than the person named as applicant in the designated patent application, a statement explaining his entitlement to apply for the grant of a standard patent for the invention and prescribed documents supporting that statement;*
  - *(e) where **priority is claimed under s.98** in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application, a statement that indicates the details of the date of priority claimed;* **[Must be within 1 year]**
  - *(f) the details of any previous disclosure that is claimed to be non-prejudicial;*
  - (g) *an address in Hong Kong for service of documents.*
- S.8, Patents (General) Rules (Cap 514C):
  - *(1) A request to record a designated patent application under s.15 of the Ordinance shall be in the specified form (Form P4).*
  - *(2) Further to s.15(2) of the Ordinance*
    - *(a) the documents required under para (a) of that subsection -*
      - *(i) shall be filed in duplicate, and one of those duplicate copies shall be in loose leaf form in accordance with s12 of these Rules;*
      - *(ii) shall be exempted from any requirement under s104(1) of the Ordinance to be filed in one of the official languages;*
    - *(b) the documents prescribed for the purposes of para (d) of that subsection are those mentioned in s9 of these Rules;*
    - *(c) the following particulars shall be set out in the request -*
      - *(i) the date of filing of the designated patent application;*
      - *(ii) the title of the invention;*
      - *(iii) the application number of the designated patent application*
      - *(iv) the publication number (if any) assigned to the designated patent application by the designated patent office, and the date (if any) of its publication by the designated patent office*

(b) **Formality examination by HKPR [C.f. Substantive examination by designated patent office**

- **S.11, PO:** NO obligation of examination on Registry for
  (a) the patentability of the invention;
  (b) whether the applicant is entitled to any priority as claimed;
  (c) whether the invention is properly disclosed in the application

- **S.18(1), PO:** *The Registrar shall examine whether -*
  (a) the request to record satisfies the requirements of s.17(1) (the "minimum requirements");
  (b) the filing fee and advertisement fee have been paid in due time.

- "Minimum requirements" defined under **s.17(1), PO:** *The date of filing a request to record shall be the earliest date on which documents filed by the applicant contain -* **[i.e. As pure formalities]**
  (a) an indication that a request is made to record a designated patent application; **[i.e. By using appropriate form]**
  (b) information identifying the applicant; and
  (c) a reference to the designated patent application, including -
  (i) the application number assigned to it by the designated patent office; and
  (ii) the publication number (if any) assigned to it by the designated patent

- Consequence of failing to meet "Minimum requirements" stated under **s.18, PO:**
  (2) If a date of filing cannot be accorded because of deficiencies as regards the minimum requirements, the Registrar shall give the applicant an opportunity to correct the deficiencies in accordance with the rules
  (3) If such deficiencies are not corrected within the prescribed time, the request shall not be dealt with as an application for a standard patent
  - S.16, Patents (General) Rules:
    (1) ... the Registrar shall communicate the disclosed deficiencies to the applicant and inform him that the request to record will not be dealt with as an application for a standard patent unless he remedies the disclosed deficiencies within 1 month of the date of the communication
    (2) [If deficiencies remedied within that period] … *the date of filing accorded to the request to record*

- "Formal requirements" stated under **s.19, PO:**
  (1) If a request to record has been accorded a date of filing ... the Registrar shall examine whether the requirements of s15(2) and (3) ("the formal requirements") have been satisfied
  (2) Where the Registrar notes that there are deficiencies as regards the formal requirements which may be corrected, he shall give the applicant an opportunity to correct them in accordance with the rules
  → See s.17, Patents (General) Rules

- Effect of registration under **s.20, PO**:

  (1) ...the deficiencies noted under s19(2) are found to have been corrected, then the Registrar shall as soon as practicable after such examination, but subject to this section and section 37 -

  (a) record the designated patent application in the register and enter particulars of the request to record in the register

  (b) publish the request to record in the prescribed manner

  (c) advertise the fact of such publication and entry by notice in the Gazette

  (d) inform the applicant of the publication of the request to record

  *(2) A request to record shall **not be published** if -*

  (a) it has been withdrawn before completion of preparations for publication; or

  (b) the filing fee or advertisement fee has not been paid.

  BUT Subject to s.37:

  - **The ONLY marginal substantive examination [as in other contexts]:** *The Registrar may refuse to record a designated patent application under s20(1) if he considers that the subject of the application for the standard patent is not a patentable invention by reason of any of the matters specified in s93(5) (i.e. contrary to public order or morality).*

(c) 2nd Stage: Registration in HK of designated patent + grant of standard patent [ss.24-26 for second stage mirrors s17-29 for 1st stage]

- **S.23, PO:**

  (1) Where in an application for a standard patent -

  (a) a designated patent application has been recorded and a request to record has been published; and

  (b) a patent has been granted in the designated patent office in pursuance of the designated patent application,

  the applicant or his successor in title may, subject to subs (2), request the Registrar to register the designated patent so granted and to grant a standard patent for the invention ("request for registration and grant")

  *(2) A request for registration and grant under subs (1) shall be made **within 6 months after the date of grant of the designated patent** by the designated patent office or publication of the request to record, whichever is the later.*

- The request must contain the documents and information prescribed in **s.23(3)**:

  (a) a verified copy of the published specification of the designated patent

  (b) statement explaining entitlement to the grant

  (c) any priority claimed and supporting documents

  and must be in specified form (Form P5): see s.19, Patents (General) Rules

- Content of application as stated under **s.24(1)**:

  The date of filing of such a request shall be the earliest date on which documents filed by the applicant contain -

(a) an indication that a request is made for the registration of a designated patent and the grant of a standard patent;
(b) information identifying the applicant;
(c) the publication number assigned to the designated patent by the designated patent office, and the date of its publication; and
(d) the publication number assigned to the request to record by the Registrar

- Effect of application as stated under **s.27**:
  S.27(1), (2):
  If the formality requirements are satisfied and necessary fees paid, the Registrar shall
  (a) register the designated patent by making an appropriate entry in the register; and
  (b) grant a standard patent for the invention and issue a certificate to that effect

  S.27(3): *As soon as practicable after a standard patent has been granted under this section the Registrar shall -*
  (a) publish in the prescribed manner the specification of the patent, the names of the proprietor and, if different, the inventor;
  (b) send the certificate issued under subs (1)(b) to the proprietor; and
  (c) advertise the fact of such grant by notice in the Gazette

- Deemed date of filing defined under **s.38**: *Where a standard patent is granted, the date of filing of the corresponding designated patent application shall be deemed to be the date of filing of the application for the standard patent*

- Terms of standard patent under **s.39**:
  (1) A standard patent granted under this Ordinance -
  (a) shall take effect from the date on which the fact of its grant is advertised in the Gazette; and
  *(b) subject to subs (2), shall remain in force until the end of the period of **20 years** beginning with the deemed date of filing of the application for the patent*
  (2) If it is desired to keep a standard patent in force for a further year after the expiry of the 3rd or any succeeding year from the date specified in subs (3), the prescribed renewal fee shall be paid before the expiry of that 3rd or, as the case may be, succeeding year, but not earlier than a date 3 months before that expiry, and a standard patent shall cease to have effect at the expiry of that 3rd or succeeding year if the renewal fee is not so paid
  (3) The date specified for the purpose of subs (2) is the anniversary of the deemed date of filing of the standard patent first occurring after the date of grant of the patent
  [Combined effect of ss.(2) and (3): Renewal every 4 years with the payment of fees]

(4) If within 6 months after the end of the period specified in subs (2) for payment the renewal fee and any prescribed additional fee are paid, the standard patent shall be treated as if it had never expired, and accordingly
(a) anything done under or in relation to it during that further period shall be valid;
(b) *an act which would constitute an infringement of it if it had not expired shall constitute such an infringement*

- Restoration of lapsed standard patents: **s.40**
  (1) Where a standard patent has ceased to have effect by reason of the failure to pay any renewal fee as provided in s39, application may be made to the Registrar, at any time within 18 months after the date on which the patent ceased to have effect, for the restoration of the patent
  (2) *An application under this section may be made by the person who was the proprietor of the standard patent at the time it ceased to have effect or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was at that time held by 2 or more persons jointly the application may, with the leave of the Registrar, be made by one or more of them without joining the others*

(2) Short-Term Patents [Local application ONLY]
S.108: Application may be made by any person either alone or jointly with another

- Major differences from standard patents:
  - NO need to first apply for a patent elsewhere
  - Direct application with HK Patents Registry
  - Shorter duration (max 8 years), thus simpler application
- Similar requirements: Registrar only required to examine whether fees are paid and whether "minimum requirements" and "formal requirements" are satisfied

- "Minimum requirements" set out in **s.114(2)**
  The date of filing of a short-term patent application shall be the earliest date on which documents filed by the applicant contain -
  (a) an indication that a short-term patent is sought;
  (b) information identifying the applicant;
  (c) a part which on the face of it appears to be a description of an invention

- **S.115** requires examination of "formal requirements" set out in **s.113(1)**:
  Every application for a short-term patent shall be signed by the applicant and be filed with the Registrar in the prescribed manner and shall contain
  (a) a request for the grant of a short-term patent;
  (b) a specification which provides on the face of it for -
  (i) a description of the invention to which the application relates;
  (ii) one or more claims but not exceeding one independent claim;

(iii) any drawings referred to in the description or the claim or claims;

(c) an abstract; and

(d) a search report in relation to the invention

- **S.117**: Formal examination ONLY
- **S.118**: Grant of short-term patent (if formal requirements satisfied)

  As soon as practicable after the grant, the Registrar shall -

  (a) publish the specification of the short-term patent;

  (b) issue a certificate of grant; and

  (c) advertise the fact of such grant by notice in the Gazette.
- **S.124**: Refusal to grant short-term patent if contrary to public order or morality

3. OWNERSHIP

- Employer / employee: **s.57**

  (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Ordinance and all other purposes if -

  *(a) it was **made in the course of the normal duties of the employee** or in the course of duties falling outside his normal duties, but **specifically assigned** to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or*

  [I.e. employed to invent, e.g. technicians]

  (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking

  [I.e. Senior managerial staff and incidentally invented sth]

- Compensation of employees: **s.58**

  (1) Where it appears to the court on an application made by an employee within the prescribed period that -

  (a) the employee has made an invention belonging to the employer for which a patent has been granted;

  (b) the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer; and

  (c) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,

  court may award him such compensation of an amount determined under s.59

(i) Registrable Transactions: **s.52(3)**

(a) the assignment of a patent or application for a patent, or a right in it
(b) the mortgage of a patent or application or the granting of security over it
(c) the grant or assignment of a licence or sub-licence or mortgage of a licence or sub-licence under a patent or application

- Effect of non-registration stated under **s.52(1)**: lost priority to person claiming under a later transaction if, at the time of the later transaction, application has not been made for registration of the earlier transaction, and the person claiming under the later transaction did not know of the earlier transaction

4. VALIDITY / REVOCATION OF PATENT

S.101(1), PO: Proceedings in which validity of patent may be put in issue

*(a) by way of **defence**, in proceedings **for infringement of the patent** under section 80 or, in the case of a standard patent, in proceedings under section 88 for infringement of rights conferred by the publication of an application;*
*(b) in proceedings under section 89 ("**groundless threats** of infringement proceedings");*
(c) in proceedings in which a declaration in relation to the patent is sought under section 90 ("declaration as to non-infringement");
*(d) in proceedings before the court under **s.91 for the revocation of the patent**;*
(e) in proceedings under section 72 ("references of disputes as to government use").

- Substantive requirements set out in Part XII Revocation of patents
  - Patentable inventions: **S.93**
  - "New" / Novelty: **S.94**; Exception for "non-prejudicial disclosure" under **s.95**
  - Inventive step [i.e. as breakthrough; c.f. novelty]: **S.96**
  - Industrial application: **S.97**

- **S.91:** Grounds on which patent may be revoked

(1) Subject to this Ordinance, the court may on the application of any person by order revoke a patent for an invention on any of the following grounds:
(a) that the invention is not a patentable invention ...
(b) that the patent was granted to a person who was not entitled to be granted that patent;
(c) that the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art ...

(1) Patentable inventions: **S.93**

(1) An invention is patentable if it is susceptible of industrial application, is new and involves an inventive step

(2) The following in particular shall not be regarded as inventions within the meaning of subsection (1) -

(a) a discovery, scientific theory or mathematical method;

(b) an aesthetic creation;

(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;

(d) the presentation of information

(3) Subsection (2) shall exclude patentability of subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to such subject-matter or activities as such **[I.e. allow partial non-patentability]**

- Meaning of phrase "as such" in **s.93(3)**:
  - ***Vicom's Application***
    - Digital processing method for producing enhanced images
    - Issue: Mathematical method as such? Computer program as such?

    Held: [Technical Board of Appeal of the European Patent Office]
    - Even if idea underlying the invention might be considered to reside in a mathematical method, the claim would be acceptable if it was directed to a technical process which was carried out on a physical entity by some technical means (e.g. computer program) implementing the mathematical method and which provided as its result a certain change in that entity

    → Still patentable if the result is a technical contribution not falling within any of the prohibited categories, and the mathematical method / computer program was just a means

  - ***Merrill Lynch's Application***
    - Computer program for making a trading market in securities

    → NOT patentable because the result was a method of doing business, prohibited under **s.93(2)(c)**

  - See also **s.93(5), (6)**:

    (5) 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

    (6) *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, shall not be patentable*

[cont'd]

- ***Harvard (Onco-Mouse) Application***
  - Claim in respect of a method for producing transgenic non-human mammals having an increased probability of developing neoplasms + mammals produced

  Held: [Technical Board of Appeal]
  - Necessary to provide proper balance between interest of investors in this field in obtaining reasonable protection for their efforts and society's interest in excluding certain categories of animals from patent protection
  - Method claimed was NOT essentially biological, thus the resulting products not prohibited
  - Remitted case to Examining Division to consider whether contrary to public order or morality

  Held: [Examining Division]
  - Usefulness of invention in cancer research outweighed any negative effect that might be generated by animal testing

    → NOT contrary to public order or morality

(2) Industrial application: **S.97**:

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture

- See also **S.93(4)**: Method for treatment of human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body NOT regarded as an invention which is susceptible of industrial application
  - EXCEPT product, and in particular a substance or composition, for use in any such method [i.e. drugs]

(3) Novelty: **S.94** [NB: Exception for "non-prejudicial disclosure" under **s.95**]

*(1) An invention shall be considered to be new if it does **NOT** form part of the state of the art*

(2) The state of the art shall be held to comprise everything made available to the public (whether in Hong Kong or elsewhere) by means of a written or oral description, by use, or in any other way –

⊨> [E.g. demonstrate invention by use]

*(a) before the deemed date of filing of an application for a standard patent for the invention or, if **priority** was claimed, before the date of priority; or*

►**ss.98-99** for claim of priority (standard)

*(b) before the date of filing of an application for a short-term patent for the invention or, if **priority** was claimed, before the date of priority, whichever is the earlier.*

►**ss.110-112** for claim of priority (short-term)

- See also **S.94(3)** on further definition of "state of art": Include another patent with earlier deemed date of filing

Additionally, the state of the art shall be considered as comprising the content of -

(a) any application for a standard patent as filed, of which -

(i) the deemed date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and

(ii) the corresponding designated patent application was published in the designated patent office on or after the date referred to in subsection (2);

(b) any designated patent application as filed in a designated patent office -

(i) of which the date of filing or, if priority was claimed in the designated patent office, the date of priority accorded in the designated patent office is before the date referred to in subsection (2); and

(ii) which was published by the designated patent office on or after the date referred to in subsection (2); or

(c) any application for a short-term patent -

(i) of which the date of filing or, if priority was claimed, the date of priority is before the date referred to in subsection (2); and

(ii) pursuant to which a short-term patent was published under this Ordinance on or after the date referred to in subsection (2).

- Meaning of "made available to the public" under **s.94(2)**:
  - Invention NOT "made available to the public" unless the prior disclosure or prior use was to such an extent that
    - Process claim: "clear and unmistakable directions" to do what the applicant claims to have invented were given
      - ***Flour Oxidizing Co Ltd v Carr*** (1908) 25 RPC 428, quoted in ***General Tire v Firestone Tyre*** [1972] RPC 457 and ***Beecham Group's (Amoxycillin) Application*** [1980] RPC 261
    - Product claim: "a person of ordinary knowledge of the subject would at once perceive, understand and be able practically to apply the discovery without the necessity for making further experiments"
      - ***Hills v Evans*** (1862) 31 LJ Ch (NS) 457, quoted in ***Asahi Kabushiki Kaisha's Appn*** [1991] RPC 485

  ➔ "enabling disclosure" (i.e. enable recipient to work the invention out): ***SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent*** [2006] RPC 10 (p 323) (HL)

- Exception: "non-prejudicial disclosure"
  [**S.95** (standard patents); **S.109** (short-term patents)]

  (1) a disclosure of the invention shall not be taken into consideration if it occurred no earlier than 6 months before the deemed date of filing of the application and if it was due to, or in consequence of -

(a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being [C.f. Patents Act 1977 "in breach of confidence"]*; or*

(b) 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 [See General Rules, s.65]

(2) Subsection (1)(b) shall only have effect if, at the time of filing the corresponding designated patent application, the applicant stated in accordance with the law of the designated patent office relating to non-prejudicial disclosure that the invention had been so displayed

- Patents (General) Rules, S55:

(a) an official or officially recognized international exhibition within the terms of the Convention on International Exhibitions

(b) an international exhibition sponsored or recognized by the Chinese Government or an academic or technological meeting organized by a competent department concerned of the State Council of the Chinese Government or by a national academic or technological association, so recognized by the Chinese Government

(4) Inventive step: **S.96**

(1) An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art

(2) *For the purpose of subs (1), if the state of the art also includes documents within the meaning of s94(3) [prior patent applications published after deemed date of filing], these documents are not to be considered in deciding whether there has been an inventive step*

- Approach of Eng. CA in ***Windsurfing v Tabur Marine*** [1985]:
  (1) Identify the inventive concept embodied in the patent
  (2) Court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge in the art in question
  (3) Identify what, if any, differences exist between the matter cited as being "known or used" and the alleged invention
  (4) Court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man

- ***Canon Kabushiki Kaisha v Green Cartridge Co (HK) Ltd*** [1997] (HK)
  - Question as one for the Court to answer, assisted by expert witness

5. INFRINGEMENT & EXCEPTIONS

S.73, PO: [Direct infringement]

A patent while it is in force shall confer on its proprietor the right to prevent ***all third parties*** [i.e. including those who had worked out invention by themselves] *not having his consent from doing in Hong Kong all or any of the following -*

(a) in relation to any product which is the subject-matter of the patent -

(i) making, putting on the market, using or importing the product; or

(ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise;

(b) in relation to any process which is the subject-matter of the patent-

(i) using the process; or

(ii) offering the process for use in Hong Kong when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent;

(c) where the invention is a process, then in relation to any product obtained directly by means of that process -

(i) putting on the market, using or importing the product; or

(ii) stocking the product, whether for the purpose of putting it on the market (in Hong Kong or elsewhere) or otherwise

S.74(1), PO: [Indirect infringement]

A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent ***from supplying or offering to supply*** *in Hong Kong a person, other than a party entitled to work the patented invention,* ***with means****, relating to an essential element of that invention,* ***for putting it*** [i.e. invention] ***into effect****, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect in Hong Kong*

S.75, PO: **[EXCEPTIONS]**

The rights conferred by a patent shall not extend to -

(a) acts done privately for non-commercial purposes

(b) acts done for experimental purposes relating to the subject-matter of the relevant patented invention

- Test for infringement: ***Catnic*** (HL)
  - Lintel for placing over doors and windows in construction of bldgs
  - One of the pieces of steel extend "vertically" down one side of lintel
  - D's product slightly varied the angle by 6 degrees

  Held:
  - Invention must be "vertical" – If YES, NO infringement by D as 6^{o}
  - Adopted "purposive construction": still infringement

- Test propounded by Eng CA in ***Improver v Remington*** (Eng CA 1989)
    1. Does the variant have a **material effect** upon the way the invention works? If yes, the variant is outside the claim.

    If NO –
    2. Should this (i.e. that the variant had no material effect) have been **obvious** at the date of publication of the patent to a reader skilled in the art? If no, the variant is outside the claim.

    If YES –
    3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee **intended that strict compliance** with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

NB: Q.1 & 2 are questions of fact (the essence of the invention)
Q.3 is a question of construction (interpretation of the specification)

- ***Kirin-Amgen Inc v Hoechst Marion Roussel*** [2005]: *Improver* questions ONLY as guidelines; ONLY applicable in some cases, e.g. NOT for ***Catnic*** itself (taking description of "vertical" literally)

Improver v Raymond (HKCA)

- P's depilatory device: inventive feature was use of helical spring which would rotate at a high speed and by which hair would be caught and plucked from the skin
- D's depilatory device: helical spring replaced by a cylindrical rubber rod with slits cut in it ("variant")

Held:

1. Does the variant have a material effect upon the way the invention works?
    - No (cylindrical rubber rod has the same effect as helical spring)
2. Should this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art?
    - Yes (a skilled person would know that they had the same effect)
3. Would the skilled person nevertheless have understood from the language of the claim that the patentee intended strict compliance with the specification (i.e. must use helical spring and nothing else)?

- From the language of the specification, helical spring should be treated as an essential feature of the invention

→ D did NOT infringe by using cylindrical rubber rod

NB:

- If specification is drafted narrowly (e.g. essence of invention is use of helical spring and nothing else to achieve the intended result), NO infringement if D uses cylindrical rubber rod to achieve same result
- **BUT** if specification is too wide (e.g. essence of invention is a device for plucking hair), would NOT be accepted at application stage because specification fails to show what is innovative about the invention