

**Hong Kong China's response to letter from
World Intellectual Property Organization dated 10 March 2014 (C. 8343)**

(I) Exceptions and limitations to patent rights

Please see the updated response to the questionnaire attached.

(II) Transfer of technology

As the Patents Registry of Hong Kong China does not regulate or oversee any transfer of technology, we are not in a position to provide any information on examples or experience on patent-related incentives and impediments to transfer of technology.

Having said that, as far as we are aware, there is a local funding scheme titled "Patent Application Grant" (the "Grant") administered by the Innovation and Technology Commission with Hong Kong Productivity Council as the implementation agent with a view to assisting local companies and individuals to apply for patents of their own inventions. The Grant aims to encourage local companies and inventors to capitalize their intellectual work through patent registration.

**(III) Aspects of national/regional patent laws, available at:
http://www.wipo.int/scp/en/annex_ii.html**

Please add the following information to the corresponding webpages as such information regarding Hong Kong China is currently missing:

Prior Art

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) of the subject application.
2. Contents of any Hong Kong standard patent application with an earlier filing date (priority date) and of which the corresponding designated patent application was published in the designated patent office on or after the filing date (priority date) of the subject application.
3. Contents of any designated patent application as filed in a designated patent office with an earlier filing date (priority date) and of which the designated patent application was published by the designated patent office on or after the filing date (priority date) of the subject application.

4. Contents of any short-term patent application with an earlier filing date (priority date) which was published on or after the filing date (priority date) of the subject application.

Novelty

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) of the subject application.
2. the contents of:
 - (a) any Hong Kong standard patent application with an earlier filing date (priority date) and of which the corresponding designated patent application was published in the designated patent office on or after the filing date (priority date) of the subject application;
 - (b) any designated patent application as filed in a designated patent office with an earlier filing date (priority date) and of which the designated patent application was published by the designated patent office on or after the filing date (priority date) of the subject application;
 - (c) any short-term patent application with an earlier filing date (priority date) which was published on or after the filing date (priority date) of the subject application.

Inventive Step (Obviousness)

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:

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) of the subject application.
2. the contents of:
 - (a) any Hong Kong standard patent application with an earlier filing date (priority date) and of which the corresponding designated patent application was published in the designated patent office on or after the filing date (priority date) of the subject application;
 - (b) any designated patent application as filed in a designated patent office with an earlier filing date (priority date) and of which the designated patent application was published by the designated patent office on or after the filing date (priority date) of the subject application;

- (c) any short-term patent application with an earlier filing date (priority date) which was published on or after the filing date (priority date) of the subject application.

Grace Period

Disclosure of the invention not to be taken into consideration if it occurred no earlier than 6 months before the filing date due to:

- (a) an evident abuse in relation to the applicant or any proprietor of the invention for the time being; 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.

Sufficiency of Disclosure

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

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 and 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.
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 Limitation of the Rights

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.
5. Continued prior use by a person who in Hong Kong 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.

(IV) National/ regional laws and practices relating to confidentiality of communications between patent advisors and their clients

1. There is currently no regulatory regime for provision of patent agency services in Hong Kong China. Any person, with or without the relevant technical and/ or legal expertise, may claim himself or herself to be a patent practitioner.

2. In Hong Kong China, it is not uncommon that solicitors are retained as patent agents. In this connection, communications between clients and their patent advisors who are solicitors will qualify as confidential information.

(a) A solicitor owes the duty of confidence to his client during the subsistence of the solicitor-client relationship. This relationship comes to an end with the termination of the retainer. But the duty of confidentiality survives the termination to protect the confidentiality of the information imparted during the subsistence of that solicitor-client relationship: see *Prince Jefri Bolkiah and KPMG (a firm)* [1999] 2 AC 222 at 235C-F, per Lord Millett.

(b) Moreover, under paragraph 8.01 of The Hong Kong Solicitors' Guide to Professional Conduct, Vol. 1, it is stated that:

“8.01 A solicitor has a duty to hold in strict confidence all information concerning the business and affairs of his client acquired in the course of the professional relationship, and must not divulge such information unless disclosure is expressly or impliedly authorized by the client or required by law or unless the client has expressly or impliedly waived the duty.”

(c) Further, legal professional privilege protects the confidentiality of *bona fide* communications between lawyer and client concerning matters of legal advice or in reference to litigation, be it on-going or in contemplation. The

privilege conveys the right to resist the compulsory disclosure of those communications.

3. Upon endorsing the recommendations made by the Advisory Committee of Review of the Patent System in Hong Kong, the Government of Hong Kong, China has decided to develop a full-fledged regulatory regime on patent agency services in the long run, which has to be achieved in stages, with possible interim measures.

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