

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

Section 1: Novelty

Meaning of novelty

- 1.1. Section 9A(1) of the Ordinance sets out that the first condition for patentability of an invention is its novelty which means that no invention will be granted a patent if it is not new. The question of novelty is further addressed under section 9B(1) of the Ordinance, which states that an invention shall be considered new if it does not form part of the state of the art.

State of the art

- 1.2. Section 9B(2) of the Ordinance defines the term “state of the art” as everything made available to the public (whether in the Hong Kong Special Administrative Region (the Hong Kong SAR) or elsewhere) by means of a written or oral description, by use, or in any other way-
 - (a) before the date of filing of the corresponding designated patent application in relation to an application for a standard patent (R) for the invention or, if priority is claimed, the date of priority; or
 - (b) before the date of filing of an application for a standard patent (O) for the invention or, if priority is claimed, the date of priority; or
 - (c) before the date of filing of an application for a short-term patent for the invention or, if priority is claimed, the date of priority.
- 1.3. Additionally, pursuant to section 9B(3) of the Ordinance, the state of the art shall be considered as comprising the contents of all

substantive examination (unless they are filed by the patent applicant or proprietor at the earlier stage)—

- (a) a translation of the previous application in the language of the specification of the standard patent (O) application or the short-term patent, as the case requires; or
- (b) if the standard patent (O) application or the short-term patent for which priority is claimed is a translation of the previous application – a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate (see section 13.92 of these Guidelines – “Translation of documents”).

(section 56B(5) of the Rules)

Claiming priority: standard patent (R) applications

1.61. Pursuant to section 11B(3) of the Ordinance, the proprietor or the proprietor’s successor in title of a designated patent application for an invention enjoys, for the purpose of filing a standard patent (R) application for the same invention, the same right of priority as the proprietor enjoys in respect of the designated patent application. Such a right of priority may be claimed where an earlier application for a patent or other protection for the same invention was filed within 12 months before the date of filing of the designated patent application in or for a Paris Convention country or a non-Paris Convention country, territory or area that fulfills the conditions set out in section ~~1.61~~1.62 below (see sections 11B(1) – (3) of the Ordinance).

1.62. If the earlier application was filed in or for a non-Paris Convention country, territory or area, the following conditions must be met for the purpose of establishing a priority right in a standard patent (R) application—

- (a) the right of priority granted by the designated patent office is consequent on an international agreement that applies to the Hong Kong SAR; and