

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

**Section 4: Exclusions from patentability**

**General principles**

- 4.1. Section 9A(2) of the Ordinance expressly excludes the following subject-matter or activities from being inventions (collectively referred to as “**the excluded subject-matter**”):
- (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; and
  - (d) a presentation of information.
- 4.2. The aforesaid exclusion is however subject to section 9A(3) of the Ordinance to the effect that the exclusion is only applicable to the extent to which a patent or patent application relates to the excluded subject-matter as such. In other words, a claim is unpatentable if it amounts to no more than any of the excluded subject-matter.

**Example**

*A claim concerning the production of an aesthetic effect on an article is not unpatentable if it also involves a technical contribution by solving a technical problem in addition to its aesthetic value.*

- 4.3. The subject-matter of a patent application may sometimes involve the interplay between at least two exclusions. In such case, where such subject-matter falls wholly within two or more of the excluded subject-matter rather than just falling wholly within one of the excluded subject-matter, such subject-matter will still be denied of

patentability (see Raytheon Company v Comptroller General of Patents, Designs and Trade Marks [2007] EWHC 1230 (Pat)).

4.4. Each case must be determined on its own fact as to whether a patent application solely involves any excluded subject-matter. In this connection, our examiners would generally adopt the following 4-step test as laid down by the English Court of Appeal in Aerotel Ltd v Telco Holdings Ltd Macrossan's Patent Application [2007] RPC 7 ("Aerotel/Macrossan"):

(a) properly construe the claim;

(b) identify the actual contribution;

(c) ask whether it falls solely within the excluded subject-matter; and

(d) check whether the actual or alleged contribution is actually technical in nature.

4.5. The **first step** of the Aerotel/Macrossan test requires proper construction of the claims having regard to the general principles such as those as established in Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] RPC 9 (see section 12.4 of these Guidelines).

4.6. The **second step** of the Aerotel/Macrossan test is essentially asking what the inventor has added to human knowledge. Jacob LJ outlined the following considerations to be applied when identifying the actual contribution made by the claims:

*"The second step – identify the contribution - is said to be more problematical. How do you assess the contribution? Mr Birss submits the test is workable – it is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are. What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at substance not form – which is surely what the legislator intended."*  
(paragraph 43 of Aerotel/Macrossan)

4.7. Accordingly, knowledge of the prior art will play a role in assessing the contribution ~~but the prior art falling in the field of section 9B(3) of the Ordinance should not be considered.~~