Bills Committee on the Patents (Amendment) Bill 2015

Follow-up actions arising from the discussion at the meeting on 12 January 2016

Purpose

At the meeting on 12 January 2016, the Government was requested to-

(a) advise the Bills Committee of the textual amendments made to new sections 9A to 9F of the new Part 1A under clause 11 of the Bill; and

(b) provide citation of court cases for Members' reference in relation to–

(i) the patentability criteria of an invention, namely, novelty, inventive step and industrial application; and

(ii) use of "Swiss-type claim" in Hong Kong to seek protection of inventions relating to second medical use.

2. The Government provides the requested information at Annexes A and B respectively.

Commerce and Economic Development Bureau
Intellectual Property Department
January 2016

Chapter:	514	PATENTS ORDINANCE		

Part 1A

Patentability, Right to Patent and Mention of Inventor

Division 1—Patentability

Section:	~~93~~9A	Patentable inventions		

~~Patentable inventions~~

(1) An invention is patentable if it~~—~~

(a) is new;

(b) involves an inventive step; and

(c) is susceptible of industrial application~~, is new and involves an inventive step~~.

(2) The following ~~in particular shall~~are not to be regarded as ~~inventions within~~an invention for the ~~meaning~~purposes 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; and

(d) ~~the~~a presentation of information.

(3) Subsection (2) ~~shall exclude~~ excludes the patentability of the subject-matter or activities referred to in that subsection only to the extent to which a patent or patent application relates to ~~such~~the subject-matter or activities as such.

(4) A method for the treatment of the human or animal body by surgery or therapy ~~and~~, or a diagnostic method practised on the human or animal body ~~shall~~, is not to be regarded as an invention ~~which~~that is susceptible of industrial application for the purposes of subsection (1)~~, but~~. However, this subsection ~~shall~~does not apply to a product, and in particular a substance or composition, for use in any such method.

(5) An invention the publication or working of which would be contrary to public order ("ordre public") or morality ~~shall~~is not ~~be~~ a patentable invention~~; however~~. However, the working of an invention ~~shall~~is not ~~be deemed~~ to be regarded as so contrary ~~merely~~only because it is prohibited by any law in force in Hong Kong.

(6) ~~A~~The following are not patentable—

(a) a plant or animal variety ~~or~~ ; and

(b) an essentially biological process for the production of plants or animals~~,~~ (other than a microbiological process or ~~the~~its products ~~of such a process, shall not be patentable.~~).

Section:	~~94~~9B	Novelty		

(1) An invention ~~shall be considered~~ is to be regarded as new if it does not form part of the state of the art.

(2) ~~The~~ For a patent application for an invention (***subject application***), the state of the art ~~shall be held~~

~~to comprise~~comprises everything made available to the public (~~whether~~ in Hong Kong or elsewhere), whether by means of a written or oral description, by use~~,~~ or in any other way~~-~~

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

~~(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.~~

(3) ~~Additionally~~For the subject application, the state of the art ~~shall be considered as comprising the content of~~ also comprises the contents of the following applications for an invention—

(a) ~~any application for~~ a standard patent (R) application as filed~~, of which~~—

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

(ii) the corresponding designated patent application of which was published ~~in~~by the designated patent office on or after the ~~date referred to in subsection (2);~~material date of the subject application;

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

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

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

(c) a standard patent (O) application, as filed and as published—

(i) the material date of which is before the material date of the subject application; and

(ii) which was published under section 37Q on or after the material date of the subject application; and

(d) ~~any application for~~ a short-term patent application—

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

(ii) because of ~~pursuant to~~ which a short-term patent was published under ~~this Ordinance~~ section 118 on or after the material date of the subject application~~referred to in subsection (2)~~.

(4) ~~Subsections (1) to (3) shall not exclude the patentability of any~~ For an invention consisting of a substance or composition~~, comprised in the state of the art,~~ for use in a method referred to in section ~~93~~9A(4) ~~where its~~, if the use ~~for any~~ of the substance or composition in any such method ~~referred to in~~ does not form part of the state of the art, then the fact that ~~subsection is not comprised in~~ the substance or composition forms part of the state of the art does not prevent the invention from being regarded as new.

(5) For an invention consisting of a substance or composition for a specific use in a method referred to in section 9A(4), if the specific use of the substance or composition in any such method does not form part of the state of the art, then the fact that the substance or composition, and any other use of the substance or composition in any such method, form part of the state of the art does not prevent the invention from being regarded as new.

(6) For the purpose of any validity proceedings commenced before the commencement date in relation to a pre-existing patent, section 94 as in force immediately before that date continues to apply to the invention, which is the subject of the patent, as if that section had not been repealed.

(7) For the purpose of any validity proceedings commenced on or after the commencement date in relation to a pre-existing patent, this section applies to the invention, which is the subject of the patent, as if the patent was granted on or after the commencement date.

(8) In this section—

commencement date (生效日期) means the date on which the Patents (Amendment) Ordinance 2015 (of 2015) comes into operation;

pre-existing patent (既有專利) means a standard patent or short-term patent granted before the commencement date;

validity proceedings (有效性法律程序) means any proceedings in which the validity of a patent is put in issue under section 101(1).

Section:	~~96~~9C	Inventive step		

(1) An invention ~~shall~~is to be ~~considered~~regarded 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~~purposes of subsection (1), if the state of the art also ~~includes documents~~comprises the contents of the applications falling within ~~the meaning of~~ section ~~94~~9B(3), ~~these documents~~those applications are not to be considered in deciding whether there has been an inventive step.

Section:	~~97~~9D	Industrial application		

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

Division 2—Right to Patent and Mention of Inventor

Section:	~~100~~9E	Right to ~~a~~ patent ~~to belong~~belongs to inventor		

~~Right to a patent~~

(1) ~~Except as provided in subsection~~Subject to subsections (2) and (3), the right to a patent ~~shall belong~~belongs to the inventor or ~~his~~the inventor's successor in title.

(2) If the inventor is an employee, the right to the patent ~~shall~~is to be determined~~—~~

(a) in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed; or~~,~~

(b) if the identity of ~~such~~the country, territory or area cannot be determined, in accordance with the law of the country, territory or area ~~in which~~where the employer ~~has his~~'s place of business to which the employee is attached is located.

(3) If 2 or more persons have made an invention independently of each other, the right to~~the patent shall belong~~ a patent for the invention belongs to the person whose patent application has the earlier or earliest material date (as the case requires).

~~(a) as between persons who have applied for or been granted a standard patent for the invention, to the person in respect of whose application for the standard patent the date of filing of the~~

corresponding designated patent application or, if priority was claimed, the date of priority, is the earlier or earliest; or

(b) as between persons who have applied for or been granted a short-term patent for the invention, to the person in respect of whose application for a short-term patent the date of filing or, if priority was claimed, the date of priority, is the earlier or earliest; or

(c) where one or more of the persons has applied for or been granted a standard patent and one or more of the persons has been granted a short-term patent, to the person in respect of whose application the date specified in paragraphs (a) and (b) (as may be appropriate) is the earlier or earliest,

but in the application of paragraphs (a) and (c) regard shall only be had to an application for a standard patent that has been published under this Ordinance.

(4) Subsection (3) does not apply to a standard patent application that has not been published under section 20 or 37Q.

Section:	459F	Mention of inventor		

Patents generally

(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in—

(a) any published patent application for the invention; and

(b) any patent granted for the invention.

(2) WhereIf a person has been mentioned in a patent as the sole inventor or a joint inventor in pursuanceof an invention because of this section, any other person who alleges that the formerperson ought not to have been so mentioned may at any time after the grant of the patent request the Registrar to make a finding to that effect; and if.

(3) If the Registrar makes such a finding he shall, the Registrar—

(a) must accordingly amend the register and any undistributed copies;

(b) must advertise the fact of the patent, and amendment by notice in the official journal; and

(c) may issue a certificate to the effect of histhe finding to the person who made the request.

Annex B

Citation of Court Cases on

(i) Patentability Criteria of an Invention; and

(ii) Use of "Swiss-type Claim" in Hong Kong to seek Protection of Inventions relating to Second Medical Use

A. Case Authorities on Patentability Criteria of an Invention

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

Novelty

2. An invention is regarded as new (novel) if it does not form part of the state of art[2].

3. The "state of the art" comprises everything made available to the public anywhere, whether by means of a written or oral description, by use or in any other way before the filing date (or the priority date if applicable) of the patent application in question[3].

(i) *Synthon BV v SmithKline Beecham Plc (Paroxetine Methanesulfonate)* [2006] RPC 10 (UK House of Lords) –

An invention is not considered as novel if it is anticipated by the state of the art, i.e. if the invention is disclosed by the state of the art, and the ordinary skilled person would have been able to perform the invention which satisfies the requirement of disclosure.

Inventive Step

4. An invention is regarded 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[4].

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[1] Section 9A(1) under Clause 11 of the Patents (Amendment) Bill 2015 ("the Bill") re-enacting section 93(1) of the Patents Ordinance

[2] Section 9B(1) under Clause 11 of the Bill re-enacting section 94(1) of the Patents Ordinance

[3] Section 9B(2) under Clause 11 of the Bill re-enacting section 94(2) of the Patents Ordinance

[4] Section 9C(1) under Clause 11 of the Bill re-enacting section 96(1) of the Patents Ordinance

(i) *Technograph Printed Circuits Limited v Mills & Rockley (Electronics) Limited* [1972] RPC 346 (UK House of Lords) –

The "person skilled in the art" refers to a notional skilled technician who –
(a) is well acquainted with workshop technique and who has carefully read the relevant literature; and
(b) has an unlimited capacity to assimilate the contents of, it may be, scores of specifications but to be incapable of a scintilla of invention.

(ii) *Pozzoli SPA v BDMO SA* [2007] FSR 37 (UK Court of Appeal) –

Whether an invention is obvious to a person skilled in the art is assessed by reference to a four-step objective approach:

(a) identify the notional person skilled in the art and the relevant common general knowledge;
(b) identify the inventive concept of the claim in question;
(c) identify the differences that exist between the matter cited as forming part of the state of the art and the inventive concept of the claim;
(d) determine whether, viewed without any knowledge of the alleged invention as claimed, those differences constitute steps which would have been obvious to the person skilled in the art or whether they require any degree of invention.

Industrial Application

5. An invention is regarded as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.[5]

(iii) *Eli Lily & Co v Human Genome Sciences Inc* [2008] RPC 29 (UK Patents Court) –

The notion "industry", which must be construed broadly, includes all manufacturing, extracting and processing activities of enterprises that are carried out continuously, independently and for commercial gain.

(iv) *Human Genome Sciences Inc v Eli Lily & Co* [2012] RPC 6 (UK Supreme Court) –

As noted by the UK Supreme Court, the patent must disclose a practical application in the industrial practice for resolving a given technical problem,

[5] Section 9D under Clause 11 of the Bill re-enacting section 97 of the Patents Ordinance

being the actual benefit or advantage of exploiting the invention. In this connection, the patent and common general knowledge have to enable the skilled person to reproduce or exploit the claimed invention without undue burden, or having to carry out "a research programme".

B. Case Authority Confirming the Use of "Swiss-type claim" in Hong Kong for Seeking Patent Protection of Inventions relating to Second Medical Use

(v) *Abbott GMBH & Another v Pharmareg Consulting Company Ltd & Another* [2009] 3 HKLRD 524 (HK Court of First Instance) –

The Court of First Instance noted that the relevant claim in the Hong Kong patent in question was a Swiss-type claim about use of a known compound "Sibutramine" in the manufacture of a medicament for the treatment of obesity which was not previously known could be treated by using the compound. By noting the proposition that second medical use claims could be obtained by means of appropriate drafting, and also holding that the treatment of obesity was a new medical use of Sibutramine, the Court did not consider that there was any real doubt about the validity of the patent thereby rejecting the defendants' submission on challenging the validity of the Swiss-type claim. (See paragraphs 36 to 39 of the judgment)

C. Corresponding Oversea Enactments concerning Inventions relating to Second Medical Use

6. Clause 11 of the Bill adding section 9B(5) to the Patents Ordinance enables patent claims for inventions relating to second medical use to be drafted in a simpler and more direct manner[6]. Section 9B(5) mirrors the corresponding provisions in the *UK Patents Act 1977* (section 4A(4)) and also the *European Patent Convention 2000* (Article 54(5)) as reproduced at **Enclosure**.

Presentation

7. Members are invited to note the information above.

[6] A direct second medical use claim is usually drafted in a format such as "substance X for use in the treatment of disease/condition Y".

Enclosure

UK Patents Act 1977

Methods of treatment or diagnosis

4A. (1) A patent shall not be granted for the invention of-

(a) a method of treatment of the human or animal body by surgery or therapy, or

(b) a method of diagnosis practised on the human or animal body.

(2) Subsection (1) above does not apply to an invention consisting of a substance or composition for use in any such method.

(3) In the case of an invention consisting of a substance or composition for use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

(4) In the case of an invention consisting of a substance or composition for a specific use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if that specific use does not form part of the state of the art.

European Patent Convention 2000

Article 54

Novelty

(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 by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

(4) Paragraphs 2 and 3 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 53(c), provided that its use for any such method is not comprised in the state of the art.

(5) Paragraphs 2 and 3 shall also not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in a method referred to in Article 53(c), provided that such use is not comprised in the state of the art.