WORLD TRADE ORGANIZATION

RESTRICTED

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Council for Trade-Related Aspects of Intellectual Property Rights

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REVIEW OF THE PROVISIONS OF ARTICLE 27.3(b)

Information from Members

Addendum

HONG KONG, CHINA

The present document represents the information requested by the Council for Trade-Related Aspects of Intellectual Property Rights which the Secretariat has received from Hong Kong, China, by means of a communication from the Hong Kong Economic and Trade Office, dated 29 June 2001.[1]

A. PATENT SYSTEM

1. In your territory, is there any basis for denying a patent on an invention consisting of an entire plant or animal that is novel, capable of industrial application, involves an inventive step and has been adequately disclosed?

Yes. Section 93(6) of the Patents Ordinance ("PO") provides that a plant or animal variety shall not be patentable. See also the answer to question 2(c).

2. If the answer to question 1 is yes, please respond to the following questions:

(a) Does your patent system exclude entire plants or animals as inventions?

No, but whether such inventions are patentable depends on whether they comply with Section 93(1) of the PO (see the answer to question 3(a)).

(b) If your patent system does recognize entire plants and animals as inventions, does it exclude all such inventions from being patentable subject-matter, or does it only exclude certain types of plants or animals? If it excludes only certain types, please identify the categories or characteristics of inventions that are excluded.

Section 93(6) of the PO indicates that plant and animal varieties are not patentable.

[1] The questions to which answers are provided are those which can be found in the synoptic tables contained in document IP/C/W/273.

(c) Is there any other basis in your law that precludes the grant of a patent on any categories of plant or animal inventions that otherwise are novel, involve an inventive step, are capable of industrial application and have been adequately disclosed?

Section 93(5) of the PO provides that "an invention the publication or working of which would be contrary to public order ("ordre public") or morality shall not be a patentable invention". This exclusion has not yet been tested in the Hong Kong courts. No patent has so far been found contrary to public order or morality in Hong Kong, China ("HKC").

3. Other than with respect to subject-matter you defined as being ineligible to be patented under question 2, is it possible in your territory to obtain a patent claim defined in any of the following ways?

(*a*) *A patent claim that is not limited to a specific plant or animal variety.*

Yes. Such an invention must satisfy the provision of Section 93(1) of the PO (i.e. must be susceptible of industrial application, is new and involve an inventive step) and must not be in breach of Section 93(5). See the answer to question 2(c).

(b) A patent claim that is expressly limited to a plant or animal variety.

No. See the answer to question 1.

(c) A patent claim that is expressly limited to a group of plants or animals, where the group is defined through reference to a shared characteristic such as incorporation of a particular gene.

There has been no case on this topic in HKC.

Whether such an invention is patentable must depend on whether it complies with Section 93(1) of the PO. Commentators elsewhere have taken the view that plants and animals altered by genetic manipulation are not varieties within the meaning of the European Patent Convention, but rather are representatives of a large family characterized by some novel gene, such as one imparting resistance to a herbicide. (See paragraph 1.20 of the C.I.P.A. Guide to Patents Act (4th Edition).) In such a case, the prohibition against patentability as regards plant or animal varieties contained in Section 93(6) of the PO may not be applicable.

4. Is it possible to obtain a patent in your territory on a microorganism that is novel, involves an inventive step and is capable of industrial application?

Yes. In relation to microorganisms and short-term patents, the PO contains detailed provisions relating to the deposit of such microorganisms. (See Section 128 of the PO and Section 73 of the Patents (General) Rules.)

5. Is it possible to obtain a patent in your territory on an essentially biological process for the production of a plant or animal (i.e. a process limited to those acts that are necessary for sexual or asexual reproduction of a plant or animal)?

No. Section 93(6) of the PO provides that an "essentially biological process for the production of plants or animals" shall not be patentable.

6. Is it possible to obtain a patent in your territory for subject-matter that is identical to that found in nature (e.g. a plant or animal in its natural state)?

There has been no case in HKC on this topic.

Section 93(1) of the PO provides that an invention is patentable if it is susceptible of industrial application, is new and involves an inventive step. Section 93(2) of the PO provides a list of what shall **not** be regarded as inventions. This list includes: a discovery, scientific theory or mathematical method.

The fundamental point to note is that "a discovery" is not patentable. Products or compositions are not excluded from patentability under Hong Kong law on the grounds that they are nature-identical. The question is whether there is a discovery. It is probably the case that the finding of a new substance or microorganism occurring freely in nature is a discovery. However, if it is necessary to develop a process to extract the substance or microorganism, such a process, and the material obtained from this process, may well be patentable. Much depends on the facts of a particular case, and the state of the art.

7. Does your patent system include any special provisions to ensure adequate disclosure regarding inventions covered by Article 27.3(b) (for example, microorganisms)?

Yes. See the answer to question 4 above.

B. PLANT VARIETY PROTECTION SYSTEMS

1. Do the laws applicable to your territory provide for a sui generis form of protection for a new plant variety?

Yes. HKC provides *sui generis* plant variety protection by way of the Plant Varieties Protection Ordinance (Cap. 490).

2. If the answer to question 1 is yes, does that protection conform to the standards defined in one of the Acts of the International Convention for the Protection of New Varieties of Plants (UPOV).

HKC is not a member of UPOV, and is therefore unable to say categorically that Cap. 490 conforms to the standards defined in one of the Acts of UPOV. However, HKC had in mind the 1991 UPOV Act when drafting Cap. 490.

3. If the answer to question 2 is yes, please specify the Act of the UPOV Convention upon which your legislation is based (i.e. the 1991 Act, the 1978 Act or the 1961/1972 Act).

See the answer to question 2.

4. If sui generis protection for plant varieties is provided in your territory, would any of the following acts require the prior authorization of the right holder:

(*a*) *acts performed for research or experimental purposes, or to develop new varieties of plants;*

No. See Sections 26(b)(ii) and (iii) of Cap. 490.

(*b*) *acts performed to commercially exploit a variety distinct from the protected variety but sharing its essential characteristics;*

Yes, if essentially derived from the protected initial variety. See Section 31(1) of Cap. 490. A variety is treated as an essentially derived variety of another variety if:

(a) it is predominantly derived from that other variety;

(b) it retains the relevant characteristics that result from the genotype or combination of genotypes of that other variety;

(c) it is clearly distinguishable from that other variety; and

(d) except for the differences which result from the act of derivation, it confirms to the initial variety in the expression of the relevant characteristics that result from the genotype or combination of genotypes of that other variety. (Section 31(3) of Cap. 490.)

(*c*) *acts performed by a farmer of harvesting seed from his planting of a protected variety legitimately obtained, storage of that seed, and replanting of that seed on the farmers' land.*

Yes, prior authorization is required unless the particular types of plant within which the protected variety is classified have been prescribed for exemption under Section 26(c) of Cap. 490.

If prior authorization is not required for any of the above examples of activities, is there any requirement that the party undertaking the specified actions provide the right holder with remuneration in any form?

There is no particular right for remuneration. The rights of a grantee under Cap. 490 are a proprietary right. It is the responsibility of a grantee to bring legal action against any person infringing his/her rights through civil proceedings in the courts.

5. Would acts done privately and for non-commercial purposes require the authorization from the right holder?

No. Section 26 of Cap. 490 permits use for non-commercial purposes.

6. Does your legislation provide for other exceptions to the rights conferred?

The exceptions to the rights granted are set out in Section 26 of Cap. 490 and include:

- Use for experimental or research purposes.
- Use for the purposes of breeding a new variety.
- Use of reproductive material for human consumption or other non-reproductive purposes.
- Section 29 of Cap. 490 also enables a third party to obtain an order from the Registrar of Plant Varieties Rights in relation to the sale of reproductive material relating to a particular plant variety if such is not available for purchase at a reasonable price.

7. Can protection be obtained for a plant variety that was known to the public, or was publicly available, prior to the application for sui generis protection for that plant variety, and, if so, under what conditions (i.e. what are the time-limits during which public disclosure or availability will not preclude the grant of protection)?

Yes. Section 18(4)(a) provides that a variety is new if there has been no sale of that variety in Hong Kong for more than 12 months before an application was made, or no sale outside Hong Kong in respect of trees or vines for a period of six years, or a period of four years in every other case.

8. To be entitled to rights under sui generis plant variety protection does one have to be the person who bred, or discovered and developed the variety, or his successor in title?

Under Section 18(2)(b) of Cap. 490, one of the requirements for an application to be treated as being eligible for the making of a grant is that the Registrar is satisfied that the applicant is an owner of that variety. Section 2 of Cap. 490 defines an owner, in relation to any variety, as: "a person who bred or discovered and developed that variety; an agent of that person; a successor to that person".

9. Can protection be predicated on identification of an unexpressed gene, on an unexpressed set of genes present in the genome of the plant variety, or on the characteristics of germplasm, rather than the expressed characteristics of plant varieties derived from such genes or germplasm?

Protection is only granted if criteria like distinctness, uniformity, and stability (which are based upon the characteristics of the plant varieties) can be fulfilled.

10. What are the conditions that your law require for protection?

Cap. 490 applies to all botanical genera and species of vascular plants as well as edible fungi and algae. Varieties of all types of plants (e.g. food crops, vegetables, ornamentals) are eligible for protection.

Plant varieties must meet the following criteria:

(a) Novelty

Protection can only be considered for a variety that has not been sold in Hong Kong for more than 12 months and elsewhere in the world for six years, in the case of trees and vines, or for more than four years, in every other case.

(b) Distinctness

To be considered for protection, the Registrar must be satisfied that the variety is clearly distinguishable in one or more important characteristics from existing varieties whose existence is a matter of common knowledge at the time of application. Distinguishing characteristics must be capable of precise description.

(c) Uniformity

The Registrar must be satisfied that the variety is sufficiently uniform or homogeneous in its relevant characteristics, subject to any variation that may be expected having regard to any particular features of its sexual reproduction or vegetative propagation, before the variety can be considered for protection.

(d) Stability

The Registrar must be satisfied that the variety retains its relevant characteristics over a number of generations of reproduction or propagation or, where a particular cycle of reproduction or multiplication is specified by the application, at the end of each cycle.

11. What is the duration of protection?

Plant variety rights are granted for a term of 25 years in the case of trees and vines, and 20 years in every other case.