

Deferral of Formality Examination of Applications for Standard Patents by Original Grant (Pilot Scheme)

Every application for standard patent by original grant (“OGP application”) is subject to examination of minimum requirements and formal requirements by the Registrar of Patents (“the Registrar”)¹ before the application is published. Once the minimum requirements are met, the Registrar will accord a filing date to the application and initiate formality examination to check whether the application contains the required supporting documents and information.

One of the formal requirements for an OGP application is submission of claim(s). In some cases, applicants may need time and additional costs for formulation and drafting of the claim(s). To offer applicants a greater degree of flexibility in prosecuting OGP applications, applicants can now request to defer formality examination for their applications under the latest pilot scheme.

Deferral of formality examination essentially allows an applicant to establish an early filing date without having to immediately furnish any claim(s). An applicant making use of such option to defer formality examination can enjoy the same flexibilities and convenience of late filing of claims which is currently offered by taking out a provisional patent application or making use of the grace period for late filing in some jurisdictions.

Pilot scheme

An applicant may submit a request for deferral of formality examination for a period up to 12 months from the filing or priority date. Deferral of formality examination is granted at the Registrar’s sole discretion, and once granted the processing of the OGP application will be suspended during the deferred period. Upon the expiry of the deferred period, the Registrar will resume formality examination automatically. If there are deficiencies on formal requirements in the application to be corrected, the applicant will receive notice from the Registry requiring such correction before his/her application may become ready for publication. If the application has been found to have satisfied all formal requirements, the applicant will receive notification of publication.

¹ See sections 37M(3) and 37L of the Patents Ordinance (Cap. 514) for the minimum and formal requirements respectively.

Requirements

The Registrar may defer formality examination of an OGP application if the following conditions are met:

- (1) The OGP application has obtained a filing date.
- (2) The applicant has not made any early publication request under section 37Q(2) of the Patents Ordinance (Cap. 514).
- (3) The end date of the deferred period requested does not exceed beyond 12 months from the filing or priority date.
- (4) The Registrar has not issued any deficiency notice under section 31Y(1) of the Patents (General) Rules (Cap. 514C).

How to Apply

- (1) Submit an OGP application containing a description of the invention or a reference to an earlier specified application.
- (2) Submit a request for deferral of formality examination at the time of filing of the OGP application or within 1 month from the filing date of the OGP application.
- (3) There is no specified form for making the request but an applicant may submit the request by including the following statement in the OGP application:
“I request to defer formality examination of this patent application for a period of [whole number] months (maximum 12 months), from the filing or priority date.”
- (4) No fee is required for seeking deferral of formality examination.

Benefits

- Establishes an early priority date as soon as practicable
- Enables quick filing before impending public disclosure of the invention
- Delays the deadline imposed under the normal procedures for submitting claims
- Defers the costs required for prosecution of patent applications in Hong Kong
- Offers applicants more time to assess the patentability and commercial potential of the invention
- Offers applicants more time to seek funding for R&D or patent prosecution if needed

Points to Note

- As only new inventions are patentable, inventions should be kept confidential before the filing of patent applications.
- The most accessible way to obtain a filing date for an OGP application is by submitting an electronic record of the application via IPD's e-filing system which is available around the clock at <https://efiling.ipd.gov.hk/>.
- All claims filed after expiry of the deferred period must not extend the subject matter disclosed in the application as filed.
- At the formality examination stage, the Registrar will issue notice for deficiencies (if any) on formal requirements in the OGP application. The applicant has to correct any deficiencies of his/her OGP application promptly to avoid delay in publication of the application.
- Please seek independent professional advice for any questions about acquisition, protection and enforcement of intellectual property rights.