

Patents Registry

Intellectual Property Department

Hong Kong SAR Government

Patents Examination Guidelines

Section 14: Formality Examination of Patent Applications

Introduction

- 14.1 Every patent application is subject to examination of minimum requirements and formal requirements by the Registrar. If the Registrar considers that a patent application does not comply with any of these requirements, the Registrar will, by notice, inform the applicant of the deficiencies and also request the applicant to timely correct such deficiencies.

Requirements for according a date of filing to each type of patent application

Standard patent (O)/short-term patent applications

- 14.2 Sections 37M(3) and 114(3) of the Ordinance respectively set out the minimum requirements with which a standard patent (O) application and a short-term patent application must comply in order to enable the Registrar to accord a date of filing to the application.
- 14.3 In order to satisfy the minimum requirements, a standard patent (O) application / a short-term patent application must contain—
- (a) an indication that a patent is sought;
 - (b) information identifying the applicant; and
 - (c) something that appears to be a description of the invention or a reference to an earlier specified application together with a statement indicating that a description and the drawings (if any) of the invention in question are completely contained in ~~an~~the earlier application.

- 14.24 Where the only deficiency remaining in a patent application is the failure to file a translation of the title of the invention or the abstract, or a transliteration of the name(s) of the applicant or the inventor as required under section 56(2) of the Rules, the Registrar may, upon the applicant's request, grant an extension for a period that the Registrar considers reasonable for the applicant to correct the deficiency (sections 100 and 100AAD of the Rules).
- 14.25 Where a short-term patent application includes a request for deferral of grant of the patent and the only deficiency in the short-term patent application is the failure to file a search report, the applicant may request an extension of time for filing the search report to a date not later than 1 month before the deferred date of grant of the patent (section 68A(1) of the Rules).
- 14.26 If a deficiency, other than one solely relating to a priority claim, is not corrected timely by the applicant, the application must be:
- (a) regarded as being withdrawn where no steps are taken to correct the deficiencies;
or
 - (b) refused in any other case.
- (sections 19(3) & 26(3) of the Ordinance (for standard patent (R) applications); section 37P(4) of the Ordinance (for standard patent (O) applications); section 115(3) of the Ordinance (for short-term patent applications))
- 14.27 If a deficiency relating solely to a priority claim in a patent application cannot be corrected or is not timely corrected, only the priority right is lost for the application (sections 19(4) and 26(4) of the Ordinance (for standard patent (R) applications); section 37P(5) of the Ordinance (for standard patent (O) applications); section 115(4) of the Ordinance (for short-term patent applications)).
- 14.28 If there are deficiencies in the application or request as regards the formal requirements that cannot be corrected, the application or request must be refused (sections 19(1A) (for requests to record), 26(1A) (for requests for registration and grant), 37P(2) (for standard patent (O) applications) and 115(1A) (for short-term patent applications) of the Ordinance).

Example

~~Where a reference to an earlier specified application is made in a standard patent (O) or short-term patent application, the failure to file any of the following documents within 4 months after the date of compliance with the minimum requirement of the subsequent application will be regarded as a deficiency that cannot be corrected:~~

~~(a) a copy of the earlier specified application;~~

~~(b) a copy of the certificate issued by the authority that received the earlier specified application;~~

~~(c) the translation of the earlier specified application (where applicable); or~~

~~(d) a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate (where applicable).~~

~~(see section 13.52 of the Guidelines)~~

Request for reinstatement of patent applications

14.29 If a patent application is refused or deemed to be or regarded as being withdrawn following the applicant's failure to comply with a time limit to correct a deficiency, the applicant may reinstate the application by filing a request for reinstatement **within 2 months** after the refusal or (deemed) withdrawal of the application (sections 28(1)&(2) (for standard patent (R) applications), 37ZD(1) (for standard patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance).

14.30 A request for reinstatement should be made in Patents form P13 together with payment of the official fee (sections 28(1)&(2) (for standard patent (R) applications), 37ZD(1) (for standard patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance).

14.31 A request for reinstatement is not deemed to be filed unless the omission which constituted the failure to comply with the time limit has been made good (sections 28(2)(c) (for standard patent (R) applications), 37ZD(1) (for standard patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance). An omission is not made good by a mere procedural request such as a request for oral hearing.

14.32 The reinstatement relief is however not available at the formality examination stage under any of the following circumstances—

(a) a standard patent (R) application that is deemed to be/regarded as being withdrawn/refused for the reason of—

(i) a failure to file a request for registration and grant within the non-extendible 6-month period (sections 24(2) and 28(3)(b) of the Ordinance);

(ii) a failure to pay the prescribed maintenance fee within the prescribed period (sections 28(3)(b) and 33(2) of the Ordinance); and

(iii) a failure to correct any deficiency concerning the requirements for the accordance of a date of filing for a request for registration and grant within the time limit (sections 25(2) & (4) and 28(3) of the Ordinance);