

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

Section 15: Substantive examination of standard patent (O) applications and short-term patents

Overview

15.1 An important new procedure introduced by the new patent system launched on 19 December 2019 is the substantive examination of standard patent (O) applications and also short-term patents. More specifically, applicants of standard patent (O) applications must request the Registrar to carry out substantive examination of their applications as a prerequisite for grant of standard patent (O). On the other hand, while it remains the status quo that short-term patent applications are generally granted upon formality examination, short-term patents are subject to post-grant substantive examination by the Registrar upon requests by the patent proprietors or any third party with reasonable grounds/legitimate business interests under the new patent system.

Request for substantive examination

Standard patent (O) applications

15.2 Subject to certain exceptions¹, an applicant of standard patent (O) application must generally request the Registrar to carry out substantive examination of the application by filing Patents form OP2 within 3 years (non-extendable) from the earliest priority date claimed or, where there is no priority claim, from the date of filing of the application (section 37T(1) of the Ordinance and section 31ZC(2)(a) & (b) of the Rules).

15.3 The official fee for the request must be paid to the Registrar within one month after the date of the request (section 37T(1) of the Ordinance and section 31ZC(3) of the

¹ If a standard patent (O) application is an application ordered to be filed by the court or Registrar to replace an application or a granted patent for which the applicant or proprietor is not entitled to apply or be granted or a divisional application with a fulfilment date (i.e. the date on which the minimum requirement is complied with and notified to the applicant by a notice) which is either less than 2 months before the expiry of the 3-year period or on or after the date of expiry of the 3-year period, the applicant must file a request for substantive examination within 2 months after the fulfilment date of the new application (section 37T(1) of the Ordinance and section 31ZC(2)(c) & (d) of the Rules).

Rules). If the fee is not paid within such period, the fee may still be validly paid within a grace period that ends at the expiry of one month after the date of notice given to the applicant by the Registrar but no further extension will be allowed (section 37T(1) of the Ordinance and section 31ZC(4) of the Rules).

- 15.4 The Registrar will inform the applicant that the standard patent (O) application has entered into the stage of substantive examination after the publication of the application and the receipt of a request for substantive examination and the prescribed fee (section 37U(1) of the Ordinance).
- 15.5 If the request for substantive examination is not made or the prescribed fee is not paid within the time limit, the standard patent (O) application will be regarded as being withdrawn (section 37T(2) of the Ordinance).

15.5A Generally, substantive examination commences upon the expiry of the 3-month period available for pre-grant amendment under section 31ZT(2)(d) of the Rules (see section 16.13(c) of the Guidelines). Substantive examination may commence earlier if an applicant files a written statement with the Registrar confirming that no such amendment is required, thereby reducing the overall time for the examination process.

Short-term patents

- 15.6 A short-term patent proprietor or any person having reasonable grounds or legitimate business interests may request the Registrar to conduct substantive examination of the patent for determining the validity of the grant (section 127B(1) & (2) of the Ordinance).
- 15.7 A request for substantive examination of a short-term patent may be filed in Patents form OP4 at any time after the grant of the short-term patent. However, no such request can be made when—
- (a) a previous request has been made, and either—
 - (i) the outcome is still pending, or
 - (ii) that request has resulted in the issue of a certificate of substantive examination or in the revocation of the patent; or
 - (b) the short-term patent has previously been found by the court to be wholly valid in any proceedings in which the validity of the patent is contested.
- (section 127B(4) of the Ordinance)
- 15.8 A request for substantive examination of a short-term patent must be accompanied by the official fee (section 127B(3)(b) of the Ordinance).
- 15.9 A request for substantive examination of a short-term patent may not be withdrawn (section 127B(5) of the Ordinance).