

## Patents Registry

### Intellectual Property Department

### Hong Kong SAR Government

## Patents Examination Guidelines

### Section 13: Patent applications

#### **Overview of patent application process**

- 13.1. Under the Ordinance, two kinds of patents are granted in the Hong Kong SAR—
- (a) “standard patent” with a maximum protection term of 20 years; and
  - (b) “short-term patent” with a maximum protection term of 8 years.
- 13.2. In respect of standard patent, there are two alternative application routes for grant—
- (a) the “original grant” patent route for “standard patent (O)”; or
  - (b) the “re-registration” route for “standard patent (R)”.
- 13.3. Accordingly, to apply for protection of an invention in the Hong Kong SAR, an applicant may opt to file one of the following types of patent applications with the Registrar—
- (a) a standard patent (O) application;
  - (b) a standard patent (R) application; or
  - (c) a short-term patent application.

#### ***Standard patent (O) applications***

- 13.4. A standard patent (O) application can be filed in ***Patents form OP1*** with the Registrar directly without filing any previous corresponding patent application elsewhere in support (cf. the precondition for filing a standard patent (R) application in section 13.6 of these Guidelines).

- 13.5. A standard patent (O) application is subject to both formality and substantive examination.
- (a) If the application has been accorded a date of filing and also has been found by the Registrar to have satisfied all formal requirements, the Registrar will—
- (i) publish the application as filed, together with any subsequent amendment of the application, as soon as practicable on the expiry of 18 months after the accorded date of filing or the earliest priority date claimed, unless the application is withdrawn or refused before preparations for its publication are completed by the Registrar; and
  - (ii) advertise the fact of the publication by notice in the official journal.
- (section 37Q of the Ordinance; section 31Z of the Rules)
- (b) After publication of the application and upon receiving a request by the applicant and the prescribed fee, the Registrar will conduct substantive examination as to whether the invention underlying the standard patent application fulfills, amongst others, the patentability requirements (see section 15 of these Guidelines).

### ***Standard patent (R) applications***

- 13.6. The filing of a standard patent (R) application with the Registrar must be based on an earlier corresponding patent application (“designated patent application”) filed with one of the following three “designated patent offices” for a corresponding patent grant (“designated patent”)—
- (a) the CNIPA (formerly known as the “State Intellectual Property Office”);
  - (b) the EPO, in respect of a patent designating the United Kingdom; and
  - (c) the UKIPO.
- 13.7. A standard patent (R) application is mainly subject to formality examination, and is made in two stages by filing:
- (a) a request to record a designated patent application (stage 1); and then
  - (b) a request for registration of a designated patent and grant of a standard patent (R) (stage 2).
- 13.8. In stage 1, a request to record should be filed in ***Patents form P4*** with the Registrar within six months (which is non-extendible) after the date of publication of the designated patent application. If the request to record has been accorded a date of filing and has also been found by the Registrar to have satisfied all formal requirements, unless the Registrar considers that the publication or working of the

invention being the subject of the patent application is contrary to public order (“ordre public”) or morality, the Registrar will—

(a) record the designated patent application in the register and enter particulars of the request to record in the register; and

(b) publish the request to record, advertise the fact of publication by notice in the official journal and inform the applicant of the same;

(sections 9A(5), 20 and 37 of the Ordinance)

13.9. In stage 2, a request for registration and grant should be filed in **Patents form P5** with the Registrar within six months (which is non-extendible) after the date of grant of the designated patent by the designated patent office or publication of the request to record by the Registrar, whichever is later. If the request for registration and grant has been accorded a date of filing and has also been found by the Registrar to have satisfied all formal requirements, unless the Registrar considers that the publication or working of the invention being the subject of the patent application is contrary to public order (“ordre public”) or morality, the Registrar will —

(a) register the designated patent and grant a standard patent (R) for the invention shown in the published specification of the designated patent;

(b) issue and send a certificate of grant to the proprietor(s) and advertise the fact of grant by notice in the official journal; and

(c) publish the patent specification and the names of the proprietor(s) and inventor(s) (if different from the proprietor(s)).

(sections 9A(5), 27 and 37 of the Ordinance)

### **Short-term patent applications**

13.10. A short-term patent application must be, amongst others, supported by a search report in relation to the invention (being the subject of the patent application) issued by an international searching authority under the Patent Cooperation Treaty or one of three designated patent offices (section 113(1A)(d)&(8)(a) of the Ordinance; section 71 of the Rules).

13.11. A short-term patent application should be filed in **Patents form P6** with the Registrar.

13.12. A short-term patent application is mainly subject to formality examination. If the application has been accorded a date of filing and has also been found by the Registrar to have satisfied all formal requirements, unless the Registrar considers that the publication or working of the invention being the subject of the patent application is contrary to public order (“ordre public”) or morality, the Registrar will—

- (a) grant a short-term patent for the invention, issue a certificate of grant and advertise the fact of grant by notice in the official journal; and
- (b) publish the patent specification and the names of the proprietor(s) and inventor(s) (if different from the proprietor(s)).

(sections 9A(5), 118 and 124 of the Ordinance)

### **Guidance to completing patent application forms**

13.13. Each type of patent application should be filed with the Registrar in an appropriate official form.

#### Standard patent (O) application

- (a) Patents form OP1: a request for grant of a standard patent (O)

#### Standard patent (R) application

- (b) (Stage 1) Patents form P4: a request to record the designated patent application in the register (stage 1 of a standard patent (R) application)
- (c) (Stage 2) Patents form P5: a request for registration of a designated patent and grant of a standard patent (R) (stage 2 of a standard patent (R) application)

#### Short-term patent application

- (d) Patents form P6: a request for grant of a short-term patent

13.14. The following sub-sections explain how to complete the different parts of an application form. Some parts need to be completed in support of all types of patent applications whereas others only need to be completed in certain types of applications.

**Table: Guidance to completing the different parts of the patent application forms**

<b>Type of application</b>	Standard patent (O) applications	Requests to record	Requests for registration and grant	Short-term patent applications
<b>Part of the form</b>				
<i>Reference number</i>	Section 13.15	Section 13.15	Section 13.15	Section 13.15
<i>Details of applicant(s)</i>	Sections 13.16 – 13.22	Sections 13.16 – 13.22	Sections 13.16 – 13.22	Sections 13.16 – 13.22
<i>Statement of entitlement to apply</i>	--	Sections 13.23 – 13.26	Sections 13.23 – 13.26	--
<i>Title of invention</i>	Sections 13.27 and 13.28	Sections 13.27 and 13.29	Sections 13.27 and 13.29	Sections 13.27 and 13.28
<i>Details of designated patent application</i>	--	Sections 13.30 – 13.33	--	--
<i>Details of the corresponding request to record published</i>	--	--	Section 13.34	--
<i>Details of the designated patent</i>	--	--	Section 13.35	--
<i>Verification of the published specification of the designated patent</i>	--	--	Sections 13.36 – 13.37	--
<i>Number of independent claims</i>	--	--	--	Section 13.38
<i>Use of micro-organisms</i>	Sections 13.39 – 13.45	--	--	Sections 13.39 – 13.45
<i>Details of the international application</i>	--	Sections 13.46 – 13.47	--	Sections 13.48 – 13.50
<i>Statement of reference to an earlier specified application</i>	Sections 13.51 – 13.52	--	--	Sections 13.51 – 13.52

<b>Type of application</b>	Standard patent (O) applications	Requests to record	Requests for registration and grant	Short-term patent applications
<b>Part of the form</b>				
<i>Details of earlier application</i>	Sections 13.53 – 13.54	Sections 13.53 – 13.54	--	Sections 13.53 – 13.54
<i>Statement of priority</i>	Sections 13.55 – 13.59	Sections 13.60 – 13.62	--	Sections 13.55 – 13.59
<i>The inventor(s)</i>	Sections 13.63 – 13.69	Sections 13.63, 13.64 and 13.69	--	Sections 13.63 – 13.69
<i>Non-prejudicial disclosure</i>	Sections 13.70, 13.72, 13.74 and 13.75	Sections 13.70, 13.71 and 13.73	--	Sections 13.70, 13.72, 13.74 and 13.75
<i>Request for early publication</i>	Sections 13.76 – 13.77	--	--	--
<i>Request for deferral of grant</i>	--	--	--	Sections 13.78 – 13.79
<i>List of documents</i>	Section 13.80	Section 13.80	Section 13.80	Section 13.80
<i>Address for service</i>	Sections 13.81 – 13.83	Sections 13.81 – 13.83	Sections 13.81 – 13.83	Sections 13.81 – 13.83
<i>Agent's details</i>	Section 13.84	Section 13.84	Section 13.84	Section 13.84
<i>Signature</i>	Sections 13.85 – 13.88	Sections 13.85 – 13.88	--	Sections 13.85 – 13.88

### **Reference number**

#### **For all patent applications**

13.15. While provision of reference number is optional, applicants are encouraged to provide such number which will assist the applicant in identifying the patent application to which the subsequent correspondences between the Registrar and the applicant relates.

### **Details of applicant(s)**

#### **For all patent applications**

13.16. Any person (whether an individual or a corporate) may make a patent application either alone or jointly with others. The right to apply for the grant of a patent may belong to the inventor(s) or any other person by operation of law or any other enforceable agreement entered into with the inventor(s).

## Full name and address of applicant

13.17. The full name and address of the applicant should be furnished in the space provided. If the name of the applicant is not in the Roman alphabet or in Chinese characters, a transliteration of the same in the Roman alphabet should be provided (section 56(2)(c) of the Rules).

## Applicant type

13.18. If the applicant is a natural person, or natural persons making an application in joint names, the box “Individual” should be marked.

13.19. If the applicant is a sole proprietorship, an application is usually filed in the name of the sole proprietor trading in the name of the firm (e.g. Chan Tai Man trading as Mr. Chan). The box “Individual” should be marked.

13.20. If the applicant is a partnership, it is common for an application to list the names of the partners followed by the name of the firm (e.g. Chan Siu-ling and Lam Mei-mei trading as Chan & Lam). In this case, the box “Individual” should be marked.

13.21. If the applicant is a corporation (i.e. a company incorporated in the Hong Kong SAR, or any other body corporate incorporated/established in or outside the Hong Kong SAR), the box “Incorporated” should be marked. The applicant may indicate the country / territory / area of incorporation as well as the state of incorporation (if the applicant is incorporated in the US).

13.22. If the applicant is an unincorporated entity which nevertheless has legal capacity to hold property under the law of the place where it is established, the box “Unincorporated” should be marked.

## ***Statement of entitlement to apply***

**For requests to record**

**For requests for registration & grant**

13.23. For a standard patent (R) application, the applicant should, by default, be:

(a) in the case of a request to record, the person named as the applicant in the designated patent application (sections 12(1)(a) and 15(1) of the Ordinance); or

(b) in the case of a request for registration and grant, the person named in the register as the applicant for a standard patent (R) (section 23(1)&(3)(b) of the Ordinance).

13.24. If that is not the case, the applicant for standard patent (R) should file a statement explaining his entitlement to apply for the grant of a standard patent (R) together with the supporting documents.

(a) In the case of a request to record, the supporting documents are—

- (i) where the statement indicates that the applicant for standard patent (R) is the successor in title to the applicant of the designated patent application—
  - (1) copies of such documents establishing the transfer, assignment or mortgage of the rights under the designated patent application in the Hong Kong SAR from the applicant of the designated patent application to the applicant for standard patent (R), such as a copy of the duly executed transfer, assignment or mortgage agreement or the updated official register of the designated patent office or an official communication from the designated patent office confirming the transfer, assignment or mortgage; or
  - (2) *(in the absence of any of the aforesaid supporting document)* a statement signed by the transferor, assignor or mortgagor confirming the fact of the transfer or assignment or mortgage of the rights under the designated patent application;
- (ii) where the statement indicates that the applicant for standard patent (R), not being a successor in title to the designated patent applicant, is the inventor of the invention who is entitled to the property in the invention in the Hong Kong SAR, such documents establishing that entitlement;
- (iii) where the statement indicates that the applicant for standard patent (R) is the successor in title to the person specified in section 13.24(a)(ii) of these Guidelines, the documents specified in that paragraph and, in addition—
  - (1) such documents establishing the transfer or assignment or mortgage (whether by a single such transaction or by a number of such transactions) of the property in the invention in the Hong Kong SAR from the inventor of the invention to the applicant; or
  - (2) *(in the absence of any of the aforesaid document)* a statement signed by the transferor, assignor or mortgagor confirming the fact of the transfer, assignment or mortgage of the property in the invention in the Hong Kong SAR.

(section 15(2)(d) of the Ordinance; section 9 of the Rules)

- (b) In the case of a request for registration and grant, the supporting documents are such documents establishing the entitlement to apply for the grant of a standard patent (R), such as a copy of the duly executed transfer, assignment or mortgage agreement.

(section 23(3)(b) of the Ordinance; section 20 of the Rules)

13.25. If a person acquires the rights to an application for standard patent (R) after the filing of a request to record, the transfer of such right should be registered in the Hong

Kong SAR by filing in ***Patents form P19*** with the Registrar. The date on which such transfer is treated as complete depends on the applicable law and practice of the relevant jurisdiction in which the transfer takes place.

13.26. If any document supporting the statement of the entitlement to apply for a standard patent (R) is not in one of the official languages, they must contain a translation into the language of proceedings (section 56(3) of the Rules).

### ***Title of invention***

#### **For all patent applications**

13.27. A title of the invention (being the subject of a patent application) in both official languages must be included in the application (sections 8(2)(c)(ii) (for requests to record), 19(2)(c)(ii) (for requests for registration and grant), 31M(2)(a) (for standard patent (O) applications) and 58(2) (for short-term patent applications) of the Rules). Otherwise, a translation into one or both of the official languages must be provided (section 56(2)(a) & (b) of the Rules).

13.28. For a standard patent (O) or short-term patent application, the title of the invention must—

(a) be short;

(b) indicate the matter to which the invention relates; and

(c) be stated in the specification.

(sections 31M(2)(a)&(3) (for standard patent (O) applications) and 58(2)&(3) (for short-term patent applications) of the Rules)

13.29. For a standard patent (R) application, the title of the invention should be the same as that used in the designated patent application or designated patent.

### ***Details of designated patent application***

#### **For requests to record**

13.30. The following particulars of the designated patent application should be furnished in the space provided —

(a) date of filing;

(b) application number;

(c) publication number (if any); and

(d) publication date (if any).

(section 8(2)(c) of the Rules)

13.31. The applicant should also check the box indicating which designated patent office with which the designated patent application is filed.

13.32. A photocopy of the designated patent application as published by the designated patent office needs to be filed with the Registrar together with the application form (section 15(2)(a) of the Ordinance).

13.33. A translation into the language of the proceedings or into one of the official languages of the designated patent application as published by the designated patent office is not required (section 56(4) of the Rules).

#### ***Details of the corresponding request to record published***

##### **For requests for registration & grant**

13.34. The following particulars of the request to record as published should be furnished in the space provided:

(a) application number;

(b) publication number; and

(c) date of publication.

(section 24(1)(d) of the Ordinance; section 19(2)(c)(i) of the Rules)

#### ***Details of the designated patent***

##### **For requests for registration & grant**

13.35. The following particulars of the designated patent as granted should be furnished in the space provided:

(a) publication number;

(b) date of grant; and

(c) date of publication.

(section 24(1)(c) of the Ordinance; section 19(2)(c)(iii) of the Rules)

#### ***Verification of the published specification of the designated patent***

##### **For requests for registration & grant**

13.36. A verified copy of the published specification of the designated patent should be filed together with the application form (section 23(3)(a) of the Ordinance). The applicant needs to mark the relevant box in the form to confirm that the filed copy of the published specification of the designated patent is a true copy issued by or kept at the relevant designated patent office (section 102 of the Rules).

13.37. A translation into the language of the proceedings or into one of the official languages of the published specification of the designated patent is not required. (section 56(5) of the Rules).

### ***Number of independent claims***

#### For short-term patent applications

13.38. The applicant must declare the actual number of independent claim(s) in a short-term patent application which must not exceed two (section 113(1A)(b)(ii) of the Ordinance).

### ***Use of micro-organisms***

#### For standard patent (O) applications

#### For short-term patent applications

13.39. The applicant must fill in this part if the invention requires the use of a micro-organism for the performance of the invention. If this part is left blank, the Registrar will assume that no micro-organism is required to be used for the performance of the invention.

13.40. Neither the local patent legislation nor the Budapest treaty (i.e. the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest in 1977) provides a definition for the term “micro-organism”. For the purposes of section 149(2A) of the Ordinance and sections 31ZW and 73 as well as Schedule 1 of the Rules, our examiners may regard biological materials that have been successfully accepted for deposit with any depositary institution (as defined in para. 4(2) of Schedule 1 to the Rules and discussed in sections 13.43 – 13.45 of these Guidelines below) as “micro-organisms”.

13.41. To fill in this part, the applicant should indicate (by marking the “yes” or “no” box) whether:

(a) the micro-organism is available to the public at the date of filing of the patent application (such as the case where it is known to be readily available to those skilled in the art, e.g. a micro-organism such as baker’s yeast or *Bacillus natto* which is commercially available, or it may be a standard preserved strain, or it is known to have been preserved in a culture collection available to the public); **and**

(b) the invention can be described in the application or specification of the patent in such a manner as to enable the invention to be performed by a person skilled in the art (see the meaning of “enablement” in sections 1.18 to 1.20 of these Guidelines) (this condition is fulfilled if sufficient information is given in the description as to the identifying characteristics of the micro-organism and also its prior availability in a culture collection).

(see para. 1(1) of Schedule 1 to the Rules)

13.42. Where neither of the conditions mentioned in section 13.41 of these Guidelines is fulfilled, the applicant has to resort to the alternative, namely by—

- (a) depositing not later than the date of filing of the application, a culture of the micro-organism in a depositary institution which is able to furnish a sample of the micro-organism (paras. 1(2)(a) of Schedule 1 to the Rules); and
- (b) providing the following information in the furnished space in the application form as required under paras. 1(2)(b) and (c) of Schedule 1 to the Rules:
  - (i) name of the depositary institution;
  - (ii) date when the culture was deposited; and
  - (iii) accession number of the deposit.

13.43. A “depositary institution” means an institution which—

- (a) is an international depositary authority; or
- (b) is an institution that at all relevant times—
  - (i) performs the functions of receiving, accepting and storing micro-organism and furnishing samples of micro-organism; and
  - (ii) conducts its affairs in so far as they relate to those functions in an objective and impartial manner.

(para. 4(2) of Schedule 1 to the Rules)

13.44. The deposit of micro-organism may be made in any depositary institution in the world. The depositary institution needs not have the “International Depositary Authority” (IDA) status. It is the applicant’s responsibility to satisfy himself that a particular micro-organism will be accepted by a culture collection which he has selected and that samples will be made available in accordance with Schedule 1 to the Rules.

13.45. The information mentioned in section 13.42(b) of these Guidelines must be submitted to the Registrar:

- (a) for a standard patent (O) application –
  - (i) within 16 months after the claimed priority date or the date of filing of the application (where no priority has been claimed); or
  - (ii) where the applicant requests early publication of the application, before the date of request; or
  - (iii) within 1 month after the Registrar has communicated to the applicant regarding a right for information and inspection of documents,whichever is the earliest;

(b) for a short-term patent application –

- (i) together with the request for grant; or
  - (ii) within 1 month after the Registrar has communicated to the applicant regarding a right for information and inspection of documents,
- whichever is earlier.

(section 147(4)&(5) of the Ordinance; paras. 1(3) and (4) of Schedule 1 to the Rules)

### ***Details of the international application***

#### **For requests to record**

13.46. This part must be completed where the designated patent application is the national phase of an international application under the PCT:

(a) The following particulars of the international application should be furnished in the space provided:

- (i) application number;
- (ii) filing date;
- (iii) publication number;
- (iv) date of publication by the International Bureau; and
- (v) one of the dates referred to in section 13.47 of these Guidelines; and

(b) A copy of the following documents should be attached together with the application form:

- (i) the international application as published by the International Bureau;
- (ii) the translation of the international application published by the designated patent office (if any); and
- (iii) the publication of information in the designated patent office concerning the international application (if any).

(section 16 of the Ordinance; sections 8(2)(d) and 15 of the Rules)

13.47. Where the designated patent application is the national phase of an international application under the PCT, the publication date of the designated patent application must be construed as –

(a) *(for an international application designating the EPO)* the date of publication by the EPO in its Bulletin of the relevant bibliographical data showing that the international application has entered the national phase in the EPO;

(b) (for an international application designating the UKIPO) the date of publication by the UKIPO in its Official Journal (Patents) of the relevant bibliographical data showing that the international application has entered the national phase in the UKIPO;

(c) (for an international application designating the CNIPA) the date of publication/issuance of any of the following official documents showing/stating that the international application has entered the national phase in the CNIPA—

- (i) publication by the CNIPA in its Patent Gazette of the relevant bibliographical data; or
- (ii) official notification by the CNIPA (where the international application has been published by the International Bureau in the Chinese language).

(section 16 of the Ordinance; section 15 of the Rules)

### ***Details of the international application***

#### **☑ For short-term patent applications**

13.48. Where an international application under PCT has entered the national phase in the PRC, its applicant may, on the basis of the international application, file a short-term patent application at any time before a date—

(a) 6 months after the entry of the international application into the national phase in the CNIPA (section 125(2) of the Ordinance); or

(b) within 6 months after the date of the issuance of an official notification by the CNIPA stating that the international application has entered the national phase in the CNIPA (section 78(1) of the Rules).

13.49. If a short-term patent application is filed on the basis of an international application under the PCT that has entered its national phase in the PRC,

(a) the following particulars of the international application must be furnished in the space provided:

- (i) application number;
- (ii) filing date;
- (iii) publication number;
- (iv) publication date;
- (v) either of the following dates –

(1) date of entry into the national phase in the PRC (section 125(3)(c) of the Ordinance); or

- (2) date of issuance of an official notification by the CNIPA stating that the international application has entered the national phase; and
  - (vi) the PRC patent application number (if known); and
- (b) a copy of the following documents should be attached together with the application form (section 125(3) of the Ordinance; section 78(2) of the Rules):
- (i) the international application as published by the International Bureau;
  - (ii) the international search report as published under Article 21(3) of the Patent Cooperation Treaty;
  - (iii) the translation of the international application as published by the CNIPA (if any);
  - (iv) an official notification issued by the CNIPA stating that the international application has entered the national phase in the CNIPA (where applicable); and
  - (v) any information as published by the CNIPA concerning the international application.

13.50. Where a short-term patent application filed on the basis of an international application results in the grant of a short-term patent, the short-term patent application shall be deemed to have as its date of filing the international filing date accorded to the international application (section 125(5) of the Ordinance).

***Statement of reference to an earlier specified application***

For standard patent (O) applications

For short-term patent applications

13.51. This part needs to be completed only if the applicant, instead of filing a fresh description of the claimed invention, makes a reference to an earlier specified application under sections 37M(3)(c)(ii) (for standard patent (O) applications) and 114(3)(c)(ii) (for short-term patent applications) of the Ordinance. For this purpose, a specified application is—

- (a) an application for a patent or other protection in or for a Paris Convention country or WTO member country, territory or area;
- (b) a standard patent (O) application; or
- (c) a short-term patent application.

(sections 37M(6) (for standard patent (O) applications) and 114(7) (for short-term patent applications) of the Ordinance)

13.52. An applicant making reference to an earlier specified application must—

(a) mark the box in the form declaring that the description and drawings (if any) are completely contained in the earlier specified application;

(b) furnish the following information in the space provided:

(i) the country / territory / area in or for which the earlier specified application is filed;

(ii) the earlier specified application number; and

(iii) the date of filing of the earlier specified application

(sections 31W(2) (for standard patent (O) applications) and 67A(2) (for short-term patent applications) of the Rules);

(c) (where the earlier specified application is not a standard patent (O) or short-term patent application) submit a copy of the earlier specified application<sup>1</sup> and also a copy of the certificate issued by the authority that received such application within 4 months after the date on which the minimum requirement of the subject patent application is complied with (sections 31W(3) & (4) (for standard patent (O) applications) and 67A(3) & (4) (for short-term patent applications) of the Rules).

### ***Details of earlier application***

For requests to record

For standard patent (O) applications

For short-term patent applications

13.53. This part needs to be completed only for filing a patent application which is—

(a) a divisional patent application claiming the date of filing of an earlier application (section 22 of the Ordinance and sections 8(2)(e) and 18 of the Rules (for requests to record); section 37Z of the Ordinance and section 31ZS of the Rules (for standard patent (O) applications); section 116 of the Ordinance and section 74 of the Rules (for short-term patent applications)); or

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<sup>1</sup> Where an earlier specified application is not in one of the official languages as adopted in the subject patent application (i.e. English or Chinese), the applicant must submit the following documents within 4 months after the date of compliance with the minimum requirement of the subject patent application: (a) a translation of the earlier specified application in the language of the proceedings; or (b) (if a specification that is a translation of the specification of the earlier specified application has been filed) a statement made by the translator verifying to the satisfaction of the Registrar that the translation is complete and accurate (sections 31M(4)(d), 31W(5), 56A and 56B(3) of the Rules (for standard patent (O) applications); sections 56A, 56B(3), 58(5)(j) and 67A(5) of the Rules (for short-term patent applications)).

(b) a new patent application, claiming the date of filing of an earlier application, ordered to be filed by the court or Registrar to replace the earlier application or patent for which the applicant or proprietor is not entitled to apply or be granted (sections 37J(2) and 55(4) of the Ordinance; section 8(2)(e) of the Rules).

13.54. The application number and date of filing of the earlier application must be furnished in the space provided. For filing a request to record, the publication date of the earlier request to record should also be provided.

### ***Statement of priority***

**For standard patent (O) applications**

**For short-term patent applications**

13.55. The applicant must fill in this part so as to make a priority claim for a standard patent (O) or short-term patent application based on an application for the same invention previously filed by the applicant or the applicant's predecessor in or for a Paris Convention country or a World Trade Organization ("WTO") member country / territory / area, provided that the application claiming the priority is filed within 12 months after the date of filing of the previously filed application ("priority application") (sections 37C(2) (for standard patent (O) applications) and 110(1A) (for short-term patent applications) of the Ordinance). A list of the Paris Convention countries and WTO member countries, territories and areas is set out in Schedule 1 to the Ordinance.

13.56. To support a priority claim, the following information needs to be furnished in the space provided:

(a) the country / territory / area in or for which the priority application is filed;

(b) the priority application number; and

(c) the date of filing of the priority application.

(section 37E(1) of the Ordinance and section 31C(6) of the Rules (for standard patent (O) applications); section 111(1) of the Ordinance and section 69(6) of the Rules (for short-term patent applications))

13.57. If the priority application is not a Hong Kong SAR patent application, the applicant should submit the required documents in support of the priority claim (section 37E(1) of the Ordinance and section 31C(7)&(8) of the Rules (for standard patent (O) applications); section 111(1) of the Ordinance and section 69(7)&(8) of the Rules (for short-term patent applications); see sections 14.14(f) and 14.15(f) of these Guidelines regarding the details). Where such supporting documents are not in one of the official languages as adopted in the subject patent application, the applicant may also submit a translation of the documents (see section 1.60 of these Guidelines for details).

13.58.If the applicant wishes to make a priority claim for a patent application based on a priority application that is previously filed within 12 months of the date of filing of the patent application, but fails to fill in this part at the time of filing of the patent application, the applicant may subsequently make such priority claim provided that—

(a) a separate statement of priority in Patents form OP5 is submitted within 16 months after the date of filing of the priority application; and

(b) either of the following:

(i) *(for a standard patent (O) application)* no request for early publication of the patent application has been made or such request, if made, has been withdrawn (section 37E(1) of the Ordinance and section 31C(4)&(5) of the Rules), or

(ii) *(for a short-term patent application)* the preparations for publication of the specification of the short-term patent have not been completed (section 111(1) of the Ordinance and section 69(4)&(5) of the Rules).

13.59.The detailed requirements for claiming priority are set out in sections 1.54 to 1.60 of these Guidelines.

### ***Statement of priority***

#### **For requests to record**

13.60.The applicant must fill in this part to make a priority claim for a standard patent (R) application based on a right of priority enjoyed under the law of the designated patent office for a period of 12 months after the date of filing of the earlier application (see section 11B(1) of the Ordinance).

13.61.The priority right that can be claimed for a standard patent (R) application is equivalent to the one that has been claimed for the designated patent application (section 11B(3) of the Ordinance). If an applicant for standard patent (R) did not make a priority claim for the designated patent application, the applicant cannot subsequently claim such right for the standard patent (R) application (section 11B(1) of the Ordinance).

13.62.When filing a request to record, insofar as the procedural requirements in respect of claims to priority are concerned, the applicant should note that:

(a) it is not necessary to file a request to record within 12 months after the date of filing of the earlier application as referred to in section 13.60 of these Guidelines as long as the request to record is filed within the prescribed 6-month period under section 15(1) of the Ordinance; and

(b) there are no prescribed supporting priority documents to be filed.

## ***The inventor(s)***

- For requests to record
- For standard patent (O) applications
- For short-term patent applications

13.63. If the applicant is not an inventor, the inventor's name must be provided (section 15(2)(b) of the Ordinance (for requests to record); section 37L(3)(b)(i) of the Ordinance and section 31M(4)(a) of the Rules (for standard patent (O) applications); section 113(2)(b)(i) of the Ordinance and section 58(5)(g) of the Rules (for short-term patent applications)).

13.64. For filing a request to record, the name(s) of the person(s) whom the applicant believes to be the inventor(s) should be provided in the furnished space in the form even if the designated patent application does not contain the name(s) of the inventor(s) (where the inventor(s) waive(s) the right to be mentioned in the designated patent application published by the EPO).

13.65. If the applicant is not the sole inventor (or the applicants are not the joint inventors), a separate statement of inventorship in Patents form OP1A (for standard patent (O) applications) or P6A (for short-term patent applications) must be submitted. Such statement is however not required for standard patent (R) applications. The applicant is required to provide, amongst others, the inventor's last known address (section 37L(3)(b)(ii) of the Ordinance and section 31M(4)(a) of the Rules (for standard patent (O) applications); section 113(2)(b)(ii) of the Ordinance and section 58(5)(g) of the Rules (for short-term patent applications)) and a statement indicating how he/she becomes entitled to apply for a patent (see sections 37L(3)(c) (for standard patent (O) applications) and 113(2)(c) (for short-term patent applications) of the Ordinance).

13.66. The applicant must provide a statement containing sufficient information pertinent to the applicant's entitlement to file the patent application, though it is not necessary to give details of the entitlement or substantiate the statement.

*For example—*

- *the applicant may indicate that he is the employer of an inventor or the personal representative of a deceased inventor, or has rights by virtue of an assignment from an inventor (or simply "by assignment").*
- *However, vague statements/expressions (such as "the applicant acquires his rights 'by operation of law'" or simply "by operation of law") and an incomplete chain of title (such as "by assignment from A to B", the applicant being C) are not sufficient.*

13.67.If any documents supporting the statement of inventorship are not in one of the official languages as adopted in the application, they must contain a translation into the language of the proceedings (section 56(3) of the Rules).

13.68.The Registrar must notify the inventor(s) (whom is/are not the patent applicant(s)) that a patent application has been filed, and send a copy of the aforesaid statement of inventorship to the inventor(s) (see section 37L(3)(c) of the Ordinance and section 31T of the Rules (for standard patent (O) applications); section 113(2)(c) of the Ordinance and section 65(b) of the Rules (for short-term patent applications)).

13.69.If the name(s) of the inventor(s) is or are not in the Roman alphabet or in Chinese characters, the applicant must provide a transliteration of the same in the Roman alphabet (section 56(2)(c) of the Rules).

### ***Non-prejudicial disclosure***

For requests to record

For standard patent (O) applications

For short-term patent applications

13.70.An invention is generally not considered as new if it has already been disclosed before an application for the invention is filed. However, such pre-filing disclosure does not destroy novelty of the invention if such disclosure was due to or in consequence of an evident abuse or the fact that the invention had been displayed in a recognized international exhibition or meeting. For details, please refer to sections 1.46 to 1.50 of these Guidelines.

13.71.For a request to record, non-prejudicial disclosure can only be claimed if a non-prejudicial claim has already been made for the designated patent application under the law of the designated patent office (section 11A(3)(a) of the Ordinance).

### ***Non-prejudicial disclosure claims based on evident abuse***

13.72.For a standard patent (O) or short-term patent application, if the non-prejudicial claim relates to an evident abuse, a statement stating that there has been an evidence abuse and written supporting evidence in the form of statutory declaration or affidavit may be provided, if available, at the time of filing of the patent application or, more commonly, during substantive examination (see section 37B(2) of the Ordinance and section 31ZR of the Rules (for standard patent (O) applications); section 109(a) of the Ordinance and section 74A of the Rules (for short-term patent applications)). Applicants should also note that a statutory declaration or affidavit is not acceptable for electronic filing or communications (see *Annex B of the "Terms of Use"* at [https://www.ipd.gov.hk/eng/nis/efl\\_tou\\_e.pdf](https://www.ipd.gov.hk/eng/nis/efl_tou_e.pdf)).

13.73.A standard patent (R) applicant does not need to provide a statement or evidence for an evident abuse in Patents form P4 (request to record).

Non-prejudicial disclosure claims based on disclosure at recognized international exhibitions/meetings

13.74. If the non-prejudicial claim relates to a disclosure at a recognized international exhibition or meeting, the following information must be furnished at the time of filing the application:

- (a) name of the exhibition / meeting;
- (b) place of the exhibition / meeting; and
- (c) opening date of the exhibition / meeting or date of first disclosure of the invention if the first disclosure did not take place on the opening date.

(section 15(2)(f) of the Ordinance and section 10 of the Rules (for requests to record); section 37B(3)(a) of the Ordinance (for standard patent (O) applications); section 109(b) of the Ordinance (for short-term patent applications))

13.75. For a standard patent (O) or short-term patent application, the applicant must submit the following written evidence in support of the non-prejudicial disclosure claim at the time of filing the patent application:

- (a) a certificate issued by the authority responsible for holding the exhibition stating
  - (i) that the invention was in fact displayed at the exhibition; and
  - (ii) the date of the first disclosure of the invention at the exhibition; and
- (b) an identification of the invention duly authenticated by the authority.

(section 37B(3)(b) of the Ordinance and section 31A of the Rules (for standard patent (O) applications); section 109(b) of the Ordinance and section 70 of the Rules (for short-term patent applications))

***Request for early publication***

**For standard patent (O) applications**

13.76. This box must be marked if the applicant for standard patent (O) wishes to have the application published earlier, i.e. within a shorter timeframe than the usual 18-month period (section 37Q of the Ordinance and section 31Z of the Rules; see also section 13.5(a) of these Guidelines).

13.77. By opting for an early publication, the applicant may not be able to make a belated priority claim (i.e. one may not have the option to file the statement of priority within 16 months after the earliest date of priority claimed) (see section 37E(1) of the Ordinance and section 31C(4) & (5) of the Rules; section 13.58 of these Guidelines) or submit the information relating to the use of micro-organisms as mentioned in section 13.42(b) of these Guidelines after the date of request for early publication

(see section 147(4)&(5) of the Ordinance; paras. 1(3) and (4) of Schedule 1 to the Rules; section 13.45 of these Guidelines).

### ***Request for deferral of grant***

#### **For short-term patent applications**

13.78. This part must be completed if the applicant for short-term patent wishes to have the grant of his patent deferred for a certain period. The applicant should fill in the date on which the intended deferral period will expire. The deferral period must however not exceed 12 months after the date of filing of the application (section 119(1) of the Ordinance).

13.79. According to section 119 of the Ordinance, where an applicant for short-term patent has requested the Registrar to defer the grant of a patent for a period specified in the application, a short-term patent must not be granted in that application until-

(a) the expiry of that period, or of such shorter period as the applicant may subsequently specify by notice filed with the Registrar, after the date on which the formal requirements are found to have been satisfied; or

(b) 12 months after the date of filing of the application,

whichever occurs first; and the patent must be granted as soon as possible after the expiry of such period.

### ***List of documents***

#### **For all applications**

13.80. Applicants are required to enter the number of sheets of attached document(s), if any, in the appropriate boxes.

### ***Address for service***

#### **For all applications**

13.81. This part must be completed (sections 15(2)(g) (for requests to record), 37L(3)(d) (for standard patent (O) applications) and 113(2)(d) (for short-term patent applications) of the Ordinance) and the address for service provided should be a residential or business address in Hong Kong (section 42(2) of the Rules). P.O. box or "care of" addresses are not acceptable.

13.82. The address for service is the address to which the applicant wishes to have the Registrar's correspondences or documents sent. He may choose to fill in his own address or his agent's address.

13.83. Likewise, the applicant may choose to fill in his own name, telephone number and fax number in this part or those of his agent. The provision of such contact information is optional but the applicant is encouraged to provide such information as an alternative means of communication between the Registrar and the applicant in case postal delivery turns out to be ineffective.

### ***Agent's details***

#### For all applications

13.84. This part must be completed if the form is filed by an agent of the applicant. The details of this part would be identical to those provided for the part on "address for service" if the applicant's agent is also acting as the address for service.

### ***Signature***

#### For requests to record

#### For standard patent (O) applications

#### For short-term patent applications

13.85. Each patent application form must be signed by the applicant or his agent (see sections 15(2) (for requests to record), 37L(1)(a) (for standard patent (O) applications), 113(1)(a) (for short-term patent applications) and 140(1) of the Ordinance).

13.86. If there is more than one applicant, each applicant or his agent must sign the form.

13.87. If the form is filed electronically, the signature requirement will be met by a digital signature generated by a valid e-certificate.

13.88. Where the party concerned is a firm, a body corporate (e.g. a company) or an unincorporated body or association of persons, a document (such as a form) may in general be signed by any person who purports to sign on its behalf and satisfies the Registrar that he is authorized to do so, such as a director, the secretary, a partner or a principal officer of the applicant(s) or an authorized agent of any such person (section 140 of the Ordinance; sections 84 and 85 of the Rules). The name and official capacity of the signatory should be provided accordingly.

## **Filing**

### **For all applications**

13.89. All patent applications must be filed with the Registrar in the prescribed manner (sections 15(2) (for requests to record), 23(3) (for requests for registration and grant), 37L(1)(b) (for standard patent (O) applications) and 113(1)(b) (for short-term patent applications) of the Ordinance).

13.90. Applicants may file their applications –

(a) by hand;

(b) by post;

(c) by sending an electronic record of such applications to the designated information system by electronic means, i.e. via the e-filing system; or

(d) by fax (for standard patent (R) applications (i.e. Patents forms P4 and P5) only).

(see sections 93 to 93C of the Rules)

## **Translation of documents**

13.91. Except as expressly provided in the Rules, where any document or part of a document which is not in one of the official languages is filed with the Registrar or sent to the registry in pursuance of the Ordinance or the Rules, it must contain a translation into the language of the proceedings, and such translation must state the name of the translator and his official capacity, if any (section 56(1) of the Rules).

13.92. The applicant may be required to provide a verification of a translation. Such verification may be made in the following form and should be duly signed by the translator and dated:

*"I [name of translator] of [address of translator] being fully conversant in both [English / Chinese] and [the other language], am qualified to translate [description of the attached document] from [the other language] into [English / Chinese] and I certify that [description of the translated copy] is a complete and accurate [English / Chinese] translation of the [description of the attached document]."*

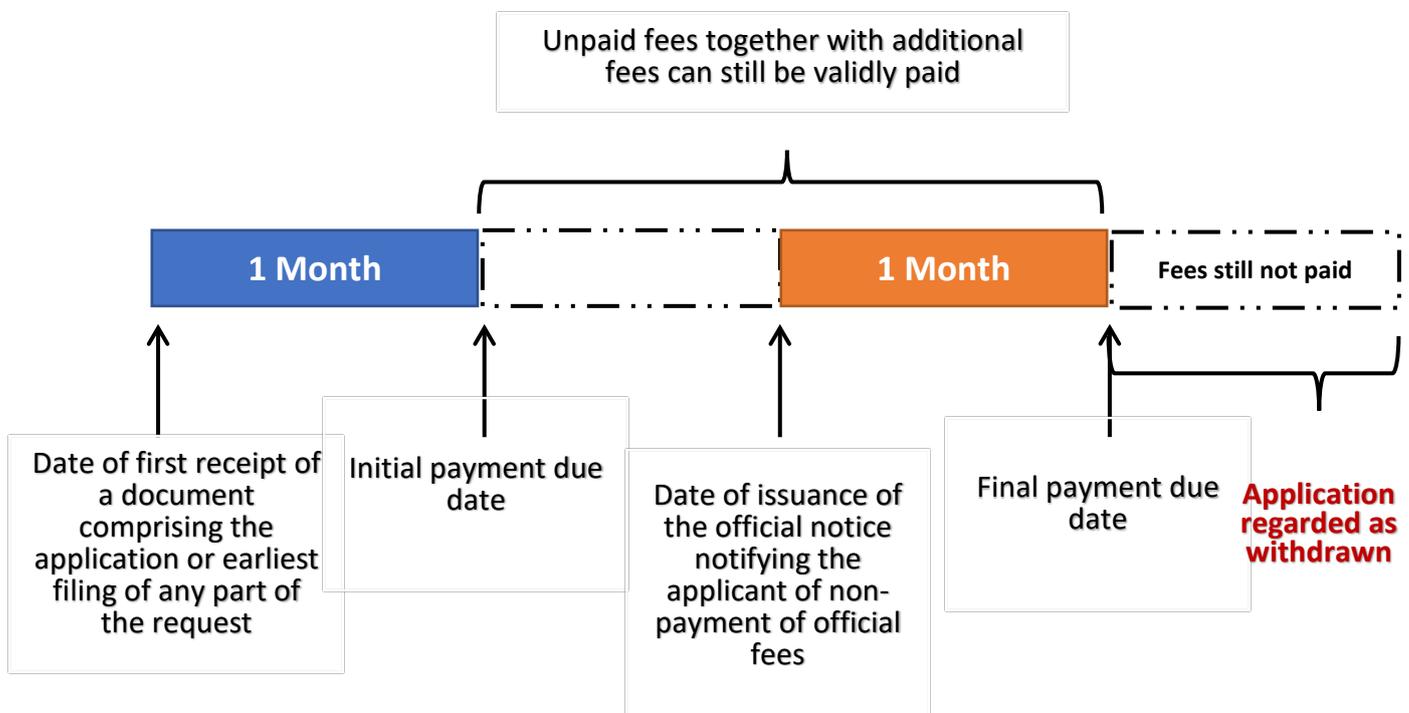
## **Payment of fees**

13.93. The applicant is required to pay the official filing and advertisement fees:

(a) (for requests to record) within one month after the earliest filing of any part of the request to record (section 15(4) of the Ordinance);

- (b) *(for requests for registration and grant)* within one month after the earliest filing of a part of the request for registration and grant (section 23(5) of the Ordinance);
- (c) *(for standard patent (O) applications)* no later than one month after the date of first receipt of any of the documents comprising the application (section 37L(5) of the Ordinance; sections 31M(5)(a) and 31U(c)(iii) of the Rules); or
- (d) *(for short-term patent applications)* within one month after the earliest filing of any part of the application (section 113(5) of the Ordinance).

13.94. If the applicant does not pay any of these official fees within the said 1-month period, the Registrar will send the applicant a notice pointing out the applicant's failure to observe the time limit. If the applicant still does not pay the outstanding official fee together with the additional fee for late payment within a grace period which begins on the expiry of the initial one-month period and ends at the expiry of one month after the date of such notice, the application must be deemed withdrawn (section 15(4)&(5) of the Ordinance and section 11 of the Rules (for requests to record); section 23(5)&(6) of the Ordinance and section 21 of the Rules (for requests for registration and grant); section 37L(6) of the Ordinance and section 31M(5)(b) of the Rules (for standard patent (O) applications); section 113(5) of the Ordinance and section 68A(2) of the Rules (for short-term patent applications)).



## Computation of time for filing

- 13.95. The filing of a document with the Registrar is deemed to be effected at the time as it is received at the Registry and recorded as received (section 93(3) of the Rules).
- 13.96. Where a document in electronic form is sent by electronic means to the designated information system, the filing of such document must be deemed to be effected at such time as that electronic record is accepted by the designated information system (section 93A(4) of the Rules).
- 13.97. If a document sent by post, the document is deemed to have been received when the document is actually received at the Registry (section 93(2) of the Rules).
- 13.98. A document required or authorized to be filed with the Registrar, if delivered by hand, must be delivered during the normal business hours of the Registry (sections 93(1) of the Rules). The normal business hours of the Registry are published in the Hong Kong Intellectual Property Journal (*Notice of Business Hours and Business Days of the Trade Marks Registry, Patents Registry and Designs Registry*: <https://www.ipd.gov.hk/eng/Notice/New Notice e.pdf>) and posted at <https://www.ipd.gov.hk/eng/about us/contact us.htm>.
- 13.99. Business done on any day after the business hours or on a day which is not a business day, must be deemed to have been done on the next business day; and where the time for doing anything under the Ordinance expires on a day which is not a business day, that time must be extended to the next business day (section 148(2) of the Ordinance).
- 13.100. Where on any day there is an event or circumstances causing an interruption in the normal operation of the Registry and the Registrar notifies that day as being one on which there is an interruption in the operation of the Registry, any period of time for filing anything under the Ordinance or Rules that expires on such day so notified by the Registrar must be extended to the first business day next following that is not so notified (section 100A of the Rules).
- 13.101. In the context of computing a filing due date or prescribed period, the word “month” means “calendar month” (section 3 of the Interpretation and General Clauses Ordinance (Cap. 1)).
- 13.102. In computation of time, a period of days from the happening of any event or the doing of any act or thing shall be deemed to be exclusive of the day on which the event happens or the act or thing is done (section 71(1)(a) of the Interpretation and General Clauses Ordinance (Cap. 1)). In other words, where an act is required to be done within a specified period from a specified date, the period begins immediately after that date.

13.103. Below are illustrative examples of calculating the last day for filing a document under the Ordinance or Rules:

*Example 1: Under section 3(7) of the Rules, an opponent to a reference made to the Registrar under section 13(1)(a) or (b) of the Ordinance (regarding the question of entitlement to apply for the grant of a standard patent (R)) must file a counter-statement within 3 months from the date on which the copies of the reference and relevant statement are received by such person. If such copies were received by the opponent on 3 May, the last day for filing the counter-statement would be 3 August.*

*Example 2: Under section 31W(3) of the Rules, a copy of the earlier specified application and a copy of the certificate issued by the authority that received the earlier specified application are required to be submitted within 4 months after the date on which the minimum requirement of the subsequent Hong Kong SAR patent application is complied with. If the date of compliance was 31 October, the last day for filing these documents would be 28 February (or 29 February in a leap year) of the next year.*

### **Service of documents between parties**

13.104. Section 93D(1) of the Rules provides that documents are properly sent to a person if such documents are left at or sent by post to his address for service on the register, or if there is no address for service, such documents may be sent by post to his last known address

13.105. Section 93D(2) of the Rules provides that sending by post must be deemed to be effected by properly addressing, preparing and posting a letter containing the document with the postage on it prepaid, to the address for service of the person, or if the person does not have an address for service, at his last known address.

13.106. The document sent by post is deemed to have been received at the time when the letter would be delivered in the ordinary course of the postal service. This deeming provision can be displaced by proof of the date of actual receipt or proof that the document was not received at all i.e. where the letter is returned undelivered (section 93D(2) of the Rules).