

**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 exceptions<sup>1</sup>, 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

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<sup>1</sup> 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).

15.10 There are additional procedural compliances where a request for substantive examination of a short-term patent is made by a person other than the patent proprietor.

(a) The requester must provide information and particulars in Patents form OP4 to satisfy the Registrar that—

- (i) there are reasonable grounds to suspect that the invention for which the patent has been granted is not new, lacks an inventive step, or is not susceptible of industrial application; or
- (ii) because of the requester’s legitimate business interests, it would be reasonable for the examination to be carried out.

(section 127B(2) of the Ordinance and section 81B(3)(b) of the Rules)

(b) The Registrar may, by notice, request further information and particulars from the requester in support of the request for post-grant substantive examination of a short-term patent. If the requester fails to file the necessary information and particulars within a period specified in the Registrar’s notice, the request will be regarded as not having been made (section 81C(1)-(2) of the Rules).

(c) Upon considering the supporting information and particulars filed before the Registrar, the Registrar will notify the patent proprietor and the requester of the official decision with reasons on whether to conduct substantive examination of a short-term patent (section 81C(3) of the Rules). If the Registrar agrees to carry out the substantive examination, the Registrar will inform the requester of the result of the substantive examination (see sections 15.53 to 15.54 of these Guidelines).

**Examination requirements**

15.11 A list of the examination requirements on substantive examination of a standard patent (O) application and a short-term patent (as set out in sections 37U(3) and 127C(2) of the Ordinance respectively) is summarized in the following table:

<b>Examination requirements</b>	<b>Relevant statutory provisions</b>
(1) Patentability of the underlying invention	Standard patent (O) applications: sections 9A to 9D and 37U(3)(a) of the Ordinance  Short-term patents: sections 9A to 9D and 127C(2)(a) of the Ordinance  <u>Non-prejudicial disclosure</u>

Examination requirements	Relevant statutory provisions
	<p>Standard patent (O) applications: section 37B of the Ordinance and sections 31A and 31ZR of the Rules</p> <p>Short-term patents: section 109 of the Ordinance and sections 70 and 74A of the Rules</p>
(2) Disclosure of the underlying invention is sufficiently clear and complete	<p>Standard patent (O) applications: sections 37U(3)(b) and 77 of the Ordinance</p> <p>Short-term patents: sections 77 and 127C(2)(b) of the Ordinance</p> <p><u><i>In cases involving use of micro-organisms</i></u></p> <p>Standard patent (O) applications: section 31ZW of and Schedule 1 to the Rules</p> <p>Short-term patents: section 73 of and Schedule 1 to the Rules (for short-term patents)</p> <p><u><i>In cases involving nucleotide and amino acid sequences</i></u></p> <p>Standard patent (O) applications: section 31ZX of the Rules</p> <p>Short-term patents: section 73A of the Rules</p>
(3) Claims must define the matter for which protection is sought or given; be clear and concise; be supported by description; and have unity of invention.	<p>Standard patent (O) applications: sections 37U(3)(c) and 78 of the Ordinance; sections 31S(2) – (7), 31S(9) &amp; (10) and 53A of the Rules</p> <p>Short-term patents: sections 78 and 127C(2)(d) of the Ordinance; sections 53A and 64 of the Rules</p>
(4) Disclosure in the specification does not extend beyond that disclosed in the application or the earlier application as filed	<p>Standard patent (O) applications: sections 37U(3)(d) and 103(1) of the Ordinance</p> <p>Short-term patents: sections 103(1) and 127C(2)(e) of the Ordinance</p>
(5) The application/patent is not one of 2 relevant applications/patents that are filed/granted for the same invention made by the same inventor;	<p>Standard patent (O) applications: section 37U(3)(e) of the Ordinance</p>

Examination requirements	Relevant statutory provisions
and have the same material date (double patenting)	Short-term patents: section 127C(2)(g) of the Ordinance
(6) Protection conferred by the patent has not been extended by an amendment ( <i>for short-term patents only</i> )	Sections 103(3)(b), 127B(1)(b), 127C(2)(f), 127D(3)(b), 127E(1)(a)(ii) and 127E(2) of the Ordinance
(7) Not more than two independent claims ( <i>for short-term patents only</i> )	Sections 113(1A)(b)(ii) and 127C(2)(c) of the Ordinance

15.12 The Registrar may enlist the technical assistance of CNIPA in conducting the substantive examination. In doing so, documents or information relating to a standard patent (O) application or a short-term patent under substantive examination will be communicated to CNIPA only after publication of the application or grant of the patent. In any event, the decision as to whether a standard patent (O) application or a short-term patent fulfills the examination requirements is ultimately made by the Registrar in discharge of the statutory obligations of the Registrar.

15.13 When carrying out substantive examination of a standard patent (O) application or a short-term patent, the Registrar will consider whether to allow any requested amendment thereto as initiated by the applicant or proprietor, or made by the same in response to an office action, having regard to sections 103(2) or 103(3) of the Ordinance, i.e. whether the amendment extends the subject-matter disclosed in the application as filed or extends the protection conferred by the patent (for details, please see section 16 – Amendments).

## The substantive examination procedure

### *Pre-grant substantive examination of a standard patent (O) application*

#### Examination

15.14 If the Registrar, when conducting substantive examination of a standard patent (O) application, is of the opinion that the application, together with any requested amendment thereto, does not comply with any examination requirement, the Registrar will issue to the applicant an **examination notice** setting out the relevant non-compliance (section 37V(1) of the Ordinance and section 31ZD of the Rules).

15.15 The applicant may respond to the examination notice by filing one or all of the following:

- (a) a representation to establish that the application complies with the examination requirement(s) concerned;
- (b) a request to amend the application to enable it to comply with the examination requirement(s) concerned.

(section 37V(3)(a) or (b) of the Ordinance and section 31ZE(1) of the Rules)

- 15.16 When opting to file a response to the examination notice in the aforesaid manner, the applicant must do so **within 4 months** after the date of the notice (extendable for 2 months if the time extension request is filed no later than 2 months after the initial deadline for response) (section 37V(3)(a) or (b) of the Ordinance; sections 31ZE(1) and 100AAB(2)(c)&(3)(b) of the Rules).
- 15.17 Upon considering a response to the examination notice filed by the applicant of a standard patent (O) application, and also taking the view that the applicant should elaborate, revise or clarify any matter covered in the response, the Registrar will issue a **further examination notice** to the applicant to set out such matter (section 37V(1) of the Ordinance and section 31ZF of the Rules).
- 15.18 If the applicant elects to file a response to the further examination notice, the applicant must do so **within 4 months** after the date of the notice (extendable for 2 months if the time extension request is filed no later than 2 months after the initial deadline for response) (sections 37V(3)(a) & (b) of the Ordinance; sections 31ZG(1) and 100AAB(2)(c)&(3)(b) of the Rules).
- 15.19 The Registrar may issue to the applicant another further examination notice in respect of any matter covered in the applicant's response to a previous further examination notice so as to require the applicant to provide further elaboration, revision or clarification of the matter concerned. Accordingly, one or more further examination notice(s) may be issued by the Registrar throughout the substantive examination of a standard patent (O) application (section 37V(1) of the Ordinance and section 31ZF(3) of the Rules).
- 15.20 When the Registrar is satisfied that the matter(s) as addressed in the applicant's response(s) to an examination notice and any further examination notice is/are in compliance with the relevant examination requirement(s), the Registrar, in further carrying out the substantive examination of the standard patent (O) application, may, in respect of any other unfulfilled examination requirement that has not previously been raised, issue fresh examination notices (section 37V(1) of the Ordinance and section 31ZO of the Rules).
- 15.21 A standard patent (O) application is treated as being withdrawn should its applicant fail to timely file a response to any examination notice or further examination notice (sections 31ZE(2) and 31ZG(2) of the Rules).
- 15.22 If the Registrar, having considered the applicant's responses to the examination notice(s) and/or any further examination notice, still considers that the standard

patent (O) application does not comply with the examination requirement(s) concerned, the Registrar may make a **provisional decision of refusal** to grant the standard patent (O) (section 31ZH(1) of the Rules).

## Review

- 15.23 The standard patent (O) applicant may file a **request to review** the provisional decision of refusal **within 2 months** after the date of the decision (extendable for 2 months if the time extension request is filed no later than 2 months after the initial deadline for response). The request to review may contain one or both of the following—
- (a) a written representation to establish that the application complies with the examination requirement(s) concerned;
  - (b) a request to amend the application to enable it to comply with the examination requirement(s) concerned
- (section 37V(3)(c) of the Ordinance; sections 31ZI and 100AAB(2)(c)&(3)(b) of the Rules).
- 15.24 If the applicant fails to timely file the request to review, the Registrar must make a **final decision to refuse** the standard patent (O) application (section 37Y of the Ordinance and section 31ZI(5) of the Rules).
- 15.25 If the Registrar, having considered the request to review filed by the applicant, maintains the view that the application does not comply with the examination requirement(s) in question, he will issue to the applicant a **review opinion** setting out the examination requirement concerned for the applicant's response, and, if the Registrar thinks fit, the review opinion will also state that the applicant may file a request for hearing (section 37W(b) of the Ordinance and section 31ZJ of the Rules).
- 15.26 The applicant may respond to the review opinion by filing:
- (a) a written representation and/or a request to amend the application as aforesaid **within 2 months** after the date of the review opinion (extendable for 2 months if the time extension request is filed no later than 2 months after the initial deadline for response) (sections 31ZK(1) and 100AAB(2)(c)&(3)(b) of the Rules); and / or
  - (b) *(if the Registrar offers the applicant an opportunity to request a hearing)* a request for hearing in Form OP6 and paying the official fee **within 2 months** after the date of the review opinion (extendable for 2 months if the time extension request is filed before the initial deadline for response; section 135 of the Ordinance) (sections 31ZK(2)-(3), 82(2)(a) and 100AAB(2)(a)&(3)(b) of the Rules).
- 15.27 Where the applicant has filed a response to the review opinion, and the Registrar takes the view that the applicant should elaborate, revise or clarify any matter covered in the response, the Registrar will issue a **further review opinion(s)** to the

applicant to set out such matter, and, if the Registrar thinks fit, to state that the applicant may file a request for hearing (section 37W(b) of the Ordinance and section 31ZL of the Rules).

15.28 If the applicant elects to file a response to the further review opinion, the applicant must do so **within 2 months** after the date of the further review opinion. Such time limit is extendable for—

(a) *(for filing a written response to elaborate, revise or clarify the matter concerned)* 2 months provided that the time extension request is filed no later than 2 months after the initial deadline for response) (sections 31ZM(1) and 100AAB(2)(c)&(3)(b) of the Rules);

(b) *(for filing a request for hearing to exercise the right to be heard as offered by the Registrar)* 2 months provided that the time extension request is filed before the initial deadline for response) (section 135 of the Ordinance; sections 31ZM(2)-(3), 82(2)(b) and 100AAB(2)(a)&(3)(b) of the Rules).

15.29 The Registrar may issue to the applicant another further review opinion in respect of any matter covered in the applicant's response to a previous further review opinion so as to require the applicant to provide further elaboration, revision or clarification in respect of the matter concerned. Accordingly, one or more further review opinion(s) may be issued by the Registrar throughout the review of the Registrar's provisional decision of refusal to grant the standard patent (O) (section 37W(b) of the Ordinance and section 31ZL(3) of the Rules).

15.29A Before a standard patent (O) application is refused, the applicant must be given an opportunity of being heard (section 135 of the Ordinance and section 82(1) of the Rules). Generally, the Registrar would offer such opportunity to the applicant in the review opinion and/or further review opinion(s) as he thinks fit.

15.30 If no response to the review opinion or further review opinion (if any) is filed and no request for hearing, if applicable, is filed within the prescribed period, the Registrar must make a **final decision of refusal** to grant the standard patent (O) and notify the applicant accordingly (section 37Y of the Ordinance; sections 31ZK(4) and 31ZM(4) of the Rules).

15.31 When the Registrar is satisfied that the matter(s) as addressed in the applicant's responses to a review opinion and/or any further review opinion is/are in compliance with the relevant examination requirement(s), the Registrar, in further carrying out the substantive examination of the standard patent (O) application, may, in respect of any other unfulfilled examination requirement that has not previously been raised, issue fresh examination notices (section 37V(1) of the Ordinance and section 31ZO of the Rules).

## Final outcome of substantive examination

- 15.32 If the Registrar, upon completing substantive examination of a standard patent (O) application, is of the opinion that the application together with any requested amendment complies with all examination requirements, the Registrar must grant a standard patent (O) for the underlying invention and take the following actions as soon as practicable—
- (a) publish the patent specification and the names of the applicant(s) and inventor(s);
  - (b) issue a certificate of grant; and
  - (c) advertise the fact of grant by notice in the official journal.
- (section 37X of the Ordinance)
- 15.33 On the other hand, if the Registrar is ultimately of the opinion that a standard patent (O) application together with any requested amendment, does not comply with all examination requirements, the Registrar must refuse to grant a standard patent (O) for the underlying invention (section 37Y of the Ordinance).

## ***Post-grant substantive examination of a short-term patent***

### Examination

- 15.34 The substantive examination procedures for a short-term patent is by and large same as that for a standard patent (O) application.
- 15.35 If the Registrar is of the opinion that a short-term patent, together with any requested amendment, does not comply with an examination requirement, the Registrar will issue an **examination notice** to the patent proprietor setting out the relevant non-compliance (section 127D(1) of the Ordinance and section 81D(1) of the Rules).
- 15.36 The proprietor may respond to the examination notice by filing one or all of the following:
- (a) a representation to establish that the patent complies with the examination requirement(s) concerned;
  - (b) a request to amend the patent to enable it to comply with the examination requirement(s) concerned.
- (section 127D(3)(a) or (b) of the Ordinance and section 81E(1) of the Rules)
- 15.37 When opting to file a response to the examination notice in the aforesaid manner, the proprietor must do so **within 2 months** after the date of the notice (extendable for 1 month if the time extension request is filed no later than 1 month after the initial deadline for response) (section 127D(3)(a) or (b) of the Ordinance; sections 81E(1) and 100AAB(2)(b)&(3)(a) of the Rules).

- 15.38 Upon considering a response to the examination notice filed by a short-term patent proprietor, and also taking the view that the proprietor should elaborate, revise or clarify any matter covered in the response, the Registrar will issue a **further examination notice** to the proprietor to set out such matter (section 127D(1) of the Ordinance and section 81F of the Rules).
- 15.39 If the proprietor elects to file a response to the further examination notice, the proprietor must do so **within 2 months** after the date of the notice (extendable for 1 month if the time extension request is filed no later than 1 month after the initial deadline for response) (section 127D(3)(a) or (b) of the Ordinance; sections 81G(1) and 100AAB(2)(b)&(3)(a) of the Rules).
- 15.40 The Registrar may issue to the proprietor another further examination notice in respect of any matter covered in the proprietor's response to a previous further examination notice so as to require the proprietor to provide further elaboration, revision or clarification of the matter concerned. Accordingly, one or more further examination notice(s) may be issued by the Registrar throughout the post-grant substantive examination of a short-term patent (section 127D(1) of the Ordinance and section 81F(3) of the Rules).
- 15.41 When the Registrar is satisfied that the matter(s) as addressed in the proprietor's response(s) to an examination notice and any further examination notice is/are in compliance with the relevant examination requirement(s), the Registrar, in further carrying out the substantive examination of the short-term patent, may, in respect of any other unfulfilled examination requirement that has not previously been raised, issue fresh examination notices (section 127D(1) of the Ordinance and section 81O of the Rules).
- 15.42 If a short-term patent proprietor fails to timely file a response to any examination notice or further examination notice, the Registrar must make a **provisional decision to revoke** the patent (sections 81E(2) and 81G(2) of the Rules).
- 15.43 If the Registrar, having considered a short-term patent proprietor's responses to the examination notice(s) and/or any further examination notice still considers that the patent does not comply with the examination requirement(s) concerned, the Registrar may make a **provisional decision to revoke** the patent (section 81H(1) of the Rules).

### Review

- 15.44 The short-term patent proprietor may file a **request to review** the provisional decision of revocation **within 2 months** after the date of the decision (extendable for 1 month if the time extension request is filed no later than 1 month after the initial deadline for response). The request to review may contain one or both of the following—

- (a) a written representation to establish that the patent complies with the examination requirement(s) concerned;
  - (b) a request to amend the patent to enable it to comply with the examination requirement(s) concerned
- (section 127D(3)(c) of the Ordinance; sections 81I and 100AAB(2)(b)&(3)(a) of the Rules).

15.45 If the proprietor fails to timely file the request to review, the Registrar must make a **final decision to revoke** the short-term patent (section 127G of the Ordinance; section 81I(5) of the Rules).

15.46 If the Registrar, having considered the request to review filed by the proprietor, maintains the view that the short-term patent does not comply with the examination requirement(s) in question, the Registrar will issue to the proprietor a **review opinion** setting out the examination requirement concerned for the proprietor's response, and, if the Registrar thinks fit, the review opinion will also state that the proprietor may file a request for hearing (section 127E(1)(b) of the Ordinance and section 81J of the Rules).

15.47 The proprietor may respond to the review opinion by filing:

- (a) a written representation and / or a request to amend the patent as aforesaid **within 2 months** after the date of the review opinion (extendable for 1 month if the time extension request is filed no later than 1 month after the initial deadline for response) (sections 81K(1) and 100AAB(2)(b)&(3)(a) of the Rules); and / or
- (b) *(if the Registrar offers the proprietor an opportunity to request a hearing)* a request for hearing in Form OP6 and paying the official fee **within 2 months** after the date of the review opinion (extendable for 1 month if the time extension request is filed before the initial deadline for response) (section 135 of the Ordinance; sections 81K(2)-(3), 82(2)(c) and 100AAB(2)(a)&(3)(a) of the Rules).

15.48 Where the proprietor has filed a response to the review opinion, and the Registrar takes the view that the proprietor should elaborate, revise or clarify any matter covered in the response, the Registrar will issue a **further review opinion(s)** to the proprietor to set out such matter, and, if the Registrar thinks fit, to state that the proprietor may file a request for hearing (section 127D(1) of the Ordinance and section 81L of the Rules).

15.49 If the proprietor elects to file a response to the further review opinion, the proprietor must do so **within 2 months** after the date of the further review opinion. Such time limit is extendable for—

- (a) *(for filing a written response to elaborate, revise or clarify the matter concerned)* 1 month provided that the time extension request is filed no later than 1 month after the initial deadline for response) (sections 81M(1) and 100AAB(2)(b)&(3)(a) of the Rules);

(b) (for filing a request for hearing to exercise the right to be heard as offered by the Registrar) 1 month provided that the time extension request is filed before the initial deadline for response) (section 135 of the Ordinance; sections 81M(2)-(3), 82(2)(d) and 100AAB(2)(a)&(3)(a) of the Rules).

15.50 The Registrar may issue to the proprietor another further review opinion in respect of any matter covered in the proprietor's response to a previous further review opinion so as to require the proprietor to provide further elaboration, revision or clarification of the matter concerned. Accordingly, one or more further review opinion(s) may be issued by the Registrar throughout the review of the Registrar's provisional decision to revoke the short-term patent (section 127E(1)(b) of the Ordinance and section 81L(3) of the Rules).

15.50A Before a short-term patent is revoked, the proprietor must be given an opportunity of being heard (section 135 of the Ordinance and section 82(1) of the Rules). Generally, the Registrar would offer such opportunity to the proprietor in the review opinion and/or further review opinion(s) as he thinks fit.

15.51 If no response to the review opinion or further review opinion (if any) is filed and no request for hearing, if applicable, is filed within the prescribed period, the Registrar must make a **final decision to revoke** the short-term patent and notify the proprietor and the requester (if any) accordingly (section 127G of the Ordinance; sections 81K(4) and 81M(4) of the Rules).

15.52 When the Registrar is satisfied that the matter(s) as addressed in the proprietor's responses to a review opinion and/or any further review opinion is/are in compliance with the relevant examination requirement(s), the Registrar, in further carrying out the substantive examination of the short-term patent, may, in respect of any other unfulfilled examination requirement that has not previously been raised, issue fresh examination notices (section 127D(1) of the Ordinance and section 81O of the Rules).

#### Final outcome of post-grant substantive examination

15.53 If the Registrar, upon completing post-grant substantive examination of a short-term patent, is of the opinion that the patent, together with any requested amendment, complies with all examination requirements, the Registrar must issue a certificate of substantive examination in respect of the patent, and take the following actions as soon as practicable—

- (a) inform the proprietor and the person who requested the substantive examination (if such person is not the proprietor) by written notice that the certificate has been issued;
- (b) send the certificate to the proprietor; and
- (c) enter a record of the issue of the certificate in the register.

(section 127F of the Ordinance)

15.54 On the other hand, if the Registrar is ultimately of the opinion that a short-term patent, together with any requested amendment, does not comply with all examination requirements, the Registrar must revoke the patent and take the following actions as soon as practicable—

(a) inform the proprietor and the person who requested the substantive examination (if such person is not the proprietor) by written notice that the patent has been revoked;

(b) advertise the fact of the revocation by notice in the official journal; and

(c) enter a record of the revocation in the register.

(section 127G of the Ordinance)

### **Request for reinstatement and restoration of rights**

15.55 In respect of a standard patent (O) application which is refused or deemed to be/regarded as being withdrawn following its applicant's failure to comply with a prescribed/specified time limit, the applicant may, in appropriate cases, seek relief by filing a notice requesting reinstatement and/or an application for restoration of rights. On the other hand, such relief is not available to a short-term patent under post-grant substantive examination which is revoked as a result of its proprietor's failure to comply with a prescribed/specified time limit.

### ***Request for reinstatement***

15.56 If a standard patent (O) application is deemed to be/regarded as being withdrawn following its applicant's failure to file a request for substantive examination or to respond to an examination notice or a further examination notice within the prescribed time limit, the applicant may file a notice requesting reinstatement of the application **within 2 months** after the refusal or withdrawal of the application.

15.57 A request for reinstatement should be made in Patents form P13 together with payment of the official fees (sections 28(1) & (2) and 37ZD(1) of the Ordinance; section 31ZU of the Rules).

15.58 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) and 37ZD(1) of the Ordinance). An omission is not made good by a mere procedural request such as a request for oral hearing.

15.59 The reinstatement relief is however not available to a standard patent (O) application at its substantive examination stage under any of the following circumstances:

- (a) a standard patent (O) application that is regarded as being withdrawn by reason of a failure to pay the prescribed fee for a substantive examination request within the prescribed period (section 37ZD(2)(a) (containing reference to section 37T(2)(b)) of the Ordinance); and
- (b) a standard patent (O) application that is refused following a failure to file a request to review the Registrar’s provisional decision on refusal to grant the application, or a failure to respond to a review opinion or further review opinion (if any), within the prescribed time limit (section 37ZD(2)(b) (containing references to sections 37V, 37W and 37Y) of the Ordinance).

***Application for restoration of rights***

- 15.60 The relief of restoration of rights may be available to an applicant who has, in spite of having taken all reasonable care required by the circumstances, failed to comply with the time limit to file a request for substantive examination, make a payment of the prescribed fee for substantive examination, respond to an examination notice or a further examination notice, file a request to review the Registrar’s provisional decision on refusal to grant the application, or respond to a review opinion or further review opinion (if any), within the prescribed time limit concerned (sections 29(1) and 37ZD(1) of the Ordinance).
- 15.61 An application for restoration must be made within 1 year after the expiry of the relevant time limit or 2 months after the removal of the cause of non-compliance, whichever is the earlier (sections 29 and 37ZD(1) of the Ordinance).
- 15.62 Insofar as the meaning of “reasonable care” is concerned, please refer to sections 14.42 to 14.44 of these Guidelines.
- 15.63 The restoration relief is however not applicable to the failure to observe the following time limits in respect of an standard patent (O) application:
- (a) a failure to file divisional applications within the prescribed time limits (section 37ZD(3) (containing reference to sections 37Z) of the Ordinance); and
  - (b) a failure to amend or withdraw a patent application within the prescribed time limits (section 37ZD(3) (containing reference to sections 37ZA and 37ZB) of the Ordinance; section 31ZT of the Rules).