

Patents Registry

Intellectual Property Department

Hong Kong SAR Government

Patents Examination Guidelines

Section 14: Formality Examination of Patent Applications

Introduction

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

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

Standard patent (O)/short-term patent applications

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

Requests to record (i.e. 1st stage of filing standard patent (R) applications)

14.4 The Registrar will accord a date of filing to a request to record if such request contains the following information in compliance with the minimum requirements—

- (a) an indication that the request is made to record a designated patent application;
- (b) information identifying the applicant;
- (c) the application number of the designated patent application;
- (d) the publication number of the designated patent application (if any); and
- (e) the publication date of the designated patent application (if any).

(section 17(1) of the Ordinance)

Requests for registration and grant (i.e. 2nd stage of filing standard patent (R) applications)

14.5 The Registrar will accord a date of filing to a request for registration and grant if such request contains the following information in compliance with the requirements for according a date of filing—

- (a) an indication that a request for registration and grant is made;
- (b) information identifying the applicant;
- (c) the publication number of the granted designated patent;
- (d) the publication date of the granted designated patent; and
- (e) the publication number of the request to record.

(section 24(1) of the Ordinance)

Requirements for according a date of filing – individual requirements

An indication that a patent is sought or a request is made (for all patent applications)

14.6 The filing of a specified application form containing the necessary filing particulars is generally regarded by the Registrar as an indication that a patent is sought or a request is made.

14.7 Alternatively, a patent applicant is allowed to give such indication clearly in writing, such as by letter, to meet this minimum requirement.

Information identifying the applicant (for all patent applications)

- 14.8 This minimum requirement is considered to be met whenever it is possible to establish beyond reasonable doubt the identity of the patent applicant on the basis of all data contained in the documents filed by the applicant or his representative (*J25/86* (EPO OJ 1987, 475)).
- 14.9 Each case must be considered on its own facts. In general, the Registrar will consider the applicant as sufficiently identified if—
- (a) the applicant's signature can be seen on an authorization form and the address of the legal representative is provided (*J25/86*); or
 - (b) the name and address of the applicant indicated are sufficient to meet the customary requirements for postal delivery (notwithstanding that the name is misspelled, the given names are not fully indicated or, in the case of legal entities, the indication of the name is abbreviated or incomplete).

Something that appears to be a description or a reference to an earlier specified application (for standard patent (O) and short-term patent applications)

- 14.10 When examining whether this minimum requirement is met, the Registrar is not required to scrutinize the contents of the description. It is sufficient for the filed document(s) to contain something which appears to be a description of the invention.
- 14.11 As an alternative to filing a specific description for a standard patent (O) / short-term patent application, an applicant may make a reference to an earlier specified application which is—
- (a) a previously filed application for a patent or other protection in or for a Paris Convention country or WTO member country, territory or area;
 - (b) a previously filed standard patent (O) application; or
 - (c) a previously filed short-term patent application.
- (sections 37M(6) (for standard patent (O) applications) and 114(7) (for short-term patent applications) of the Ordinance)
- 14.12 The reference to an earlier specified application should include the following particulars of the earlier application—
- (a) the date of filing;
 - (b) the application number;
 - (c) the country, territory or area in or for which the application was filed; and
 - (d) a statement indicating that a description and the drawings (if any) of the claimed invention are completely contained in the earlier application.

(section 37M(3)(c)(ii) of the Ordinance and section 31W(2) of the Rules (for standard patent (O) applications); section 114(3)(c)(ii) of the Ordinance and section 67A(2) of the Rules (for short-term patent applications)).

14.13 In any event, it is not necessary to file any claims for the purpose of obtaining a date of filing for a patent application.

Formal requirements for each type of patent application

Standard patent (O) patent applications

14.14 Based on section 37L of the Ordinance and sections 31M to 31S of the Rules, the Registrar, when conducting formality examination of a standard patent (O) patent application, examines if the application complies with the following formal requirements—

(a) the application—

- (i) is signed by or on behalf of the applicant (where a person signs the application on behalf of the applicant, the Registrar will generally assume that such person is duly authorized to act for the applicant to file the application unless there is a reason for the Registrar to believe that such person is not so authorized, and in the latter case, the Registrar will ask for proof of authorization) (section 37L(1)(a) of the Ordinance);
- (ii) is filed with the Registrar in the prescribed manner (section 37L(1)(b) of the Ordinance; also see sections 13.89 to 13.90 of these Guidelines);
- (iii) contains a request for grant in Patents form OP1 (section 37L(2)(a) of the Ordinance; section 31M(1) of the Rules); and
- (iv) *(if the applicant is not the inventor)* contains a statement in Patents form OP1A indicating how the applicant becomes entitled to apply for the patent (section 37L(3)(c) of the Ordinance);

(b) the application specifies—

- (i) the name and address of the applicant (section 37L(3)(a) of the Ordinance);
- (ii) the name of each inventor (section 37L(3)(b)(i) of the Ordinance);
- (iii) *(if the applicant is not the inventor)* the last-known address of each inventor in Patents form OP1A (section 37L(3)(b)(ii) of the Ordinance); and
- (iv) a Hong Kong address for service of documents (section 37L(3)(d) of the Ordinance);

- (c) the application contains a specification¹ that—
- (i) provides for a description (section 37L(2)(b)(i) of the Ordinance);
 - (ii) provides for at least one claim (section 37L(2)(b)(ii) of the Ordinance);
 - (iii) provides for any drawing referred to in the description or claim(s) (section 37L(2)(b)(iii) of the Ordinance); and
 - (iv) states the title of the invention which must be short and indicate the matter to which the invention relates (section 37L(7)(a) of the Ordinance; sections 31M(2)(a)&(3) of the Rules);
- (d) the application contains an abstract that—
- (i) begins with a title of the invention;
 - (ii) contains a concise summary of the matters contained in the specification which specifies the technical field to which the invention relates, and is written in a way that allows a clear understanding of the technical problem to which the invention relates, the gist of the solution to that problem through the invention and the principal use or uses of the invention;
 - (iii) does not contain more than 150 English words or 200 Chinese characters as appropriate save in exceptional cases;
 - (iv) where appropriate, contains the chemical formula that, among those contained in the specification, best characterizes the invention;
 - (v) does not contain statements on the alleged merits or value of the invention or on its speculative application; and
 - (vi) indicates any figure or, exceptionally, figures in the drawings that the applicant suggests should accompany the abstract when it is published;
- (section 37L(2)(c) of the Ordinance and section 31P of the Rules)
- (e) *(where the applicant claims non-prejudicial disclosure of the claimed invention on the basis that the invention was displayed at a recognized exhibition)* the application includes a statement to the effect that the invention was so displayed, together with written evidence in support of the statement (sections 37B(2)(b)(ii), 37B(3) and 37L(2)(d) of the Ordinance; see also sections 1.49 and 1.50 of these Guidelines), which the Registrar only examines their substance at the stage of substantive examination;
- (f) *(where the applicant claims priority on the basis of a previous patent application)* the application includes a statement of priority, a copy of the previous application,

¹ The language of the specification should be the same as that of the application form. Otherwise, the applicant may be required to file a verified translation of the specification.

and also a copy of the certificate issued by the authority that received the previous application stating the date of filing of the previous application (sections 37E(1) and 37L(2)(e) of the Ordinance; sections 31C(6)&(7) of the Rules);

- (g) *(where a reference has been made to an earlier specified application)* the application includes a copy of the earlier specified application, and also a copy of the certificate issued by the authority that received the earlier specified application (sections 37L(2)(b) and 37M(3)(c)(ii) of the Ordinance; sections 31M(4)(g) and 31W(3) of the Rules);
- (h) *(where the invention requires the use of a micro-organism for performance of the invention)* the application includes information on the availability of samples of the micro-organism to the public (if any) (section 37L(2)(f) of the Ordinance);
- (i) *(where the invention involves nucleotide and amino acid sequences)* the application includes a sequence listing (section 37L(7)(b) of the Ordinance; section 31ZX of the Rules);
- (j) *(where any document in support of the application is not in one of the official languages or any name in the application is not in the Roman alphabet or Chinese characters, as the case may be)* the filing of the document is accompanied by its translation or a transliteration of the name is provided (section 37L(4) of the Ordinance; sections 31M(4)(d), 56, 56A and 56B(3) of the Rules);
- (k) the application includes a list of the documents in support of the application with an indication of the number of sheets of each supporting document (sections 31M(4)(b)&(c) of the Rules); and
- (l) the size and presentation of documents in support of the application comply with the applicable requirements under sections 31Q and 31R of the Rules.

Short-term patent applications

14.15 A short-term patent application must comply with the formal requirements under section 113 of the Ordinance and sections 58 to 65 of the Rules, namely the following:

- (a) the application—
 - (i) is signed by or on behalf of the applicant (section 113(1)(a) of the Ordinance; and see also section 14.14(a)(i) of these Guidelines);
 - (ii) is filed with the Registrar in the prescribed manner (section 113(1)(b) of the Ordinance; see sections 13.89 to 13.90 of these Guidelines);
 - (iii) contains a request for grant in Patents form P6 (section 113(1A)(a) of the Ordinance; section 58(1) of the Rules); and

- (iv) *(if the applicant is not the inventor)* contains a statement in Patents form P6A indicating how the applicant becomes entitled to apply for the patent (section 113(2)(c) of the Ordinance; section 65(a) of the Rules);
- (b) the application specifies—
 - (i) the name and address of the applicant (section 113(2)(a) of the Ordinance);
 - (ii) the name of each inventor (section 113(2)(b)(i) of the Ordinance);
 - (iii) *(if the applicant is not the inventor)* the last-known address of each inventor in Patents form P6A (section 113(2)(b)(ii) of the Ordinance); and
 - (iv) a Hong Kong address for service of documents (section 113(2)(d) of the Ordinance);
- (c) the application contains a specification² that
 - (i) provides for a description (section 113(1A)(b)(i) of the Ordinance);
 - (ii) provides for one or more claims but in any event not more than two independent claims (section 113(1A)(b)(ii) of the Ordinance);
 - (iii) provides for any drawing referred to in the description or claim(s) (section 113(1A)(b)(iii) of the Ordinance); and
 - (iv) states the title of the invention which must be short and indicate the matter to which the invention relates (section 113(4)(a) of the Ordinance; sections 58(2)&(3) of the Rules);
- (d) the application contains an abstract (section 113(1A)(c) of the Ordinance; section 61 of the Rules; see section 14.14(d) of these Guidelines);
- (e) *(where the applicant claims non-prejudicial disclosure of the invention on the basis that the claimed invention was displayed at a recognized exhibition)* the application includes a statement to the effect that the invention was so displayed together with written evidence in support of the statement (sections 109(b) and 113(1A)(e) of the Ordinance; see also sections 1.49 and 1.50 of these Guidelines), which the Registrar only examines their substance at the stage of substantive examination;
- (f) *(where the applicant claims priority on the basis of a previous patent application)* the application includes a statement of priority, a copy of the previous application, and a copy of the certificate issued by the authority that received the previous application stating the date of filing of the previous application (sections 111(1) and 113(1A)(f) of the Ordinance; sections 69(6)&(7) of the Rules);

² The language of the specification should be the same as that of the application form. Otherwise, the applicant may be required to file a verified translation of the specification.

- (g) *(where a reference has been made to an earlier specified application)* the application includes a copy of the earlier specified application, and also a copy of the certificate issued by the authority that received the earlier specified application (sections 113(1A)(b) and 114(3)(c)(ii) of the Ordinance; sections 58(5)(i) and 67A of the Rules);
- (h) *(where the invention requires the use of a micro-organism for the performance of the invention)* the application includes information on the availability of samples of the micro-organism to the public (if any) (section 113(1A)(h) of the Ordinance);
- (i) *(where the invention involves nucleotide and amino acid sequences)* the application includes a sequence listing (section 113(4)(b) of the Ordinance; section 73A of the Rules);
- (j) *(where any document in support of the application is not in one of the official languages or any name in the application is not in the Roman alphabet or Chinese characters, as the case may be)* the filing of the document is accompanied by its translation or a transliteration of the name is provided (section 113(3) of the Ordinance; sections 56, 56A, 56B(1) to (3) and 58(5)(j) of the Rules);
- (k) the application includes a list of the documents in support of the application with an indication of the number of sheets of each supporting document (section 58(5)(h) of the Rules);
- (l) the size and presentation of documents in support of the application comply with the applicable requirements under sections 62 and 63 of the Rules;
- (m) the application contains a search report (section 113(1A)(d) of the Ordinance) that—
 - (i) identifies by name the searching authority which prepared the report (section 72(a) of the Rules);
 - (ii) is dated and also indicates the date on which the search was actually completed (section 72(b) of the Rules);
 - (iii) contains the classification of the subject-matter according to the International Patent Classification (section 72(c) of the Rules);
 - (iv) contains the citations of the documents considered to be relevant (section 72(d) of the Rules);
 - (v) lists the classification identification of the fields searched (section 72(e) of the Rules); and
 - (vi) contains the name of the officer of the searching authority responsible for the report (section 72(f) of the Rules); and

- (n) (where the applicant requests for deferring the grant of the short-term patent) the application includes a written request for such deferral (sections 113(1A)(g) and 119 of the Ordinance).

Requests to record (i.e. 1st stage of filing standard patent (R) applications)

14.16 A request to record must comply with the following formal requirements under section 15 of the Ordinance and sections 8, 9 and 12 of the Rules:

(a) the request is—

- (i) filed with the Registrar within 6 months (non-extendable) after the publication of a designated patent application in a designated patent office based on which the request is made (section 15(1) of the Ordinance);
- (ii) signed by or on behalf of the applicant (section 15(2) of the Ordinance, and see also section 14.14(a)(i) of these Guidelines);
- (iii) filed with the Registrar in the prescribed manner (section 15(2) of the Ordinance; see sections 13.89 to 13.90 of these Guidelines); and
- (iv) made in Patents form P4 (section 15(2) of the Ordinance; section 8(1) of the Rules);

(b) the request contains—

- (i) a photocopy of the designated patent application as published (section 15(2)(a) of the Ordinance);
- (ii) the title of the invention (section 15(2) of the Ordinance; section 8(2)(c)(ii) of the Rules);
- (iii) the date of filing, application number, publication number (if any), and publication date (if any) of the designated patent application (section 15(2) of the Ordinance; sections 8(2)(c)(i), (iii) and (iv) of the Rules);
- (iv) (*if the designated patent application is the national phase of an international application*) the relevant particulars of the international application (section 15(2) of the Ordinance; sections 8(2)(d) of the Rules; see sections 13.46 to 13.47 of these Guidelines);
- (v) (*if the designated patent application does not contain the name of the inventor*) a statement identifying the person or persons whom the applicant believes to be the inventor(s) (section 15(2)(b) of the Ordinance);
- (vi) the name and address of the person making the request (section 15(2)(c) of the Ordinance);

- (vii) *(if the person filing the request is a person other than the person named as applicant in the designated patent application)* a statement explaining the requester's entitlement to apply for the grant and the supporting documents (section 15(2)(d) of the Ordinance; section 9 of the Rules);
 - (viii) *(if priority is claimed in respect of a right of priority enjoyed in the designated patent office on the basis of an earlier application)* a statement of priority (section 15(2)(e) of the Ordinance);
 - (ix) *(if a claim for non-prejudicial disclosure of the invention has been made with the law of the designated patent office)* a statement indicating the details of the non-prejudicial disclosure claim made at the time of filing of the designated patent application (section 15(2)(f) of the Ordinance; section 10 of the Rules);
 - (x) a Hong Kong address for service of documents (section 15(2)(g) of the Ordinance);
 - (xi) *(if the designated patent application is the national phase of an international application)* the relevant filing and publication particulars and documents of the international application (section 16 of the Ordinance; section 8(2)(d) of the Rules);
 - (xii) translation of any documents and / or transliteration of any names (if needed) (section 15(3) of the Ordinance; sections 8(2)(f) and 56 of the Rules); and
 - (xiii) a list of the documents comprising the request to record and an indication of the number of sheets of each of these document (section 15(2) of the Ordinance; section 8(2)(g) of the Rules);
- (c) the size and presentation of all documents in support of the request comply with the applicable requirements under section 12 of the Rules.

Requests for registration and grant (i.e. 2nd stage of filing standard patent (R) applications)

14.17 A request for registration and grant must comply with the following formal requirements under section 23 of the Ordinance and sections 12, 13, 19 and 20 of the Rules:

- (a) the request is—
 - (i) filed with the Registrar within 6 months (non-extendable) after the date of grant of the designated patent by the designated patent office or publication of the request to record, whichever is the later (section 23(2) of the Ordinance);

- (ii) filed with the Registrar in the prescribed manner (section 23(3) of the Ordinance; see sections 13.89 to 13.90 of these Guidelines); and
 - (iii) made in Patents form P5 (section 23(3) of the Ordinance; section 19(1) of the Rules);
- (b) the request contains:
- (i) a verified copy of the published specification of the designated patent (section 23(3)(a) of the Ordinance; section 102 of the Rules);
 - (ii) the title of the invention (section 23(3) of the Ordinance; section 19(2)(c)(ii) of the Rules);
 - (iii) the application number, publication number and date of publication of the request to record (section 23(3) of the Ordinance; section 19(2)(c)(i) of the Rules);
 - (iv) the date of grant and publication number of the designated patent (section 23(3) of the Ordinance; section 19(2)(c)(iii) of the Rules);
 - (v) *(if the person filing the request is a person other than the person named in the register as the applicant for a standard patent (R) for the invention) a statement explaining the requester's entitlement to apply for the grant and the supporting documents (section 23(3)(b) of the Ordinance; section 20 of the Rules);*
 - (vi) translation of any documents and / or transliteration of any names (if needed) (section 23(4) of the Ordinance; sections 19(2)(d) and 56 of the Rules); and
 - (vii) a list of the documents comprising the request for registration and grant and an indication of the number of sheets of each of these document (section 23(3) of the Ordinance; section 19(2)(e) of the Rules);
- (c) the size and presentation of all documents in support of the request comply with section 12 of the Rules (sections 19(2)(a)&(3) of the Rules).

Correction of deficiencies

Deficiencies regarding requirements for according a date of filing

14.18 If the Registrar, upon examining a patent application, considers that the application does not comply with any of the requirements for according a date of filing to the application, the Registrar will give notice to the applicant to correct the deficiencies within—

- (a) 1 month *(for standard patent (R) applications); or*

(b) 2 months (*for standard patent (O) / short-term patent applications*)

after the date of the notice (sections 18(2) & 25(3) of the Ordinance and sections 16(1) & 23(1) of the Rules (for standard patent (R) applications); section 37M(4) of the Ordinance and section 31V(2)(b) of the Rules (for standard patent (O) applications); section 114(4) of the Ordinance and 67(2)(b) of the Rules (for short-term patent applications)).

14.19 The correction periods under section 14.18 above are not extendable (see sections 100 and 100AA of the Rules).

14.20 If the Registrar is of the view that a patent application fulfills the requirements for according a date of filing to the application, the Registrar will notify the applicant of the date of filing so accorded (sections 17(1) & 24(1) of the Ordinance and sections 16(2) & 23(2) of the Rules (for standard patent (R) applications); section 37M(2) of the Ordinance and section 31V(1)&(3) of the Rules (for standard patent (O) applications); section 114(2) of the Ordinance and section 67(1)&(3) of the Rules (for short-term patent applications)).

14.21 Failure on the part of a patent applicant to timely correct any deficiency in a patent application as identified by the Registrar will render the application as-

(a) not being further dealt with by the Registrar (*for requests to record (section 18(3) of the Ordinance), standard patent (O) applications (section 37M(5) of the Ordinance) and short-term patent applications (section 114(5) of the Ordinance)*);
or

(b) withdrawn or refused (*for requests for registration and grant (section 25(4) of the Ordinance)*).

Deficiencies regarding formal requirements

14.22 After according a date of filing to a patent application, the Registrar will examine whether the application fulfils the formal requirements. If the Registrar considers that the application is not in order, the Registrar will inform the applicant, by notice, to correct the deficiencies within 2 months after the date of the notice (sections 19(2) & 26(2) of the Ordinance and sections 17 & 24 of the Rules (for standard patent (R) applications); section 37P(3) of the Ordinance and section 31Y(1) of the Rules (for standard patent (O) applications); section 115(2) of the Ordinance and section 68(1) of the Rules (for short-term patent applications)).

14.23 The period for correcting the deficiencies is extendable for 2 months once provided that a request for the extension is filed before the initial deadline for correction (sections 100 and 100AAB(1), (2)(a), 3(b) & (4) of the Rules).

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

Request for reinstatement of patent applications

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

patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance).

- 14.30 A request for reinstatement should be made in Patents form P13 together with payment of the official fee (sections 28(1)&(2) (for standard patent (R) applications), 37ZD(1) (for standard patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance).
- 14.31 A request for reinstatement is not deemed to be filed unless the omission which constituted the failure to comply with the time limit has been made good (sections 28(2)(c) (for standard patent (R) applications), 37ZD(1) (for standard patent (O) applications) and 123(1) (for short-term patent applications) of the Ordinance). An omission is not made good by a mere procedural request such as a request for oral hearing.
- 14.32 The reinstatement relief is however not available at the formality examination stage under any of the following circumstances—
- (a) a standard patent (R) application that is deemed to be/regarded as being withdrawn/refused for the reason of—
 - (i) a failure to file a request for registration and grant within the non-extendible 6-month period (sections 24(2) and 28(3)(b) of the Ordinance);
 - (ii) a failure to pay the prescribed maintenance fee within the prescribed period (sections 28(3)(b) and 33(2) of the Ordinance); and
 - (iii) a failure to correct any deficiency concerning the requirements for the accordance of a date of filing for a request for registration and grant within the time limit (sections 25(2) & (4) and 28(3) of the Ordinance);
 - (b) a patent application that is regarded as being withdrawn by reason of a failure to pay the prescribed filing or advertisement fee(s) within the prescribed period (sections 15(4), 23(5) & 28(3)(b) of the Ordinance (for standard patent (R) applications); sections 37L(6) & 37ZD(2)(a) of the Ordinance (for standard patent (O) applications); sections 113(5) & 123(2) of the Ordinance (for short-term patent applications)).

Application for restoration of rights

General

- 14.33 If any right or means of redress is lost by a patent applicant as a direct consequence of the failure to comply with a time limit, the applicant may, in appropriate cases, apply to the Registrar for restoration of rights by satisfying the Registrar that the failure to comply with the time limit occurred in spite of the applicant having taken

all reasonable care required by the circumstances (see section 14.42 of these Guidelines regarding the test on what constitutes reasonable care).

- 14.34 An application for restoration must be made in writing within 1 year after the failure to comply with the relevant time limit or 2 months after the removal of the cause of non-compliance, whichever is the earlier (section 29(1)&(2) of the Ordinance (for standard patent (R) applications); section 37ZD(1) of the Ordinance (for standard patent (O) applications); section 123(1) of the Ordinance (for short-term patent applications)).
- 14.35 The restoration relief is however not applicable to the failure to observe the following time limits:
- (a) a failure to file a request to record or request for registration and grant within the non-extendible 6-month period (sections 17(2), 24(2) and 29(5) of the Ordinance);
 - (b) a failure to remedy a deficiency in respect of any requirement for according the date of filing of a standard patent (R) or short-term patent application within the prescribed period (sections 18, 25(4) & 29(5) of the Ordinance (for standard patent (R) applications); sections 114 and 123(3) of the Ordinance (for short-term patent applications));
 - (c) a failure to pay the prescribed filing or advertisement fee(s) within the prescribed period in respect of a standard patent (R) or short-term patent application (sections 15(4), 23(5) and 29(5) of the Ordinance (for standard patent (R) applications); sections 113(5) and 123(3) of the Ordinance (for short-term patent applications));
 - (d) a failure to remedy a deficiency in respect of any formal requirement of a request to record or a short-term patent application within the prescribed period (sections 15, 19 and 29(5) of the Ordinance (for requests to record); sections 113, 115 and 123(3) of the Ordinance (for short-term patent applications));
 - (e) a failure to pay the prescribed maintenance fee and / or additional fees within the prescribed period in respect of a standard patent (R) application (sections 29(5) and 33(2)&(4) of the Ordinance);
 - (f) a failure to claim or restore a priority right for standard patent (O) and short-term patent applications within the prescribed period (sections 37D, 37E and 37ZD(3) of the Ordinance (for standard patent (O) applications); sections 110A, 111 and 123(3) of the Ordinance (for short-term patent applications));
 - (g) a failure to file or withdraw a missing description or drawing and / or the relevant documents within the prescribed time limits for standard patent (O) and short-term patent applications (sections 37N, 37O and 37ZD(3) of the Ordinance (for

standard patent (O) applications); sections 114A, 114B and 123(3) of the Ordinance (for short-term patent applications));

- (h) a failure to file divisional applications within the prescribed time limits (sections 22 and 29(5) of the Ordinance (for standard patent (R) applications); sections 37Z and 37ZD(3) of the Ordinance (for standard patent (O) applications); sections 116 and 123(3) of the Ordinance (for short-term patent applications)); and
- (i) a failure to amend or withdraw a patent application within the prescribed time limits (sections 29(5), 31(1), 32(1) and 36 of the Ordinance (for standard patent (R) applications); sections 37X(2)(a), 37ZA, 37ZB and 37ZD(3) of the Ordinance and section 31ZT of the Rules (for standard patent (O) applications); sections 120, 121, 122 and 123(3) of the Ordinance (for short-term patent applications)).

Restoration of priority right

14.36 If a standard patent (O) or short-term patent application, which seeks to claim priority based on a previously filed corresponding patent application, is not filed within 12 months after the date of filing of the earlier application, the applicant may still apply for restoration of priority provided that the subsequent patent application is filed no later than 14 months after the date of filing of the earlier application (sections 37D (for standard patent (O) applications) and 110A (for short-term patent applications) of the Ordinance).

14.37 The restoration application must be filed with the Registrar in Patents form OP5 and accompanied by the following-

- (a) a complete statement of priority;
- (b) evidence to establish the reasons for failing to file the subsequent patent application before the expiry of the said 12-month period;
- (c) evidence to satisfy the Registrar that the applicant failed to do so even though all reasonable care required by the circumstances has been taken (please refer to section 14.42 of these Guidelines regarding the test on what constitutes reasonable care); and
- (d) the prescribed fee.

(section 37D of the Ordinance and section 31B(2) of the Rules (for standard patent (O) applications); section 110A of the Ordinance and section 68B(2) of the Rules (for short-term patent applications))

14.38 The restoration application must be filed before the earlier of the following periods:

- (a) the end of 2 months after the expiry of the 12-month period;

(b) the date on which preparations for publication of the standard patent (O) application or short-term patent to be granted are completed.

(sections 37D(3) (for standard patent (O) applications) and 110A(3) (for short-term patent applications) of the Ordinance)

14.39 If the restoration application is not accompanied by the required supporting evidence (see items 14.37(b) and (c) above), such evidence must be filed within a period as specified by the Registrar. If the evidence is not so filed, the restoration application will be regarded as being withdrawn (sections 31B(3) & (5)(a) (for standard patent (O) applications) and 68B(3) & (5)(a) (for short-term patent applications) of the Rules).

14.40 If the restoration application is approved by the Registrar and where the previous application based on which a priority right is restored is a non-Hong Kong SAR application, the applicant must file the following supporting documents within a period as specified by the Registrar—

(a) a copy of the previous application;

(b) a copy of the certificate issued by the authority that received the previous application stating the date of filing of the previous application; and

(c) translation documents (as required)

(sections 31B(6) & (8) (for standard patent (O) applications) and 68B(6) & (8) (for short-term patent applications) of the Rules)

14.41 On the other hand, if the previous application is a Hong Kong SAR application, the copy of the previous application and the copy of the certificate are to be regarded as having been filed in due time (sections 31B(7) (for standard patent (O) applications) and 68B(7) (for short-term patent applications) of the Rules).

Meaning of reasonable care

14.42 In considering whether all reasonable care has been taken by the applicant in complying with a time limit, the Registrar will consider the individual facts of each case. Generally, the standard of having exercised “reasonable care” can be met if the applicant has taken all measures which a notional reasonably competent applicant would have employed in all the relevant circumstances.

14.43 For instance, an applicant is expected to have an effective and reliable system in place to ensure timely payment of the relevant official fees, and that the failure to pay in a particular case was an isolated incident.

14.44 On the other hand, the following reasons are unlikely to be considered satisfactory:

- (a) “The applicant does not have knowledge of the application procedures in order to be able to timely file the required document.”
- (b) “The applicant failed to pay the relevant fees due to financial constraints.”
- (c) “The required documents for the application were not filed in a timely manner due to increased workload and / or lost files.”
- (d) “The proprietor, relying on the professional assistance of an agent, has failed to pay sufficient attention to payment reminders from the agent.”
- (e) “The failure to timely file a required document was due to scheduled absence from the office (e.g. vacation or medical appointment).”

Missing parts of the description or drawings (for standard patent (O) and short-term patent applications only)

- 14.45 If parts of the description, or drawings referred to in the description or in the claims for a standard patent (O) or short-term patent application, appear to be missing, the applicant may, on his own initiative or as required by the Registrar, file a missing description or missing drawing in the prescribed manner within the prescribed time (sections 37N (for standard patent (O) applications) and 114A (for short-term patent applications) of the Ordinance).
- 14.46 During the formality examination, the Registrar may request the applicant, by notice, to file the missing parts within 2 months after the date of the notice which is extendable for 2 months provided that such extension is requested before the initial deadline for filing the missing parts (sections 31X(1)(a) and 100AAB(2)(a)&(3)(b) of the Rules (for standard patent (O) applications); sections 67B(1)(a) and 100AAB(2)(a)&(3)(b) of the Rules (for short-term patent applications)).
- 14.47 Alternatively, if the applicant notices the omission in the patent application, the applicant may initiate filing the missing parts within 2 months after the accorded date of filing of the application and such period is extendable for 2 months provided that such extension is requested before the initial deadline for filing the missing parts (sections 31X(2)(a) and 100AAB(2)(a)&(3)(b) of the Rules (for standard patent (O) applications); sections 67B(2)(a) and 100AAB(2)(a)&(3)(b) of the Rules (for short-term patent applications)).
- 14.48 If the applicant fails to file the missing parts within the prescribed period, all references to the missing parts will be regarded as being deleted (sections 37O(1) (for standard patent (O) applications) and 114B(1) (for short-term patent applications) of the Ordinance).
- 14.49 If the missing description or missing drawing is filed within the prescribed period but later than the date of filing as accorded to the patent application, such date of filing

is to be changed to the date on which the missing description or missing drawing was filed (sections 37N(3) (for standard patent (O) applications) and 114A(3) (for short-term patent applications) of the Ordinance).

14.50 However, if the missing description or missing drawing is filed within the prescribed period but later than the accorded date of filing of an application, and the application claims priority of a previous application, such date of filing shall remain unchanged provided that certain conditions are fulfilled (sections 37N(5) (for standard patent (O) applications) and 114A(5) (for short-term patent applications) of the Ordinance).

14.51 For the purposes of section 14.50 of these Guidelines, the conditions that need to be fulfilled are:

(a) the missing description or missing drawing is completely contained in the previous application;

(b) the applicant makes a request to retain the originally accorded date of filing; and

(c) the applicant files the following within 16 months after the earliest date of priority claimed (extendable for 2 months provided that such extension is requested before the initial deadline for filing such documents)—

(i) a copy of the previous application³; and

(ii) a statement indicating the location of the description or drawing in the previous application.

(section 37N(5) of the Ordinance, sections 31X and 100AAB(2)(a)&(3)(b) of the Rules (for standard patent (O) applications); section 114A(5) of the Ordinance, sections 67B and 100AAB(2)(a)&(3)(b) of the Rules (for short-term patent applications))

14.52 Where the Registrar has issued a notice of change of the date of filing of a patent application for the reason as set out in section 14.49 above, the applicant may withdraw the filed missing description or missing drawing within 1 month after the date of the notice (sections 37O(2) (for standard patent (O) applications) and 114B(2) (for short-term patent applications) of the Ordinance).

14.53 If the applicant opts to withdraw the subsequently filed missing parts, the original date of filing of the patent application as accorded will remain unchanged with the consequence as set out in section 14.48 above (sections 37O(3) (for standard patent (O) applications) and 114B(3) (for short-term patent applications) of the Ordinance).

³ If the previous application is not in one of the official languages, (a) its translation in the language of the specification of the subsequent application and (b) a statement indicating which part of the translation represents the missing description or drawing must also be provided within the prescribed period (sections 37N(5) (for standard patent (O) applications) and 114A(5) (for short-term patent applications) of the Ordinance; section 56C of the Rules).