

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

Section 11: Double patenting

General principles

11.1 Under the *Patents (Amendment) Ordinance 2016* with the commencement date of 19 December 2019, two patents are not to be granted for one invention made by the same inventor (see section 37U(3)(e) (for substantive examination of standard patent (O) applications) and section 127C(2)(g) of the Ordinance (for post-grant substantive examination of short-term patents)) to ensure that there is no double patenting.

11.2 In this connection, our examiners must be satisfied that:

(a) (when conducting substantive examination of a standard patent (O) application) the standard patent (O) application is not one of two relevant patent applications¹ that—

(i) are filed for the same invention made by the same inventor; and

(ii) have the same material date;

(b) (when conducting post-grant substantive examination of a short-term patent) the short-term patent is not one of the two patents that—

¹ Relevant patent application means—

(a) a patent application which is pending; or

(b) a patent application because of which a patent, being one that is in force, was granted.

(See section 37U(6) of the Ordinance)

- (i) are granted for the same invention made by the same inventor; and
- (ii) have the same material date.

Same invention

11.3 The element “for the same invention” in the two relevant patent applications/the two patents in question generally refers to the patent applications/patents containing—

(a) claims of identical features; or

(b) claims differing in their wording but having the same scope in substance.

11.4 The issue on “for the same invention” must be considered on the facts of each case with regard to both independent and dependent claims.

Example

A double patenting objection will not be raised where the descriptions of two patent applications (for the same inventions made by the same inventor) both relate to a product and a process to manufacture the product but one application contains the product claim(s) whereas the other application contains the process claim(s).

Same material date

11.5 The element “same material date” means the same deemed date of filing, date of filing or date of priority, as the case may be.

Same inventor

11.6 The element “same inventor” in the two relevant patent applications/the two patents in question refers to the patent applications/patents having—

(a) the same inventor(s) regardless of whether the respective patent applicants or proprietors (as the case may be) are the same; and

(b) an inventor in common.

Example

Application 1 has the inventors A and B, application 2 has the inventor A and application 3 has the inventors A and C – all three applications are regarded as having a common inventor A and a double patenting objection may be raised if the other elements (i.e. same invention and same material date) are also present.

Overcoming double patenting objection

11.7 A double patenting objection may be overcome by, for example, amending one of the relevant patent applications/patents to distinguish the inventions from each one (subject to compliance with the requirements on amendment under section 103 of the Ordinance), or choosing one of the relevant patent applications to proceed and abandoning/withdrawing the other relevant patent application. However, a double patenting objection cannot be overcome by surrendering the granted patent as cited in the objection since such surrender will not have retrospective effect (IBM Corporation (Barclay and Biqar's) Application [1983] RPC 283).