

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

Section 16: Amendments to Patent Applications and Patents

Overview

16.1 An amendment to the specification of a patent application or patent may be necessary to avoid or overcome an objection or challenge to the patent application or the validity of the patent on the basis of, for instances, lack of novelty and/or lack of inventive step in the underlying invention.

Pre-grant amendments

16.2 A pre-grant amendment takes effect from the time the amendment is made.

16.3 All applications for pre-grant amendments must be made to the Registrar (section 31(1) of the Ordinance and section 27(1) of the Rules (for standard patent (R) applications); section 37ZA(1) of the Ordinance and section 31ZT(1)(d) of the Rules (for standard patent (O) applications); section 120(1) of the Ordinance and section 75(1)(d) of the Rules (for short-term patent applications)).

Post-grant amendments

16.4 A post-grant amendment has effect as from the date of grant of the patent (sections 43(4) (for standard patents (R)), 46(9) (for all types of patents except for short-term patents in respect of which substantive examination certificates have not been issued), 102(3) (for all types of patents in infringement and revocation proceedings before the court) and 127E(5) (for short-term patents for which requests for substantive examination have been made) of the Ordinance).

16.5 An application for post-grant amendment to a standard patent (R) must be made to the court (sections 46(2)(a) and 102 of the Ordinance) except for an application for post-grant amendment to a standard patent (R) following post-grant opposition proceedings in the EPO which must be made to the Registrar (section 43 of the Ordinance).

16.6 In respect of a standard patent (O), an application for post-grant amendment to the patent—

- (a) *(in infringement or revocation proceedings before the court)* must be made to the court (section 102 of the Ordinance);
- (b) *(in other cases)* may be made either to the court or to the Registrar (section 46(2)(b) of the Ordinance).
- 16.7 In respect of a short-term patent, an application for post-grant amendment to the patent —
- (a) *(in infringement or revocation proceedings before the court)* must be made to the court (section 102 of the Ordinance);
- (b) *(where the patent has not undergone post-grant substantive examination)* must be made to the Registrar together with filing a request for post-grant substantive examination with the Registrar (section 127B(1)(b) of the Ordinance; section 81P(2)(c) of the Rules);
- (c) *(where the patent is under post-grant substantive examination by the Registrar)* must be made to the Registrar (section 127D(3) of the Ordinance; section 81P(2)(c) of the Rules);
- (d) *(where a certificate of substantive examination has been issued for the patent)* may be made to the court or the Registrar (section 46(2)(c) of the Ordinance).
- 16.8 In respect of an application to the Registrar for post-grant amendment under section 46 of the Ordinance to ~~a standard patent (R)~~, a standard patent (O) or a short-term patent in respect of which a certificate of substantive examination has been issued, ~~no such amendment is allowed by~~ the Registrar may not allow such amendment where there are pending before the court proceedings in which the validity of the patent may be put in issue (section 46(6) of the Ordinance).

Applications for pre-grant/post-grant amendments to the Registrar

- 16.9 A patent applicant or proprietor may, in appropriate circumstances, file a request for amendment to a patent application or patent of his own volition or otherwise with the Registrar in accordance with the statutory requirements.
- 16.10 A request to the Registrar for a pre-grant amendment must be made in the specified form clearly identifying the proposed amendment and stating the reasons for such amendment (section 31(1) of the Ordinance and section 27 of the Rules (for standard patent (R) applications); section 37ZA(1) of the Ordinance and section 31ZT(1) of the Rules (for standard patent (O) applications); section 120(1) of the Ordinance and section 75(1) of the Rules (for short-term patent applications)).
- 16.11 A request to the Registrar for a post-grant amendment must be made in the specified form and be accompanied by:
- (a) a copy of the specification incorporating the requested amendment; and