

**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).

- (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 for 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 be heard~~ 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 ~~offer the applicant a right to be heard~~ (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 ~~for~~ 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).

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 ~~for 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 ~~to that effect~~, 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 be heard~~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 ~~offer the proprietor a right to be heard~~ 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 ~~applicant proprietor~~ 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 ~~for~~ 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—