



**FREEDOM OF INFORMATION ACT
Section 15 and 16 Reference Book**

Guide to the Functions, Records, Rules and Practices of the Patents Office.

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INTRODUCTION

This Reference Book is compiled in accordance with the Sections 15 and 16 of the Freedom of Information Act 1997, as amended by the Freedom of Information Act 2003. All references in this manual to the Freedom of Information Act or Acts refer to the 1997 Act as amended by the 2003 Act.

The Freedom of Information (FOI) Acts, effective from 21st April 1998, establish three new statutory rights:

- a legal right for each person to access information held by public bodies;
- a legal right for each person to have official information relating to him/herself amended where it is incomplete, incorrect or misleading; and
- a legal right to obtain reasons for decisions affecting oneself.

The Acts assert the right of members of the public to obtain access to official information to the greatest extent possible consistent with the public interest and the right to privacy of individuals.

Purpose of Reference Book

This reference book has been prepared and published in accordance with the requirements of Sections 15 and 16 of the FOI Acts.

In accordance with **Section 15** of the Act, this reference book facilitates access to official information held by the Patents Office, by outlining the structure and functions of the Office, details of the services provided and how they may be availed of, information on the classes of records held, and information on how to make a request to the Office under the Freedom of Information Acts, 1997 and 2003.

Section 16 of the FOI Act requires the Patents Office to publish a manual containing information about the rules, procedures, practices, guidelines and interpretations used by the Office, and an index of any precedents kept, for the purposes of decisions under any enactment or scheme administered by the Office, with respect to:

- rights, privileges, benefits, obligations, penalties or other sanctions to which members of the public are or may be entitled,
- appropriate information in relation to the manner or intended manner of administration of any such enactment or scheme.

Part 1 - Access to Information

1.1. Routinely Available Information

The Patents Office currently makes a considerable amount of information available to the public in relation to its functions and activities including particulars of published applications and access to the Registers of Patents, Trade Marks and Designs. The publication of this information is, in fact, required by the legislation which governs the operations of the Patents Office. Access to a great deal of information is possible via the Office's website www.patentsoffice.ie, through the Official Journal published fortnightly and there are certain rights of inspection contained in the legislation. In certain cases Rules apply to the manner and timing of public access to this information and fees are also payable in relation to certain matters.

Appendix 4 contains details of the services and information provided by the Patents Office. General information on the Office and its work is also contained in the Controller's Annual Report which is available on the Office's website.

The main Acts and Rules under which the Office operates are listed at Appendix 1 and can be accessed via the Office's web site under the "legislation" section. Copies of all intellectual property legislation may be obtained from:

**The Government Publications Sales Office,
Telephone: 01-6710309, Fax: 01-4752760**

The Office of the Attorney General also maintains an on-line database of Irish legislation, which is available on the Internet at www.irishstatutebook.ie

The FOI Act is designed to allow public access to information held by public bodies which is NOT normally made available through other sources. Access to this kind of information is provided for under the FOI Act and is subject to certain exemptions and involves specific procedures and time limits. The Patents Office is disposed to conduct its business in as open and transparent a manner as possible. It will, therefore, make available whatever information it possibly can, without requiring people to have resort to the formal procedures of the Freedom of Information (FOI) Acts.

Part 2 (6) also lists the 'Classes of Records', held by the Office. Because much of the information contained in these records is publicly available, it may not be necessary in all cases to use the FOI Acts to access information held in these records. In setting out the classes of records held, this manual distinguishes between records containing information which can be made available by the Patents Office in accordance with patents, trade marks, copyright and designs legislation and records held by the Patents Office, the disclosure of which is not provided for under patents, trade marks and designs legislation. Appendix 4 should be consulted for a summary of the services and information which is made available by the Office under the relevant intellectual property legislation.

In case of doubt, persons seeking information should contact the Office's FOI Officer (see Section 1.2. below).

1.2. Applications under the FOI Acts

An application under the FOI Acts for access to information not otherwise made available by the Office under the legislation it administers should be addressed to:

Mr. David Hyde
Freedom of Information Officer
Patents Office
Government Buildings
Hebron Road
Kilkenny

| | |
|--|--|
| Telephone: | (056) 7720111 |
| Lo-Call Telephone Service to Kilkenny (available within Ireland if calling outside the (056) area): | 1890 220223 |
| Fax: | (056) 7720100 |
| Lo-Call Fax Service to Kilkenny (available within Ireland if calling outside the (056) area): | 1890 220120 |
| e-mail | david.hyde@patentsoffice.ie patlib@patentsoffice.ie |

1.3 Compiling your application

- (i) Your application should be in writing and, if applicable, accompanied by the appropriate fee (see "fees" below). The relevant fee should be paid by Bank Draft, Money Order, Postal Order or cheque drawn on a bank in the Republic of Ireland, made payable to "The Patents Office".

You may use the form entitled 'Request for Information under the Freedom of Information Acts' (see Appendix 1). This form is available from the FOI Officer and from the Office's web site. If you are not using the form outlined above, then your application should clearly indicate that the information is sought under the Freedom of Information Act.

- (ii) If you require a reply in a particular format i.e. photocopy, computer disk, etc. please mention this in your application.
- (iii) Please be as detailed and as specific as possible when compiling your application as this will assist in dealing with it. It can also result in lesser charges being incurred on search and retrieval in cases where these fall to be paid. Where possible please try to indicate the time period for which you wish to access records e.g. records created between May 1998 and December, 1998. If you have difficulty in identifying the precise records which you require, the FOI Officer will be happy to assist you in preparing your request.
- (iv) Please include a daytime telephone number, if possible, so that you may be contacted quickly if it is necessary to clarify details of your request.

1.4 Assistance to persons with a disability

The Freedom of Information Officer in the Patents Office is available to provide assistance to persons with a disability to exercise their rights under the FOI Act (e.g. accepting oral requests from requesters who are unable to read, print and/or write due to their disability, enabling the requester to inspect or have records explained to him or her).

1.5 FOI Decision Making in the Patents Office

Receipt of an FOI application is acknowledged not later than 2 weeks following receipt. Decisions on applications are made by nominated officers (at a level not below Higher Executive Officer) known as FOI Decision Makers. Internal Appeal decisions are made by nominated officers of a higher grade. The Patents Office will normally be obliged to respond to an FOI request within 4 weeks. A week is defined in the Act to mean 5 consecutive weekdays, excluding Saturdays and public holidays (Sundays are also excluded, as they are not week days).

1.6. Rights of Review and Appeal under the FOI Act

The Act sets out a series of exemptions to protect sensitive information where its disclosure may damage key interests of the State or of third parties. Where the Patents Office invokes these provisions to withhold information, the decision may be appealed. Decisions in relation to deferral of access, charges, forms of access, etc. may also be the subject of appeal. Details of the appeals mechanisms are set out in paragraphs 1.7 and 1.8.

1.7 Internal Review

You may seek internal review of the initial decision which will be carried out by an official at a higher level if:

- (a) you are dissatisfied with the initial response received i.e. refusal of information, form of access, charges, etc. or
- (b) you have not received a reply within four weeks of your initial application. This is deemed to be a refusal of your request and allows you to proceed to internal review.

Request for internal review should be submitted in writing to:

**Mr. Gerard Barrett
Controller
Patents Office
Government Buildings
Hebron Road
Kilkenny**

Phone: (056) 7720189

Fax: (056) 7720100

The relevant fee should be paid by Bank Draft, Money Order, Postal Order or cheque drawn on a bank in the Republic of Ireland, made payable to 'The Patents Office'.

Such a request for internal review must be submitted within 4 weeks of the initial decision. The Office must complete the review within 3 weeks. Internal review must normally be completed before an appeal may be made to the Office of the Information Commissioner.

1.8. Review by the Information Commissioner

Following completion of the internal review, you may seek independent review of the decision from the Information Commissioner. Also if you have not received a reply to your application for internal review within 3 weeks, this is deemed to be a refusal and you may appeal the matter to the Information Commissioner.

Appeals in writing, and, if applicable, accompanied by the appropriate fee, (see under Fees below) may be made directly to the Information Commissioner at the following address:

Office of the Information Commissioner
18 Lower Leeson Street,
Dublin 2

Telephone: 01-6395689
Fax: 01-6395676
E-mail: info@oic.ie
Website: <http://www.oic.ie>

1.9 Fees

There is no application fee required when requesting information under the FOI Act 2014. However if your request is for non-personal information, where the estimated SRC (search, Retrieval & Copying fees) is in excess of the 'appropriate minimum amount' provided for in Section 37(3)(d), charging of the SRC is mandatory. A deposit is payable where the estimated cost of search and retrieval of records sought is estimated to exceed 'appropriate minimum amount'. In such a case, every effort will be made to assist the requester to amend the request so as to reduce or eliminate the amount of the deposit.

The relevant fee should be paid by EFT, Money Order, Postal Order or cheque drawn on a bank in the Republic of Ireland, made payable to "The Patents Office".

Search and Retrieval and Copying Fees

Fees also apply in respect of the time spent searching and retrieving records that are released to you on foot of your request and in respect of the copying of any records released. Such fees are unlikely to arise if your request is for personal information. The rates of these fees are as follows:

- €20.95 per hour of search and retrieval
- €0.04 per sheet for a photocopy
- €0.51 for a three and a half inch computer diskette containing copy documents
- €10.16 for a CD-ROM containing copy documents
- €6.35 for a radiograph (X-ray) containing copy documents

Reductions and Waivers

A fee in respect of search and retrieval and copying of records will be waived where the cost of collecting and accounting for the fee would exceed the amount of the fee itself (a guideline of less than €10 is used in this respect);

A fee in respect of search and retrieval and copying of records or a deposit may be reduced or waived where the information in the record would be of particular assistance to the understanding of an issue of national importance.

A charge applies to most internal and independent reviews (Information Commissioner) concerning access to non-personal records. There is a reduction for medical card holders. These will be notified to you at the appropriate time by the relevant public body.

Right of Appeal

If you are unhappy with the decision which is made on your request, you can appeal it by making an application for an internal review. A fee of €30 (€10 for medical card holders and their dependents) applies to requests for an internal review of a decision on a non-personal request. There is no fee for an internal review of a request for personal information or in the case of a late decision on a non-personal request.

1.10 Policy statement on confidentiality.

The Patents Office undertakes to use its best endeavours to hold confidential any information provided by persons corresponding with the Office, subject to the Office's obligations under the law including the Freedom of Information Act.

As well as containing provisions which oblige the Office to "publish" (make available to the public) certain information, the patents, trade marks and designs legislation also contains various secrecy provisions and references to privileged communications which prohibit the release of information or allow the release of certain information only in accordance with prescribed rules and time limits. These provisions will continue to operate.

Excepting the information about patent, trade mark or design applications which the Controller is required by law to publish, persons who provide certain other information or documents to the Patents Office have a right to request the Controller that these be not disclosed (for instance if the information is of a sensitive nature), and the Controller may be obliged to treat such information as confidential. Normally, the person or body will, when supplying the information, indicate why it is to be treated as confidential.

If a request under the FOI Act relates to any such information, it may necessitate the Office consulting with the provider of the information before making a decision on its release.

1.11 Further information on Freedom Of Information.

If you are unfamiliar with the Freedom of Information Acts and require further information, you might want to access the following resources;

- The Department of Finance [Central Policy Unit](#) has overall responsibility for FOI legislation and policy. Its website (<http://www.foi.gov.ie/>) includes copies of all the legislation, policy notices, and a detailed guide to assist decision makers.
- The Office of the [Information Commissioner](#) reports annually on the operation of the Act and publishes the text of significant FOI appeal decisions. Its website

- (<http://www.oic.gov.ie/>) includes copies of FOI legislation, a guide to the FOI Act, an index of decisions and other relevant publications.
- The Office of the [Data Protection Commissioner](http://www.dataprivacy.ie/) (<http://www.dataprivacy.ie/>) reports annually on the operation of data protection legislation and can be of assistance in relation to compliance with its requirements.

2. DESCRIPTION & FUNCTIONS OF THE PATENTS OFFICE

2.1. Legislative Background

The Patents Office was established under the Industrial and Commercial Property (Protection) Act 1927. It is an independent statutory office under the control of the Controller of Patents, Designs and Trade Marks. The Controller is appointed by the Government. The provision of the staff and resources of the Office are functions of the Minister for Jobs, Enterprise and Innovation (in consultation with the Minister for Finance, in so far as staff numbers are concerned).

Since 1993, the Intellectual Property Unit of the Department of Enterprise, Trade & Employment, which was created at that time, has had responsibility for certain legislative and policy matters relating to intellectual property. The Patents Office provides input in the drafting of legislation and in the formulation/implementation of policy in relation to the development of the system of intellectual property protection.

2.2 Principal statutory functions

The statutory functions of the Controller are set out in the Industrial and Commercial Property (Protection) Acts, 1927-1958; the Patents Act, 1992; the Trade Marks Act, 1996; the Industrial Designs Act, 2001; and the Statutory Rules and Regulations made under these Acts and the European Communities (Supplementary Protection Certificate) Regulations, 1993. Decisions under the relevant Acts, Rules and Regulations rest with the Controller in his statutory capacity, subject to certain rights of appeal to the High Court.

A comprehensive list of applicable national intellectual property legislation is at Appendix 1. Appendix 2 lists relevant EU legislation and Appendix 3 lists the main international agreements and treaties in the area of intellectual property protection.

The Controller has a limited number of statutory functions under the Copyright and Related Rights Act, 2000 relating to copyright licensing disputes and the maintenance of registers of licensing bodies.

The principal statutory functions of the Office can be summarised as follows:

- the granting of patents;
- the registration of industrial designs and trade marks;
- providing information in relation to patents, designs and trade marks;
- certain limited functions under the Copyright & Related Rights Act 2000 in relation to the registration of copyright licensing bodies and copyright disputes.

2.3 Mission Statement

The central mission of the Patents Office is:

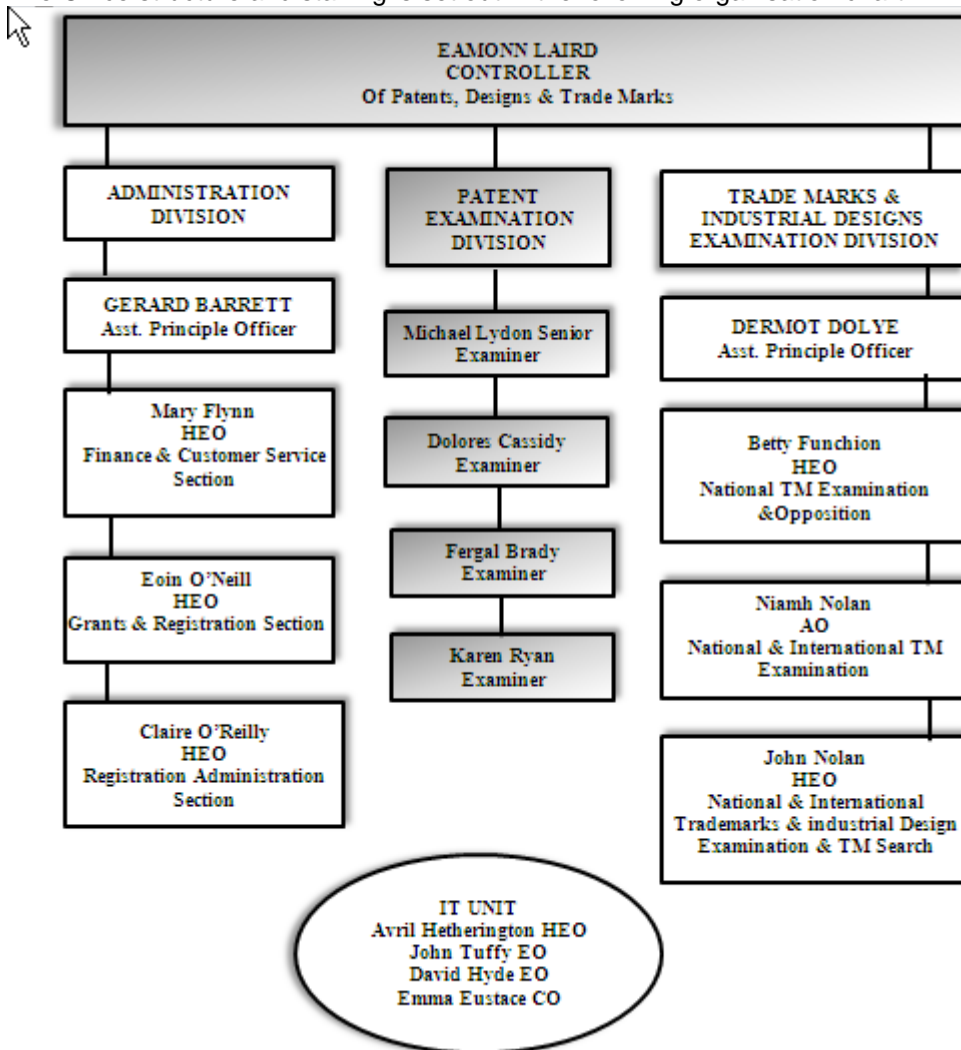
“To provide an efficient and effective system of industrial property protection that will encourage technological progress and promote enterprise through implementation by the Office of the relevant legislation”.

This is to be achieved through the protection of industrial property rights in the fields of patents, trade marks and designs, and the dissemination of relevant knowledge in conjunction with each of these activities.

2.4 Structure & Organisation

The head of the Patents Office is Gerard Barrett, the Controller of Patents, Designs and Trade Marks.

The Office structure and staffing is set out in the following organisation chart.



IT Services

*The provision of Information Technology services in the Patents Office is the responsibility of the Information Technology & Business Services Unit of the Department of Jobs, Enterprise and Innovation. There are 4 staff members of the Department of Jobs Enterprise, and Innovation (1 HEO, 1 EO and 1 CO) working in the Office providing information technology services.

2.5 Staff

STAFF SERVING AT 31 DECEMBER 2011

| <u>Number of posts</u> | <u>Staff</u> |
|----------------------------|--------------------------|
| 1 | Controller |
| 2 | Assistant Principal |
| 1 | Senior Patent Examiner |
| 4 | Higher Executive Officer |
| 1 | Administrative Officer |
| 3 | Patent Examiner |
| 16 | Executive Officer |
| 1 | Staff Officer |
| 19 | Clerical Officer |
| 1 | Services Officer |
| 49* | |

* Includes fifteen staff (2 Higher Executive Officers (HEOs), 8 Executive Officers (EOs) and 5 Clerical Officers (COs)) who availed of a work-sharing scheme which permits a variety of attendance patterns. Four staff availed of a teleworking scheme which permits staff to carry out their duties from home for part of the week.

2.6 Administration Division

ROLE OF DIVISION

Core Functions:

- Administrative tasks associated with the filing, processing and grant/registration of patent, trade mark and design applications.
- Maintenance of patents, supplementary protection certificates, trade marks and designs.
- Compilation and maintenance of Patents & Trade Marks and Design Registers
- Compilation and maintenance of Registers of Patent and Trade Mark Agents
- Making information available to the public regarding intellectual property and developing the library and information service provided by the Office including the Patents Office WEBSITE.
- Ensuring the Office fulfils the functions and obligations assigned to it in relation to the European Patent Convention (EPC) and the Patent Co-operation Treaty (PCT) including performing the functions of a Receiving Office in relation to processing European patent applications, PCT applications and applications for International Registrations of trademarks (Madrid Agreement).
- Management of financial and budgetary matters including maintenance of financial records and the preparation of estimates.
- Development and management of tasks associated with personnel matters, staff training and accommodation.
- Publication of the Official Journal, Controller's Annual Report and other information material.
- Representing the Office at European Patent Office meetings and other appropriate international meetings and conferences.
- Preparation and co-ordination of statistical and management information reports.
- Providing analysis, comment and advice to the Controller on EU, international and national legislative proposals on intellectual property matters.

- Assisting in relation to the copyright dispute functions of the Controller and new functions assigned to the Controller under the Copyright and Related Rights Act, 2000.

STRUCTURE OF ADMINISTRATION DIVISION

| | |
|--|--|
| Gerard Barrett (Principal Officer) | |
| Finance & Customer Services Section Mary Flynn HEO | Grants & Register Administration Section (including Copyright) Claire O'Reilly HEO |

The main functions of each section are summarised as follows:

| Name of Section | Summary of Main Functions |
|--|---|
| <u>Finance & Customer Services</u> | <p>Key-in and receipt of all monies received by the Office including fees received via the online payments system.</p> <p>Data key-in of patent, trade mark and design applications.</p> <p>Management of financial and budgetary matters including maintenance of all financial records and the preparation of accounts; preparation of estimates.</p> <p>Preparation and publication of Annual Report and other intellectual property information booklets.</p> <p>Dissemination of information on intellectual property rights.</p> <p>Development and maintenance of Office website.</p> <p>Dealing with queries from the public.</p> <p>Dealing with FOI queries.</p> <p>Provision of office services including management of stationery stocks, filing, file management and maintenance of file room.</p> <p>Management of office equipment (excluding computers and printers)</p> <p>Building management and accommodation.</p> <p>Maintenance of Asset register.</p> <p>Health and safety issues.</p> <p>Personnel issues and general administrative tasks relating to the Office.</p> <p>Internal staff training.</p> <p>Scanning of patent documents and trade mark images/devices.</p> <p>Post handling.</p> <p>Staffing and management of Kilkenny Information Centre</p> |

| Name of Section | Summary of Main Functions |
|-----------------|---------------------------|
|-----------------|---------------------------|

| | |
|--|--|
| <p><u>Grants & Register Administration</u></p> | <p>Formality checks on patent applications and issuing defect letters. Processing the withdrawing of patent applications, Requesting payment of grant and registration fees. Issuing patent grant documents and Supplementary Protection Certificates (SPC's) following completion of the examination process. Processing the withdrawing of trademark applications. Registration of trade marks and industrial designs following completion of the examination process (including the issuing of certificates of grant and of registration). Recording of international trade marks protected in the state. Forwarding international applications to the relevant international body/office (EPO, OHIM, WIPO). Production of published patent applications and specifications. Caveats. Production of the Patents Office Journal. Compilation and production of statistics. Co-ordination and implementation of measures aimed at the clean-up of the Offices databases. Assisting in relation to the copyright functions of the Controller including the registration of copyright licensing bodies and maintenance of said register. Registration of Patent Agents. Registration of Trade Mark Agents. Responsibility for the maintenance of the Patents, Trade Marks and Designs Registers including the recordal of assignments and other security interests, licenses, addresses for service, and receipt of translations of European Patents etc. Management of renewal payments for patents, trademarks, designs and SPC's including renewal of European patents validated in Ireland and the remitting of 50% of those renewal fees to the EPO. Issuing of reminders and overdue reminders in respect of the payment of renewal fees. Issuing of renewal certificates. Post-registration procedures for trade marks including processing of removals, change of address for service, change of name/address of proprietor, etc. Processing of notifications received via MECA download and paper from WIPO in respect of international trademarks. Dealing with requests for rectification of data concerning patents and trademarks contained in the patent and trade mark registers. Voiding of European Patents Processing applications for the restoration of lapsed Patents Issuing of certified copies and certified extracts Processing of Caveat requests in respect of patents</p> |
|--|--|

The main classes of records held in Administration Division are:

- Patent, trade mark & design application files.
- General administration files (see below).
- Supplementary Protection Certificate application files.
- Copyright files.
- Patent, trade mark, design and copyright registers.
- Registers of patent and trade mark agents
- Registers of copyright licensing bodies

General administrative records

Apart from the records of the Office comprising specific patent, design and trade mark applications in numbered series, a series of general files called "PAT" files was in use up until 21 April 1998. This was a numbered series of files, which kept track of correspondence mostly on the day-to-day administration of the Office. Thus, there are PAT files on subjects such as annual financial estimates; financial procedures; computerisation; drafting of legislation; the registration of patent/trade mark agents; compilation of Controller's Annual Report; correspondence with Association of Patent and Trade Mark Agents; correspondence with individual agents; correspondence with members of the public, etc. This file series is no longer active.

Because the FOI Act (Section 6) applies only to records created after the commencement of the Act, a new record/file administration system was put in place to enable such records to be easily identified. This system replaced the existing "PAT" file system and largely comprises files relating to general administrative matters. Details of all new files or records opened after 21 April 1998, may be obtained on request at the Information Centre. Records on the following topics are held (the list below is indicative only as further file series are regularly created):

- Estimates
- Budget & Finance
- Travel & Subsistence
- Office Procedures & Organisation
- Statistics / Reports
- Legislation
- Legal cases
- Patent Revocations
- Accommodation / Office Infrastructure
- Information Technology
- European Patents Office
- European/International Liaison
- Patent Agents Register / Trade Marks Agents Register
- Customer Services/Complaints/Users
- Industrial Designs
- Licences of the Trade Marks database
- Office Practice and Procedures – Trademarks
- Certification Trade Marks
- Trade Mark Appeals
- Trade Mark Applications
- Trade Mark Court Cases – except appeals
- Trade Mark Opposition
- Trade Mark Registrable Transactions
- Trade Mark Rectification and Revocation
- Strategic Planning
- Copyright
- Freedom of Information
- Information Centre
- Online access to databases
- Personnel

- Patent Examination Practice
- Patent litigation Costs
- Recognition of Qualifications
- PTOLEMY

LEGISLATION – RULES, REGULATIONS and PROCEDURES

The legislation to be observed by the Division and its sections in carrying out its administrative functions are contained in the applicable intellectual property legislation (Acts and Rules) under which the Patents Office operates. The Principal Acts and Rules applied by Administration Division are as follows:

- Patents Act, 1992 (No. 1 of 1992)
- Patents (Amendment) Act 2006 (No.31 of 2006)
- Patents Rules, 1992 (S.I. No. 179 of 1992)
- European Communities (Supplementary Protection Certificate) Regulations, 1993 (S.I. No. 125 of 1993).
- European Communities (Supplementary Protection Certificate) (Amendment) Regulations, 2001 (S.I. No. 648 of 2001)
- The Industrial Designs Act 2001 (No.39 of 2001)
- The Industrial Designs Regulations 2002 (S.I. No.280 of 2002)
- Trade Marks Act 1996 (No. 6 of 1996)
- Trade Marks Rules 1996 (S.I. No. 199 of 1996)
- Trademark Amendment Rules - S.I. 621 of 2007
- Trade Marks (Madrid Protocol) Regulations 2001 SI No. 346 of 2001
- Patents, Trade Marks and Designs (Fees) Rules, 2001 (S.I. No. 482 of 2001)
- Industrial Designs (Amendment) Regulations 2004 (S.I. 574 of 2004).
- The European Communities (Community Designs) Regulations 2003. (S.I. No. 27 of 2003)
- Copyright and Related Rights Act 2000 (No.28 of 2000)
- Copyright and Related Rights (Register of Copyright Licensing Bodies)Regulation, 2002 (S.I. No. 463 of 2002.
- Copyright and Related Rights (Proceedings before the Controller) Rules 2009 - S.I. 20 of 2009
- Copyright and Related Rights (Register of Licensing Bodies for Performers' Property Rights) Regulations 2008 - S.I. No 306 of 2008
- The European Communities (Patent Agents) Regulations 2006 (S.I. No. 141 of 2006)
- Patents (Amendment) Rules 2006S.I. No 142 of 2006
- European communities (Provision of services Concerning Trade Marks & Industrial designs) regulations 2007 (S.I. No. 266 of 2007)
- Trade Marks (Amendment) Rules 2007 (S.I. No. 621 of 2007)
- European Communities (Provision Of Services Concerning Trade Marks And Industrial Designs) Regulations 2007 (SI No 622 Of 2007)

A comprehensive list of intellectual property legislation is at Appendix 1,2 and 3. and in the legislation section of the Office website www.patentsoffice.ie

From time to time the Controller may issue communications (usually to the Association of Patent & Trademark agents) regarding Office practice in relation to the operation of the various Acts and Rules. Such communications are usually published in the Official Journal.

RELEVANT DOCUMENTATION / PUBLICATIONS

- Annual Reports of the Controller of Patents, Designs and Trademarks.
- Patents Office Journal
- Patents Office Customer Action Plan 2002-2005
- Patents Office Statement of Strategy 2004-2007

- Information Booklets (on Patents for Inventions, Trademarks, Industrial designs & Copyright) published by the Irish Patents Office, WIPO, the European Patents Office (EPO), and The Organisation for the harmonisation of the Internal market (OHIM)
- LIIP (Linking Innovation and Industrial Property) Intellectual Property Good Practice Guide & CD.

Whilst the Patents Office library continues to maintain an extensive paper document collection comprising Irish, European (EP), International (PCT) and British published applications, its electronic database of patent information has grown considerably in recent years. The library now houses an extensive collection of several thousand CD-ROMs and DVD's containing several of the ESPACE series of disks produced by the European Patent Office (EPO) comprising information on EP, PCT and GB patents, the USAPat series from the US Office, the PAJ series from Japan and the GlobalPat first page series. These disks contain bibliographic data, text-searchable abstracts, allow cross-referencing to EP and PCT patents, and may be accessed directly by visitors to the library. There is also a facility to search Community Trade Marks by searching through Marquesa CD-ROMs. These CD-ROMs are updated on a monthly basis. International Trade Marks are available via a ROMARIN DVD publication from WIPO. Copies of the Patents Office Official Journal (online or on paper) together with Gazettes and Bulletins issued by the EPO, WIPO and OHIM (on CD ROM) are also available for consultation.

Appendix 4 contains a list of the principal databases available in the Library. This list is indicative as new publications are regularly added.

In addition to these databases, the library contains many legal and technical works of interest to inventors and those interested in patents, designs and trade marks.

A computerised patents and trade marks search facility is also available via the Office's computer system, whereby details of Irish patent applications and granted specifications, pending and registered marks are available for inspection either in person at the Office in Dublin or Kilkenny or via the Office's website.

It is also possible to licence from the Controller the part of the trade mark database consisting of all trade marks (excluding device representations).

The library provides a document delivery service to patent and trade mark agents and to members of the public.

DECISIONS & PRECEDENTS - General

The legislation (see Appendix I) provides that the Controller is the sole authority in all matters relating to the grant of Patents and the registration of Trade Marks and Designs.

Decisions to grant patents or to register trade marks or designs rest with the Controller (or his staff under delegated authority) and are made on the basis of the Acts and Rules. Procedural instructions about how certain functions are to be performed, exist.

Notice of decisions taken by the Controller following hearings before him (or before a hearing officer appointed by him) on patent and trade mark matters are published in the Patents Office Journal and can be inspected online at www.patentsoffice.ie or inspected and purchased at the Patents Office. The grounds of the decisions are published and may be inspected on request at the Patents Office, Kilkenny and online at www.patentsoffice.ie.

Existing case law on matters as infringements of patents and trade marks, invalidity, opposition and revocation, etc. may be found in various legal journals and law reports (e.g. the UK Reports of Patent, Design and Trade Mark Cases (RPC), and case law of the Boards of Appeal of the EPO many of which can be accessed through the Patents Library and Information Centres

2.7 Trade Marks Examination Division

ROLE OF DIVISION

To determine the registrability of trademarks and industrial designs in accordance with the legislation in force and to perform ancillary functions.

Core functions

- Searching national and international trademark applications for conflicting marks
- Examining national and international trademark applications and national design applications to determine acceptability
- Determining opposition, revocation, rectification and invalidity proceedings
- Hearing *ex-parte* and *inter-partes* cases
- Liaison with Chief State Solicitor's Office in respect of legal proceedings affecting the registration of trademarks and designs

STRUCTURE OF DIVISION

| Dermot Doyle Assistant Principal | |
|--|--------------------|
| National & International TM Examination , Industrial Designs & Opposition | John Nolan HEO |
| National & International TM & Industrial Designs Examination | Niamh Nolan AO |
| National Trademarks, Industrial Designs Examination and Opposition | Betty Funchion HEO |

The main functions of each section are summarised hereunder:

| Name of section | Summary of Main Functions |
|---------------------------|---|
| Opposition & TM Search | <p>To conduct a search of the trade marks database of pending and registered marks and other searches when new applications for registration are filed.</p> <p>To conduct a search of Community Trade Mark applications filed with O.H.I.M. and to communicate to O.H.I.M. the results of each search report within three months of the date of receipt.</p> <p>Administrative aspects of opposition, revocation, rectification and invalidity proceedings.</p> |

| Name of section | Summary of Main Functions |
|----------------------|--|
| Examination Sections | <p>To determine the registrability of trade marks and industrial designs in accordance with the legislation in force and to perform ancillary functions.</p> <p>Examining national and international trade mark applications and national design applications to determine acceptability</p> |

CLASSES OF RECORDS HELD

The main classes of records held in the Trade Marks Division are:

- National trade mark application files.
- National industrial design application files.
- Files relating to oppositions to trade mark registration, including hearings.
- International trade mark application files

LEGISLATION – RULES AND REGULATIONS and PROCEDURES

The legislation to be observed by the Division and its sections in carrying out its functions is contained in the applicable intellectual property legislation (Acts and Rules) under which the Patents Office operates. The principal Acts and Rules used by Trade Marks Examination Division are as follows:

- The Industrial Designs Act 2001 (No.39 of 2001)
- The Industrial Designs Regulations 2002 (S.I. No.280 of 2002)
- Trade Marks Act 1996 (No. 6 of 1996)
- Trade Marks Rules 1996 (S.I. No. 199 of 1996)
- Trade Marks (Madrid Protocol) Regulations 2001 SI No. 346 of 2001
- Patents, Trade Marks and Designs (Fees) Rules, 2001 (S.I. No. 482 of 2001)
- Industrial Designs (Amendment) Regulations 2004 (S.I. 574 of 2004).
- The European Communities (Community Designs) Regulations 2003. (S.I. No. 27 of 2003)
- Trade Marks (Amendment) Rules 2007 (S.I. No. 621 of 2007)

A comprehensive list of national, EU and international trade mark and design legislation is at Appendix 1,2 and 3.

DECISIONS AND PRECEDENTS

Decisions to register trade marks or industrial designs are made when applications for registration are in conformity with the Trade Marks Act and Rules of 1996 and the Industrial Designs Act 2001 and the Industrial Designs Regulations 2002 as appropriate.

Notice of decisions taken by the Controller following hearings before him(or or a hearing officer appointed by him on trade mark cases are published in the Patents Office Journal which can be inspected online at www.patentsoffice.ie or inspected and purchased at the Patents Office. The grounds of the decisions are published and may be inspected on request at the Patents Library and Information Centre.

The written grounds of decisions in *inter-partes* hearings where the registration of a trade mark has been put at issue are made available via the Office's website (www.patentsoffice.ie).

2.8 Patents Examination Division

ROLE OF DIVISION

- The examination of applications for short-term and full-term patents and for Supplementary Protection Certificates (SPCs) and the granting of same.
- The examination of applications for post-grant amendments of patent specifications
- Analysis and comment on EU, International and National legislative proposals on patent protection and furnishing advice to the Controller on implications for the Office.
- Certain functions in relation to patent information dissemination.
- Contributing to the development of the Office automation infrastructure relating to patent examination and information dissemination.

STRUCTURE OF DIVISION

| | | |
|---|--|-----------------------------------|
| Dr Michael Lydon (Senior Examiner) | | |
| Examiner Dr. Fergal Brady | Examiner Dr. Dolores Cassidy | Examiner Dr. Karen Ryan |

| Name of Section | Summary of Main Functions |
|-----------------------------|---|
| Patents Examination Section | <ol style="list-style-type: none"> 1. Reading patent applications (title, description, claims and drawings) and analysing them sufficiently to identify the problem the invention seeks to address, the insight leading to its solution, the means essential to the solution as particularly reflected in the technical features thereof (as found in the claims) and recommending the grant or refusal of the application; 2. Performing technical classification of the applications according to the International Patent Classification Convention for the purpose of creation of a searchable data base; 3. Considering if the abstract (a brief summary of the invention) filed with the application meets the formal requirements, and determining its definitive content with a view to publication; 4. Pointing out any technical defects in the application for attention of the applicant; 5. Carrying out the examination of applications for Supplementary Protection Certificates, applications for revocation of patents, applications for licences and requests for amendments to granted patent specifications; 6. Dealing with certain legal and technical aspects of patent law, conventions and directives. 7. Keeping patent examination practice under review. 8. Contributing to the development of the Office automation infrastructure relating to patent examination and information dissemination. |

CLASSES OF RECORDS HELD

The main classes of records held in the Patents Examination Division are:

- Patent application files;
- Supplementary Protection Certificate application files;

LEGISLATION – RULES AND REGULATIONS and PROCEDURES

The legislation observed by the Division in carrying out its functions is contained in the applicable intellectual property legislation (Acts and Rules) under which the Patents Office operates. The Acts and Rules principally applicable in the Patents Examination Division are as follows:

- Patents Act, 1992 (No. 1 of 1992)
- PATENTS (AMENDMENT) ACT 2006, No. 31 of 2006
- Patents Rules, 1992 (S.I. No. 179 of 1992)
- European Communities (Supplementary Protection Certificate) Regulations, 1993 (S.I. No. 125 of 1993).
- European Communities (Supplementary Protection Certificate) (Amendment) Regulations, 2001 (S.I. No. 648 of 2001)
- Patent (Amendment) Rules 2009 - S.I. 194 of 2009.
- European Communities (Supplementary Protection Certificate) Regulations 2008 - S.I. No 307/2008
- European Communities (Compulsory Licensing of Patents Relating to the Manufacture of Pharmaceutical Products for Export to Countries with Public Health Problems) Regulations 2008 - S.I. 408 of 2008

DECISIONS AND PRECEDENTS

Decisions to grant patents and supplementary protection certificates are made where the applications are in conformity with the applicable legislative provisions.

Notice of decisions taken by the Controller following hearings before him (or a hearing officer appointed by him) on patent cases are published in the Patents Office Journal which can be inspected online at www.patentoffice.ie or inspected and purchased at the Patents Office. The grounds of the decisions are also published and are available via the Office's website (www.patentoffice.ie) or may be inspected on request at the Patents Office, Kilkenny.

Appendix 1

(For an up-to-date list of active legislation please consult the “Legislation” section at www.patentsoffice.ie).

National Legislation

- The Industrial Designs Act 2001 (No.39 of 2001)
- Industrial Designs Act 2001 (Commencement) Order 2002 (S.I. No. 275 of 2002)
- The Industrial Designs Regulations 2002 (S.I. No.280 of 2002)
- Industrial Designs (Amendment) Regulations 2004 (S.I. 574 of 2004).
- The European Communities (Community Designs) Regulations 2003. (S.I. No. 27 of 2003)
- Industrial Designs (Amendment) Regulations 2007 [S.I. No. 620 of 2007]

- European Communities (Enforcement of Intellectual Property Rights) Regulations 2006 S.I. No. 360 of 2006.
- European Communities (Enforcement of Community Judgements on Trade Marks and Designs) Regulations 2006. S.I. No 646 of 2006

- Copyright and Related Rights Act 2000 (No.28 of 2000)
- Copyright and Related Rights Act 2000 (Commencement) Order 2000 (SI No. 404 of 2000)
- Copyright and Related Rights (Register of Copyright Licensing Bodies) Regulations, 2002 (S.I. No. 463 of 2002.
- Copyright and Related Rights (Certification of Licensing Scheme for Reprographic Copying by Educational Establishments)(The Irish Copyright Licensing Agency Limited) Order 2002 (S.I. No. 514 of 2002).
- The European Communities (Copyright and Related Rights) Regulations 2004 (S.I. No. 16 of 2004)
- Copyright and Related Rights (Amendment) Act 2004 (Number 18 of 2004).
- Copyright and Related Rights (Librarians and Archivists) (Copying of Protected Material) regulations, 2000 (S.1. No. 427 of 2000)
- Copyright and Related Rights (Material open to Public Inspection) (International Organisations) Order 2000 (S.1. No. 411 of 2000)
- Copyright and Related Rights (Educational Establishments and Establishments to which members of the Public have access) Order, 2000 (S.1. No. 409 of 2000)
- Copyright and Related Rights (Works of folklore) (Designated bodies) Order 2000 (S.1. No. 408 of 2000)
- Copyright and Related Rights (Recording for purposes of time-shifting) Order 2000 (S.1. No. 407 of 2000)
- Copyright and Related Rights (Provision of modified works) (Designated bodies) Order 2000 (S.1. No. 406 of 2000)
- Copyright and Related Rights (Recording of broadcasts and cable programmes for archival purposes) (Designated bodies and classes) Order 2000 (S.1. No. 405 of 2000)
- Copyright and Related Rights Act 2000 (Certain Provisions) (Commencement) Order 2007 [S.I. No 157 of 2007]
- Copyright and Related Rights (Register of Licensing Bodies for Performers’ Property Rights) Regulations 2008 (SI No. 306 of 2008)
- European Communities (Artist’s Resale Right) Regulations 2006. S.I. No 312 of 2006

- Trade Marks Act 1996 (No. 6 of 1996)
- Trade Marks Act, 1996 (Commencement) Order, 1996 (S.I. No. 198 of 1996)
- Trade Marks Rules 1996 (S.I. No. 199 of 1996)
- Trade Marks (Madrid Protocol) Regulations 2001 SI No. 346 of 2001
- Trade Marks Act (Section 66) Regulations 2001 (SI No. 9 of 2001)

- Trade Marks Act (Community Trade Mark) Regulations 2000 (SI No. 229 of 2000)
- Trade Mark Act, 1996 (Residence of Trade Mark Agents) Regulations, 2000 (S.I. No. 34 of 2000)
- Trade Marks (Amendment) Rules 2007 [S.I. No. 621 of 2007]
- European Communities (Provision of Services concerning Trade Marks and Industrial Designs) Regulations 2007 [S.I. No. 622 of 2007]

- Industrial & Commercial Property (Protection) Act, 1927 (No. 16 of 1927))
- Industrial Property Rules, 1927 (S.I. No. 78 of 1927)
- Industrial Property Rules, 1927 (Amendment) Rules, 1987 (S.I. No. 332 of 1987)

- Patents Act, 1992 (No. 1 of 1992)
- PATENTS (AMENDMENT) ACT 2006, No. 31 of 2006
- Patents (Amendment) Act 2006 (Certain Provisions) (Commencement) Order 2007 [S.I. No. 761 of 2007]
- Patents Rules, 1992 (S.I. No. 179 of 1992)
- Patents, Trade Marks and Designs (Fees) Rules, 2001 (S.I. No. 482 of 2001)
- Register of Patent Agents Rules, 1992 (S.I. No. 180 of 1992)
- Intellectual Property (Miscellaneous Provisions) Act 1998 (No. 28 of 1998)
- Intellectual Property (Miscellaneous Provisions) Act 1998 (Patents Office Location Designation) Order, 1998 (S.I. No. 293 of 1998)
- Patents (International Arrangements) Order, 1996 (S.I. No. 38 of 1996)
- European Communities (Legal Protection of Biotechnological Inventions) Regulations, 2000 (S.I. No. 247 of 2000)
- European Communities (Supplementary Protection Certificate) Regulations, 1993 (S.I. No. 125 of 1993).
- European Communities (Supplementary Protection Certificate) (Amendment) Regulations, 2001 (S.I. No. 648 of 2001)
- European Communities (Patent Agents) Regulations 2006 S.I. No 141 of 2006.
- Patents (Amendment) Rules 2006. S.I. No 142 of 2006
- European Communities (Compulsory Licensing of Patents Relating to the Manufacture of Pharmaceutical Products For Export To Countries With Public Health Problems) Regulations 2008 (S.I. 408 of 2008)
- European Communities (Supplementary Protection Certificate) Regulations 2008 (SI No. 307 of 2008)

The text of the foregoing legislation may be accessed on the Internet at the following sites:

<http://www.irishstatutebook.ie>
<http://www.patentsoffice.ie>
<http://www.entemp.ie>

Appendix 2

European Union

- Council Regulation (EC) No 422/2004 of 19 February 2004 amending Regulation (EC) No 40/94 on the Community trade mark
- Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)
- Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark
- Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)
- Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark
- First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks.
- Council Regulation (EC) n° 6/2002 of 12 December 2001 on Community Designs
- Commission Regulation (EC) n°2245/2002 of 21 October 2002 implementing Council Regulation (EC)No 6/2002 on Community designs
- Commission Regulation (EC) n° 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs
- Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs
- Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of the original work of art.
- Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.
- Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.
- Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights.
- Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission.
- Council Directive 92/100/EEC of 19 November 1992 on rental and lending right and on certain rights related to copyright in the field of intellectual property.
- Council Directive 91/250/EEC of May 1991 on the legal protection of computer programs.

- Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions.
- Council Regulation (EEC) No, 1768/92 concerning the creation of a supplementary protection certificate for medicinal products.
- Regulation (EC) No. 1610/96 of the European Parliament and the Council of 23rd July 1996 concerning the creation of a supplementary protection certificate for plant protection products

All the EU legislation listed above is available on the [EU Website](#) :

<http://europa.eu.int/eur-lex/lex/en/index.htm>

In addition, EU Directives and Regulations on Trade Marks and Designs may be accessed and downloaded from the website of the Office for Harmonization in the Internal Market (Trade Marks and Designs) :

<http://oami.eu.int/en>

Appendix 3

Summary of the main international agreements and treaties in the area of Intellectual Property Protection.

European Patent Organisation

- European Patent Convention, 1973 (EPC). This was revised in 2000.

The text of the Convention may be obtained from the EPO's website (<http://www.european-patent-office.org>)

Conventions/Treaties under the auspices of WIPO (World Intellectual Property Organisation)

The following documents can be obtained from the WIPO website (<http://www.wipo.int/>)

- Patent Cooperation Treaty, 1970 (PCT)
- Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent procedure.
- Locarno Agreement Establishing an International Classification for Industrial Designs.
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.
- Strasbourg Agreement Concerning the International Patent Classification.
- Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks.
- Berne Convention for the Protection of Literary and Artistic Works.
- Paris Convention for the Protection of Industrial Property.
- Patent Law Treaty
- Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.
- Trademark Law Treaty
- WIPO Copyright Treaty
- WIPO Performances and Phonograms Treaty

Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (as in force on April 1 2002)

Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (in Force as of January 1, 2005)

Regulations Under the Patent Cooperation Treaty (as in force from January 1, 2004)

PCT Administrative Instructions

APPENDIX 4

SERVICES and INFORMATION PROVIDED BY THE PATENTS OFFICE

In accordance with the principal functions of the Office as laid down in legislation, the Patents Office is responsible for providing the following principal services:

Principal Services

- The granting of patents subject to the criteria laid down in the Patents Act and Rules.
- Maintaining patents in force on foot of payment of the appropriate annual renewal fee over the life of the patent.
- Maintaining a register of patents.
- Issuing Supplementary Protection Certificates in accordance with the provisions of the European Communities (Supplementary Protection Certificate) Regulations, 1993 [S.I. No. 125 of 1993].
- Acting as a receiving office for European and PCT patent applications.
- The registration of national and international trade marks (including service marks) subject to criteria set out in the Trade Marks Act and Rules.
- Acting as a receiving office for applications for Community Trade Marks and Community Designs and forwarding same to OHIM.
- Maintaining trade marks and industrial designs in force subject to the payment of the appropriate renewal fee.
- Maintaining a register of trade marks.
- The registration of industrial designs in accordance with the provisions of the Industrial Designs Act, 2001 and Industrial and Commercial Property (Protection) Act, 1927.
- Maintaining a register of Copyright Licensing Bodies.
- Maintaining a register of industrial designs.
- Maintenance of a register of Patent Agents;
- Maintenance of a register of Trade Mark Agents;
- Making information available to the public regarding industrial and intellectual property.

Public Access to the Office

Patents Office
Government Buildings
Hebron Road
Kilkenny
Ireland

Phone: 353 56 7720111
Fax: 353 56 7720100
Lo Call Phone: 1890 220223 (within Ireland)
Lo Call Fax: 1890 220120 (within Ireland)

E-mail: patlib@entemp.ie

The office is open to the public from Monday to Friday from 9.30 am to 5.00 pm each day inclusive of lunch hour.

It is a policy of the Patents Office to make as much information as possible available outside of the framework of the Freedom of Information legislation. In addition to information made available under the Patents, Trade Marks, Designs and Copyright legislation the Patents Office routinely makes information available through information leaflets, publications, website and in response to enquiries.

Provision of Information and Inspection of Documents - Patents.

The current procedure operated by the Patents Office in accordance with the Patents Act and Rules in respect of individual patent applications is as follows:

The law requires that a patent application cannot be disclosed until 18 months from the filing or priority date whichever is the earlier. On expiry of the 18 month period, the fact that an application is open for inspection is advertised in the Patents Office Journal. Copies of published applications are, from that point on, made available to anyone who wishes to inspect them.

Members of the public can therefore obtain access to this information in accordance with the relevant provisions of the Patents Act and Rules without recourse to an FOI request.

Each patent application is assigned a specific number in sequence upon filing and on the grant of a patent a "Grant Number" is assigned.

Usually a person seeking to inspect a particular Irish patent application file will already be in possession of specific information regarding the application and will be able to quote the relevant application number. However, in the absence of a number, the Library/Information Centre staff may be able to assist a person to search the database of published Irish patent applications.

It is also possible to access online data in respect of published Irish patent applications via the Patents Office website (www.patentsoffice.ie). In addition the Patents Office provides free of charge access to the [ESP@CENET](#) database which offers access to:

- Recent published patent applications of the 38 EPO member states including Ireland.
- EPO published patent applications.
- Published PCT (Patent Co-operation Treaty) applications from the World Intellectual Property Organisation (WIPO).
- "Worldwide" patent information (English language patent abstracts).
- Japanese patent documents.

Copies of the patent specifications of granted Irish Patents may also be obtained from the Patents Office.

The Register of Patents

The Controller has a statutory obligation to keep a **Register of Patents** at the Patents Office under the Patents Act, 1992. This Register may be kept in such form as the Controller may determine. There is provision under the Patents Act & Rules for public inspection of the Patents Register, and for the public to obtain reproductions of entries in the register on payment of the prescribed fees.

The register is computerised and is open to public inspection in the Library and Information Centres in both Dublin and Kilkenny. The register is also accessible online at www.patentsoffice.ie

The data entered in the Register comprises such items as:

- a) the name, address and nationality of the applicant(s);

- b) the name and address of the person(s) stated by the applicant(s) to be believed to be the inventor(s);
- c) the title of the invention;
- d) the date of filing and the number of the application for the patent;
- e) in the case of an application claiming priority under Section 26, the date of any previous filing, the name of the State in or for which it was made and the file number;
- f) the date of publication of the application;
- g) the address for service of the applicant(s).

Also entered are:-

- ◆ the date on which an application is refused, withdrawn, deemed to be withdrawn or lapsed;
- ◆ the date on which notice of grant of a patent is published;
- ◆ particulars of assignments, mergers and licences of patents and published applications;
- ◆ change of address of applicants, proprietors and the address for service.

Summary of Information Available on Patents - access to which is not dependent on an FOI Request

| What's available? | Where is it available? |
|---|--|
| General information relating to Patents | Patents Office Website : www.patentsoffice.ie |
| Patents Office Journal (published fortnightly) | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny Price €10.00 for paper copies |
| Explanatory leaflets/booklets/ application forms on patents | Patents Office - Kilkenny Information Centre (no charge). |
| Extract from paper Patents Register (All patent applications accepted to No 56999) | Patents Office - Kilkenny (no charge). |
| Extract from computerised Patents Register | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny |
| Published patent applications from 1927 to date (bibliographic data and/or abstract according to class) on CD ROM | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny |
| Patent applications open to public inspection between 1940 - 1990, stored on microfilm | Patent Office, Kilkenny – no charge for a search; €0.30 per page for a copy. |
| Specifications of granted Irish Patents 1927 to date. | Patents Office - Kilkenny Information Centre (no charge if provided in electronic format). |

| | |
|---|--|
| Legislation pertaining to patents | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny Government Publications Sales Office. (paper copies are available for purchase) |
| Specific items of information on a particular patent or patent application can be sought as provided for under Rule 64(3) of the 1992 Patents Rules | €6.00 fee per item of information sought, request must be made in writing |
| Inspection of patent application/granted patent (paper record) Rule 65(1). | Members of the public can carry out an inspection of a patent application/granted patent at the Patents Office Information Centre in Kilkenny. The request must be submitted in writing in advance, (preferably a minimum of a week before the intended inspection as the papers may be stored off the premises). If copies are required there is a fee of €0.30 per page. |

Provision of Information and Inspection of Documents - Trade Marks.

The current procedure operated by the Patents Office in accordance with the Trade Marks Act and Rules in respect of individual trade mark applications is as follows:

Once an application for registration of a trade mark has been published, the Controller shall on request provide a person with such information as is prescribed in the 1996 Trade Mark Rules and permit him/her to inspect such documents relating to the application or to any registered trade mark resulting from it. Rule 60(3) of the Trade Mark Rules, 1996 sets out the documents which may be requested.

Members of the public can therefore obtain access to this information in accordance with the relevant provisions of the Trade Marks Act and Rules. Access to this information does not necessitate a request under the FOI Act

Each trade mark application is assigned a specific number in sequence upon filing and is accorded a registration number on registration. Application number format is 2000/02222 and registration number format is 219712. The Office treats International Trade Mark Registration Numbers as 7 digit numbers and inserts a leading zero '0' where necessary

Usually a person seeking to inspect a particular Irish trade mark application file will already be in possession of specific information regarding the application and will be able to quote the relevant application or registration number. However, in the absence of a number, the Library/Information Centre staff may be able to assist a person to search the trade mark database.

It is also possible to access, online, data in respect of published Irish trade mark applications and registered trade marks via the Patents Office website (www.patentsoffice.ie).

The Register of Trade Marks

The Controller has a statutory obligation to keep a **Register of Trade Marks** at the Patents Office under the **Trade Marks Act, 1996**. This Register may be kept in such form as the Controller may determine.

The main information in the Register is:

- (a) registered trade marks and the names and addresses of the proprietors thereof;

- (b) particulars of registerable transactions affecting a registered trademark (e.g. assignments licences etc.);
- (c) the date of registration of a mark
- (d) the date of publication of the registration;
- (e) the priority date (if any) claimed pursuant to section 40 or 41;
- (f) the address for service;
- (g) any disclaimer or limitation subject to which the mark is registered;
- (h) the goods or services in respect of which the mark is registered and their class or classes;
- (i) where the mark is a collective or certification mark, that fact;
- (j) any consent pursuant to section 10(6) by the proprietor of an earlier trade mark or other earlier right to which that section relates.

There is provision under the Trade Marks Act & Rules for -

- (a) public inspection of the register, and
- (b) the supply of certified or uncertified copies of, or extracts from, entries in the register.

Persons wishing to inspect the register may do so at the Office or online via the Patents Office website (www.patentsoffice.ie).

Summary of Information Available on Trade Marks/Designs - access to which is not dependant on an FOI Request

| What's Available? | Where is it available? |
|--|--|
| General information relating to Trade marks and designs. Explanatory leaflets on trade mark/designs; application forms for registration of trade marks/designs; list of registered trade mark agents | Website: www.patentsoffice.ie office.ie Kilkenny Information Centre - no charge |
| Patents Office Journal (Trade Marks material is included in Part II – Designs in Part 1) | Published fortnightly. Can be viewed online at www.patentsoffice.ie or purchased from Patents Office Price €10.00 |
| Extract from Trade Mark Register. Extract from Designs Register (2001 Act) | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny Information Centre (requests received for paper copies to be sent by post – €0.30 per page) |
| Extract from Designs Register (1927 Act) | Patents Office Kilkenny (If request received for paper copies to be sent by post – €0.30 per page) |
| Inspection of computerised database of pending & registered trade marks (covers the period from 1927 to date) | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny Information Centre – no charge |
| Inspection of computerised database of published designs filed under the Industrial Designs Act 2001 | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny Information Centre – no charge |
| Under Rule 60 of the Trade Mark Rules 1996, inspection of certain documents | Kilkenny Library & Information Centre - a request to inspect must be lodged in writing |

| | |
|--|--|
| relating to trade mark applications or registered trade marks and other matters is permitted | a minimum of one week before the intended inspection. - there is a fee of €6.00 for the item of information provided - |
| Legislation pertaining to trade marks & designs | <ul style="list-style-type: none"> • Patents Office Website : www.patentsoffice.ie • Patents Office Kilkenny or Dublin • Government Publications Sales Office. <p>(paper copies are available for purchase)</p> |
| List of state emblems; official signs; hallmarks; emblems/abbreviations and names of international organisations which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter (3) of that Convention | Available for inspection in the Kilkenny Library and Information Centre – fee of €0.30per page for photocopies |
| Information about an application or a registered design under Section 39 of the Designs Act 2001 | Kilkenny Library and Information Centre - there is a fee of €6.00 for the item of information provided |
| Request for information as to existence of right in a registered design under Section 40 of the Designs Act 2001. | Kilkenny Library and Information Centre - there is a fee of €10.00 |

The Register of Designs maintained under the Industrial Designs Act, 2001

The Industrial Designs Act, 2001 and the Industrial Design Regulations 2002 came into effect on the 1st July 2002. The Act gave effect to Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs and the regulations prescribed the procedures for application and registration of a design and subsequent matters under the Industrial Designs Act, 2001.

The Industrial Designs Act, 2001 and the Industrial Design Regulations 2002 require the Controller to maintain a register of Designs registered under this legislation at the office

The main entries in the register are:

- the registration number;
- the name, address and nationality of the registered proprietor;
- the address for service;
- the description of the design;
- the product or products to or in which the design is to be applied or incorporated and the class or classes thereof, including sub-classes;
- the date of registration;
- the date of publication of the registration as provided for in section 32 of the Principal Act. Where deferment of publication is requested under section 32(2) of the Principal Act the date of publication shall only be entered on the Register upon such publication;
- the priority date (where any) claimed pursuant to section 27 of the Principal Act and , the name of the state, country, territory or area concerned and the filing number;
- any disclaimer or limitation subject to which the design is registered;
- where the first proprietor is not the author of the design, the name of the
- author;
- a representation or representations of the design.

Deferment of publication

The period for which publication of a design may be deferred under section 32(2) of the Principal Act shall be a period of up to 30 months from the filing date, or where priority is claimed, for a period of up to 30 months from the date of priority.

Upon the expiry of the period of deferment referred to in the foregoing paragraph, or at any earlier date on request by the registered proprietor, the Controller shall open the Register to public inspection in respect of that design and shall publish the registration of the design.

The Register of Designs maintained under the Industrial and Commercial Property (Protection) Act, 1927

The Industrial and Commercial Property (Protection) Acts, 1927 to 1958 continue to apply to applications for registration of a design pending on 1/7/2002 (other than pending applications where conversion under the Act of 2001 has been requested) and all designs registered under those Acts.

The Register kept under the Industrial and Commercial Property (Protection) Act, 1927 at the Patents Office contains the following main information:

- (a) the names and addresses of the proprietors of the registered designs;
- (b) assignments and transmissions;
- (c) the registration number and class of the design;
- (d) the date of registration of the design;
- (e) a description of the goods;
- (f) the address for service in the State of the proprietor.

In addition to the Register of Designs, the Controller keeps, in respect of each design registered, a representation of the design. Generally the representation of a design will show a perspective or alternative view of the design.

Inspections of the 1927 Act Register

Inspection of the Register is provided for under Section 73 of the Industrial and Commercial Property (Protection) Act, 1927. In practice, designs which are registered less than two years (or five years in the case of Class 5- textile piece goods) are not open to inspection except by the proprietor, or a person authorised in writing by him, a person authorised by the Controller or by the Court. No copies can be made by the person inspecting the register.

Inspection of the Register can only be carried out in the Kilkenny Office and in the presence of a member of staff.

Where an application to register a design is refused on the grounds that the design is identical to a previously registered design, the applicant is entitled to see the registered design.

When the statutory two year period after registration of a design has expired, the design is open to public inspection by any person on payment of the prescribed fee and copies may be made of the registered design.

1927 Act Design Applications abandoned or refused.

Under Section 79, where an application for a design has been abandoned or refused, the application and any drawings, photographs, tracings, representations, or specimens left in connection with the application shall not, at any time, be open to public inspection or be published by the Controller.

The Register Of Copyright Licensing Bodies

Under the Copyright and Related Rights Act 2000, the Controller is responsible for maintaining a register of licensing bodies which contains the information prescribed under the Act and Regulations

There is provision under the Act and the applicable regulations for

- (a) public inspection of the register, and
- (b) the supply of certified or uncertified copies of, or extracts from, entries in the register.

Persons wishing to inspect the register may do so at the Office. Information Centre staff will assist members of the public to obtain the information being sought.

The main information in the Register is:

- (a) the name and address of the body;
- (b) the names of the chairperson and other members of the board or officers, or names of partners, as the case may be, of the applicant.
- (c) a copy of the memorandum and articles of association, or partnership agreement, as the case may be, of the body;
- (d) details of the scheme operated by the body and the scales of charges;
- (e) the class of rightsholders represented or proposed to be represented by the body;
- (f) in the case of sound recordings, the names of the rightsholder or rightsholders in respect of whom the body concerned claims entitlement to receive payments.

Patents Office Journal

The Office publishes a **Patents Office Journal** on a fortnightly basis. The Journal is in two parts. Part 1 concerns patents and designs and includes information for a fortnightly period under a number of headings, including, but not confined to:

- Patent applications filed
- Applications published
- Patents granted
- European Patents designating the State
- Applications lapsed
- Applications withdrawn, deemed withdrawn or refused.
- Patents expired
- Any proceedings under the Patents Act, 1992
- Matters concerning Supplementary Protection Certificates.
- Copyright in Designs extended
- Designs registered
- Designs expired

Part II of the Journal contains information relating to trade marks under a number of headings, including, but not confined to:

- Trade mark applications accepted
- Oppositions to registration
- Applications amended
- Applications abandoned
- Applications withdrawn
- Trade Marks registered
- Trade Marks renewed
- Unpaid renewal fees
- Trade Marks removed
- Merger of separate Trade Mark registrations

Journals may be consulted and searched online at the Patents Office Website : www.patentsoffice.ie or on request at the Kilkenny Information Centre or purchased directly from the Patents Office..

Online Services (national)

Patents Register Search

Patents Database Search

SPC Database Search

Trade Mark Register Search

Trade Mark Database Search

Register of Copyright Licensing Bodies

Design Register Search

Design Database Search

Official Journal Download

Official Journal Search/Browse

Decisions Database (Patents & Trade Marks)

Online Payments (Patent, TM and Design renewal fees and Patent grant and TM registration fees)