

Patents Act 1992 (as amended)

Changes Tracked – Colour Coded.

Note to users:

This is an unofficial consolidation of the Patents Act 1992 and amendments up to and including the 19 May 2017 and is produced here as a reference document only. This document has no legal force. The Patents Act, 1992 has been updated on a number of occasions since it was enacted on the 27th February 1992, but the amending laws have not been officially consolidated into a single text. Whilst every effort has been made to ensure the accuracy of the information/material contained on this document, the State nor the Department of Enterprise, Trade and Innovation, its servants or agents assume no responsibility for and give no guarantees, undertakings or warranties concerning the accuracy, completeness or up to date nature of the information provided and do not accept any liability whatsoever arising nor for any errors or omissions in this document.

Amended by:

-  Knowledge Development Box (Certification of Inventions) Act 2017
-  S.I. 579 of 2015 European Communities (Patent Agents) Regulations 2015
-  Intellectual Property (Miscellaneous Provisions) Act 2014 [36/2014]
-  Patent (Amendment) Act 2012 [1/2012]
-  Arbitration Act 2010 [1/2010]
-  Patent (Amendment) Act 2006 [31/2006]
-  SI 141 of 2006 European communities (Patent Agents) Regulations
-  SI 50 of 2006 European Communities (Limitation of Effect of Patent) Regulations
-  SI 39 of 2001 Industrial Designs Act
-  SI 247 of 2000 European Communities (Legal Protection of Biotechnological Inventions) Regulations
-  SI 6 of 1996 Trademarks Act
-  Intellectual Property (Miscellaneous Provisions) Act 1998 [28/1998]
-  Repealed or deleted

No. 1/1992:

PATENTS ACT, 1992
As amended – changes tracked

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Companies Act, 1963	1963, No. 33
Continental Shelf Act, 1968	1968, No. 14
Foreign Tribunals' Evidence Act, 1856	1856, c. 113
Industrial and Commercial Property (Protection) Act, 1927	1927, No. 16
Local Government Act, 1941	1941, No. 23
Maritime Jurisdiction Act, 1959	1959, No. 22
Patents Act, 1964	1964, No. 12

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Patents (Amendment) Act, 1966	1966, No. 9
Petty Sessions (Ireland) Act, 1851	1851, c. 93
Public Offices Fees Act, 1879	1879, c. 58
Solicitors Act, 1954	1954, No. 36
Superannuation and Pensions Act, 1976	1976, No. 22

Number 1 of 1992

PATENTS ACT, 1992

AN ACT TO MAKE NEW PROVISION IN RESPECT OF PATENTS AND RELATED MATTERS IN SUBSTITUTION FOR THE PROVISIONS OF THE PATENTS ACTS, 1964 AND 1966; TO ENABLE EFFECT TO BE GIVEN TO CERTAIN INTERNATIONAL CONVENTIONS ON PATENTS; AND TO PROVIDE FOR OTHER MATTERS CONNECTED WITH THE MATTERS AFORESAID. [27th February, 1992]

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:

PART I

PRELIMINARY AND GENERAL

Short title and commencement.

1.—(1) This Act may be cited as the Patents Act, 1992 .

(2) Except as otherwise provided, this Act shall come into operation on such day as the Minister may by order appoint.

Interpretation.

2.—(1) In this Act, except where the context otherwise requires—

"the Act of 1964" means the Patents Act, 1964 ;

"Agreement establishing the World Trade Organisation" means the Agreement establishing the World Trade Organisation done at Marrakesh on 15 April 1994, as amended or supplemented by any protocol to that Agreement which is for the time being in force in the State;*

"applicant", in relation to an application under this Act, means the person making the application and includes a person whose title has been registered under section 85 or in relation to whose title a direction has been given under that section and the personal representative of a deceased person by whom such an application is made;

"application for a European patent" means an application made under the European Patent Convention;

* Patents Amendment Act 2006 [31/2006]

"assignee" includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

[“Board of Appeal” means a Board of Appeal referred to in Article 21 of the European Patent Convention;*](#)

"commercially worked" means the manufacture of the product or the carrying on of the process which is the subject of a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable in all the circumstances;

"company" means a company within the meaning of section 2 of the Companies Act, 1963, or any other body corporate whether incorporated inside or outside the State;

"the Controller" means the Controller of Patents, Designs and Trade Marks;

"Convention on International Civil Aviation" means the Convention on International Civil Aviation signed at Chicago on the 7th day of December, 1944;

"the Court" means the High Court and, in relation to proceedings to which section 66 applies, includes the Circuit Court;

"date of filing" means—

(a) in relation to an application for a patent made under this Act, the date which is the date of filing of the application by virtue of the relevant provision of this Act, and

(b) in relation to any other application, the date which, under the law of the country where the application is made or in accordance with the terms of a treaty or convention to which the country is a party, is to be treated as the date of filing the application or is equivalent to the date of filing an application in that country;

"date of priority" means the earliest date which has been claimed for priority purposes in accordance with section 26;

"designate" means—

(i) in relation to an application for a patent, designate (in pursuance of the European Patent Convention or the Treaty, as the case may be) the state or states in which protection is sought for an invention, [and includes a reference to a country being treated as designated in pursuance of the European Patent Convention or the Treaty;*](#)

(ii) in relation to a patent, designate (in pursuance of the European Patent Convention) the state or states in which the patent has effect;

* [Patents Amendment Act 2006 \[31/2006\]](#)

"director" includes any person occupying the position of director (by whatever name called) of any body corporate;

"divisional application" has the meaning assigned to it by section 24;

'EEA Agreement' means the Agreement on the European Economic Area signed at Oporto on 2 May 1992, as adjusted by all subsequent amendments to that Agreement:

'EEA state' means—

(a) a Member State (other than the State), or

(b) a state (other than a Member State) that is a contracting party to the EEA agreement; *

"Enlarged Board of Appeal" means the Enlarged Board of Appeal referred to in Article 22 of the European Patent Convention; *

"the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention;

"European patent" means a patent granted under the European Patent Convention;

"European Patent Bulletin" means the bulletin of that name published under the European Patent Convention;

"European Patent Convention" means the Convention on the Grant of European Patents signed at Munich on the 5th day of October, 1973 as amended for the time being; *

"European Patent Office" means the office of that name established by the European Patent Convention;

"exclusive licence" means a licence from a proprietor of or applicant for a patent which confers on the licensee or on the licensee and persons authorized by him, to the exclusion of all other persons (including the proprietor of or applicant for the patent), any right in respect of the invention and "exclusive licensee" and "non-exclusive licence" shall each be construed accordingly;

"functions" includes powers and duties;

"international application for a patent" means an application made under the Treaty;

"inventor" means the actual deviser of an invention and "joint inventor" shall be construed accordingly;

"the Journal" means the Patents Office Journal;

“member of the World Trade Organisation” means a party to the Agreement establishing the World Trade Organisation;*

"the Minister" means the Minister for Industry and Commerce;

"the Office" means the Patents Office;

"the Paris Convention for the Protection of Industrial Property" means the convention of that name signed at Paris on the 20th day of March, 1883, as amended or supplemented by any protocol to that convention which is for the time being in force in the State;

"patent" means an exclusive right conferred pursuant to Part II or Part III;

‘patent agent’ except in section 94 has the meaning assigned to it by section 105 and a reference to a patent agent in this Act (except in section 94) or any other enactment shall be construed as including a reference to a patent attorney;*

"patent application" means an application under Part II or Part III for a patent;

"prescribed" means, in the case of proceedings before the Court, prescribed by rules of court, and, in any other case, prescribed by rules made under this Act;

"proprietor of the patent" means the person to whom the patent was granted or the person whose title is subsequently registered under section 85;

"published"—

(a) in relation to any document which is required to be published under this Act, means made available to the public and includes the making available for inspection of the document as of right, at the Office and such other place (if any) as may be for the time being specified for the purpose by the Minister, by the public, whether on payment of a fee or not, and

(b) in relation to any other document, matter, record or information which the Controller is authorized to publish means made available to the public and includes the making available of the document, matter, record or information in any form at the Office and such other place (if any) as may be for the time being specified for the purpose by the Minister, whether on payment of a fee or not;

"the register" means the Register of Patents or the register of patent agents, as may be appropriate;

"right", in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference in this Act to a right in a patent includes a reference to a share in the patent;

"the Treaty" means the treaty known as the Patent Co-operation Treaty signed at Washington on the 19th day of June, 1970;

“TRIPs Agreement” means the Agreement on Trade- Related Aspects of Intellectual Property Rights annexed to the Agreement establishing the World Trade Organisation;*

"Union of Paris for the Protection of Industrial Property" means the union established by the Paris Convention for the Protection of Industrial Property.

(2) In this Act, unless otherwise indicated—

(a) a reference to a Part, section or Schedule is to a Part, section or Schedule of this Act,

(b) a reference to a subsection is a reference to a subsection of the section in which the reference occurs.

Orders and rules.

3.—(1) Where a power to make orders or rules is conferred by this Act, such orders or rules may be made either as respects all, or as respects any one or more, of the matters to which the power relates, and different provisions may be made by any such orders or rules as respects matters which are of different classes or descriptions.

(2) Every order or rule made under this Act shall be laid before each House of the Oireachtas as soon as may be after it is made and if a resolution annulling the order or rule is passed by either such House within the next twenty-one days on which the House has sat after the order or rule is laid before it, the order or rule shall be annulled accordingly, but without prejudice to the validity of anything previously done thereunder.

(3) As soon as may be after any order or rule is made under this Act notice of the making thereof, and of the place where copies thereof may be obtained, shall be published in the Journal.

(4) The power to make an order includes power to amend or revoke the order, except in the case of an order under section 1 (2).

Expenses.

4.—The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas.

Repeals and transitional provisions.

5.—The Act of 1964 and the Patents (Amendment) Act, 1966 are hereby repealed, subject to the provisions of the First Schedule.

PART II

PATENTS GENERALLY

CHAPTER I

THE PATENTS OFFICE AND THE CONTROLLER

The Patents Office and the Controller of Patents, Designs and Trade Marks.

6.—(1) The Patents Office and the Controller of Patents, Designs and Trade Marks shall continue in being for the purposes provided for by this Act or any other enactment.

(2) The Controller of Patents, Designs and Trade Marks shall continue as a corporation sole with perpetual succession and an official seal which shall be judicially noticed and may sue and be sued by that name.

~~—(3) The Patents Office shall be under the control of the Controller who shall be independent in the discharge of the functions conferred on him by this Act or any other enactment.~~

(3) The Office shall be under the control of the Controller who shall act under the general superintendence and direction of the Minister.*

(4) References in any enactment to the Industrial and Commercial Property Registration Office and to the Controller of Industrial and Commercial Property shall continue to be construed respectively as references to the Patents Office and the Controller.

Grant of patents.

7.—Patents shall be granted by the Controller subject to and in accordance with the provisions of this Act.

Extent of application of Part II.

8.—The subsequent provisions of this Part shall, in relation to short-term patents to which Part III applies, have effect subject to the provisions of that Part.

CHAPTER II

PATENTABILITY

Patentable inventions.

9.—(1) An invention **in all fields of technology*** shall be patentable under this Part if it is susceptible of industrial application, is new and involves an inventive step.

* Intellectual Property (Miscellaneous Provisions) Act 1998 [28/1998]

* Patents Amendment Act 2006 [31/2006]

(2) Any of the following in particular shall not be regarded as an invention within the meaning of subsection (1):

- (a) a discovery, a scientific theory or a mathematical method,
- (b) an aesthetic creation,
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer,
- (d) the presentation of information.

(3) The provisions of subsection (2) shall exclude patentability of subject-matter or activities referred to in that subsection only to the extent to which a patent application or patent relates to such subject-matter or activities as such.

~~–(4) A method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body shall not be regarded as an invention susceptible of industrial application for the purposes of subsection (1). This provision shall not apply to a product, and in particular a substance or composition, for use in any such method.~~

~~–(5) The Minister may by order modify any of the provisions of this section or of section 10 (other than paragraph (a)) or section 11 for the purpose of giving effect, in relation to the patentability of inventions, to the European Patent Convention as amended by any international treaty, convention or agreement to which the State is or proposes to become a party.~~

(Deleted by 2006 Act)

Exceptions to patentability.

10.—A patent shall not be granted in respect of—

- (1) (a) an invention the ~~publication or exploitation~~ **commercial exploitation** of which would be contrary to public order or morality, provided that the exploitation shall not be deemed to be so contrary only because it is prohibited by law;
- (b) a plant or animal variety or an essentially biological process for the production of plants or animals other than a micro-biological process or the products ~~thereof.~~ **thereof;**
- (c) a method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body.

(2) Subsection (1)(c) shall not apply to products, in particular substances or compositions, for use in any such method.*

* Patents Amendment Act 2006 [31/2006]

Novelty.

11.—(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public (whether in the State or elsewhere) by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

(3) Additionally, the content of a patent application as filed, of which the date of filing is prior to the date referred to in subsection (2) and which was published under this Act on or after that date, shall be considered as comprised in the state of the art.

~~(4) The provisions of subsections (1), (2) and (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in subsection (4) of section 9 provided that its use for any method referred to in the said subsection (4) is not comprised in the state of the art.~~

(4) The provisions of subsections (2) and (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 10(1)(c) provided that its use for any such method is not comprised in the state of the art.

(5) The provisions of subsections (2) and (3) shall also not exclude the patentability of any substance or composition referred to in subsection (4) for any specific use in any method referred to in section 10(1)(c), provided that such use is not comprised in the state of the art.*

Non-prejudicial disclosures.

12.—(1) For the application of section 11 a disclosure of the invention shall not be taken into consideration if it occurred not earlier than six months preceding the filing of the patent application and if it was due to, or in consequence of—

(a) a breach of confidence or agreement in relation to, or the unlawful obtaining of the matter constituting, the invention, or

(b) the fact that the applicant or his legal predecessor has displayed the invention at an international exhibition which is either official or officially recognised under the Convention on International Exhibitions signed at Paris on the 22nd day of November, 1928, or any subsequent treaty, convention or other agreement replacing that Convention:

Provided that the exhibitor states, when making the patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions prescribed.

(2) The Minister may for the purpose of subsection (1) prescribe a period other than the six months specified in that subsection and circumstances other than those specified in paragraph (a) or (b) of that subsection where the Minister is satisfied that it is necessary to do so in order to give effect to any treaty or international convention to

* Patents Amendment Act 2006 [31/2006]

which the State is or becomes a party and the said subsection shall be construed accordingly.

(3) Where a statement appears in the Journal stating that an international exhibition specified in the statement is or was an international exhibition of the class referred to in subsection (1), then for the purposes of this section the statement shall be evidence that the international exhibition specified therein is or was an international exhibition of such class.

Inventive step.

13.—An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art, but if the state of the art also includes documents within the meaning of section 11 (3) those documents shall not be considered in deciding whether or not there has been an inventive step.

Industrial application.

14.—An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

CHAPTER III

APPLICATIONS

Right to apply for patent.

15.—Any person may make an application for a patent either alone or jointly with another.

Right to patent.

16.—(1) The right to a patent shall belong to the inventor or his successor in title, but if the inventor is an employee the right to a patent shall be determined in accordance with the law of the state in which the employee is wholly or mainly employed or, if the identity of such state cannot be determined, in accordance with the law of the state in which the employer has his place of business to which the employee is attached.

(2) If two or more persons have made an invention independently of each other, the right to a patent for the invention shall belong to the person whose patent application has the earliest or earlier (as may be appropriate) date of filing, but this provision shall apply only if the earliest or earlier application has been duly published under this Act.

(3) For the purposes of proceedings before the Controller the applicant shall be deemed to be entitled to exercise the right to the patent.

Mention of inventor.

17.—(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any specification of a patent granted for the invention and shall also have a right to be so mentioned, if practicable, in any published patent application for the invention.

(2) Unless he has already given the Controller the information hereinafter mentioned, an applicant shall within the prescribed period file with the Controller a statement—

(a) identifying the person or persons whom he believes to be the inventor or inventors, and

(b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent,

and if he fails to do so, the application shall be deemed to be withdrawn.

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time request the Controller to make a finding to that effect; and if the Controller does so, he shall accordingly amend the register and any undistributed copies both of the published patent application and of the specification of the granted patent.

Making of application.

18.—(1) Every application for a patent under this Part shall be filed at the Office in the prescribed manner and be in the prescribed form.

(2) A patent application shall contain—

(a) a request for the grant of a patent;

(b) a specification containing a description of the invention to which the application relates, one or more claims and any drawing referred to in the description or the claim or claims; and

(c) an abstract.

(3) Every application shall be accompanied by the prescribed filing fee unless the Minister prescribes a later date by which such fee may be paid.

Disclosure of invention.

19.—(1) A patent application shall disclose the invention to which it relates in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(2) Without prejudice to the generality of subsection (1), rules may prescribe the circumstances in which an application for a patent for an invention which requires for its performance the use of ~~a micro-organism~~ biological material* is to be treated for the purposes of this Act as complying with that subsection and may specify other provisions, in relation to such applications.

Claims.

20.—The claim or claims shall define the matter for which protection is sought, be clear and concise and be supported by the description.

* SI 247/2000 European Communities (Legal Protection of Biotechnological Inventions) Regulations

Unity of invention.

21.—(1) A patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(2) Without prejudice to the generality of subsection (1), rules may provide for treating two or more inventions as being so linked as to form a single general inventive concept for the purpose of this Act.

Abstract.

22.—(1) The abstract shall only serve for use as technical information; it may not be taken into account for any other purpose and in particular it may be used neither for the purpose of interpreting the scope of the protection sought nor for the purpose of applying section 11 (3).

(2) The Controller may determine whether the abstract adequately fulfils its purpose and if, in his opinion, it does not, he may reframe it so that it does.

Date of filing application.

~~23.—(1) The date of filing of a patent application shall be the earliest date on which the applicant paid the filing fee and filed documents which contain—~~

~~—(a) an indication that a patent is sought;~~

~~—(b) information identifying the applicant; and~~

~~—(c) a description of the invention even though the description does not comply with the requirements of this Act or with any requirements that may be prescribed.~~

~~—(2) If the Minister prescribes a later date for payment of the filing fee under section 18 (3), the date of filing referred to in subsection (1) shall be the date on which the documents referred to in that subsection are filed.~~

~~—(3) If any drawing referred to in the application is filed later than the date of filing accorded to the application by virtue of subsection (1), the Controller shall give the applicant an opportunity of requesting, within the prescribed period, that the date on which the drawing was filed shall be treated as being, for the purposes of this Act, the date of filing the application, and—~~

~~—(a) if the applicant makes any such request, the date of filing the drawing shall be so treated;~~

~~—(b) if the request is not made, any reference to the drawing in the application shall be deemed to be deleted.~~

~~—(4) If any drawing referred to in the application has not been filed, the Controller shall invite the applicant to file the drawing within the prescribed period, and—~~

~~—(a) if the drawing is subsequently filed within the prescribed period, the date on which it is filed shall be treated for the purposes of this Act as the date of filing the application;~~

~~–(b) if the drawing is not so filed, any reference to the drawing in the application shall be deemed to be deleted.~~

~~–(5) If in the case of an application which has a date of filing by virtue of the foregoing provisions of this section, or is deemed to have a date of filing accorded to it by virtue of section 24 or 81, one or more claims or the abstract has not been filed within the relevant prescribed period, the application shall be deemed to have been withdrawn at the end of that period.~~

23.—(1) The date of filing of a patent application shall be taken to be the earliest date on which the applicant paid the filing fee and filed documents which contain—

(a) an indication that a patent is sought,

(b) information identifying the applicant or information sufficient to enable that person to be contacted by the Office, and

(c) (i) a description of the invention for which a patent is sought even where the description does not comply with other requirements of this Act or with any requirements that may be prescribed, or

(ii) a reference, complying with any relevant requirements that may be prescribed, to a previously filed application made by the applicant or the applicant's predecessor in title.

(2) It is immaterial for the purposes of subsection (1)(c)(i) whether the description of the invention concerned is in, or is accompanied by a translation into, a language accepted by the Office in accordance with any requirements that may be prescribed.

(3) If the Minister prescribes a later date for payment of the filing fee under section 18(3), the date of filing referred to in subsection (1) shall be the date on which the documents referred to in subsection (1) are filed.

(4) Where documents filed at the Office do not satisfy all of the conditions specified in subsection (1), the Controller shall as soon as practicable after the filing of those documents notify the applicant of the further documents required to be filed in order for the application to have a date of filing.

(5) Where documents filed at the Office satisfy all the conditions specified in subsection (1), the Controller shall as soon as practicable after the filing of the last of those documents notify the applicant of—

(a) the date of filing the application, and

(b) the requirements that must be complied with, and the periods within which they are required by this Act or rules made under this Act to be complied with, if the application is not to be treated as having been withdrawn.

(6) If any drawing or a part of a description referred to in the application is filed later than the date of filing accorded to the application by virtue of subsection (1), the Controller shall give the applicant an opportunity of requesting, within the prescribed

period, that the date on which the drawing or that part of the description was filed shall be treated as being, for the purposes of this Act, the date of filing the application, and—

(a) if the applicant makes any such request, the date of filing the drawing or that part of the description shall be so treated,

(b) if the request is not made, any reference to the drawing or that part of the description in the application shall be deemed to be deleted.

(7) If any drawing or part of a description referred to in the application has not been filed, the Controller shall invite the applicant to file the drawing or that part of the description within the prescribed period, and—

(a) if the drawing or part of the description is subsequently filed within the prescribed period, the date on which it is filed shall be treated for the purposes of this Act as the date of filing the application,

(b) if the drawing or part of the description is not so filed, any reference to the drawing or part of the description in the application shall be deemed to be deleted.

(8) Where the applicant, subsequent to the date of filing under subsection (1), files a missing part of the description or a missing drawing, subsection (6)(a) or (7)(a) shall not apply where—

(a) on or before the date which is the date of filing the application under subsection (1) a declaration is made under section 26(1) in, or in connection with, the application, and

(b) the applicant makes a request for subsection (6)(a) or (7)(a), as the case may be, not to apply and that request complies with the prescribed requirements and is made within the prescribed period.

(9) An application which has a date of filing under this section or is deemed to have a date of filing accorded to it by virtue of section 24 or 81 shall be treated as withdrawn where any of the following applies:

(a) the filing fee has not been paid within the prescribed period;

(b) one or more claims or the abstract has not been filed within the relevant prescribed period;

(c) where a reference to a previously filed application has been filed as referred to in subsection (1)(c)(ii), the applicant fails to file at the Office—

(i) a description of the invention for which a patent is sought, before the end of the prescribed period,

(ii) a copy of the application referred to, complying with the relevant prescribed requirements, before the end of the prescribed period.

(10) This section applies to patent applications filed on or after the coming into operation of this section.*

Divisional application.

24.—A patent application (a "divisional application") which—

(a) is in respect of subject-matter which does not extend beyond the content of an earlier application as filed, and

(b) complies with the relevant requirements (including procedure and time limits) specified in the rules,

shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.

Priority right.

25.—(1) A person who has duly filed in or for the State, or in or for any other state party to the Paris Convention for the Protection of Industrial Property [or to the Agreement establishing the World Trade Organisation](#)*, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a subsequent patent application under this Act in respect of the same invention, a right of priority during such period as may be prescribed, subject to compliance with any prescribed conditions and the payment of any prescribed fee.

(2) Every filing that is equivalent to a regular national filing under the national law of the state where it was made (including the State), or under bilateral or multilateral agreements, shall be recognised as giving rise to a right of priority.

(3) In this section "a regular national filing" means any filing that establishes the date on which the application was filed, whatever may be the outcome of the application.

(4) (a) A subsequent application for the same subject-matter as a previous first application and filed in or in respect of the same state (including the State) shall be considered as the first application for the purposes of determining priority if, and only if, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without having been open to public inspection and without having left any rights outstanding, and has not served as a basis for claiming right of priority.

(b) Where, pursuant to this subsection, a subsequent application is considered as a first application, the first application may not thereafter serve as a basis for claiming a right of priority.

(5) If the first filing has been made in a state which is not a party to the Paris Convention for the Protection of Industrial Property [or which is not a party to the Agreement establishing the World Trade Organisation](#)* subsections (1) to (4) shall

* Patents Amendment Act 2006 [31/2006]

apply if the Government makes an order to that effect under this subsection consequent upon bilateral or multilateral agreements under which the State grants on the basis of a first filing made in or for that state and subject to conditions equivalent to those laid down in the said convention, a right of priority having equivalent effect.

(6) In this section a ‘state party to the Agreement establishing the World Trade Organisation’ means a member of the World Trade Organisation and, for the purposes of subsection (5), every country or territory shall be taken to be a state in the case of which an order may be made under that subsection.*

Claiming priority.

26.—(1) An applicant desiring to take advantage of the priority of a previous application shall file, in the prescribed manner and within the prescribed period, a declaration of priority. Rules made under this Act may require the filing of a copy of the previous application and, if the language of the latter is a foreign language, a translation in English.

(2) Multiple priorities may be claimed in respect of a patent application, notwithstanding the fact that they originated in different states, and, where appropriate, multiple priorities may be claimed for any one claim, and where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

(3) If one or more priorities are claimed in respect of a patent application, the right of priority shall cover only those elements of the patent application which are included in the application or applications whose priority is claimed.

(4) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted if the documents of the previous application as a whole specifically disclosed such elements.

Effect of priority right.

27.—(1) The right of priority shall have the following effect, namely, the date of priority shall be regarded as being the date of filing of the patent application for the purposes of subsections (2) and (3) of section 11 and section 16 (2).

(2) Where a patent application is filed and the priority of a previous application is claimed under section 26, then, notwithstanding anything contained in this Act, the patent application and any patent granted in pursuance of it shall not be invalidated by reason only of the fact that any subject-matter disclosed in the previous application was made available to the public at any time after the date of filing of the previous application.

Publication of application.

28.—(1) A patent application shall be published in the prescribed manner as soon as practicable after the expiry of the period of eighteen months beginning on the date of

filing, or, if priority has been claimed, beginning on the date of priority; provided that at the request of the applicant the application may be published before the expiry of the period aforesaid.

(2) Subject to subsection (3), a patent application shall not be published if, before the termination of the technical preparations for publication, it has been finally refused or withdrawn or has been deemed to have been withdrawn.

(3) A patent application which forms the basis for a divisional application under section 24 shall be published with its divisional application unless it has already been published under subsection (1).

(4) The Controller shall advertise the date of publication of a patent application in the Journal.

(5) The Controller may cause to be omitted from the published patent application—

(a) statements or other matter contrary to public order or morality;

(b) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person; provided that mere comparisons with the prior art shall not be considered disparaging per se.

CHAPTER IV

PROCEDURE UP TO GRANT

Search report.

29.—(1) If a patent application under this Part has a date of filing, includes one or more claims and is not withdrawn or deemed to be withdrawn the Controller shall, on the request of the applicant made within the prescribed time, accompanied by the prescribed fee (in this section referred as the ‘section 29 fee’), cause a report incorporating a written opinion as to patentability to be prepared in relation to the invention (in this section and section 30 referred to as the ‘section 29 report and opinion’). Rules made under this Act may specify who shall prepare the section 29 report and opinion (including any part thereof) and the scope thereof. (~~“the search fee”~~) cause a search to be undertaken in relation to the invention and a report (a “search report”) of the results of the search to be prepared. The rules may specify by whom the search report shall be prepared and the scope thereof.

(2) ~~If it appears, in the course of the search, that an application discloses more than one invention the search shall be conducted in relation only to the first invention specified in the claims. A search may however be conducted in relation to the additional invention, or inventions, if the applicant, within the time allowed by the Controller, submits a request to that effect accompanied by the search fee.~~

(2) If it appears, in the course of the preparation of the section 29 report and opinion, that an application discloses more than one invention, the section 29 report and opinion shall be prepared in relation only to the first invention specified in the claims. A further section 29 search and opinion may be prepared in relation to any additional invention if the applicant, within the time allowed by the Controller for the purpose, submits a request to that effect accompanied by the section 29 fee.

(3) The Controller shall send a copy of the ~~search report~~ section 29 report and opinion to the applicant and, unless the application is withdrawn within a prescribed period, shall publish it.

~~(4) If the application is not withdrawn, the Controller shall allow the applicant an opportunity to amend the application in the light of the search report or reports. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, either to submit amendments to the application or a statement that no amendment is considered necessary, the application may be refused by the Controller. In the case of an application to which subsection (2) applies, such application shall be amended so as to confine it to one invention only.~~

(4) If the application is not withdrawn, the Controller shall allow the applicant an opportunity to amend the application in the light of the section 29 reports and opinions. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, to submit either amendments to the application or a statement setting out the applicant's reasons why the applicant considers that no such amendments are necessary, the application may, subject to section 90, be refused by the Controller. An application to which subsection (2) applies shall be amended so as to confine it to one invention only.

(5) If the applicant, in pursuance of subsection (4), submits amendments or a statement referred to in that subsection within the prescribed period, the Controller shall cause a substantive examination of the application to be carried out. Such substantive examination shall have regard to the application as originally filed together with any amendments or statement furnished under subsection (4) and shall investigate if the application complies with the requirements of this Act and of rules made under this Act.

Use of foreign specification or search report.

30.—(1) In lieu of making the request provided for in section 29 (1), an applicant for a patent under this Part may, within the time, prescribed for the purpose of section 29 (1), submit a statement to the Controller that an application for a patent for the same invention has been made in a prescribed foreign state or under the provisions of any prescribed convention or treaty and where such a statement is submitted the applicant shall submit, within the prescribed period, such evidence as may be prescribed of either—

~~(a) the results of the search carried out on the said application, or~~

(a) the results of the equivalent (or, taken together, the equivalents), in that prescribed foreign state or under the provisions of that prescribed convention or treaty (as the case may be), to a section 29 report and opinion prepared in respect of such application, or

(b) the grant of a patent in pursuance of the said application.

(2) The applicant shall, if so required by the Controller, also furnish to the Controller within the prescribed time such information as may be prescribed with regard to the filing of foreign applications for protection of the invention for which a patent is sought.

(3) The evidence submitted under subsection (1) shall be accompanied by the prescribed fee. Unless the application is subsequently withdrawn within a prescribed period the evidence shall be published by the Controller.

~~(4) Where the evidence submitted is that referred to in subsection (1) (a) the Controller shall, unless the application is withdrawn, allow the applicant an opportunity to amend the application in the light of that evidence. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, either to submit amendments to the application or a statement that no amendment is considered necessary, the application may be refused by the Controller.~~

~~(5) Where the evidence submitted is that referred to in subsection (1) (b) the Controller shall, unless the application is withdrawn, allow the applicant an opportunity to amend the application in the light of that evidence. The applicant shall in particular submit such amendments as are required to the specification so that the subject matter claimed therein does not extend beyond that of the evidence. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, either to submit amendments to the application or a statement that no amendment is considered necessary the application may be refused by the Controller.~~

(4) Where the evidence submitted is that referred to in subsection (1)(a) or (b), the Controller shall, unless the application is withdrawn, allow the applicant an opportunity to amend the application in the light of that evidence. The applicant shall in particular submit such amendments as are required to the specification so that the subject-matter claimed therein does not extend beyond that of the evidence. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, to submit either amendments to the application, or a statement setting out the applicant's reasons why the applicant considers that no such amendments are necessary, the application may, subject to section 90, be refused by the Controller.

(5) If the applicant, in pursuance of subsection (4), submits amendments or a statement referred to in that subsection within the prescribed period, the Controller shall cause a substantive examination of the application to be carried out. Such substantive examination shall have regard to the application as originally filed together with the evidence furnished under subsection (1) and any amendments or statement furnished under subsection (4) and shall investigate if the application complies with the requirements of this Act and of rules made under this Act.

~~-(6) Any amendment or statement submitted in pursuance of subsections (4) and (5) or section 29 (4) shall, where a duly authorized patent agent acts on behalf of the applicant, be submitted by such agent.~~

Observations by third party on patentability

30A. —

- (1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the Controller on the question of whether the invention is a patentable invention, stating reasons for the observations, and the Controller shall consider the observations in accordance with rules made under this Act.
- (2) A person who makes observations under this section does not, by reason only of those observations, become a party to any proceedings under this Act.

Refusal or grant of patent.

31.—(1) If it appears to the Controller, following the substantive examination and investigation carried out in pursuance of section 29(5) or 30(5), that an application does not comply with a requirement of this Act or the rules made thereunder, (other than and in particular the requirements of sections 9 (1), 11, 13, 14, 19 and 20) the Controller shall so inform the applicant and if the applicant, within the time specified by the Controller, fails to satisfy the Controller that the said requirement is complied with or to amend the application so as to comply therewith the Controller may, subject to section 90, refuse the application.

~~—(2) Nothing in subsection (1) shall preclude the Controller from refusing, or requiring amendment of, a patent application by reference to any requirement of a section mentioned in that subsection which may be specified in rules.~~

(2) If the Controller finds that the application as originally filed or as amended in accordance with subsection (1) complies with the requirements of this Act and of rules made under this Act, the Controller shall grant the patent.

(3) A patent shall not be granted by the Controller until he has requested the applicant to pay the prescribed fee for the grant of a patent and the applicant has paid the said fee within the prescribed time. If the said fee is not so paid, the application shall be deemed to be withdrawn.

(4) The grant of a patent shall be notified to the applicant in the prescribed form.

(5) Where two or more patent applications for the same invention having the same date of filing or the same date of priority are filed by the same applicant or his successor in title, the Controller may on that ground refuse to grant a patent in respect of more than one of the applications.

Amendment of application.

32.—(1) At any time before a patent is granted under this Act an applicant may, in accordance with the prescribed conditions, amend the application of his own volition.

(2) Any amendment made under this section or under section 29, 30 or 31 shall be invalid to the extent that it extends the subject matter disclosed in the application as filed.

(3) The Controller may refuse an amendment under this section if, in his opinion, it ought properly to have been submitted under the provisions of section 29 or 30.

(4) Where an amendment of an application under this section or under section 29, 30 or 31 involves alterations to the specification or any drawing the applicant shall, if requested to do so, file a fresh specification or drawing, as the case may require, within the time specified by the Controller.

Withdrawal of application.

33.—(1) At any time before a patent is granted under this Act the applicant may withdraw in writing his application and any such withdrawal may not be revoked.

(1A) Subsection (1) does not affect the power of the Controller under section 110 to correct an error or mistake in the withdrawal of an application.*

(2) Where a patent application is withdrawn under this section, or is deemed under this Act to have been withdrawn, or is refused under any provision of this Act, the following provisions shall apply:

(a) if the application has been published under section 28, the provisions of section 11 (3) shall continue to apply as regards the application;

(b) the applicant shall continue to enjoy the right of priority under section 25 which he enjoyed immediately before such withdrawal or refusal;

(c) no other right may be claimed under this Act in relation to the application.

Notification of grant; publication of specification.

34.—(1) The Controller shall as soon as practicable after a patent has been granted publish a notice of the grant in the Journal.

(2) At the same time as the publication of the notice of a grant, the Controller shall publish a specification of the patent containing the description and claims, and drawings (if any), and also such matters and information as appear to him to be useful or important.

Continuation in force of applications.

35.—(1) A pending application shall lapse at the end of the period prescribed for the payment of any renewal fee if the fee is not paid, within that period or within that period as extended under this section.

(2) The period prescribed for payment of any renewal fee shall be extended by such period, not being a period of more than six months, as may be specified in a request made in that behalf by the applicant to the Controller if the request is made and the prescribed additional fee paid before the expiration of the period of extension so specified.

(3) The provisions of section 37 shall apply to an application to which this section relates as if the references in that section to a patent and the proprietor of a patent were references to a patent application and the applicant for a patent, respectively.

Reinstatement of applications.

35A.—(1) This section shall not apply to a patent application which has lapsed by reason of the failure to pay any renewal fee and section 35(3) shall continue to apply to any such application.

(2) Where an application for a patent is refused or is treated as having been withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules made thereunder within a period which is prescribed or specified by the Controller, subject to subsection (3), the Controller shall reinstate the application only if—

- (a) the applicant requests the Controller to do so,
- (b) the request complies with the prescribed requirements, and
- (c) the Controller is satisfied that the said failure to comply occurred despite reasonable care having been taken to so comply.

(3) The Controller shall not reinstate the application if the period referred to in subsection (2) is prescribed or specified by the Controller—

- (a) in relation to any proceedings before the Controller pursuant to Part VIII,
- (b) for the purposes of section 25(1), or
- (c) for the purposes of a request under this section or section 118A.

(4) Where the application for a patent was made by 2 or more persons jointly, a request under subsection (2) may, with the leave of the Controller, be made by one or more of them without joining the others.

(5) Where the application has been published under section 28 and it appears to the Controller that reasonable care was taken to comply with the requirement within the prescribed period or, as the case may be, the period specified by the Controller, the Controller shall publish notice of a request under subsection (2) in the Journal and within the prescribed period any person may give notice to the Controller of opposition thereto.

(6) If notice of opposition is duly given under this section, the Controller shall notify the applicant and determine the question.

(7) Where an application is reinstated under this section the applicant shall comply with the requirement referred to in subsection (2) within the further period specified by the Controller in making the order to reinstate the application, which further period shall not be less than 2 months.

(8) Where the applicant fails to comply with subsection (7) the application shall be treated as having been withdrawn on the expiration of the period referred to in that subsection.

Effect of reinstatement.

35B.—(1) Where an application is reinstated under section 35A—

(a) anything done under or in relation to the application during the period between termination and reinstatement shall be treated as valid,

(b) in a case where the application has been published under section 28 before its termination, anything done during the period referred to in paragraph (a), which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred, shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights,

(c) in a case where the application has been published under section 28 before its termination and, after the termination and before publication of a notice of request for its reinstatement, a person—

(i) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or

(ii) made, in good faith, effective and serious preparations to do such an act, the person shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the reinstatement of the application and the grant of the patent.

(2) Paragraph (c) of subsection (1) does not extend to granting a licence to any person to do an act referred to in that paragraph.

(3) If the act referred to in paragraph (c) of subsection (1) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by the said paragraph (c) may—

(a) authorise that act to be done by any partner of that person for the time being in that business, and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(4) Where a product is disposed of by any person to another person in exercise of a right conferred by paragraph (c) of subsection (1) or by subsection (3), that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.

(5) In this section ‘termination’, in relation to an application, means—

- (a) the refusal of the application, or
- (b) the application is treated as having been withdrawn.*

CHAPTER V

PROVISIONS AS TO PATENTS AFTER GRANT

Term of patent.

36.—(1) A patent shall take effect on the date on which notice of its grant is published in the Journal and, subject to subsection (2), shall continue in force until the end of the period of twenty years beginning with the date of filing of the patent application.

(2) A patent shall lapse at the end of the period prescribed for payment of any renewal fee if the fee is not paid within that period or within that period as extended under this section.

(3) The period prescribed for payment of any renewal fee shall be extended by such period, not being a period of more than six months, as may be specified in a request made in that behalf by or on behalf of the proprietor of the patent to the Controller if the request is made and the prescribed additional fee paid before the expiration of the period of extension so specified.

(4) The Minister may by order alter the period for which a patent shall remain in force for the purpose of giving effect to a provision of any international treaty, convention or agreement relating to the term of protection of a patent to which the State is or proposes to become a party.

Restoration of lapsed patents.

37.—(1) Where a patent has lapsed by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 36 (3), an application may be made to the Controller, within two years from the date on which the patent lapsed, for the restoration of the patent.

(2) An application under this section may be made by the person who was the proprietor of the patent or by his personal representative, and where the patent was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.

(3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee, and the Controller may require from the applicant such further evidence as he may think necessary.

(4) If the Controller is satisfied that the failure to pay the renewal fee was prima facie unintentional, that reasonable care had been taken to ensure payment of the fee within

* Patents Amendment Act 2006 [31/2006]

the prescribed period and that there has not been undue delay in the making of the application, he shall advertise the application in the Journal, and within the prescribed period any person may give notice to the Controller of opposition thereto.

(5) If notice of opposition is duly given under this section, the Controller shall notify the applicant and shall determine the question.

(6) If the Controller decides to allow an application under this section for restoration, he shall upon payment of any unpaid renewal fee and of such additional fee as may be prescribed, make a restoration order in accordance with the application.

~~(7) An order under this section for the restoration of a patent—~~

~~—(a) may be made subject to such conditions as the Controller thinks fit, including in particular a condition requiring the entry in the register of any matter in respect of which the provisions of this Act as to entries in the register is not complied with; and~~

~~—(b) shall be subject to such provisions as are prescribed for the protection of persons who, during the period beginning on the date on which the patent lapsed and ending on the date of the order under this section, may have begun to avail themselves of the invention which is the subject of the patent,~~

~~—and if any condition to which an order under this section is subject is not complied with by the proprietor of the patent, the Controller may revoke the order and give such directions consequential on the revocation as he thinks fit.~~

(7) An order under this section for the restoration of a patent may be made subject to such conditions as the Controller thinks fit, including, in particular, a condition requiring the entry in the register of any matter in respect of which the provisions of this Act as to entries in the register is not complied with and if any condition to which an order under this section is subject is not complied with by the proprietor of the patent, the Controller may revoke the order and give such directions consequential on the revocation as he thinks fit.

(8) An order under this section for the restoration of a patent shall have the following effect:

(a) anything done under or in relation to the patent during the period beginning on the date on which the patent lapsed and ending on the date of an order under this section shall be treated as valid;

(b) anything done during the period referred to in paragraph (a) which would have constituted an infringement if the patent had not lapsed shall be treated as an infringement—

(i) if it was done at a time when it was possible for the patent to be renewed during the period of extension specified for the purpose of section 36(3), or

(ii) if it was a continuation or repetition of an earlier infringing act;

(c) where, after the expiration of the period of extension specified for the purpose of section 36(3) and before the date of publication of the application for restoration of the patent in the Journal under subsection (4), a person—

(i) began in good faith to do an act which would constitute an infringement of the patent if it had not lapsed, or

(ii) made in good faith effective and serious preparations to do such an act,

the person shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the patent.

(9) Paragraph (c) of subsection (8) does not extend to granting a licence to any person to do an act referred to in that paragraph.

(10) If the act referred to in paragraph (c) of subsection (8) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by the said paragraph (c) may—

(a) authorise that act to be done by any partner of that person for the time being in that business, and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(11) Where a product is disposed of by any person to another person in exercise of a right conferred by paragraph (c) of subsection (8) or by subsection (10), that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.*

Amendment after grant.

38.—(1) Subject to the following provisions of this section, the Controller may, on an application made in the prescribed manner by the proprietor of a patent, allow the specification of the patent to be amended, subject to such terms as to advertising the proposed amendment and such other conditions, if any, as he thinks fit; provided that no such amendment shall be allowed where there are pending before the Court or the Controller proceedings in which the validity of the patent has been or may be put in issue.

(2) In any proceedings before the Court or the Controller in which the validity of a patent is put in issue, the Court or, as may be appropriate, the Controller may, subject to the following provisions of this section, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the Court or the Controller thinks fit.

(3) An amendment of a specification under this section shall be invalid to the extent that it extends the subject matter disclosed in the application as filed or the protection conferred by the patent.

(4) An amendment of a specification under this section shall have effect and be deemed always to have had effect from the date of the grant of the patent.

(5) Where an application for leave to amend a specification has been advertised in accordance with subsection (1) or (2), any person may give within the prescribed period notice to the Court or the Controller, as may be appropriate, of his opposition to an amendment proposed by the proprietor of the patent, and if he does so shall notify the proprietor and the Court or the Controller shall consider the opposition in deciding whether the amendment, or any other amendment, should be allowed.

(6) Where an application for an order under this section is made to the Court, the applicant shall notify the Controller who shall be entitled to appear and be heard on the hearing of the application and shall so appear if so directed by the Court.

(7) In considering whether or not to allow an amendment proposed under this section the Court or the Controller shall have regard to any relevant principles applicable under the European Patent Convention.*

Surrender of patent.

39.—(1) A proprietor of a patent may at any time by written notice given to the Controller offer to surrender his patent.

(2) Where an offer is made under this section, the Controller shall advertise the offer in the prescribed manner and any person interested may, within the prescribed period commencing on the date of the publication of the advertisement, give notice to the Controller of opposition to the proposed surrender.

(3) Where notice of opposition is duly given under this section the Controller shall notify the proprietor of the patent and determine the question.

(4) Subject to subsection (3), if the Controller is satisfied that a patent may properly be surrendered, he may accept the offer.

(5) As from the date when notice of acceptance is published in the Journal the patent shall cease to have effect but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the service of the State.

CHAPTER VI

THE EFFECTS OF A PATENT AND A PATENT APPLICATION

Prevention of direct use of invention.

* Patents Amendment Act 2006 [31/2006]

40.—A patent while it is in force shall confer on its proprietor the right to prevent all third parties not having his consent from doing in the State all or any of the things following:

(a) making, offering, putting on the market or using a product which is the subject-matter of the patent, or importing or stocking the product for those purposes;

(b) using a process which is the subject-matter of the patent, or, when the third party knows, or it is obvious to a reasonable person in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, offering the process for use in the State;

(c) offering, putting on the market, using or importing, or stocking for those purposes, the product obtained directly by a process which is the subject-matter of the patent.

Prevention of indirect use of invention.

41.—(1) A patent while it is in force shall also confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply in the State a person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it is obvious in the circumstances to a reasonable person, that the said means are suitable and intended for putting that invention into effect.

(2) Subsection (1) shall not apply when the means referred to therein are staple commercial products, except when the third party induces the person supplied to commit acts which the proprietor of a patent is enabled to prevent by virtue of section 40.

(3) Persons performing acts referred to in paragraph (a), (b), or (c) of section 42 shall not be considered to be parties entitled to exploit an invention pursuant to subsection (1).

Limitation of effect of patent.

42.—(1) The rights conferred by a patent shall not extend to—

(a) acts done privately for non-commercial purposes;

(b) acts done for experimental purposes relating to the subject-matter of the relevant patented invention;

(c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription issued by a registered medical practitioner or acts concerning the medicine so prepared;

(d) the use on board vessels registered in any of the countries of the Union of Paris for the Protection of Industrial Property [or in any of the members of the World Trade Organisation](#), other than the State, of the invention which is the

subject of the patent, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the territorial waters of the State, provided that the invention is used in such waters exclusively for the needs of the vessel;

(e) the use of the invention which is the subject of the patent in the construction or operation of aircraft or land vehicles of countries of the Union of Paris for the Protection of Industrial Property [or of members of the World Trade Organisation](#)*, other than the State, or of such aircraft or land vehicle accessories when such aircraft or land vehicles temporarily or accidentally enter the State;

(f) the acts specified in Article 27 of the Convention on International Civil Aviation, where those acts concern the aircraft of countries, other than the State, benefiting from the provisions of that Article,

(g) acts done in relation to the subject matter of the relevant patented invention which consist of:

(i) acts done in conducting the necessary studies, tests and trials which are conducted with a view to satisfying the application requirements of paragraphs 1, 2, 3 and 4 of Article 10 of Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 (as last amended by Directive 2004/27/EC of the European Parliament and of the Council of 31 March 2004) for a marketing authorisation in respect of a medicinal product for human use, or

(ii) acts done in conducting the necessary studies, tests and trials which are conducted with a view to satisfying the application requirements of paragraphs 1 to 5 of Article 13 of Directive 2001/82/EC of the European Parliament and of the Council of 6 November 2001 (as last amended by Directive 2004/28/EC of the European Parliament and of the Council of 31 March 2004) for a marketing authorisation in respect of a veterinary medicinal product, or

(iii) any other act which is required as a consequence of the acts referred to in subparagraph (i) or (ii) for the purposes specified in those subparagraphs, as appropriate.*

(h) insofar as paragraph (g) does not apply, acts done in relation to the subject matter of the relevant patented invention which consist of—

(i) acts done in conducting studies, tests, experiments and trials (including clinical trials and field trials) with a view to satisfying the application requirements for a marketing authorisation or similar instrument (howsoever described) that is required by the

* Patents Amendment Act 2006 [31/2006]

* SI 50/2006 European Communities (Limitation of Effect of Patent) Regulations

* Intellectual Property (Miscellaneous Provisions) Act 2014 [36/2014]

law of the State or of any other state in order to sell or supply or offer to sell or supply—

- (I) a medicinal product for human use, within the meaning of subsection (2), or
- (II) a veterinary medicinal product, within the meaning of subsection (2),

or

- (ii) any other act done which is required as a consequence of the acts referred to in subparagraph (i) for the purposes specified in that subparagraph, as appropriate.

(2) In this section (other than paragraph (g) of subsection (1))—

‘medicinal product for human use’ means—

(a) any substance or combination of substances having or purporting to have properties for treating or preventing disease in human beings,

or

(b) any substance or combination of substances which may be used on or be administered to human beings with a view either to restoring, correcting or modifying physiological functions by exerting a pharmacological, immunological or metabolic action, or to making a medical diagnosis;

‘substance’ means any matter of—

(a) human origin (including human blood and human blood products),

(b) animal origin (including micro-organisms, whole animals, parts of organs, animal secretions, toxins, extracts and blood products),

(c) vegetable origin (including micro-organisms, plants, parts of plants, vegetable secretions and extracts), or

(d) chemical origin (including elements, naturally occurring chemical materials and chemical products obtained by chemical change or synthesis);

‘veterinary medicinal product’ means—

(a) any substance or combination of substances having or purporting to have properties for treating or preventing disease in animals, or

(b) any substance or combination of substances which may be used on or be administered to animals with a view either to restoring, correcting or modifying

physiological functions by exerting a pharmacological, immunological or metabolic action, or to making a medical diagnosis.*

Limitation of rights.

43.—The rights conferred by a patent shall not extend to any act which, pursuant to any obligations imposed by the law of the Treaties establishing the European Communities, cannot be prevented by the proprietor of the patent.

Rights conferred by patent application after publication.

44.—(1) A patent application shall, on and from the date of its publication under section 28, provisionally confer upon the applicant such protection as is conferred by virtue of sections 40 to 43.

(2) A patent application shall be deemed never to have had the effects set out in subsection (1) if it is withdrawn, is deemed to be withdrawn or is finally refused.

Extent of protection.

45.—(1) The extent of the protection conferred by a patent or a patent application shall be determined by ~~the terms of~~ the claims; nevertheless, the description and drawings shall be used to interpret the claims.

(2) For the period up to the grant of a patent, the extent of the protection conferred by the patent application shall be determined by the latest filed claims contained in the publication under section 28; however, ~~the terms of~~ the claims of the patent as granted or as amended in accordance with section 38 shall determine the extent of protection conferred by section 44; provided that the foregoing provisions of this subsection shall not be construed as granting to an applicant protection greater than that sought by him at the date of publication under section 28.

(3) In the interpretation of this section, the Court shall have regard to the directions contained in the Protocol on the Interpretation of Article 69 of the European Patent Convention and set out in the Second Schedule to this Act.

~~(Deleted by 2006 Act)~~

Burden of proof.

46.—(1) If the subject-matter of a patent or patent application is a process for obtaining a new product, the same product when produced by a person other than the proprietor or applicant, as the case may be, shall, in the absence of sufficient evidence to raise an issue as to whether the product was obtained by that or another process, be deemed to have been obtained by the process which is such subject-matter.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the Court shall have regard to the interest of the defendant in the protection of his manufacturing and business secrets, and for that purpose the Court may, if it

* Intellectual Property (Miscellaneous Provisions) Act 2014 [36/2014]

thinks fit, hear or receive evidence on behalf of the defendant in the absence of any other party to the proceedings.

(3) (a) Any party to infringement proceedings may, in the absence of every other party to the proceedings, apply to the Court for an order under this subsection.

(b) If in considering an application for an order under this subsection the Court is satisfied that—

(i) the applicant is in possession of a manufacturing or commercial secret, and

(ii) the secret (evidence of which shall be given in the absence of any party to the proceedings other than the applicant) is such as would enable the applicant to discharge the burden imposed by this section, and

(iii) in the circumstances of the case to require the disclosure (otherwise than on the application) of the secret would be unreasonable, the Court shall allow the application.

(c) Where the Court makes an order under this subsection, the burden imposed under this section shall, in relation to the relevant infringement proceedings, be regarded as having been discharged by the applicant.

CHAPTER VII

INFRINGEMENT

Action for infringement of patent.

47.—(1) Civil proceedings for infringement of a patent may be brought in the Court by the proprietor of the patent in respect of any act of infringement which he alleges he is entitled under sections 40 to 43 and section 45 to prevent and (without prejudice to any other jurisdiction of the Court) in those proceedings a claim may be made—

(a) for an injunction restraining the defendant from any apprehended act of such infringement;

(b) for an order requiring the defendant to deliver up or destroy any product covered by the patent in relation to which the patent is alleged to have been infringed or any article in which the product is inextricably comprised;

(c) for damages in respect of the alleged infringement;

(d) for an account of the profits derived by the defendant from the alleged infringement;

(e) for a declaration that the patent is valid and has been infringed by the defendant.

(2) The Court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

Proceedings for infringement by co-owner.

48.—(1) In the application of sections 40 to 43 to a patent of which there are two or more joint proprietors each of the references therein to the proprietor shall be construed—

(a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 80 or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and

(b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 80 or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless all the others are made parties to the proceedings as defendants, but any of the others who, pursuant to the requirements of this subsection, is made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Restrictions on recovery of damages for infringement.

49.—(1) In proceedings for the infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that that patent existed, and a person shall not be deemed to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word "patent" or "patented" or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the relevant patent accompanied the word or words in question.

(2) In proceedings for infringement of a patent the Court may, if it thinks fit, refuse to award any damages or make any order in respect of any infringement committed during an extension period specified in a request under subsection (3) of section 36 but before the payment of the renewal fee and any additional fee prescribed for the purpose of that subsection.

(3) Where an amendment of a specification of a patent has been allowed under this Act, no damages shall be awarded in any proceedings for an infringement of the patent committed before the date of the decision allowing the amendment, unless the Court is satisfied that the specification of the patent, as originally published, was framed in good faith and with reasonable skill and knowledge.

Relief for infringement of partially valid patent.

50.—(1) If in proceedings for infringement of a patent the validity of the patent is put in issue and it is found that the patent is only valid in part, the Court may grant relief in respect of that part of the patent which is found to be valid and infringed; provided that the Court shall not grant relief by way of damages or costs except in the circumstances mentioned in subsection (2).

(2) Where in proceedings for the infringement of a patent the plaintiff proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, the Court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under subsection (1) or subsection (2) the Court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section 38, and such an application may be made whether or not all other issues in the proceedings have been determined.

(4) The Court may also grant relief under this section in the case of a European patent designating the State on condition that the claims are limited to the Court's satisfaction by the European Patent Office at the request of the proprietor.*

Proceedings for infringement by exclusive licensee.

51.—(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the like right as the proprietor of the patent to take proceedings in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings the Court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as a result of the infringement or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any proceedings taken by the holder of an exclusive licence by virtue of this section the proprietor of the relevant patent shall, unless he is joined as plaintiff in the proceedings, be added as defendant; provided that a proprietor added as a defendant in pursuance of this subsection shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Certificate of contested validity of patent.

52.—(1) If in any proceedings before the Court the validity of a patent to any extent is contested and the patent is found by the Court to be wholly or partially valid, the Court may certify the finding and the fact that the validity of the patent was contested.

(2) Where any certificate has been granted under subsection (1), then if, in any subsequent proceedings before the Court for infringement of the patent or before the Court or the Controller for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and own client.

Remedy for groundless threats of infringement proceedings.

53.—(1) Where any person (whether entitled to or interested in a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for

* Patents Amendment Act 2006 [31/2006]

infringement of a patent, any person aggrieved thereby may bring proceedings in the Court against him for any such relief as is mentioned in subsection (2).

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent, the plaintiff shall be entitled to the following relief, that is to say—

(a) a declaration to the effect that the threats complained of were unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) such damages, if any, as have been sustained by him by reason of the threats.

~~–(3) Proceedings may not be brought under this section as regards a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.~~

(3) Proceedings may not be brought under this section as regards—

(a) a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or

(b) a threat, made to a person who made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.*

(4) For the purposes of this section a notification of the existence of a patent or a patent application does not of itself constitute a threat of proceedings.

Power of Court to make declaration as to non-infringement.

54.—(1) A declaration that the use by any person of any process, or the making or use or sale by any person of any product, does not and would not constitute an act of infringement of a patent may be made by the Court in proceedings between the person and the proprietor of the patent or the holder of an exclusive licence under the patent, notwithstanding the fact that no assertion to the contrary has been made by the proprietor or licensee, if it is shown that—

(a) the plaintiff has applied in writing to the proprietor or licensee for a written acknowledgement the effect of which, if given, would be similar to that of the declaration claimed, and has furnished him with full particulars in writing of the process or product in question; and

(b) the proprietor or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in proceedings for a declaration made by virtue of this section shall, unless for special reasons the Court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a patent in whole or in part shall not be called in question in proceedings for a declaration made by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

Right to continue use begun before date of filing or priority.

55.—(1) Where a patent is granted for an invention, a person who in the State before the date of filing of the patent application or, if priority was claimed, before the date of priority, does in good faith an act which would constitute an infringement of the patent if it were then in force, or makes in good faith effective and serious preparations to do such an act, shall have the rights specified in subsection (2).

(2) The rights referred to in subsection (1) are the following:

(a) the right to continue to do or, as the case may be, to do the act referred to in subsection (1),

(b) if such act was done or preparations had been made to do it in the course of a business—

(i) in the case of an individual—

(I) the right to assign the right to do it or to transmit such right on death, or

(II) the right to authorize the doing of the act by any of his partners for the time being in the business in the course of which the act was done or preparations had been made to do it;

(ii) in the case of a body corporate, the right to assign the right to do it or to transmit such right on the body's dissolution;

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1)

(4) Where a product which is the subject of a patent is disposed of by any person to another in exercise of a right conferred by subsection (2), that other and any person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole proprietor of the patent.

Action for infringement of published application.

56.—(1) After a patent has been granted the proprietor may bring civil proceedings in the Court for infringement of the patent application by any act committed in the period,

beginning on the day after the date of publication of the application pursuant to section 28 and ending on the day before the date of publication of the notice of the grant of the patent, which he alleges he is entitled by virtue of sections 44 and 45 to prevent and in such proceedings a claim for damages may be made in respect of an alleged infringement.

(2) The provisions of sections 48 to 53 and section 55 relating to infringement of a patent shall apply, in so far as they are appropriate, to proceedings under this section.

(3) In considering the amount of any damages to be awarded in proceedings under this section, the Court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 28, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to have infringed those rights, and if the Court finds that it would not have been reasonable so to expect, it shall reduce the damages to such an amount as it thinks fit.

CHAPTER VIII

REVOCATION

Application for revocation of patent.

57.—(1) Subject to the following provisions of this section and section 58, any person may apply to the Court or the Controller for revocation of a patent.

(2) An application for the revocation of a patent on the ground mentioned in section 58 (e) may be made only by a person found by the Court pursuant to section 81 (2) to be entitled to be granted that patent or to be granted a patent for part of the matter covered by the patent, or, in case more than one person is found to be so entitled, by all those persons.

(3) An application under this section may be filed even if the patent has lapsed.

(4) The application for revocation of a patent shall be made in the prescribed manner and it shall not be deemed to have been filed until the fee prescribed in relation to such applications has been paid.

(5) Where proceedings with respect to a patent are pending in the Court under any provision of this Act, no application may be made to the Controller under this section in relation to the patent without the leave of the Court.

(6) Where the Controller has not disposed of an application made to him under this section, the applicant may not apply to the Court under this section in respect of the patent concerned unless either—

(a) the proprietor of the patent agrees that the applicant may so apply, or

(b) the Controller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the Court.

Grounds for revocation.

58.—An application for revocation of a patent may be made only on the grounds that—

(a) the subject-matter of the patent is not patentable under this Act;

(b) the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the matter disclosed in the specification of the patent extends beyond that disclosed in the application as filed, or, if the patent was granted on an application which by virtue of section 24 or 81 is deemed to have been filed on the date of filing of an earlier application, it extends beyond that disclosed in the earlier application as filed;

~~(d) the protection conferred by the patent has been extended by an amendment of the application or the specification of the patent;~~

(d) the protection conferred by the patent has been extended by an amendment which should not have been allowed;*

(e) the proprietor of the patent is not entitled thereto under section 16 (1).

Examination of application for revocation.

59.—(1) If the application for revocation of a patent is admissible, the Court or the Controller, as may be appropriate, shall consider whether the grounds for revocation mentioned in section 58 prejudice the maintenance of the patent.

(2) If on an application for revocation of a patent the Court or the Controller considers that the grounds for revocation mentioned in section 58 prejudice the maintenance of the patent, the Court or the Controller, as may be appropriate, may by order unconditionally revoke the patent.

(3) If on an application for revocation of a patent the Court or the Controller considers that the grounds for revocation mentioned in section 58 affect the patent only in part, the Court or the Controller, as may be appropriate, may make an order for the revocation of the patent unless within a time specified by the Court or the Controller the relevant specification is amended, ~~under section 38~~, to the satisfaction of the Court or the Controller.

(4) For the purposes of subsection (3), the reference to the specification being amended is to its being amended under section 38 and also, in the case of a European patent designating the State, to its being amended under any provision of the European Patent Convention under which the claims of the patent may be limited by amendment at the request of the proprietor.*

* Patents Amendment Act 2006 [31/2006]

* Patents Amendment Act 2006 [31/2006]

Controller's power to revoke patents on his own initiative.

60.—(1) If it appears to the Controller that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 11 (3), he may on his own initiative by order revoke the patent, but he shall not do so without giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent in accordance with section 38 so as to exclude any matter which formed part of the state of the art as aforesaid.

(2) If it appears to the Controller that—

(a) a patent under this Part and a European patent designating the State have been granted for the same invention, and

(b) the applications for both patents have the same date as their date of filing or, where priority was claimed, their date of priority, and

(c) the applications for both patents were filed by the same applicant or his successor in title,

the Controller shall give the proprietor of the patent under this Part an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the Controller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, he shall revoke the patent.

(3) The Controller shall not take action under subsection (2) before—

(a) the end of the period for filing an opposition to the European patent designating the State under the European Patent Convention, or

(b) if later, the date on which any opposition proceedings under the Convention are finally disposed of;

and he shall not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention.

Circumstances in which validity of patent may be put in issue.

61.—(1) Subject to the following provisions of this section, the validity of a patent may be put in issue only on a ground which is one of the grounds specified in section 58, and, in addition to the foregoing, such validity shall be raised only—

(a) by way of defence in proceedings for infringement under section 47 or 56, or

(b) in proceedings under section 53 or 57, or

(c) pursuant to section 77.

(2) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground specified in section 58 (e) unless—

(a) it has been determined, either in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue, that the patent should have been granted to him and not some other person; and

(b) except where it has been so determined in entitlement proceedings,

(i) the proceedings in which the validity of the patent is in issue are commenced before the end of the period of two years beginning on the date of the grant of the patent, or

(ii) it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(3) In subsection (2) "entitlement proceedings", in relation to a patent, means proceedings, whether by way of a reference under section 81 or otherwise, to determine the question whether a patent was granted to a person not entitled to it.

(4) It is hereby declared that, for the purposes of this Act, the validity of a patent is not put in issue by reason only of the fact that the Controller considers its validity in order to decide whether or not to revoke it under section 60.

Controller to be given notice of Court proceedings.

62.—The Controller shall be given notice in writing by the plaintiff or proprietor, as the case may be, of any proceedings for infringement under section 47 or 56 or of any proceedings before the Court where, under section 61, the validity of a patent is put in issue and of the decision of the Court in respect of any such proceedings.

PART III

SHORT-TERM PATENTS

Application for short-term patent.

63.—(1) An application under this Part may be made for a patent the term of which shall be ten years in lieu of the term provided for by or under section 36 in respect of a patent granted under Part II.

(2) A patent granted on such an application is referred to in this Part as a short-term patent.

(3) Part II shall apply to a short-term patent and an application for a short-term patent as it applies to a patent and an application for a patent under that Part subject to the necessary modifications and to the provisions of this Part.

(4) An invention shall be patentable under this Part if it is new and susceptible of industrial application provided it is not clearly lacking an inventive step.

(5) An application for a short-term patent shall be filed at the Office in the prescribed manner and be in the prescribed form.

(6) Rules made under Part II in relation to patent applications shall apply to an application for a short-term patent as they apply to an application under that Part except so far as otherwise prescribed, and different rules may be made in relation to short-term patents and applications for short-term patents.

(7) An application for a short-term patent shall—

(a) contain a request for the grant of a short-term patent;

(b) contain a specification which—

(i) describes the invention and the best method of performing it known to the applicant,

(ii) incorporates one or more claims, but not exceeding five, defining the matter for which protection is sought, which claims shall be clear and supported by the description, and

(iii) is accompanied by any drawing referred to in the description, claim or claims and an abstract to which section 22 shall apply.

(8) The application shall be accompanied by the prescribed filing fee unless the Minister prescribes a later date by which the fee may be paid.

Patent under Part II and a short-term patent not to co-exist for same invention.

64.—Where an application for a patent under Part II and an application for a short-term patent have been filed by the same applicant in respect of the same invention, then—

(a) the short-term patent, if granted first, shall be deemed void upon the grant of a patent under Part II,

(b) the short-term patent application shall, if pending on the date of grant of a patent under Part II, be deemed abandoned as of that date.

Provisions relating to short-term patents and applications therefor.

65.—(1) Sections 29, 30 and 35 shall not apply in respect of an application for a short-term patent. Sections 44 and 56 shall have effect in relation to such an application subject to section 66.

(2) Sections 40 to 43 shall have effect in relation to short-term patents subject to section 66.

(3) If a short-term patent is granted before the expiry of the period referred to in section 28 (1), the application shall be published at the same time as the publication provided for in section 34 (1).

Actions for infringement.

66.—(1) Civil proceedings for infringement under section 47 or 56 shall not be instituted against any person by the proprietor of a short-term patent until he has—

(a) made a request to the Controller, accompanied by the prescribed fee, to cause a search to be undertaken in relation to the invention and a report (a "search report") of the results of the search to be prepared, and

(b) received from the Controller a copy of the search report and furnished a copy to that person.

(2) The Controller shall publish the search report referred to in subsection (1).

(3) In lieu of making the request referred to in subsection (1) (a) the applicant may, if an application for a patent for the same invention has also been filed in a prescribed foreign state or under the provisions of any prescribed convention or treaty, submit to the Controller the evidence referred to in section 30 (1); and proceedings may not be instituted until after the Controller has published any evidence so submitted to him and the proprietor has sent a copy thereof to the person concerned.

(4) The proceedings referred to in subsection (1) may be brought in the Circuit Court irrespective of the amount of a claim.

(5) References to the Court in sections 47, 49, 50, 51, 52, 54, 56 and 62 in relation to an action for infringement of a short-term patent shall be construed as including references to the Circuit Court.

(6) The Minister may, by rules, permit any person other than the proprietor to make a request to the Controller to cause a search report to be prepared in relation to an invention which is the subject of a short-term patent. The rules may specify that such a request shall be subject to the payment of any prescribed fee. A search report prepared under this subsection shall be published by the Controller.

Special ground for revocation of short-term patent.

67.—Section 58 shall, so far as relevant, apply to an application for the revocation of a short-term patent: provided, however, that it shall also be a ground for revocation of a short-term patent that the claims of the specification of the patent are not supported by the description.

PART IV

VOLUNTARY AND COMPULSORY LICENCES

Application for entry in register that licences of right are available.

68.—(1) At any time after the grant of a patent the proprietor of the patent may apply to the Controller for an entry to be made in the register to the effect that licences under the patent are to be available as of right, and where such an application is made, the Controller shall give notice of the application to any person entered on the register as being entitled to an interest in the patent, and if the Controller is satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent he shall make such entry.

(2) Where an entry is made under this section in the register the following provisions shall apply:

(a) any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement, be settled by the Controller on the application of the proprietor or the person requiring the licence,

(b) the Controller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right upon terms to be settled as aforesaid,

(c) if in proceedings for infringement of the patent (~~otherwise than by the importation of goods~~) (otherwise than by the importation of goods from a country which is not a member of the World Trade Organisation)* the defendant undertakes to take a licence upon terms to be settled by the Controller as aforesaid, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement,

(d) the renewal fees payable in respect of the patent after the date of entry shall be one half of the renewal fees which would be payable if the entry had not been made.

(3) The licensee under any licence of right granted by virtue of this section shall (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) be entitled to require the proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the proprietor refuses or neglects to comply with a requirement under this subsection within two months after being so required, the licensee may institute proceedings for the infringement in his own name as if he were the proprietor, and in case such proceedings are initiated, the proprietor of the patent shall be made a defendant; provided that a proprietor who is so made a defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) An application for an entry under this section shall contain a statement (to be verified in such manner as may be prescribed) that the proprietor of the patent to which the application relates is not precluded by contract from granting licences under the patent, and the Controller may require from the proprietor such further evidence in this regard as he may think necessary.

(5) All entries in the register under this section shall be published in the Journal and in such other manner (if any) as the Controller thinks desirable for bringing the entry to the notice of the public.

Cancellation of entry.

69.—(1) At any time after an entry has been made under section 68, the proprietor of a patent may apply to the Controller for cancellation of the entry, and where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the Controller may, if satisfied that there is no existing licence under the patent, or that all licensees under the patent have consented to such cancellation, cancel the entry.

(2) If, within the prescribed period after an entry has been made under section 68, any person claims that the proprietor of the patent concerned is, and was at the time when the entry was made, by a contract in which the claimant is interested precluded from granting licences under the patent, he may apply to the Controller for cancellation of the entry.

(3) Where the Controller is satisfied, on application made under subsection (2), that the proprietor of a patent is and was precluded in the manner mentioned in subsection (2), he shall cancel the entry referred to in that subsection, and thereupon the proprietor shall be liable to pay, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and if the sum is not paid within the said period the patent shall cease to have effect on the expiration of the said period.

(4) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent to which the entry relates shall thereafter be the same as if the entry had not been made.

(5) The Controller shall advertise in the prescribed manner any application made to him under this section and within the prescribed period after publication of such advertisement notice of opposition to the cancellation sought may be given to the Controller by—

(a) in the case of an application under subsection (1), any person, and

(b) in the case of an application under subsection (2), the proprietor of the patent to which the application relates.

(6) Where a notice of opposition is given under subsection (5), the Controller shall notify the applicant before determining the application.

Compulsory licences.

~~70.—(1) At any time after the expiration of the period of three years, or such other period as may be prescribed, beginning on the date of the publication of notice of grant of a patent any person may apply to the Controller for a licence under the patent, or for an entry in the register to the effect that licences under the patent are to be available as of right, on one or more of the grounds specified in subsection (2).~~

~~—(2) The grounds referred to in subsection (1) are the following:~~

~~—(a) that the invention which is the subject of the patent, being capable of being commercially worked in the State, is not being commercially worked therein or is not being so worked to the fullest extent that is reasonably practicable;~~

~~—(b) that a demand in the State for a product which is protected by the patent is not being met, or is not being met on reasonable terms, or is being met to a substantial extent by importation;~~

~~—(c) that the commercial working in the State of the invention which is the subject of the patent is being prevented or hindered by the importation of a product which is protected by the patent;~~

~~—(d) that by reason of the refusal of the proprietor to grant a licence or licences on reasonable terms—~~

~~—(i) a market for the export of a product which is protected by the patent and is manufactured in the State is not being supplied; or~~

~~—(iii) the working or efficient working in the State of any other invention which is the subject of a patent and which makes a substantial contribution to the art is prevented or hindered; or~~

~~—(iii) the establishment or development of commercial or industrial activities in the State is unfairly prejudiced;~~

~~—(e) that by reason of conditions imposed by the proprietor upon the grant of licences under the patent, or upon the purchase, hire or use of the product or process which is the subject of the patent, the manufacture, use or sale of materials not protected by the patent or the establishment or development of commercial or industrial activities in the State is unfairly prejudiced;~~

~~—(f) that a condition which by virtue of section 83 is null and void has been included in a contract in relation to the sale or lease of, or licence to use or work, any product or process protected by the patent.~~

~~—(3) Subject as hereinafter provided, the Controller may, on an application being made under this section, if satisfied that any of the grounds specified in subsection (2) are established, make an order in accordance with the application, and where the order is for the grant of a licence, it may require the licence to be granted upon such terms as the Controller thinks fit; provided that—~~

- ~~–(a) where the application is made on the grounds that the invention which is the subject of the relevant patent is not being commercially worked in the State or is not being worked to the fullest extent that is reasonably practicable, and it appears to the Controller that the time which has elapsed since the grant of the patent has for any reason been insufficient to enable it to be so worked, he may by order adjourn the application for such period as will, in his opinion, give sufficient time for the invention to be so worked;~~
- ~~–(b) an order shall not be made under this section for an entry in the register on the ground that a market for the export of the product which is protected by the relevant patent is not being supplied, and any licence granted under this section on that ground shall contain such provisions as appear to the Controller to be expedient for restricting the countries in which the product may be sold or used by the licensee;~~
- ~~–(c) no order shall be made under this section in respect of a patent on the ground that the working or efficient working in the State of another invention which is the subject of a patent is prevented or hindered unless the Controller is satisfied that the proprietor of the patent of which the other invention is the subject is able and willing to grant to the proprietor of the patent and his licensees a licence in respect of that other invention on reasonable terms;~~
- ~~–(d) any licence granted under this section shall be both non-exclusive and non-transferable;~~
- ~~–(e) the terms of any licence so granted may be so framed as to preclude the licensee from importing into the State any goods the importation of which the proprietor of the patent has the right to prevent, and in case the said terms are so framed the proprietor of the patent and all licensees under the patent shall be deemed to have mutually covenanted against such importation;~~
- ~~–(f) in settling the terms of any licence granted under this section in respect of a patent which relates to food or medicine the Controller shall endeavour to secure that food and medicine shall be available to the public at the lowest prices consistent with the proprietors of patents deriving reasonable remuneration having regard to the nature of the inventions.~~
- ~~–(4) The Controller shall, in determining whether to make an order in pursuance of an application under this section, take account of the following matters, that is to say—~~
 - ~~–(a) the nature of the relevant invention, the time which has elapsed since the grant of the patent and the measures already taken by the proprietor or any licensee to make full use of the invention;~~
 - ~~–(b) the ability of any person to whom a licence would be granted under the order to work the invention to the public advantage; and~~
 - ~~–(c) the risks to be undertaken by that person in providing capital and working the invention if the application is granted;~~
- ~~–but he shall not be required to take account of matters subsequent to the making of the application.~~

~~–(5) An application under this section may be made by any person notwithstanding the fact that he is already the holder of a licence under the patent, and no person shall be estopped from alleging any of the matters mentioned in subsection (2) by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.~~

~~–(6) Section 68 (3) shall apply to a licence granted in pursuance of an order under this section as it applies to a licence granted by virtue of section 68.~~

70.—(1) At any time after the expiration of the period of three years, or such other period as may be prescribed, beginning on the date of the publication of notice of grant of a patent any person may apply to the Controller for a licence under the patent, or for an entry in the register to the effect that licences under the patent are to be available as of right, on any or all of the following grounds:

(a) that—

(i) a demand in the State for the subject matter of the patent is not being met or is not being met on reasonable terms, or

(ii) a demand in the State for a product which is protected by the patent is being met by importation other than from a member of the World Trade Organisation;

(b) that the establishment or development of commercial or industrial activities in the State is unfairly prejudiced.

(2) If an invention protected by a patent (in this section referred to as ‘the second patent’) cannot be exploited in the State without infringing rights deriving from another patent (in this section referred to as ‘the first patent’) the proprietor of the second patent may apply to the Controller for a licence under the first patent to the extent necessary for the exploitation of the invention concerned, provided that such invention involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

(3) Where an application is made under this section, if the Controller is satisfied—

(a) that any of the grounds specified in subsection (1) are established, or

(b) that an invention protected by a patent cannot be exploited without infringing rights deriving from the first patent as referred to in subsection (2), the Controller may make an order in accordance with the application and, where the order is for the grant of a licence, the order may require the licence to be granted upon such terms as the Controller thinks fit, provided that:

(i) any licence granted shall be nonexclusive;

(ii) any licence granted shall be predominantly for the supply of the market in the State;

(iii) any licence granted may only be assigned with the prior authorisation of the Controller and with that part of the enterprise or goodwill which uses the patented invention and, in the case of a licence granted on an application under subsection (2) in respect of the first patent, the licence may only be assigned by the proprietor of the second patent in conjunction with the assignment of the second patent;

(iv) a licence shall only be granted subject to the payment to the proprietor of the patent of adequate remuneration in the circumstances of the case, taking into account the economic value of the licence;

(v) the scope and duration of the licence shall be limited to the purpose for which it is granted;

(vi) any licence granted on an application under subsection (1) in respect of a patent which relates to semi-conductor technology shall only be for public non-commercial use;

(vii) no order shall be made on an application under subsection (2) unless the proprietor of the second patent is able and willing to grant the proprietor of the first patent and the licensee of that proprietor a cross-licence, on reasonable terms, to use the invention claimed in the second patent.

(4) The Controller shall, in determining whether to make an order pursuant to an application under this section, take account of the following matters, namely—

(a) the nature of the relevant invention, the time which has elapsed since the grant of the patent and the measures already taken by the proprietor or any licensee to make full use of the invention,

(b) the ability of any person to whom a licence would be granted under the order to exploit the patent to the public advantage, and

(c) the risks to be undertaken by that person in providing capital and exploiting the patent if the application is granted.

(5) Section 68(3) shall apply to a licence granted pursuant to an order under this section as it applies to a licence granted by virtue of section 68.

Provisions as to compulsory licences.

~~71.—(1) Where the Controller is satisfied, on application made under section 70, that the manufacture, use or sale of materials not protected by the relevant patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent upon the grant of licences under the patent, or upon the purchase, hire or use of the product or process which is the subject of the patent, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.~~

~~—(2) Where an application under section 70 is made by a person being the holder of a licence under the relevant patent, the Controller may, if he makes an order under~~

~~section 70 for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making such an order, order the existing licence to be amended.~~

71.—(1) Where an order for the grant of a licence or for an entry in the register has been made pursuant to an application under section 70, any person may apply to the Controller to amend or cancel the order on the grounds that the circumstances which led to the order have changed or have ceased to exist and are unlikely to recur.

(2) Where the Controller is satisfied that the circumstances referred to in subsection (1) have changed or have ceased to exist and are unlikely to recur, the Controller may order the amendment or cancellation of the existing order upon such terms as the Controller thinks fit, including, in particular, terms which provide for the protection of the interests of the licensee concerned.

(3) Section 73 shall, in so far as it is applicable, apply in relation to an application under subsection (1).

(4) Where, following an application under subsection (1), an order is amended, subsections (1), (2) and (3) shall, in so far as they are applicable, apply in relation to the order so amended.*

Licences, etc. on application of Minister of Government.

72.—(1) At any time after the expiration of the period of three years beginning on the date of the publication of notice of grant of a patent, or such other period as may be prescribed under section 70 (1), any Minister of the Government may apply to the Controller upon any one or more of the grounds specified in section 70 for an entry in the register to the effect that licences under the patent are to be available as of right, or for the grant to any person specified in the application of a licence under the patent, and the Controller may, if satisfied that any of those grounds are established, make an order in accordance with the application.

(2) Sections 70 (3) and 71 shall, so far as applicable, apply in relation to an application and an order made under this section as they apply in relation to an application and an order under section 70.

Procedure on applications under sections 70 and 72.

73.—(1) Every application under section 70 or 72 shall specify the nature of the order sought by the applicant and shall contain a statement (to be verified in such manner as may be prescribed) setting out the nature of the applicant's interest (if any) and the facts upon which the application is based and shall be accompanied by evidence indicating that the applicant sought to obtain a licence from the proprietor of the patent but has been unable to obtain such a licence on reasonable terms and within a reasonable time.

(1A) The Controller may, when so requested by the applicant, dispense with the evidence referred to in subsection (1)—

(a) where there exists a national emergency or other circumstances of extreme urgency, or

(b) in the case of an application for a licence for public non-commercial use:

Provided that the proprietor of the relevant patent has been informed as soon as reasonably practicable of the intention of the applicant to apply to the Controller for a licence under the patent.*

(2) Where the Controller is satisfied, upon consideration of any application referred to in subsection (1), that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the proprietor of the relevant patent and any other persons appearing from the register to be interested in the patent in respect of which the application is made, and shall advertise the application in the Journal.

(3) The proprietor of the relevant patent or any other person desiring to oppose an application referred to in subsection (1) may, within such time as may be prescribed, give to the Controller notice of opposition.

(4) A notice of opposition given under this section shall contain a statement (to be verified in such manner as may be prescribed) setting out the grounds on which the relevant application is opposed.

(5) Where a notice of opposition is duly given under this section, the Controller shall notify the applicant and shall, subject to the provisions of section 74 with respect to arbitration, determine the question.

Appeals and references to arbitrator.

74.—(1) On any appeal from any order made by the Controller in pursuance of an application under ~~section 70 or 72~~ section 70, 71 or 72* the Attorney General shall be entitled to appear and be represented.

(2) Where an application is opposed and either—

(a) the parties consent; or

(b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot, in the opinion of the Controller, conveniently be made before him,

the Controller may at any time order the whole proceedings, or any question or issue of fact arising therein, to be referred to an arbitrator agreed on by the parties, or, in default of agreement, appointed by the Controller.

(3) Where the whole proceedings are referred under this section, ~~section 35 of the Arbitration Act, 1954 (which relates to the statement of cases by arbitrators for the decision of the Court), shall not apply to the arbitration; but~~* unless the parties

* Patents Amendment Act 2006 [31/2006]

* Arbitration Act 2010

otherwise agree before the award of the arbitrator is made, an appeal to the Court shall lie from the award.

(4) Where a question or issue of fact is referred under this section, the arbitrator shall report his findings to the Controller.

Supplementary provisions as to licences.

75.—(1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order.

(2) An order may be made on an application under ~~section 70 or 72~~ [section 70, 71 or 72*](#) for an entry in the register to the effect that licences under the relevant patent are to be available as of right notwithstanding any contract which would have precluded the making of such an entry in respect of the patent on the application of the proprietor of the patent under section 68, and any such order shall for all purposes have the same effect as an entry made in pursuance of an application under section 68.

(3) No order shall be made in pursuance of any application under ~~section 70 or 72~~ [section 70, 71 or 72*](#) which would be at variance with the Treaty establishing the European Economic Community [or with the TRIPs Agreement*](#).

PART V

USE OF INVENTIONS FOR THE SERVICE OF THE STATE

Assignment of invention, application, or patent to Minister of Government.

76.—(1) Any inventor, or any applicant for or proprietor of a patent, may (either for or without valuable consideration) make to a Minister of the Government, and such Minister may take on behalf of the State, an assignment of the whole of or any share or interest in the benefit of an invention, of a patent application therefor, or of any patent obtained or to be obtained therefor, and where a Minister of the Government takes any such assignment, such Minister may do, or, as may be appropriate, join in doing, on behalf of the State, all or any of the following things, that is to say—

(a) develop and perfect such invention,

(b) form or promote an incorporated company or an unincorporated association of persons to develop and perfect such invention,

(c) sell or lease any such patent application or patent or grant licences under any such application or patent on such terms as he shall, with the agreement of the Minister for Finance, think proper,

* [Patents Amendment Act 2006 \[31/2006\]](#)

(d) form or promote an incorporated company or an unincorporated association of persons to work commercially any such invention,

(e) do all such things as may be necessary for the maintenance or preservation of any such application or patent or be otherwise incidental to the ownership thereof.

(2) Every Minister of the Government shall, before the 1st day of April in every year, lay before each House of the Oireachtas a report of every (if any) exercise by him during the year ending on the previous 31st day of December of the several powers conferred on him by paragraph (c) or (d) of subsection (1) and also, if and so far as he considers it to be in the public interest, of any or all of the powers conferred by paragraph (a), (b) or (e) of subsection (1).

(3) All expenses incurred by a Minister of the Government under this section shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas.

Right to use inventions for service of State.

77.—(1) A patent and a patent application shall have to all intents the like effect as against the State as it has individual; provided that any Minister of the Government may, by himself or by such of his officers, servants or agents as may be authorized in writing by him or by any other person acting on his behalf at any time after the making of an application for a patent, do for the service of the State any of the following acts in the State in relation to an invention which is the subject of the application or patent, without the consent of the applicant for or the proprietor of the patent, that is to say—

(a) where the invention is a product, make, use, import or stock the product or dispose of or sell or offer to dispose of or sell it to any person;

(b) where the invention is a process, use it or do in relation to any product obtained directly by means of the process anything mentioned in paragraph (a);

(c) supply or offer to supply to any person any of the means, relating to an essential element of that invention, for putting the invention into effect.

(2) Any thing done by virtue of subsection (1) in relation to an invention which is the subject of an application or a patent, is subsequently in this section and in section 78 referred to as "use of the invention" and the doing of any such thing shall not amount to an infringement of the application or patent concerned.

(3) Use of an invention under this section shall be subject to such terms as may, either before or after the use thereof, be agreed on, with the approval of the Minister for Finance, by any Minister of the Government and the applicant for or the proprietor of the patent relating to the invention, or, in default of agreement, as may be settled in the manner hereinafter provided, and the terms of any agreement or licence concluded between such applicant or proprietor and any person other than a Minister of the Government shall not operate to prevent or regulate the use of the invention for the service of the State.

(4) Where an invention which is the subject of any patent or application for a patent has, before the date of filing, or, where priority is claimed, the priority date of the application, been duly recorded in a document by, or been tried by or on behalf of any Minister of the Government (such invention not having been communicated directly or indirectly by the applicant for or the proprietor of the relevant patent), any Minister of the Government or such of his officers, servants or agents as may be authorized in writing by him, may use the invention so recorded or tried for the service of the State free of any royalty or other payment to the applicant for or the proprietor of the patent, notwithstanding the existence of the application or patent, and, if in the opinion of such Minister the disclosure to the applicant or the proprietor, as the case may be, of the document recording the invention or the evidence of the trial thereof would be detrimental to the public interest, such disclosure may be made confidentially to counsel on behalf of such applicant or proprietor or to any independent expert mutually agreed upon.

(5) Where any use of an invention is made by or with the authority of a Minister of the Government under this section, then, unless it appears to such Minister that it would be contrary to the public interest so to do, the Minister shall notify the applicant for or the proprietor of a patent (if any) relating to the invention as soon as practicable after the use is begun and furnish him with such information as to the extent of the use as he may from time to time reasonably require.

(6) In the case of any dispute as to or in connection with the use of an invention under this section or the terms therefor, or as to the existence or scope of any record or trial referred to in subsection (4), the matter shall be referred to the Court for decision, and the Court shall have the power to refer the whole matter or any question or issue of fact arising thereon to be heard by an arbitrator upon such conditions as it may direct; the Court or arbitrator in settling the dispute shall be entitled to take into consideration any benefit or compensation which the applicant for or proprietor of a patent (if any) relating to the invention or any other person interested in such application or in such patent may have received directly or indirectly from the State in respect of such application or patent.

(7) In any proceedings under this section the Minister of the Government who is a party to the proceedings may—

(a) put in issue the validity of the relevant patent without applying for its revocation;

(b) if the proprietor of a patent is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 58.

(8) The right to use an invention for the service of the State under the provisions of this section shall include a power to dispose of or sell, or offer to dispose of or sell, any products made in pursuance of such right which are no longer required for the service of the State.

(9) Any person who acquires products disposed of or sold in the exercise of powers conferred by this section and any person claiming through him shall have power to deal with the products in the same manner as if they had been made pursuant to a patent held on behalf of the State.

(10) In this section "service of the State" means a service financed out of moneys charged on or advanced out of the Central Fund or moneys provided by the Oireachtas or by a local authority for the purposes of the Local Government Act, 1941 .

Use of inventions pursuant to section 77; supplementary provisions.

78.—(1) During any period when an order under subsection (2) (a) is in force the power exercisable in relation to an invention by a Minister of the Government, or a person authorized by a Minister of the Government under section 77, shall include power to use the invention for any purpose which appears to such Minister to be necessary or expedient—

(a) for the maintenance of supplies and services essential to the life of the community;

(b) for securing a sufficiency of supplies and services essential to the well-being of the community;

(c) for promoting the productivity of commerce and industry, including agriculture;

(d) generally for ensuring that the whole resources of the community are available for use and are used, in a manner best calculated to serve the interests of the community;

(e) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory other than the State that is in grave distress; or

(f) for ensuring the public safety and the preservation of the State.

(2) (a) Where the Government are of opinion that, owing to the existence of exceptional circumstances, it is desirable in the interests of the community that a power conferred by subsection (1) shall be available, they may by order declare that the power shall be available.

(b) Where an order under paragraph (a) of this subsection is for the time being in force and the Government are of the opinion that the exceptional circumstances referred to in that paragraph no longer exist, they shall by order revoke the first-mentioned order.

PART VI

PROPERTY IN PATENT APPLICATIONS AND PATENTS CONTRACT CONDITIONS

Nature of patent applications and patents.

79.—Subject to section 80, the rules of law applicable to the ownership and devolution of personal property shall apply in relation to patent applications and patents as they apply in relation to other choses in action.

Co-ownership of patent applications and patents.

80.—(1) Where a patent is applied for by, or is granted to, two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in common in the patent application or patent, as the case may be.

(2) Subject to the provisions of this section where two or more persons are entered in the register as applicants for or proprietors of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to do in respect of the invention concerned for his own benefit without accounting to the others any act which would, apart from this sub-section, amount to an infringement of the patent application or patent concerned.

(3) Subject to any agreement for the time being in force, a licence under a patent or a published patent application shall not be granted, and a share in a patent or in any such application shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are entered in the register as applicants for or proprietors of the patent.

(4) Subject to the provisions of this section, where two or more persons are entered in the register as applicants for or proprietors of a patent, any other person may supply one of those persons with means, relating to an essential element of the relevant invention, for putting the invention into effect, and the supply of those means by virtue of this section shall not amount to an infringement of the patent application or patent.

(5) Where a product is sold by one of two or more persons who are entered in the register as applicants for or proprietors of a patent in respect of the product, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the product had been sold by a sole applicant for or sole proprietor of a patent relating to the product.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Determination of entitlement to patents, etc.

81.—(1) Any person may refer to the Court the question whether, by operation of law or otherwise, he is entitled (alone or jointly with any other person) to any patent granted or to be granted in the State for an invention, and the Court may make such order (including an order of apportionment) for giving effect to its decision as it considers expedient.

(2) The Court on a reference under this section, or in the exercise of any declaratory or other jurisdiction, shall not determine a question whether a patent was granted to a person not entitled to be granted the patent if the reference was made or the action was commenced after the end of the period of two years beginning on the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer or assignment of the patent to him, that he was not entitled to the patent.

(3) An order under this section shall not be made so as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(4) When the Court finds on a reference under this section, or in the exercise of any declaratory or other jurisdiction, that a patent was granted to a person who was not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 57 the Court or Controller makes an order by reason of the persons not being so entitled for the conditional or unconditional revocation of the patent, the Court or Controller may order that the person by whom the application was made or his successor in title may make a new patent application—

(a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent, and

(b) in the case of conditional revocation, for the matter which in the opinion of the Court or the Controller should be excluded from the specification by amendment under section 38,

and when such a new application is made, it shall be treated as having been filed on the date of filing of the application for the patent to which the reference or other proceedings relate and shall have the benefit of any right to priority.

(5) A new patent application shall not be allowed to be filed under subsection (4) in respect of subject-matter which extends beyond the content of the original patent application.

Effect of change of proprietorship.

82.—(1) Where there is a complete change of proprietorship of a patent as a result of an order of the Court transferring the patent to one or more persons none of whom immediately before the transfer had a proprietary interest in the patent (on the ground that the patent was granted to a person who was not entitled to be granted the patent), then, subject to subsection (2), licences and other rights which, as regards the relevant patent, were in force immediately before such transfer shall lapse upon the entry in the register of the name of the person or persons entitled to the patent.

(2) Where an order referred to in subsection (1) is made, the Controller shall notify the person or persons registered as proprietor or proprietors of the relevant patent and their licensees (if any) of whom he is aware, of the making of the order, and where the proprietor or proprietors or such a licensee acting in good faith has, before the commencement of the proceedings in which the order is made, used the invention within the State or made effective and serious preparations to do so, he may continue such use if, but only if, he requests, within the period prescribed, a non-exclusive licence under the patent from the new proprietor whose name is entered in the register.

(3) A licence granted under subsection (2) shall be for a reasonable period and upon reasonable terms and failing agreement between the parties concerned the terms of the licence shall be determined by the Controller.

Avoidance of certain conditions in contracts.

83.—(1) It shall not be lawful to include in any contract in relation to the sale or lease of, or licence to use or work, any product or process which is the subject of a patent application or patent a condition which, directly or indirectly, would—

(a) prevent or restrict a party to the contract from using any product or process, whether or not the subject of a patent application or patent, which in either case is supplied or owned by any person other than a party to the contract or his nominee;

(b) require any such party to acquire from any other such party, or his nominee, any product which is not the subject of a patent application or a patent;

and any such condition, if so included, shall be null and void; provided that this subsection shall not apply if—

(i) the party seeking to rely on the condition proves that at the time the contract was entered into the party which the condition purports to bind had the option of purchasing the relevant product or obtaining a lease or licence in relation thereto on reasonable terms, without the conditions described in paragraphs (a) and (b) of this subsection; and

(ii) the contract entitles the party to the contract which the condition purports to bind to relieve himself of his liability to observe the condition on giving to the other party three months notice in writing and on the payment of compensation for such relief, in the case of a purchase, of such sum, or in the case of a lease or licence, of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Minister.

(2) In any proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason only of any admission made by him as to the reasonableness of the terms offered to him under paragraph (i) of the proviso to subsection (1).

(3) Any contract for or relating to a lease of or a licence to use or work any product or process which, at the time when the contract is made, is the subject of one or more patent applications or one or more patents may, at any time after the patent or all of the patents, as may be appropriate, by which the product or process was protected or the patent or patents, as may be appropriate, resulting from such application or applications, has or have ceased to be in force, be determined by either party to the contract on giving three months notice in writing to the other party to the contract notwithstanding anything to the contrary contained in that or in any other contract.

(4) The inclusion by the proprietor of or applicant for a patent in a contract of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent or application to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(b) be construed as validating any contract which would, apart from this section, be invalid; or

(c) affect any right of determining a contract or conditions in a contract exercisable independently of this section; or

(d) affect any condition in a contract for the lease of or licence to use a product which is the subject of a patent application or patent, whereby a party to the contract reserves to himself or his nominees the right to supply such new parts of the product as may be required to put or keep it in repair.

PART VII

REGISTER OF PATENTS; EVIDENCE OF REGISTER, DOCUMENTS, ETC.

Register of patents.

84.—(1) There shall continue to be kept at the Office a register to be known as the Register of Patents in which there shall be entered particulars of published patent applications, of patents in force, of assignments and transmissions of, and of licences under, patents and published applications, and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of published applications and patents as the Controller thinks fit.

(2) Rules under this section may make provision for the register, or entries or reproductions of entries in it, to be open to inspection by the public at all convenient times and for copies of any entry in the register to be given to any person requiring them on payment of the prescribed fee.

(3) Rules under this section may make provision for the register, entries therein and reproductions thereof to be made and kept in any form whether by means of writing, printing, lithography, photography, electromagnetism or any electronic or other mode of retaining, storing or reproducing information.

(4) The register shall be prima facie evidence of any matters required or authorized by or under this Act to be entered therein.

(5) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

Assignment, etc. of patent applications and patents.

85.—(1) Where a person becomes entitled by assignment or transmission, operation of law or any other mode of transfer to an interest in a published patent application or a patent, or to a share in such an application or patent, or becomes entitled as mortgagee, licensee or otherwise to any other interest in such an application or patent he shall apply to the Controller in the prescribed manner for the registration of his title as applicant or

co-applicant, proprietor or co-proprietor, or, as the case may be, of notice of his interest, in the register.

(2) An application for the registration in the register of the title of any person becoming entitled by assignment to a published patent application or a patent, or a share in such an application or patent, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in such an application or patent, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to the instrument by which the assignment is made.

(3) Where application is made under subsection (1) or (2) for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction—

(a) that the person is entitled to an interest in a published patent application or a patent, or a share in such an application or patent, register him in the register as applicant or co-applicant for the patent, or proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or event by which he derives title; or

(b) that the person is entitled to any other interest in the application or patent, enter in the register notice of his interest, with particulars of the instrument (if any) creating it.

(4) An entry in the register that a person has an interest in a published patent application, or in a patent by virtue of a mortgage, licence or other instrument, may be cancelled by the Controller if he is satisfied, upon an application's being made in the prescribed manner by the person registered as applicant for the patent or proprietor of the patent, that such interest has ceased, and in case the Controller is so satisfied he shall note in the register the cancellation of such entry.

(5) Subject to the provisions of this Act relating to co-ownership of patent applications and co-ownership of patents, and subject also to any rights vested in any other person of which notice is entered in the register, the person registered as applicant for a patent or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the application or patent, and to give effectual receipts for any consideration for any such assignment, licence or dealings; provided that any equities in respect of the application or patent may be enforced in like manner as equities arising in respect of any other personal property.

(6) Rules under this Act may require the supply for the purposes of this section to the Controller for filing at the Office of copies of such deeds, licences and other documents as may be prescribed.

(7) Except for the purposes of an application to amend the register under section 86, a document in respect of which no entry has been made in the register under subsection (3) shall only be admitted in any court as evidence of the title of any person to a patent application or patent or share of or interest in a patent application or patent if the court so directs.

(8) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent is granted, that, by virtue of any assignment or agreement made by the applicant or one of the applicants, or by a decision under section 81, the claimant

would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller shall direct that the application shall proceed in the name of the claimant or in the names of the claimant and the applicant or each of the other such applicants, according as the case may require; provided that no such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint patent applicants except with the consent of the other joint applicant or each of the other such applicants.

Power of Court to amend register.

86.—(1) Subject to subsection (7), the Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in, or omission from, the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining in the register, or by an error or defect in any entry in the register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The Court may in any proceedings under this section decide any question that it may be necessary or expedient to decide in connection with the amendment of the register.

(3) The prescribed notice of any application under this section shall be given to the Controller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Unless otherwise directed by the Court, the Controller may, in lieu of appearing and being heard, submit to the Court a statement in writing, signed by him, giving particulars of the proceedings before him in relation to the matter in issue, or of the grounds of any decision given by him affecting the same, or of the practice of the Office in like cases, or of such matters relevant to the issues, and within his knowledge as Controller, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceedings.

(5) In the case of fraud in the registration or transmission of a patent application or a patent, the Controller may apply on his own motion to the Court under this section.

(6) Any order of the Court for the amendment of the register shall provide for service of notice of the amendment on the Controller in the prescribed manner and on receipt of any such notice the Controller shall amend the register in accordance with the terms of the order to which the notice relates.

(7) Any application under this section (other than an application by the Controller) may, at the option of the applicant, be made in the first instance to the Controller, and in such case the Controller shall have all the powers of the Court under this section to decide the matter.

Certificate of Controller and certified copies of documents to be evidence.

87.—(1) A certificate purporting to be under the hand of the Controller as to any entry, matter, or thing which he is authorized by this Act to do, or by any rules made thereunder, to make or do, shall be prima facie evidence of the entry having been made,

and of the contents thereof, or, as may be appropriate, of the matter's or thing's having been done or left undone.

(2) Copies or extracts, purporting to be certified by the Controller or an officer of the Controller and sealed with the seal of the Controller, and purporting to be of or from applications for patents, patents, or other documents or books in the Office, or of or from registers kept there shall be admitted in any legal proceedings as prima facie evidence without further proof or production of the originals.

Information about and inspection of patent applications and patents.

88.—(1) After publication of a patent application under section 28 the Controller shall, on a request's being made in the prescribed manner and on payment of the prescribed fee, give the person making the request such information as may be prescribed and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application, as may be specified in the request subject, however, to any prescribed restrictions.

(2) Subject to subsection (3), until a patent application is published under section 28, documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the Controller.

(3) Subsection (2) shall not prevent the Controller from—

(a) sending the European Patent Office information which it is his duty to send that office under the European Patent Convention; or

(b) publishing or communicating any prescribed bibliographic information about an unpublished patent application; or

(c) giving information as to whether an unpublished patent application has been either withdrawn or is deemed to be withdrawn.

Request for search.

89.—The Controller may, on a request being made to him in the prescribed manner by any person, and on payment of the prescribed fee, cause a search to be made as regards any product, process or apparatus specified by the person making the request and amongst such categories of documents as are so specified, being categories of documents which for the time being stand prescribed for the purposes of this section and cause to be furnished the results of such search to the person.

PART VIII

PROCEEDINGS BEFORE THE CONTROLLER OR THE COURT

Exercise of discretionary power by Controller.

90.—Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to any applicant for or proprietor of a patent or to any party in any proceeding before him without giving that applicant, proprietor or party an opportunity of being heard as regards such exercise.

Costs and security for costs.

91.—(1) The Controller may, in any proceeding before him under this Act, order the payment to any party of such costs (if any) as he may consider reasonable, and direct how and by what parties they are to be paid, and any such order may be made a rule of court.

(2) If any party by whom notice of any opposition is given to the Controller under this Act or by whom an application is made to the Controller for the revocation of a patent or for the grant of a licence under a patent, or by whom notice of appeal is given from any decision of the Controller under this Act, neither resides nor carries on business in the State or in such other states as may be prescribed, the Controller, or, in the case of an appeal, the Court, may require the party to give security for the costs of the proceedings and in default of a requirement under this subsection being complied with the Controller or the Court, as may be appropriate, may treat the opposition, application or appeal as abandoned.

Evidence before Controller.

92.—(1) In any proceeding under this or any other enactment before the Controller, (including proceedings under the Trademarks Act 1996,* and the Industrial Designs Act, 2001)* evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Controller thinks it right so to do he may take evidence viva voce in lieu of or in addition to evidence by such declaration.

(2) Any such statutory declaration in pursuance of subsection (1) may in the case of an appeal be used in lieu of evidence on affidavit, but if so used shall have all the incidents and consequences of evidence on affidavit.

(3) The Controller may for the purposes of any of the functions assigned to him by this Act or by any other enactment* do all or any of the following things—

(a) summon witnesses to attend before him;

(b) examine on oath or affirmation (which he is hereby authorized to administer) or permit the examination on oath or affirmation of the witnesses attending before him;

* SI 6/1996 Trademarks Act

* SI 39/2001 Industrial Designs Act

* Patents Amendment Act 2006 [31/2006]

(c) require any such witness to produce to him any document relevant to the proceedings and which is within his power to produce;

(d) permit evidence to be given on affidavit or other sworn testimony instead of, or in addition to, evidence given by statutory declaration, or orally.

(4) A witness summons under this section shall be signed by the Controller.

(5) A witness before the Controller shall be entitled to the same immunities and privileges as if he were a witness before the Court.

(6) If any person—

(a) on being duly summoned as a witness before the Controller makes default in attending, or

(b) being in attendance as witness refuses to take an oath or affirmation duly required by the Controller to be taken, or to produce any document which is within his power to produce and which is duly required by the Controller to be produced by him, or to answer any question to which the Controller may properly require an answer,

he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,000.

Right of audience before Controller.

93.—Any party to a proceeding before the Controller under this Act may be represented by counsel or a solicitor, or by a patent agent who is for the time being registered in the register within the meaning of Part X, or may appear before the Controller in person or be represented by any other person, whom he desires to represent him, being a person to whom section 106 (3) applies.

Privileged communications.

94.—(1) A communication to which this section applies shall be privileged from disclosure in any proceeding (including a proceeding before the Controller or competent authority under the European Patent Convention or the Treaty) to the same extent as a communication between client and solicitor is privileged in any proceeding before a court in the State.

(2) This section applies to a communication—

(a) between a person, or person acting on his behalf and a solicitor or patent agent, or person acting on his behalf, or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a solicitor or patent agent

in relation to any matter concerning the protection of an invention, patent, **design*** or technical information or any matter involving passing off.

~~–(3) In this section "patent agent" means a person registered as a patent agent in the register of patent agents, a company or partnership lawfully practising as a patent agent in the State or a person or partnership who satisfies the condition mentioned in subsection (1) or (3) of section 125.~~

(3) In this section 'patent agent' means-

(a) a person registered as a patent agent in the register of patent agents,

(b) a company or partnership lawfully practicing as a patent agent in the State

(c) a person to whom section 106(3) applies,

or

(d) a person or partnership who satisfies the condition mentioned in subsection (1) or (3) of section 125.*

Assessors.

95.—(1) In an action or proceedings for infringement or revocation of a patent, or other proceedings under this Act, the Court may, if it thinks fit, and shall, on the request of all parties to the proceedings, call in the aid of an assessor specially qualified in the opinion of the Court, and try the case wholly or partially with his assistance.

(2) The Supreme Court may, if it thinks fit, in any proceedings before it relating to a patent application or a patent call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Supreme Court, as may be appropriate, and be paid as part of the expenses incurred by the Minister in the administration of this Act.

Appeals from decisions of Controller.

96.—(1) An appeal to the Court shall lie from any decision or order of the Controller other than a decision under section 22 (2) or section 28 (5).

(2) Any appeal under this Act which concerns a patent application which has not been published shall be heard in private.

(3) In any appeal under this Act the Controller shall be entitled to appear or be represented and be heard in support of his decision and shall appear if so directed by the Court.

* SI 39/2001 Industrial Designs Act

* SI 141/2006 European Communities (Patent Agents) Regulations

(4) In any appeal under this Act the Court may exercise any power which could have been exercised by the Controller in the proceedings from which the appeal is brought.

(5) Rules of court for the conduct of appeals under this Act may include provisions for the appointment of scientific advisers to assist the Court, and for regulating the functions of such advisers; and the remuneration of any such scientific adviser shall be defrayed out of moneys provided by the Oireachtas.

(6) (a) Save where otherwise provided in this Act and subject to paragraph (b), an appeal, except by leave of the Court, from an order or decision of the Controller shall not be entertained unless notice to the Court is given within the period of three months beginning on the date of the order or decision appealed against.

(b) Where a written statement of the grounds of the order or decision of the Controller, in the exercise of his discretionary power, has been requested in the prescribed manner and within the prescribed period by a party to the proceedings, the period of three months shall begin on the date on which the written statement is furnished to the party requesting it.*

(7) An appeal to the Supreme Court from a decision of the Court under this section shall lie only on a question of law.

(8) In an appeal under this Act the Controller shall not be awarded or be ordered to pay costs.

PART IX

THE CONTROLLER: SUPPLEMENTARY PROVISIONS

Appointment of Controller.

97.—(1) ~~(a) The Government shall appoint as occasion arises a fit person to the office of Controller who shall hold office on such terms and conditions as the Government shall, at the time the appointment is made, determine.~~

~~(b) The person holding the office of Controller immediately before the commencement of this section shall continue to hold that office on the same terms and conditions, including conditions as to superannuation or other allowance or gratuity, as those on which he held the office theretofore.~~

(1) (a) The Government shall appoint as occasion arises a person to the office of Controller for a term of 5 years on such terms and conditions as shall be specified by the Government when making the appointment.

(b) A person appointed under paragraph (a) of this subsection, whose term of office expires otherwise than by reason of the person being removed from office, shall be eligible for reappointment.

(c) Notwithstanding paragraphs (a) and (b) of this subsection, a person appointed to the office of Controller shall retire on attaining the age of 65 years.

(d) Without prejudice to paragraphs (a), (b) and (c) of this subsection, the person holding office as Controller, immediately before the commencement of this section, shall hold that office on the same terms and conditions, including conditions as to superannuation or other allowance or gratuity, as specified by the Government when making his appointment to that office.*

(2) The Controller shall receive such remuneration as the Minister for Finance shall determine.

~~-(3) The Controller shall be a civil servant in the Civil Service of the State.~~

(3) Subject to the Controller being in good health at the time of appointment and notwithstanding that the Controller is appointed without a certificate from the Civil Service Commissioners, the Controller shall, during his term of office, be deemed to be employed in the Civil Service of the State.

(3A) The Office shall be located at such a place in the State as may be designated from time to time by the Minister, and the functions of the office of Controller shall be discharged at that place, subject to such exceptions as the Minister may from time to time specify in writing.

(4) Whenever the Controller is temporarily unable to attend to his duties or his office is vacant, the Minister may appoint a person to perform the duties of the Controller during such inability or vacancy, and every person so appointed shall for as long as the appointment remains in force have all the powers of the Controller under this Act and as otherwise determined by law and shall receive such remuneration as the Minister shall, with the sanction of the Minister for Finance, direct.

(4A) Notwithstanding subsection (1), the Government may remove from the office of Controller a person who has become incapable through ill-health of effectively performing the duties of Controller or for stated misbehaviour or whose removal appears to the Government to be necessary for the effective performance of the functions of Controller.

~~-(5) The Controller may authorize any of his officers to exercise any of his functions under this Act or any other enactment and any such function shall, when exercised for the purpose of such enactment, be deemed to have been exercised by the Controller.~~

(5) Any act or thing directed to be done by or to the Controller under this Act or any other enactment may be done by or to any officer authorised by the Minister.

~~-(6) An authorization under subsection (5) —~~

~~-(a) may be made subject to such directions as the Controller may specify;~~

~~-(b) shall, while in force, not prevent the discharge by the Controller of the functions thereby delegated, and~~

* Intellectual Property (Miscellaneous Provisions) Act 1998 [28/1998]

~~–(c) may at any time be modified or revoked by the Controller.~~

(6) An authorisation under subsection (5)—

(a) may be made subject to such directions as the Minister may specify, and

(b) may at any time be modified or revoked by the Minister.*

Appointment of officers of Controller.

98.—(1) The officers of the Controller shall be appointed by the Minister and there shall be such number of officers as the Minister, with the sanction of the Minister for Finance, may consider necessary and those persons shall hold office upon such terms and be remunerated at such rates and in such manner as the Minister for Finance may sanction.

(2) The salaries or remuneration of the Controller and his officers and such other expenses of carrying this Act into effect as may be sanctioned by the Minister for Finance shall be paid out of moneys provided by the Oireachtas.

(3) Persons who immediately before the commencement of this section were officers of the Controller shall continue to hold office under this Act on the same terms and conditions (subject to the provisions of this Act) as theretofore.

Fees.

99.—(1) There shall be charged by the Controller and paid in respect of matters relating to applications for and the grant and renewal of patents or other matters determined by law as coming within the functions of the Controller, such fees as may from time to time be prescribed by the Minister with the sanction of the Minister for Finance.

(2) All fees charged by the Controller under this section shall be collected and accounted for in such manner as shall be determined by the Minister with the consent of the Minister for Finance.

(3) The Public Offices Fees Act, 1879, shall not apply in respect of any fees payable under this section.

Official Journal and publication of information.

100.—(1) The Controller shall issue periodically a journal to be known as the Patents Office Journal (which is referred to in this Act as "the Journal") in which he shall include all matters which he is directed by this Act or otherwise by law to publish in the Journal and also such matters and information as appear to him to be useful or important in relation to patents or applications for patents and other matters for which he is responsible under this Act or otherwise by law and references in any enactment to the Official Journal of Industrial and Commercial Property shall each be construed as including a reference to the Journal.

* Intellectual Property (Miscellaneous Provisions) Act 1998 [28/1998]

(2) The Controller may prepare for publication and publish such matters, records and information as appear to him to be useful or important in relation to inventions, designs, patents, trade marks, copyright and patent and trade mark applications whether the matters, records or information originate within the State or elsewhere.

(3) The Controller shall make provision for the sale of copies of all documents which he is, by law, directed to issue or publish and may make such provision as he deems expedient for the sale of copies of other documents, information or records which he is by law authorized to publish.

Certain reports to be privileged.

101.—Except as provided by this Act or as prescribed by the Minister, reports of the Controller and officers of the Controller made under this Act or under any other enactment for the administration of which the Controller is responsible shall not be published or be open to public inspection and shall not be liable to production or inspection in any legal proceedings unless the Court or any officer having power to order discovery in such proceedings certifies that such production or inspection is desirable in the interests of justice and ought to be allowed.

Controller may apply to Attorney General for advice.

102.—The Controller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act or of any other enactment for the administration of which he is responsible, apply to the Attorney General for advice in the matter.

Annual report.

~~103.—The Controller shall prepare a report in respect of each year ending 31st December respecting the execution by or under him of this Act and of any other enactment for the administration of which he is responsible and he shall cause the report to be laid before each House of the Oireachtas within 6 months following the end of the year to which it relates. The report shall include, in respect of the year to which it relates, particulars of all rules made in that year under or for the purposes of the said Act or enactments and an account of all fees, salaries and allowances, and other money received and paid under the Act or enactments.~~

103.

(1) Subject to subsections (2) to (4), the Controller shall, as soon as practicable but, in any case, not later than 5 months after the end of each year, make a report in writing to the Minister of the Controller's activities under-

(a) this Act, and

(b) each other enactment for the administration of which the Controller is responsible.

(2) The report shall include, in respect of the year to which it relates, particulars of all rules made in that year under or for the purposes of this Act or other enactment referred to in subsection (1)(b) and an account of all fees, salaries and allowances, and other money, received and paid under this Act or such other enactment.

- (3) The Minister shall ensure that a copy of the report is laid before each House of the Oireachtas not later than 6 months after the end of the year to which the report relates.
- (4) Nothing in this section shall be construed as requiring the Controller to include in the report information the inclusion of which would, in the opinion of the Controller, be likely to prejudice the performance of the Controller's functions under this Act or other enactment referred to in subsection (1)(b).

Hours of business and excluded days.

104.—(1) Rules made by the Minister under section 114 may specify the hour at which the Office shall be deemed to be closed on any day for the purpose of the transaction by the public of business under this Act or such other business as may by law be made a function of the Controller or of any class of such business, and may specify days as excluded days for any such purposes.

(2) Any business done under this Act on any day after the hour specified as aforesaid or on a day which is an excluded day, in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, the time shall be extended to the next following day not being an excluded day.

PART X

PATENT AGENTS

Authorized agent may act.

105.—(1) Subject to rules under section 109 (2) or 114, whenever under this Act any act has to be done by or to any person in connection with a patent or any procedure relating to a patent or the obtaining thereof, the act may be done by or to an agent (in this Act referred to as a "patent agent") of such person duly authorized in the prescribed manner.

(2) A person duly authorized by another person under subsection (1) to act as his patent agent may (subject to any provision to the contrary in any agreement between the patent agent and that person) on giving notice to the Controller and the other person, cease to act as patent agent for the other person.

Unauthorized claim to be patent agent.

106.—(1) The register which, immediately before the commencement of this section, was known as the register of patent agents shall continue to be known as such and to be maintained by the Controller (which register is in this Part referred to as "the register").

~~(2) Subject to the subsequent provisions of this section—~~

~~–(a) a person acting for gain shall not, either alone or in partnership with any other person, practise, describe himself or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is for the time being registered as a patent agent in the register, or, in case he is a member of a partnership holding itself out as patent agents, unless he and all his partners are so registered;~~

~~–(b) a company acting for gain shall not practise, describe itself or hold itself out or permit itself to be described or held out as aforesaid unless every director of the company and, if the company has a manager who is not a director, that manager, is registered as aforesaid.~~

(2) Subject to the subsequent provisions of this section—

(a) a person established in the State shall not carry on the business of acting as a patent agent in the State unless that person is for the time being registered in the register;

(b) a person acting for gain shall not practise, describe himself or hold himself out as a registered patent agent or patent agent, or permit himself to be so described or held out, unless that person is for the time being registered in the register.*

~~–(3) The Minister may, at his discretion, permit any person not registered as aforesaid, upon application made by that person, to act on behalf of others for the purpose of obtaining patents subject to any conditions he considers appropriate.~~

(3) Notwithstanding subsection (2) but subject to subsections (3A) to (3D), a person established in a Member State of the European Community an EEA state (other than the State) and qualified under the law of that state to act as a patent agent in that state –

(a) may carry on the business of acting as patent agent for others in connection with a patent or any procedure relating to a patent or the obtaining thereof, and

(b) may, accordingly, be the subject of an authorization referred to in section 105(1).

(3A) On or before the first occasion on which a person acts, in reliance on subsection (3), on behalf of another before the Controller in connection with a patent or any procedure relating to a patent or the obtaining thereof, the person shall provide to the Controller such evidence as may be prescribed relating to –

(a) the person's being established in another Member State of the European Community EEA state,

(b) the person's being qualified under the law of that state to act as a patent agent in that state, and

(c) whichever of the following is appropriate -

(i) the person's nationality, or

(ii) the person's falling within paragraph (b) of the definition of 'person' in subsection (3E).

(3B) In acting, in reliance on subsection (3), on behalf of another in connection with a patent or any procedure relating to a patent or the obtaining thereof, the person shall use the applicable professional title (if any) but its use in the State shall be subject to the following requirements -

(a) the title is to be expressed in the official language or one of the official languages of the ~~Member State~~ EEA state referred to in subsection (3), and

(b) in a case where the language in which the title is expressed is also an official language of the State, the use of the title is not such as is likely to be understood as indicating that the person is a patent agent registered under this Act.

(3C) It shall be sufficient compliance with subsection (3B)(b) if the use of the title concerned is accompanied by an indication of the ~~Member State~~ EEA state in which the person concerned is established as a patent agent.

(3D) If there is no applicable professional title, then the person, in acting as mentioned in subsection (3B), shall indicate that the person possesses the applicable qualifications and those qualifications shall be expressed in the official language or one of the official languages of the ~~Member State~~ EEA state referred to in subsection (3).

(3E) In this section –

'applicable professional title', in relation to a person, means the professional title that, by virtue of the person's being qualified to act as a patent agent in the ~~Member State~~ EEA state referred to in subsection (3), the person is entitled to use in that state;

'applicable qualifications', in relation to a person, means the qualifications that the person must possess, under the law of the ~~Member State~~ EEA state referred to in subsection (3), so as to be qualified to act as a patent agent in that state;

'person' means –

(a) in the case of an individual, a national of a ~~Member State of the European Community~~ an EEA state, and

(b) in the case of a person which is not an individual, a company or firm (within the meaning of Article 48 of the Treaty establishing the European Community) formed in accordance with the law of a ~~Member State of the European Community and having its registered office, central administration or principal place of business within the European Community~~ an EEA state and

having its registered office, central administration or principal place of business within an EEA state. **

(4) The legal personal representative of a deceased patent agent may carry on the business or practice of the deceased patent agent for a period not exceeding three years from the death of the patent agent, or for such further period (if any) as the Court allows, if he is authorized by the Court to manage the business or practice or employs another person who is so authorized to manage the business or practice on his behalf.

(5) Any person who contravenes any provision of this section shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £500 in the case of a first offence, and in the case of a second or subsequent offence, £1,000.

(6) Notwithstanding section 10 (4) of the Petty Sessions (Ireland) Act, 1851, proceedings for an offence under this section may be begun at any time within twelve months from the date of the offence.

(7) Nothing in this Act shall be construed as prohibiting solicitors from taking such part in proceedings under this Act as has heretofore been taken by solicitors in connection with a patent or any procedure relating to a patent or the obtaining thereof.

(8) A patent agent shall not be guilty of an offence under section 58 of the Solicitors Act, 1954 (which prohibits the preparation for reward of certain instruments by persons not legally qualified), by reason only of the preparation by him of a deed assigning the right to make an application for a patent, or the property in a patent application or a patent, or any document (not being a deed) for use in proceedings under this Act before the Controller or the Court.

Entitlement to be registered as patent agent.

~~107.—(1) Any person who—~~

~~—(a) resides in the State or in such other state as maybe prescribed,~~

~~—(b) has a place of business in the State,~~

~~—(b) has a place of business in the State or in such other state as may be prescribed,**~~

~~—(c) possesses the prescribed educational and professional qualifications, and~~

~~—(d) complies with the prescribed conditions,~~

~~—shall be eligible to be registered in the register and a partnership shall be so eligible if every partner thereof is registered in accordance with the provisions of this section and a person or partnership so eligible shall on application in the prescribed form and manner and on payment of the prescribed fee be so registered.~~

* SI 141/2006 European Communities (Patent Agents) Regulations

* S.I. 579/2015 European Communities (Patent Agents) Regulations 2015

107.—(1) Any person who—

- (a) resides in the State or in an EEA state,
- (b) has a place of business in the State or in an EEA state,
- (c) possesses the prescribed educational and professional qualifications,
and
- (d) complies with the prescribed conditions,

shall be eligible to be registered in the register and a person so eligible shall, on application in the prescribed form and manner and on payment of the prescribed fee, be so registered.*

(2) Persons and partnerships whose names were entered in the register under the Act of 1964 immediately before the commencement of this Act shall be deemed to be registered in the register.

Removal from register or suspension of registration of patent agents.

108.—(1) Any person registered in the register who applies to the Controller to be removed from the register may be removed by the Controller.

(2) Where, in the opinion of the Controller, a person registered in the register ceases to be eligible to be registered or has been guilty of conduct disgraceful to that person in his capacity as a patent agent the Controller may decide that the name of that person should be erased from the register or that during a period of specified duration registration of his name in the register should not have effect, but no such decision shall be made without giving that person an opportunity of being heard.

(3) On making a decision under subsection (2), the Controller shall forthwith send by post to the person to whom the decision relates, at his address as stated in the register, a notice in writing stating the decision, the date thereof and the reason therefor.

(4) On giving notice to the Controller in the prescribed manner, a person to whom a decision under this section relates may, within the period of 21 days, beginning on the date of the decision, apply to the Court for cancellation of the decision and if he so applies—

(a) the Court, on hearing the application, may either—

- (i) cancel the decision, or
- (ii) declare that it was proper for the Controller to make a decision under this section in relation to such person and either (as the Court may consider proper) direct the Controller to erase his name from the register or direct that during a specified period (beginning not earlier than 7 days

* S.I. 579/2015 European Communities (Patent Agents) Regulations 2015

after the decision of the Court) registration of his name in the register shall not have effect.

(b) If at any time the Controller satisfies the Court that such person has delayed unduly in proceeding with the application, the Court shall, unless it sees good reason to the contrary, declare that it was proper for the Controller to make a decision under this section in relation to such person and either (as the Court may consider proper) direct the Controller to erase his name from the register or direct that during a specified period (beginning not earlier than 7 days after the decision of the Court) registration of his name in the register shall not have effect.

(5) The Controller shall not be awarded or be ordered to pay costs on an application under this section.

(6) Where a person to whom a decision of the Controller under this section relates does not, within the period of 21 days beginning on the date of the decision, apply to the Court for cancellation of the decision, the Controller may apply ex parte to the Court for confirmation of the decision and, if the Controller so applies, the Court on the hearing of the application shall, unless it sees good reason to the contrary, declare accordingly and either (as the Court may consider proper) direct the Controller to erase the name of such person from the register or direct that during a specified period (beginning not earlier than 7 days after the decision of the Court) registration of his name in the register shall not have effect.

(7) The decision of the Court on an application under this section shall be final, save that, by leave of the Court or the Supreme Court, an appeal, by the Controller or the person concerned, from the decision shall lie to the Supreme Court on a specified question of law.

(8) (a) On erasing the name of a person from the register the Controller shall forthwith send by pre-paid post to such person, at his address as stated in the register, notice in writing of the erasure.

(b) Where a direction is given under this section that during a specified period registration of the name of a person in the register shall not have effect, the Controller shall, before the commencement of that period, send by pre-paid post to such person, at his address as stated in the register, notice in writing of such direction.

(9) The name of any person which has been erased from the register may at any time be restored to the register by direction of the Controller but not otherwise, and when a person's name is so restored to the register, the Controller may attach to the restoration such conditions (including the payment of a fee not exceeding the fee which would be payable by such person for registration if he was then being registered for the first time) as he thinks fit.

(10) Where the registration of a person in the register has ceased to have effect under this section for a period of specified duration, the Controller may, if he so thinks fit, on application made to him by such person, by direction terminate the suspension.

Rules relating to patent agents.

~~109.—(1) The Minister may make rules for the management of the register and may by such rules prescribe any matter or thing referred to in section 107 or 108 as prescribed, and in particular may so prescribe the educational and professional qualifications and the conditions (including conditions relating to nationality or citizenship) for eligibility for registration in the register, and the maximum fees which may be charged by any person registered in the register for such services in connection with the obtaining of patents as may be specified in such rules.~~

109. —(1) The Minister may make rules for the management of the register and may by such rules prescribe any matter or thing referred to in section 107 or 108 as prescribed, and in particular may so prescribe-

(a) the educational and professional qualifications and the conditions (including conditions relating to nationality or citizenship) which must be satisfied for eligibility for registration in the register;

(b) the conditions which must be satisfied by a partnership, body corporate or unincorporated body of persons for eligibility for registration in the register, including conditions relating to:

(i) evidence of establishment as a partnership, body corporate or unincorporated body;

(ii) evidence that a patent agent established in an EEA state (other than the State) is acting as a patent agent in accordance with the law of that State;

(iii) evidence that the partnership, body corporate or unincorporated body is performing the services of a patent agent in the State;

and

(c) the maximum fees which may be charged to any person registered in the register for such services in connection with the obtaining of patents as may be specified in such rules. *

(2) Rules under this section may authorize the Controller to refuse to recognise as agent in respect of any business under this Act any person who does not satisfy the requirements of section 106.

~~(3) Rules under this section may authorize the Controller to refuse to recognise as agent in respect of any business under this Act a company or firm of which any director or manager or any partner (as the case may be) is an individual whom the Controller could refuse to recognise as an agent.~~

PART XI

MISCELLANEOUS

Correction of errors.

110.—(1) (a) The Controller may, in accordance with the provisions of this section, correct any linguistic error, error of transcription, clerical error or mistake in any specification of a patent, any application for a patent, or any document filed in pursuance of such an application, or any error in the register.

(b) The power conferred on the Controller by paragraph (a) of this subsection is in addition to the powers conferred on him by section 86 (7).

(2) A correction may be made in pursuance of this section either upon a request made in the prescribed manner by any person interested and accompanied by the prescribed fee, or without such a request.

(2A) Where the Controller is requested to correct an error or mistake in a withdrawal of an application for a patent, which application was published under section 28 and details of the withdrawal were published by the Controller, the Controller shall publish notice of the request in the Journal.

(2B) Where the Controller has published a notice in accordance with subsection (2A) any person may within a prescribed period give notice to the Controller of opposition to the request.

(2C) If notice of opposition is given under subsection (2B), the Controller shall notify the person who made the request and shall determine the matter.

(2D) Where the Controller decides to allow a request under this section to correct an error or mistake in a withdrawal of an application for a patent and notice of the request was published in the Journal under subsection (2A), the Controller shall make an order restoring the application and publish notice of the restoration in the Journal.

(3) Where the Controller proposes, or a request is made, to make a correction referred to in subsection (1), *other than a request to correct an error or mistake in a withdrawal of an application for a patent referred to in subsection (2A),** he shall before determining the matter give notice of the proposal or the request to the proprietor of or applicant for the patent, as the case may be, and to any person, other than the person by whom a request is made, who appears to him to be concerned.

Effect of restoring a withdrawn application under section 110.

110A.—(1) Where—

(a) the Controller is requested to correct an error or mistake in a withdrawal of an application for a patent, and

(b) an application for a patent has been restored in accordance with that request, the following provisions apply:

* Patents Amendment Act 2006 [31/2006]

(i) anything done under or in relation to the application during the period between the application being withdrawn and its restoration shall be treated as valid;

(ii) where the Controller has published notice of the request referred to in section 110(2A), anything done during the period referred to in subparagraph (i) which would have constituted an infringement of the rights conferred by publication of the application if the application had not been withdrawn shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights;

(iii) where the Controller has published notice of the request referred to in section 110(2A) and, after the withdrawal of the application and before publication of the notice, a person—

(I) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the withdrawal had not taken place, or

(II) made, in good faith, effective and serious preparations to do such an act,

the person shall have the rights conferred by subsection (2).

(2) The person referred to in subsection (1)(iii) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the application and the grant of the patent.

(3) Subsection (2) does not extend to granting a licence to any person to do an act referred to in subsection (1)(iii).

(4) If the act referred to in subsection (1)(iii) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (2) may—

(a) authorise that act to be done by any partner of that person for the time being in that business, and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(5) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (2) or (4) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.*

Falsification of register, etc.

111.—If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,000, or, at the discretion of the court, to imprisonment for any term not exceeding six months or to both such fine and such imprisonment.

Unauthorized claim of patent rights.

112.—(1) If any person falsely represents that any product sold by him is patented, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,000.

(2) For the purpose of this section a person who sells a product having stamped, engraved or impressed thereon, or otherwise applied thereto, the word "patent" or "patented", or any word expressing or implying that the product is patented, shall be deemed to represent that the product is patented.

False suggestion of official connection with Office.

113.—If any person uses on his place of business, or on any document issued by him, or otherwise, any words suggesting that his place of business is officially connected with, or is, the Office, he shall be guilty of an offence and shall be liable on summary conviction thereof to a fine not exceeding £500.

Power of Minister to make rules.

114.—(1) The Minister may make such rules (except in relation to any matter appropriate to be provided for by rules of court) and do such things as he thinks expedient, subject to the provisions of this Act—

(a) for prescribing the form and contents of applications for patents and other documents which may be filed at the Office, and for requiring copies to be furnished of any such documents;

(b) for regulating the procedure to be followed in connection with any proceedings or other matter before the Controller and for authorizing the rectification of irregularities of procedure;

(c) for requiring fees to be paid in connection with any such proceedings or matter or in connection with the provision of any service by the Office and providing for the remission of fees in prescribed circumstances;

(d) for prescribing the circumstances under which a person is required to be represented by a patent agent who is for the time being registered in the register within the meaning of Part X and act through him in proceedings under this Act;

(e) for prescribing time limits for doing anything required to be done in connection with any such proceedings by or under this Act and providing for the alteration of any period of time specified in or under this Act;

(f) for prescribing how periods of time are to be calculated;

(g) for regulating the publication, sale and contents of anything which the Controller is by this Act required or authorized to publish;

(h) for regulating the presentation of copies of publications made under this Act to applicants for and proprietors of patents and to public authorities, bodies and institutions (whether in or outside the State);

(i) for regulating the maintenance and keeping of the Register of Patents and the register referred to in paragraph (d);

(j) for prescribing any matter or thing referred to in this Act as prescribed;

(k) for doing anything which is either by Article 9 of the First Schedule or otherwise by this Act authorized or required to be done or is in this Act referred to as being, or to be done, by rules under this Act;

(1) generally for regulating the business of the Office and anything which by this Act is placed under the direction or control of the Controller.

(2) Without prejudice to subsection (1), the Controller may adopt such procedures for giving effect to this Act as appear to him to be appropriate.

Service of notice, etc. by post.

115.—Any notice required or authorized to be given by or under this Act, and any application or other document so required or authorized to be made or filed, may be given, made or filed by post or by any other prescribed means.

Articles forfeited under law.

116.—Nothing in this Act shall affect the right of the State, or of any person deriving title directly or indirectly from the State, to sell or use any products forfeited under the Customs Acts or any enactment relating to the excise.

Extent of territorial protection.

117.—For the avoidance of doubt, it is hereby declared that this Act applies to the following waters, namely, the waters in the portion of the sea which comprises the territorial seas of the State, the waters in all the areas of the sea to which the internal or inland waters of the State are extended by section 5 of the Maritime Jurisdiction Act, 1959 , and the waters in any area which is for the time being a designated area within the meaning of section 1 of the Continental Shelf Act, 1968 .

Immunity of Minister, Controller and officers as regards official acts.

118.—Neither the Minister, the Controller nor any officer of the Minister or Controller shall—

(a) be taken to warrant the validity of any patent granted under this Act or any treaty or international convention to which the State is a party; or

(b) incur any liability by reason of or in connection with any search, examination or investigation carried out under the provisions of this Act or any such treaty or convention or any report, communication or proceeding consequent on any such search, examination or investigation.

118A.—(1) If an applicant for, or proprietor of, a patent fails to observe any time limit specified by the Controller the applicant or proprietor may request an extension of time in accordance with the prescribed requirements.

(2) Subject to subsections (5) and (6), the Controller shall grant the request, provided that the prescribed requirements are complied with.

(3) An extension of a time limit granted under subsection (2) shall expire at the end of the period prescribed for the purposes of this section.

(4) If the request for an extension of time is granted, the legal consequences of the failure to observe the time limit specified by the Controller shall be deemed not to have ensued.

(5) Where a time limit has been extended under subsection (2) any further request for an extension of time may be granted by the Controller subject to the conditions that the Controller sees fit.

(6) This section does not apply to proceedings before the Controller pursuant to Part VIII.*

PART XII

PROVISIONS REGARDING INTERNATIONAL CONVENTIONS

Effect of European patent.

119.—(1) Subject to the provisions of this Act, a European patent designating the State shall, as from the publication of the mention of its grant in the European Patent Bulletin, be treated for the purposes of this Act as if it were a patent under this Act granted in pursuance of an application made under Part II and as if notice of the grant of the patent had, on the date of the publication, been published under section 34 in the Journal, and in addition to the foregoing the following shall apply:

(a) the proprietor of a European patent designating the State shall, accordingly, as respects the State have the same rights and remedies and be subject to the same conditions, as the proprietor of a patent granted under this Act;

* Patents Amendment Act 2006 [31/2006]

(b) references in this Act to a patent shall be construed accordingly; and

(c) any statement made and any certificate filed for the purposes of the provision of the European Patent Convention corresponding to section 12 (1) (b) shall be treated respectively as a statement made and certificate filed for the purposes of section 12 (1) (b).

(2) Subsection (1) shall not affect the operation in relation to a European patent designating the State of any provisions of the European Patent Convention relating to the amendment, **limitation** or revocation of such a patent in proceedings before the European Patent Office.

(3) Where, after proceedings for the infringement of a European patent designating the State have been commenced before the Court but have not been finally disposed of, it is established in proceedings before the European Patent Office that the patent is only valid in part, section 50 shall, without prejudice to the jurisdiction of the Court concerning the validity of the European patent insofar as it designates the State, apply in relation to such patent in the same manner as it applies to proceedings in which the validity of a patent granted under this Act is put in issue and in which it is found that the patent so granted is only valid in part.

(4) **Where** a European patent designating the State is amended, **limited** or revoked in accordance with the European Patent Convention, the amendment shall be treated for the purposes of this Act as if it had been made, or where appropriate, the patent shall be treated for those purposes as having been revoked, under this Act.*

(5) Where—

~~—(a) under the European Patent Convention a European patent designating the State is revoked for failure to observe a time limit and is subsequently restored; and~~

(a) under the European Patent Convention a European patent designating the State—

(i) is revoked for failure to observe a time limit and is subsequently restored, or

(ii) is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal,

and

(b) between the revocation and publication of the fact that it has been restored a person begins in good faith to do an act which would, apart from section 77, constitute an infringement of the patent or makes in good faith effective and serious preparations to do such an act;

~~he shall have the same protection as if an order had been made under section 37 (7).~~
the person shall have the rights conferred by subsections (8)(c) and (10) of section 37 and subsections (9) and (11) of that section shall apply accordingly.*

~~(6) — (a) Subsection (1) shall not apply to a European patent designating the State and whose specification was published in French or German, unless a translation in English of the specification is filed at the Office and the prescribed fee is paid before the end of the prescribed period.~~

~~— (b) Subsection (4) shall not apply to an amendment or a limitation made in French or German unless a translation in English of the specification as amended or limited is filed at the Office and the prescribed fee is paid before the end of the prescribed period.~~

~~— (7) Where such a translation is not filed in accordance with subsection (6), the patent shall be treated as always having been void.~~

~~— (8) The Controller shall publish any translation filed at the Office under subsection (6).~~

Restoration where translation not filed under section 119(6)

~~119A. — (1) Where a translation of the specification concerned is not filed within the period prescribed under section 119(6), an application may be made to the Controller to restore the effect of section 119(1).~~

~~(2) An application under this section shall contain a statement (to be verified in the manner that may be prescribed) setting out the circumstances which led to the failure to file the translation referred to in subsection (1), and the Controller may require from the applicant any further evidence that he considers necessary.~~

~~(3) An application under this section shall be accompanied by the translation together with the prescribed fee.~~

~~(4) An application under this section shall be made within the prescribed period and shall be accompanied by the prescribed application fee.~~

~~(5) Where the Controller is satisfied that reasonable care was taken to ensure that the translation was filed within the period prescribed under section 119(6), the Controller shall advertise the application in the Journal, and within the prescribed period any person may give notice to the Controller of opposition thereto.~~

~~(6) Where notice of opposition is duly given under this section, the Controller shall notify the applicant and determine the issue.~~

~~(7) Where the Controller decides to allow an application under this section, he shall make a restoration order and publish notice of the restoration in the Journal.~~

~~(8) Where, in the period between the expiration of the prescribed period under section 119(6) for filing a translation and the date on which the application under this section was published in the Journal, a person—~~

~~(a) began in good faith to do an act which would have constituted an infringement of the rights conferred by the patent had it been in force, or~~

~~(b) made, in good faith, effective and serious preparations to do such an act,~~

~~subsections (8A) to (8D) shall apply:~~

~~(8A) The person referred to in subsection (8) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the effect of section 119(1).~~

~~(8B) Subsection (8A) does not extend to granting a licence to any person to do an act referred to in subsection (8).~~

~~(8C) If the act referred to in subsection (8) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (8A) may—~~

~~(a) authorise that act to be done by any partner of that person for the time being in that business, and~~

~~(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.~~

~~(8D) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (8A) or (8C) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.~~

~~(9) Where the Controller refuses an application under this section, the patent shall be treated as always having been void.~~

~~(10) Where a restoration order is made by the Controller, a translation filed under subsection (3) shall be published.*~~

Effect of filing application for European patent.

120.— (1) (a) An application for a European patent designating the State and having a date of filing under the European Patent Convention shall be treated for the purposes of the provisions of this Act specified in subsection (2) as an application for a patent under this Act having the said date as its date of filing under this Act.

(b) This Act shall apply to an application described in paragraph (a) of this subsection subject to the modifications specified in subsection (3).

(2) The provisions of this Act referred to in subsection (1) are sections 11 (3), 25, 26, 27, 44, 45, 46, 55, 56, 62, 76, 77, 78, 79, 80, 83, 84 and 85 together with section 17 (3) in so far, and only in so far, as it provides for the making of a request to and a finding by the Controller and section 22 in so far as it restricts the application of section 11 (3).

* Patents Amendment Act 2006 [31/2006] *Patent Amendment Act 2012 [1/2012]

(3) The modifications referred to in subsection (1) are the following:

(a) any declaration of priority made in connection with the application under the European Patent Convention shall be treated for the purposes of this Act as a declaration of priority under section 26 (1);

(b) where a period of time relevant to priority is extended under the said convention, the reference in section 25 (1) shall in relation to the application be regarded as being a reference to a period equal to the period as so extended;

(c) where the date of filing an application is re-dated under that convention to a later date, that date shall be so treated as the date of filing the application;

(d) the application, if published in accordance with the said convention, shall, subject to subsection (6), be treated as having been so published under section 28;

(e) any designation of the inventor under the said convention or any statement under it indicating the origin of the right to a European patent shall be treated for the purposes of section 17 (3) as a statement filed under section 17 (2);

(f) registration of the application in the Register of European Patents shall be treated as registration in the register;

(g) the provisions of section 35 shall not apply to such an application.

~~-(4) Subsections (1), (2) and (3) shall cease to apply to an application for a European patent designating the State when the application is refused or withdrawn or deemed to be withdrawn, or the designation of the State in the application is withdrawn or deemed to be withdrawn, but if the rights of the applicant are re-established under the European Patent Convention, subsections (1), (2) and (3) shall, as from the re-establishment of those rights, again apply to the application; provided, however, that the occurrence of an event of withdrawal or refusal referred to shall not affect the continued operation of section 11(3) in relation to matter contained in an application for a European patent designating the State which by virtue of that provision has become part of the state of the art as regards other inventions.~~

(4) Subsections (1), (2) and (3) shall cease to apply to an application for a European patent designating the State, except as provided for in subsection (4A), if—

(a) the application is refused or withdrawn or deemed to be withdrawn, or

(b) the designation of the State in the application is withdrawn or deemed to be withdrawn,

but shall apply again if the rights of the applicant are reestablished under the European Patent Convention, as from the re-establishment of those rights.

(4A) (a) The occurrence of any of the events referred to in subsection (4)(a) or (b) shall not affect the continued operation of section 11(3) in relation to matter contained in an application for a European patent designating the State which by

virtue of that provision has become part of the state of the art as regards other inventions.

(b) The occurrence of any of the events mentioned in subsection (4)(b) shall not prevent matter contained in the application for a European patent designating the State becoming part of the state of the art by virtue of section 11(3) as regards other inventions, where the event occurs before the publication of that application.

(c) Paragraph (b) shall apply only to European patents and European patent applications filed after the coming into operation of that paragraph.

~~(5) Where between the cesser, by virtue of subsection (4), of subsections (1), (2) and (3) as regards an application for a European patent and the re-establishment of the rights of the applicant, a person begins in good faith to do an act which would, apart from section 77, constitute an infringement of the application if subsections (1), (2) and (3) then applied, or makes in good faith effective and serious preparations to do such an act, he shall have the same protection as if an order had been made under section 37 (7).~~

(5) Where between the cesser, by virtue of subsection (4), of subsections (1), (2) and (3) as regards an application for a European patent and the re-establishment of the rights of the applicant, a person begins in good faith to do an act which would, apart from section 77, constitute an infringement of the rights conferred by publication of the application if subsections (1), (2) and (3) then applied, or makes in good faith effective and serious preparations to do such an act, subsections (5A) to (5D) shall apply.

(5A) The person referred to in subsection (5) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding subsections (1) to (3) applying again and notwithstanding the grant of the patent.

(5B) Subsection (5A) does not extend to granting a licence to any person to do an act referred to in subsection (5).

(5C) If the act referred to in subsection (5) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (5A) may—

(a) authorise that act to be done by any partner of that person for the time being in that business,

and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(5D) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (5A) or (5C) that other person and any person claiming

through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.*

(6) An application for a European patent designating the State published by the European Patent Office under the European Patent Convention in French or German shall be treated for the purposes of section 56 as published under section 28 when a translation in English of the claims of the application has been filed at and published by the Office and the prescribed fee has been paid, but an applicant may bring proceedings by virtue of section 56 in respect of an act mentioned in that section which is done before publication of that translation if, but only if, before the doing of that act he has sent by post or delivered to the person alleged to have done the act, a translation in English of the said claims.

~~–(7) An application for a European patent may be filed at the Office. This provision shall not apply in respect of an application which is a European divisional application under the European Patent Convention.~~

(7) (a) An application for a European patent may be filed at the Office. The Office shall forward an application to the European Patent Office within the time specified in the Implementing Regulations to the European Patent Convention.

(b) This provision shall not apply in respect of an application which is a European divisional application under the European Patent Convention.*

Authentic text of European patents and patent applications.

121.—(1) Subject to subsection (2), the text of a European patent or application for such a patent in the language of the proceedings, that is to say the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office, shall be the authentic text for the purposes of any proceedings under this Act before the Controller or the Court.

(2) Where the language of the proceedings referred to in subsection (1) is French or German, a translation in English of the **claims of the European patent concerned***, or of the claims of the application under section 120, shall be treated as the authentic text for the purpose of any proceedings under this Act, other than proceedings for the revocation of the patent, if the **claims of the patent or application, as translated, confers** protection which is narrower than that conferred by **them** in French or German.

(3) If any such translation referred to in subsection (2) results in a European patent or application conferring a narrower protection than that conferred by the language of the proceedings referred to in subsection (1), the proprietor of or applicant for the patent may file a corrected translation with the Office and, if he pays the prescribed fee within the prescribed period, the Office shall publish it; provided that the proprietor of the patent or the applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent or application as correctly translated, but not as originally translated, unless before the doing of the act the corrected translation has been published by the Office or the proprietor or applicant has sent the corrected translation by post or delivered it to the person alleged to have done that act.

* Patents Amendment Act 2006 [31/2006] *Patent Amendment Act 2012 [1/2012]

(4) Where a correction of a translation is published under subsection (3) and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application, as originally translated, but would (apart from section 77) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act ~~he shall have the same protection as if an order had been made under Section 37(7)~~ subsections (5) to (8) shall apply.

(5) The person referred to in subsection (4) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent.

(6) Subsection (5) does not extend to granting a licence to any person to do an act referred to in subsection (4).

(7) If the act referred to in subsection (4) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (5) may—

(a) authorise that act to be done by any partner of that person for the time being in that business,

and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(8) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (5) or (7) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent or the applicant, as the case may be.

Conversion of European patent application.

122.—(1) ~~Where under the European Patent Convention an application for a European patent designating the State is deemed to have been withdrawn because it has not, within the period required by the said convention, been received by the European Patent Office~~ Where an application designating the State is deemed withdrawn under the provisions of the European Patent Convention because it has not been forwarded to the European Patent Office in due time^{*}, the Controller may direct that, on compliance with the conditions mentioned in subsection (2), the application shall be treated as a patent application under Part II.

(2) The conditions referred to in subsection (1) are that—

(a) the applicant within the prescribed period shall pay the filing fee, and, if the application is in French or German, file a translation in English of the

^{*} Patents Amendment Act 2006 [31/2006]

application and of any amendments previously made in accordance with the European Patent Convention; and

(b) (i) the applicant shall request the Controller within the prescribed period (where the application was filed with the Office) to give a direction under this section; or

(ii) the central industrial property office of a country which is party to the said convention, other than the State, with which the application was filed shall transmit within the prescribed period a request that the application be converted into an application under Part II, together with a copy of the said application as so filed.

(3) Where an application for a European patent falls to be treated as a patent application (within the meaning of this Act) by virtue of a direction under this section—

(a) the date which is the date of filing the application under the European Patent Convention shall be treated as its date of filing for the purposes of this Act, but if that date is re-dated under the European Patent Convention to a later date, then that later date shall be treated for those purposes as the date of filing the application;

(b) if the application satisfies a requirement imposed by virtue of a provision of the said convention it shall be treated as satisfying the requirements for a patent application under this Act;

(c) any document filed with the European Patent Office under any provision of the European Patent Convention corresponding to any of the following provisions of this Act, that is to say, sections 12 (1) (b), 17 (2), 18 (2) or 26 (1) or any rule made for the purposes of any of those provisions, shall be treated as filed with the Office under that provision or rule.

Determination by Court of questions as to right to European patent.

123.—(1) The Court shall determine a question to which this section applies in accordance with the following provisions of this section.

(2) This section applies to a question arising before the grant of a European patent as to whether or not a person has a right to be granted a European patent, or a share in any such patent, and in this section "employer-employee question" means any such question between an employer and an employee, or either or both of their successors in title, arising out of an application for a European patent for an invention made by the employee.

(3) Subject to subsection (5), the Court shall consider and determine a question to which this section applies, other than an employer-employee question, if, and only if, the following conditions are satisfied:

(a) there is neither an agreement in writing whereby, nor other written evidence establishing that, the parties have agreed to submit to the jurisdiction

of a court or other competent authority which under the law of a relevant contracting state other than the State has jurisdiction to decide the question, and

- (b) (i) the applicant ordinarily resides in or has his principal place of business in the State, or
 - (ii) the other party claims that the patent should be granted to him and he ordinarily resides in or has his principal place of business in the State, and the applicant does not have his residence or principal place of business in any of the relevant contracting states.

(4) Subject to subsection (5), the Court shall consider and determine an employer-employee question if, and only if, the following conditions are satisfied:

- (a) (i) the employee is wholly or mainly employed in the State, or
 - (ii) the employee is neither wholly nor mainly employed in a particular state or territory, or
 - (iii) the place at which the employee is mainly employed cannot be determined but the employer has in the State a place of business to which the employee is attached (whether or not he is also attached elsewhere);

and

- (b) there is not written evidence that the parties have agreed to submit to the jurisdiction of a court or other competent authority which under the law of a relevant contracting state other than the State has jurisdiction to decide the question, or, where there is such evidence of such an agreement, the proper law of the contract of employment does not recognise the validity of the agreement.

(5) The Court may consider and determine any question to which this section applies if there is written evidence that the parties have agreed to submit to the jurisdiction of the Court and, in the case of an employer-employee question, the proper law of the contract of employment recognises the validity of the agreement.

(6) If, after proceedings to determine a question to which this section applies have been brought before a court or other competent authority which under the law of a relevant contracting state other than the State has jurisdiction to decide the question, proceedings are begun before the Court, the Court shall stay the proceedings before it until the following conditions are satisfied:

- (a) such authority either—
 - (i) declines jurisdiction, or
 - (ii) makes a determination which the Court refuses to recognise under section 124, and
- (b) where an appeal lies from the decision of such authority, either an appeal has been taken and has been determined or withdrawn or, in case such an appeal is not taken, the time for appealing has expired.

(7) References in this section to the determination of a question include references to—

(a) the making of a declaration with respect to the question; and

(b) the making of such order as the Court deems appropriate in relation to the question.

(8) In this section and section 124 "relevant contracting state" means a state which is a party to the European Patent Convention and has not exercised its right under the said convention to exclude the application of the protocol to the said convention therein referred to and known as the Protocol on Recognition.

(9) This section and section 124 apply to a question arising before the grant of a European patent whether the relevant European patent application designates the State or not.

Effect of patent decisions of competent authorities of other states.

124.—(1) Subject to subsection (2), a determination of a question to which section 123 applies by a court or other competent authority which under the law of a relevant contracting state other than the State has jurisdiction to decide the question shall, if no appeal lies from the determination or if the time for appealing has expired without an appeal having been taken, be recognised in the State as if it had been made by the Court.

(2) The Court may refuse to recognise any determination referred to in subsection (1) that the applicant for a European patent had no right to be granted the patent, or any share of it, if either—

(a) the applicant did not contest the proceedings to which the determination relates because he was not notified of them either at all or in the proper manner or was not notified of them in time for him to contest such proceedings; or

(b) the determination conflicts with the determination of a court or other competent authority which under the law of any other relevant contracting state has jurisdiction to decide the question in proceedings instituted earlier between the same parties as those to the proceedings under this Act and relating to the same question.

Patent agents and other representatives.

125.—(1) A person acting for gain shall not, either alone or in partnership with any other person, practise, describe himself or hold himself out as being, or as carrying on the business of agent or other representative of other persons for the purpose of applying for or obtaining European patents or for the purpose of conducting proceedings in connection with such patents before the European Patent Office, unless he satisfies the condition that his name and that of each of his partners appears on the European list.

(2) Subsection (1) shall not be construed as prohibiting a barrister or solicitor from appearing or taking part in proceedings before the European Patent Office which correspond to proceedings in which by virtue of section 93 or 106 he is entitled to appear or take part.

(3) A company acting for gain shall not practise, describe itself or hold itself out or permit itself to be described or held out as agent or other representative of other persons for any purpose mentioned in subsection (1) unless permitted to do so under the European Patent Convention.

(4) Any person who contravenes subsection (1) or (3) shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £500 in the case of a first offence, and in the case of a second or subsequent offence, £1,000.

(5) A person who does any act mentioned in subsection (1) but satisfies the condition mentioned in that subsection shall not be treated as contravening section 106 so long as he does not without qualification describe himself as a patent agent and does not hold himself out, or permit himself to be held out, as carrying on any business other than the one mentioned in that subsection.

(6) The Controller may refuse to recognise as agent or other representative for the purposes of applying for European patents any person who does not satisfy the conditions mentioned in subsection (1) and does not fall within the exception in subsection (2).

European patent attorneys.

126.—(1) For the avoidance of doubt, it is hereby declared that any person whose name appears on the European list shall not be guilty of an offence under section 56 of the Solicitors Act, 1954, by reason only of his describing himself as a European patent attorney.

(2) A person whose name appears on the European list shall not be guilty of an offence under the Solicitors Acts, 1954 to 1960, by reason only of the preparation by him of any document (other than a deed) for use in proceedings before the Controller under this Act in relation to a European patent or an application for such a patent.

International applications for patents.

127.—(1) An international application for a patent designating the State shall be deemed to be an application for a European patent designating the State.

(2) The Office may, without prejudice to Article 151 of the European Patent Convention, act as a receiving office within the meaning of Article 2 (xv) of the Treaty for persons making international applications, provided such applications are in English.

(3) Applications filed at the Office, as receiving office, shall be accompanied by the prescribed transmittal fee.

(4) The Minister may by rules make provisions with respect to international applications consequent upon the Office acting as a receiving office for applicants making such applications.

(5) Any application referred to in subsection (1) which is published under the Treaty shall be treated for the purposes of section 11 (3) as published when, and only when, a copy of the application has been supplied to the European Patent Office in English, French or German and the relevant fee has been paid under the European Patent Convention.

(6) Any application referred to in subsection (1) which is published under the Treaty in a language other than English, French or German shall be treated for the purposes of section 56 as published when, and only when, it is re-published in English, French or German by the European Patent Office under the European Patent Convention.

Orders to give effect to international agreements relating to patents.

128.—(1) The Minister may by order make such provision as appears to him to be necessary or expedient to enable effect to be given to, or to any particular provision of, any amendment of the European Patent Convention or the Treaty or to any international treaty, convention or agreement (or protocol thereto) relating to patents to which the State is or proposes to become a party.

(2) The Minister may by order revoke or amend an order under this section.

Evidence of conventions and instruments under conventions.

129.—(1) Judicial notice and notice by the Controller shall be taken of the following, that is to say—

(a) the European Patent Convention, the Treaty and any other convention or any protocol or other agreement to which an order under section 128 applies,

(b) any bulletin, journal or gazette published or issued under the European Patent Convention and the Treaty and the register of European patents kept under the European Patent Convention, and

(c) any decision of, or expression of opinion pursuant to the European Patent Convention by, a competent authority on any question arising under or in connection with that convention.

(2) Any document mentioned in subsection (1) (b) which purports to state the contents or provisions, or part of the contents or provisions, of any instrument made or any act done by any institution of the European Patent Convention or the Treaty shall be admissible under this Act as prima facie evidence of such contents, provisions or part.

(3) Prima facie evidence of any instrument made under the European Patent Convention or the Treaty by any institution referred to in subsection (2), including any judgment or order so made by a competent authority of the European Patent Convention, or of any record or other document in the custody of any such institution, or any part of, entry in or extract from, such a record or other document, may be given in any legal proceedings by the production of a copy certified as a true copy by an

officer of that institution; and any document purporting to be such a copy shall be received in evidence without proof of the official position or handwriting of the person signing the certificate or of his authority to do so.

(4) Evidence of any instrument or order referred to in subsection (3) may also be given in any proceedings whether under this Act or otherwise—

(a) by the production of a copy purporting to be officially printed on behalf of the institution by whom it was issued or made,

(b) where the instrument is in the custody of a government department, by the production of a copy certified as being a true copy by an officer of the department duly authorized in that behalf,

and any document purporting to be a copy mentioned in paragraph (b) shall be received in evidence without proof of the official position or handwriting of the person signing the certificate, or of his authority to do so, or of the document's being in the custody of the department.

Obtaining evidence for proceedings under European Patent Convention.

130.—(1) The Foreign Tribunals' Evidence Act, 1856 (in this section subsequently referred to as "the Act of 1856"), shall apply in relation to any competent authority constituted under the European Patent Convention as it applies in relation to any court or tribunal of competent jurisdiction in a foreign country and accordingly the reference in section 1 of that Act to a court or tribunal of competent jurisdiction in a foreign country shall be construed as including a reference to a competent authority so constituted.

(2) In the application of the Act of 1856, the Court may order the examination upon oath of any witness before the Controller.

(3) Any person who, being examined on oath before the Controller pursuant to the Act of 1856, as extended by this section, wilfully gives false evidence shall be liable to the penalties of perjury.

Communication of information to European Patent Office, etc.

131.—No enactment, whether passed before or after the passing of this Act, shall be construed as making it unlawful to communicate the following information in pursuance of the European Patent Convention to the European Patent Office or the authority competent to receive such information in any country which is party to that convention, that is to say—

(a) information in the files of the Court which, in accordance with rules of court, the Court authorizes to be so communicated,

(b) information in the files of the Office which, in accordance with rules made under this Act in that behalf, the Controller authorizes to be so communicated.

Financial provisions.

132.—(1) There shall be paid out of moneys provided by the Oireachtas any sums, as may be sanctioned by the Minister for Finance, required to meet any financial obligation of the State under the European Patent Convention or the Patent Co-operation Treaty.

(2) Any sums received in pursuance of the convention or treaty referred to in subsection (1) shall be paid into such fund and accounted for in such manner as shall be determined by the Minister with the consent of the Minister for Finance.

Section 5.

FIRST SCHEDULE

TRANSITIONAL PROVISIONS

1. Subject to the provisions of this Schedule, any order, regulation, rule, patent, requirement, certificate, notice, decision, direction, authorization, consent, application, request or thing made, granted, issued, given or done under any enactment repealed by this Act shall, if in force immediately before the commencement of this Act, and insofar as it could have been made, granted, issued, given or done under this Act, continue in force and have effect as if made, granted, issued, given or done under the corresponding provision of this Act. A patent of addition granted under the Act of 1964 shall remain in force only for so long as the patent for the main invention remains in force.

2. (1) The term of any patent granted under the Act of 1964 and in force at the commencement of this Act shall be extended to 20 years, subject to the payment of the prescribed renewal fees, within the period prescribed, in respect of each year of the additional term.

(2) This paragraph does not apply to a patent the term of which was extended, prior to the commencement of this Act, following presentation of a petition under section 27 of the Act of 1964.

(3) No petition for an extension of the term of any patent granted under the Act of 1964 shall be presented under section 27 of that Act after the commencement of this Act.

3. (1) Where a patent expired before the commencement of this Act and a petition under the Act of 1964 for the extension of its term was pending immediately before such commencement, the following provisions shall apply:

(a) if no notice of objection to the extension has been given within the time prescribed in that behalf by rules under the Act of 1964 or by rules of court (as the case may be) or if, having been so given, such notice has been withdrawn the proprietor of the patent may withdraw the petition and the term of the patent shall thereupon stand extended for a period of 4 years from the date of its expiry;

(b) if notice as aforesaid has been given within the time prescribed and has not been withdrawn or if the petition is not withdrawn the provisions of the Act of 1964 shall continue to apply in respect of that petition.

(2) Where, immediately before the commencement of this Act, an appeal was pending against a decision on a petition presented under section 27 of the Act of 1964, the provisions of that Act shall continue to apply in respect of that appeal until the appeal is determined.

~~4. In the case of a patent the term of which has been extended under paragraph 2 (1) or 3 (1) of this Schedule, proceedings for infringement of such a patent may not be instituted against a person who, during the final 2 years of the term of that patent, as extended under those provisions, makes any such preparations (other than the importation or placing on the market of a product protected by such patent) as would enable that person to put the invention into effect commercially after the term of the patent expires.~~ Repealed by 2006 Act

5. Applications for restoration of lapsed patents which were pending at the commencement of this Act shall be decided under the provisions of the Act of 1964.

6. Where, before the commencement of this Act, a complete specification had been filed under the Act of 1964 but had not been accepted, the provisions of Part II of this Act shall apply to the application to which such specification relates and to any patent granted on the application as they apply to applications under that Part, subject to the modifications specified in paragraph 7 of this Schedule.

7. The modifications referred to in paragraph 6 of this Schedule are as follows:

(a) the date of filing of the application shall be the date on which the complete specification was filed and references in Part II to the description, claims and drawings shall be construed as referring to this complete specification,

(b) sections 18 (2) (c), 19 (2) and 35 shall not have effect as regards the application, and sections 29 (1) and 30 (1) shall not have effect except as specified in subparagraph (k),

(c) any provisional specification filed shall give rise to the same right of priority for the application as if a valid claim to priority had been made under section 26 to the extent, and only to the extent, that the matter disclosed in the provisional specification forms a fair basis for the invention the subject of the complete specification,

(d) where the application was made as a Convention application within the meaning of the Act of 1964, then, provided the requirements for Convention applications within such meaning are met, the application shall enjoy the same right of priority as if a valid claim to priority had been made under section 26,

(e) where a complete specification was laid open to public inspection under section 69 of the Act of 1964 before the commencement of this Act, the laying open to public inspection shall be regarded as being publication under section 28 and the date on which it was so laid open shall be regarded as being the date

of such publication; other documents accompanying the application (including any provisional specification filed in relation to the application) shall be laid open to public inspection as soon as practicable after the commencement of this Act,

(f) a declaration as to inventorship made in respect of an application filed or deemed to have been filed before the commencement of this Act shall be deemed to satisfy the requirements of section 17 (2),

(g) the time limit for doing any act or filing any document under this Act shall not expire before the expiry of the corresponding time limit under the Act of 1964,

(h) an application under section 11 (5) of the Act of 1964 shall be treated as a divisional application within the meaning of section 24,

(i) an application for a patent of addition under section 28 of the Act of 1964 shall be considered as being an application for an independent patent,

(j) notwithstanding anything contained in this Act, an application may proceed in the name of a person who was entitled to apply under the Act of 1964,

(k) an applicant who furnishes the evidence specified under section 8 (6) (a) or (b) of the Act of 1964 within the time prescribed in the Patents Rules, 1965 for so doing shall be deemed to have satisfied the requirements of section 30 (1) of this Act; where such evidence is furnished after the commencement of this Act, it shall be accompanied by the fee prescribed for the purpose of section 30 (3); and where, in the case of any application, the evidence is not furnished within the time prescribed by the said Rules, the application shall be deemed to have been withdrawn unless the applicant complies with the provisions of section 29 (1) or 30 (1), as appropriate,

(l) any amendments to an application submitted before the commencement of this Act which correspond to amendments which could be submitted under the provisions of section 29 (4), 30 (4) or 30 (5) as appropriate shall be deemed to have been submitted under these provisions provided they have been submitted by a duly authorized patent agent where such an agent acts on behalf of the applicant,

(m) in the case of any application in respect of which the applicant had been notified of any requirements under the Act of 1964 (or the Rules made thereunder) with which he was required to comply and the applicant had not, before the commencement of this Act, complied with these requirements or satisfied the Controller that the requirements were complied with, the provisions of the Act of 1964 (and the relevant Rules made thereunder) shall continue to apply until the matters at issue are finally decided.

8. (1) In the case of any application the acceptance of the complete specification of which had been advertised under section 18 of the Act of 1964 and in respect of which the period specified in subsection (1) of section 19 of that Act had not expired at the commencement of this Act, a patent shall not be granted under this Act on such

application before the expiry of that period or, where opposition is notified during that period, before the relevant proceedings are concluded under the provisions of the Act of 1964 and a determination that a patent may be granted has been made.

(2) In any case in which opposition to the grant of a patent had been notified under section 19 of the Act of 1964 and the case had not been decided before the commencement of this Act, a patent shall not be granted under this Act before the relevant proceedings have been concluded under the Act of 1964 and a determination that a patent may be granted has been made.

9. The power to make rules under section 114 shall include power to make rules for any purpose mentioned in section 96 of the Act of 1964.

10. A patent application (the original application) which is made before the commencement of this Act, but in respect of which a complete specification is not filed before such commencement, shall be taken to have been abandoned immediately before that commencement but, notwithstanding anything in subsection (1) or (4) of section 25, the original application may nevertheless serve to establish a claim to priority under section 26 in relation to a later patent application under this Act if the date of filing of the original application falls within the period of fifteen months ending on the day immediately preceding the date of filing of the later application, and in relation to such later application the following provisions shall apply, namely:

(a) publication of the application, which shall take place as soon as practicable after the expiry of a period of eighteen months beginning on the date of filing of the original application, shall include the provisional specification which accompanied the original application, and

(b) where for a purpose of this Act a period is prescribed as being twelve months from the date of priority of an application, then such period shall for such purpose in relation to such later application be taken to be a period of fifteen months beginning on the date of filing of the original application.

11. Where there is in any document a reference to an enactment repealed by this Act, the reference shall be construed as a reference to the provision of this Act which corresponds to such enactment.

12. A patent granted under the Act of 1964 to which paragraph 1, 2 or 3 of this Schedule applies shall be revocable only in accordance with the provisions of that Act.

13. Any application for a licence under section 42 of the Act of 1964 which was pending at the commencement of this Act shall be decided under the provisions of the Act of 1964.

Section 45.

~~–SECOND SCHEDULE~~

~~–DIRECTIONS REFERRED TO IN SECTION 45 (3)~~

~~–Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of~~

~~the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.~~

SECOND SCHEDULE

Directions referred to in section 45(3)

General principles

Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of certainty for third parties.

Equivalents

For the purpose of determining the extent of protection conferred by a patent, due account shall be taken of any element which is equivalent to an element specified in the claims.
