



STATUTORY INSTRUMENTS.

S.I. No. 589 of 2019



PATENTS (AMENDMENT) RULES 2019

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I, HEATHER HUMPHREYS, Minister for Business, Enterprise and Innovation, in exercise of the powers conferred on me by section 114 of the Patents Act 1992 (No. 1 of 1992) (as adapted by the Jobs, Enterprise and Innovation (Alteration of Name of Department and Title of Minister) Order 2017 (S.I. No. 364 of 2017)), hereby make the following Rules:

Citation and commencement

1. These Rules may be cited as the Patents (Amendment) Rules 2019 and shall come into operation on 2 December 2019.

Definition

2. In these Rules,-

“Act” means the Patents Act, 1992 (No.1 of 1992);

“Principal Rules” means the Patents Rules 1992 (No. 179 of 1992) and (except where the context otherwise requires) a reference to a Rule is a reference to a Rule of those Rules.

Amendment of Rule 24

3. Rule 24 of the Principal Rules is amended by substituting the following paragraph for paragraph (5):

“(5) Within eighteen months from the priority or filing date, or within six months of the date of issue by the Controller to the applicant of a copy of the section 29 report and opinion, whichever is later, the applicant shall, unless the application is withdrawn, comply with the requirements of section 29(4)”.

Amendment of Rule 34

4. Rule 34 of the Principal Rules is amended by substituting the following paragraph for paragraph (5):

“(5) Where the period for payment of a renewal fee pursuant to paragraphs (1) and (2) has expired and if an address for service has been provided in accordance with Rule 92, the Controller shall, not later than six weeks after the last day for payment under those paragraphs and if the fee still remains unpaid, send to the proprietor of

the patent a notice reminding them that payment is overdue and of the consequences of non-payment”.

Amendment of Rule 65

5. Rule 65 of the Principal Rules is amended –

(a) by substituting the following paragraphs for paragraph (1):

“(1) After the date of publication of a patent application the Controller shall, in accordance with section 88 (1), upon request and subject to payment of the prescribed fee, permit documents filed or kept in the Office in relation to the application, or to any patent granted in pursuance of it, to be inspected at the Office.

(1a) This provision shall not apply to —

(a) a document which the Controller, consequent upon a request from a person filing or sending the document, directs shall be treated as confidential;

(b) any document sent to the Office for inspection and subsequent return to the sender;

(c) any document prepared in the Office solely for its own use;

(d) any document, or part thereof, kept at the Office which the Controller considers should be treated as confidential.”

(b) by inserting the following paragraph after paragraph (2):

(3) Nothing in section 88 relating to the publication of information shall be construed as preventing the publication of decisions on cases relating to patents decided by the Controller.

Amendment to Rule 75

6. Rule 75 of the Principal Rules is amended –

(a) by the substitution of “court” for “Court” in the title of the Rule, and

(b) by the substitution of “the appropriate court” for “the Court”.

Amendment to Rule 76

7. Rule 76 of the Principal Rules is amended –

- (a) by the substitution of “court” for “Court” in the title of the Rule, and
- (b) by the substitution of “the appropriate court” for “the Court”.

8. The Principal Rules are amended by inserting the following Rule after Rule 87:

“An international application as an application for a patent under Part II

87A.— (1) In accordance with section 127A (1), an applicant for an international application designating the State may, within two months from the date on which the International Bureau notifies the applicant that their international application is refused a filing date under the Treaty, make a written request to the Controller to accord the international application a filing date so that it can be treated as an application for a patent under Part II.

(2) The request under paragraph (1) must state the name and address of the applicant and shall be accompanied by: -

- (i) a copy of the international application as filed,
- (ii) a statement of the reasons for the request,
- (iii) any document, information or evidence verifying the said statement, and
- (iv) the prescribed fee, if any.

(3) Where the applicant fails, before the end of the period specified in paragraph (1), to meet the requirements of paragraph (2), the Controller may treat the request as having been withdrawn.

(4) If upon consideration of the statement and evidence furnished under paragraph (2), the Controller is not satisfied that a prima facie case has been made for the issuing of a filing date, the applicant shall be notified accordingly, and unless within one month the applicant requests to be heard in the matter, the Controller shall refuse the request.

(5) If the applicant requests a hearing within the time allowed under paragraph (4), the Controller, after giving the applicant the opportunity to be heard, shall determine whether the request under paragraph (1) shall be allowed or refused.

(6) (a) Where the Controller has accorded a filing date under paragraph (1), the applicant shall, within a period of two months of the notification of that date, submit a request to the Controller to treat the international application as a patent application under Part II.

(b) The request shall be in writing or in electronic form and shall be accompanied by: -

- (i) a copy of the international application as filed,
- (ii) a completed Form No. 1 as prescribed under Rule 8,
- (iii) the filing fee as prescribed under Rule 8B, and
- (iv) any other documents which the applicant wishes to submit.

(7) (a) A request made to the Controller to treat the international application as a patent application under Part II, pursuant to sections 127A(2) and (3), shall be made within three months of the date of withdrawal of the international application or the date of the notification by the International Bureau or Receiving Office that the application is withdrawn or is considered withdrawn, whichever is applicable, and no later than 31 months from the filing date or the priority date of the international application, whichever is later.

(b) The request shall be made in writing or in electronic form and shall be accompanied by: -

- (i) a copy of the international application as filed,
- (ii) a copy of the request to the International Bureau or Receiving Office to withdraw the application, if applicable,
- (iii) a copy of the acknowledgement of the International Bureau or Receiving Office of the withdrawal, if applicable,
- (iv) a completed Form No. 1 as prescribed under Rule 8,
- (v) the filing fee as prescribed under Rule 8B, and
- (vi) any other documents which the applicant wishes to submit.

(c) Within two months of filing a request under paragraph (a), the applicant may submit amendments they wish to have considered prior to the commencement of search and examination pursuant to Section 29 or Section 30.

(d) If it appears to the Controller that the international application which is the subject of a request under paragraphs (6) and (7) satisfies the formal requirements of the Act and Rules, but is not accompanied by an international search report and written opinion, the Controller shall, unless the application is withdrawn within a period of two months from the filing of the request under paragraph 6(a) or 7(a), cause the application under Part II to proceed in accordance with Section 29 and Rule 24.

(e) Where the request under paragraphs (6)(a) or (7)(a) is accompanied by evidence in the form of a search report and written opinion as specified in Rule 27(1), the Controller shall allow that evidence to meet the requirements of Section 30.

(8) Where, for the purposes of paragraph (7), the date which is the date of filing of the international application shall be treated as its date of filing for the purposes of the Act, but if that date is re-dated under the Treaty to a later date, that later date shall be treated for those purposes as the date of filing of the application under Part II.

(9) The Controller may, by notice in writing or by electronic means, require an applicant who has submitted a request under paragraph (6) or (7), to provide such additional documents as he or she considers appropriate, within the period as is specified in the notice.

(10) If the Controller is not furnished with additional documents requested under paragraph (9), the application shall be deemed to be withdrawn.

(11) Subject to Rule 95, where the international application is in a language other than English, the request under paragraphs (6) or (7) must be accompanied by a translation into Irish or English of: -

- (i) the international application as filed,
- (ii) any other documents accompanying the request, and
- (iii) any documents furnished pursuant to paragraph (9).

(12) Where an international application is the subject of a request under paragraphs (6) or (7): -

- (a) any declaration of priority made under the Treaty shall be treated as having been made under Section 26(1), and where in accordance with the Treaty any extra days are allowed, the prescribed period of 12 months prescribed under Section 25(1) shall be treated as altered accordingly;
- (b) if the application is published in accordance with the Treaty it shall be treated as published under Section 28;
- (c) if the application satisfies a requirement of the Treaty corresponding to any of the requirements of the Act or Rules designated as formal requirements, it shall be treated as satisfying that formal requirement;
- (d) any document or application filed with the International Bureau under any provision of the Treaty corresponding to any of the following provisions of the Act, that is to say, Sections 17, 18 and 26, 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 and accorded the same filing date unless the Controller otherwise directs.

(13) Where the international application which is the subject of a request under paragraphs (6) and (7) has not been published in English under the Treaty, it shall be published under Section 28.

(14) In this rule, "International Bureau" and "Receiving Office" shall have the meanings assigned to them in Article 2 of the Treaty."



GIVEN under my Official Seal,
26 November, 2019.

HEATHER HUMPHREYS,
Minister for Business, Enterprise and Innovation.

EXPLANATORY NOTE

(This note is not part of the Instrument and does not purport to be a legal interpretation.)

The amendment to Rule 24(5) of the Patents Rules 1992 is for the purpose of extending the prescribed period for responding to the search report and written opinion furnished under Section 29 from four months to eighteen months from the priority or filing date, or within six months of the date of issue by the Controller to the applicant of a copy of the Section 29 report and written opinion, whichever is later.

The amendment to Rule 34(5) is for the purpose of limiting the sending of overdue reminder letters to patent proprietors who have provided an address for service.

The amendment to Rule 65 is for the purpose of preventing the public inspection of a document related to a patent application or to a granted patent filed or kept at the Office which the Controller considers should be confidential and to provide for the publication of decisions on cases relating to patents decided by the Controller.

The amendments to Rules 75 and 76 provide that IP proceedings may take place in the relevant court, subsequent to the changes made in relation to the courts in the Copyright and Other Intellectual Property Law Provisions Act 2019.

The inclusion of new Rule 87A is for the purpose of prescribing the procedures to be followed pursuant to Section 127A of the Patents Act 1992, as inserted by Section 42(e) of the Copyright and Other Intellectual Property Law Provisions Act 2019, in circumstances where the Controller receives a request that an international application for a patent designating the State be treated as an application for a patent under Part II of the Patents Act 1992.

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