

The Irish Law and Practice of Patents Examination

Syllabus

Aim	<p>The aim of this examination is to test candidates understanding of the law and practice relating to the grant, enforcement and exploitation of Patents rights as they apply in Ireland, Europe and internationally.</p> <p>Candidates are expected to have a good knowledge of Irish patent law and practice, including a good knowledge of relevant case law and show a knowledge of E.U. Directives and Regulations relating to patent matters and a knowledge of international arrangements relating to patents such as the Paris Convention for the Protection of Industrial Property, the European Patent Convention and the Patent Co-Operation Treaty.</p> <p>Candidates can also expect to be asked to set out how they would advise a client in various circumstances, and propose legal remedies of which the client might avail.</p>
Format of the Exam	<p>The examination is a closed book examination lasting 3 hours.</p> <p>The paper will comprise of 9 questions of which 6 questions must be answered. Questions 1 and 2 are compulsory questions.</p> <p>A total of 120 marks are available for the paper. All questions carry equal marks. The pass requirement is 50%.</p>
Knowledge required for the examination	<ul style="list-style-type: none">• Patentable inventions• Right to apply for and obtain a patent, inventorship, ownership and employee rights• Making patent applications, use of foreign specification or search report, amendment and correction of applications.• Provisions as to patents after grant – term, unity, amendment, restoration• Patents as a form of property, compulsory licences, the patent register, securing information about patents, patent applications and inspection of documents• Infringement including impact of partial validity, right to continue use, effect of publication, threats, marking• Revocation of patents International (PCT) applications and obtaining granted IE patent through the European route• Convention applications

	<ul style="list-style-type: none"> • Restrictions on publication and making patent applications abroad • SPCs
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Breakdown of Legislation

Patentability	<ul style="list-style-type: none"> • Patentable inventions – <i>Section 9</i> • Exceptions to patentability – <i>Section 10</i> • Novelty – <i>Section 11</i> • Non-prejudicial disclosures – <i>Section 12</i> • Inventive step – <i>Section 13</i> • Industrial application – <i>Section 14</i>
Applications	<ul style="list-style-type: none"> • Right to apply for a patent – <i>Section 15</i> • Right to patents – <i>Section 16</i> • Mention of inventor – <i>Section 17</i> • Making of application – <i>Section 18</i> • Disclosure of invention – <i>Section 19</i> • Claims – <i>Section 20</i> • Unity of invention – <i>Section 21</i> • Abstract – <i>Section 22</i> • Date of filing application – <i>Section 23</i> • Divisional application – <i>Section 24</i> • Priority right – <i>Section 25</i> • Claiming priority – <i>Section 26</i> • Effect of priority right – <i>Section 27</i> • Publication of application – <i>Section 28</i>
Procedure Up To Grant	<ul style="list-style-type: none"> • Search report – <i>Section 29</i> • Use of foreign specification or search report – <i>Section 30</i> • Refusal or grant of patent – <i>Section 31</i> • Amendment of application – <i>Section 32</i> • Withdrawal of application – <i>Section 33</i> • Notification of grant; publication of specification – <i>Section 34</i> • Continuation in force of applications – <i>Section 35</i> • Reinstatement of applications – <i>Section 35A</i> • Effect of reinstatement – <i>Section 35B</i>
Provision as to Patents after grant	<ul style="list-style-type: none"> • Term of patent – <i>Section 35</i> • Restoration of lapsed patents – <i>Section 37</i> • Amendment after grant – <i>Section 38</i> • Surrender of patent – <i>Section 39</i>
The effects of a patent and a patent application	<ul style="list-style-type: none"> • Prevention of direct use of invention – <i>Section 40</i> • Prevention of indirect use of invention – <i>Section 41</i> • Limitation of effect of patent – <i>Section 42</i>

	<ul style="list-style-type: none"> • Limitation of rights – <i>Section 43</i> • Rights conferred by patent application after publication – <i>Section 44</i> • Extent of protection – <i>Section 45</i> • Burden of proof – <i>Section 46</i>
Infringement	<ul style="list-style-type: none"> • Action for infringement of patent – <i>Section 47</i> • Proceedings for infringement by co-owner – <i>Section 48</i> • Restrictions on recovery of damages for infringement – <i>Section 49</i> • Relief for infringement of partially valid patent – <i>Section 50</i> • Proceedings for infringement by exclusive licensee – <i>Section 51</i> • Certificate of contested validity of patent – <i>Section 52</i> • Remedy for groundless threats of infringement proceedings – <i>Section 53</i> • Power of Court to make declaration as to non-infringement – <i>Section 54</i> • Right to continue use begun before date of filing or priority – <i>Section 55</i> • Action for infringement of published application – <i>Section 56</i>
Revocation	<ul style="list-style-type: none"> • Application for revocation of patent – <i>Section 57</i> • Grounds for revocation – <i>Section 58</i> • Examination of application for revocation – <i>Section 59</i> • Controller's power to revoke patents on his own initiative – <i>Section 60</i> • Circumstances in which validity of patent may be put in issue – <i>Section 61</i> • Controller to be given notice of Court proceedings – <i>Section 62</i>
Short-term Patents	<ul style="list-style-type: none"> • Application for short-term patent – <i>Section 63</i> • Patent under Part II and a short-term patent not to co-exist for same invention – <i>Section 64</i> • Provisions relating to short-term patents and applications therefor – <i>Section 65</i> • Actions for infringement – <i>Section 66</i> • Special ground for revocation of short-term patent – <i>Section 67</i>
Voluntary and Compulsory Licences	<ul style="list-style-type: none"> • Application for entry in register that licences of right are available – <i>Section 68</i> • Cancellation of entry – <i>Section 69</i> • Compulsory licences – <i>Section 70</i> • Provisions as to compulsory licences – <i>Section 71</i>

	<ul style="list-style-type: none"> • Licences, etc. on application of Minister of Government – <i>Section 72</i> • Procedure on applications under sections 70 and 72 – <i>Section 73</i> • Appeals and references to arbitrator – <i>Section 74</i> • Supplementary provisions as to licences – <i>Section 75</i>
Use of Inventions for the service of the State	<ul style="list-style-type: none"> • Assignment of invention, application, or patent to Minister of Government – <i>Section 76</i> • Right to use inventions for service of State – <i>Section 77</i> • Use of inventions pursuant to Section 77; supplementary provisions – <i>Section 78</i>
Property in patent applications and patent contract conditions	<ul style="list-style-type: none"> • Nature of patent applications and patents – <i>Section 79</i> • Co-ownership of patent applications and patents – <i>Section 80</i> • Determination of entitlement to patents, etc – <i>Section 81</i> • Effect of change of proprietorship – <i>Section 82</i> • Avoidance of certain conditions in contracts – <i>Section 83</i>
Register of Patents; Evidence of Register, Document, etc.	<ul style="list-style-type: none"> • Register of patents – <i>Section 84</i> • Assignment, etc. of patent applications and patents – <i>Section 85</i> • Power of Court to amend register – <i>Section 86</i> • Certificate of Controller and certified copies of documents to be evidence – <i>Section 87</i> • Information about and inspection of patent applications and patents – <i>Section 88</i> • Request for search – <i>Section 89</i>
Proceedings before the Controller or the Court	<ul style="list-style-type: none"> • Exercise of discretionary power by Controller – <i>Section 90</i> • Costs and security for costs – <i>Section 91</i> • Evidence before Controller – <i>Section 92</i> • Right of audience before Controller – <i>Section 93</i> • Privileged communications – <i>Section 94</i> • Assessors – <i>Section 95</i> • Appeals from decisions of Controller – <i>Section 96</i>
Provisions regarding International Conventions	<ul style="list-style-type: none"> • Effect of European patent – <i>Section 119</i> • A restoration where translation not filed under section 119(6) – <i>Section 119A</i> • Effect of filing application for European patent – <i>Section 120</i> • Authentic text of European patents and patent applications – <i>Section 121</i> • Conversion of European patent application – <i>Section 122</i> • Determination by Court of questions as to right to European patent – <i>Section 123</i>

	<ul style="list-style-type: none"> • Effect of patent decisions of competent authorities of other states – <i>Section 124</i> • Patent agents and other representatives – <i>Section 125</i> • European patent attorneys – <i>Section 126</i> • International applications for patents – <i>Section 127</i> • Orders to give effect to international agreements relating to patents – <i>Section 128</i> • Evidence of conventions and instruments under conventions - <i>Section 129</i> • Obtaining evidence for proceedings under European Patent Convention – <i>Section 130</i> • Communication of information to European Patent Office, etc – <i>Section 131</i> • Financial provisions – <i>Section 132</i>
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Suggested Reading List

	<ul style="list-style-type: none"> • Patents Act, 1992 (as amended) • Patents Rules, 1992 (as amended) • Written grounds of decisions of the Controller under the Act and Rules (available on the Patent Office website). • Paris Convention for the Protection of Industrial Property. • Council Regulations (EEC) Nos. 1768/92 and 1610/96 on Supplementary Protection Certificates and European Communities (Supplementary Protection Certificates) Regulations, 1993 (S.I. No. 125, 1993) • European Patent Convention. • Patent Cooperation Treaty (PCT), and Regulations under the PCT Directive on the Legal Protection of Biotechnological Inventions. • "Intellectual Property Law in Ireland" by Clark Smyth - Butterworths. • "Intellectual Property Law" - Law Society of Ireland. • "C.I.P.A. Guide to the Patents Act" by the UK Chartered Institute of Patent Agents - Sweet Maxwell. • "Intellectual Property: Patents, Copyright, Trade Marks Allied Rights" by W.R. Cornish - Sweet Maxwell.
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- "Terrell on the Law of Patents" - Sweet Maxwell.
- "European Patent Handbook" by CIPA - Longman.
- "Singer Stauder:- The European Patent Convention A Commentary " – Sweet Maxwell.
- "European Patent System" by Gerald Paterson - Sweet Maxwell.
- "Case Law of the Boards of Appeal of the European Patents Office" – European Patent Office.
- "Intellectual Property Law" by Bently and Sherman. (2009 Oxford University Press).

Case Law List

Ireland	Year	Court
Gilead Sciences Inc v. Mylan SAS	2021	IECA
Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd	2021	IECA
Teva Pharmaceutical Industries v. Mylan Teoranta	2018	IEHC
Re Boehringer Ingelheim Pharma GmbH	2018	IEHC
Norton (Waterford) Ltd v. Boehringer Ingleheim Pharma GmbH and Co KG	2017	IEHC
Gilead Sciences Inc v. Mylan SAS	2017	IEHC
Bristol Myers Squibb Co. v. Merck Sharp and Dohme Corp	2016	IEHC
Boehringer Ingleheim Pharma GmbH and Co KG v. Norton (Waterford) Ltd	2016	IECA
Medinol Ltd. v Abbot Ireland	2010	IEHC
Glaxo Group and the Patents Act (Patent 65535)	2009	Irish High Court
Medtronic Inc. v Guidant Corporation	2007	IEHC
Schneider (Europe) GmbH v Conor Medsystems Ireland Ltd	2007	ILRM
Novartis AG v Comptroller of Patents	2007	Irish High Court
Ranbaxy Laboratories Ltd v Warner Lambert Company	2007	Irish High Court
Ranbaxy Laboratories Ltd v Warner Lambert Company	2006	ILRM
Merial Ltd v Sanyko Co. Ltd.	2005	Irish High Court
Akzo Nobel N.V.,	2005	Irish High Court
Smithkline Beecham plc v Genthon BV	2003	Irish High Court
Merck & Co Inc v G.D. Searle & Co.	2001	ILRM
Bristol-Myers Squibb v Barker Norton Pharmaceuticals Inc,	2001	RPC
McDermott Laboratories Ltd v The Controller of Patents, Designs and Trade Marks	1998	Supreme Court
Biogen v Medeva	1997	RPC
Allen & Hanbury v The Controller	1997	Irish High Court
Merrell Dow Pharmaceuticals Inc v H N Norton & Co Ltd.	1996	RPC
Improver Corporation v Remington Consumer Products Ltd	1989	RPC
Allen & Hanbury v Generics (UK) Ltd	1988	ECR
Windsurfing International Inc v Tabur Marine (GB) Ltd,	1985	RPC
Pharmon BV v Hoechst AG	1985	ECR
Wavin Pipes Ltd v Hepworth Iron Co Ltd.	1982	Irish High Court
Merck v Stephar	1981	CMLR
Rawls v Irish Tyre and Rubber Services Ltd.	1960	IR

UK	Year	Court
Actavis UK Ltd v Eli Lilly and Co.	2017	UKSC
Dr Reddy's Laboratories v Eli Lilly	2008	EWHC
Pozzoli Spa v BDMO	2007	EWCA
Synthon v SmithKline Beecham	2005	UKHL
Kirin-Amgen Inc v Hoechst Marion Roussel Limited	2004	UKHL
Merrell Dow v Norton	1995	UKHL
Improver v Remington	1990	FSR
Windsurfing v Tabur Marine	1985	RPC
Catnic v Hill & Smith	1982	HL

European	Year	Issuer
T 0667/08	2012	EPO
T641/00	2002	EPO
T 24/81	1982	EPO
T 2/83	1984	EPO
G 1/03 and G 2/03	2004	EPO
G 2/10 (and G 1/03 and G 2/03)	2011	EPO
G 1/15	2016	EPO
G 1/07	2010	EPO
G 1/04	2005	EPO
G 1/93	1994	EPO
G 5/83 & G 2/08	1984	EPO