



## **Practice Note**

concerning

### **Section 127A of the Patents Act**

and

### **Rule 87A of the Patent Rules**

regarding

**Requests to the Controller for the Treatment of an  
International (PCT) Patent Application as an Application for  
an Irish Patent under Part II of the Patents Act.**

**V2.1 - 26 January 2021**

## PRACTICE NOTE

### Requests to the Controller for the Treatment of an International (PCT) Patent Application as an Application for an Irish Patent under Part II of the Patents Act 1992.

#### Legislation

- Patents Act 1992, as amended: S127A  
[Copyright and Other Intellectual Property Law Provisions Act 2019 \( Number 19 of 2019\)](#)
- Patent Rules, 1992, as amended: R87A  
[Patents \(Amendment\) Rules 2019 - S.I. No. 589 of 2019](#)

#### Overview

The PCT allows a State which is party to a regional patent system two forms of designation, namely national and regional. In such cases there are two designatable Offices for that State - the national Office of the State itself and the regional Office concerned. As Ireland is party to the European Patent Convention (EPC), the European Patent Office (EPO) is the applicable regional Office.

Certain States party to the EPC have “closed the national route,” so that patent protection through the PCT can only be obtained in those countries *only* by way of a regional (EP) designation for a European patent. Where any State that has “closed the national route” is designated, the designated Office concerned is always the European Patent Office.

In that regard, Section 127(1) of the Patents Act 1992 has been amended to provide that “*an international application for a patent designating the State shall be deemed to be an application for a European patent designating the state and shall, subject to section 127A, also be capable of being treated as an application for a patent under Part II.*”

The amendment of section 127(1) and the inclusion of a new section 127A in the Patents Act 1992 (the Act), by the Copyright and Other Intellectual Property Law Provisions Act 2019, allows for the parallel filing of an Irish national application based on a PCT application which, at filing, designates both Ireland and the EPO, within the 31 month period allowed by the PCT for entering the national or regional phase.

An applicant for an international patent under the PCT can request that it be treated here as an Irish patent application (the ‘Request’), subject to certain prescribed conditions. The Office will, where a valid Request is made, treat the application as though it had been filed under Part II of the Act. Such Requests can therefore *only* be made for Irish *full-term* patents. It does not allow for PCT applicants to request that a PCT application be treated as a short term patent application under Part III of the Act.

Section 127A (1) and (2) (a) (b) and (c) cater for the most part for persons whose international application fails to be accepted, fails to get a filing date, or if accepted is either withdrawn or deemed withdrawn.

Section 127A (2) (d) also makes provision for a PCT applicant to decide to request the grant of an Irish national patent irrespective of the status of the international application and without needing to proceed to the regional phase before the EPO.

Section 127A (3) allows an application which has ceased to be an application for a European patent designating the State to be treated as an application under Part II, subject to proof of cesser.

While these provisions do not open the national route in the traditional sense, they are considered to be more generous because they allow PCT applicants more flexibility to decide to obtain patent protection in Ireland in circumstances where international or wider European patent protection may not make economic or business sense. The section 127A provisions do not require an international PCT application to have failed or come to an end in order for a Request to be made. Indeed, section 127A does not prevent the international application from continuing into the regional/national phase and becoming a EURO PCT application before the EPO. However, if the EURO PCT application were to become a granted European Patent designating Ireland, the Controller is empowered to revoke the Irish patent granted from the PCT filing, pursuant to the provisions of Section 60 of the Act, on the principle that two patents should not co-exist for the same invention.

### **Filing requests and fees**

Section 127A Requests/Applications can only be received via Dropbox, Sharefile or post at this time. A notification will be issued when the e-filing system has been adapted to accommodate S127A requests.

Since a valid Request for a PCT application to be treated as an application for a patent under Part II of the Act should result in the application being given the status of a full term Irish national patent application, all fee requirements relevant to a Part II patent application apply equally to the PCT filing when submitted under a Request. So for example, the standard filing fee of €125 applies, as does whichever of the search or evidence fee obtains, and translation fees where necessary. Where the patent proceeds to grant, the grant fee of €64 will also apply.

## Scenarios

This practice note sets out the procedure which the Controller will follow in considering any Request filed under S127A, and draws attention to matters which the applicant should be aware of, in seeking an efficient and successful outcome.

Requests under S127A can be broadly categorised under four different scenarios.

- A. The applicant sought to make a PCT application, but the IB (International Bureau) refuses to accept it [S127A(1)].**
- B. The applicant has successfully filed a PCT application but it fails to make it through the international phase [S127A(2)(a,b)] or has not been received by the European Patent Office when entering the national/regional phase [S127A(2)(c)]**
- C. The applicant has successfully filed a PCT application but wants an Irish one regardless of the status of the PCT application [S127A(2)(d)].**
- D. A PCT application has ceased to comprise a European Patent application designating Ireland [S127A(3)].**

**NB:** When making the application, it is extremely important that an applicant clearly identifies which provision of S127A 1, 2 (including which specific subsection (a, b, c or d) therein) or 3 applies. The Office will not accept applications which are silent or unclear on which specific provision applies, since certain provisions have different implications regarding actions and timeframes.

The subsequent procedures followed by this Office in each case are set out below.

## **A. The applicant has sought to file a PCT but has not been accorded a filing date [S127A(1)].**

Where the applicant has attempted to file a PCT, but it has been not accepted by the IB, the applicant may request permission from the Controller for that application to be treated as an Irish national application under Part II of the Act. This is a two-step process.

- 1) The applicant asks the Controller for a filing date for the Irish application.
- 2) If 1) is successful, the applicant then requests that the PCT be treated as an Irish full-term application.

### **Valid Ground [S127A(1)]:**

The refusal to give a filing date was because of an error or omission on the part of an institution having functions under the PCT. For example, an administrative error at the IB might lead to the application not being processed and missing a deadline, or a transmitting office (of which the IPOI is one) might fail to properly transmit the PCT application to the IB until after the priority period has expired.

### **1) Requesting the Controller for a filing date for the Irish national application**

#### **Conditions [R87A(1,2)]:**

- a) The request must be received by the Controller within 2 months of the applicant being given notice that the IB has refused to give the PCT application a filing date [R87A(1)].
- b) The request must be in writing or electronic [R87A(1)].
- c) It must include the following [R87A(2)]:
  - i) Name and address of the applicant [R87A(2)]
  - ii) A copy of the PCT application as filed [R87A(2)(i)]
  - iii) A statement for the reasons for the request [R87A(2)(ii)]
  - iv) Any document, information or evidence verifying the above statement [R87A(2)(iii)]
  - v) The prescribed fee (as of 1 Dec 2020 no fee is prescribed for this) [R87A(2)(iv)].
- d) If the PCT application or any documents furnished with the Request are not in English, a translation into either Irish or English of these documents must be provided, subject to Rule 95 [R87A(11)].

#### **Outcomes**

- a) If the applicant fails to make a written request to the Controller for a filing date within the two months specified by **Rule 87A(1)**, – the application will be treated as withdrawn [R87A(3)]<sup>1</sup>.
- b) A full request is received but doesn't persuade the Controller – refused [R87A(4)] (option of hearing within 1 month [R87A(5)]).

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<sup>1</sup> But see E(iii) on p.13 regarding time limits.

- c) Case made – the Controller sets such filing date for the application as he considers appropriate [S127A(1)]. The applicant should now formally request the Controller to treat the international application as a patent application under Part II.

## 2) Requesting that the international application be treated as a patent application under Part II.

### Conditions:

- a) The Request must be received within 2 months of the applicant being given a filing date [R87A(6)(a)].
- b) The Request can be either in writing or electronic [R87A(6)(b)]. (Note that currently S127A Requests cannot be e-filed online and must be filed using the Dropbox, Sharefile or in hard copy.)
- c) It must include the following:
- i) A copy of the PCT application as filed [R87A(6)(b)(i)]
  - ii) Form No.1 (as per Rule 8) [R87A(6)(b)(ii)]
  - iii) The prescribed filing fee for a Part II patent application (as per Rule 8B) [R87A(6)(b)(iii)]. This means that an electronic Request must include the fee at the time of filing, but a print Request can avail of a deferred filing fee payment.

The applicant is also allowed to include other documents if they wish [R87A(6)(b)(iv)].

- d) If the PCT application or *any* documents furnished with the Request are not in English, a translation into either Irish or English of these documents must be provided, subject to Rule 95 [R87A(11)]. This means that the applicant can, in theory, take as long as they like furnishing the translation. However, if the translation is of a document fundamental to the request (e.g. the PCT as filed), and the applicant delays furnishing a translation so that it arrives after the last valid date for making the request, their Request will be deemed withdrawn, since the Office does not have to act on an untranslated document, effectively voiding the Request. Also, the application will not receive any further processing until such time as all foreign language documents filed have an acceptable translation on file.

### Processing the Request (application)

- Additional documentation can be requested from the applicant [R87A(9)]. See part E(ii) (p.13).
- Any PCT priority declaration is treated as an Irish priority declaration under Section 26 [R87A(12)(a)], but see **Priority** below.
- Where the PCT application has satisfied the PCT in an equivalent way to the **formal** requirements of our Act and Rules, it is considered to have satisfied those **formal** requirements of our Act and Rules [R87A(12)(c)].
- Other than the foregoing, the application is treated as a regular Irish full-term application under Part II of the Act, whose provisions apply fully to this patent application unless stated otherwise.

## Priority

If the failed PCT application included a declaration of priority, then the applicant is entitled to have that priority declaration deemed a priority declaration under Section 26(1). There are three possibilities:

- i) The Request deemed filing date is within 12 months of the priority document filing date.  
Priority can be allowed **[R21(1)]**.
- ii) The Request deemed filing date is between 12 and 14 months after the priority document filing date.  
**Rule 21(2)** should be invoked (satisfying the Controller that the delay is outside the applicant's control).
- iii) The Request deemed filing date is later than 14 months of the priority document filing date.  
Priority right is lost for that document **[R21(2)]**.

Also, such priority rights, if not declared at the time of the Request, must be declared within 16 months of the earliest priority date sought **[R22(2)]**.

In this case, since no filing was accepted under the PCT, no PCT filing/priority date benefits according to **R87A(12)(d)** can apply, priority must be processed under the normal provisions of the Act and Rules for Part II applications.

## Publication

See part E(iii) (p.13).

## Outcomes

If the conditions are met, the PCT filing is treated and examined as an Irish full term application under Part II **[S127A(2)]**.

The filing date for the Irish application is as the Controller directs **[S127A(1)]** - noting the **Priority** outcomes above.

**B. The applicant has filed a PCT application, but it has failed [S127A(2)(a), (b) or (c)].**

There are 3 reasons for this.

- I) The application was withdrawn while in the international phase [S127A(2)(a)].
- II) The IB deems either the application or any IE designation therein withdrawn [S127A(2)(b)]
- III) It is deemed withdrawn because it has not been received by the EPO in the regional/national phase [S127A(2)(c)]

If the prescribed conditions are met, each of these allows the application to be treated as an Irish full-term patent application under Part II. The process and conditions are essentially the same for each.

**Conditions [R87A(7)]:**

- a) If it was withdrawn (see I) above), then the Request must have been made within three months of withdrawal (*subject to c) below*). [R87A(7)(a)]
- b) If it was deemed withdrawn (see II), III) above), then the Request must have been made within three months of notification of withdrawal (*subject to c) below*). [R87A(7)(a)].
- c) Regardless of the applicability of a) or b) above, the application must have been made not later than 31 months from PCT filing or priority date (whichever is **earlier**<sup>2</sup>) [R87A(7)(a)].
- d) The Request can be either in writing or electronic [R87A(7)(b)]. (Note that currently S127A applications cannot be e-filed online and must be filed using Sharefile, the Dropbox or in hard copy.)
- e) It must include the following [R87A(7)(b)]:
  - i) A copy of the PCT application as filed [R87A(7)(b)(i)]
  - ii) Form No.1 (as per Rule 8) [R87A(7)(b)(iv)]
  - iii) The prescribed (Part II patent application) filing fee (as per Rule 8B) [R87A(7)(b)(v)].

The applicant must also provide

- iv) A copy of their withdrawal request, *if applicable* [R87A(7)(b)(ii)] – this may have been made either to the IB or the receiving Office.
- v) A copy of the withdrawal acknowledgement, *if applicable* [R87A(7)(b)(iii)] - this may have been given either by the IB or the receiving Office.

The applicant may also include other documents if they wish [R87A(7)(b)(vi)].

- f) If the PCT application or *any* documents furnished with the Request are not in English, a translation into either Irish or English of these documents must be provided, subject to Rule 95 [R87A(11)]. This means that the applicant can delay as long as they like furnishing the translation (subject to the necessary extensions of time being sought and allowed). However, if the translation is of a document fundamental to the Request (e.g. the PCT as filed), and the applicant delays furnishing a translation so that it arrives after the last valid date for making the Request, their Request will be deemed withdrawn,

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<sup>2</sup> The Rules have a typographical error which says whichever is the *later*. However, the Act (which takes precedence over the Rules where any clash or discrepancy arises) repeatedly indicates that it is the **earlier** of the filing or priority date which is correct, and this is the norm for all related PCT matters.



since the Controller does not have to act on an untranslated document, effectively voiding the Request (Rule 95).

### **Processing the Request (application)**

- The filing date is deemed to be the PCT application filing date.
- The applicant can amend the application before search/examination. They have **two months** from when they filed the conversion Request to do so **[R87A(7)(c)]**.
- If there is an international (PCT) search report **and** written opinion, we will accept that as evidence of novelty **[R87A(7)(e)]**. Said report and opinion must be accompanied by the evidence fee (as per Rule 27(2)). Regard will be had to the results of any Supplementary International Search Reports and the International Preliminary Report on Patentability (IPRP), if these are available. Otherwise, the applicant must request a search under Section 29 **[R87A(7)(d)]**.
- We can request additional documentation from the applicant. See part E(ii) (p.13).
- Other than the foregoing, the application is treated and examined as a regular Irish full-term application under Part II of the Act, the provisions of which apply fully to this application unless stated otherwise.
- Any PCT priority documents and dates are treated as Irish priority documents and dates under Section 26(1) **[R87A(12)(a),(d)]** (subject to the provision of any necessary translations, *see condition f) above*).
- Where the PCT application has satisfied the PCT in an equivalent way to the **formal** requirements of our Act and Rules, it has thereby satisfied those **formal** requirements of our Act and Rules **[R87A(12)(c)]** and the Office is therefore unlikely to engage in further formalities checks when processing the application.

### **Publication**

See part E(iii) (p.13).

### **Outcomes**

If the conditions are met, the PCT filing is treated and examined as an Irish full term application under Part II **[S127A(2)]**, with recognition of priority.

The PCT filing date is set as the filing date for the Irish application **[R87A(8)]**.

If the PCT filing date gets amended for any reason by the IB to a **later** date, then that date becomes the Irish filing date **[R87A(8)]**.

### C. The applicant has filed a PCT application and also wishes to file an Irish national application [S127A(2)(d)].

This scenario recognises a situation where the PCT filing does not have to have failed or perished. The applicant can seek an Irish filing from a live PCT application within 31 months of the earlier of its filing or priority date, regardless of the status of the international application.

#### Conditions:

- a) The Request must be made not later than 31 months from PCT filing or priority date (whichever is earlier<sup>3</sup>) [R87A(7)(a)].
- b) The Request can be either in writing or electronic [R87A(7)(b)].
- c) It must include the following [R87A(7)(b)]:
  - vi) A copy of the PCT application as filed [R87A(7)(b)(i)]
  - vii) Form No.1 (as per Rule 8) [R87A(7)(b)(iv)]
  - viii) The prescribed filing fee (as per Rule 8B) [R87A(7)(b)(v)].

The applicant may also include other documents if they wish [R87A(7)(b)(vi)].

- d) If the PCT application or *any* documents furnished with the Request are not in English, a translation into either Irish or English of these documents must be provided, subject to Rule 95 [R87A(11)]. This means that the applicant can take as long as they like furnishing the translation. However, if the translation is of a document fundamental to the request (e.g. the PCT as filed), and the applicant delays furnishing a translation so that it arrives after the last valid date for making the request, their Request will be deemed withdrawn, since the Office does not have to act on an untranslated document, effectively voiding the Request.

#### Process

- The filing date is deemed to be the PCT application filing date.
- The applicant can amend the application before search/examination. They have **two months** from when they filed the Request to do so [R87A(7)(c)].
- If there is an international (PCT) search report **and** written opinion, we will accept it as evidence of novelty [R87A(7)(e)]. Said report and opinion must be accompanied by the evidence fee (as per Rule 27(2)). Regard will be had to the results of any Supplementary International Search Reports and the International Preliminary Report on Patentability (IPRP), if these are available. Otherwise, the applicant must request a search under Section 29 [R87A(7)(d)].
- We can request additional documentation from the applicant. See part E(ii) (p.13).
- Other than the foregoing, the application is treated as a regular Irish full-term application under Part II of the Act, the provisions of which apply fully to this application unless stated otherwise.
- Any PCT priority documents and dates are treated as Irish priority documents and dates under Section 26(1) [R87A(12)(a),(d)] (subject to the provision of any necessary translations, *see condition d) above*).

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<sup>3</sup> The Rules have an error which says whichever is the *later*. However, the Act repeatedly indicates that the **earlier** of the filing or priority date is correct, and this is the norm for all related PCT matters.

- Where the PCT application has satisfied the PCT in an equivalent way to the **formal** requirements of our Act and Rules, it will be considered to have satisfied the **formal** requirements of our Act and Rules **[R87A(12)(c)]** and the Office is therefore unlikely to engage in further formalities checks when processing the application.

### **Publication**

See part E(iii) (p.13).

### **Outcomes**

If the conditions are met, the PCT filing is treated and examined as an Irish full term application under Part II **[S127A(2)]**, with recognition of priority.

The PCT filing date is set as the filing date for the Irish application **[R87A(8)]**.

If the PCT filing date gets amended by the IB to a **later** date, then that date becomes the Irish filing date **[R87A(8)]**.

## D. The PCT application has ceased to comprise a European Patent application designating Ireland [S127A(3)].

A PCT application may or may not have been successfully filed, but either way, the application has ceased to be deemed to be an application for a European patent designating the State.

There are several possibilities here.

- I) The PCT filing failed according to **S127A(1)**, or
- II) A filing was made according to **S127A(2)**, or
- III) As a consequence of the applicant's action or inaction the International PCT application is not proceeding as a European Patent application designating the State, e.g. where the applicant has not performed the acts required for entry into the national or regional phase before the EPO within the time limit allowed; [see [paragraphs 4.001 to 4.003 of the PCT Applicant's Guide - National Phase](#)] or where the applicant has decided not to proceed further with the EURO PCT application.

The subsequent procedures are as follows:

### I) The PCT filing failed and there is no PCT filing date.

#### Procedure

The procedure according to Scenario B (p7 above) is followed, except that the filing date to be given to the Irish patent is **the date we received the Request** (since there is no other valid date to use). The Office will not entertain argument about when a PCT filing might have been made or attempted. Also, priority rights are subject to the time limits of Rules 21 and 22.

#### Priority

If the failed PCT application included a declaration of priority, then the applicant is entitled to have that priority declaration deemed a priority declaration under Section 26(1), subject to the Rules governing admissibility of priority. There are three possibilities:

- i) The Request filing date is within 12 months of the priority document filing date.  
Priority can be allowed **[R21(1)]**.
- ii) The Request filing date is between 12 and 14 months after the priority document filing date.  
**Rule 21(2)** should be invoked (satisfying the Controller that the delay is outside the applicant's control).
- iii) The Request filing date is later than 14 months of the priority document filing date.  
Priority right is lost for that document **[R21(2)]**.

Also, such priority rights, if not declared at the time of the Request, must be declared within 16 months of the earliest priority date sought **[R22(2)]**.

In this case, since no filing was accepted under the PCT, no PCT filing/priority date benefits according to **R87A(12)(d)** can apply, priority must be processed under the normal provisions of the Act and Rules for Part II applications.

**II) A valid PCT filing was made.**

The situation set out in Scenario B (p6 above) applies mutatis mutandis.

The filing date is deemed to be the PCT application filing date **[R87A(8)]**.

If the PCT filing date gets amended by the IB to a **later** date, then that date becomes the Irish filing date **[R87A(8)]**.

Any PCT priority documents and dates are treated as Irish priority documents and dates **[R87A(12)(a)], [R21(1)]**, subject to the furnishing of any necessary translations.

**Proof of cesser**

While neither the Act or the Rules explicitly require that the applicant should furnish proof of 'cesser' (the ceasing of the application's being able to act as a European Patent application) when filing the Request, it would be reasonable to expect it to be among the documents the applicant may wish to submit. Should the Office not receive any proof of cesser, we would request it under **Rule 87A(9)**. Should the applicant then fail to furnish it within the set deadline, or offer valid argument why it cannot be produced, and cannot demonstrate that the application has ceased to act as an EP application, or that it can no longer designate Ireland therein, the Request will be deemed withdrawn **[R87A(10)]**.

## **E. Other matters common to two or more Request scenarios.**

### **i) Filing of Requests**

Note that though the legislation permits electronic filing of S127A Requests, the online patent e-filing system is not presently configured to accept them. For example, the system would automatically reject any S127A application request comprising priority documents where the priority is more than 14 months from the filing date.

For this reason, any S127A applications submitted through the online patent e-filing system will not be regarded as constituting a valid Request. The applicant will instead be requested to either make the Request in writing, or via Sharefile or the Drop Box, and the filing date for the Request will be the date of receipt by whichever of those means applies.

### **ii) Request for further documentation**

We can ask for any further documents from the applicant we deem necessary **[R87A(9)]**.

In the case of Scenario C, where the applicant has not provided any evidence of the cessation of the PCT as a European Patent application, we will request such evidence. Note, however, that it is not limited to this, and the Controller may seek any document that is considered appropriate, regardless of the scenario under which the Request is made.

The request can be made in writing or electronically (by e-mail) **[R87A(9)]**.

#### **Outcomes**

If the applicant fails to provide these documents, the Request is **deemed withdrawn [R87A(10)]**.

Otherwise, the Request proceeds as normal.

### **iii) Publication**

All Irish patent applications are required to be published at 18 months under Section 28 of the Act. PCT conversions need to be published too. There are three possibilities.

- a. If the PCT has already been published by the IB, it is deemed published under S28 **[R87A(12)(b)]**.
- b. If the IB has published the PCT application, but not in (Irish or) English, any successful conversion will require a translation of the claims into either Irish or English before it is considered published under S28 **[R87A(12)(b)]**.
- c. If the PCT has not been published by the IB, we publish it ourselves under S28 **[R87A(13)]**.

**iv) Time limits under Rule 98**

Rule 98(3) has not been amended to include any aspect of Rule 87A. Accordingly, any time limit for action specified under any part of Rule 87A may be extended on request from the applicant in accordance with Rule 98 in the normal way.

**v) Priority**

Note that matters specific to priority documents are set out in each scenario above, depending on whether a PCT application was successfully filed. More generally, and notwithstanding the specific advice given above in each section, Rule 22(5) of the Patents Act, to which any patent application accepted under S127A is subject, requires that certified copies of priority documents be submitted not later than the end of the 16th month after the priority date, with the possibility of an extension, if the Controller sees fit.

Allowing for the fact that an application under S127A may not have been made until after this period is expired, applicants in such cases, where priority documents outside this timeframe are being invoked by the applicant, are strongly advised to ensure that certified, or otherwise acceptable, copies of the priority documents are provided **at the time of filing**. In so doing, the priority documents will be accepted in the situation where said documents were accepted by the IB as part of a PCT application, according to Rule 87A(12)(d). Where the applicant can not furnish said priority documents at filing, they should instead at the time of filing submit a request for an extension of time to submit them under S118A and Rule 98 (along with the prescribed fee). Justification for the inability to provide the documents at filing will be required for any extension to be entertained.

**vi) Interpretation of Rule 87A(7)(a)**

This rule sets out the time limits under which a Request may be made under Section 127A(2) and (3). In the interests of clarity, the Controller applies this Rule as follows:

Where an application is made under S127A (2)(a, b, c OR d) OR (3), the following time limits apply.

- 1) If the international (PCT) application was withdrawn, then the Request must be filed no later than 3 months from the date of withdrawal.
- 2) If the international (PCT) application was deemed withdrawn, then the Request must be filed no later than 3 months from the date of notification of the withdrawal by the relevant office under the PCT.
- 3) Notwithstanding 1 or 2 above, the Request must be filed no later than 31 months from the date of filing or priority of the international (PCT) application, whichever is the EARLIER. The error in the wording of the Rule must be interpreted this way, to recognise the primacy of the provisions of the Act under the law. Hence, a PCT application having been withdrawn at 30 months does **not** permit the applicant to file a Request under S127A(2) or (3) at 33 months, but rather the application must still be made within the 31 months allowed.
- 4) The 31 month deadline also applies in situations where no withdrawal or deemed withdrawal is involved, as may be the case, for instance, for applications made under S127A(2)(d).

## Appendix A

### Patents Act, Section 127A

#### Circumstances in which international application for patent designating State shall be treated as application for a patent under Part II

- 127A. (1) If an international application for a patent which designates the State is refused a filing date under the Treaty and following a request made in the prescribed manner and within the prescribed period, the Controller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application shall be treated as an application under Part II, having such date of filing as he may direct.
- (2) Subject to compliance with the prescribed conditions, an international application for a patent which designates the State shall be treated as an application under Part II if—
- (a) the applicant withdraws the international application at any time prior to the expiration of 31 months from the filing date or the priority date of the application, whichever is the earlier, and the international processing procedures in the international phase are discontinued,
  - (b) the International Bureau determines, for any reason, that the international application or the designation of the State in it, is withdrawn or considered withdrawn,
  - (c) the international application is considered to be withdrawn on the ground that it has not, within the period prescribed by Article 20 (as that Article is construed in accordance with Rule 47 of the Treaty Regulations), 22(1) or 39(1) of the Treaty, been received by the European Patent Office, or
  - (d) the applicant decides, at any time prior to the expiration of 31 months from the filing date or the priority date of the international application designating the State, whichever is the earlier, to request the Controller to treat the international application as a patent application under Part II.
- (3) Subject to compliance with the prescribed conditions, an international application for a patent designating the State which has, under subsection (1) or (2), ceased to be deemed to be an application for a European patent designating the State shall, upon that cesser taking effect, be treated as an application under Part II.
- (4) Subsection (5) applies to an international application for a patent designating the State which is treated as an application for a patent under Part II.
- (5) An application for an international patent designating the State which has been published by the International Bureau in accordance with the Treaty in a language other than Irish or English shall be treated, for the purposes of sections 56 and 66(3), as published under section 28 when a translation into Irish or English of the claims of the application have been filed and published by the Office.
- (6) Article 2 of the Treaty shall apply to the interpretation of this section as that Article applies to the interpretation of the Treaty.
- (7) In this section, 'Treaty Regulations' means the Regulations under the Treaty as such Regulations are in force from 1 July 2016.



## Appendix 2

### Rule 87A

#### 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.