

Consultation on the Review of the Patents Act 1992

Purpose of the consultation

This consultation is intended to engage with interested parties, including patent applicants/proprietors and to those acting as agents, and to seek their views for inclusion in the review of the Patents Act 1992 (as amended).

Background

Ireland is a party to the European Patent Convention, the Patent Cooperation Treaty, as well as having obligations under the European Union and other international treaties. The Patents (Amendment) Act 2006 contained the necessary substantive legislative provisions to give effect to a number of international agreements, such as the revised European Patent Convention (EPC 2000), the Patent Law Treaty (2000) and certain articles of the World Trade Organisation.

In 2008, the Government published its medium-term economic framework -[*Building Ireland's Smart Economy*](#), which sets out the policy to position Ireland as an International Innovation Hub. In order to achieve this objective the recent [*Report of the Innovation Taskforce*](#) examined this issue and made a wide range of recommendations, including proposals to support marketing Ireland as a location for research and commercialising Intellectual Property. The first step is to ensure that Irish patent legislation is harmonised with international laws and standards. The ultimate aim of the review is to identify priorities to further align Ireland's patent legislation with international best practice, thereby, ensuring that the Irish patent legislative framework is recognised worldwide, as, being one of the best and most modern regulatory regimes in the Intellectual Property arena.

Focus of the review of the Patents Act

The review will examine the current legislative framework in order to establish key issues for deliberation, with a view to bringing a proposal for legislative changes to Government for approval. The review will focus, in particular, on the process for the

granting of national patents and the protection of these rights once granted to align these procedures further with international standards and practice. The following areas have been initially identified for consultation and deliberation:

Substantive Examination

The *Report of the Innovation Taskforce* launched by An Taoiseach, Brian Cowen T.D. in March 2010 recommended the introduction of substantive examination at the Patents Office to provide greater integrity and reliability to the patent process in Ireland. This function was previously carried out in the Patents Office. In light of the recommendation of the Task Force and Government policy, it is timely, to explore the possibility of re-introducing substantive examinations for national patent applications.

Patent Co-operation Treaty (PCT) Application

The Patent Co-operation Treaty (PCT) makes it possible to seek protection for an invention simultaneously in each of a large number of countries by filing an “international” patent application. The main objective of the Treaty is to streamline patent application filing and novelty search procedures for applicants wishing to obtain patent protection in a wide number of countries around the world. Ireland ratified the PCT in 1992 and the Patent Office acts as receiving office for PCT applications. The Office carries out administrative formalities checks before transmitting the application to the International Bureau at the World Intellectual Property Organisation (WIPO). The Office also accepts certain fees associated with a PCT application for transmission to WIPO.

A PCT application requesting patent protection in Ireland is deemed to be an application for a European patent designating Ireland and is processed by the EPO in accordance with the European Patent Convention (EPC). Under the current legislation, there is no specific provision to enable a PCT applicant to designate Ireland independently of the European patent designation – this would give an applicant greater flexibility in that he/she could still obtain an Irish patent if it was decided to withdraw from the European patent route at any point in the procedure.

Short-term patent

The term of an Irish full-term patent is 20 years and the invention for which it is granted must be new, have an inventive step and have an industrial application. The same general criteria apply for a short-term patent under the Irish Patents Act, 1992 except that the level of inventive step is not as strict as would be required for a full-term patent. The term of a short-term patent is of 10 years duration. Applications for short term patents are processed faster as such applications are not subject to search and substantive examination, and are a good deal less expensive than full-term patent application fees.

In general, in other European countries short-term patents are known as Utility Models. Due to the “light” nature of the search and examination of short-term patents by the Patents Office there is a view that that the title ‘short-term patent’ is misleading and may, to some extent, undermine the integrity of the patenting system in Ireland.

At present, there is no proposal at European Union level to harmonise national laws for utility models. However, 57% of all patent applications received by the Irish Patent Office in 2009 were for short-term patents. In light of this choice by industry, it is suggested that the title ‘short-term patent’ should be changed to ‘utility model’ to reflect best practice internationally. The benefits and facilities enshrined in legislation in regard to short-term patents would continue to apply to utility models.

Any further submissions on other key issues or sections of the Act unrelated to the above will be welcomed, bearing in mind the international commitments enshrined in the Patents Act 1992 (as amended).

How and when to respond

Any questions in relation to the Consultation Document should be addressed to Ms Imelda Hardiman at 01 631 2581

Responses to the consultation may be sent by e-mail marked Review of the Patents Act 1992 to ipu@deti or by post to:

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Responses should be received by close of business on Thursday 30th September 2010.