

## **Responses to the consultation on the Review of the Patents Act 1992**

In 2010, a review the Patents Act 1992 was instigated, the purpose of which is to examine the current patent legislative framework to establish key issues for deliberation, with a view to bringing a proposal for legislative changes to the Government for approval.

The main focus of the review is to examine the process for the granting of national patents, validation of international patents and the protection of these rights, once granted, to ensure that Irish legislation is in alignment with best international standards and practice.

In order to define the scope of the review, informal meetings were held with interested parties and three specific issues were identified for further deliberation, which were highlighted in the consultation document.

The [Consultation on the Review of Patents Act 1992](#) was put on the Department of Enterprise, Jobs and Innovation's website and the following organisations were consulted directly: the Controller and the Patents Office, the Association of Patent and Trade Marks Attorneys, Industrial Liaison Officers in the Universities and Technology Institutes, IBEC, ISME, the Law Library, the Law Society and the Patents Office Users Council, (which includes members from Enterprise Ireland, the Licensing Executive Society, UCD, DCU and Microsoft Ireland).

### **Summary of the consultation:**

A reasonable number of responses to the consultation were received and all points raised will be addressed in the Regulatory Impact Assessment. A short summary of the responses follows:

#### **1. Substantive Examination:**

##### **(Relevant sections of the Act: 29 to 35)**

The reintroduction of substantive examination was recommended in the Innovation Task Force's Report-Annex 7

*“Introduce substantive examination of patents applications by the Patents Office, thus restoring one of its core functions and increasing IP expertise”.*

Currently, the Patent Office is precluded from carrying out substantive examination of full-term applications. The Patents Act 1992 places the responsibility for ensuring that an application is in order for grant entirely into the hands of the applicant/agent. An amendment could return the powers of substantive examination to the Patents Office with regard to novelty, inventive step and industrial applicability. Also, the issues of clarity, conciseness of claims and disclosure of the invention should also fall within the Patents Office's competence.

Overall, most of the responses strongly supported the resumption of substantive examination by the Patents Office. However, concerns were highlighted about possible resulting increased fees for applicant, while the need for enhanced training and resources for the Patents Office was also highlighted.

## **2. Patent Cooperation Treaty (PCT)** **(Relevant sections of the Act: 127, 135)**

*There is no specific provision under the legislation to enable a PCT applicant to designate Ireland independently of the European patent designation.*

Submissions were strongly supportive of this proposed change to amend the relevant section of the Patents Act 1992 to allow for Ireland to be designated directly in a PCT application, thereby opening up the national route for PCT applicants. Currently, a patent PCT applicant can only be validated in Ireland by way of a European patent grant. Amending this anomaly may increase the number of full-term patent applications to the Patents Office. This proposed change would be less costly and more convenient for applicants.

## **3. Short Term Patents:** **(Relevant sections of the Act: 63 to 67)**

*The term “short-term patent” has been highlighted for examination, with a view to re naming to “Utility Model” to better reflect the form of rights it relates compared to the full term patent.*

Submissions on the issue of renaming the short-term patent to a “utility model” were substantially against the proposal, citing possible confusion and suggesting the absence of either a need or a demand for an alternation to the current name. There is considerable support for retaining the title short patent, though several other alternative titles were suggested which, crucially, retained the word ‘patent’.

### **Other issues for further deliberation:**

Stakeholders took the opportunity of this consultation to offer a wide range of suggested changes to current patent legislation and procedures including:

- **Novelty /Prior art search-** facility where a novelty/prior art search carried out on newly filed patent applications and the results delivered within a few months of filing so that application can make informed and practical decisions as to whether to proceed with their applications.
- **Late Filing of Supplementary Protection Certificate (SPC) applications** – suggesting a resolution to the perceived anomaly where there appears to be no corresponding Controller discretion for the late filing of SPCs as there currently exists for patent applications.
- **The European Communities (Limitation of Effect of Patents) Regulations 2006 (“Regulatory Review Exemption”)** – relating to medicinal products, suggesting Ireland’s narrow interpretation of the Regulatory Review Exemption when transposing Directive 2001/83/EC places Irish patent applications at a competitive disadvantage.
- **Assignments** – suggesting changes to current assignment practices in the Patents Office, in particular relating to certain requirements from the European

Patent Office and the current requirement for a patent to be published prior to assignment.

- **Entry on the Register of Patent Agents** – highlighting the current situation whereby individuals and partners may be listed as patent agents, but not companies.
- **Authorisation of Agent Forms** – removing the prescribed manner under SI 105, for filing an Authorisation of Agent form or Power of Attorney form. This issue was also highlighted, with regard to foreign patent applicants, in a separate submission.
- **Clarification of Deadline Dates** – raising a minor issue on current deadline dates practice in the Patents Office.
- **Increased on-line functionality** in the Patent Office – e.g. on-line filing,
- The need to keep **patent fees** low so as to remain accessible for SMEs

The next step is to carry out a Regulatory Impact Assessment and all issues identified in the consultation will be addressed in the RIA.

**The complete responses received are attached in the annexes.**

## ANNEX 1

### Correlated submissions received for the Review of the 1992 Patent Act

#### 1. Substantive Examination

Respondent 1 supports the re-introduction of substantive examination at the Irish Patents Office and agrees that this would be a necessary step in aligning Ireland's patent legislation with international best practice. However, Respondent 1 submits that a significant investment in resources and training would be required to implement a substantive examination system at the Irish Patents Office that would meet the standards of international best practice.

Some specific issues in relation to substantive examination are discussed further below.

a) Defined Corrective Process

Filing a patent application and prosecuting it to grant requires the submission of a variety of documents, generally in response to deadlines defined in the Act or Rules, or in response to deadlines defined in letters from the Irish Patents Office. In many cases, failure to meet these deadlines can result in the loss of the patent application. Respondent 1 proposes that any changes to Irish patent legislation include a defined "last-chance" procedure, whereby applicants are provided with an opportunity to remedy any deficiencies that would otherwise result in the loss of the patent application. Such procedures are available under the European Patent Convention (EPC) in the form of Further Processing under Article 121, and similar safe-guards are built into the majority of the procedures under the Patent Co-operation Treaty.

b) Hearings in patent prosecution

Currently, patent prosecution before the office takes place in written form, with the opportunity to request a hearing before the Controller being available before refusal of a patent application, or other adverse determinations by the Controller. The deadline for requesting such a hearing is within 10 days of the date of the notifying letter. Respondent 1 submits that this deadline is very short and that a longer deadline, such as 2 months, would be appropriate, so as to allow an applicant to consider his options.

Respondent 1 further submits that a more frequent use of hearings would be useful in the course of substantive examination of patent applications. It can be seen from Oral Proceedings at the EPO that this can be a very efficient way to conclude proceedings.

*(Respondent 1)*

The re-introduction of a substantive examination system for 20 year or full term patents sounds very much like an opportunistic attempt by Patent Agents to charge applicants more exorbitant fees. The current system of bringing an Irish Patent application into conformity with an existing corresponding British, European or German granted patent works well in practice. There is however, already a significant additional delay between bringing applications into conformity and processing to grant which should be addressed. Bringing in a formal examination system will significantly add to the expense of getting a patent in Ireland for Irish inventors and make the system even less attractive to International applicants, in addition, the Patents Office currently does not have the expertise, facilities or manpower to carry out such substantive examinations and the cost of addressing this would be prohibitive.

What would be a highly useful and practical measure would be the facility to have a novelty search carried out on newly filed patent applications and the results delivered within a few months of filing so that applicants can make informed and practical decisions as to whether to proceed with their applications. Currently many applicants file first in the United Kingdom who provide such a search result within 4 months of filing.

***(Respondent 2)***

Sections 29 and 30 of the Act specify the procedure applicable to Irish Patent applications up to grant and, respectively, require either a search to be performed by the Patents Office (Section 29) or the filing of evidence of novelty acquired in respect of a corresponding, overseas application (Section 30).

Sections 29, 30, together with Sections 31 and 32 of the Act specify that, further to the search report issued by the Patents Office or the filing of evidence of novelty, the onus for placing the application in order as regards the essential criteria of novelty, inventive step and industrial applicability are solely incumbent to the applicant, since the provisions of the Act omit the consideration on the merits by a Patents Examiner of any amendments and/or arguments filed by applicants.

Given the stated aims of the Review to further align Ireland's Patent Legislation with International Best Practice, understood as including for instance practice by the EPO, the USPTO and the JPO, for ensuring that the Irish Patent Legislative framework is recognised worldwide as being one of the best and most modern regulatory regimes in the field of Intellectual Property, then re-introduction of Substantive Examination appears to be a *sine qua non* starting point, upon which to build further legislative primacy on the global stage.

The Patents Act 1992 still mirrors substantially the UK Patents Act 1977 save as to the implementation of legislative concepts that are specific to Ireland, such as the evidence of novelty alternative referred to above and short-term patents discussed in further details below. For purposes of expediency and legislative compatibility, the Review may usefully consider Section 18 of the UK Patents Act 1977 as amended, which is aligned with the requirements of EPC 2000, as notional guidance for a legislative update.

***(Respondent 5)***

Respondent 6 would welcome the re-introduction of substantive patent examination in Ireland, and the option for direct national phase entry of PCT applications. Both proposals would do much to increase the integrity and flexibility of the Irish Patent system.

***(Respondent 6)***

At present, an applicant for an Irish Patent may either request the Irish Patents Office to conduct a search (s.29 of the Act) or rely upon a search report from a foreign patents office (s.30 of the Act). Respondent 3 notes that, if a search report shows that the invention clearly lacks novelty, or has no inventive step, the Irish Patents Office cannot refuse to grant the patent application.

Respondent 3 therefore recommends that the Irish Patents Office be allowed to examine a patent application after the s.29/30 search report has issued in order to ensure that the application meets the requirements for novelty/inventive step.

***(Respondent 3)***

## **2. Patent Co-operation Treaty (PCT)**

Respondent 1 supports the direct nationalisation of PCT applications at the Irish Patents Office, and again agrees that this would be a necessary step in aligning Ireland's patent legislations with international best practice. The Office will currently grant an Irish patent application on the basis of a published International Search Report from a corresponding PCT application, used as Evidence of Novelty. Therefore, even in the absence of substantive examination, it would seem reasonable to allow direct nationalisation of PCT applications at the Office. The possible reduction in revenue due to a reduced number of Irish patent applications being filed would likely be recovered by not having to share the renewal fees for these cases with the EPO.

***(Respondent 1)***

Sections 127 and 128 of the Act define the relationship between the State and International patent applications filed under the PCT. Section 127 (1) in particular specifies that a PCT application intended to achieve patent rights in Ireland is deemed to be an application for a European patent designating Ireland. Section 122 of the Act specifies the context for converting the Irish designation of a withdrawn European patent application into a patent application under Part II of the Act.

In view of the above, there are effectively no legislative provisions to allow an independent Irish national phase from a PCT application to proceed, either early or by

the expiry of the international phase at 30 months (optionally 31 months such as for EP applications and others).

This legislative situation appears detrimental, particularly as the provision of an International Search Report and Written Opinion, often as not prepared by the European Patent Office acting as the International Searching Authority, would appear sufficiently authoritative to meet the conditions of Sections 30 and 66(3) for such an Irish national phase, at least cost and inconvenience to the applicant.

As is the case in connection with the question of re-introducing Substantive Examination discussed above, the Patents Act 1992 still mirrors substantially the UK Patents Act 1977 and, for purposes of expediency and legislative compatibility, the Review may usefully consider Sections 89, 89A and 89B of the UK Patents Act as amended as notional guidance for a legislative update.

*(Respondent 5)*

Under the current legislation, there is no specific provision to enable a PCT applicant to designate Ireland independently of the European patent designation.

Respondent 3 supports an amendment to the position whereby a PCT applicant has an option to designate Ireland independently of the European patent designation in order to maintain the possibility of obtaining an Irish patent in the event that the applicant withdraws from the European patent application.

*(Respondent 3)*

### **3. Short Term Patents**

Respondent 1 feels that the short term patent is an effective and useful tool for patent applicants and does not feel that any change to the title of the current legislation is required. However, in the light of the concerns raised in the consultation document, Respondent 1 suggests the following possible changes.

Change of name to ‘Petty Patent’ or ‘Innovation Patent’

The consultation document highlights that 57% of all patent applications filed at [the] Irish Patent Office are short-term patent applications. Many of these short-term patent applications are filed to provide preliminary protection and to form the basis for filings claiming priority within twelve months. Therefore many become abandoned at the end of that 12-month period. Respondent 1 is concerned that the elimination of the word ‘patent’ from the name, by changing the name to ‘utility model’, would make applicants uncomfortable about the level of protection they have for their inventions in such situations and submit that the terms ‘petty patent’ or ‘innovation patent’ provide a useful compromise in this matter.

Respondent 1 submits that such a changer of name would also indicate that the levels of search and examination carried out on such applications is not stringent, without undermining the integrity of the Irish patenting system.

*(Respondent 1)*

To start renaming Short Term patents after such a lengthy period in existence will only add to further confusion by inventors/applicants. The short-term patent process is almost exclusively used by people in Ireland and there is no need or indeed demand to change its name. Furthermore changing its name will only make the task of patent searching difficult with documents designated as short term and new ones as utility models. Ireland is not the only country to call such patents short term so also does Hong Kong and some other countries call them petty patents.

*(Respondent 2)*

Part III of the Act specifies the legislative framework applicable to Irish short-term patents.

The advantages of this particular form of patent protection in Ireland, now long-established, are best represented, or translated, by the growing proportion such applications have come to represent as a total of applications received by the Irish Patents Office over the years since it was introduced.

The Review suggests that the benefits and facilities enshrined in legislation in connection with short-term patents would continue to apply, even if short-term patents were to be renamed as utility models. This outcome is desirable, as it is these benefits and facilities which have driven the uptake and success of this particular form of protection, not only by domestic applicants but a non-trivial number of foreign applicants.

A brief comparison of the format and requirements of the Irish short-term patent against European equivalents, which are alternatively named “short-term patents” (translated as) or “utility models”, suggests little difference in terms of duration, requirements (expressed as thresholds of novelty and inventive step relative to full-term patents) and costs.

As regards the choice of appellation for this particular form of protection, it is accepted that the expression “utility model” may be better recognised by potential applicants, as more connotative of the form of right it relates to.

However, and by way of contrast, the French Patent Office still refers to its own equivalent to the Irish short-term patent, both as a short-term patent (“Petit Brevet”) and a utility model (“Certificat D’utilité”), there being no distinction between the two terms in legislative terms. Moreover, the United States has long been known by applicants the world over, for its own equivalent to short-term patents and utility models of European countries, as “Design Patents”. Considering the fact that US applicants represent a non-trivial number of applicants for patents and utility models across Europe, including Ireland, this further denomination of “design patent” may usefully be considered by the Review as an additional alternative to the expression “utility model”.

For purposes of completeness of information, the following information highlights commonalities and differences across 17 European countries which, respectively, provide essentially the same form of shorter-duration patent right:

- Fifteen of seventeen countries provide a utility-model duration of 10 years. The two exceptions are France (6 years) and Greece (7 years).
- Fourteen of seventeen countries have a legal requirement of absolute novelty for the invention, substantially per the Irish requirements of Section 63 (4). The remaining three countries mandate relative novelty (Germany, Hungary, Spain).
- Twelve of seventeen countries restrict utility models to apparatus inventions alone. The remaining five countries extend the protection conferred by a utility model to both apparatus and method inventions (Austria, Estonia, France, Ireland, Portugal).
- Interestingly, in connection with the earlier discussion about possible legislative developments in connection with the PCT, eleven countries provide the opportunity of filing a utility model as a national phase of a PCT application. The remaining six countries do not (France, Greece, Ireland, Italy, Poland and Slovenia).

Thus, beyond the question of changing the expression of “short-term patent” for “utility model” in relevant Statutes, there is the scope to include this alternative form of patent protection in Ireland within the wider question of permitting direct Irish national phase entry from PCT applications.

With reference again to the aforementioned benefits and facilities enshrined in legislation about this particular format, and which are arguably at the base of its success, the possibility of entering an Irish utility model phase directly from a PCT may be expected to yield a significant increase in filings.

***(Respondent 5)***

Respondent 3 is of the view that the current title of “*short-term patent*” is appropriate to describe the type and level of protection afforded to qualifying inventions, and does not support an amendment of the title to “*utility model*”.

Respondent 3 recommends that, as part of any review which may be taking place in relation to the short-term patent regime, opportunities to provide additional low-level protection to certain high technology inventions are considered. Respondent 3 notes that the inventions in this area are often incremental. Respondent 3 is however of the view that long-term patent protection is inappropriate due to the fact that the underlying technology quickly becomes obsolete.

***(Respondent 3)***

## 4. Other Issues

### Authorisation of Agent Forms

It is currently a requirement under Section 105 of the act that patent agents be authorised by applicants signing Form No. 5. Additionally, the Office requires that applicants and inventors for a PCT application, filed at the office, supply executed Power of Attorney forms for PCT applications, even though this is not a requirement under the PCT. Respondent 1 submits that these requirements are unnecessary, serve not advantage and simply create unwanted paperwork. The EPO and UK Intellectual Property Office do not, in general, require such signed documents from applicants represented by duly registered patent agents. The EPO maintains the right to request an Authorisation, for example, in case of a change of representative. Respondent 1 would therefore welcome removal of the automatic requirement for filing an Authorisation of Agent form or Power of Attorney form, but suggest that the Office have the right to request such a form in certain circumstances.

### Clarification of Deadline Dates

Correspondence from the Irish Patents Office setting a headline for reply with a certain number of months must be responded to in that number of months less one day. In this way, a letter dated 10 April 2011 setting a deadline for response of within 2 months of the date of the letter must be responded to by 9 June 2011. Respondent 1 submits this is a confusing manner of operation and would welcome a more 'common sense' implementation of such deadlines.

### Assignments

Firstly, currently it is not possible to record the assignment of the Irish part of a European patent at the Office using confirmation from the EPO that the assignment has been recorded with them (issued on EPO Form 2544), if the transfer was registered after the grant of the European patent. In such cases, the Irish Patents Office requires submission of certified copies of the documents of assignment. Respondent 1 submits that confirmation from the EPO should be sufficient to allow recordal of the assignment. Even if the Form 2544 is in French or German, the standard format of the form readily allows for the necessary information to be deduced. If translation of the Form 2544 is required, Respondent 1 suggests that such translation could be certified by a registered patent agent.

Secondly, currently the Office will not allow recordal of an assignment of a patent application until after the patent application has been published. Therefore it is possible that, in some cases, out of date applicant information could be deliberately maintained by the Office for as much as 18 months. Respondent 1 submits that this is not a helpful situation and further submits that recordal of assignments should be allowed at any time in the lifetime of the application or patent.

### Entry on the Register of Patent Agents

Currently, Sections 106 and 107 of the Act allow a company to hold themselves out to be patent agents, but does not allow that company to be entered on the register of patent agents, as the register is restricted to individuals and partnerships. Therefore, a company is not allowed to enter its address as being "as currently entered on the register" which would create difficulties if the company in question ever changed

address. Respondent 1 submits that the requirements for entry on the register of patent agents be extended such that a suitable company may be entered thereon.

#### Late Filing of Supplementary Protection Certificate (SPC) applications

Currently, there are no provisions governing the late filing of an SPC application. An application for an SPC must be filled within six months of the date of grant or six months from the date of the relevant product authorisation, whichever is earlier. If this date is missed, there is no explicit rule in Irish patent law which allows late filing if the SPC application.

The case law for SPCs has suggested that any errors that are not dealt with by the SPC Regulations can be corrected by applying the relevant national legislation to patents. However, there are no overarching discretionary powers given to the Controller under the Act. In particular, there is no discretionary power such as the Rule 110 (discretionary extension of time) provision under UK law.

Therefore, Respondent 1 would welcome a revision of the Act to include some discretionary power to the Controller which is broad enough to allow acceptance of late filed SPC applications.

#### S.I. No. 50 of 2006, European Communities (Limitation of Effect of Patents) Regulations 2006 – “Regulatory Review Exemption”

The EU regulatory review exemption has been implemented in different ways across individual Member States. In this regard, it is noteworthy that Ireland is amongst the group of countries that has adopted a narrower exemption tied to a specific regulatory approval route (the so-called “abridged procedure”) and geographical scope (regulatory applications in EU countries only).

Countries such as Ireland and the UK have incorporated the language of the Directive directly into the respective statutes. In contrast, other countries have not limited the scope of the regulatory review exemption to activities supporting “abridged applications”, or to activities carried out in order to obtain regulatory approval within the EU itself.

The net result is effectively a two tier system which gives companies in those countries that have adopted a broader exemption a distinct commercial advantage (by virtue of having a wider safe harbour from patent infringement) over competitors in countries which have adopted a narrower interpretation of the Directive. Thus, instead of “only” being at a disadvantage against competitors in the US and Japan, where the corresponding exemptions to patent infringement are more generous, Irish pharmaceutical companies face an up-hill battle against companies based elsewhere in the EU who can benefit from a more favourable interpretation of the regulatory review exemption in their home country.

While the rationale behind the regulatory review exemption may be sound, the manner in which this legislation has been enacted has implications for Ireland that may not have been intended – putting Irish companies at a competitive disadvantage to their peers elsewhere in the EU.

Respondent 1 submits that it would be beneficial for the provision of Section 42(g) of the Act to be amended in line with the approach adopted in countries such as France and Germany described above.

***(Respondent 1)***

Respondent 3 has reviewed the consultation paper and would agree with the proposals set out. In addition Respondent 3 believes that getting the earliest possible indication of prior art reduces cost and effort and creates an efficient patents system. A Confidential prior art search reports similar to those being issued by EPO may influence people to file Irish provisionals.

***(Respondent 4)***

Some practical aspects of how patent applications are received and processed should be changed; the Patents Office has spent a lot of taxpayers money in the area of computerisation, yet the benefits of such investment have been minimal in a practical sense. Applications for Patents, Trademarks etc should be able to be filed electronically on-line, as is the case with most other national Patent Offices and a fee reduction for utilising such a facility. Other matters such as subsequent filing of documentation such as responses to objections, changes of name and addresses of applicants etc should also be available on-line. The huge forced reliance on Patent Agents in Ireland ensures that an applicants cost of applying for a patent in Ireland is very expensive compared to other countries, in the United Kingdom and many other countries such applications can be filed and prosecuted by virtually anybody anywhere. Indeed the influence of Patent Agents and Trademark agents over both legislation and costs in Ireland has resulted in a cartel like scenario in practice, to the detriment of users and potential users of the system.

The Patents Office needs to provide other information on-line such as copies of published and granted patent specifications free of charge and also enhanced searching facilities.

The Patents Office makes a healthy surplus each year yet it is increasing its fees, fees should be reduced so as to make the Patent system more attractive, affordable and accessible to all not just to big business.

***(Respondent 2)***

Declarations for Non-Infringement - With regard to s.54(2) of the Act, Respondent 3 would recommend an amendment to this section whereby an award of costs would follow the event. Respondent 3 notes that this is the current position in the UK. At present, the applicant for a declaration of non-infringement is required to meet both parties' costs, with the result that this procedure (which in practical terms maybe extremely useful from a client's perspective) is rarely used and leads to increased litigation due to the need in the alternative to seek patent revocation or to defend patent infringement proceedings. The amendment proposed would redress an arguably anti-competitive position by achieving a better balance between the rights of patentees and new market entrants.

***(Respondent 3)***

Section 105

One of the most primitive and tedious aspects for foreign clients is the requirement to furnish authorisation of agent forms: the duly prescribed manner should be removed from S.105

***(Respondent 7)***

## Annex 2 – Other responses to Consultation on the Review of the Patents Act 1992

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| <b><u>Section of the Act to be amended</u></b>  |
| Section 31(1) - remove the text in brackets i.e. “(other than the requirements of sections 9(1), 11, 13, 14, 19 and 20)”<br>Section 29(4), which provides an opportunity for the applicant to amend the application in the light of the search report, would need to be amended or removed.   |
| <b><u>Present Situation</u></b>   |
| Currently the Patents Office is precluded from carrying out substantive examination of full-term applications. The 1992 Act places the responsibility for putting an application in order for grant entirely into the hands of the applicant/agent.   |
| <b><u>Proposed Changes</u></b>  |
| The amendment would return the powers of substantive examination to the Office with regard to novelty, inventive step and industrial applicability. Also, the issues of clarity, conciseness of claims and disclosure of the invention would also fall within the Patents Office’s competence   |
| <b><u>New Situation</u></b>   |
| Evidence since 2008 would suggest that about 50 applications per year would be eligible for substantive examination i.e. applications for which search reports have been submitted as evidence of novelty. There would be a resource implication in that at least 1 additional patent examiner would be required to meet the additional workload. |
| <b><u>Comments</u></b>  |
| The reintroduction of substantive examination was recommended in Appendix 7 of the 2010 Innovation Taskforce Report   |

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| <b><u>Section of the Act to be amended</u></b>   |
| Part III – Short-term patents. The Respondent proposes that that this type of patent be redefined as a “utility model”. This would require an extensive redrafting of Part III.  |
| <b><u>Present Situation</u></b>  |
| The term “short-term patent” is a misnomer in that it is not just a shorter-lasting version (10 years) of a normal patent but really just a registered “invention” with much less rigorous patentability requirements. |
| <b><u>Proposed Changes</u></b>   |
| The amendment would bring Ireland more into line with international practice (apart for Australia where it is called an “innovation patent”)   |
| <b><u>New Situation</u></b>  |
| It is possible that the number of such applications may decrease whilst at the same time there may be a small increase in the number of full-term applications.  |
| <b><u>Comments</u></b>   |
| Only 16 other EPC Member States provide for utility models.  |

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| <b><u>Section of the Act to be amended</u></b>   |
| International applications for patents:- Sections 127(1), (5) and (6) should be amended to allow for Ireland to be designated directly in a PCT application i.e. it would open up the National route for PCT applicants. |
| <b><u>Present Situation</u></b>  |
| If an applicant files a PCT application, s/he can only obtain an Irish patent by way of an EP grant.   |
| <b><u>Proposed Changes</u></b>   |
| The amendment would allow an applicant to obtain an Irish patent independently of an EP application.   |
| <b><u>New Situation</u></b>  |
| Anecdotal evidence would lead us to believe that this amendment would be of benefit to potential applicants and would increase the number of full-term applications.   |
| <b><u>Comments</u></b>   |
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| <b><u>Section of the Act to be amended</u></b>  |
| Section 25(4)(a) – Priority right   |
| <b><u>Present Situation</u></b>   |
| This section appears to cause confusion for some agents on two counts.<br><br><i>(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, <u>the previous application has been withdrawn, abandoned or refused, without having been open to public inspection and without having left any rights outstanding</u>, and has not served as a basis for claiming right of priority.</i> |
| <b><u>Proposed Changes</u></b>  |
| <i>(4) (a) <u>This 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 granted, open to public inspection and without having left any rights outstanding</u>, and has not served as a basis for claiming right of priority.</i>   |

| <b>Comments</b>  |
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| <p>The wording “<i>A subsequent application..</i>” here in addition to the wording “<i>subsequent application</i>” in section 25(1) leads some agents to presume this relates to a third application (i.e. a subsequent application of the subsequent application). Perhaps it would be no bad idea to change the wording to “This subsequent application for the same subject matter...”.</p> <p>One other difficulty was the non-precise inclusion of the wording “granted” in subsection (4)(a). Many agents read this as ‘the previous application has been withdrawn without opi [being ‘open to public inspection’], abandoned without opi or refused without opi....’. Again the inclusion of the word “granted” would clarify matters for all.</p> |

| <b>Section of the Act to be amended</b>  |
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| Creation of a Section 29(5) as per Section 30(2).  |
| <b>Present Situation</b>   |
| <p>This section has raised issues for us in the past.</p> <p>If an applicant has filed a foreign specification (either granted or with search report) the Patents Office can request information with regard to filing of other foreign applications for protection of the invention.<br/>The Patents Office cannot do this if it is carrying out a search under Section 29(1).</p> <p>It has occurred in the past that an applicant has filed an Irish application and requested a search report, meanwhile filed foreign application and requested searches there. The Irish search did not find any novelty destroying prior art whereas some of the foreign searches did.<br/>The Patents Office has no provision to request these searches and must simply act on the Irish search.</p> |
| <b>Proposed Changes</b>  |
| An equivalent wording to Section 30(2) as a new Section 29(5)?   |
| <b>Comments</b>  |
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| <b><u>Section of the Act to be amended</u></b>   |
| Section 65(1) of the 1992 Patents Act.   |
| <b><u>Present Situation</u></b>  |
| Renewal fees fall due on the 3 <sup>rd</sup> year anniversary of the filing date. The majority of short-term patents are granted well in advance of this period and renewal fees are then requested at the due time. However where the short-term patent is still pending at the 3 <sup>rd</sup> year anniversary, it's not possible under the 1992 Act to request renewal fees. Section 35 of the Patents Act states that “ 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”. In Part 3 of the Act, which deals with the short term patent, Section 65(1) of the 1992 Patents Act states that “ <b>Section 29, 30 and 35 shall not apply in respect of an application for a short-term patent</b> ”. In practice this means that the Patents Office cannot request a renewal fee on a pending short term patent application and must wait until the patent is granted before requesting renewal fees. |
| <b><u>Proposed Changes</u></b>   |
| Amend the current Section 65(1) as follows:<br>“Section 29 and 30 shall not apply in respect of an application for a short-term patent”  |
| <b><u>New Situation</u></b>  |
| A pending short term patent application will be dealt with in the same way as a pending long-term application, in that renewal fees will be requested at the year 3 stage, issued with an overdue reminder and lapsed in the normal way, irregardless of whether the patent is pending or granted.   |
| <b><u>Comments</u></b>   |
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