

# **PATENTS ACT, 1964**

## **ARRANGEMENT OF SECTIONS**

### **PART I.**

#### **PRELIMINARY AND GENERAL.**

Section.

1. Short title and commencement.
2. Interpretation.
3. Orders and rules.
4. Expenses.
5. Transitional provisions and repeals.

### **PART II.**

#### **APPLICATION, INVESTIGATION, OPPOSITION, ETU.**

6. Persons entitled to apply for patent.
7. Application for patent.
8. Complete and provisional specifications.
9. Contents of specification.
10. Priority dates in relation to specifications.
11. Examination of application.
12. Search for anticipation by previous publication.
13. Further search for anticipation.
14. Reference in case of potential infringement.
15. Refusal of application in certain cases.
16. Supplementary provisions as to searches, etc.
17. Time for putting application in order for acceptance.
18. Acceptance and publication of complete specification.
19. Opposition to grant of patent.
20. Refusal of patent without opposition.
21. Mention of inventor as such in patent.
22. Substitution of applicants, etc.

### **PART III.**

#### **GRANT, RESTORATION, REVOCATION AND SURRENDER, ETC, OF PATENT.**

23. Grant and sealing of patent.

24. Amendment of patent granted to deceased applicant.
25. Effect and form of patent.
26. Date and term of patent.
27. Extension of term of patent.
28. Patents of addition.
29. Restoration of lapsed patents.
30. Restoration of lapsed applications for patents.
31. Amendment of specification with leave of Controller.
32. Amendment of specification with leave of the Court.
33. Supplementary provisions as to amendment of specification.
34. Revocation of patent by Court.
35. Revocation of patent by Controller.
36. Surrender of patent.

#### **PART IV.**

#### **VOLUNTARY AND COMPULSORY ENDORSEMENT, ANTICIPATION, AND PROVISIONS AS TO RIGHTS IN INVESTIONS.**

37. Endorsement of patent "licences of right".
38. Cancellation of endorsement.
39. Compulsory endorsement or licence.
40. Provisions as to licences.
41. Endorsement, etc., on application of a Minister of State.
42. Inventions relating to food or medicine.
43. Revocation of patent after grant of licence.
44. Procedure on applications under *sections 39 to 43*.
45. Appeal and references to arbitrator.
46. Supplementary provisions as to licences.
47. Previous publication.
48. Previous communication, display or working.
49. Use and publication after provisional specification or foreign application.
50. Priority date in case of obtaining.
51. Co-ownership of patents.
52. Power of Controller to give directions to co-owners.
53. Disputes as to inventions made by employees.
54. Avoidance of certain conditions attached to the sale, etc., of patented articles.

#### **PRAT V.**

#### **PROCEEDINGS FOR INFRINGEMENT OF PATENTS.**

55. Restrictions on recovery of damages for infringement.
56. Order for account in action for infringement.
57. Counterclaim for revocation in action for infringement.

- 58. Relief for infringement of partially valid specification.
- 59. Proceedings for infringement by exclusive licensee.
- 60. Certificate of contested validity of specification.
- 61. Remedy for groundless threats of infringement proceedings.
- 62. Power of Court to make declaration as to noninfringement.

**PART VI.**

**REGISTER OF PATENTS.**

- 63. Register of patents.
- 64. Registration of assignments, etc.
- 65. Power of Court to amend register.
- 66. Power to correct clerical errors, etc.
- 67. Certificate of Controller and sealed copies of documents in Office to be evidence.
- 68. Requests for information as to patent or patent application.
- 69. Restriction upon publication of specifications, etc.
- 70. Loss or destruction of patents.

**PART VII.**

**PROCEEDINGS BEFORE THE CONTROLLER OR THE COURT.**

- 71. Exercise of discretionary power by Controller.
- 72. Costs and security for costs.
- 73. Evidence before Controller.
- 74. Hearing by Court with assessor.
- 75. Appeals from decisions of Controller.
- 76. Costs of Controller in Court proceedings.

**PART VIII.**

**THE OFFICE AND THE CONTROLLER.**

- 77. Patents Office.
- 78. Controller of Patents, Designs and Trade Marks.
- 79. Appointment of officers of Controller.
- 80. Fees.
- 81. Official journal.
- 82. Reports to be privileged.
- 83. Controller may consult Attorney General.
- 84. Annual report.
- 85. Hours of business and excluded days.

**PART IX.**  
**MISCELLANEOUS.**

- 86. Patent agents.
- 87. Falsification of register, etc.
- 88. Unauthorised claim of patent rights.
- 89. False suggestion of official connection with the Office.
- 90. Inventions relating to instruments or munitions of war.
- 91. Assignment of invention or patent to a Minister of State.
- 92. Use of patented inventions for the service of the State.
- 93. Government orders as to convention countries.
- 94. Supplementary provisions as to convention applications.
- 95. Special provisions as to vessels, aircraft and land vehicles.
- 96. Power of Minister to make rules.
- 97. Power of Minister to delegate his duties under this Act.
- 98. Service of notices, etc., by post.
- 99. Saving for articles forfeited under laws relating to the customs or excise.

**FIRST SCHEDULE.**

**ENACTMENTS REPEALED.**

**SECOND SCHEDULE.**

**TRANSITIONAL PROVISIONS.**

Number 12 of 1964

PATENTS ACT, 1964

AN ACT TO MAKE NEW PROVISION IN RESPECT OF PATENTS AND RELATED MATTERS IN  
SUBSTITUTION FOR THE PROVISIONS OF THE INDUSTRIAL AND COMMERCIAL PROPERTY  
(PROTECTION) ACT, 1927, RELATING TO PATENTS AND OF OTHER ENACTMENTS RELATING  
TO PATENTS, AND TO PROVIDE FOR OTHER MATTERS CONNECTED WITH THE MATTERS  
AFORESAID. [*24th June, 1964.*]

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:—

**PART I.**

**Preliminary and General.**

Short title and commencement.

**1.**—(1) This Act may be cited as the Patents Act, 1964.

(2) This Act shall come into operation on such day as the Minister may by order appoint.

Interpretation.

2.—In this Act, unless the context otherwise requires—

“the Act of 1927” means the Industrial and Commercial Property (Protection) Act, 1927;

“applicant”, in relation to an application, means the person making the application and includes a person in whose favour a direction has been give under *section 23* of this Act, and the personal representative of a deceased applicant;

“article” includes any substance or material, and any plant, machinery or apparatus, whether affixed to land or not;

“assignee” includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

“commercially worked” means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable in all the circumstances;

“the Controller” means the Controller of Patents, Designs and Trade Marks appointed under this Act;

“convention application” has the meaning assigned to it by *subsection (3)* of *section 6* of this Act;

“convention country” has the meaning assigned to it by *subsection (1)* of *section 93* of this Act;

“the Court” means the High Court;

“date of filing”, in relation to any document filed under this Act, means the date on which the document is filed or, where it is deemed by virtue of any provision of this Act or of rules made thereunder to have been filed on any different date, means the date on which it is deemed to be filed;

“exclusive licence” means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the invention, and “exclusive licensee” shall be construed accordingly;

“invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter, and includes an alleged invention and also any new method or process of testing applicable to the improvement or control of manufacture;

“the Journal” means the journal issued by the Controller pursuant to *section 81* of this Act;

“the Minister” means the Minister for Industry and Commerce;

“the Office” means the Patents Office established by the Act of 1927 and continued in being by *section 77* of this Act;

“patent” means letters patent for an invention;

“patent of addition” means a patent granted in accordance with *section 28* of this Act;

“patentee” means the person or persons for the time being entered on the register of patents as grantee or proprietor of the patent;

“prescribed” means, in the case of proceedings before the Court, prescribed by rules of court, and, in any other case, prescribed by rules made under this Act;

“priority date” has the meaning assigned to it by *section 10* of this Act;

“published” means made available to the public by the written or spoken word or by public use, or in any other way.

Orders and rules.

3.—(1) Where a power to make orders or rules is conferred by any provision of this Act, such orders or rules may be made either as respects all, or as respects any one or more, of the matters to which the provision relates; and different provisions may be made by any such orders or rules as respects different classes of cases to which the orders or rules apply.

(2) Every order or rule made under this Act shall be laid before each House of the Oircachtas as soon as may be after it is made and if a resolution annulling the order or rule is passed by either such House

within the next subsequent twenty-one days on which that House has sat after the order or rule is laid before it, the order or rule shall be annulled accordingly but without prejudice to the validity of anything previously done thereunder.

(3) Every order or rule made under this Act shall be advertised twice in the Journal.

Expenses.

4.—The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oircachtas.

Transitional provisions and repeals.

5.—(1) The transitional provisions contained in the *Second Schedule* to this Act shall have effect for the purposes of this Act.

(2) Subject to the said transitional provisions, the enactments specified in the *First Schedule* to this Act are hereby repealed to the extent specified in the third column of that Schedule.

## PART II.

### Application, Investication, Opposition, etc.

Persons entitled to apply for patent.

6.—(1) An application for a patent may be made by any person who claims—

(a) to be the true and first inventor of the invention to which the application relates, or

(b) that the true and first inventor of the invention to which the application relates has assigned to him the right to make the application,

and may be made either alone or jointly with another person.

(2) Notwithstanding the provisions of *subsection (1)* of this section, application for a patent may be made by a person who has applied in a convention country for protection for the invention to which the application for the patent relates or by a person to whom such person has assigned the right to make the application for the patent.

(3) An application for a patent under *subsection (2)* of this section (in this Act referred to as a convention application) shall be made during such period (not being less than twelve months) as may be prescribed commencing on the date of the relevant application for protection or, in the case of more than one application, the date of the first such application.

(4) An application for a patent may be made by the personal representative of a person who, immediately before his death was entitled to make such an application.

Application for patent.

7.—(1) An application for a patent shall be made in the prescribed form and shall be filed at the Office in the prescribed manner.

(2) If the application (not being a convention application) is made by virtue of an assignment of a right to apply for a patent, there shall be furnished with the application or within such period after the filing of the application as may be prescribed a declaration signed by the person claiming to be the true and first inventor or by the personal representative of such person stating that he assents to the making of the application.

(3) An application (other than a convention application) shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor, and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes him to be the true and first inventor.

(4) A convention application shall specify the date on which and the convention country in which the application for protection for the invention to which the convention application relates, or the first application for protection was made, and shall state that no application for protection has been made in a convention country in respect of that invention before that date by the applicant or any person from whom he derives title.

(5) Where applications for protection have been made in one or more convention countries in respect of two or more inventions that are cognate or of which one is a modification of another, a single convention application may, subject to the provisions of *section 9* of this Act, be made in respect of those inventions at any time within the period prescribed under *subsection (3) of section 6* of this Act commencing on the date of the first of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications had been made in respect of each of the said inventions, and the requirements of the last foregoing subsection shall in the case of any such application apply separately to the applications for protection in respect of each of the said inventions.

(6) Without prejudice to the provisions of *subsection (4)* of this section, every application for a patent shall give such information as may be prescribed.

Complete and provisional specifications.

**8.—**(1) Every application for a patent (other than a convention application) shall be accompanied by either a complete specification or a provisional specification; and every convention application shall be accompanied by a complete specification.

(2) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application and if the complete specification is not so filed the application shall be deemed to be abandoned:

Provided that the complete specification may be filed at any time after twelve months but within fifteen months from the date aforesaid if a request to that effect is made to the Controller and the prescribed fee paid on or before the date on which the specification is filed.

(3) Where two or more applications accompanied by provisional specifications have been filed in respect of inventions which are cognate or of which one is a modification of another, a single complete specification may, subject to the provisions of this and the next following section, be filed in pursuance of those applications, or, if more than one complete specification has been filed, may with the leave of the Controller be proceeded with in respect of those applications.

(4) Where an application for a patent (not being a convention application) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Act as a provisional specification, and proceed with the application accordingly.

(5) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under the last foregoing subsection as a provisional specification, the Controller may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

(6) Where a complete specification is filed in pursuance of an application for a patent, the applicant shall furnish, within the time prescribed, such evidence as may be prescribed of—

(a) the result of any investigation made for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification has been published before the date of filing of the complete specification in a specification filed in any of such patent offices outside the State as may be prescribed, or

(b) the acceptance by any of such patent offices outside the State as may be prescribed of an application for a patent for the invention aforesaid.

Contents of specification.

9.—(1) Every specification, whether complete or provisional, shall describe the invention, and shall begin with a title indicating the subject to which the invention relates.

(2) Subject to any rules made by the Minister under this Act, drawings may, and shall if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional, and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) Every complete specification—

(a) shall particularly describe the invention and the method by which it is to be performed,

(b) shall disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection, and

(c) shall end with a claim or claims defining the scope of the invention claimed.

(4) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification.

(5) Rules made by the Minister under this Act may require that in such cases as may be prescribed by the rules, a declaration as to the inventorship of the invention, in such form as may be so prescribed, shall be furnished with the complete specification or within such period as may be so prescribed after the filing of that specification.

(6) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification, or filed with a convention application, may include claims in respect of developments of or additions to the invention which was described in the provisional specification or, as the case may be, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of *section 6* of this Act to make a separate application for a patent.

(7) Where a complete specification claims a new substance, the claim shall be construed as not extending to that substance when found in nature.

Priority dates in relation to specifications.

10.—(1)

(a) Every claim of a complete specification shall have effect from the date provided for by this section in relation to that claim and in this Act a reference to a priority date is, unless the context otherwise requires, a reference to such date.

(b) A patent shall not be invalidated by reason only of the publication or use of the invention, so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.

(2) Where the complete specification is filed in pursuance of a single application accompanied by a provisional specification or by a specification which is treated by virtue of a direction under *subsection (4)* of *section 8* of this Act as a provisional specification, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.

(3) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in the last foregoing subsection, and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification.

(4) Where the complete specification is filed in pursuance of a convention application and the claim is fairly based on the matter disclosed in the application for protection in a convention country or, where the convention application is founded upon more than one such application for protection, in one of those applications, the priority date of that claim shall be the date of the relevant application for protection.

(5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for this provision, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(6) In any case to which *subsections (2) to (5)* of this section do not apply, the priority date of a claim shall be the date of filing of the complete specification.

(7) The priority date of any matter disclosed in the descriptive part of a specification shall be the date on which that matter was first disclosed in pursuance of the application for a patent of which the specification forms a part or (in the case of a convention application) was first disclosed in the relevant application for protection in a convention country.

#### Examination of application.

**11.**—(1) When the complete specification has been filed in respect of an application for a patent, the application and specification or specifications shall be referred by the Controller to an officer of the Controller (in this Act referred to as an examiner) for examination together with any information furnished under *subsection (6) of section 7* of this Act and any evidence furnished under *subsection (6) of section 8* of this Act.

(2) If the examiner reports that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act or of any rules made by the Minister thereunder, or that there is lawful ground of objection to the grant of a patent in pursuance of the application, the Controller may either—

- (a) refuse to proceed with the application, or
- (b) require the application or any such specification as aforesaid to be amended before he proceeds with the application.

(3) At any time after an application has been filed under this Act and before acceptance of the complete specification, the Controller may, at the request of the applicant and upon payment of the prescribed fee, direct that the application shall be post-dated to such date as may be specified in the request:

Provided that,

- (a) no application shall be post-dated under this subsection to a date later than six months from the date on which it was actually made or would, but for this subsection be deemed to have been made, and
- (b) a convention application shall not be post-dated under this subsection to a date later than the last date on which, under the foregoing provisions of this Act, the application could have been made.

(4) Where an application or specification filed under this Act is amended before acceptance of the complete specification, the Controller may direct that the application or specification shall be post-dated to the date on which it is amended or, if it has been returned to the applicant, to the date on which it is refiled.

(5) Rules made by the Minister under this Act may make provision for securing that where, at any time after an application or specification has been filed under this Act and before acceptance of the complete specification, a fresh application or specification is filed in respect of any part of the subject matter of the first-mentioned application *or specification*, the Controller may direct that the fresh application or specification shall be ante-dated to a date not earlier than the date of filing of the first-mentioned application or specification.

(6) An appeal shall lie from any decision of the Controller under *subsection (2)* or *subsection (4)* of this section.

#### Search for anticipation by previous publication.

**12.**—(1) Subject to the provisions of the last foregoing section of this Act, an examiner to whom an application for a patent is referred under this Act shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published

before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in the State.

(2) The examiner shall, in addition, make such investigation as the Controller may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published in the State before the date of filing of the applicant's complete specification in any other document.

(3) The examiner shall, in addition, consider any information furnished in pursuance of *subsection (6) of section 7* of this Act and any evidence furnished in pursuance of *subsection (6) of section 8* of this Act.

(4) If it appears to the Controller that the invention, so far as claimed in any claim of the complete specification, has been published as described in *subsection (1) or subsection (2)* of this section, or if he is not satisfied by the information and evidence referred to in *subsection (3)* of this section that the invention so claimed has not been published before the date of the complete specification in any specification filed in an office prescribed under *paragraph (a) of subsection (6) of section 8* of this Act, he may refuse to accept the complete specification unless the applicant either—

(a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which any relevant document or prescribed specification, as the case may be, was published,

(b) furnishes further evidence to the satisfaction of the Controller in pursuance of *subsection (6) of section 8* of this Act, or

(c) amends his complete specification to the satisfaction of the Controller.

(5) An appeal shall lie from any decision of the Controller under this section.

Further search for anticipation.

**13.**—(1) In addition to the investigation required by the last foregoing section, the examiner shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, is claimed in, or included in matter disclosed in the descriptive part of, any other specification published on or after the date of filing of the applicant's complete specification, being a specification filed—

(a) in pursuance of an application for a patent made in the State and dated before that date, or

(b) in pursuance of a convention application founded upon an application for protection made in a convention country before that date.

(2) If it appears to the Controller that the said invention is claimed in, or included in matter disclosed in the descriptive part of, any such other specification as aforesaid, he may, subject to the provisions of this section, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed either—

(a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim or the matter disclosed in the descriptive part of the said other specification, or

(b) the complete specification is amended to the satisfaction of the Controller.

(3) If in consequence of the investigation under *section 12* of this Act or otherwise it appears to the Controller—

(a) that the invention, so far as claimed in any claim of the applicant's complete specification, has been claimed in, or included in matter disclosed in the descriptive part of, any such specification as is mentioned in *subsection (1)* of that section, and

(b) that the other specification was published on or after the priority date of the applicant's claim,

then unless it has been shown to the satisfaction of the Controller under that section that the priority date of the applicant's claim is not later than the priority date of the relevant claim of, or the matter disclosed

in the descriptive part of, that other specification, the provisions of *subsection (2)* of this section shall apply as they apply in relation to a specification published on or after the date of filing of the applicant's complete specification.

(4) An appeal shall lie from any direction of the Controller under this section.

Reference in case of potential infringement.

**14.**—(1) If, in consequence of the investigations required by the foregoing provisions of this Act or of proceedings under *section 19* or *section 35* of this Act, it appears to the Controller that an invention in respect of which application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public unless within such time as may be prescribed either—

(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent, or

(b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under the foregoing subsection—

(a) that other patent is revoked or otherwise ceases to be in force,

(b) the specification of that other patent is amended by the deletion of the relevant claim, or

(c) it is found, in proceedings before the Court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,

the Controller may, on the application of the applicant, delete the reference to that other patent.

(3) An appeal shall lie from any decision or direction of the Controller under this section.

Refusal of application in certain cases.

**15.**—(1) If it appears to the Controller in the case of any application for a patent—

(a) that it claims as an invention anything obviously contrary to well-established natural laws,

(b) that the use of the invention in respect of which the application is made would be contrary to public order or morality, or

(c) that it claims as an invention a substance capable of being used as food or medicine which is a mixture of known ingredients possessing only the aggregate of the known properties of the ingredients, or that it claims as an invention a process producing such a substance by mere admixture,

he may refuse the application.

(2) If it appears to the Controller that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may insert in the complete specification such disclaimer in respect of that use of the invention, or such other reference to the illegality thereof, as he thinks fit.

(3) An appeal shall lie from any decision of the Controller under this section.

Supplementary provisions as to searches, etc.

**16.**—(1) The powers of the Controller under *section 13* or *section 14* of this Act may be exercised either before or after the complete specification has been accepted or a patent granted to the applicant, and references in those sections to the applicant shall accordingly be construed as including references to the patentee.

(2) Where a complete specification is amended under the foregoing provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.

(3) The examination and investigations required by the foregoing provisions of this Act shall not be deemed to warrant the validity of any patent, and no liability shall be incurred by the Minister or Controller or any officer of the Minister or Controller by reason of or in connection with any such examination or investigation or any report or other proceedings consequent thereon.

Time for putting application in order for acceptance.

**17.**—(1) An application for a patent shall be void unless within such period, beginning with the date of filing of the complete specification, as may be prescribed, or within such longer period as may be allowed under the following provisions of this section or under rules made under this Act, the applicant has complied with all requirements imposed on him by or under his Act, whether in connection with the complete specification or otherwise in relation to the application, and where the application or any specification or, in the case of a convention application, any document filed as part of the application, has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with the said requirements unless and until he has refiled it.

(2) The period allowed by *subsection (1)* of this section shall be extended to such period, ending not later than three months after the date on which the period allowed under that subsection or that period as extended under *subsection (3)* of this section or under rules made under this Act would otherwise have expired, as may be specified in a notice given by the applicant to the Controller, if the notice is given and the prescribed fee paid before the expiration of the period so specified.

(3) If at the expiration of the period allowed under the foregoing provisions of this section an appeal is pending under any of the provisions of this Act in respect of the application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the application for the patent for the main invention) or the time within which such an appeal could be brought (apart from any future extension of time thereunder) has not expired, then—

(a) where such an appeal is pending, or is brought within the time aforesaid or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, the said period shall be extended until such date as the Court may determine,

(b) where no such appeal is pending or is so brought, the said period shall continue until the end of the time aforesaid, or if any extension of that time is granted as aforesaid, until the expiration of the extension or last extension so granted.

Acceptance and publication of complete specification.

**18.**—(1) Subject to the provisions of the last foregoing section, the complete specification filed in pursuance of an application for a patent may be accepted by the Controller at any time after the applicant has complied with the requirements mentioned in *subsection (1)* of that section, and if not so accepted within the period allowed under that section for compliance with those requirements, shall be accepted as soon as may be thereafter:

Provided that the applicant may give notice to the Controller requesting him to postpone acceptance until such date, not being later than fifteen months from the date of filing of the complete specification, as may be specified in the notice; and if such notice is given and, where the notice requests a postponement to a date later than twelve months from the date aforesaid, the prescribed fee is paid, the Controller may postpone acceptance accordingly.

(2) On the acceptance of a complete specification the Controller shall give notice to the applicant, and shall advertise in the Journal the fact that the specification has been accepted and the date on which the application and the specification or specifications filed in pursuance thereof will be open to public inspection.

(3) Any reference in this Act to the date of the publication of a complete specification shall be construed as a reference to the date advertised as aforesaid.

(4) After the date of the publication of a complete specification and until the sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the publication of the complete specification:

Provided that an applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

Opposition to grant of patent.

**19.**—(1) At any time within three months from the date of the publication of a complete specification under this Act, any person interested may give notice to the Controller of opposition to the grant of the patent on any of the following grounds—

(a) that the applicant for the patent, or the person described in the application as the true and first inventor, obtained the invention or any part thereof from him, or from a person of whom he is the personal representative,

(b) that the invention, so far as claimed in any claim of the complete specification, has been published in the State, before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in the State,

(ii) in any other document,

(c) that the invention, so far as claimed in any claim of the complete specification, is claimed in, or included in matter disclosed in the descriptive part of, another specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in the State, the priority date of the relevant claim or the matter disclosed in the descriptive part of the other specification being earlier than that of the applicant's claim,

(d) that the invention, so far as claimed in any claim of the complete specification, was used in the State before the priority date of that claim,

(e) that the invention, so far as claimed in any claim of the complete specification, is obvious and clearly does not involve any inventive step having regard to any matter published in the manner specified in *paragraph (b)* of this subsection, any matter claimed or disclosed in the manner specified in *paragraph (c)* of this subsection or what was used in the State before the priority date of the applicant's claim,

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act,

(g) that the complete specification does not sufficiently and fairly describe the invention or the method by which it is to be performed,

(h) that, in the case of a convention application, the application was not made within the period prescribed under *subsection (3)* of *section 6* of this Act from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title, but on no other ground.

(2) Where any such notice is given, the Controller shall give notice of the opposition to the applicant, and shall give to the applicant and the opponent an opportunity to be heard before he decides on the case.

(3) For the purposes of *paragraph (d)* or *paragraph (e)* of *subsection (1)* of this section, no account shall be taken of any secret use.

(4) An appeal shall lie from any decision of the Controller under this section.

Refusal of patents without opposition.

**20.**—(1) If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before the grant of a patent thereon it comes to the notice of the Controller, otherwise than in consequences of proceedings in opposition to the grant under the last foregoing section,

that the invention, so far as claimed in any claim of the complete specification, has been published in the State before the priority date of the claim—

- (a) in any specification filed in pursuance of an application for a patent in the State, or
- (b) in any other document,

the Controller may refuse to grant the patent unless within such time as may be prescribed the complete specification is amended to his satisfaction.

(2) An appeal shall lie from any decision of the Controller under this section.

Mention of inventor as such in patent.

**21.**—(1) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section—

(a) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention, and

(b) that the application for the patent is a direct consequence of his being the inventor,

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) For the purposes of this section the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor, and no person shall be deemed to be the inventor of an invention or a part of an invention by reason only that it was imported by him into the State.

(3) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(4) If any person (other than a person in respect of whom a request in relation to the application in question has been made under the last foregoing subsection) desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

(5) A request or claim under the foregoing provisions of this section must be made not later than two months after the date of the publication of the complete specification, or within such further period (not exceeding one month) as the Controller may, on an application made to him in that behalf before the expiration of the said period of two months and subject to payment of the prescribed fee, allow.

(6) No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Controller that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of *paragraph (a) of subsection (1) of section 19* of this Act by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section.

(7) Subject to the provisions of the last foregoing subsection, where a claim is made under *subsection (4) of this section*, the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested, and before deciding upon any request or claim made under *subsection (3) or subsection (4) of this section*, the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and in the case of a claim under the said *subsection (4)*, any person to whom notice of the claim has been given as aforesaid.

(8) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may

consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

(9) An appeal shall lie from any decision of the Controller under this section.

Substitution of applicants, etc.

**22.**—(1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement made by the applicant or one of the applicants for the patent, or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimant and the applicant or the other joint applicant or applicants, according as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless either—

(a) the invention is identified therein by reference to the number of the application for the patent,

(b) there is produced to the Controller as acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made, or

(c) the rights of the claimant in respect of the invention have been finally established by a decision of any court or by a determination of the Controller under the following provisions of this Act.

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the personal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent as to whether or the manner in which the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

(6) An appeal shall lie from any decision of the Controller under this section.

### PART III.

#### Grant, Restoration, Revocation and Surrender, etc., of Patent.

Grant and sealing of patent.

**23.**—(1) Subject to the provisions of this Act with respect to opposition, and to any other power of the Controller to refuse the grant, a patent sealed with the official seal of the Controller shall, if the prescribed request is made within the time allowed under this section, be granted to the applicant or applicants within that time or as soon as may be thereafter; and the date on which the patent is sealed shall be entered in the register of patents.

(2) Subject to the following provisions of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of four months from the date of the publication of the complete specification:

Provided that—

(a) where at the expiration of the said four months any proceeding in relation to the application for the patent is pending in any court or before the Controller, the request may be made within the prescribed period after the final determination of that proceeding;

(b) where the applicant or one of the applicants has died before the expiration of the time within which under the provisions of this subsection the request could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

(3) The period within which under the last foregoing subsection a request for the sealing of a patent may be made may from time to time be extended by the Controller to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:

Provided that the first-mentioned period shall not be extended under this subsection by more than six months or such shorter period as may be prescribed.

(4) For the purposes of this section a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for any appeal therein (apart from any such extension) has expired without the appeal being brought.

Amendment of patent granted to deceased applicant.

**24.**—Where at any time after a patent has been sealed in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or (in the case of a body corporate) had ceased to exist, before the patent was sealed, he may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted; and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Effect and form of patent.

**25.**—(1) Subject to the provisions of this Act, every patent granted under this Act and sealed with the official seal of the Controller shall operate and have effect and shall be expressed to operate and have effect—

(a) to confer on the person to whom the same is granted, his executors, administrators and assigns (in this subsection collectively referred to as the grantee) the full, sole, and exclusive right, power and authority by himself, his agents or licensees at all times so long as the patent remains in force to make, use, exercise, and vend in the State the invention in respect of which the patent is granted;

(b) to confer on the grantee the sole right to have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during such period as the patent remains in force;

(c) to prohibit all persons whatsoever in the State while the patent remains in force from making use of or putting in practice the said invention or any part thereof, or in anywise imitating the same or in anywise representing or pretending themselves to be the inventors of the said invention or of the said invention with any addition thereto or subtraction therefrom without the consent, licence or agreement of the grantee in writing under his hand and seal;

(d) to make all persons who, while the patent remains in force, shall in the State in anywise infringe any right, power, or authority expressed in the patent to be thereby conferred on the grantee or do any act, matter, or thing the doing of which is expressed in the patent to be

thereby prohibited, answerable according to law to the grantee for such infringement or the doing of such act, matter, or thing.

(2) Every patent shall be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Date and term of patent.

**26.**—(1) Every patent shall be dated with the date of filing of the complete specification:

Provided that no proceeding shall be taken in respect of an infringement committed before the date of the publication of the complete specification.

(2) The date of every patent shall be entered in the register of patents.

(3) Except as otherwise expressly provided by this Act, the term of every patent shall be sixteen years from the date of the patent.

(4) A patent shall cease to have effect, notwithstanding anything therein or in this Act, on the expiration of the period prescribed for the payment of any renewal fee if that fee is not paid within the prescribed period or within that period as extended under this section.

(5) The period prescribed for the payment of any renewal fee shall be extended to such period, not being more than six months longer than the prescribed period, as may be specified in a request made to the Controller if the request is made and the renewal fee and the prescribed additional fee paid before the expiration of the period so specified.

Extension of term of patent.

**27.**—(1) A patentee may, after advertising in manner provided by rules of court his intention to do so, present a petition to the Court or the Controller praying that his patent may be extended for a further term.

(2) A petition under this section shall be presented at least six months before the time limited for the expiration of the patent:

Provided that the period within which a petition under this section may be presented may, at the discretion of the Court or the Controller, be extended by the Court or the Controller, as the case may be.

(3) Any person may give notice to the Court or the Controller, as the case may be, of objection to the extension.

(4) On the hearing of any petition under this section the patentee and any person who has given notice of objection shall be made parties to the proceeding and, if the petition is presented to the Court, the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(5) The Court or the Controller, in making a decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(6) If it appears to the Court or the Controller that the patentee has been inadequately remunerated by his patent, the Court or the Controller, as the case may be, may by order extend the term of the patent for a further term not exceeding five years or, in exceptional cases, ten years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the Court or the Controller, as the case may be, may think fit.

(7) The Controller may, at any stage of the proceedings before him under this section, refer the petition to the Court and thereupon the petition shall be deemed to have been presented to the Court by the patentee of the invention to which it refers under *subsection (1)* of this section.

(8) An appeal shall be from any decision of the Controller under this section.

Patents of Addition.

**28.**—(1) Subject to the provisions of this section, where application is made for a patent in respect of any improvement in or modification of an invention (in this Act referred to as the main invention) and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions of this section, where an invention, being an improvement \$\$\$ or modification of another invention, is the subject of an \$\$\$ independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention the Controller may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for this provision, a request for the sealing of a patent of addition could be made under *section 23* of this Act expires before the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last-mentioned period.

(5) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that—

(a) if the term of the patent for the main invention is extended under the last foregoing section of this Act, the term of the patent of addition may also be extended accordingly; and

(b) if the patent for the main invention is revoked under this Act, the Court or Controller, as the case may be, may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.

(6) No renewal fees shall be payable in respect of a patent of addition; but, if any such patent becomes an independent patent by virtue of an order under the last foregoing subsection, the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

(7) An appeal shall lie from any decision of the Controller under this section.

Restoration of lapsed patents.

**29.**—(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under *section 26* of this Act, and the Controller is satisfied, upon application made within three years from the date on which the patent ceased to have effect, that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall by order restore the patent and any patent of addition specified in the application which has ceased to have effect, on the cesser of that patent.

(2) An application under this section may be made by the person who was the patentee or by his personal representative; and where the patent was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.

(3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee; and the Controller may require from the applicant such further evidence as he may think necessary.

(4) If after hearing the applicant (if the applicant so requires or the Controller thinks fit) the Controller is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the

application in the Journal; and within the prescribed period any person may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say:—

- (a) that the failure to pay the renewal fee was not unintentional; or
- (b) that there has been undue delay in the making of the application.

(5) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(6) If no notice of opposition is given within the period aforesaid or if, in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.

(7) An order under this section for the restoration of a patent—

- (a) may be made subject to such conditions as the Controller thinks fit, including in particular a condition requiring the registration in the register of patents of any matter in respect of which the provisions of this Act as to entries in that register have not been complied with; and
- (b) shall be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the application under this section;

and if any condition of an order under this section is not complied with by the patentee, the Controller may, after giving to the patentee an opportunity to be heard, revoke the order and give such directions consequential on the revocation as he thinks fit.

(8) An appeal shall lie from any decision of the Controller under this section.

Restoration of lapsed applications for patents.

**30.**—(1) Where a patent has not been sealed by reason only that the prescribed request was not made within the time allowed for that purpose by or under *section 23* of this Act, then if the Controller is satisfied, upon application made within six months after the expiration of that time by the applicant for the patent, that the failure to make the request was unintentional, he may order the patent to be sealed notwithstanding that the prescribed request was not made as aforesaid.

(2) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to make the prescribed request; and the Controller may require from the applicant such further evidence as he may think necessary.

(3) If after hearing the applicant (if the applicant so requires or the Controller thinks fit) the Controller is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the application in the Journal; and within the prescribed period any person may give notice to the Controller of opposition thereto on the ground that the failure to make the prescribed request was not unintentional.

(4) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(5) If no notice of opposition is given within the period aforesaid, or if in the case of opposition the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of the fee prescribed in respect of the making of the request for sealing and of such additional fee as may be prescribed, make the order in accordance with the application.

(6) An order under this section for the sealing of a patent shall be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the invention between the date when the time allowed by or under *section 23* of this Act for making the prescribed request expired and the date of the application under this section.

(7) An appeal shall lie from any decision of the Controller under this section.

Amendment of specification with leave of Controller.

**31.**—(1) Subject to the provisions of *section 33* of this Act, the Controller may, upon application made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not allow a specification to be amended under this section upon an application made while any action before the Court for infringement of the patent or any proceeding before the Court for the revocation of the patent is pending.

(2) Every application for leave to amend a specification under this section shall state the nature of the proposed amendment and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend a specification under this section, and the nature of the proposed amendment, shall be advertised in the prescribed manner:

Provided that where application is made before the publication of the complete specification, the Controller may, if he thinks fit, dispense with advertisement under this subsection or direct that advertisement shall be postponed until the complete specification is published.

(4) Within the prescribed period after the advertisement of an application under this section, any person may give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An appeal shall lie from any decision of the Controller under this section.

(6) This section shall not apply in relation to any amendment of a specification effected in proceedings in opposition to the grant of a patent or in pursuance of any provision of this Act authorising the Controller to direct a reference to another specification or patent to be inserted, or to refuse to grant a patent, or to revoke a patent, unless the specification is amended to his satisfaction.

Amendment of specification with leave of the Court.

**32.**—(1) In any action for infringement of a patent or any proceeding before the Court for the revocation of a patent the Court may, subject to the provisions of the next following section, by order allow the patentee to amend his complete specification in such manner, and subject to such terms as to costs, advertisements or otherwise, as the Court may think fit; and if in any such proceedings for revocation the Court decides that the patent is invalid, the Court may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

Supplementary provisions as to amendment of specification.

**33.**—(1) After the acceptance of a complete specification, no amendment thereof shall be effected except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved by the Controller or the Court under this Act, the right of the patentee or applicant to make the amendment shall not be called in question except on the ground of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification:

Provided that in construing the specification as amended references may be made to the specification as originally published.

(3) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved as aforesaid, the fact that the specification has been amended shall be advertised in the Journal.

#### Revocation of patent by Court.

**34.**—(1) Subject to the provisions of this Act, a patent may, on the petition of the Attorney General or any person authorised by him, or of any person interested, be revoked by the Court on any of the following grounds, that is to say—

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in, or included in matter disclosed in the descriptive part of, another specification published on or after the priority date of the claim and filed in pursuance of an application for a patent in the State, the priority date of the relevant claim or of the matter disclosed in the descriptive part of the other specification being earlier than that of the claim;

(b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;

(c) that the patent was obtained in contravention of the rights of the petitioner or any person under or through whom he claims;

(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(e) that the invention, so far as claimed in any claim of the complete specification, is not new having regard to what was published before the priority date of the claim;

(f) that the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve any inventive step having regard to any matter claimed or disclosed in the manner specified in *paragraph (a)* of this subsection or to any matter published in the manner specified in *paragraph (e)* of this subsection;

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, or does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(j) that the patent was obtained on a false suggestion or representation;

(k) that the primary or intended use or exercise of the invention is contrary to public order or morality.

(2) Without prejudice to the provisions of *subsection (1)* of this section, a patent may be revoked by the Court on the petition of any Minister of State if the Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Minister to make, use, exercise or vend the patented invention for the service of the State upon reasonable terms.

(3) Every ground on which a patent may be revoked shall be available as a ground of defence in any proceeding for the infringement of the patent.

#### Revocation of patent by Controller.

**35.**—(1) At any time within twelve months after the sealing of a patent, any person interested who did not oppose the grant of the patent may apply to the Controller for an order revoking the patent on any one or more of the grounds upon which the grant of the patent could have been opposed:

Provided that when an action for infringement, or proceedings for the revocation, of a patent are pending in any court, an application to the Controller under this section shall not be made except with the leave of the court.

(2) Where an application is made under this section, the Controller shall notify the patentee and shall give to the applicant and the patentee an opportunity to be heard before deciding the case.

(3) If on an application under this section the Controller is satisfied that any of the grounds aforesaid are established, he may by order direct that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction:

Provided that the Controller shall not make an order for the unconditional revocation of a patent under this section unless the circumstances are such as would have justified him in refusing to grant the patent in proceedings under *section 19* of this Act.

(4) An appeal shall lie from any decision of the Controller under this section.

Surrender of patent.

**36.**—(1) A patentee may at any time by notice given to the Controller offer to surrender his patent.

(2) Where such an offer is made the Controller shall advertise the offer in the prescribed manner; and within the prescribed period after such advertisement any person interested may give notice to the Controller of opposition to the surrender.

(3) Where any such notice of opposition is duly given the Controller shall notify the patentee.

(4) If the Controller is satisfied, after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and by order revoke the patent.

(5) An appeal shall lie from any decision of the Controller under this section.

#### PART IV.

Voluntary and Compulsory Endorsement, Anticipation, and Provisions as to Rights in Inventions.

Endorsement of patent “licences of right”.

**37.**—(1) At any time after the sealing of a patent the patentee may apply to the Controller for the patent to be endorsed with the words “licences of right”; and where such an application is made, the Controller shall notify the application to any person entered on the register as entitled to an interest in the patent, and if satisfied, after giving any such person an opportunity to be heard, that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.

(2) Where a patent is endorsed under this section—

(a) any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement, be settled by the Controller on the application of the patentee or the person requiring the licence;

(b) the Controller may, on the application of the holder of any licence granted under the patent before the endorsement, order the licence to be exchanged for a licence to be granted by virtue of the endorsement upon terms to be settled as aforesaid;

(c) if in proceedings for infringement of the patent (otherwise than by the importation of goods) the defendant undertakes to take a licence upon terms to be settled by the Controller as aforesaid, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement;

(d) the renewal fees payable in respect of the patent after the date of the endorsement shall be one half of the renewal fees which would be payable if the patent were not so endorsed.

(3) In settling the terms of any such licence the Controller—

- (a) shall endeavour to secure the widest possible user of the invention in the State consistent with the patentee's deriving a reasonable advantage from his patent rights,
- (b) shall endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the State,
- (c) shall endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted,
- (d) may so frame the terms as to preclude the licensee from importing into the State any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation.

(4) The licensee under any licence granted by virtue of the endorsement of a patent under this section shall (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent; and if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as if he were patentee, making the patentee a defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(5) An application for the endorsement of a patent under this section shall contain a statement (to be verified in such manner as may be prescribed) that the patentee is not precluded by contract from granting licences under the patent; and the Controller may require from the applicant such further evidence as he may think necessary.

(6) An application made under this section for the endorsement of a patent of addition shall be treated as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the endorsement of the patent of addition also; and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed.

(7) All endorsements of patents under this section shall be entered in the register of patents and shall be published in the Journal and in such other manner as the Controller thinks desirable for bringing the endorsement to the notice of manufacturers.

(8) An appeal shall lie from any decision of the Controller under this section.

#### Cancellation of endorsement.

**38.**—(1) At any time after a patent has been endorsed under the last foregoing section, the patentee may apply to the Controller for cancellation of the endorsement; and where such an application is made and the balance paid of all renewal fees which would have been payable if the patent had not been endorsed, the Controller may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, cancel the endorsement accordingly.

(2) Within the prescribed period after a patent has been endorsed as aforesaid, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Controller for cancellation of the endorsement.

(3) Where the Controller is satisfied, on application made under the last foregoing subsection, that the patentee is and was precluded as aforesaid, he shall cancel the endorsement; and thereupon the patentee shall be liable to pay, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed, and if that sum is not paid within that period the patent shall cease to have effect at the expiration of that period.

(4) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee shall thereafter be the same as if the endorsement had not been made.

(5) The Controller shall advertise in the prescribed manner any application made to him under this section; and within the prescribed period after such advertisement—

(a) in the case of an application under *subsection (1)* of this section, any person interested; and

(b) in the case of an application under *subsection (2)* of this section, the patentee, may give notice to the Controller of opposition to the cancellation.

(6) Where any such notice of opposition is given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

(7) An application made under this section for the cancellation of the endorsement of a patent of addition shall be treated as an application for the cancellation of the endorsement of the patent for the main invention also, and an application made under this section for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the cancellation of the endorsement of the patent of addition also.

(8) An appeal shall lie from any decision of the Controller under this section.

Compulsory endorsement or licence.

**39.**—(1) At any time after the expiration of four years from the date of application for a patent or three years from the date of sealing the patent, whichever is the later, any person interested may apply to the Controller for a licence under the patent or for the endorsement of the patent with the words “licences of right” on the ground that there has been an abuse of the monopoly rights under the patent.

(2) The grounds, deemed to constitute an abuse of monopoly rights, upon which application may be made for an order under this section are as follows, that is to say:

(a) that the patented invention, being capable of being commercially worked in the State, is not being commercially worked therein or is not being so worked to the fullest extent that is reasonably practicable;

(b) that a demand for the patented article in the State is not being met on reasonable terms, or is being met to a substantial extent by importation;

(c) that the commercial working of the invention in the State is being prevented or hindered by the importation of the patented article;

(d) that by reason of the refusal of the patentee to grant a licence or licences on reasonable terms—

(i) a market for the export of the patented article manufactured in the State is not being supplied; or

(ii) the working or efficient working in the State of any other patented invention which makes a substantial contribution to the art is prevented or hindered; or

(iii) the establishment or development of commercial or industrial activities in the State is unfairly prejudiced;

(e) that by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the State is unfairly prejudiced;

(f) that a condition which by virtue of *section 54* of this Act is null and void has been inserted in a contract made after the commencement of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by the patent:

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be commercially worked in the State without undue delay.

(3) Subject as hereinafter provided, the Controller may, if satisfied that any of the grounds aforesaid are established, make an order in accordance with the application; and where the order is for the grant of a licence, it may require the licence to be granted upon such terms as the Controller thinks fit:

Provided that—

(a) where the application is made on the ground that the patented invention is not being commercially worked in the State or is not being worked to the fullest extent that is reasonably practicable and it appears to the Controller that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable it to be so worked, he may by order adjourn the application for such period as will in his opinion give sufficient time *for* the invention to be so worked;

(b) an order shall not be made under this section for the endorsement of a patent on the ground that a market for the export of the patented article is not being supplied, and any licence granted under this section on that ground shall contain such provisions as appear to the Controller to be expedient for restricting the countries in which the patented article may be sold or used by the licensee;

(c) no order shall be made under this section in respect of a patent on the ground that the working or efficient working in the State of another patented invention is prevented or hindered unless the Controller is satisfied that the patentee in respect of that other invention is able and willing to grant to the patentee and his licensees a licence in respect of that other invention on reasonable terms;

(d) any licence granted shall be non-exclusive and non-transferable;

(e) the terms of any licence granted may be so framed as to preclude the licensee from importing into the State any goods the importation of which, if effected by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation.

(4) The Controller shall, in determining whether to make an order in pursuance of any such application, take account of the following matters, that is to say:-

(a) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(b) the ability of any person to whom a licence would be granted under the order to work the invention to the public advantage; and

(c) the risks to be undertaken by that person in providing capital and working the invention if the application is granted;

but shall not be required to take account of matters subsequent to the making of the application.

(5) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent; and no person shall be estopped from alleging any of the matters specified in *subsection (3)* of this section by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.

(6) In this section “patented article” includes any article made by a patented process.

Provisions as to licences.

**40.**—(1) Where the Controller is satisfied, on application made under the last foregoing section of this Act, that the manufacture, use or sale of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under the last foregoing section is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where on an application under the last foregoing section the Controller orders the grant of a licence, he may direct that the licence shall operate—

(a) to deprive the patentee of any right which he may have as patentee to make, use, exercise or vend the invention or to grant licences under the patent;

(b) to revoke all existing licences in respect of the invention.

(4) *Subsection (4) of section 37* of this Act shall apply to a licence granted in pursuance of an order under the last foregoing section of this Act as it applies to a licence granted by virtue of the said *section 37*.

Endorsement, etc. on application of a Minister of State.

**41.**—(1) At any time after the expiration of four years after the date of application for a patent or of three years from the date of the sealing of a patent, whichever is the later, any Minister of State may apply to the Controller upon any one or more of the grounds specified in *section 39* of this Act for the endorsement of the patent with the words “licences of right” or for the grant to any person specified in the application of a licence under the patent; and the Controller may, if satisfied that any of those grounds are established, make an order in accordance with the application.

(2) *Subsections (3) and (6) of section 39* of this Act and *section 40* of this Act shall, so far as applicable, apply in relation to an application and an order under the last foregoing subsection as they apply in relation to an application and an order under the said *section 39*.

Inventions relating to food or medicine.

**42.**—(1) Without prejudice to the foregoing provisions of this Act, where a patent is in force in respect of—

(a) a substance capable of being used as food or medicine or in the production of food or medicine; or

(b) a process for producing such a substance as aforesaid; or

(c) any invention capable of being used as, or as part of a medical, surgical or other remedial device,

the Controller shall, on application made to him by any person interested, order the grant to the applicant of a licence under the patent on such terms as he thinks fit, unless it appears to him that, having regard to the desirability of encouraging inventors and the growth and development of industry and to such other matters as he considers relevant, there are good reasons for refusing the application.

(2) In settling the terms of licences under this section the Controller shall endeavour to secure that food, medicines and medical, surgical and other remedial devices shall be available to the public at the lowest prices consistent with the patentees' deriving a reasonable advantage from their patent rights.

(3) A licence granted under this section shall entitle the licensee to make, use, exercise and vend the invention as a food or medicine, or for the purposes of the production of food or medicine or as, or as part of, a medical, surgical or other remedial device, but for no other purposes.

Revocation of patent after grant of licence.

**43.**—(1) Where an order for the grant of a licence under a patent has been made in pursuance of an application under *section 39* of this Act, any person interested may, at any time after the expiration of two years from the date of that order, apply to the Controller for the revocation of the patent upon any of the grounds specified in *subsection (2) of the said section 39*; and if upon any such application the Controller is satisfied—

(a) that any of the said grounds are established; and  
(b) that the purposes for which an order may be made in pursuance of an application under the said *section 39* could not be achieved by the making of any such order as is authorised to be made in pursuance of such an application,  
he may order the patent to be revoked.

(2) An order for the revocation of a patent under this section may be made so as to take effect either unconditionally, or in the event of failure to comply, within such reasonable period as may be specified in the order, with such conditions as may be imposed by the order with a view to achieving the purposes aforesaid; and the Controller may, on reasonable cause shown in any case, by subsequent order extend any period so specified.

Procedure on applications under *section 39* to *43*.

**44.**—(1) Every application under *sections 39* to *43* of this Act shall specify the nature of the order sought by the applicant and shall contain a statement (to be verified in such manner as may be prescribed) setting out the nature of the applicant's interest (if any) and the facts upon which the application is based.

(2) Where the Controller is satisfied, upon consideration of any such application, that a *prima facie* case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other persons appearing from the register of patents to be interested in the patent in respect of which the application is made, and shall advertise the application in the Journal.

(3) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of oppositions.

(4) Any such notice of opposition shall contain a statement (to be verified in such manner as may be prescribed) setting out the grounds on which the application is opposed.

(5) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall, subject to the provisions of the next following section with respect to arbitration, give to the applicant and the opponent an opportunity to be heard before deciding the case.

Appeal and references to arbitrator.

**45.**—(1) An appeal shall lie from any order made by the Controller in pursuance of an application under *sections 39* to *43* of this Act.

(2) On any appeal under this section, the Attorney General or such other counsel as he may appoint shall be entitled to appear and be heard.

(3) Where any such application is opposed in accordance with the last foregoing section, and either—

(a) the parties consent; or

(b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Controller conveniently be made before him, the Controller may at any time order the whole proceedings, or any question or issue of fact arising therein, to be referred to an arbitrator agreed on by the parties, or, in default of agreement, appointed by the Controller.

1954, No. 26.

(4) Where the whole proceedings are referred as aforesaid, section 35 of the Arbitration Act, 1954, (which relates to the statement of cases by arbitrators for the decision of the High Court) shall not apply to the arbitration; but unless the parties otherwise agree before the award of the arbitrator is made, an appeal shall lie from the award.

(5) Where a question or issue of fact is referred as aforesaid, the arbitrator shall report his findings to the Controller.

Supplementary provisions as to licences.

**46.**—(1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) An order may be made on an application under *sections 39 to 41* of this Act for the endorsement of a patent with the words “licences of right” notwithstanding any contract which would have precluded the endorsement of the patent on the application of the patentee under *section 37* of this Act; and any such order shall for all purposes have the same effect as an endorsement made in pursuance of an application under the said *section 37*.

(3) No order shall be made in pursuance of any application under *sections 39 to 43* of this Act which would be at variance with any treaty, convention, arrangement or engagement applying to the State and any convention country.

Previous publication.

**47.**—(1) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or applicant for the patent proves—

(a) that the matter published was obtained from him or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and

(b) that the application for a patent or (in the case of a convention application) the application for protection in a convention country was made not more than six months after the date of such publication:

Provided that this subsection shall not apply if the invention was before the priority date of the claim commercially worked in the State, otherwise than for the purpose of reasonable trial, either by the patentee or applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title.

(2) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention, made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of the invention by that applicant if the first-mentioned application was made not more than six months after any such use or publication.

(3) Notwithstanding anything in this Act, the Controller shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Previous communication, display or working.

**48.**—(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to a Minister of State or to any person authorised by such a Minister to investigate the invention or its merits.

(2) The exhibition of an invention at an international exhibition, certified as such by the Minister, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not be deemed to be an anticipation of the invention:

Provided that—

(a) the exhibitor, before exhibiting the invention, or permitting such publication, gives the Controller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months after the date of the opening of the exhibition.

(3) Notwithstanding anything in this Act, the Controller shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Use and publication after provisional specification or foreign application.

**49.**—(1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or by a specification treated by virtue of a direction under *subsection (4) of section 8* of this Act as a provisional specification, then, notwithstanding anything in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used or published at any time after the date of filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used or published at any time after the date of that application for protection.

Priority date in case of obtaining.

**50.**—Where an application is made for a patent for an invention which has been claimed in a complete specification filed in pursuance of any other such application, then if—

(a) the Controller has refused to grant a patent in pursuance of that other application on the ground specified in *paragraph (a) of subsection (1) of section 19* of this Act; or

(b) a patent granted in pursuance of that other application has been revoked by the Court or the Controller on the ground specified in *paragraph (a) of subsection (1) of section 19* or *paragraph (c) of subsection (1) of section 34* of this Act; or

(c) the complete specification filed in pursuance of the said other application has, in proceedings under *section 19, section 34* or *section 35* of this Act, been amended by the exclusion of the claim relating to the said invention in consequence of a finding by the Controller or the Court that the invention was obtained by the applicant or patentee from any other person, the Controller may direct that the first-mentioned application and any specification filed in pursuance thereof shall be deemed, for the purposes of the provisions of this Act relating to the priority date of claims of complete specifications, to have been filed on the date on which the corresponding document was *or* was deemed to have been filed in the proceedings upon the said other application.

Co-ownership of patents.

**51.**—(1) Where after the commencement of this Act a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of this and the next following section, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise and vend the patented invention for his own benefit without accounting to the other or others.

(3) Subject to the provisions of the next following section, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as grantee or proprietor of the patent.

(4) Where an article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions of this section, the rules of law applicable to the ownership and devolution of personal property generally shall apply in relation to patents as they apply in relation to other choses in action; and nothing in *subsection (1)* or *subsection (2)* of this section shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Power of Controller to give directions to co-owners.

**52.**—(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under the last foregoing section in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—

(a) in the case of an application under *subsection (1)* of this section, to the other person or persons registered as grantee or proprietor of the patent;

(b) in the case of an application under *subsection (2)* of this section, to the person in default.

(4) An appeal shall lie from any decision or direction of the Controller under this section.

(5) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Disputes as to inventions made by employees.

**53.**—(1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Controller may, upon application made to him in the prescribed manner by either of the parties, and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decisions as he considers expedient:

Provided that if it appears to the Controller upon any application under this section that the matter in dispute involves questions which would more properly be determined by the Court, he may decline to deal therewith.

(2) In proceedings before the Court between an employer and a person who is or was at the material time his employee, or upon an application made to the Controller under *subsection (1)* of this section, the Court or Controller may, unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by the employee, by order provide for the apportionment between

them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the Court or Controller considers just.

(3) A decision of the Controller under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Court.

(4) An appeal shall lie from any decision of the Controller under this section.

Avoidance of certain conditions attached to the sale, etc., of patented articles.

**54.**—(1) It shall not be lawful in any contract in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition which, directly or indirectly, will—

(a) prevent or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(b) require the purchaser, lessee, or licensee to acquire from the seller, lessor, licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void:

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in compensation for such relief, in the case of a purchase, of such sum, or in the case of a lease or licence, of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Minister.

(2) In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under *paragraph (t)* of the proviso to the foregoing subsection.

(3) Any contract relating to the lease of or licence to use or work any patented article or patented process may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party.

(4) The insertion by the patentee in a contract of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(b) be construed as validating any contract which would, apart from this section, be invalid; or

(c) affect any right of determining a contract or condition in a contract exercisable independently of this section; or

(d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

## PART V.

### PROCEEDINGS FOR INFRINGEMENT OF PATENTS.

#### Restrictions on recovery of damages for infringement.

**55.**—(1) In proceedings for the infringement of a patent damages shall not be awarded against a defendant who proves that at the date of the infringement he was *not* aware, and had *no* reasonable ground for supposing, that the patent existed; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained in the State for the article, unless the number of the patent accompanied the word or words in question.

(2) In any proceeding for infringement of a patent the Court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceedings in respect of the use of the invention before the date of the decision allowing the amendment, unless the Court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a patent.

#### Order for account in action for infringement.

**56.**—In an action for infringement of a patent the plaintiff shall be entitled, at his option, to an account of profits in lieu of damages.

#### Counterclaim for revocation in action for infringement.

**57.**—A defendant in an action for infringement of a patent may, without presenting a petition, apply in accordance with rules of court by way of counterclaim in the action for revocation of the patent.

#### Relief for infringement of partially valid specification.

**58.**—(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the Court may grant relief in respect of any valid claim which is infringed:

Provided that the Court shall not grant relief by way of damages or costs except in the circumstances mentioned in the next following subsection.

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under *subsection (1)* or *subsection (2)* of this section the Court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under *section 32* of this Act, and such an application may be made accordingly whether or not all other issues in the proceedings have been determined.

#### Proceedings for infringement by exclusive licensee.

**59.**—(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the like right as the patentee to take proceedings in respect of an infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings, the Court shall take into consideration any loss suffered or likely to be suffered by the

exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any proceedings taken by the holder of an exclusive licence by virtue of this section, the patentee shall, unless he is joined as plaintiff in the proceedings be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Certificate of contested validity of specification.

**60.**—(1) If in any proceedings before the Court the validity of any claim of a specification is contested, and that claim is found by the Court to be valid, the Court may certify that the validity of that claim was contested in those proceedings.

(2) Where any such certificate has been granted, then if, in any subsequent proceedings before the Court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and client so far as concerns the claim in respect of which the certificate was granted:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

Remedy for groundless threats of infringement proceedings.

**61.**—(1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring an action against him for any such relief as is mentioned in the next following subsection.

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he had sustained thereby.

(3) For the avoidance of doubt it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

Power of Court to make declaration as to non-infringement.

**62.**—(1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the Court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown—

- (a) that the plaintiff has applied in writing to the patentee or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
- (b) that the patentee or licensee has refused or neglected to give such an acknowledgment.

(2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall, unless for special reasons the Court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

(4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and reference in this section to the patentee shall be construed accordingly.

## PART VI.

### REGISTER OF PATENTS.

#### Register of patents.

**63.**—(1) There shall continue to be kept at the Office a register of patents, in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents, and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of patents as the Controller thinks fit.

(2) Subject to the provisions of this Act and to any rules made by the Minister, the register of patents shall, at all convenient times, be open to inspection by the public; and certified copies, sealed with the seal of the Controller, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(3) The register of patents shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

(4) No notice of any trust, whether expressed, implied or constructive, shall be entered in the register of patents, and the Controller shall not be affected by any such notice.

#### Registration of assignments, etc.

**64.**—(1) Where a person becomes entitled by assignment or transmission, operation of law or any other mode of transfer to a patent or to a share in a patent, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a patent, he shall apply to the Controller in the prescribed manner for the registration of his title as proprietor or co-proprietor, or, as the case may be, of notice of his interest, in the register of patents.

(2) Without prejudice to the provisions of the foregoing subsection, an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction—

(a) where that person is entitled to a patent or a share in a patent, register him in the register of patents as proprietor or co-proprietor of the patent, and enter in that register particulars of the instrument or event by which he derives title; or

(b) where that person is entitled to any other interest in the patent, enter in that register notice of his interest, with particulars of the instrument (if any) creating it.

(4) Subject to the provisions of this Act relating to co-ownership of patents, and subject also to any rights vested in any other person of which notice is entered in the register of patents, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the patent, and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other personal property.

(5) Rules made by the Minister under this Act may require the supply to the Controller for filing at the Office of copies of such deeds, licences and other documents as may be prescribed.

(6) Except for the purposes of an application to rectify the register under the following provisions of this Act, a document in respect of which no entry has been made in the register of patents under *subsection* (3) of this section shall not be admitted in any court as evidence of the title of any person to a patent or share of or interest in a patent unless the court otherwise directs.

Power of Court to amend register.

**65.**—(1) Subject to the provisions of this Act, the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry or by any entry made in the register without sufficient cause, or by any entry wrongly remaining in the register, or by an error or defect in any entry in the register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) The prescribed notice of any application under this section shall be given to the Controller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Controller in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the Office in like cases, or of such other matters relevant to the issues, and within his knowledge as Controller, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

(4) In the case of fraud in the registration or transmission of a patent, the Controller may himself apply to the Court under the provisions of this section.

(5) Any order of the Court rectifying the register shall direct that notice of the rectification be served on the Controller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

(6) Any application under this section (other than an application by the Controller) may, at the option of the applicant, be made in the first instance to the Controller, and in such case the Controller shall have all the powers of the Court under this section, but his decision shall be subject to appeal.

Power to correct clerical errors, etc.

**66.**—(1) The Controller may, in accordance with the provisions of this section, correct any clerical error in any patent, any application for a patent, or any document filed in pursuance of such an application, or, without prejudice to *subsection* (6) of the last foregoing section, any error in the register of patents.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

Certificate of Controller and sealed copies of documents in Office to be evidence.

**67.**—(1) A certificate purporting to be under the band of the Controller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, or of the matter or thing having been done or left undone.

(2) Printed or written copies or extracts, purporting to be certified by the Controller or an officer of the Controller and sealed with the seal of the Controller, of or from patents, specifications, and other

documents or books in the Office, and of or from registers kept there, shall be admitted in evidence in all courts and in all legal proceedings without further proof or production of the originals.

Requests for information as to patent or patent application.

**68.**—The Controller shall, on request made to him in the prescribed manner by any person and on payment of the prescribed fee, furnish the person making the request with such information relating to any patent or application for a patent as may be specified in the request, being information in respect of any such matters as may be prescribed.

Restriction upon publication of specifications, etc.

**69.**—An application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller or be open to public inspection at any time before the date advertised in the journal in pursuance of *subsection (2) of section 18* of this Act:

Provided that the Minister may prescribe a time within which any complete specification filed at the Office in pursuance of an application for a patent shall be laid open to public inspection.

Loss or destruction of patents.

**70.**—If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time seal a duplicate thereof.

## PART VII.

### PROCEEDINGS BEFORE THE CONTROLLER OR THE COURT.

Exercise of discretionary power by Controller.

**71.**—Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to the applicant for a patent or for amendment of a specification or the registered proprietor of a patent without (if so required within the prescribed time by the applicant or registered proprietor) giving the applicant or registered proprietor an opportunity of being heard.

Costs and security for costs.

**72.**—(1) The Controller may, in any proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid; and any such order may be made a rule of Court.

(2) If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the revocation of a patent or for the grant of a licence under a patent or for the determination of a dispute as to an invention under *section 53* of this Act, or by whom notice of appeal is given from any decision of the Controller under this Act, neither resides nor carries on business in the State, the Controller, or in the case of appeal, the Court, may require him to give security for the costs of the proceedings or appeal, and in default of such security being given may treat the opposition, application or appeal as abandoned.

Evidence before Controller.

**73.**—(1) In any proceeding under this or any other enactment before the Controller, the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Controller thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may in the case of appeal be used in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

- (3) The Controller may for the purposes of his functions do all or any of the following things:—
- (a) summon witnesses to attend before him,
  - (b) examine on oath (which he is hereby authorised to administer), or permit the examination on oath of, the witnesses attending before him,
  - (c) require any such witness to produce to him any document in his power or control.
- (4) A summons shall be signed by the Controller.
- (5) A witness before the Controller shall be entitled to the same immunities and privileges as if he were a witness before the Court.
- (6) If any person—
- (a) on being duly summoned as a witness before the Controller makes default in attending, or
  - (b) being in attendance as a witness refuses to take an oath legally required by the Controller to be taken, or to produce any document in his power or control legally required by the Controller to be produced by him, or to answer any question to which the Controller may legally require an answer, or
  - (c) does any other thing which would, if the Controller were a court of justice, having power to commit for contempt of court, be contempt of such court,

the Controller may certify the offence of that person under his official seal to the Court and the Court may, after such inquiry as it thinks proper to make, punish or take steps for the punishment of that person in like manner as if he had been guilty of contempt of the Court.

Hearing by Court with assessor.

**74.**—(1) In an action or proceeding for infringement or revocation of a patent, or other proceeding under this Act, the Court may, if it thinks fit, and shall, on the request of all parties to the proceedings, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance, in which event the action shall be tried without a jury unless the Court otherwise directs.

(2) The Supreme Court may, if it thinks fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Supreme Court, as the case may be, and be paid as part of the expenses of the execution of this Act.

Appeals from decisions of Controller.

**75.**—(1) Any appeal from the Controller under this Act shall be to the Court and shall be heard by one judge of the Court and the President of the High Court shall from time to time make arrangements for securing that all appeals under this section shall, so far as practicable, be heard by the same judge.

(2) Any such appeal which concerns a patent specification which has not become open to public inspection shall be heard in private.

(3) In any such appeal the Controller shall be entitled to appear or be represented in support of his decision and shall appear if so directed by the Court.

(4) In any such appeal the Court may exercise any power which could have been exercised by the Controller in the proceedings from which the appeal is brought.

(5) Rules for the conduct of proceedings under this section may include provision for the appointment of scientific advisers to assist the Court, and for regulating the functions of such advisers. The remuneration of a scientific adviser appointed in accordance with such rules shall be defrayed out of moneys provided by the Oireachtas.

(6) Except by leave of the Court, no appeal from an order or decision of the Controller shall be entertained of which notice to the Court is not given within one month from the date of the order or decision appealed against or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of one month).

(7) An appeal to the Supreme Court on a specified question of law shall lie from the decision of the Court on an appeal to it under this Act (other than an appeal under *section 11, 12, 13, 14, 19, 20, 21, 22, 28, 30 or 31* of this Act).

Costs of Controller in Court proceedings.

**76.**—In all proceedings before the Court under this or any other enactment the Controller shall neither be awarded nor ordered to pay costs.

## PART VIII.

### THE OFFICE AND THE CONTROLLER.

Patents Office.

**77.**—(1) There shall continue to be, for the purposes of this Act and for such other purposes as have been or may, from time to time, be assigned to it by the Oireachtas, an office for the registration of patents, designs and trade marks which shall be known as the Patents Office and references in any enactment to the Industrial and Commercial Property Registration Office established under the Act of 1927 shall be construed as references to the Office.

(2) The Office shall be under the immediate control of the Controller who shall act under the general superintendence and direction of the Minister.

Controller of Patents, Designs and Trade Marks.

**78.**—(1) The office of Controller of Industrial and Commercial Property shall continue in being as a corporation sole with perpetual succession and an official seal (impressions of which shall be judicially noticed and admitted in evidence) and shall be known as the Controller of Patents, Designs and Trade Marks and the Controller may sue and be sued in that name and references in any enactment to the Controller of Industrial and Commercial Property appointed under the Act of 1927 shall be construed as references to the Controller.

(2)

(a) The Government shall appoint as occasion arises a fit person to the office of Controller who shall hold office for such time and on such terms as the Government shall appoint.

(b) The person holding office immediately before the commencement of this Act as Controller of Industrial and Commercial Property shall be deemed for the purposes of this Act to have been appointed to the office of Controller under this section on the same terms and at the same remuneration as he held the first-mentioned office.

(3) Every person appointed to be Controller under this Act shall receive such remuneration as the Minister for Finance shall determine.

(4) Subject to his being in good health at the time of appointment and notwithstanding that he is appointed without a certificate from the Civil Service Commissioners, the Controller shall, if appointed permanently, be deemed to be employed in the permanent Civil Service of the State and there may be granted to him on retirement or to his legal personal representative on death such superannuation or other allowance or gratuity as might under the Superannuation Acts for the time being in force have been granted had he been in the permanent Civil Service of the State.

(5) Any act or thing directed to be done by or to the Controller may be done by or to any officer authorised by the Minister.

(6) Whenever the Controller is temporarily unable to attend to his duties, or his office is vacant, the Minister may appoint a fit person to perform the duties of the Controller during such inability or vacancy, and every person so appointed shall during his appointment have all the powers of the Controller under this

Act and as otherwise determined by law and shall receive such remuneration, out of moneys provided by the Oireachtas, as the Minister shall, with the sanction of the Minister for Finance direct.

Appointment of officers of Controller.

**79.**—(1) The officers of the Controller shall be appointed by the Minister and there shall be such number of officers as the Minister with the sanction of the Minister for Finance, may consider necessary for the purposes of this Act and for such other functions as the Controller may be charged with, and those persons shall hold office upon such terms and be remunerated at such rates and in such manner as the Minister for Finance may sanction.

(2) The salaries or remuneration of the Controller and his officers and such other expenses of carrying this Act into effect as may be sanctioned by the Minister for Finance shall be paid out of moneys provided by the Oireachtas.

(3) Persons holding office immediately before the commencement of this Act as officers of the Controller of Industrial and Commercial Property shall be deemed for the purposes of this Act to have been appointed officers of the Controller under this Act on the same terms and at the same remuneration as they held such first mentioned offices.

**80.**—(1) There shall be charged by the Controller and paid in Fees. respect of matters relating to the grant of patents under this Act or other matters determined by law as coming within the duties of the Controller, such fees as may from time to time be prescribed by the Minister with the sanction of the Minister for Finance.

(2) All fees charged by the Controller under this section shall be collected and accounted for in such manner as shall be prescribed by the Minister with the sanction of the Minister for Finance.

(3) The Public Offices Fees Act, 1879, shall not apply in respect 1879, c. 58. of any fees payable under this section.

Official Journal.

**81.**—(1) The Controller shall issue periodically a journal (which is referred to in this Act as the Journal) in which he shall publish all matters which he is directed by this Act or otherwise by law to publish, and also such matters and information as appear to him to be useful or important in relation to patented inventions and other matters for which he is responsible under this Act or otherwise by law.

(2) The Controller may issue periodically either in or as a supplement to the Journal or as a separate publication reports of—

(a) cases relating to patents, designs, trade marks or copyright decided in the State, and

(b) such cases relating to patents, designs, trade marks, or copyright decided outside the State as the Controller may consider to be useful or important.

(3) The Controller may prepare and publish indexes, abridgments of specifications, catalogues and other works relating to inventions, patents, designs, and trade marks.

(4) The Controller shall make provision for the sale of copies of all documents which he is by this section, or otherwise by law, directed or authorised to issue or publish, and also of all complete specifications (together with any accompanying drawings) of patents in force under this Act.

Reports to be privileged.

**82.**—Except as prescribed by the Minister, reports of examiners and other officers made under this Act or under any other Act for the administration of which the Controller is responsible shall not be published or be open to public inspection and shall not be liable to production or inspection in any legal proceeding unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice and ought to be allowed.

Controller may consult Attorney General.

**83.**—The Controller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act or of any other Act for the administration of which he is responsible apply to the Attorney General for directions in the matter.

Annual report.

**84.**—The Controller shall, before the 1st day of September in every year, cause a report respecting the execution by or under him of this Act and of any other Act for the administration of which he is responsible during the year ending on the previous 31st day of March to be laid before each House of the Oireachtas, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of the said Acts and an account of all fees, salaries, and allowances, and other money received and paid under the said Acts.

Hours of business and excluded days.

**85.**—(1) Rules made by the Minister under this Act may specify the hour at which the Office shall be deemed to be closed on any day for purposes of the transaction by the public of business under this Act or such other business as may by law be made a function of the Controller or the Office or of any class of such business, and may specify days as excluded days for any such purposes.

(2) Any business done under this Act on any day after the hour specified as aforesaid or on a day which is an excluded day, in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

## PART IX.

### MISCELLANEOUS.

Patent agents.

**86.**—

(1) Subject to such exceptions as may be prescribed or as, in any particular case, the Controller may direct, whenever under this Act any act has to be done by or to any person in connection with a patent or any procedure relating to a patent or the obtaining thereof, the act may under and in accordance with rules made under this section be done by or to an agent (in this Act referred to as a patent agent) of such person duly authorised in the prescribed manner.

(2) There shall continue to be kept at the Office a register called the register of patent agents and a person acting for gain shall not, either alone or in partnership with any other person, practise, describe himself or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent in the register of patent agents or, as the case may be, unless he and all his partners are so registered; and a company acting for gain shall not practise, describe itself or hold itself out or permit itself to be described or held out as aforesaid unless every director of the company and, if the company has a manager who is not a director, that manager, is registered as aforesaid:

Provided that if in any circumstances he thinks it right so to do the Minister may authorise any person whom he considers suitable to act as a patent agent in a particular case or at a particular time:

Provided further that it shall not be an offence under this section if the legal personal representative of a deceased patent agent carries on the business or practice of that deceased patent agent for a period not exceeding three years from the death of the patent agent, or for such further period (if any) as the Court allows, and is himself registered as a patent agent or employs a registered patent agent or a person authorised under this section to act as a patent agent to manage the business or practice on his behalf.

(3) Any person who—

- (a) resides in the State,
- (b) has a place of business in the State,
- (c) possesses the prescribed educational and professional qualifications, and
- (d) complies with the prescribed conditions,

shall be eligible to be registered in the register of patent agents, and a partnership shall be so eligible if every partner of the firm is registered in accordance with the provisions of this section, and a person or firm so eligible shall on application in the prescribed form and manner and on payment of the prescribed fee be so registered.

(4) Any person who contravenes the provisions of this section shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding, in the case of a first offence, twenty pounds, and in the case of a second or subsequent offence, one hundred pounds.

1851, c. 93.

(5) Notwithstanding subsection (4) of section 10 of the Petty Sessions (Ireland) Act, 1851, proceedings for an offence under this section may be begun at any time within twelve months from the date of the offence.

(6) Nothing in this section shall be construed as prohibiting solicitors from taking such part in proceedings under this Act as has heretofore been taken by solicitors in connection with a patent or any procedure relating to a patent or the obtaining thereof.

1954. No. 36.

(7) A patent agent shall not be guilty of an offence under section 58 of the Solicitors Act, 1954, (which prohibits the preparation for reward of certain instruments by persons not legally qualified) by reason only of the preparation by him of a deed assigning the right to make an application for a patent, a deed assigning from the patent agent a patent granted to him or any other document (not being a deed) for use in proceedings under this Act before the Controller or the Court.

(8) A person (in this subsection referred to as an agent) duly authorised by any person under *subsection (1)* of this section to act as his agent may (subject to any provision to the contrary in any agreement between the agent and that person), on giving notice to the Controller and that person, cease to act as agent for that person.

(9) There shall continue to be kept at the Office a register called the register of clerks and the Minister may make rules for the management of the register and may by such rules prescribe the qualifications and conditions for eligibility for and the fees to be paid on registration in such register.

(10) Any person registered in the register of patent agents who—

- (a) ceases to be eligible to be so registered, or
  - (b) applies to be removed from the register,
- may be removed by the Controller from the register of patent agents, but no person shall be so removed (except on his own application) without being given an opportunity of being heard.

(11)

(a) Where a person registered in the register of patent agents is found by the Controller, after due inquiry by the Controller (including the hearing by the Controller of representations, if any, by the person), to have been guilty of conduct disgraceful to that person in a professional

respect, the Controller may, if he sees fit, decide that the name of that person should be erased from the register of patent agents.

(b) On making a decision under this subsection, the Controller shall forthwith send by post to the person to whom the decision relates, at his address as stated in the register of patent agents, a notice in writing stating the decision, the date thereof and the reason therefor.

(c) A person to whom a decision of the Controller under this subsection relates may, within the period of fourteen days beginning on the date of the decision, on giving notice to the Controller in the prescribed manner, apply to the Court for cancellation of the decision, and if he so applies—

(i) the Court, on the hearing of the application, may either—

(I) cancel the decision, or

(II) confirm the decision and direct the Controller to erase the name of such person from the register of patent agents,

(ii) if at any time the Controller satisfies the Court that such person has delayed unduly in proceeding with the application, the Court shall, unless it sees good reason to the contrary, confirm the decision and direct the Controller to erase the name of such person from the register,

(iii) the Court may, subject to *section 76* of this Act, direct how the costs of the application are to be borne.

(d) Where a person to whom a decision of the Controller under this subsection relates does not, within the period of fourteen days beginning on the date of the decision, apply to the Court for cancellation of the decision, the Controller may apply *ex \$\$\$* to the Court for confirmation of the decision and, if the Controller so applies, the Court, on the hearing of the application, shall, unless it sees good reason to the contrary, confirm the decision and direct the Controller to erase the name of such person from the register of patent agents.

(e) The decision of the Court on an application under this subsection shall be final, save that, by leave of the Court, an appeal, by the Controller or the person concerned, from the decision shall lie to the Supreme Court on a specified question of law.

(f) On erasing the name of a person from the register of patent agents under this subsection, the Controller shall forthwith send by post to such person, at his address as stated in the register of patent agents, notice in writing of the erasure.

(g) A person whose name has been erased from the register of patent agents under this subsection may at any time be restored to the register by special direction of the Controller but not otherwise, and when a person is so restored to the register, the Controller may attach to the restoration such conditions (including the payment of a fee not exceeding the fee which would be payable by such person if he was then being registered for the first time) as the Controller thinks fit.

(12) The Minister may make rules for the management of the register of patent agents, and may by such rules prescribe any matter or thing referred to in this section as prescribed, and in particular may so prescribe the educational and professional qualifications and the conditions (including conditions relating to nationality or citizenship) for eligibility for registration in that register, and the maximum fees which may be charged by any person registered in the register of patent agents for such services in connection with the obtaining of patents as may be specified in such rules.

(13) Rules under this section may authorise the Controller to refuse to recognise as agent in respect of any business under this Act any person whose name, having been entered in the register of patent agents under this Act, has been removed therefrom.

(14) Rules under this section may authorise the Controller to refuse to recognise as agent in respect of any business under this Act a company or firm of which any director or manager or any partner (as the case may be) is an individual whom the Controller could refuse to recognise as an agent.

Publication of register, etc.

**87.**—If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding one hundred pounds or, at the discretion of the court, to imprisonment for any term not exceeding three months or to both such fine and such imprisonment.

Unauthorised claim of patent rights.

**88.**—If any person falsely represents that any article sold by him is patented, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding twenty pounds; and for the purposes of this provision a person who sells an article having stamped, engraved or impressed thereon or otherwise applied thereto the word “patent” or “patented”, or any other word expressing or implying that the article is patented, shall be deemed to represent that the article is patented.

False suggestion of official connection with the Office.

**89.**—If any person uses on his place of business, or on any document issued by him, or otherwise, any words suggesting that his place of business is officially connected with, or is, the Office, he shall be guilty of an offence and shall be liable on summary conviction thereof to a fine not exceeding twenty pounds.

Inventions relating to instruments or munitions of war.

**90.**—

(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Minister for Defence on behalf of the State all the benefit of the invention and of any patent obtained or to be obtained for the invention.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Minister for Defence on behalf of the State, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Minister for Defence.

(3) Where any such assignment as aforesaid has been made, the Minister for Defence may at any time before the publication of the complete specification certify to the Controller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Minister for Defence so certifies, the application and specifications, with the drawings (if any) and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Office, be delivered to the Controller in a packet sealed by authority of the Minister for Defence.

(5) The packet aforesaid shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Controller and shall not be opened save under the authority of an order of the Minister for Defence or of the Attorney General.

(6) The sealed packet aforesaid shall be delivered at any time during the continuance of the patent to any person authorised by the Minister for Defence to receive it, and shall, if returned to the Controller, be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Minister for Defence.

(8) Where the Minister for Defence certifies as aforesaid after an application for a patent has been left at the Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Controller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Minister for Defence.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which such a certificate as aforesaid has been given by the Minister for Defence.

(10) No copy of any specification or other document or drawings by this section required to be placed in a sealed packet shall in any manner whatever be published or opened to the inspection of the public, but, save as in this section is otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Minister for Defence may at any time waive the benefit of this section with respect to any particular invention, and thereupon the specifications, documents, and drawings relating to that invention shall thenceforth be kept and dealt with in the ordinary way.

(12) Rules may be made under this section by the Minister, after consultation with the Minister for Defence, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Assignment of invention or patent to a Minister of State.

**91.—**

(1) Without prejudice to the provisions of the last foregoing section, any inventor or patentee may (either for or without valuable consideration) make to a Minister of State on behalf of the State, and such Minister may take on such behalf, an assignment of the whole of or any share or interest in the benefit of an invention and of any patent obtained or to be obtained for such invention, and where a Minister of State has taken any such assignment, such Minister may (as the case may be) do or join in doing on behalf of the State all or any of the following things, that is to say:—

(a) develop and perfect such invention,

(b) form or promote an incorporated company or an unincorporated association of persons to develop and perfect such invention,

(c) take an assignment of any patent or of a share or interest in any patent theretofore or thereafter obtained for such invention,

(d) sell or lease any such patent or grant licences under any such patent on such terms as he shall, with the sanction of the Minister for Finance, think proper,

(e) form or promote an incorporated company or an unincorporated association of persons to work commercially any such patent,

(f) do all such things as may be necessary for the maintenance or preservation of any such patent or be otherwise incidental to the ownership thereof.

(2) Every Minister of State shall, before the 1st day of April in every year, lay before each House of the Oireachtas a report of every (if any) exercise by him in the next preceding year of the several powers conferred by *paragraphs (d) and (e) of subsection (1)* of this section and also, if and so far as he considers it expedient in the public interest, of the several powers conferred by *paragraphs (a), (b), (c) and (f)* of the said subsection.

(3) All expenses incurred by a Minister of State under this section shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas.

Use of patented inventions for the service of the State.

92.—

(1) A patent shall have to all intents the like effect as against the State as it has against a citizen:

Provided that any Minister of State may, by himself or by such of his agents, contractors, or others as may be authorised in writing by him at any time after the application for a patent, make, use, exercise or vend the invention for the service of the State on such terms as may, either before or after the use thereof, be agreed on with the approval of the Minister for Finance by such Minister and the applicant or proprietor, or, in default of agreement, as may be settled in the manner hereinafter provided, and the terms of any agreement or licence concluded between the applicant or proprietor and any person other than a Minister of State shall be inoperative to prevent or regulate the making, use, exercise or vending of the invention for the service of the State:

Provided further that, where an invention which is the subject of any patent or application for a patent has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document by, or been tried by or on behalf of any such Minister (such invention not having been communicated directly or indirectly by the applicant or the proprietor), any Minister of State or such of his agents, contractors, or others as may be authorised in writing by him, may make, use, exercise or vend the invention so recorded or tried for the service of the State free of any royalty or other payment to the applicant or proprietor, notwithstanding the existence of the application or patent, and if in the opinion of such Minister the disclosure to the applicant or the proprietor, as the case may be, of the document recording the invention or the evidence of the trial thereof would be detrimental to the public interest, such disclosure may be made confidentially to counsel on behalf of the applicant or proprietor or to any independent expert mutually agreed upon.

(2) Where any use of an invention is made by or with the authority of a Minister of State under this section, then, unless it appears to such Minister that it would be contrary to the public interest so to do, the Minister shall notify the applicant or proprietor as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.

(3) In case of any dispute as to or in connection with the making, use, exercise or vending of an invention, under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the Court for decision, and the Court shall have the power to refer the whole matter or any question or issue of fact arising thereon to be tried before an arbitrator upon such conditions as it may direct. The Court or arbitrator in settling the terms as aforesaid shall be entitled to take into consideration any benefit or compensation which the applicant or proprietor or any other person interested in the application or patent may have received directly or indirectly from the State or from any Minister or any Government Department in respect of such application or patent.

(4) In any proceedings under this section to which a Minister of State is a party, such Minister may—

- (a) if the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under *section 34* of this Act;
- (b) in any case, put in issue the validity of the patent without applying for its revocation.

(5) The right to use an invention for the service of the State under the provisions of this section shall include the power to sell any articles made in pursuance of such right which are no longer required for the service of the State.

(6) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through him, shall have power to deal with them in the same manner as if they were made pursuant to a patent held on behalf of the State.

(7) During any period when an order under *paragraph (a)* of *subsection (8)* of this section is in force the power exercisable in relation to an invention by a Minister of State, or a person authorised by a Minister of State under *subsection (1)* of this section, shall include power to make, use, exercise and vend the invention for any purpose which appears to such Minister necessary or expedient—

- (a) for the maintenance of supplies and services essential to the life of the community;
- (b) for securing a sufficiency of supplies and services essential to the well-being of the community;
- (c) for promoting the productivity of industry, commerce and agriculture;
- (d) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
- (e) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community;
- (f) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any foreign countries that are in grave distress as the result of war; or
- (g) for ensuring the public safety and the preservation of the State;

and any reference in this section to the services of the State shall be construed as including a reference to the purposes aforesaid.

(8)

(a) Whenever the Government are of opinion that, in the interests of the community, owing to the existence of exceptional circumstances, it is desirable that the powers conferred by *subsection (7)* of this section should be available, they may by order declare that the powers aforesaid shall be available.

(b) Whenever an order under *paragraph (a)* of this subsection is in force and the Government are of opinion that the exceptional circumstances referred to in the said *paragraph (a)* no longer exist, they shall by order revoke the order under the said *paragraph (a)*.

(9) In this section “service of the State” means a service financed out of moneys charged on or advanced out of the Central Fund or moneys provided by the Oireachtas or by a local authority.

Government orders as to convention countries.

93.—

(1) The Government may, with a view to the fulfilment of any treaty, convention, arrangement or engagement with the Government of a foreign country concerning the protection of inventions, by order declare that any country specified in the order is a convention country for the purposes of this Act, and that country shall be a convention country for the purposes of this Act while the order remains in force with respect to that country:

Provided that a declaration may be made as aforesaid for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

(2) Without prejudice to the provisions of *section 96* of this Act the Minister may, for the purposes of convention applications, make rules—

(a) prescribing particular time limits for doing anything required by this Act to be done in connection with such applications;

(b) for regulating the procedures to be observed in connection with making and prosecuting such applications.

(3) The Government may, by order, revoke or amend an order under this section including an order under this subsection.

(4) In this section “foreign country” includes any territory for the foreign relations of which any state (being a state which is a party to any international agreement for the mutual protection of inventions to which the State is a party) considers itself responsible.

Supplementary provisions as to convention applications.

94.—

(1) Where a person has applied for protection for an invention by an application which—

(a) in accordance with the terms of a treaty subsisting between any two or more convention countries, is equivalent to an application duly made in any one of those convention countries, or

(b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,

he shall be deemed for the purposes of this Act to have applied in that convention country.

(2) For the purpose of this Act, matter shall be deemed to have been disclosed in an application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of prior art) in that application or in documents submitted by the applicant for protection in support of and at the same time as that application; but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the Office with the convention application or within such period as may be prescribed after the filing of that application.

Special provisions as to vessels, aircraft and land vehicles.

95.—

(1) Where a vessel or aircraft registered in a foreign state or a land vehicle owned by a person ordinarily resident in a foreign state comes into the State temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

(2) This section shall not extend to vessels, aircraft or land vehicles of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in vessels, aircraft and land vehicles of the State while in that foreign state.

Power of Minister to make rules.

96.—

The Minister may make such general rules (except in relation to any matter appropriate to be provided for by rules of court) and do such things as he thinks expedient, subject to the provisions of this Act—

- (a) for prescribing the form of applications for patents and of any specifications, drawings or other documents which may be filed at the Office, and for requiring copies to be furnished of any such documents;
- (b) for regulating the procedure to be followed in connection with any application or request to the Controller or in connection with any proceeding before the Controller and for authorising the rectification of irregularities of procedure;
- (c) for regulating the publication and sale of patent specifications, of indexes to and abridgements of patent specifications, and of the Journal and other documents which the Controller is by this Act required or authorised to publish, and for regulating the contents of the said Journal and other documents;
- (d) for regulating the presentation of copies of publications made under this Act to patentees and to public authorities, bodies, and institutions at home and abroad;
- (e) for regulating the keeping of the register of patents to be kept pursuant to this Act;
- (f) for prescribing any matter or thing referred to in this Act as prescribed or to be prescribed;
- (g) for doing anything which is by this Act authorised or required to be done, or is in this Act referred to as being or to be done, by general rules made under this Act;
- (h) generally for regulating the business of the Office, and all things by this Act placed under the direction or control of the Controller, or of the Minister.

Power of Minister to delegate to his duties under this Act.

97.—

All things required or authorised under this Act to be done by, to, or before the Minister may be done by, to, or before the Secretary of the Department of Industry and Commerce or any person authorised in that behalf by the Minister.

Service of notices, etc., by post.

98.—

Any notice required or authorised to be given by or under this Act, and any application or other document so required or authorised to be made or filed, may be given, made or filed by post.

Saving for articles forfeited under laws relating to the customs or excise.

99.—

Nothing in this Act shall affect the right of the State, or of any person deriving title directly or indirectly from the State, to sell or use any articles forfeited under the laws relating to the customs or excise.

#### **Section 5.**

#### **FIRST SCHEDULE. ENACTMENTS REPEALED.**

Number and Year	Short Title	Extent of Repeal
No. 16 of 1927.	Industrial and Commercial Property (Protection) Act, 1927.	Section 3 (in so far as it relates to patents); sections 5 to 63; sections 124 and 125 (in so far as they relate to patents); section

		126; sections 127 to 135 (in so far as they relate to patents); section 136; sections 137 and 138 (in so far as they relate to patents); sections 139 and 140; section 141 (in so far as it relates to patents); section 142; section 143 (in so far as it relates to patents); section 144; sections 145 to 150 (in so far as they relate to patents); section 151; sections 152 and 153 (in so far as they relate to patents).
No. 13 of 1929.	Industrial and Commercial Property (Protection) (Amendment) Act, 1929.	Sections 2 to 7.
No. 13 of 1957.	Industrial and Commercial Property (Protection)(Amendment) Act, 1957.	Sections 2 to 4; section 7 (in so far as it relates to patents).
No. 21 of 1958.	Industrial and Commercial Property (Protection)(Amendment) Act, 1958.	Section 4 (in so far as it relates to patents).

### **Section 5.**

#### **SECOND SCHEDULE. TRANSITIONAL PROVISIONS.**

1. Subject to the provisions of this Schedule, any order, regulation, rule, patent, requirement, certificate, notice, decision, direction, authorisation, consent, application, request or thing made, granted, issued, given or done under any enactment repealed by this Act shall, if in force at the commencement of this Act, and so far as it could have been made, granted, issued, given or done under this Act, continue in force and have effect as if made, granted, issued, given or done under the corresponding enactment of this Act.

2. *Section 10* of this Act shall apply in relation to a complete specification filed before the commencement of this Act as it applies to a complete specification filed after the commencement of this Act.

3. Notwithstanding anything in *subsection (2) of section 8* of this Act, a complete specification shall not be filed in pursuance of an application which, by virtue of section 16 of the Act of 1927, was deemed to be abandoned at any time before the commencement of this Act.

4. Where a complete specification (other than a specification relating to an invention referred to in section 55 of the Act of 1927) has been filed before the commencement of this Act but has not been accepted, then, in relation to matters arising before the acceptance or refusal of acceptance of the complete

specification, the provisions of this Act shall not apply, but the provisions of the Act of 1927 shall continue to apply notwithstanding the repeal of those provisions of that Act:

Provided that the provisions of this Act shall apply in any such case in which evidence under section 19 of the said Act of 1927 is not furnished within three months after the date of the commencement of this Act.

5. The provisions of *sections 19, 34 and 35* of this Act relating to the grounds on which the grant of a patent may be opposed or on which a patent may be revoked shall not apply in any case where the complete specification was accepted before the commencement of this Act, but the provisions of the Act of 1927 relating to those matters shall continue to apply in any such case notwithstanding the repeal of those provisions of that Act.

6. Where a specification filed before the commencement of this Act has become open to public inspection it shall continue to be open to public inspection notwithstanding anything in *section 69* of this Act.

7. Where two or more persons are registered as grantee or proprietor in respect of a patent which was granted or for which application was made before the commencement of this Act, the right of each of those persons to assign the whole or part of his interest in the patent shall not be restricted by reason only of the provisions of *section 51* of this Act.

8. *Subsections (1) and (3) of section 26* of this Act shall not apply to any patent granted before the commencement of this Act.

9. *Section 29* of this Act shall have effect, in relation to a patent which has ceased to have effect before the commencement of this Act, as if for the reference to *section 26* of this Act there were substituted a reference to section 33 of the Act of 1927.

10. Where the time allowed under section 25 of the Act of 1927 for the sealing of a patent has expired before the commencement of this Act and the patent has not been sealed, *section 30* of this Act shall have effect in relation to the application for the patent as if for the reference to *section 23* of this Act there were substituted a reference to section 25 of the Act of 1927.

11. In relation to any proceedings pending at the commencement of this Act the provisions of *sections 32 and 58* of this Act shall not apply but the provisions of sections 38 and 50 of the Act of 1927, shall continue to apply notwithstanding the repeal of those sections of that Act.

12. Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.

13. The provisions of *section 75* of this Act shall not apply to any appeal from a decision of the Controller under any provision of the Act of 1927, which is pending at the commencement of this Act but the provision of the Act of 1927 shall continue to apply to the appeal notwithstanding the repeal of that provision of that Act.