



Number 31 of 2006

PATENTS (AMENDMENT) ACT 2006

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[2006.] *Patents (Amendment) Act 2006.* [No. 31.]

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[No. 31.] *Patents (Amendment) Act 2006.* [2006.]

ACTS REFERRED TO

Copyright and Related Rights Act 2000	2000, No. 28
Industrial Designs Act 2001	2001, No. 39
Patents Act 1964	1964, No. 12
Patents Act 1992	1992, No. 1
Trade Marks Act 1996	1996, No. 6



Number 31 of 2006

PATENTS (AMENDMENT) ACT 2006

AN ACT TO GIVE EFFECT TO CERTAIN PROVISIONS OF THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS ANNEXED TO THE AGREEMENT ESTABLISHING THE WORLD TRADE ORGANISATION DONE AT MARRAKESH ON 15 APRIL 1994; TO GIVE FURTHER EFFECT TO THE EUROPEAN PATENT CONVENTION SIGNED AT MUNICH ON 5 OCTOBER 1973; TO GIVE EFFECT TO THE PATENT LAW TREATY ADOPTED AT GENEVA ON 1 JUNE 2000; TO MAKE FURTHER PROVISION IN RESPECT OF MATTERS RELATING TO INTELLECTUAL PROPERTY AND FOR THOSE PURPOSES TO AMEND AND EXTEND THE PATENTS ACT 1992, THE TRADE MARKS ACT 1996, THE COPYRIGHT AND RELATED RIGHTS ACT 2000 AND THE INDUSTRIAL DESIGNS ACT 2001 AND TO PROVIDE FOR RELATED MATTERS.

[11th December, 2006]

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:

1.—In this Act—

Definitions.

“Principal Act” means the Patents Act 1992;

“1996 Act” means the Trade Marks Act 1996.

2.—Section 2 of the Principal Act is amended in subsection (1)—

Interpretation
(section 2 of
Principal Act).

(a) by inserting the following after the definition of “the Act of 1964”:

“ ‘Agreement establishing the World Trade Organisation’ means the Agreement establishing the World Trade Organisation done at Marrakesh on 15 April 1994, as amended or supplemented by any protocol to that Agreement which is for the time being in force in the State;”,

(b) by inserting the following after the definition of “assignee”:

“ ‘Board of Appeal’ means a Board of Appeal referred to in Article 21 of the European Patent Convention;”,

(c) in paragraph (i) of the definition of “designate”, by inserting “, and includes a reference to a country being

treated as designated in pursuance of the European Patent Convention or the Treaty” after “invention”,

- (d) by inserting the following after the definition of “divisional application”:

“ ‘Enlarged Board of Appeal’ means the Enlarged Board of Appeal referred to in Article 22 of the European Patent Convention;”,

- (e) in the definition of “European Patent Convention”, by inserting “, as amended for the time being” after “1973”,

- (f) by inserting the following after the definition of “the Journal”:

“ ‘member of the World Trade Organisation’ means a party to the Agreement establishing the World Trade Organisation;”,

and

- (g) by inserting the following after the definition of “the Treaty”:

“ ‘TRIPs Agreement’ means the Agreement on Trade-Related Aspects of Intellectual Property Rights annexed to the Agreement establishing the World Trade Organisation;”.

Patentable inventions (section 9 of Principal Act).

3.—Section 9 of the Principal Act is amended—

- (a) in subsection (1), by inserting “, in all fields of technology,” after “An invention”, and
- (b) by deleting subsections (4) and (5).

Exceptions to patentability (section 10 of Principal Act).

4.—Section 10 of the Principal Act is amended—

- (a) in paragraph (a), by substituting “commercial exploitation” for “publication or exploitation”,
- (b) in paragraph (b), by substituting “thereof;” for “thereof.”,
- (c) by inserting the following after paragraph (b):

“(c) a method for treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body.”,

- (d) by renumbering the existing provision as subsection (1) of that section, and
- (e) by inserting the following:

“(2) Subsection (1)(c) shall not apply to products, in particular substances or compositions, for use in any such method.”.

5.—Section 11 of the Principal Act is amended by substituting the following for subsection (4):

Novelty (section 11 of Principal Act).

“(4) The provisions of subsections (2) and (3) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 10(1)(c) provided that its use for any such method is not comprised in the state of the art.

(5) The provisions of subsections (2) and (3) shall also not exclude the patentability of any substance or composition referred to in subsection (4) for any specific use in any method referred to in section 10(1)(c), provided that such use is not comprised in the state of the art.”.

6.—Section 23 of the Principal Act is amended by substituting the following for that section:

Date of filing application (section 23 of Principal Act).

“Date of filing application.

23.—(1) The date of filing of a patent application shall be taken to be the earliest date on which the applicant paid the filing fee and filed documents which contain—

- (a) an indication that a patent is sought,
- (b) information identifying the applicant or information sufficient to enable that person to be contacted by the Office, and
- (c) (i) a description of the invention for which a patent is sought even where the description does not comply with other requirements of this Act or with any requirements that may be prescribed, or
- (ii) a reference, complying with any relevant requirements that may be prescribed, to a previously filed application made by the applicant or the applicant’s predecessor in title.

(2) It is immaterial for the purposes of subsection (1)(c)(i) whether the description of the invention concerned is in, or is accompanied by a translation into, a language accepted by the Office in accordance with any requirements that may be prescribed.

(3) If the Minister prescribes a later date for payment of the filing fee under section 18(3), the date of filing referred to in subsection (1) shall be the date on which the documents referred to in subsection (1) are filed.

(4) Where documents filed at the Office do not satisfy all of the conditions specified in subsection (1), the Controller shall as soon as practicable

after the filing of those documents notify the applicant of the further documents required to be filed in order for the application to have a date of filing.

(5) Where documents filed at the Office satisfy all the conditions specified in subsection (1), the Controller shall as soon as practicable after the filing of the last of those documents notify the applicant of—

- (a) the date of filing the application, and
- (b) the requirements that must be complied with, and the periods within which they are required by this Act or rules made under this Act to be complied with, if the application is not to be treated as having been withdrawn.

(6) If any drawing or a part of a description referred to in the application is filed later than the date of filing accorded to the application by virtue of subsection (1), the Controller shall give the applicant an opportunity of requesting, within the prescribed period, that the date on which the drawing or that part of the description was filed shall be treated as being, for the purposes of this Act, the date of filing the application, and—

- (a) if the applicant makes any such request, the date of filing the drawing or that part of the description shall be so treated,
- (b) if the request is not made, any reference to the drawing or that part of the description in the application shall be deemed to be deleted.

(7) If any drawing or part of a description referred to in the application has not been filed, the Controller shall invite the applicant to file the drawing or that part of the description within the prescribed period, and—

- (a) if the drawing or part of the description is subsequently filed within the prescribed period, the date on which it is filed shall be treated for the purposes of this Act as the date of filing the application,
- (b) if the drawing or part of the description is not so filed, any reference to the drawing or part of the description in the application shall be deemed to be deleted.

(8) Where the applicant, subsequent to the date of filing under subsection (1), files a missing part of the description or a missing drawing, subsection (6)(a) or (7)(a) shall not apply where—

- (a) on or before the date which is the date of filing the application under subsection (1) a declaration is made under section 26(1) in, or in connection with, the application, and
- (b) the applicant makes a request for subsection (6)(a) or (7)(a), as the case may be, not to apply and that request complies with the prescribed requirements and is made within the prescribed period.

(9) An application which has a date of filing under this section or is deemed to have a date of filing accorded to it by virtue of section 24 or 81 shall be treated as withdrawn where any of the following applies:

- (a) the filing fee has not been paid within the prescribed period;
- (b) one or more claims or the abstract has not been filed within the relevant prescribed period;
- (c) where a reference to a previously filed application has been filed as referred to in subsection (1)(c)(ii), the applicant fails to file at the Office—
 - (i) a description of the invention for which a patent is sought, before the end of the prescribed period,
 - (ii) a copy of the application referred to, complying with the relevant prescribed requirements, before the end of the prescribed period.

(10) This section applies to patent applications filed on or after the coming into operation of this section.”.

7.—Section 25 of the Principal Act is amended—

Priority right
(section 25 of
Principal Act).

- (a) in subsection (1), by the insertion after “the Paris Convention for the Protection of Industrial Property” of “or to the Agreement establishing the World Trade Organisation”,
- (b) in subsection (5), by the insertion after “the Paris Convention for the Protection of Industrial Property” of “or which is not a party to the Agreement establishing the World Trade Organisation”, and
- (c) after subsection (5), by the insertion of the following:

“(6) In this section a ‘state party to the Agreement establishing the World Trade Organisation’ means a member of the World Trade Organisation and, for the purposes of subsection (5), every country or territory shall be

taken to be a state in the case of which an order may be made under that subsection.”.

Withdrawal of application (section 33 of Principal Act).

8.—Section 33 of the Principal Act is amended by inserting the following after subsection (1):

“(1A) Subsection (1) does not affect the power of the Controller under section 110 to correct an error or mistake in the withdrawal of an application.”.

Reinstatement of applications.

9.—Part II of the Principal Act is amended by inserting the following sections after section 35 but in Chapter IV of that Part:

“Reinstatement of applications. 35A.—(1) This section shall not apply to a patent application which has lapsed by reason of the failure to pay any renewal fee and section 35(3) shall continue to apply to any such application.

(2) Where an application for a patent is refused or is treated as having been withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules made thereunder within a period which is prescribed or specified by the Controller, subject to subsection (3), the Controller shall reinstate the application only if—

- (a) the applicant requests the Controller to do so,
- (b) the request complies with the prescribed requirements, and
- (c) the Controller is satisfied that the said failure to comply occurred despite reasonable care having been taken to so comply.

(3) The Controller shall not reinstate the application if the period referred to in subsection (2) is prescribed or specified by the Controller—

- (a) in relation to any proceedings before the Controller pursuant to Part VIII,
- (b) for the purposes of section 25(1), or
- (c) for the purposes of a request under this section or section 118A.

(4) Where the application for a patent was made by 2 or more persons jointly, a request under subsection (2) may, with the leave of the Controller, be made by one or more of them without joining the others.

(5) Where the application has been published under section 28 and it appears to the Controller that reasonable care was taken to comply with the requirement within the prescribed period or, as

the case may be, the period specified by the Controller, the Controller shall publish notice of a request under subsection (2) in the Journal and within the prescribed period any person may give notice to the Controller of opposition thereto.

(6) If notice of opposition is duly given under this section, the Controller shall notify the applicant and determine the question.

(7) Where an application is reinstated under this section the applicant shall comply with the requirement referred to in subsection (2) within the further period specified by the Controller in making the order to reinstate the application, which further period shall not be less than 2 months.

(8) Where the applicant fails to comply with subsection (7) the application shall be treated as having been withdrawn on the expiration of the period referred to in that subsection.

Effect of
reinstatement.

35B.—(1) Where an application is reinstated under section 35A—

- (a) anything done under or in relation to the application during the period between termination and reinstatement shall be treated as valid,
- (b) in a case where the application has been published under section 28 before its termination, anything done during the period referred to in paragraph (a), which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred, shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights,
- (c) in a case where the application has been published under section 28 before its termination and, after the termination and before publication of a notice of request for its reinstatement, a person—
 - (i) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or
 - (ii) made, in good faith, effective and serious preparations to do such an act,

the person shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the reinstatement of the application and the grant of the patent.

(2) Paragraph (c) of subsection (1) does not extend to granting a licence to any person to do an act referred to in that paragraph.

(3) If the act referred to in paragraph (c) of subsection (1) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by the said paragraph (c) may—

- (a) authorise that act to be done by any partner of that person for the time being in that business, and
- (b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(4) Where a product is disposed of by any person to another person in exercise of a right conferred by paragraph (c) of subsection (1) or by subsection (3), that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.

(5) In this section ‘termination’, in relation to an application, means—

- (a) the refusal of the application, or
- (b) the application is treated as having been withdrawn.”.

Restoration of lapsed patents (section 37 of Principal Act).

10.—The Principal Act is amended in section 37—

(a) by substituting the following for subsection (7):

“(7) An order under this section for the restoration of a patent may be made subject to such conditions as the Controller thinks fit, including, in particular, a condition requiring the entry in the register of any matter in respect of which the provisions of this Act as to entries in the register is not complied with and if any condition to which an order under this section is subject is not complied with by the proprietor of the patent, the Controller may revoke the order and give such directions consequential on the revocation as he thinks fit.”,

and

(b) by inserting the following after subsection (7):

“(8) An order under this section for the restoration of a patent shall have the following effect:

- (a) anything done under or in relation to the patent during the period beginning on the date on which the patent lapsed and ending on the date of an order under this section shall be treated as valid;
- (b) anything done during the period referred to in paragraph (a) which would have constituted an infringement if the patent had not lapsed shall be treated as an infringement—
 - (i) if it was done at a time when it was possible for the patent to be renewed during the period of extension specified for the purpose of section 36(3), or
 - (ii) if it was a continuation or repetition of an earlier infringing act;
- (c) where, after the expiration of the period of extension specified for the purpose of section 36(3) and before the date of publication of the application for restoration of the patent in the Journal under subsection (4), a person—
 - (i) began in good faith to do an act which would constitute an infringement of the patent if it had not lapsed, or
 - (ii) made in good faith effective and serious preparations to do such an act,

the person shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the patent.

(9) Paragraph (c) of subsection (8) does not extend to granting a licence to any person to do an act referred to in that paragraph.

(10) If the act referred to in paragraph (c) of subsection (8) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by the said paragraph (c) may—

- (a) authorise that act to be done by any partner of that person for the time being in that business, and
- (b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(11) Where a product is disposed of by any person to another person in exercise of a right conferred by paragraph (c) of subsection (8) or by subsection (10), that other

person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.”.

Amendment after grant (section 38 of Principal Act).

11.—Section 38 of the Principal Act is amended by inserting the following after subsection (6):

“(7) In considering whether or not to allow an amendment proposed under this section the Court or the Controller shall have regard to any relevant principles applicable under the European Patent Convention.”.

Limitation of effect of patent (section 42 of Principal Act).

12.—Section 42 of the Principal Act is amended—

(a) in paragraph (d), by the insertion after “the Union of Paris for the Protection of Industrial Property” of “or in any of the members of the World Trade Organisation”, and

(b) in paragraph (e), by the insertion after “the Union of Paris for the Protection of Industrial Property” of “or of members of the World Trade Organisation”.

Extent of protection (section 45 of Principal Act).

13.—Section 45 of the Principal Act is amended in subsections (1) and (2) by deleting “the terms of” in each place where it occurs.

Relief for infringement of partially valid patent (section 50 of Principal Act).

14.—Section 50 of the Principal Act is amended by inserting the following after subsection (3):

“(4) The Court may also grant relief under this section in the case of a European patent designating the State on condition that the claims are limited to the Court’s satisfaction by the European Patent Office at the request of the proprietor.”.

Remedy for groundless threats of infringement proceedings (section 53 of Principal Act).

15.—Section 53 of the Principal Act is amended by substituting the following for subsection (3):

“(3) Proceedings may not be brought under this section as regards—

(a) a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or

(b) a threat, made to a person who made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.”.

Grounds for revocation (section 58 of Principal Act).

16.—Section 58 of the Principal Act is amended by the substitution for paragraph (d) of the following:

“(d) the protection conferred by the patent has been extended by an amendment which should not have been allowed;”.

17.—Section 59 of the Principal Act is amended—

Examination of application for revocation (section 59 of Principal Act).

- (a) in subsection (3), by deleting “, under section 38,” and
- (b) by inserting the following after subsection (3):

“(4) For the purposes of subsection (3), the reference to the specification being amended is to its being amended under section 38 and also, in the case of a European patent designating the State, to its being amended under any provision of the European Patent Convention under which the claims of the patent may be limited by amendment at the request of the proprietor.”.

18.—Section 68 of the Principal Act is amended in paragraph (c) of subsection (2) by the substitution for “(otherwise than by the importation of goods)” of “(otherwise than by the importation of goods from a country which is not a member of the World Trade Organisation)”.

Application for entry in register that licences of right are available (section 68 of Principal Act).

19.—Section 70 of the Principal Act is amended by the substitution for that section of the following:

Compulsory licences (section 70 of Principal Act).

“Compulsory licences.

70.—(1) At any time after the expiration of the period of three years, or such other period as may be prescribed, beginning on the date of the publication of notice of grant of a patent any person may apply to the Controller for a licence under the patent, or for an entry in the register to the effect that licences under the patent are to be available as of right, on any or all of the following grounds:

(a) that—

- (i) a demand in the State for the subject matter of the patent is not being met or is not being met on reasonable terms, or
- (ii) a demand in the State for a product which is protected by the patent is being met by importation other than from a member of the World Trade Organisation;

(b) that the establishment or development of commercial or industrial activities in the State is unfairly prejudiced.

(2) If an invention protected by a patent (in this section referred to as ‘the second patent’) cannot be exploited in the State without infringing rights deriving from another patent (in this section referred to as ‘the first patent’) the proprietor of the second patent may apply to the Controller for a licence under the first patent to the extent necessary for the exploitation of the invention concerned, provided that such invention involves an

important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

(3) Where an application is made under this section, if the Controller is satisfied—

- (a) that any of the grounds specified in subsection (1) are established, or
- (b) that an invention protected by a patent cannot be exploited without infringing rights deriving from the first patent as referred to in subsection (2),

the Controller may make an order in accordance with the application and, where the order is for the grant of a licence, the order may require the licence to be granted upon such terms as the Controller thinks fit, provided that:

- (i) any licence granted shall be non-exclusive;
- (ii) any licence granted shall be predominantly for the supply of the market in the State;
- (iii) any licence granted may only be assigned with the prior authorisation of the Controller and with that part of the enterprise or goodwill which uses the patented invention and, in the case of a licence granted on an application under subsection (2) in respect of the first patent, the licence may only be assigned by the proprietor of the second patent in conjunction with the assignment of the second patent;
- (iv) a licence shall only be granted subject to the payment to the proprietor of the patent of adequate remuneration in the circumstances of the case, taking into account the economic value of the licence;
- (v) the scope and duration of the licence shall be limited to the purpose for which it is granted;
- (vi) any licence granted on an application under subsection (1) in respect of a patent which relates to semi-conductor technology shall only be for public non-commercial use;
- (vii) no order shall be made on an application under subsection (2) unless the proprietor of the second patent is able and willing to grant the proprietor of the first patent and the licensee of that

proprietor a cross-licence, on reasonable terms, to use the invention claimed in the second patent.

(4) The Controller shall, in determining whether to make an order pursuant to an application under this section, take account of the following matters, namely—

- (a) the nature of the relevant invention, the time which has elapsed since the grant of the patent and the measures already taken by the proprietor 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 exploit the patent to the public advantage, and
- (c) the risks to be undertaken by that person in providing capital and exploiting the patent if the application is granted.

(5) Section 68(3) shall apply to a licence granted pursuant to an order under this section as it applies to a licence granted by virtue of section 68.”.

20.—Section 71 of the Principal Act is amended by the substitution for that section of the following section:

Provisions as to compulsory licences (section 71 of Principal Act).

“Provisions as to compulsory licences.

71.—(1) Where an order for the grant of a licence or for an entry in the register has been made pursuant to an application under section 70, any person may apply to the Controller to amend or cancel the order on the grounds that the circumstances which led to the order have changed or have ceased to exist and are unlikely to recur.

(2) Where the Controller is satisfied that the circumstances referred to in subsection (1) have changed or have ceased to exist and are unlikely to recur, the Controller may order the amendment or cancellation of the existing order upon such terms as the Controller thinks fit, including, in particular, terms which provide for the protection of the interests of the licensee concerned.

(3) Section 73 shall, in so far as it is applicable, apply in relation to an application under subsection (1).

(4) Where, following an application under subsection (1), an order is amended, subsections (1), (2) and (3) shall, in so far as they are applicable, apply in relation to the order so amended.”.

Procedure on applications under sections 70 and 72 (section 73 of Principal Act).

21.—Section 73 of the Principal Act is amended—

- (a) in subsection (1), by the insertion after “upon which the application is based” of “and shall be accompanied by evidence indicating that the applicant sought to obtain a licence from the proprietor of the patent but has been unable to obtain such a licence on reasonable terms and within a reasonable time”, and
- (b) after subsection (1), by the insertion of the following:

“(1A) The Controller may, when so requested by the applicant, dispense with the evidence referred to in subsection (1)—

- (a) where there exists a national emergency or other circumstances of extreme urgency, or
- (b) in the case of an application for a licence for public non-commercial use:

Provided that the proprietor of the relevant patent has been informed as soon as reasonably practicable of the intention of the applicant to apply to the Controller for a licence under the patent.”.

Appeals and references to arbitrator (section 74 of Principal Act).

22.—Section 74 of the Principal Act is amended in subsection (1) by the substitution for “section 70 or 72” of “section 70, 71 or 72”.

Supplementary provisions as to licences (section 75 of Principal Act).

23.—Section 75 of the Principal Act is amended—

- (a) in subsections (2) and (3), by the substitution for “section 70 or 72” of “section 70, 71 or 72” in each place it occurs, and
- (b) in subsection (3), by the insertion after “European Economic Community” of “or with the TRIPs Agreement”.

Evidence before Controller (section 92 of Principal Act).

24.—Section 92 of the Principal Act is amended in subsection (3) by inserting “or by any other enactment” after “by this Act”.

Appeals from decisions of Controller (section 96 of Principal Act).

25.—Section 96 of the Principal Act is amended in subsection (6)—

- (a) by renumbering that subsection as paragraph (a) of that subsection,
- (b) by inserting “and subject to paragraph (b)” after “this Act”, and
- (c) by inserting the following paragraph:

“(b) Where a written statement of the grounds of the order or decision of the Controller, in the exercise of his discretionary power, has been requested in the prescribed manner and within the prescribed period by a party to the proceedings, the period of three months shall begin on the date on which the written statement is furnished to the party requesting it.”.

26.—Section 110 of the Principal Act is amended—

Correction of errors
(section 110 of
Principal Act).

(a) by inserting the following after subsection (2):

“(2A) Where the Controller is requested to correct an error or mistake in a withdrawal of an application for a patent, which application was published under section 28 and details of the withdrawal were published by the Controller, the Controller shall publish notice of the request in the Journal.

(2B) Where the Controller has published a notice in accordance with subsection (2A) any person may within a prescribed period give notice to the Controller of opposition to the request.

(2C) If notice of opposition is given under subsection (2B), the Controller shall notify the person who made the request and shall determine the matter.

(2D) Where the Controller decides to allow a request under this section to correct an error or mistake in a withdrawal of an application for a patent and notice of the request was published in the Journal under subsection (2A), the Controller shall make an order restoring the application and publish notice of the restoration in the Journal.”,

and

(b) in subsection (3), by inserting “other than a request to correct an error or mistake in a withdrawal of an application for a patent referred to in subsection (2A),” after “subsection (1),”.

27.—The Principal Act is amended by inserting the following section after section 110:

Effect of restoring a
withdrawn
application under
section 110 of the
Principal Act.

“Effect of
restoring a
withdrawn
application
under section
110.

110A.—(1) Where—

- (a) the Controller is requested to correct an error or mistake in a withdrawal of an application for a patent, and
- (b) an application for a patent has been restored in accordance with that request,

the following provisions apply:

- (i) anything done under or in relation to the application during the period between the application being withdrawn and its restoration shall be treated as valid;
- (ii) where the Controller has published notice of the request referred to in section 110(2A), anything done during the period referred to in subparagraph (i) which would have constituted an infringement of the rights conferred by

publication of the application if the application had not been withdrawn shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights;

(iii) where the Controller has published notice of the request referred to in section 110(2A) and, after the withdrawal of the application and before publication of the notice, a person—

(I) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the withdrawal had not taken place, or

(II) made, in good faith, effective and serious preparations to do such an act,

the person shall have the rights conferred by subsection (2).

(2) The person referred to in subsection (1)(iii) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the application and the grant of the patent.

(3) Subsection (2) does not extend to granting a licence to any person to do an act referred to in subsection (1)(iii).

(4) If the act referred to in subsection (1)(iii) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (2) may—

(a) authorise that act to be done by any partner of that person for the time being in that business, and

(b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(5) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (2) or (4) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.”

28.—The Principal Act is amended by inserting the following section after section 118 but in Part XI:

Extension of time limits specified by Controller.

“Extension of time limits specified by Controller.

118A.—(1) If an applicant for, or proprietor of, a patent fails to observe any time limit specified by the Controller the applicant or proprietor may request an extension of time in accordance with the prescribed requirements.

(2) Subject to subsections (5) and (6), the Controller shall grant the request, provided that the prescribed requirements are complied with.

(3) An extension of a time limit granted under subsection (2) shall expire at the end of the period prescribed for the purposes of this section.

(4) If the request for an extension of time is granted, the legal consequences of the failure to observe the time limit specified by the Controller shall be deemed not to have ensued.

(5) Where a time limit has been extended under subsection (2) any further request for an extension of time may be granted by the Controller subject to the conditions that the Controller sees fit.

(6) This section does not apply to proceedings before the Controller pursuant to Part VIII.”.

29.—Section 119 of the Principal Act is amended—

Effect of European patent (section 119 of Principal Act).

(a) in subsection (2), by inserting “, limitation” after “amendment”,

(b) in subsection (4)—

(i) by inserting “, limited” after “amended” and

(ii) by inserting “or limitation” after “amendment”,

(c) in subsection (5)—

(i) by substituting the following for paragraph (a):

“(a) under the European Patent Convention a European patent designating the State—

(i) is revoked for failure to observe a time limit and is subsequently restored, or

(ii) is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal,

and”,

and

(ii) by substituting “the person shall have the rights conferred by subsections (8)(c) and (10) of section 37

and subsections (9) and (11) of that section shall apply accordingly.” for “he shall have the same protection as if an order had been made under section 37(7).”.

and

(d) in subsection (6)(b)—

- (i) by inserting “or a limitation” after “amendment”, and
- (ii) by inserting “or limited” after “amended”.

Restoration where translation not filed under section 119(6).

30.—The Principal Act is amended by inserting the following section after section 119:

“Restoration where translation not filed under section 119(6).

119A.—(1) Where a translation of the specification concerned is not filed within the period prescribed under section 119(6), an application may be made to the Controller to restore the effect of section 119(1).

(2) An application under this section shall contain a statement (to be verified in the manner that may be prescribed) setting out the circumstances which led to the failure to file the translation referred to in subsection (1), and the Controller may require from the applicant any further evidence that he considers necessary.

(3) An application under this section shall be accompanied by the translation together with the prescribed fee.

(4) An application under this section shall be made within the prescribed period and shall be accompanied by the prescribed application fee.

(5) Where the Controller is satisfied that reasonable care was taken to ensure that the translation was filed within the period prescribed under section 119(6), the Controller shall advertise the application in the Journal, and within the prescribed period any person may give notice to the Controller of opposition thereto.

(6) Where notice of opposition is duly given under this section, the Controller shall notify the applicant and determine the issue.

(7) Where the Controller decides to allow an application under this section, he shall make a restoration order and publish notice of the restoration in the Journal.

(8) Where, in the period between the expiration of the prescribed period under section 119(6) for filing a translation and the date on which the application under this section was published in the Journal, a person—

- (a) began in good faith to do an act which would have constituted an infringement of the rights conferred by the patent had it been in force, or
- (b) made, in good faith, effective and serious preparations to do such an act,

subsections (8A) to (8D) shall apply.

(8A) The person referred to in subsection (8) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the restoration of the effect of section 119(1).

(8B) Subsection (8A) does not extend to granting a licence to any person to do an act referred to in subsection (8).

(8C) If the act referred to in subsection (8) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (8A) may—

- (a) authorise that act to be done by any partner of that person for the time being in that business, and
- (b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(8D) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (8A) or (8C) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

(9) Where the Controller refuses an application under this section, the patent shall be treated as always having been void.

(10) Where a restoration order is made by the Controller, a translation filed under subsection (3) shall be published.”.

31.—Section 120 of the Principal Act is amended—

- (a) by substituting the following for subsection (4):

“(4) Subsections (1), (2) and (3) shall cease to apply to an application for a European patent designating the State, except as provided for in subsection (4A), if—

Effect of filing application for European patent (section 120 of Principal Act).

- (a) the application is refused or withdrawn or deemed to be withdrawn, or
- (b) the designation of the State in the application is withdrawn or deemed to be withdrawn,

but shall apply again if the rights of the applicant are re-established under the European Patent Convention, as from the re-establishment of those rights.”,

(b) by inserting the following after subsection (4):

“(4A) (a) The occurrence of any of the events referred to in subsection (4)(a) or (b) shall not affect the continued operation of section 11(3) in relation to matter contained in an application for a European patent designating the State which by virtue of that provision has become part of the state of the art as regards other inventions.

(b) The occurrence of any of the events mentioned in subsection (4)(b) shall not prevent matter contained in the application for a European patent designating the State becoming part of the state of the art by virtue of section 11(3) as regards other inventions, where the event occurs before the publication of that application.

(c) Paragraph (b) shall apply only to European patents and European patent applications filed after the coming into operation of that paragraph.”,

(c) by substituting the following for subsection (5):

“(5) Where between the cesser, by virtue of subsection (4), of subsections (1), (2) and (3) as regards an application for a European patent and the re-establishment of the rights of the applicant, a person begins in good faith to do an act which would, apart from section 77, constitute an infringement of the rights conferred by publication of the application if subsections (1), (2) and (3) then applied, or makes in good faith effective and serious preparations to do such an act, subsections (5A) to (5D) shall apply.

(5A) The person referred to in subsection (5) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding subsections (1) to (3) applying again and notwithstanding the grant of the patent.

(5B) Subsection (5A) does not extend to granting a licence to any person to do an act referred to in subsection (5).

(5C) If the act referred to in subsection (5) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (5A) may—

- (a) authorise that act to be done by any partner of that person for the time being in that business, and
- (b) assign the right, or transmit that right on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(5D) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (5A) or (5C) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the applicant.”,

and

- (d) by substituting the following for subsection (7):

“(7) (a) An application for a European patent may be filed at the Office. The Office shall forward an application to the European Patent Office within the time specified in the Implementing Regulations to the European Patent Convention.

- (b) This provision shall not apply in respect of an application which is a European divisional application under the European Patent Convention.”.

32.—Section 121 of the Principal Act is amended—

Authentic text of European patents and patent applications (section 121 of Principal Act).

- (a) in subsection (4), by substituting “subsections (5) to (8) shall apply.” for “he shall have the same protection as if an order had been made under section 37(7).”,
- (b) by inserting the following subsections after subsection (4):

“(5) The person referred to in subsection (4) shall have the right to continue to do the act concerned or, as the case may be, to do that act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent.

(6) Subsection (5) does not extend to granting a licence to any person to do an act referred to in subsection (4).

(7) If the act referred to in subsection (4) was done, or the preparations were made to do it, in the course of a business, the person entitled to the right conferred by subsection (5) may—

- (a) authorise that act to be done by any partner of that person for the time being in that business, and
- (b) assign the right, or transmit that right on death (or in the case of a body corporate on its

dissolution), to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it.

(8) Where a product is disposed of by any person to another person in exercise of a right conferred by subsection (5) or (7) that other person and any person claiming through that other person shall be entitled to deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent or the applicant, as the case may be.”.

Conversion of European patent application (section 122 of Principal Act).

33.—Section 122 of the Principal Act is amended in subsection (1) by substituting “Where an application designating the State is deemed withdrawn under the provisions of the European Patent Convention because it has not been forwarded to the European Patent Office in due time,” for “Where under the European Patent Convention an application for a European Patent designating the State is deemed to have been withdrawn because it has, not within the period required by the said Convention, been received by the European Patent Office,”.

Transitional provisions (First Schedule to Principal Act).

34.—The First Schedule to the Principal Act is amended by the repeal of paragraph 4.

Directions referred to in section 45(3) (Second Schedule to Principal Act).

35.—The Principal Act is amended by substituting the following for the Second Schedule:

“SECOND SCHEDULE

DIRECTIONS REFERRED TO IN SECTION 45(3)

General principles

Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of certainty for third parties.

Equivalents

For the purpose of determining the extent of protection conferred by a patent, due account shall be taken of any element which is equivalent to an element specified in the claims.”.

36.—The Patents (International Arrangements) Order, 1996 (S.I. No. 38 of 1996), and the Patents Act 1964 (Section 93) (Declaration Order), 1976 (S.I. No. 314 of 1976), are revoked. Revocation.

37.—Section 2 of the 1996 Act is amended in subsection (1) by inserting the following after the definition of “the Act of 1963”:

Interpretation
(section 2 of 1996
Act).

“ ‘Agreement establishing the World Trade Organisation’ has the meaning assigned by section 60;”.

38.—Section 10 of the 1996 Act is amended by substituting the following for subsection (3):

Relative grounds
for refusal of
registration (section
10 of 1996 Act).

“(3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”.

39.—Section 14 of the 1996 Act is amended by substituting the following for subsection (3):

Infringement of
registered trade
mark (section 14 of
1996 Act).

“(3) A person shall infringe a registered trade mark if that person uses in the course of trade in relation to goods or services a sign which is identical with or similar to the trade mark where the trade mark has a reputation in the State and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.”.

40.—Section 25 of the 1996 Act is amended—

Infringing goods,
material or articles:
powers of seizure
and search (section
25 of 1996 Act).

(a) by substituting the following for subsection (2):

“(2) If a Judge of the District Court is satisfied by information on oath that there is reasonable ground for suspecting that infringing goods, material or articles are on any premises or place in the course of business or otherwise for the purpose of dealing in any way, the Judge may grant a search warrant authorising a member of the Garda Síochána, accompanied by such other members of the Garda Síochána or other person or persons as that member thinks proper, at any time or times within 28 days from the date of the issue of the warrant on production, where requested, of that warrant, to enter and search the premises or place specified in the warrant using reasonable force where necessary, and to do all or any of the following acts:

- (a) to seize any such goods, material or articles;
- (b) to make an inventory or prepare other evidence of infringement of a registered trade mark or potential infringement of a registered trade mark;
- (c) to seize anything found there which that member believes on reasonable grounds may

be required to be used in evidence in any proceedings brought in respect of an offence under this Act;

(d) to require any person found there to give his or her name and address.”,

(b) by inserting the following after subsection (2):

“(2A) A warrant issued under this section may authorise persons, including the registered proprietor or his or her designated representative, to accompany and assist any member of the Garda Síochána in executing the warrant or in collating any inventory or other evidence.”,

and

(c) in subsection (4), by inserting “or place” after “premises”.

Registration of transactions affecting registered trade mark (section 29 of 1996 Act).

41.—Section 29 of the 1996 Act is amended in subsection (2) by inserting the following after paragraph (c):

“(ca) matters arising from the operation of law which affect the proprietorship of a registered trade mark;”.

Claim to priority from other relevant overseas application (section 41 of 1996 Act).

42.—Section 41 of the 1996 Act is amended in subsection (2) by inserting “, or the successor in title to such a person,” after “on a person”.

The Paris Convention (section 60 of 1996 Act).

43.—Section 60 of the 1996 Act is amended in subsection (1)—

(a) in paragraph (a), by deleting “and”,

(b) by inserting the following after paragraph (a):

“(aa) “Agreement establishing the World Trade Organisation” means the Agreement establishing the World Trade Organisation done at Marrakesh on 15 April 1994, as amended or supplemented by any protocol to that Agreement which is for the time being in force in the State;”,

and

(c) in paragraph (b), by substituting “the Paris Convention or the Agreement establishing the World Trade Organisation” for “that Convention”.

Appeals from the Controller (section 79 of 1996 Act).

44.—Section 79 of the 1996 Act is amended by substituting the following for subsection (1):

“(1) (a) Save as otherwise provided by this Act and subject to paragraph (b), except by leave of the Court, an appeal shall lie to the Court from a decision of the Controller under this Act within three months from the date of the decision.

(b) Where a written statement of the grounds of the decision of the Controller, in the exercise of his discretionary power, has been requested in the prescribed manner and within the prescribed period by a party to the proceedings, the period of three months shall begin on the date on which the written statement is furnished to the party requesting it.”.

45.—Each provision of the 1996 Act specified in *column (1)* of the Table to this section is amended as specified in *column (2)* of that Table opposite the mention of that provision in *column (1)*.

Agreement establishing the World Trade Organisation – consequential amendments to 1996 Act.

TABLE

Provisions Affected (1)	Amendment (2)
Sections 11(1)(c), 60(2), 61(1) and (2), 62(2) and (3) and 63(2)	Insert “or the Agreement establishing the World Trade Organisation” after “the Paris Convention” in each place where it occurs.
Section 64	Insert the following subsection after subsection (4): “(5) A reference in this section to Article 6ter of the Paris Convention shall be read as a reference to that Article as applied by the Agreement establishing the World Trade Organisation.”.

46.—The Third Schedule to the 1996 Act is amended by inserting the following after paragraph 15:

Transitional provisions (Third Schedule to 1996 Act).

“Transitional Provisions

16. The amendment effected by *section 45* of the *Patents (Amendment) Act 2006* to section 61(2) shall not affect the continuation of any bona fide use of a trade mark begun before 1 January 1996.

17. The amendment effected by *section 43(c)* of the *Patents (Amendment) Act 2006* and the amendment effected by *section 45* of the said Act to section 63 shall not affect the rights of a person whose bona fide use of a trade mark to which section 63 applies and which is protected under the Agreement establishing the World Trade Organisation began before 1 January 1996.”.

47.—The Copyright and Related Rights Act 2000 is amended by inserting the following after section 364:

Costs of Controller in proceedings.

“Costs of Controller in proceedings.

364A.—In any proceedings before any court under this Act, the Controller shall not be awarded or be ordered to pay costs.”.

48.—Subsection (2) of section 367 of the Copyright and Related Rights Act 2000 is repealed.

References of dispute to arbitrator (section 367 of Copyright and Related Rights Act 2000).

Infringement actionable by registered proprietor (section 57 of Industrial Designs Act 2001).

49.—Section 57 of the Industrial Designs Act 2001 is amended by substituting the following for subsection (2):

“(2) Notwithstanding sections 29 and 43—

- (a) no infringement proceedings may be begun before the date of publication of the registration of the design, and
- (b) no offence shall be regarded as committed under section 66 by anything done before the date referred to in paragraph (a).”.

Appeals (section 84 of Industrial Designs Act 2001).

50.—Section 84 of the Industrial Designs Act 2001 is amended by substituting the following for subsection (1):

- “(1) (a) Save as otherwise provided by this Act and subject to paragraph (b), except by leave of the High Court, an appeal lies to the High Court from any decision or order of the Controller under this Act within 3 months from the date of the decision or order.
- (b) Where a written statement of the grounds of the decision or order of the Controller, in the exercise of his or her discretionary power, has been requested in the prescribed manner and within the prescribed period by a party to the proceedings, the period of 3 months shall begin on the date on which the written statement is furnished to the party requesting it.”.

Short title and commencement.

51.—(1) This Act may be cited as the Patents (Amendment) Act 2006.

(2) Subject to *subsection (3)*, this Act shall come into operation on such day or days as the Minister may appoint by order or orders either generally or with reference to any particular purpose or provision and different days may be so appointed for different purposes or different provisions of this Act.

(3) This section and *sections 1, 2(a), (f) and (g), 7, 10, 12, 15, 16, 18 to 25, 29(c)(ii), 31(c), 32, 34, 36 to 40 and 42 to 50* shall come into operation on the passing of this Act.