



STATUTORY INSTRUMENTS

S.I. No. 194 of 2009



PATENTS (AMENDMENT) RULES 2009

(Prn. A9/0710)

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I, MARY COUGHLAN, Minister for Enterprise, Trade and Employment, in exercise of the powers conferred on me by section 114 and, with the sanction of the Minister for Finance, section 99 of the Patents Act 1992 (No. 1 of 1992), hereby make the following Rules:

1. These Rules may be cited as the Patents (Amendment) Rules 2009.

2. In these Rules—

“Act” means Patents Act 1992 (No. 1 of 1992);

“Rules of 1992” means Patents Rules 1992 (S.I. No. 179 of 1992).

3. The Rules of 1992 are amended—

(a) in Rule 3—

(i) in paragraph (1), by substituting “ ‘Form’ means a form set out in Schedule II;” for “ ‘Form’ means a form set out in Schedule II.”, and by inserting after that definition the following definition:

“ ‘Implementing Regulations’ means the Implementing Regulations to the European Patent Convention.”,

and

(ii) by substituting the following for paragraph (2):

“(2) In these Rules, unless otherwise indicated—

(a) a reference by number to a Rule is to the Rule of these Rules bearing that number, and a reference to a paragraph or other division, by whatever name called, shall be read as a reference to a paragraph or other such division of the Rule or of the provision, as the case may be, in which the reference occurs,

(b) a reference by number to a section is to the said numbered section of the Act.”,

Notice of the making of this Statutory Instrument was published in “Iris Oifigiúil” of 26th May, 2009.

(b) by substituting the following for paragraph (1) of Rule 6:

“(1) Subject to the provisions of Rules 86 (1) and (2), if the applicant is not the sole inventor or the applicants are not the joint inventors, the statement under section 17(2) identifying the inventor or inventors and, where required by section 17(2)(b), the derivation of the right of the applicant or applicants to be granted the patent shall be made on Form No. 2 within the period of sixteen months after the date of priority or, where there is no claim to priority, the date of filing the application.”,

(c) by inserting the following Rules after Rule 8:

“Name and address of applicant.

8A. (1) Where the documents filed at the Patents Office under section 23(1)(b) do not include the applicant’s name and address, the Controller shall notify the applicant that same are required.

(2) Where the applicant has been notified under paragraph (1), he, she, they or it shall, before the end of the period of two months starting on the date of the notification, file his, her, their or its name and address; otherwise the Controller shall, subject to paragraph (3), refuse the application.

(3) On a request made to him or her at any time within the period referred to in paragraph (2), the Controller may further extend, by not more than one month, the said period.

Prescribed period for payment of filing fee — section 18(3).

8B. (1) The prescribed filing fee shall be paid within one month from the date of filing.

(2) Where the filing fee has not been paid within the period in paragraph (1) the Controller shall invite the applicant to pay the filing fee together with the prescribed additional fee within one month from the invitation.”,

(d) by inserting the following Rules after Rule 10:

“Translation of description.

10A. (1) Where—

(a) the documents filed at the Patents Office under section 23(1)(c)(i) include a description of the invention in a language other than Irish or English, and

(b) the applicant has not filed a translation into Irish or English of that description with a declaration that it is a complete and accurate translation into Irish or English of that description,

the Controller shall notify the applicant that such a translation with such a declaration is required.

(2) Where the applicant has been notified under paragraph (1), he, she, they or it shall, before the end of the period of two months starting on the date of the notification, file a translation of that description with a declaration; otherwise the Controller shall, subject to paragraph (3), refuse the application.

(3) On a request made to him or her at any time within the period referred to in paragraph (2), the Controller may further extend, by not more than one month, the said period.

Reference under section 23(1)(c)(ii).

10B. (1) A reference made under section 23(1)(c)(ii) shall include—

- (a) the date of filing of the earlier relevant application,
- (b) its application number, and
- (c) the state in or for which it was made.

(2) Subject to paragraph (3), the copy of the application provided under section 23(9)(c)(ii) (inserted by section 6 of the Patents (Amendment) Act 2006) shall—

- (a) be duly certified by the authority with which it was filed, and
- (b) where it is in a language other than Irish or English, be accompanied by—
 - (i) a translation into Irish or English of that application, or
 - (ii) a declaration that the description filed under subparagraph (i) of section 23(9)(c) is a complete and accurate translation into Irish or English of the description contained in the application provided under subparagraph (ii) of that provision.

(3) Where the application or a copy of the application is kept at the Office it shall, for the purposes of section 23(9)(c)(ii), be treated as having been filed in accordance with these Rules.

(4) Subject to paragraph (5), the prescribed period for the purpose of section 23(9)(c)(i) and (ii) is 4 months starting on the date of filing of the application.

(5) Where a divisional application is filed or a new application is filed under section 81 after the end of the period prescribed in paragraph (4), the period prescribed for the purposes of section 23(9)(c)(i)

and (ii) shall be two months from the date of filing of the divisional or new application, as the case may be.”,

(e) by substituting the following for Rule 14:

“Requirements relating to biological material.

14. (1) The specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material—

- (a) which is not available to the public at the date of filing of the application, and
- (b) which cannot be described in the specification in such a manner as to enable the invention to be performed by a person skilled in the art,

shall, in relation to the biological material itself, be treated for the purposes of the Act as disclosing the invention in such a manner only if one of the conditions set out in paragraph (2)(and, where applicable, the further condition where paragraph (17) applies) is or are satisfied and the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material.

(2) The conditions referred to in paragraph (1) are—

- (a) a condition that—
 - (i) not later than the actual filing date of the application, a sample (in this Rule referred to as the “deposit”) of the biological material concerned has been deposited in a depositary institution which is able to furnish a sample (in this Rule referred to as the “sample”) of the said biological material,
 - (ii) the name of the depositary institution and the accession number of the deposit are given in the specification of the application, and
 - (iii) where the deposit has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is filed satisfying the Controller that the depositor has authorised the applicant to refer to the deposit in the application and has given his, her, their or its unreserved and irrevocable consent to the deposit being made available to the public in accordance with these Rules,

and

- (b) a condition, in the case of a European patent designating the State or an application for a European patent designating the State which is treated, by virtue of sections 119 and 122 as, respectively, a patent or an application for a patent under the Act, that the corresponding provisions of the Implementing Regulations have been complied with,

and where paragraph (17) applies, a further condition that the applicant or proprietor has made a new deposit in accordance with that paragraph.

(3) Where, except in the case of a divisional application, the information specified in paragraph (2)(a)(ii) or (iii) is not contained in an application for a patent as filed, it shall be added to the application—

- (a) before the end of the sixteenth month after the date of priority or, if no priority has been claimed, the date of filing of the application,
- (b) where, on a request made by the applicant, the Controller publishes the application before the end of the period specified in section 28(1), before the date of the request,

whichever is the earliest.

(4) The giving of the information specified in paragraph (2)(a)(ii) shall constitute the unreserved and irrevocable consent of the applicant to the depository institution with which the deposit (including a deposit which is to be treated as having always been available by virtue of paragraph (17)) is from time to time deposited to the making available of a sample, on receipt of the Controller's certificate authorising the release, to the person who is named therein as a person to whom a sample may be made available and who makes a valid request therefor to the institution.

(5) The specification of an application for a patent described in paragraph (1) shall mention any international agreement under which the deposit concerned is deposited.

(6) Save where paragraphs (13) to (16) have effect, a request may (notwithstanding the revocation or cancellation of the relevant patent or the relevant application for a patent) be made to the Controller to issue a certificate authorising a depository institution to make available a sample at any time after publication of an application for a patent to any person. The request shall be made in Form No. 6 (which shall be filed in duplicate together, in the case of a sample which is deposited under the Budapest Treaty with an international depository authority, with the form provided for by the Regulations under the Budapest Treaty). The request shall be accompanied by the prescribed fee.

(7) The Controller shall send copies of the forms lodged with him or her under paragraph (6) and of his or her certificate authorising the release of the sample—

- (a) to the applicant for, or proprietor of, the patent,
- (b) to the depositary institution, and
- (c) to the person making the request.

(8) A request under paragraph (6) shall include, on the part of the person to whom the request relates, undertakings for the benefit of the applicant for, or proprietor of, the patent—

- (a) not to make the deposit, or any material derived from it, available to any other person, and
- (b) not to use the deposit, or any material derived from it, otherwise than for experimental purposes relating to the subject matter of the invention.

In this paragraph, references to material derived from a deposit are references to material so derived which exhibits those characteristics of the deposit essential for the performance of the invention.

(9) Subject as provided by this paragraph, both undertakings referred to in paragraph (8) shall have effect—

- (a) during any period before the application for a patent has been withdrawn, is deemed to be withdrawn, or is the subject of a final refusal, but excluding, if an application is reinstated, the period before it is reinstated, and
- (b) if a patent is granted on the application, during any period for which the patent is in force and during the period of six months referred to in section 36(3).

(10) For the purpose of enabling any act specified in section 77 to be done in relation to the deposit for the service of the State, the undertakings specified in paragraph (8)—

- (a) shall not be required from any Minister of the Government, whether by him or her self or by such of his or her officers, servants or agents as may be authorised in writing by him or her or any other person acting on his or her behalf for the purposes of this paragraph, and
- (b) shall not have effect in relation to any such person who has already given them.

(11) An undertaking given pursuant to paragraph (8) may be varied by way of derogation by agreement between the applicant or proprietor and the person by whom it is given.

(12) Where, in respect of a patent to which an undertaking pursuant to paragraph (8) has effect—

- (a) an entry is made in the register under section 68 to the effect that licences are to be available as of right, or
- (b) a compulsory licence is granted under section 70,

that undertaking shall not have effect to the extent necessary for effect to be given to any such licence.

(13) Where, before the preparations for publication of an application for a patent under section 28 have been completed, the applicant gives notice to the Controller on Form No. 7 of his, her, their or its intention that a sample should be made available only to an expert, the provisions of paragraphs (14) to (16) shall have effect.

(14) The following may be nominated as an expert for the purposes of this Rule—

- (a) any natural person, provided that any person wishing to have a sample made available furnishes evidence, when applying under paragraph (16), that the person nominated has the approval of the applicant for the patent, or
- (b) any natural person recognised as an expert by the President of the European Patent Office.

(15) The Controller—

- (a) shall publish with the application notice that the provisions of paragraphs (14) to (16) have effect, and
- (b) notwithstanding paragraphs (6) to (8) shall not—
 - (i) until the patent is granted, or
 - (ii) where the application has been withdrawn, is deemed to be withdrawn, or is the subject of a final refusal, for 20 years from the date on which the application was filed,

issue any certificate authorising release of a sample otherwise than under paragraphs (14) to (16).

(16) (a) Any person wishing to have a sample made available (“the requester”) shall apply to the Controller in Form No. 8 (which shall be filed in duplicate together, in the case of a deposit which is deposited under the Budapest Treaty with

an international depositary authority, with the form provided for by the Regulations under the Budapest Treaty) nominating the person (“the expert”) to whom he, she, they or it wishes the sample to be made available. The requester shall at the same time file undertakings by the expert in the terms set out in paragraph (8) and shall pay the prescribed fee.

(b) The Controller shall send a copy of any form lodged with him or her under this paragraph and his or her certificate authorising the release of the sample—

- (i) to the applicant for the patent,
- (ii) to the depositary institution concerned,
- (iii) to the requester, and
- (iv) to the expert.

(17) (a) This paragraph applies where—

(i) a deposit ceases to be available from the institution with which it was deposited because—

- (I) the biological material comprising the deposit is no longer viable, or
- (II) for any other reason the institution is unable to supply samples,

or

(ii) the depositary institution—

- (I) ceases to be a depositary institution for the purposes of this Rule, either entirely or for the kind of biological material to which the deposit belongs, or
- (II) discontinues, temporarily or permanently, the performance of its functions as regards deposited biological material,

and no sample of the biological material has been transferred to another depositary institution, from which it continues to be available.

(b) An interruption in availability of the deposit shall be deemed not to have occurred if within a period of three months from the date on which the depositor was notified of the interruption by the depositary institution—

- (i) the depositor (or applicant or proprietor if different) makes a new deposit of a sample of that biological material, and
 - (ii) the applicant or proprietor makes a request for amendment of the specification under section 32 or section 38, as the case may be, so as to indicate the accession number of the new deposit and, where applicable, the name of the depositary institution with which the deposit was made.
- (c) In the case provided for in subparagraph (a)(i)(I), the new deposit shall be made with the depositary institution with which the original deposit was made; in the cases provided for in subparagraphs (a)(i)(II) and (a)(ii), it may be made with another depositary institution.
- (d) Where, in a case to which subparagraph (a)(ii) applies, no notification of the interruption of availability of the deposit from the depositary institution is received by the depositor within six months from the date of such event, the three-month period referred to in subparagraph (b) shall begin on the date on which this event is announced in the Journal.
- (e) Any new deposit shall be accompanied by a statement signed by the person making the deposit certifying that the sample of biological material newly deposited is of the same biological material as was the sample originally deposited.

(18) In this Rule—

“Budapest Treaty” means the Treaty on the International Recognition of the Deposit of Microorganisms for the purposes of Patent Procedure done at Budapest in 1977, and

“international depositary authority” means a depositary institution which has acquired the status of an international depositary authority as provided for in Article 7 of the Budapest Treaty.

(19) For the purposes of this Rule a “depositary institution” is an institution which, at all relevant times—

- (a) carries out the functions of receiving, accepting and storing biological material and the furnishing of samples thereof, and
- (b) conducts its affairs in so far as they relate to the carrying out of those functions in an objective and impartial manner.”,

(f) in Rule 15—

(i) by substituting the following for paragraph (1):

“(1) The specification, drawings and abstract making up a patent application under section 18 shall be filed in duplicate.”,

and

(ii) by substituting the following for paragraph (9):

“(9) The lines of each sheet of the description and of the claims shall be—

(a) numbered in sets of five, the numbers appearing on the left side, to the right of the margin, or

(b) separated into consecutive paragraphs, the paragraph number appearing on the left side, to the right of the margin.”,

(g) by substituting the following for Rule 18:

“Prescribed period in relation to late or non-filing of drawings.

18. The period prescribed for the purposes of section 23(6) and (7) shall be two months, calculated from the date on which the Office sends out notification to the applicant that the drawing or part of a description has been filed, later than the date which is, by virtue of section 23(1), to be treated as the date of filing of the application or, as the case may be, that it has not been filed.”,

(h) by substituting the following for Rule 19:

“Prescribed period for filing claims and abstract.

19. (1) The period prescribed for filing the claims and abstract for the purposes of section 23(9) shall be twelve months from the date of filing or, if priority has been claimed, from the date of priority.

(2) Where a divisional application is filed more than nine months after the date of filing of the earlier application or, if priority has been claimed after the date of priority of the earlier application, the period prescribed for filing the claims and abstract for the purposes of section 23(9) shall be three months from the date of filing of the divisional application.

(3) Where a new application is filed under section 81 after the end of the period of 12 months prescribed in paragraph (1), the requirements of that provision shall be complied with at the actual filing date of the new application.”,

(i) by inserting the following Rule after Rule 19:

“Prescribed requirements for a request under section 23(8)(b).

19A. (1) A request made under section 23(8)(b) shall—

(a) include sufficient information to identify where in the earlier relevant application or applications the missing part of the description or missing drawing filed under section 23(6) or (7), as the case may be, was included, and

(b) be made before the end of the period prescribed for the purpose of section 23(6) or (7), as the case may be.

(2) Any request under section 23(8)(b) shall be considered never to have been made where—

(a) the earlier relevant application or applications do not contain every missing part filed under section 23(6) or (7), as the case may be, or

(b) the applicant fails to furnish to the Office copies of all earlier relevant applications, duly certified by the authority with which they were filed, before the end of the relevant period.

(3) Paragraph (2)(b) does not apply in respect of an earlier relevant application where that application or a copy of the application is kept at the Office.

(4) In this Rule the relevant period means—

(a) the period of sixteen months starting on the declared priority date, or

(b) the period of four months starting on the date the request was made under section 23(8),

whichever first expires.

(5) This Rule applies only to applications filed after the date of the making of these Rules. Rule 19 will continue to apply to applications received prior to that date.”

(j) in Rule 20(1), by substituting “has paid” for “has been requested to pay”,

(k) by substituting the following for Rule 22:

“Declaration of priority and priority documents.

22. (1) The declaration of priority based on a previous application referred to in section 26(1) shall be made on Form No. 1 and shall indicate the date of the previous filing, the state in or for which it was made and the file number, if available.

- (2) The declaration of priority may be made subsequently provided it is made within sixteen months from the earliest priority date claimed.
- (3) The applicant may correct the declaration of priority within sixteen months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within sixteen months from the corrected earliest priority date, whichever sixteen month period expires first, provided that such a correction may be submitted not later than four months from the date of filing.
- (4) The applicant may not, however, request the addition or correction of a priority claim where the applicant has made a request under section 28(1) for early publication, unless that request for early publication is withdrawn before the technical preparations for publication of the application have been completed.
- (5) A copy of the previous application as referred to in section 26(1) shall be filed before the end of the sixteenth month after the date of priority; provided that this period may be extended by the Controller if, upon request made to him or her within one month after the expiry of the said period, accompanied by the prescribed fee, he or she thinks fit. The said copy must be certified as an exact copy of the previous application (by the authority which received the previous application) or otherwise verified to the satisfaction of the Controller, and shall be accompanied by a certificate issued by that authority stating the date of filing of the previous application.
- (6) A translation of the previous application as required under section 26(1) may only be requested where such translation would be relevant to the determination of the validity of the patent where relevant prior art has been published between the priority date and the filing date.
- (7) Where a translation is requested in accordance with paragraph (6) it must be filed within twenty one months after the date of priority.
- (8) Where the previous application is an application under the Act or an international application for a patent designating the State which is filed at the Office, the applicant may, instead of filing a copy of the previous application, request the Controller, before the end of the period referred to in paragraph (6), to include such a copy with the patent application upon payment of the prescribed fee.
- (9) Where a divisional application or a new application under section 81 is filed after the period of sixteen months referred to in paragraph (5), the requirements of paragraph (5) shall be complied with at the actual filing date of the divisional or new application, as the case may be, and where such an application is filed after the period referred to in paragraph (6), the provisions of that latter paragraph shall apply at the actual filing date of the application in question.

(10) In the case of an application which is an application for a European patent designating the State which, by virtue of section 122 is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) to (8) shall be treated as having been complied with to the extent that the requirements of Rule 52(1) to (4) and Rule 53(1) and (3) of the Implementing Regulations have been fulfilled.”,

(l) in Rule 24—

(i) by inserting after paragraph (3) the following paragraph:

“(3A) The prescribed period for section 29(3) is as follows:

(a) Two months from the date of issue of the search report to the applicant, in cases where the application has been published under section 28 or is due to be so published within two months.

(b) Eighteen months from the date of filing or, where priority has been claimed, from the date of priority, in cases where the application is not one to which subparagraph (a) applies.”,

and

(ii) by inserting after paragraph (5) the following paragraph:

“(6) The time period prescribed in paragraph (1) may be extended by the Controller by not more than three months if an application for the extension required (accompanied by the prescribed fee) is submitted to the Controller at any time within the extended period specified in the request.”,

(m) by substituting the following for Rule 26:

“Prescribed foreign states etc.

26. (1) The following foreign states are prescribed for the purpose of the statement referred to in section 30(1): the United Kingdom, Germany and any other state where a search for the application relating to the same invention has been carried out by the European Patent Office.

(2) The European Patent Convention and the Patent Cooperation Treaty are prescribed for the purpose of the statement referred to in section 30(1).”,

(n) in Rule 33(4), by substituting “within three months of the date of filing of the divisional application.” for “at the time such application is filed.”,

(o) by inserting the following Rules after Rule 33:

“Application for Reinstatement.

33A. (1) The time limit for making a request under section 35A for reinstatement shall be the earlier to expire of the following periods:

- (a) two months from the date on which the removal of the cause of non-compliance occurred, or
- (b) twelve months starting from the date the application was terminated.

(2) The request for reinstatement shall state—

- (a) the name and address of the applicant for reinstatement and the number of the patent application in question, and
- (b) the circumstances which led to the failure to comply with the time limit,

and shall be accompanied by the prescribed fee and by evidence verifying any statement made in relation to the circumstances mentioned in subparagraph (b).

(3) Where upon consideration of the evidence provided under paragraph (2) it does not appear to the Controller that a case for a reinstatement order has been made, he or she shall notify the applicant accordingly and unless within one month the applicant requests to be heard in the matter the Controller shall refuse the application.

(4) If the applicant requests a hearing within the time allowed, the Controller, after giving the applicant the opportunity to be heard, shall determine whether the request for reinstatement may proceed to advertisement in accordance with section 35A(5) or whether it shall be refused. If the application has not been published under section 28, the Controller shall determine whether the request for reinstatement should be allowed or refused.

Opposition to reinstatement of application.

33B. (1) At any time within 2 months of the advertisement of the application under section 35A(5), any person may give notice of opposition to the application.

(2) Such notice shall be furnished in duplicate and shall state—

- (a) the name and address of the opponent,
- (b) the number of the application concerned, and

(c) the ground or grounds upon which reinstatement is opposed, and shall be accompanied by the prescribed fee and a statement setting out fully the facts on which the opponent relies.

(3) Upon notice of opposition being given to him or her, the Controller shall send to the opponent a copy of the application and the accompanying evidence submitted to him or her.

(4) A copy of the notice of opposition and the statement of the opponent shall also be sent by the Controller to the applicant.

(5) Within three months of the receipt of such copies, the applicant shall, if he, she, they or it wishes to continue with the application for reinstatement, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted, and the Controller shall send a copy of the counter-statement to the opponent.

(6) The Controller may give such directions as he or she thinks fit with regard to the subsequent procedure.

(7) Where the Controller reinstates the application after a notice was published under section 35A(5) he or she shall advertise in the Journal that he or she has reinstated the application.”,

(p) by substituting the following for Rule 57:

“Change of name etc. in register.

57. (1) A request for the alteration of a name or nationality or an address or an address for service in an application for the grant of a patent or in the register shall state—

- (a) the name and address of the person making the request,
- (b) the number of the patent or application in question, and
- (c) particulars of the alteration desired,

and be accompanied by the prescribed fee.

(2) If the Controller is not satisfied that a request to alter a name or nationality may be allowed, he or she may require the submission of evidence in support of the request.

(3) If the Controller is satisfied that a request to alter a name or nationality or address or address for service may be allowed, he or she shall cause the register or application to be altered accordingly.”,

(q) by substituting the following for Rules 77 and 78:

“Days and hours of business.

77. (1) The Controller may, by notice published in the Journal, give directions specifying the days and hours of business of the Office for the transaction by the public of business under the Act or under any other Act for the administration of which the Controller is responsible.

(2) Notifications of changes in days and hours of business and of days on which the Office is not open shall be advertised in the Journal.

Excluded days.

78. (1) Whenever the last day fixed by the Act, or by these Rules, for doing any act or thing at the Office falls on any of the days on which the Office is not open (which days shall be excluded days for the purposes of the Act and these Rules), it shall be lawful to do any such act or thing on the first day which is not an excluded day next following such excluded day, or days, if two or more of them occur consecutively.

(2) Where the time for delivering any application, notice or document which the Controller has directed may be delivered in electronic form and by electronic means, expires on an excluded day, that time shall be extended to the next following day which is not an excluded day.

(3) Where an application, notice or document which the Controller has directed may be delivered in electronic form and by electronic means is received by the Office at any time before midnight on any day which is not an excluded day, that application, notice or document shall be treated as having been received by the Controller at that time and on that day.”,

(r) by inserting the following Rule after Rule 82:

“Opposition to a request to correct an error in a withdrawal of an application.

82A. (1) At any time within two months of the publication of a request under section 110(2A) any person may give notice of opposition to the request.

(2) Such notice shall be furnished in duplicate and shall state—

- (a) the name and address of the opponent,
- (b) the number of the application concerned,
- (c) the ground or grounds upon which restoration of the application is opposed,

and shall be accompanied by the prescribed fee and by a statement in duplicate setting out fully the facts upon which the opponent relies.

(3) Copies of the notice and the statement of the opponent shall be sent by the Controller to the person making the request.

(4) Within three months of the receipt of such copies, if the person making the request wishes to proceed with same, he, she, they or it shall file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted, and the Controller shall send a copy of the counter-statement to the opponent.

(5) The Controller may give such directions as he or she thinks fit with regard to the subsequent procedure.”,

(s) by inserting the following Rules after Rule 83:

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

83A. (1) The time limit for making a request under section 119A to restore the effect of section 119(1) shall be the date falling—

- (a) two months from the date of the removal of the cause of non-compliance, or
- (b) twelve months from the expiration of the period prescribed for the purpose of section 119(6),

whichever is the earliest.

(2) The request to restore the effect of section 119(1) shall contain:

- (a) the name and address of the applicant for restoration and the number of the patent in question,
- (b) the circumstances which led to the failure to comply with the time limit under section 119(6),
- (c) the translation as required under section 119(6) and the prescribed fee,

and shall be accompanied by the prescribed application fee and by evidence verifying any statement made in relation to the circumstances mentioned in subparagraph (b).

(3) Where, upon consideration of the evidence provided under paragraph (2), the Controller is not satisfied that the case for a restoration order has been made, he or she shall notify the applicant accordingly, and unless within one month the applicant requests to be heard in the matter the Controller shall refuse the application.

Opposition to restoration where translation not filed under section 119(6).

83B. (1) At any time within 2 months of the advertisement of the application for restoration under section 119A(5) any person may give notice of opposition thereto.

(2) Such notice shall be furnished in duplicate and shall state—

- (a) the name and address of the opponent,
- (b) the number of the patent concerned, and
- (c) the ground or grounds upon which the application for restoration is opposed,

and shall be accompanied by the prescribed fee and by a statement in duplicate setting out fully the facts upon which the opponent relies.

(3) Upon notice of opposition being given the Controller shall send to the opponent a copy of the said application and accompanying evidence.

(4) A copy of the notice and the statement of the opponent shall be sent by the Controller to the applicant for restoration.

(5) Within three months of the receipt of such copies, the said applicant shall, if he, she, they or it wishes to proceed with the application, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted, and the Controller shall send a copy of the counter-statement to the opponent.

(6) The Controller may give such directions as he or she thinks fit with regard to the subsequent procedure.”,

(t) by substituting the following for Rule 87(5):

“(5) In the event of failure to comply with the provisions of paragraphs (3) and (4), a late payment fee, calculated in accordance with the provisions of Rule 16. bis of the Regulations under the Patent Cooperation Treaty, shall be made to the Office in the currency of the State. The fee shall be calculated as follows:

- (i) 50% of the amount of unpaid fees which is specified in the invitation, or,
- (ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

The amount of the late payment fee shall not, however, exceed the amount of the international filing fee referred to in item 1 of the Schedule of Fees of the Regulations under the Patent Cooperation Treaty.”,

(u) by inserting the following Rule after Rule 94:

“Furnishing of documents.

94A. (1) Any application, notice or other document authorised or required under the Act or these Rules to be delivered to the Controller or any other person may be sent by post or by other means subject to such terms or conditions as may be specified by the Controller and published in the Journal.

(2) For the purposes of paragraph (1) the Controller may issue directions specifying—

- (a) the forms and documents that are to be filed or submitted using electronic means,
- (b) the manner in which any such form or document is to be filed or submitted.

(3) Where the Controller has specified that an application, notice or document may be delivered in electronic form, any requirement in these Rules for duplicate copies to be filed shall not apply.

(4) Where the Controller is required or authorised under the Act or Rules to—

- (a) send or give any notice or other document,
- (b) give any directions, or
- (c) furnish any information,

he or she may, notwithstanding any provision in these Rules to the contrary, do so by means other than by post.”,

(v) by substituting the following for Rule 95(1):

“(1) Where a document in a foreign language is filed in connection with any proceedings under the Act or these Rules, it shall, unless otherwise provided, be accompanied by a translation thereof verified to the satisfaction of the Controller. Subject to the provisions of Rule 10A, where the document is or forms part of an application for a patent, the Office shall not, in the absence of such a translation, take any further action in relation to that document, unless the Controller so directs.”,

(w) by substituting the following for Rule 98(3):

“(3) The Rules referred to in paragraph (1) are Rules 6, 8A, 8B, 10A, 10B(4) and (5), 14(3), 14(9)(b), 14(15)(b)(ii), 14(17)(b) and (d), 18, 19, 19A, 21, 22(2), (3), (6) and (7), 24(1), (3A), (4) and (6), 28(1),

29, 33(4), 33A(1), (2) and (3), 33B, 34, 39(2), 40(3), 48(2), 49(1), 52(1), 82A, 83A, 83B and 86.”,

(x) by substituting the following for Rule 98(5):

“(5) (a) Where any period of time specified or prescribed in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day certified by the Controller as being one on which there is an interruption, failure or delay in a communication service, the period shall be extended to the first day following the end of the said period of interruption, failure or delay.

(b) In this rule “communication service” means a service by which documents may be sent and delivered, and includes post and electronic communications.”,

(y) by inserting the following Rule after Rule 98:

“*Extensions of time limits specified by the Controller.*

98A. (1) A request for an extension of time under section 118A(1) shall be accompanied by the prescribed fee and be made before the end of the period prescribed for section 118A(3).

(2) The period prescribed for the purpose of section 118A(3) is two months from the date of expiry of the relevant time limit mentioned in section 118A(1).”,

(z) by correcting the following typographical errors:

(i) in Rule 64(1)(f), by substituting “lapsed” for “lapsesd”, and

(ii) in Rule 94(1), by substituting “furnished” for “burnished”,

(aa) by repealing Rules 28(3), 38, 93(2) and 99,

(ab) in Schedule I (as amended by the Patents, Trade Marks and Designs (Fees) Rules 2001 (S.I. No. 482 of 2001))—

(i) by substituting for item nos. 4 and 5 the following:

“

4.	On application for extension of time of one month for filing copy of previous application required for claiming priority — Rule 22(5).	€12.00
5.	Fee in connection with previous application filed at the Office — Rule 22(8).	€12.00

”,

and

(ii) by inserting the following items at the following item nos.:

“

1A.	Additional fee on late filing of a patent application (Rule 8B) under Part II — section 18(3). under Part III — section 63(8).	€62.50 €30.00
13A.	On request for reinstatement of a patent application (Rule 33A).	€125.00
13B.	On opposition to the reinstatement of a patent application (Rule 33B).	€12.00
44A.	On opposition to an application for the correction of an error or mistake (Rule 82A).	€12.00
45A.	On application for restoration under section 119A (Rule 83A).	€125.00
45B.	On opposition to application for restoration (Rule 83B).	€12.00
52A.	On application for an extension of time under Rule 118A(1), made within the period prescribed for the purpose of section 118A(3); for each month of extension actually granted under either or both subsections (3) and (5) of section 118A.	Nil €30.00

”

and

(ac) in Schedule II—

(i) by amending the names of the forms Nos. 6, 7 and 8 to read as follows:

“Form No. 6 Request for Controller’s Certificate authorising release of a sample of biological material Rule 14(6)

Form No. 7 Notification to Controller that a sample of biological material may be made available only to an expert Rule 14(13)

Form No. 8 Request for Controller’s Certificate authorising release of a sample of biological material to an expert Rule 14(16)”,

and

(ii) by substituting the following forms for those set out:

“

FORM **PATENTS ACT 1992 (as amended)**
NO. 1.

Reference No. of Applicant or Authorised Agent.....

REQUEST FOR THE GRANT OF A PATENT

Grant of a Full Term patent (20 year)	<input type="checkbox"/>
Grant of a Short Term patent (10 year)	<input type="checkbox"/>

1. Applicant(s) (Full name and address of each person or company applying)

Name(s)	
Address(es)	
Nationality(ies)	
Telephone(s)	
Email(s)	

2. Legal Representative

The following is authorised to act as agent in all proceedings connected with the obtaining of a patent to which this request relates and in relation to any patent granted:

Name	
Address	
Telephone	
Email	

3. Address for Service (within the EU, to which correspondence is to be sent)

If different to address at 1 or 2	
Address	
Telephone	
Email	

4. Title of Invention

--

5. Declaration of Priority (If you have filed any application(s) for the same invention within the last 12 months please enter the relevant information where a right to priority is claimed)

State	Date	Number

6. Inventor(s)

The applicant(s) is/are the sole/joint inventor(s)	YES		NO	
If no, please specify the full name(s) and address(es) of the inventor(s) below				
Name(s)				
Address(es)				
Telephone(s)				
Email(s)				

7. Statement of right to be granted a Patent

(To be completed if applicant(s) is/are not the sole inventor(s))

Please state how the applicant derived the right from the inventor to be granted a patent

By Deed of Assignment	<input type="checkbox"/>	By Contract of Employment	<input type="checkbox"/>
Other (please specify)			<input type="checkbox"/>

8. Divisional Application(s)

The following information is applicable to the present application	YES		NO	
Earlier Application No.	Filing Date of Earlier Application			

9. Items accompanying this Request

Filing fee (€)	<input type="checkbox"/>
Specification containing a description and claims	<input type="checkbox"/>
Specification containing a description only	<input type="checkbox"/>
Drawings referred to in descriptions or claims	<input type="checkbox"/>
An abstract	<input type="checkbox"/>
Copy of previous application(s) in respect of which priority is claimed	<input type="checkbox"/>
Translation of previous application in respect of which priority is claimed	<input type="checkbox"/>
Authorisation of agent	<input type="checkbox"/>
General authorisation of agent filed on a previous application	<input type="checkbox"/>
Earlier Application No.	Filing Date of Earlier Application

10. Signature

Signature	
Name in BLOCK CAPITALS	
Capacity in company	If a company state the position within the company of the person signing
Date	

FORM **PATENTS ACT 1992 (as amended)**
NO. 2.Reference No. of Applicant or
Authorised Agent.....**STATEMENT OF INVENTORSHIP AND OF RIGHT TO GRANT OF A
PATENT****1. Application Number**

--

2. Title of Invention

--

3. Declaration

I/We, the applicant(s), believe the following person(s) to be the inventor(s) of the invention which the above application relates to:			
Name			
Address			
Telephone			
Email			

4. Statement of right to be granted a patent

(To be completed if applicant(s) is/are not the sole inventor(s))

(State how the applicant derived the right from the inventor to be granted a patent)

By Deed of Assignment <input type="checkbox"/>	By Contract of Employment <input type="checkbox"/>
Other (please specify) <input type="checkbox"/>	

5. Signature

Signature	
Name in BLOCK CAPITALS	
Capacity in company	If a company state the position within the company of the person signing
Date	

FORM NO. 3.

PATENTS ACT 1992 (as amended)

CERTIFICATE OF GRANT OF A PATENT

In accordance with Section 31 of the Patents Act, it is hereby certified that a patent bearing the specification number has been granted in respect of an invention under Partof the Act, having the following particulars:

Title

Application Number

Date of Filing

Priority Date

Name of Proprietor(s)

Address of Proprietor(s)

Date of Grant

Dated this .. day of ... 20...

FORM **PATENTS ACT 1992 (as amended)**
NO. 4.

Reference No. of Applicant or Authorised Agent.....

PAYMENT OF PATENT RENEWAL FEE

1. Patent Number

2. Proprietor(s)

3. Address(es) For Service	
Telephone(s)	
Email(s)	

4. Fee

Year for which fee paid		Amount paid	

5. Name & address of person transmitting fee (if different from 2 or 3 above)

Name	
Address	
Telephone	
Email	

Signature

Date

FORM **PATENTS ACT 1992 (as amended)**
 NO. 5.

Reference No. of Applicant or Authorised Agent.....

AUTHORISATION OF PATENT AGENT

I/We

hereby appoint the following to act as my/our agent:

Name	
Address	
Telephone	
Email	

In connection with

--

Signature(s)

Name(s) in BLOCK CAPITALS	
Capacity in company	If a company state the position within the company of the person signing

Date

--

FORM **PATENTS ACT 1992 (as amended)**
NO. 6.Reference No. of Applicant or
Authorised Agent.....**REQUEST FOR CONTROLLER'S CERTIFICATE AUTHORISING THE
RELEASE OF A SAMPLE OF BIOLOGICAL MATERIAL****1. Person(s) making the request** (Full name and address of each person or company applying)

Name(s)	
Address(es)	
Telephone(s)	
Email(s)	
Capacity(ies)	

2. Application or Patent Number

--

3. Applicant or Proprietor(s) (Full name and address(es) of the applicant(s)/ proprietor(s))

Name(s)	
Address(es)	
Telephone(s)	
Email(s)	

4. Depository institution in which the biological material is deposited

Name	
Address	
Telephone	
Email	

5. Accession Number of the deposit

--

6. Declaration and undertaking

I/We, the person(s) making this request, declare that the invention disclosed in the specification of the application/patent referred to at 2 above requires for its performance the use of a biological material to which the information at 4 and 5 above relates. If a sample of the biological material is made available, I/We undertake, for the benefit of the applicant(s)/proprietor(s), not to make the sample or any sample derived from it available to any other person and not to use the sample or sample derived from it other than for experimental purposes relating to the subject matter of the invention.

I/We accordingly request that a certificate of the Controller authorising the release of a sample of the biological material be sent to me/us.

Signature(s)	
--------------	--

Name(s) in BLOCK CAPITALS	
------------------------------	--

Date

--

FORM **PATENTS ACT 1992 (as amended)**
NO. 7.Reference No. of Applicant or
Authorised Agent.....**NOTIFICATION TO CONTROLLER THAT A SAMPLE OF A
BIOLOGICAL MATERIAL MAY BE MADE AVAILABLE ONLY TO
AN EXPERT****1. Application Number****2. Depository institution in which the biological material is deposited**

Name	
Address	
Telephone	
Email	

3. Accession Number of the deposit**4. Declaration and undertaking**

I/We, applicant(s) in the above numbered application, give notice of intention that samples of the biological material identified hereunder are to be available only to experts in accordance with the provisions of Rule 14 of the Patents Rules 1992.	
Signature(s)	

Name(s) in BLOCK CAPITALS	
------------------------------	--

Date

FORM **PATENTS ACT 1992 (as amended)**
NO. 8.

Reference No. of Applicant or Authorised Agent.....

**REQUEST FOR CONTROLLER'S CERTIFICATE AUTHORISING THE
RELEASE OF A SAMPLE OF BIOLOGICAL MATERIAL TO AN
EXPERT**

1. Person(s) making the request (Full name and address of each person or company applying)

Name(s)	
Address(es)	
Telephone(s)	
Email(s)	
Capacity(ies)	

2. Application Number

--

3. Applicant(s) (Full name(s) and address(es))

Name(s)	
Address(es)	
Telephone(s)	
Email(s)	

4. Depository institution in which the biological material is deposited

Name	
Address	
Telephone	
Email	

5. Accession Number of the deposit

--

6. Expert Nominated:

Name	
Capacity	
Address	
Telephone	
Email	

7. Undertaking by Expert

<p>I verify that I am the person nominated at 6 and hereby undertake, for the benefit of the applicant(s), if a sample of the biological material is made available to me</p> <ul style="list-style-type: none"> — not to make the sample, or any sample derived from it, available to the person making this request or any other person — not to use the sample or any sample derived from it other than for experimental purposes relating to the subject matter of the invention. 	
Signature	

Name in BLOCK CAPITALS	
---------------------------	--

Date

8. Declaration

<p>I/We, the person(s) making this request, declare that the invention disclosed in the specification of the application referred to at 2 above requires for its performance the use of biological material to which the information at 4 and 5 above relates. I/We accordingly request that a certificate of the Controller authorising the release of a sample of the biological material be sent to the person nominated at 6.</p>	
Signature(s)	

Name(s) in BLOCK CAPITALS	
------------------------------	--

Date

”.

The Minister for Finance consents to the making of the foregoing Rules.



GIVEN under my Official Seal,
21st May 2009

BRIAN LENIHAN,
Minister for Finance.



GIVEN under my Official Seal,
21st May 2009

MARY COUGHLAN,
Minister for Enterprise, Trade and Employment.

EXPLANATORY NOTE

(This note is not part of the Instrument and does not purport to be a legal interpretation.)

These amendments to the Patent Rules 1992 arise from changes to primary legislation mainly related to the enactment of the Patents (Amendment) Act, 2006 along with some rules allowing for procedural changes. Certain rule amendments are necessary to allow for the commencement of some sections of the Patents (Amendment) Act 2006, in particular, the provisions relating to the Patent Law Treaty.

BAILE ÁTHA CLIATH
ARNA FHOILSIÚ AG OIFIG AN tSOLÁTHAIR
Le ceannach díreach ón
OIFIG DHÍOLTA FOILSEACHÁN RIALTAIS,
TEACH SUN ALLIANCE, SRÁID THEACH LAIGHEAN, BAILE ÁTHA CLIATH 2,
nó tríd an bpost ó
FOILSEACHÁIN RIALTAIS, AN RANNÓG POST-TRÁCHTA,
AONAD 20 PÁIRC MIONDÍOLA COIS LOCHA, CLÁR CHLAINNE MHUIRIS,
CONTAE MHAIGH EO,
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