



DÁIL ÉIREANN

BILLE NA bPAITINNÍ (LEASÚ) 1999 PATENTS (AMENDMENT) BILL 1999

LEASUITHE TUARASCÁLA REPORT AMENDMENTS

DÁIL ÉIREANN

BILLE NA bPAITINNÍ (LEASÚ) 1999 —AN TUARASCÁIL

PATENTS (AMENDMENT) BILL 1999 —REPORT

Leasuithe Amendments

1. In page 5, line 9, after “ORGANISATION” to insert “DONE AT MARRAKESH ON 15 APRIL 1994”.

—Ruairi Quinn.

2. In page 5, line 10, after “CONVENTION” to insert “DONE AT MUNICH ON THE 5TH DAY OF OCTOBER, 1973”.

—Ruairi Quinn.

3. In page 5, line 11, after “TREATY” to insert “DONE AT GENEVA ON 1 JUNE 2000”.

—Ruairi Quinn.

4. In page 5, line 28, to delete “signed” and substitute “done”.

—An tAire Fiontar, Trádála agus Fostaíochta, Ruairi Quinn.

5. In page 10, line 17, to delete “Where the application is made” and substitute “Where the application for a patent was made”.

—An tAire Fiontar, Trádála agus Fostaíochta.

6. In page 10, line 22, after “section 28” to insert the following:

“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”.

—An tAire Fiontar, Trádála agus Fostaíochta.

7. In page 11, to delete lines 25 to 27 and substitute the following:

“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.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

8. In page 11, between lines 27 and 28, to insert the following:

“(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.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

9. In page 11, to delete line 28 and substitute the following:

“(5) In this section “termination”, in relation to”.

—An tAire Fiontar, Trádála agus Fostaíochta.

10. In page 11, to delete lines 34 to 42 and substitute the following:

“(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.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

11. In page 12, line 13, to delete “infringing act.”.” and substitute “infringing act;”.

—An tAire Fiontar, Trádála agus Fostaíochta.

12. In page 12, between lines 13 and 14, to insert the following:

“(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 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.”.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

13. In page 14, to delete lines 9 to 13 and substitute the following:

“concerned, provided that such invention involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

14. In page 14, line 14, to delete “Subject as hereinafter provided, where” and substitute “Where”.

—An tAire Fiontar, Trádála agus Fostaíochta.

15. In page 14, to delete lines 26 to 28 and substitute the following:

“licence to be granted upon such terms as the Controller thinks fit, provided that:”.

—An tAire Fiontar, Trádála agus Fostaíochta.

16. In page 17, to delete lines 32 to 46 and in page 18, to delete lines 1 to 29 and substitute the following:

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

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

“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.”.”

—An tAire Fiontar, Trádála agus Fostaíochta.

17. In page 19, to delete lines 7 to 16 and substitute the following:

“(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).”.

—An tAire Fiontar, Trádála agus Fostaíochta.

18. In page 20, to delete lines 23 and 24 and substitute the following:

“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 proprietor of the patent.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

19. In page 21, between lines 17 and 18, to insert the following:

“(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.”.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

20. In page 21, between lines 29 and 30, to insert the following:

“Authentic text of European patents and patent applications.

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

- (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.”.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

21. In page 21, between lines 29 and 30, to insert the following:

“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,”.”

—An tAire Fiontar, Trádála agus Fostaíochta.

22. In page 23, line 35, to delete “signed” and substitute “done”.

—Ruairi Quinn.

23. In page 24, line 43, to delete “effect” and substitute “affect”.

—An tAire Fiontar, Trádála agus Fostaíochta.

24. In page 25, between lines 32 and 33, to insert the following:

“(2) The Patents Act 1992 and this Act may be cited together as the Patents Acts 1992 and 2006.”.

—Ruairi Quinn.

25. In page 25, to delete lines 38 to 40 and substitute the following:

“(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*, 32, 34 to 38 and 40 to 48 shall come into operation on the passing of this Act.”.

—An tAire Fiontar, Trádála agus Fostaíochta.

[**This is the appropriate reference if an earlier amendment is accepted.*]