



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

Mar a tionscnaíodh
As initiated

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Acts Referred to

Intellectual Property (Miscellaneous Provisions) Act, 1998	1998, No. 28
Patents Act, 1992	1992, No. 1
Trade Marks Act, 1996	1996, No. 6



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

BILL

entitled

5 AN ACT TO GIVE EFFECT TO CERTAIN PROVISIONS OF
THE AGREEMENT ON TRADE-RELATED ASPECTS OF
INTELLECTUAL PROPERTY RIGHTS ANNEXED TO
10 THE AGREEMENT ESTABLISHING THE WORLD
TRADE ORGANISATION AND TO GIVE FURTHER
EFFECT TO THE EUROPEAN PATENT CONVENTION
AND FOR THOSE PURPOSES TO AMEND AND
EXTEND THE PATENTS ACT, 1992, AND TO PROVIDE
FOR RELATED MATTERS.

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:

15 **1.**—In this Act “Principal Act” means the Patents Act, 1992, as Definition.
amended by the Trade Marks Act, 1996, and the Intellectual Prop-
erty (Miscellaneous Provisions) Act, 1998.

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

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

25 “‘Agreement establishing the World Trade Organisation’
means the Agreement establishing the World Trade
Organisation signed at Marrakesh on the 15th day of
April, 1994;”,

(b) by the insertion after the definition of “the Journal” of the
following:

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

and

(c) by the insertion after the definition of “the Treaty” of the
following:

“‘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 hereby amended in subsection (5) by the substitution for “the European Patent Convention as amended by any international treaty, convention or agreement to which the State is or proposes to become a party” of “any amendment of the European Patent Convention”. 5

Exceptions to patentability (section 10 of Principal Act).

4.—Section 10 of the Principal Act is hereby amended in paragraph (a) by the substitution for “publication or exploitation” of “commercial exploitation”. 10

Priority right (section 25 of Principal Act).

5.—Section 25 of the Principal Act is hereby amended—

(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”, 15

(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 20

(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.”. 25

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

6.—Section 42 of the Principal Act is hereby 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 30

(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”. 35

Grounds for revocation (section 58 of Principal Act).

7.—Section 58 of the Principal Act is hereby 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;”.

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

8.—Section 68 of the Principal Act is hereby 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)”. 40

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

Compulsory
licences (section 70
of Principal Act).

“Compulsory
licences.

5 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—

15 (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

20 (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.

25 (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:

30 Provided that such invention involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

35 (3) Subject as hereinafter provided, where an application is made under this section, if the Controller is satisfied—

40 (a) that any of the grounds specified in subsection (1) are established, or

45 (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),

50 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; 5
 - (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; 10 15
 - (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; 20
 - (v) the scope and duration of the licence shall be limited to the purpose for which it is granted; 25
 - (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; 30
 - (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. 35
- (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— 40
- (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, 45
 - (b) the ability of any person to whom a licence would be granted under the 50

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.”.

10 **10.**—Section 71 of the Principal Act is hereby 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.

15 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.

20 (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.

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

30 (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.”.

11.—Section 73 of the Principal Act is hereby amended—

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

35 (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

40 (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)—

45 (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).

12.—Section 74 of the Principal Act is hereby 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).

13.—Section 75 of the Principal Act is hereby 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.”.

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

14.—Section 119 of the Principal Act is hereby amended by the substitution for subsections (6), (7) and (8) of the following:

“(6) (a) Subsection (1) shall not apply to a European patent designating the State and whose specification was published in French or German, unless a translation in English of the specification is made available in such form and manner and within such period as may be prescribed by the Minister in rules made under this Act.

(b) Subsection (4) shall not apply to an amendment made in French or German unless a translation in English of the specification as amended is made available in such form and manner and within such period as may be prescribed by the Minister in rules made under this Act.

(c) The Minister may prescribe, in rules made under this Act, a fee to be paid—

(i) when a translation is made available under paragraph (a) or (b), or

(ii) within a specified period after such a translation is made available under paragraph (a) or (b),

and the form and manner in which such fee is to be paid.

(7) Where, in accordance with subsection (6), a translation is not made available, or any prescribed fee is not paid, the patent shall be treated as always having been void.

(8) The Minister may make rules in respect of the publication of translations made available under subsection (6).”.

- 5 **15.**—Section 120 of the Principal Act is hereby amended in subsection (3) by the insertion of the following proviso to paragraph (d):
- “Provided that the application shall be considered as comprised in the state of the art under section 11(3) only if the designation fee in respect of the State under the European Patent Convention has been validly paid;”.
- Effect of filing application for European patent (section 120 of Principal Act).
- 16.**—The First Schedule to the Principal Act is hereby amended by the repeal of paragraph 4.
- Transitional provisions (First Schedule to Principal Act).
- 10 **17.**—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 hereby revoked.
- Revocation.
- 18.**—(1) This Act may be cited as the Patents (Amendment) Act, 1999.
- Short title, collective citation and commencement.
- 15 (2) The Patents Act, 1992, section 75 of the Trade Marks Act, 1996, sections 4 and 5 of the Intellectual Property (Miscellaneous Provisions) Act, 1998, and this Act may be cited together as the Patents Acts, 1992 to 1999.
- (3) Section 14 of this Act shall come into operation on such day as the Minister may by order appoint.