



STATUTORY INSTRUMENTS.

**S.I. No. 206 of 2017**



PATENTS (AMENDMENT) RULES 2017

## PATENTS (AMENDMENT) RULES 2017

I, MARY MITCHELL O'CONNOR, Minister for Jobs, Enterprise and Innovation, in exercise of the powers conferred on me by section 114 of the Patents Act 1992 (No. 1 of 1992), hereby make the following Rules:

1. These Rules may be cited as the Patent (Amendment) Rules 2017.

2. In these Rules—

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

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

3. The Rules of 1992 are amended—

(a) by substituting the following for Rule 24:

“24. (1) The request to the Controller by the applicant to cause a report incorporating a written opinion as to patentability to be prepared under section 29 (1) (“the section 29 report and opinion”) shall be accompanied by the prescribed fee and shall be submitted not later than twenty one months from the date of filing of the application or, if priority has been claimed, from the date of priority; provided that where the application is a divisional application filed on or after the expiry of twenty one months from the date of filing (or date of priority as the case may be) of the earlier application, the request to the Controller to cause a section 29 report and opinion to be prepared, shall be submitted on the actual filing date of the divisional application.

(2) The search shall be conducted and the section 29 report and opinion prepared in accordance with arrangements made for that purpose approved by the Minister.

(3) If, under the provisions of section 29(2), the applicant wishes that a section 29 report and opinion be prepared in relation to any additional invention he shall submit a request to that effect to the Controller, accompanied by the prescribed fee. The request shall be submitted within one month of the date of issue by the Controller to the applicant of the copy of the section 29 report and opinion relating to the first invention.

*Notice of the making of this Statutory Instrument was published in  
“Iris Oifigiúil” of 23rd May, 2017.*

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

- (a) Two months from the date of issue of the section 29 report and opinion 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.

(5) Within four months of the date of issue by the Controller to the applicant of a copy of the section 29 report and opinion the applicant shall, unless the application is withdrawn, comply with the requirements of section 29(4).

(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.”,

(b) by substituting the following for Rule 25:

“25. Where so requested by the Controller under section 30(2), the applicant shall, within a period of six months from the request, furnish a statement of all the foreign countries, if any, in which applications for protection for the invention, which is the subject of the patent application, have been made (including applications under conventions or treaties), together with a copy of the search report accompanied by a written opinion as to patentability relating to such applications. Within the same period the applicant shall also, where so requested by the Controller, furnish a statement as to whether such applications are still pending, have been accepted, are withdrawn or deemed to have been withdrawn or have been refused.”,

(c) in Rule 26 by substituting the following for paragraph (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 report accompanied by a written opinion as to patentability for the application relating to the same invention has been prepared by the European Patent Office.”,

(d) by substituting the following for Rule 27:

“27. (1) The evidence referred to in section 30(1) in relation to the invention for which a patent is sought shall be either—

- (a) where an application for a patent is also made under the provisions of the European Patent Convention, a copy of the published European patent application and the related

Extended European Search Report which is accompanied by a written opinion as to patentability or a copy of the published specification of the granted European patent in respect of the said invention; or

(*b*) where an application for a patent is also made under the provisions of the Treaty, a copy of the published International Application and the related International Search Report and written opinion as to patentability in respect of the said invention; or

(*c*) where an application for a patent is also made to the United Kingdom Intellectual Property Office, a copy of the published application for the patent and the related search report and written opinion as to patentability or a copy of the published specification of the granted patent in respect of the said invention; or

(*d*) where an application for a patent is also made to the Deutsches Patentamt, a copy of the published application for the patent and the related search report and extended search opinion or a copy of the published specification of the granted patent [Patentschrift] in respect of the said invention; or

(*e*) where an application for a patent is also made to the Patent Office (or other authority competent for the grant of patents) of a state on whose behalf such applications are the subject of searches carried out by the European Patent Office, a copy of the published application for the patent and the search report thereon together with a written opinion as to patentability prepared by the European Patent Office.

(2) On submitting evidence the applicant shall pay the prescribed fee.

(3) The time for submitting evidence shall be—

(*a*) in the case of the evidence referred to in paragraph (1) (*a*), within two months of the publication of the search report and written opinion or of the specification,

(*b*) in the case of the evidence referred to in paragraph (1) (*b*), within two months of the publication of the International Search Report and Written Opinion as to patentability,

(*c*) in the case of the evidence referred to in paragraph (1) (*c*), within two months of the publication of the application or of the receipt by the applicant of the search report incorporating a written opinion as to patentability (whichever is the

later), or within two months of the publication of the specification,

- (d) in the case of the evidence referred to in paragraph (1) (d), within two months of the publication of the search report and extended search opinion or of the specification,
- (e) in the case of the evidence referred to in paragraph (1) (e), within two months of the publication of the search report and written opinion; provided that where the application is a divisional application, the evidence shall be submitted on the actual filing date of that application if it has already been published before that date.

(4) The Controller may grant an extension of the time prescribed in paragraph (3) if a request for such extension, accompanied by the prescribed fee, is made at any time within the extended period specified in the request.”,

(e) by substituting the following for Rule 28(2):

“28. (2) Following receipt by him of evidence under Rule 27 the Controller, unless the application is withdrawn, shall notify the applicant that the provisions of section 30 (4) shall be complied with within four months of the date of the notification.”,

(f) by inserting the following Rule after Rule 28:

*“Observations by third parties on patentability*

28A.— (1) The Controller shall consider any observations on patentability he or she receives under section 30A and shall, subject to section 28(5), send to the applicant a copy of the observations.

(2) The Controller may, if he or she thinks fit, send to the applicant a copy of any document referred to in the observations.

(3) Paragraph (1) does not apply where the observations are received after the request for payment of the fee for the grant of a patent has issued.

(4) If the Controller is satisfied that the observations are such as to call into question the patentability of the invention which is the subject of the application, he or she shall notify the applicant and invite the applicant to amend the specification in light of the observations.

(5) Within two months of the date of issue by the Controller to the applicant of a copy of the observations and the notice under paragraph (4), the applicant shall, unless the application is withdrawn, comply with the requirements of section 29(5) or section 30(5) as appropriate.”

and

(g) by substituting the following for Rule 45(1):

“45. (1) A request to the Controller under section 66 (1)(a) or (6) shall be accompanied by the prescribed fee.”.

(4) The Rules immediately in force before these Rules come into force shall continue to apply to an application for a patent made but not yet determined under the Act before 19th May 2017.



GIVEN under my Official Seal,  
19 May 2017.

MARY MITCHELL O'CONNOR,  
Minister for Jobs, Enterprise and Innovation.

## 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 the Patents Act 1992 which re-introduce substantive examination of Irish patent applications. The rules set the procedural changes to support substantive examination including the submission of a search report and written opinion as to patentability of an invention. Third party observations to the Controller in relation to the patentability of applications are also provided for.

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