



Number 6 of 2017 -

Knowledge Development Box (Certification of Inventions) Act 2017



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**KNOWLEDGE DEVELOPMENT BOX (CERTIFICATION OF INVENTIONS) ACT
2017**

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[2017.]

*Knowledge Development Box
(Certification of Inventions) Act 2017.*

[No. 6.] -

ACTS REFERRED TO

Finance Act 2015 (No. 52) -

Patents Act 1992 (No. 1) -

Patents Acts 1992 to 2014 -

Taxes Consolidation Act 1997 (No. 39) -



Number 6 of 2017

KNOWLEDGE DEVELOPMENT BOX (CERTIFICATION OF INVENTIONS) ACT 2017

An Act to provide for the issue, by the Controller of Patents, Designs and Trade Marks, to a relevant company of a knowledge development box certificate in respect of an invention by that company which is novel, non-obvious and useful, as specified in the definition of “intellectual property for small companies” in section 769R of the Taxes Consolidation Act 1997, in order to enable the company to use the certificate to obtain a tax benefit under the Taxes Consolidation Act 1997; to amend the Patents Act 1992 to ensure that Irish patents granted on or after the commencement of *Part 6* of this Act can fall within paragraph (a) of the definition of “qualifying patent” in section 769G of the Taxes Consolidation Act 1997; and to provide for related matters. [12th April, 2017]

Be it enacted by the Oireachtas as follows:

PART 1

PRELIMINARY AND GENERAL

Short title, collective citation and commencement

1. (1) This Act may be cited as the Knowledge Development Box (Certification of Inventions) Act 2017.
- (2) The Patents Acts 1992 to 2014 and *Part 6* may be cited together as the Patents Acts 1992 to 2017.
- (3) This Act shall come into operation on such day or days as the Minister may by order or orders appoint either generally or with reference to any particular purpose or provision and different days may be so appointed for different purposes or different provisions.

Interpretation

2. (1) In this Act—
 - “Act of 1997” means the Taxes Consolidation Act 1997;
 - “Act of 2015” means the Finance Act 2015;
 - “applicant” means the relevant company making the application concerned;

“application” means an application under *section 7(1)*; -

“Controller” means the Controller of Patents, Designs and Trade Marks; -

“industry” includes agriculture; -

“KDB” means knowledge development box; -

“KDB certificate” means a knowledge development box certificate; -

“knowledge development box certificate” has the meaning assigned to it by *section 7(1)*; -

“non-obvious”, in relation to an invention the subject of an application, means that the invention, having regard to the state of the art before the date contained in the application pursuant to *section 7(2)(d)*, involves an inventive step that is not obvious to a person skilled in the art; -

“novel”, in relation to an invention the subject of an application, means that the invention, having regard to the state of the art before the date contained in the application pursuant to *section 7(2)(d)*, does not form part of the state of the art; -

“Minister” means the Minister for Jobs, Enterprise and Innovation; -

“prescribed” means prescribed by rules made by the Minister under *section 21*; -

“relevant company” means a company— -

- (a) which is a relevant company within the meaning of the definition of “relevant company” in *section 769G* (inserted by *section 32(1)(a)* of the Act of 2015) of the Act of 1997, and
- (b) to which *section 769R* (inserted by *section 32(1)(b)* of the Act of 2015) of the Act of 1997 applies by virtue of subsection (2) of such *section 769R*;

“review” means a review under *section 14*;

“specified”, in relation to a form of document, means specified under *section 24*;

“state of the art”, in relation to an invention the subject of an application, means everything made available to the public (whether in the State or elsewhere) by means of a written or oral description, by use, or in any other way, before the date contained in the application pursuant to *section 7(2)(d)*;

“useful”, in relation to an invention the subject of an application, means that the invention has a specific, credible and substantial utility in that it can be made or used in one or more than one industry.

- (2) A reference in this Act to an invention includes a reference to a group of inventions where *section 6* so permits.

Expenses

3. The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Public Expenditure and Reform, be paid

out of monies provided by the Oireachtas.

PART 2

REQUIREMENTS THAT MUST BE MET BEFORE KDB CERTIFICATE MAY BE ISSUED IN RESPECT OF INVENTION

Invention must be novel, non-obvious and useful

4. (1) Subject to *subsection (2)*, a KDB certificate may only be issued in respect of an invention which is novel, non-obvious and useful.
- (2) Any of the following in particular shall not be regarded as an invention within the meaning of *subsection (1)*:
- (a) a discovery, scientific theory or mathematical method;
 - (b) an aesthetic creation;
 - (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
 - (d) the presentation of information.

Cases in which KDB certificate shall not be issued

5. (1) A KDB certificate shall not be issued in respect of—
- (a) an invention the commercial exploitation of which would be contrary to public order or morality, provided that the exploitation shall not be deemed to be so contrary only because it is prohibited by law,
 - (b) a plant or animal variety or an essentially biological process for the production of plants or animals other than a micro-biological process or the products thereof, or
 - (c) subject to *subsection (2)*, a method for treatment of a human or animal body by surgery or therapy and a diagnostic method practised on the human body or animal body.
- (2) *Subsection (1)(c)* shall not apply to products, in particular substances or compositions, for use in any such method.

KDB certificate may only be issued for one invention except in specified cases

6. A KDB certificate may only be issued in respect of one invention except that a KDB certificate may be issued in respect of a group of inventions if the inventions are so linked as to form a single general inventive concept.

PART 3

APPLICATION FOR KDB CERTIFICATE, DETERMINATION OF APPLICATION AND REVIEWS

Application for KDB certificate

7. (1) Subject to *subsections (2) and (3)*, a relevant company may make an application, in the specified form and accompanied by the prescribed fee (if any), to the Controller for the issue of a certificate (in this Act referred to as a “knowledge development box certificate”) for the purposes of section 769R (inserted by section 32(1)(b) of the Act of 2015) of the Act of 1997 and, in particular, for the purposes of the definition of “intellectual property for small companies” in subsection (1) of such section 769R.
- (2) Without prejudice to the generality of *section 24*, the application shall contain the following information:
- (a) evidence that the applicant is a relevant company (which may be a statutory declaration to that effect);
 - (b) the title of the invention in sufficient detail to indicate the matter to which the invention relates;
 - (c) a full, clear, concise and accurate description in writing of the invention and of the manner and process of making and using it, including any drawings, images or other evidentiary material which may assist in understanding the nature of the invention and such other information which might materially assist in the making of a decision on the application by the Controller whether to issue a KDB certificate in respect of the invention;
 - (d) for the purposes of determining if the invention is novel and non-obvious, the date on which the process, product or technology which is or comprises the invention began to be used, produced or marketed;
 - (e) the novel features or improvements contained in the invention which were not part of the state of the art in the field of technology concerned before the date referred to in *paragraph (d)*;
 - (f) the features of the invention which were part of the state of the art in the field of technology concerned, and were known to the applicant, on or before the date referred to in *paragraph (d)*;
 - (g) without prejudice to the generality of *paragraph (c)*—
 - (i) -a description of the advantageous effects (if any) of the invention with reference to—
 - (I) the state of the art in the field of technology concerned, and
 - (II) the way in which the invention is made and used in industry,
 - and

- (ii) if the invention is described as an improvement, a description of the invention pointing out the part or parts of the process, or the technical features, to which the improvement relates, focusing on the exact nature of the improvement and to such parts or technical features which cooperate with the improvement or as otherwise may be necessary for a complete understanding or description of the improvement.
- (3) The application shall be accompanied by—
 - (a) an opinion from a patent agent which attests (including attests by way of reference to the information required by *subsection (2)(e)* and *(f)*) to the invention being novel, non-obvious and useful on the date contained in the application pursuant to *subsection (2)(d)*, and
 - (b) evidence to support that opinion.
 - (4) In this section, “patent agent” has the meaning assigned to it by section 2(1) of the Patents Act 1992.
 - (5) The Office of the Revenue Commissioners shall, within 3 months of the enactment of this Act, publish a guidance document to provide information to businesses considering making an application for a KDB certificate.

Insufficient information, etc.

- 8. (1) If the Controller is satisfied that the application does not comply with all the requirements of *section 7* that apply to the application, he or she shall give the applicant a notice in writing—
 - (a) stating that the Controller is satisfied that the application does not comply with all the requirements of *section 7* that apply to the application,
 - (b) identifying (and, if the Controller considers it appropriate to do so, giving particulars of) such of those requirements in respect of which the Controller is satisfied that the application does not comply,
 - (c) stating that the applicant may, within 30 days of the date of issue of the notice, or such longer period as the Controller may permit in any particular case (either at the initiative of the Controller or upon a request in writing made by the applicant to the Controller), revise and resubmit the application to take account of such of those requirements which the Controller has identified in the notice as being requirements in respect of which the Controller is satisfied that the application does not comply, and
 - (d) stating that, if the applicant does not revise and resubmit the application in accordance with *paragraph (c)* before the expiration of the period concerned referred to in that paragraph, the applicant shall, by virtue of *subsection (2)*, be deemed to have withdrawn the application.
- (2) If the applicant the subject of a notice under *subsection (1)*—

- (a) subject to *subsections (3) and (4)*, does not revise and resubmit the application in accordance with *paragraph (c) of subsection (1)* before the expiration of the period concerned referred to in that paragraph, or
 - (b) does not withdraw the application pursuant to *section 10* before that expiration, the applicant shall, by virtue only of this subsection and with effect immediately upon that expiration, be deemed to have withdrawn the application.
- (3) *Subsection (4)* applies if—
- (a) the applicant revises and resubmits the application before the expiration of the period concerned referred to in *paragraph (c) of subsection (1)*, and
 - (b) the application still does not, however, take account of all of the requirements of *section 7* which the Controller has identified in the notice concerned under *subsection (1)*.
- (4) The Controller shall, as soon as is practicable after he or she receives the revised and resubmitted application, give the applicant a notice in writing identifying (and, if the Controller considers it appropriate to do so, giving particulars of) such of the requirements of *section 7* in respect of which the Controller is satisfied that the application still does not comply.
- (5) Subject to *subsection (6)*, the Controller shall be entitled to defer the consideration, or further consideration, of the application the subject of a notice under *subsection (1)* until the application is revised and resubmitted in accordance with *paragraph (c) of that subsection*.
- (6) The Controller shall cease the consideration, or further consideration, of the application the subject of a notice under *subsection (1)* if, by virtue of *subsection (2)*, the applicant is deemed to have withdrawn the application.
- (7) The Minister at the end of each year (beginning with the year ending 31 December 2018) shall prepare and lay before each House of the Oireachtas an anonymised report outlining why applications for KDB certificates were not successful.

Certain applications made in respect of 2 or more inventions

9. (1) *Subsection (2)* applies where—
- (a) 2 or more inventions are the subject of the same application, and
 - (b) without prejudice to the generality of *sections 4 and 5*, the Controller is minded to refuse to issue a KDB certificate in respect of the inventions on the ground that the inventions do not meet the requirement of *section 6*.
- (2) The Controller may give the applicant a notice in writing stating that—
- (a) the Controller is minded to refuse to issue a KDB certificate in respect of the inventions the subject of the application on the ground that the inventions do not meet the requirement of *section 6*,

- (b) the applicant may, within 30 days of the date of issue of the notice, give the Controller a notice in writing (in this section referred to as the “identifying notice”) identifying which one of those inventions (in this subsection referred to as the “identified invention”) the applicant wishes the Controller to further consider the application on the basis that the identified invention shall be treated as the only invention the subject of the application,
 - (c) if the applicant does give the Controller the identifying notice before the expiration of the period referred to in *paragraph (b)*, the applicant may, if it wishes to do so, make a new application in respect of any of the inventions which is not the identified invention, and
 - (d) if the applicant does not give the Controller the identifying notice before the expiration of the period referred to in *paragraph (b)*, the Controller will further consider the application on the basis on which the application was originally made.
- (3) The Controller shall be entitled to defer the further consideration of the application the subject of a notice under *subsection (2)* until—
- (a) the Controller is given the identifying notice before the expiration of the period referred to in *paragraph (b)* of that subsection, or
 - (b) that period expires without the Controller being given the identifying notice,
- whichever first occurs.

Withdrawal of application

10. Without prejudice to the operation of *section 8(2)*, the applicant may withdraw the application at any time (including following the receipt of a notice under *section 8(1)*) before the issue of a KDB certificate in respect of the invention the subject of the application.

New application may be made following withdrawn application

11. Nothing in this Act shall be construed to prevent the applicant—
- (a) whose application has been deemed to be withdrawn under *section 8(2)*, or
 - (b) who has withdrawn the application under *section 10*,
- from making a new application in respect of the invention that is the subject of the withdrawn application.

Decision to issue KDB certificate

12. (1) Where the Controller is satisfied that the invention the subject of the application meets all the requirements of *Part 2*, he or she shall issue a KDB certificate in the specified form to the applicant.
- (2) Without prejudice to the generality of *section 24*, a KDB certificate shall state—

- (a) the name of the applicant,
- (b) the address, principal office, or principal place of business, in the State, of the applicant,
- (c) the title of the invention in sufficient detail to indicate the matter to which the invention relates, and
- (d) the date contained in the application pursuant to *section 7(2)(d)*.

Decision to refuse to issue KDB certificate

- 13.** Where the Controller is not satisfied that the invention the subject of the application meets all the requirements of *Part 2*, he or she shall give the applicant a notice in writing—
- (a) stating that the Controller refuses to issue a KDB certificate in respect of the invention because he or she is not satisfied that the invention meets all the requirements of *Part 2*,
 - (b) setting out the grounds on which the Controller is not so satisfied (including referring the applicant to the relevant provisions of this Act), and
 - (c) stating that the applicant may, if the applicant so wishes, make a request under *section 14* to the Controller to cause a review of the decision to be carried out.

Review of decision to refuse to issue KDB certificate

- 14.** (1) The applicant who has been given a notice under *section 13* may, within 30 days of the date of issue of the notice or such longer period as the Controller may permit in any particular case (either at the initiative of the Controller or upon a request in writing made by the applicant to the Controller), make a request in writing (in this section referred to as the “review request”), in the specified form (if any) and accompanied by the prescribed fee (if any), to the Controller to cause a review of the relevant decision to be carried out.
- (2) Without prejudice to the generality of *section 24*, the review request shall, by reference to the grounds referred to in *section 13(b)* set out in the notice concerned under *section 13*, state the reasons why the applicant wishes the relevant decision to be reviewed.
- (3) Subject to *subsection (4)*, the Controller shall, upon receipt of the review request, appoint an officer of the Controller (in this section referred to as the “reviewer”) to review the relevant decision.
- (4) The reviewer—
- (a) shall not be the officer of the Controller who made the relevant decision, and
 - (b) shall be of a grade senior to the grade of the officer of the Controller who made the relevant decision.

- (5) The reviewer shall, as soon as is practicable after being appointed, review the relevant decision, taking into account only the reasons stated in the review request and, as he or she thinks fit—
- (a) confirm the relevant decision and give the applicant a notice in writing of such confirmation and the reasons for such confirmation, or
 - (b) cancel the relevant decision and issue a KDB certificate to the applicant in respect of the invention the subject of that decision.
- (6) In this -section, “relevant decision” means the decision, as set out in the notice concerned under *section 13*, to refuse to issue a KDB certificate in respect of the invention the subject of the application concerned.

New application may be made following refusal to issue KDB certificate

- 15.** Nothing in this Act shall be construed to prevent the applicant who has been given a notice under *section 13* or *14(5)(a)* from making a new application in respect of the invention to which that notice relates if that application contains new matters for the Controller’s consideration as to whether the invention meets all the requirements of *Part 2*.

PART 4

ADMINISTRATION

Authorisations by Controller

- 16.** Such functions of the Controller under this Act as may be specified by the Controller may be performed, under the supervision and subject to the general direction of the Controller, by officers of the Controller duly authorised in that behalf by the Controller.

Confidentiality of records, etc.

- 17.** (1) The Controller shall keep records of—
- (a) applications,
 - (b) KDB certificates issued,
 - (c) refusals to issue KDB certificates, and
 - (d) reviews,
- in such manner and form as he or she considers appropriate.
- (2) Subject to *subsections (3) and (4)*, a relevant person shall not publish, open to public inspection or otherwise disclose (including disclose in any legal proceedings) any of the following (including any copies, in any form, of any of the following) which has been obtained by the relevant person during the course of the performance by that

relevant person or another relevant person of a function under this Act, or which has been obtained by the relevant person during the course of assisting another relevant person in the performance of a function under this Act:

- (a) the records referred to in *subsection (1)*;
 - (b) information concerning any invention the subject of an application;
 - (c) technical information concerning industrial processes, commercial processes or formulae (including trade secrets and know-how) disclosed in an application, notice or request referred to in this Act.
- (3) A relevant person may disclose records or information referred to in *subsection (2)* that he or she has obtained as specified in that subsection if—
- (a) a court, or any officer having the power to order discovery in legal proceedings, certifies that such disclosure is desirable in the interests of justice and ought to be allowed, or
 - (b) the disclosure is—
 - (i) -made to another relevant person, and
 - (ii) -reasonably necessary for the purposes of this Act.
- (4) Nothing - in this section shall prevent the due disclosure to the Revenue Commissioners or an officer of the Revenue Commissioners of records or information referred to in *subsection (2)* for the purposes of making a determination in relation to any tax, tax refund or tax credit under the Taxes Consolidation Act 1997.
- (5) A relevant person who contravenes *subsection (2)* shall be guilty of an offence and shall be liable—
- (a) on -summary conviction, to a class A fine or imprisonment for a term not exceeding 6 months or both, or
 - (b) on conviction on indictment, to a fine not exceeding €50,000 or imprisonment for a term not exceeding 3 years or both.
- (6) In this section, “relevant person” means—
- (a) the Controller,
 - (b) an officer of the Controller (including any trainee, temporary worker, intern or person on work experience),
 - (c) an adviser or consultant to the Controller or a member of the staff of such adviser or consultant (including any trainee, temporary worker, intern or person on work experience),
 - (d) a person engaged under a contract for services by the Controller or a member of the staff of such person (including any trainee, temporary worker, intern or person on work experience), or
 - (e) a person who was formerly a person who fell within *paragraph (a), (b), (c) or (d)*.

KDB report

- 18.** (1) In this section, “KDB report” means the report required to be made under subsection (1) of section 103 of the Patents Act 1992 in so far as this Act is an enactment which falls within paragraph (b) of that subsection.
- (2) The KDB report shall include statistical information in a form, and regarding such matters, as the Minister may direct.
- (3) The Minister may seek the introduction of appropriate categories or sectoral headings in respect of applications and request information from the Controller as to the proportion of applications under each heading.
- (4) The KDB report shall not disclose details of any invention the subject of an application.
- (5) The KDB report shall specify—
- (a) the number of applications received by the Controller during the year to which the report relates,
 - (b) the number of applications deemed to be withdrawn under *section 8(2)*, and the number of applications withdrawn under *section 10*, by applicants during that year,
 - (c) the number of applications during that year in respect of which the Controller issued a KDB certificate,
 - (d) the number of applications during that year in respect of which the Controller refused to issue a KDB certificate,
 - (e) the number of refusals to issue a KDB certificate that were subject to a review during that year,
 - (f) the number of reviews carried out during that year that resulted in the confirmation of the decision to refuse to issue a KDB certificate,
 - (g) the number of reviews carried out during that year that resulted in the issue of a KDB certificate, and
 - (h) such other statistical information as may be prescribed.

Indemnity

- 19.** No action for damages or other proceedings shall lie or be maintainable against the Controller or an officer of the Controller for anything done, anything purported to be done or anything omitted to be done by him or her in performing a function under this Act, unless the act or omission is shown to have been in bad faith.

PART 5

MISCELLANEOUS

Forgery of documents

20. (1) A person who forges, or utters knowing it to be forged, a notice, certificate or other document purporting to be given, issued or granted under this Act (in this section referred to as a “forged document”) shall be guilty of an offence.
- (2) A person who alters with intent to defraud or deceive, or utters knowing it to be so altered, a notice, certificate or other document given, issued or granted under this Act (in this section referred to as an “altered document”) shall be guilty of an offence.
- (3) A person -who, without lawful authority, has in his or her possession a forged document or an altered document shall be guilty of an offence.
- (4) A person guilty of an offence under this section shall be liable—
- (a) on -summary conviction, to a class A fine or imprisonment for a term not exceeding 6 months or both, or
- (b) on conviction on indictment, to a fine not exceeding €50,000 or imprisonment for a term not exceeding 3 years or both.

Rules

21. (1) The Minister may by rules provide for any matter referred to in this Act as prescribed or to be prescribed but shall not prescribe a fee except—
- (a) for the purposes of defraying the cost of the determination of an application or the carrying out of a review, as the case may be, and
- (b) - with the consent of the Minister for Public Expenditure and Reform.
- (2) Without prejudice to any provision of this Act, rules made under this section may contain such incidental, supplementary and consequential provisions as appear to the Minister to be necessary or expedient for the purposes of the rules.
- (3) Every rule made by the Minister under this section shall be laid before each House of the Oireachtas as soon as may be after it is made and, if a resolution annulling the rule is passed by either such House within the next 21 days on which that House sits after the rule is laid before it, the rule shall be annulled accordingly, but without prejudice to the validity of anything previously done thereunder.
- (4) Without -prejudice to *subsections (1) and (2)*, the Controller may adopt such procedures for giving effect to this Act as appear to him or her to be appropriate.

Liability for offences by body corporate

22. Where an offence under this Act is committed by a body corporate and is proved to have been so committed with the consent or connivance of any person, being a director,

manager, secretary or other officer of the body corporate, or a person who was purporting to act in such capacity, that person shall, as well as the body corporate, be guilty of an offence and shall be liable to be proceeded against and punished as if he or she were guilty of the first-mentioned offence.

Fees

- 23.** All fees paid to the Controller pursuant to this Act shall be paid into or disposed of for the benefit of the Exchequer in such manner as the Minister for Public Expenditure and Reform may direct.

Forms

- 24.** (1) Subject to *sections 7(2) and (3), 12(2) and 14(2)*, the Controller may specify the form of any documents required for the purposes of this Act as he or she thinks fit.
- (2) The Controller's power under *subsection (1)* may be exercised in such a way as to—
- (a) include in the specified form of any document a statutory declaration—
 - (i) to be made by the person completing the form, and
 - (ii) -as to whether the particulars contained in the form are true and correct to the best of that person's knowledge and belief,and
 - (b) specify 2 or more forms of any document referred to in that subsection, whether as alternatives, or to provide for particular circumstances or particular cases, as the Controller thinks fit.
- (3) The form of a document specified under this section shall be—
- (a) completed in accordance with such directions and instructions as are specified in the document,
 - (b) accompanied by such other documents as are specified in the document, and
 - (c) if the completed document is required to be provided to—
 - (i) the Controller,
 - (ii) -another person on behalf of the Controller, or
 - (iii) any other person, -so provided in the manner (if any) specified in the document. -

PART 6

AMENDMENT OF PATENTS ACT 1992

Definition

25. In this Part, “Act of 1992” means the Patents Act 1992.

Application

26. If an application for a patent is made under the Act of 1992 before the commencement of this Part but is not determined before that commencement, that Act, as in force immediately before that commencement, shall continue to apply to that application until the application is determined.

Amendment of section 29 of Act of 1992

27. Section 29 of the Act of 1992 is amended—

- (a) in subsection (1), by the substitution of “(in this section referred as the ‘section 29 fee’), cause a report incorporating a written opinion as to patentability to be prepared in relation to the invention (in this section and section 30 referred to as the ‘section 29 report and opinion’). Rules made under this Act may specify who shall prepare the section 29 report and opinion (including any part thereof) and the scope thereof.” for “(‘the search fee’) cause a search to be undertaken in relation to the invention and a report (a ‘search report’) of the results of the search to be prepared. The rules may specify by whom the search report shall be prepared and the scope thereof.”,
- (b) by the substitution of the following subsection for subsection (2):
 - “(2) If it appears, in the course of the preparation of the section 29 report and opinion, that an application discloses more than one invention, the section 29 report and opinion shall be prepared in relation only to the first invention specified in the claims. A further section 29 report and opinion may be prepared in relation to any additional invention if the applicant, within the time allowed by the Controller for the purpose, submits a request to that effect accompanied by the section 29 fee.”,
- (c) in subsection (3), by the substitution of “section 29 report and opinion” for “search report”,
- (d) by the substitution of the following subsection for subsection (4):
 - “(4) If the application is not withdrawn, the Controller shall allow the applicant an opportunity to amend the application in light of the section 29 reports and opinions. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, to submit either amendments to the application, or a statement setting out the applicant’s reasons why the applicant

considers that no such amendments are necessary, the application may, subject to section 90, be refused by the Controller. An application to which subsection (2) applies shall be amended so as to confine it to one invention only.”,

and

(e) by the insertion of the following subsection after subsection (4):

“(5) If the applicant, in pursuance of subsection (4), submits amendments or a statement referred to in that subsection within the prescribed period, the Controller shall cause a substantive examination of the application to be carried out. Such substantive examination shall have regard to the application as originally filed together with any amendments or statement furnished under subsection (4) and shall investigate if the application complies with the requirements of this Act and of rules made under this Act.”.

Amendment of section 30 of Act of 1992

28. Section 30 of the Act of 1992 is amended—

(a) in subsection (1), by the substitution of the following paragraph for paragraph (a):

“(a) the results of the equivalent (or, taken together, the equivalents), in that prescribed foreign state or under the provisions of that prescribed convention or treaty (as the case may be), to a section 29 report and opinion prepared in respect of such application, or”,

(b) by the substitution of the following subsections for subsections (4) and (5):

“(4) Where the evidence submitted is that referred to in subsection (1)(a) or (b), the Controller shall, unless the application is withdrawn, allow the applicant an opportunity to amend the application in the light of that evidence. The applicant shall in particular submit such amendments as are required to the specification so that the subject-matter claimed therein does not extend beyond that of the evidence. Any amendments shall be submitted within the prescribed period. If the applicant fails, before the expiry of the prescribed period, to submit either amendments to the application, or a statement setting out the applicant’s reasons why the applicant considers that no such amendments are necessary, the application may, subject to section 90, be refused by the Controller.

(5) If the applicant, in pursuance of subsection (4), submits amendments or a statement referred to in that subsection within the prescribed period, the Controller shall cause a substantive examination of the application to be carried out. Such substantive examination shall have regard to the application as originally filed together with the evidence

furnished under subsection (1) and any amendments or statement furnished under subsection (4) and shall investigate if the application complies with the requirements of this Act and of rules made under this Act.”,

and

(c) by the deletion of subsection (6).

Observations by third party on patentability

29. The Act of 1992 is amended by the insertion of the following section after section 30:

“**30A.**(1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the Controller on the question of whether the invention is a patentable invention, stating reasons for the observations, and the Controller shall consider the observations in accordance with rules made under this Act.

(2) A person who makes observations under this section does not, by reason only of those observations, become a party to any proceedings under this Act.”.

Amendment of section 31 of Act of 1992

30. Section 31 of the Act of 1992 is amended—

(a) in subsection (1)—

(i) by - the insertion of “, following the substantive examination and investigation carried out in pursuance of section 29(5) or 30(5),” after “If it appears to the Controller”, and

(ii) by the substitution of “and in particular” for “other than”,

and

(b) by the substitution of the following subsection for subsection (2):

“(2) If the Controller finds that the application as originally filed or as amended in accordance with subsection (1) complies with the requirements of this Act and of rules made under this Act, the Controller shall grant the patent.”.

Annual report

31. The Act of 1992 is amended by the substitution of the following section for section 103:

“**103.** (1) Subject to subsections (2) to (4), the Controller shall, as soon as practicable but, in any case, not later than 5 months after the end of

each year, make a report in writing to the Minister of the Controller's activities under—

- (a) this Act, and
 - (b) -each other enactment for the administration of which the Controller is responsible.
- (2) The report shall include, in respect of the year to which it relates, particulars of all rules made in that year under or for the purposes of this Act or other enactment referred to in subsection (1)(b) and an account of all fees, salaries and allowances, and other money, received and paid under this Act or such other enactment.
- (3) The Minister shall ensure that a copy of the report is laid before each House of the Oireachtas not later than 6 months after the end of the year to which the report relates.
- (4) Nothing in this section shall be construed as requiring the Controller to include in the report information the inclusion of which would, in the opinion of the Controller, be likely to prejudice the performance of the Controller's functions under this Act or other enactment referred to in subsection (1)(b)."