Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

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[redacted]

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Country:

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IP Office

Ireland

Job title

Patent Examiner

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

Irish Patents Act 1992 (as amended) - Section 11(2). The state of the art (prior art) shall be held to comprise 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 filing date (priority date) of the patent application. In addition, Section 11(3) identifies prior art as the contents of Irish patent applications filed before but published on or after that filing date (priority date).

2. Against which date is prior art assessed under the applicable law?

If no priority is claimed, prior art is assessed from the filing date of the patent application. If priority is claimed, prior art is assessed from the priority date of the patent application.

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

The state of the art means anything public. No special medium based exclusions exists under Irish Law.

Section 12 of the Irish Patents Act (as amended) provides exception for certain disclosures that do not count as prior art. It states disclosure of the invention shall not be taken into consideration if it occurred not earlier than six months preceding the filing of the patent application and if it was due to, or in consequence of:
(a) a breach of confidence or agreement in relation to, or the unlawful obtaining of the matter constituting, the invention, or
(b) the fact that the applicant or his legal predecessor has displayed the invention at an international exhibition which is either official or officially recognised under the Convention on International Exhibitions signed at Paris on the 22nd day of November, 1928, or any subsequent treaty, convention or other agreement replacing that Convention:
provided that the exhibitor states, when making the patent application, that the invention has been so displayed and files supporting certificate within the period and under the conditions prescribed.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as "secret prior art")?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : Section 11(3) of the Irish Patents Act 1992 (as amended) states the content of a patent application, of which the date of filing is prior to the filing date of the current application and which was published under the Irish Patents Act on or after that date, shall be considered as comprised in the state of the art.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

IPOI Information booklet - 'Patents for Inventions'.

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Utility models, known as 'short term patents' in Ireland, require an application to be new, susceptible of industrial application provided it is not clearly lacking an inventive step - [Section 63(4) Irish Patents Act 1992 (as amended)]. The criteria of 'new' is laid down as per patents of invention - the invention shall be considered new if it does not form part of the state of the art.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Section 11(1) of the Irish Patents Act 1992 (as amended) provides that an invention is novel if it does not form part of state of the art. Section 11(2) and 11(3) defines state of the art as everything made available to the public. The state of the art consists of everything made available to the public by a written or oral description, use, or in any other way before the filing date (priority date), and the contents of earlier Irish patent applications published on or after that date.

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Section 13 - Irish Patents Act 1992 (as amended) states: An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. The state of the art consists of everything made available to the public by a written or oral description, use, or in any other way before the filing date (priority date).

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

If priority is validly claimed, the priority date is the relevant date for assessing inventive step. If no priority is claimed, the Irish filing date applies. The prior art taken into consideration is that defined as state of the art under Section 11(2) of the Irish Patents Act 1992 (as amended) - the state of the art consists of everything made available to the public by a written or oral description, use, or in any other way before the filing date (priority date).

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the "person skilled in the art", focusing on how the standard is understood or applied, rather than its formal legal definition?

The applied test in Ireland is not only whether the invention could be made based on the prior art, but whether it would have been obvious to do so. Examiners will look to see: if there is a teaching in the prior art to modify; if the invention provides an unexpected advantage over this teaching; does the invention solve a technical problem in a non-obvious way? Given that the person skilled in the art is knowledgeable but unimaginative, would the technical solution have been obvious to them?

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:**

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

IPOI Information booklet - 'Patents for Inventions'.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Utility models, known as 'short term patents' in Ireland, require an application to be new, susceptible of industrial application provided it is not clearly lacking an inventive step - [Section 63(4) Irish Patents Act 1992 (as amended)]. The criteria of 'not clearly lacking an inventive step' is interpreted considering common general knowledge.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Section 12 of the Irish Patents Act 1992 (as amended) makes provision for non prejudicial disclosures. Disclosure is not to be taken into account in determining novelty if it occurred within six months before the filing date due to: (a) a breach of confidence or agreement in relation to the invention; (b) the unlawful obtaining of information concerning the invention; or (c) display of the invention by the applicant or his legal predecessor at an official or officially recognized international exhibition. 2. The applicant shall state, when filing the application, that the invention has been so displayed, and file a certificate within a prescribed period. 3. The Ministry may prescribe a period other than the six months and circumstances other than (a), (b), and (c) to give effect to any treaty or international conventions.

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

Disclosure is not to be taken into account in determining novelty if it occurred within six months before the filing date (priority date). The Ministry may prescribe a period other than the six months and circumstances other than (a), (b), and (c) to give effect to any treaty or international conventions.

3. Where such a mechanism exists, which categories of disclosures are covered by it?

(a) a breach of confidence or agreement in relation to the invention;
(b) the unlawful obtaining of information concerning the invention;
(c) display of the invention by the applicant or his legal predecessor at an official or officially recognized international exhibition.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** The applicant shall, when filing the application, state that (a) disclosure has occurred due to a breach of confidence or (b) the unlawful obtaining of the information concerning the invention or (c) the invention has been displayed by the applicant or his legal predecessor at an official or officially recognized international exhibition. A statement (for option a or b) or a certificate of exhibition (for option c) must be provided within a prescribed period.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

Yes

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:** Section 55 of the Irish Patents Act 1992 (as amended) discusses the right to continue use of an invention commenced before the date of filing or priority. Third parties are protected if a person was already using an invention (or preparing to use it) before the patent was filed, allowing them to keep doing so even after the patent is granted. They will also maintain the right to assign the right to use the invention or to transmit such right on death or a business' dissolution. These rights do not include the right to grant a license for the invention to any person.

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Submission of information concerning other aspects of national/regional patent law

E. Sufficiency of Disclosure

Sufficiency_of_disclosure_-_IE.docx

F. Exclusions from Patentable Subject Matter

Exclusions_from_patentable_subject_matter_-_IE.docx

G. Exceptions and Limitations to Patent rights

Exceptions_and_Limitations_to_Patent_Rights_-_IE.docx

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.