

O I F I G N A b P A I T I N N Í



T H E P A T E N T S O F F I C E

SEVENTY SECOND ANNUAL REPORT  
OF THE  
CONTROLLER OF PATENTS, DESIGNS  
AND TRADE MARKS

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Oifig na bPaitinní



The Patents Office

# **Seventy Second Annual Report of the Controller of Patents, Designs and Trade Marks 1999**

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BAILE ÁTHA CLIATH:  
ARNA FHOILSIÚ AG OIFIG AN tSOLÁTHAIR

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TEACH SUN ALLIANCE, SRÁID THEACH LAIGHEAN, BAILE ÁTHA CLIATH 2,  
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# INTRODUCTION

I have the honour to submit to the Oireachtas, in accordance with the provisions of Section 103 of the Patents Act, 1992, a Report for the year ended 31 December 1999.

My functions are set out in the Industrial and Commercial Property (Protection) Acts, 1927-1958, the Patents Act, 1992, the Trade Marks Act, 1996; the Statutory Rules made under these Acts; and the European Communities (Supplementary Protection Certificate) Regulations relating to pharmaceutical products and plant protection products. Decisions under these Acts, Rules and Regulations rest with me in my statutory capacity, subject to certain rights of appeal to the High Court. I have certain statutory functions also under the Copyright Act, 1963 viz. the resolution of disputes regarding royalty amounts arising mainly in the area of public performance of sound recordings. In addition, I make available information about Industrial and Intellectual Property.

## **Mission and Objectives**

The objective of the Patents Office is reflected in its mission statement which is:

*“To provide, in the implementation of the relevant legislation, an efficient system of industrial property protection and thus contribute to the*

*promotion of enterprise and technological progress.”*

The role of the Patents Office involves the grant of rights in the fields of inventions, trade marks and designs, and the dissemination of relevant knowledge in conjunction with each of these activities. The Patents Office aims to provide business, industry and individual entrepreneurs with an effective system of protection for their industrial property rights. In so doing, the work of the Office ties in with the wider national objectives of supporting and encouraging enterprise and innovation and an effective business environment in Ireland.

The Intellectual Property Unit of the Department of Enterprise, Trade and Employment has responsibility for intellectual property policy and preparation of legislation in this field. The Office furnishes advice in these matters to the Department, including comments on the impact for the work of the Office of proposed changes.

Throughout the remainder of this Report, unless the context otherwise requires, a reference to the 1963 Act means a reference to the Trade Marks Act, 1963; a reference to the 1964 Act means a reference to the Patents Act, 1964; a reference to the 1992 Act means a reference to the Patents Act, 1992 and a reference to the 1996 Act means a reference to the Trade Marks Act, 1996.

# GENERAL

## Receipts and Expenses

The receipts and expenses for the year amounted to £6,430,988.65/€8,165,671.17 and £3,480,247.53/€4,419,002.81 respectively.

Particulars are given in Appendix B. The corresponding figures for 1998 were £6,208,793.44/€7,883,541.45 and £3,763,901.64/€4,779,169.24.

In 1999, fees received in connection with patents amounted to over £3.1 million/€4.04 million; trade marks accounted for over £2.79 million/€3.55 million; design fees amounted to £88,657/€112,572.

## Office – Staff and Structure

The total number of staff serving at 31 December 1999 was 72 compared to 76 at the end of 1998. This compares with a figure of 88 at the end of 1997. The decrease arises as a result of a decision taken by the Department of Enterprise, Trade and Employment to reduce the staff complement of the Office simultaneously with its relocation to Kilkenny following a Business Process Re-engineering (BPR) exercise on the Office carried out in 1997/98. A breakdown of staff serving at the end of the year is given in Appendix A.

## Information

The Office has been gradually replacing its paper document collection with an electronic database. This database of patent information continues to grow in importance. The library now houses an extensive collection of several thousand CD-ROMs containing several of the ESPACE series of disks produced by the European Patent Office (EPO) comprising information on EP, PCT and GB patents, the USAPat series from the US Office, the PAJ series from Japan and the

GlobalPat first page series. These disks contain bibliographic data, text-searchable abstracts, allow cross-referencing to EP and PCT patents, and may be accessed directly by visitors to the library. A computerised patents and trade marks search facility is also available via the new PTOLEMY computer system, whereby details of Irish patent applications and granted patents, and, pending and registered marks are available for inspection. In addition, it is now possible to licence from the Controller the part of the trade mark database consisting of the representations of all trade marks (excluding device representations). The library provides a document delivery service to patent and trade mark agents and to members of the public. The library contains many legal and technical works of interest to inventors and those interested in patents, designs and trade marks.

The technical co-operation programme with the EPO, begun in 1997 with the primary aim of enhancing the access to patent information in Ireland, continued throughout 1999 to produce significant results. The second phase of a network of CD-ROM/EPOQUE workstations linked to a number of high capacity CD-ROM jukeboxes was completed in May 1999 to increase both the number of workstations and the CD-ROM storage capacity of the system. This network links the library in Kilkenny with the patent information centre in Dublin in such a way that the 2000-plus CD-ROMs in the jukeboxes in Kilkenny are accessible by visitors to the Dublin centre. A further enhancement was added in December 1999 with the upgrading of one of the jukeboxes to access DVD's – this will enable the Office to take advantage of new collections of patent documents which are being produced on DVD. The network also allows library staff to access the internal databases of the EPO via an ISDN line so that older patent documents not currently available in the Office can be downloaded and printed on

request. 1999 also saw the production of the further disks in the Irish ESPACE CD-ROM series containing Irish applications laid open to public inspection in 1995. By the end of 2000, it is expected that a complete series of disks, comprised of abstracts from 1927 to 1990 and facsimiles of the complete application documents from 1991 to the present, will be available.

### **Internet**

The Patents Office has established a presence on the Internet as part of the esp@cenet initiative of the EPO. Esp@cenet has been adopted by the European Commission as part of its initiative in promoting innovation and its Intellectual Property Rights (IPR) helpdesk project. Esp@cenet offers free access to over 30 million patent documents online. By logging on the Irish Patent Office's website at [www.patentsoffice.ie](http://www.patentsoffice.ie) it is possible to access directly the largest volume of patent documentation available anywhere on the Internet and to search it via a standardised search interface. Information on patents was only available on accessing the Irish Patents Office web-site during 1999. The site is currently being improved and re-designed and will include detailed information about the Office and its services including dissemination of information on trade marks and designs.

### **Exhibitions/Seminars**

During the course of the year, Office staff were again actively involved in the promotion of intellectual property information through their attendance at a number of exhibitions and seminars. The Office took the opportunity to introduce the world of patents to the next generation of Irish inventors at the "Young Scientist & Technology Exhibition" in the RDS in January; in September it attended the "1999 Celtic Business Convention" organised by Waterford and Pembrokeshire in Business; and in October it participated in "Enterprise Ireland" organised by the Small Firms Association at the RDS. The Office also participated in a number of presentations /seminars: Transition Year students

at Kilkenny College in January as part of the Mini-Company Programme; bilateral discussions with the National Microelectronics Research Centre in Cork in February; and "Patent Searching on the Internet" at the Dairy Industry Seminar organised by TEAGASC in Fermoy in September. The volume of enquiries at these events yet again confirmed that, allied to the sustained growth in the country's economy, there continues to be an increasing role for the Office in the promotion of information on intellectual property.

### **Publications**

The Office is intent upon ensuring its information publications are as informative and as user-friendly as possible. To this end, its information booklets on patents, designs and trade marks were revised and updated.

### **Service Standards**

The Office is committed to providing the best possible service to its customers. Its Customer Action Plan set out the manner in which the Office intended to implement the principles of quality customer service until the end of 1999. The Plan also set out specific standards and targets the Office was to meet. These standards are set out in a separate booklet which is made available to the public and the performance of the Office against the targets and standards is monitored regularly.

### **Users Council**

In May 1997, the Minister for Enterprise, Trade and Employment decided to establish a Patents Office Users Council. The terms of reference given to the Council were:

*"To consider and report to the Minister on the administration of industrial property protection by the Patents Office and to advise on appropriate changes and innovations in the operation of the Office."*

The Council comprises the Controller and representatives of the Association of Patent and

Trade Mark Agents, Forbairt, IBEC and University College, Dublin, and is chaired by a senior official from the Department of Enterprise, Trade, and Employment.

The Council, which met on three occasions in 1999, provides a useful forum for the exchange of views on improving delivery of the Office's services and on domestic and international developments relating to industrial property protection.

### **New Legislation**

In my 1998 Annual Report I referred to the enactment of the Intellectual Property (Miscellaneous Provisions) Act, 1998 which became law on 7th July, 1998. I outlined, inter alia,

the changes brought about by Sections 4 and 5 of that Act relating to the office of Controller and indicated that the provisions of these sections were introduced and enacted while Judicial Review proceedings which I had initiated earlier in 1998 were still pending and that no reference to the existence of these proceedings was contained in the relevant Dail and Seanad debates dealing with the passage of the provisions of Sections 4 and 5. I also indicated that High Court proceedings had been issued concerning the constitutionality of these two sections and that an appeal was pending in the Supreme Court. At the end of 1999, the High Court proceedings and the appeal before the Supreme Court were still pending.

Appendix I lists the new statutory instruments made during the year.

# PATENTS

As at 31 December 1999, there were a total of 9,756 pending applications on hand. The bulk of these applications were awaiting the submission of evidence of novelty. While the number of applications on hands has been reduced steadily over the years, the Office has taken steps to further reduce the number by seeking to identify applications with which applicants may no longer wish to proceed.

## Applications and Grants

The number of applications for patents received was 1,114, just six more than in 1998. Following Ireland's ratification of the European Patent Convention in 1992, there was a noticeable reduction in the annual volume of patent applications being filed at the Office. However, the increase in recent years suggests the trend of the preceding years may be reversing. Applications claiming priority under the Paris Convention totalled 340.

Analyses by country of the applications received and patents granted are given in Appendix C and Appendix D, respectively. The number of applications received from applicants in the State was 996 compared with 985 in 1998.

Figures showing the numbers of patent applications received and patents granted by the office during the past three years are shown in the following Table:

YEAR	APPLICATIONS RECEIVED	PATENTS GRANTED
1997	940	1,405
1998	1,108	594
1999	1,115	320

The background to the reduced patent grant figures in the past 2 years is as follows. At the end of 1997 the Office had 10 professional patent examination staff. None of these staff wished to relocate to Kilkenny in connection with the decentralisation there of the Office.

As a consequence, the Department of Enterprise, Trade & Employment decided that the 10 staff in question should be dispersed and assigned to other duties and new patent examiner staff recruited. At the same time the Department decided following the BPR exercise mentioned earlier, that the complement of examiner staff, post-relocation in Kilkenny, was to be 5. Only one of the new examiner staff had been recruited by the date set for the opening of the Office in Kilkenny and 1 of the 5 has still not been recruited. The drop in patent examiner numbers and the time involved for training-in of the new examiners all meant that output of patent grants would inevitably be affected. When the new staff become more familiar with the work and the outstanding examiner is assigned and trained the output figure may be expected to rise.

## Assignments and other miscellaneous matters

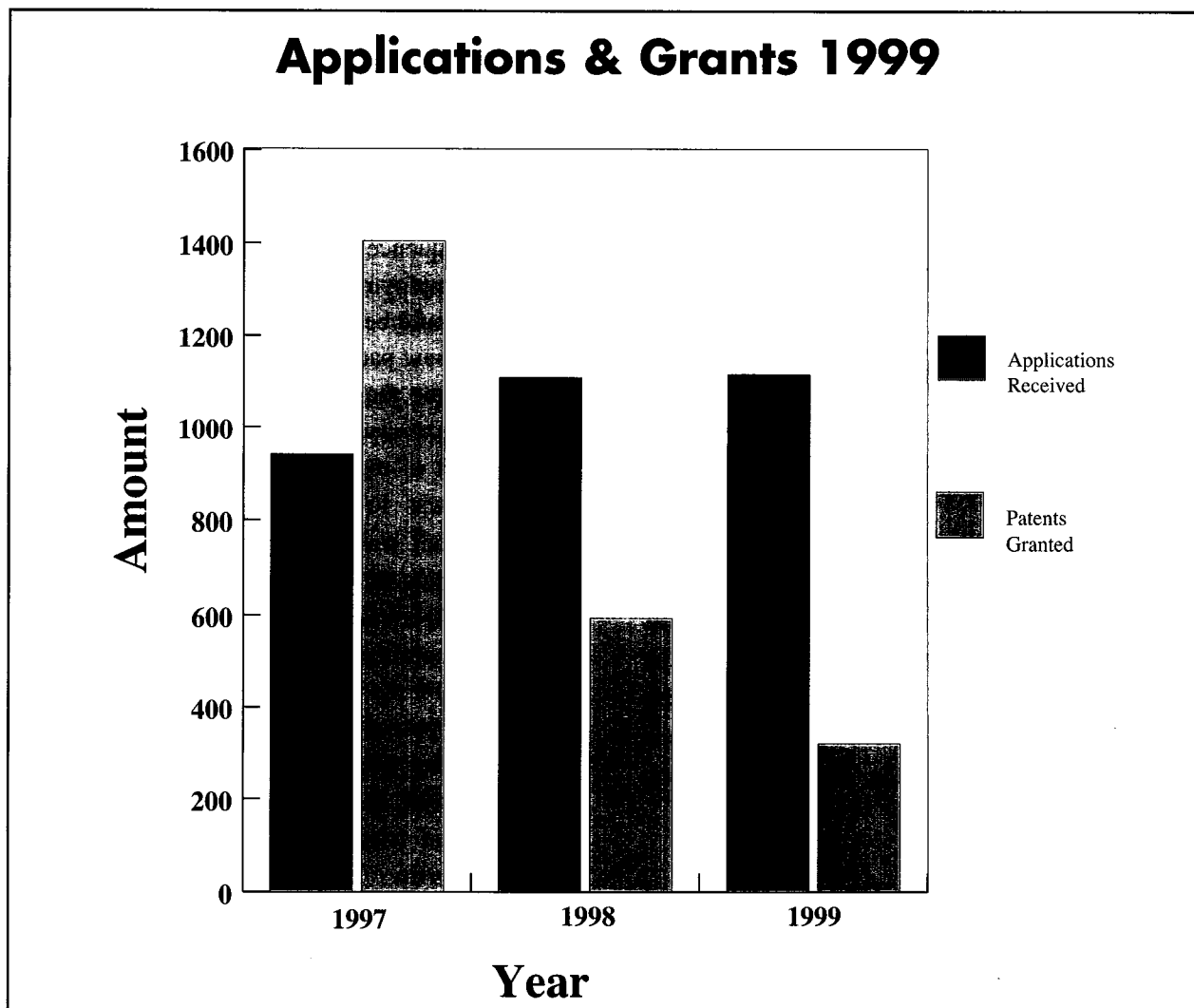
Applications allowed under Section 85 of the 1992 Act for registration of assignments, etc. of patent applications, patents and supplementary protection certificates affected a total of 370 patents and patent applications, and one supplementary protection certificate.

The Office acts as a receiving office for European patent applications and for international applications filed under the Patent Co-Operation Treaty (PCT), which was ratified by Ireland during 1992. The number of international applications received at the Office, as a receiving office under the PCT, was 144. Following completion of the receiving office functions under the PCT, these applications are transmitted to the World



Intellectual Property Organisation. The number of European applications filed for onward transmission to the European Patent Office was 123, of which 65 were filed by applicants whose places of residence or principal places of business were outside the State.

In 1999, the number of European patents designating Ireland was 6968, compared to 6,518 in 1998. These patents were entered in the National Register of Patents. They have the same legal status in Ireland as if they had been granted by my Office.



\* European applications designating Ireland (first arising in 1992) are not included in the above chart and amount to:

Year	Filings
1992	11,755
1993	35,762
1994	40,705
1995	44,161
1996	52,755
1997	41,875
1998	61,584
1999	65,708

The 1999 applications received figure includes 590 applications for short-term patents under Part III of the 1992 Act, which came into force on 1 August 1992. The 1999 figure for patents granted includes 148 short-term patents.

An analysis of the patents granted as classified according to the Subsections of the International Classification of Patents for Inventions is given in Appendix E.

### **Revocations**

The application to the Controller for revocation of a patent mentioned in last year's report, is still pending. One application was made during the year leaving a total of two applications for revocation pending at the end of the year.

### **Petitions for Extensions of Terms of Patents under the 1964 Act**

The six petitions to the High Court for extensions of terms of patents mentioned as pending in last year's report, were still pending at the end of 1999.

### **Patents in force**

The number of patents in force in Ireland on the 31 December 1999 was 24,650. The number of patent renewal fees paid was 10,746 of which particulars are given in Appendix F, together with figures from the previous nine reports. Patents that lapsed due to the non-payment of renewal fees numbered 2,497, and 168 expired through effluxion of time.

### **Restoration of Lapsed Patents**

At the end of last year, eight applications for restoration of lapsed patents and one application for restoration of a lapsed patent application were pending. Nine applications for restoration of lapsed patents were received in 1999. Eight patents and one patent application were restored during the year, leaving nine applications for restoration of lapsed patents pending at the end of the year.

### **Applications for Licences under Section 42 of the 1964 Act**

The 1964 Act was revoked by the 1992 Act, but the Transitional Provisions of the latter provide that licence applications that were pending on the date of its entry into force (viz. 1 August 1992) will be considered, and decided, under the provisions of the 1964 Act.

Fourteen applications for licences had been made under the 1964 Act. Two were deemed to be invalid on the grounds that the patents to which they related were not in force at the time the applications for the licences were made; in another case I decided not to grant a licence; and in two cases I made an order for the grant of a licence. My order was appealed to the High Court by the patentees concerned and the judgement of that Court, delivered in July 1996, was appealed to the Supreme Court by the applicant for the licences and by the Controller.

Subsequently, the applicant decided not to pursue its appeal. The appeal of the Controller was still pending at the end of 1998. On the afternoon of 22 January 1999, I was informed by the Chief State Solicitor's Office that my appeal had come before the Supreme Court that morning and that on instructions given by the Attorney General's Office my appeal was withdrawn. I had not been aware, in advance, that the matter was to be before the Court that day and had not consented to the withdrawal.

### **Requests for Supplementary Protection Certificates**

A total of 19 requests for Supplementary Protection Certificates were received during the year under the European Communities (Supplementary Protection Certificates) Regulations, 1992 (medicinal) and 1996 (plant protection products). During the year, 25 certificates were granted (20 medicinal and 5 plant protection). This figure includes two Supplementary Protection Certificates, which were originally granted in 1996 but were cancelled

following a hearing and re-granted in 1999. At the end of the year there were 44 requests pending.

### **Register of Patent Agents**

The Board appointed by the Minister under Rule 6 of the Register of Patent Agents Rules, 1992 held

examinations during the year (pursuant to Rule 7 of the Rules). One new name was entered in the register during the year. Two names were removed at the request of the individuals concerned for a specified period. At the end of the year, there were 30 individuals and five partnerships entered in the Register of Patent Agents.

# DESIGNS

Applications for the registration of designs received during the year totalled 657, being 111 more than in 1998.

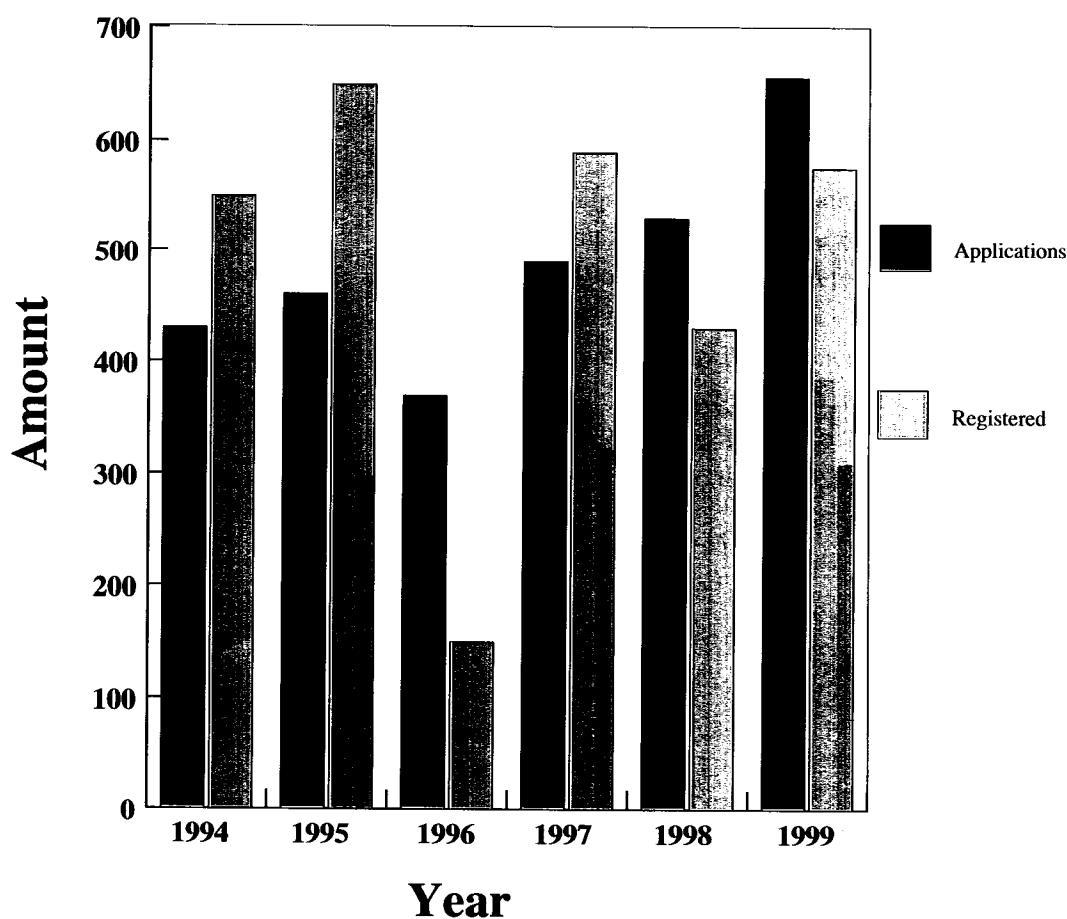
An analysis by country of the applications received is given in Appendix C. Applications filed by residents in the State totalled 227 compared with 126 for 1998.

The number of designs registered during the year was 576. Particulars of registration by country of

origin of proprietor are given in Appendix D. The period of protection was extended for a second period of five years in 218 cases and a third period of five years in 176 cases. Three hundred and eighty registrations lapsed. The total number of designs in force at the end of the year was 3513.

The number of designs registered according to the International Classification of Designs is shown in Appendix H.

## Design Applications and Registrations

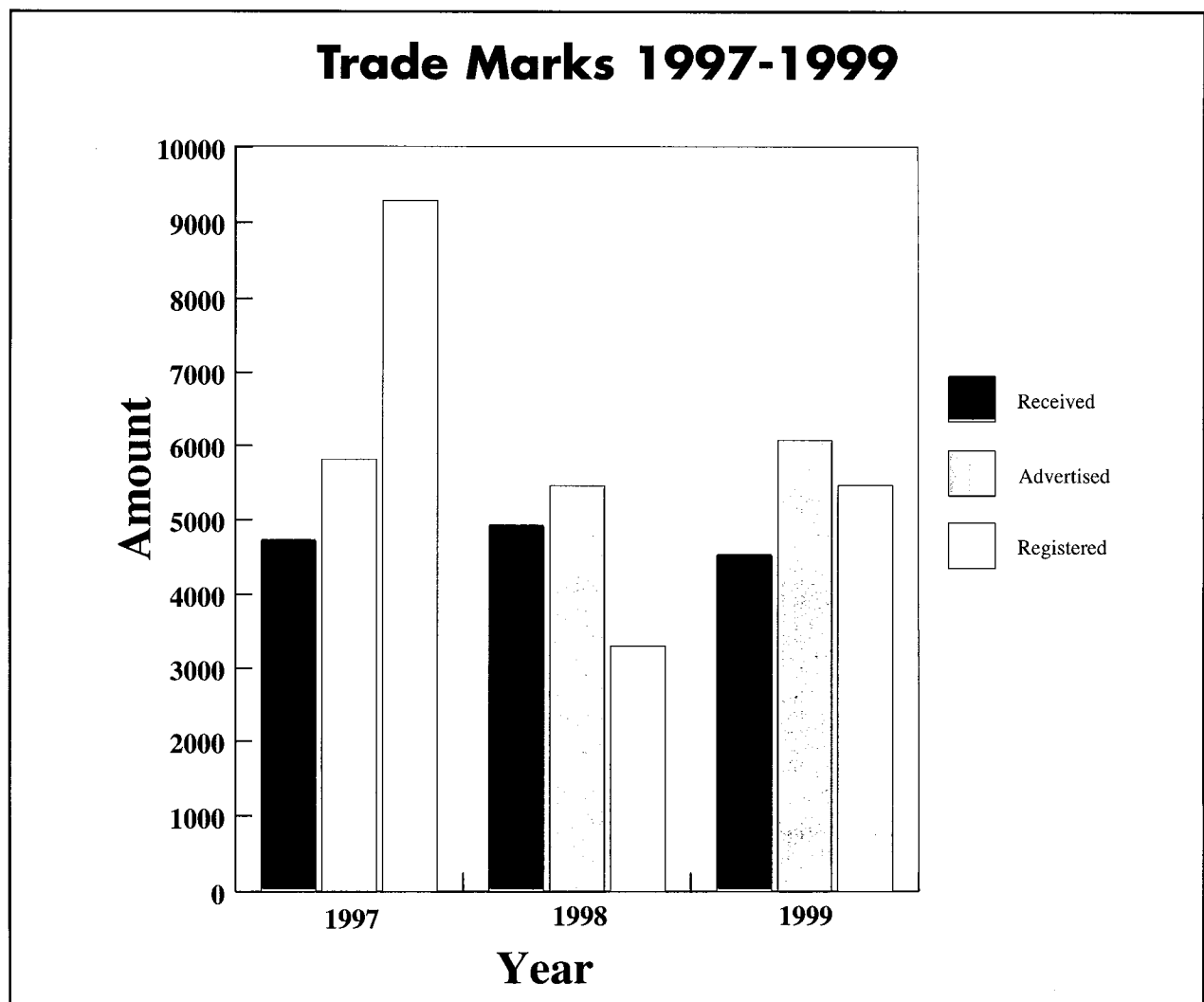


# TRADE MARKS

## Applications and Registrations

The number of applications for the registration of trade marks received during the year, together with the number of marks advertised in the Journal and registered, are given in the table below, with comparative figures for the previous two years.

Year ended	Applications		Registered
	Received	Advertised	
1997	4,709	5,812	9,288
1998	4,910	5,460	3,301
1999	4,518	6,077	5,464



The 4,518 trade mark applications received in 1999 includes 1355 applications in respect of services. The variance in the applications received figures is due partly to the provision in the 1996 Trade Marks Act under which an application can now relate to more than one class of goods/services.

During the year under review, significant progress was made in relation to the examination of trade mark applications. Approximately 5,726 applications were examined during the year. This resulted in further improvement being made in reducing the length of time between the date of filing an application and initial examination stage. This has been reduced from five months at the beginning of 1999 to 14 weeks at the end of the year.

On 1 August 1999, the Office commenced using the “Marquesa” system for searching the trademarks database of the Office for Harmonisation in the Internal Market (O.H.I.M.). This means that prior to examination, a national trade mark application is now subjected to two searches: a search of the National database as was heretofore the case, and a search of the community trade mark database using the Marquesa system. This additional necessary search has doubled the workload of the search section, and given that only two searchers are assigned to the Office, it was necessary to involve trade mark examiners in the search process. The output from the examination division is therefore significant, in view of the additional search work and the considerable amount of time spent by staff in testing the new office computer system (Ptolmey).

Analyses by country of the applications received and trade marks registered are given in Appendix C and Appendix D, respectively.

Applications filed by persons resident in the State totalled 1123 compared with 1,039 in 1998. Details of the international classification of goods and services into which the trade marks registered in 1999 fall are shown in Appendix G.

The number of registrations of trade marks renewed was 4,828. The number removed from the Register for non-payment of renewal fees was 2,692. Six registrations were restored by order of the Controller. On 31 December 1999, the number of registered trade marks in force was 89,626.

### **Appeals**

The four notices of appeal to the High Court pending at the end of 1998 are still pending. During 1999, no notice of appeal was filed.

### **Oppositions to Registration**

There were 304 notifications of opposition pending at the end of 1998. During the year, 178 further notifications were received. Taking into account cases decided during the year, withdrawals of oppositions and withdrawals of certain applications for registration following receipt of notice of opposition, there were 318 notifications of opposition pending at the end of 1999.

### **Assignments and Transmissions**

During the year, 501 persons were entered in the Register as proprietors of trade marks consequent on assignments or transmissions. The number of trade marks affected was 1670.

### **Matters affecting the Register of Trade Marks**

There were seven applications made under section 34 of the 1963 Act for removal of registered marks, pending at the end of the year.

Eleven applications made under Section 40 of the 1963 Act for rectification of the register were pending at the end of the year.

At the end of the year, 34 applications under Section 51 of the 1996 Act for revocation of registrations and one application under Section 52 of the 1996 Act for a declaration of Invalidity of registration were pending.

## **Community Trade Mark Applications**

During 1999, a total of 50 Community Trade Mark (C.T.M.) applications were filed through the Office, and forwarded to the Office for Harmonisation in the Internal Market (O.H.I.M.), Alicante, Spain. The Office received a £20/€25.39 handling fee in respect of each application.

## **Searching of Community Trade Mark Applications**

Under Article 39(3) of Council Regulation No. 40/94 of 20 December 1993 on the Community Trade Mark, the Office may search C.T.M. applications and convey the result of its searches to O.H.I.M.; the results of searches must be with O.H.I.M. within three months of the date on which the Office received the C.T.M. applications from O.H.I.M. During 1999, the Office received 44,109 C.T.M. applications for searching under the above regulation and the results of 610 searches were forwarded to O.H.I.M.

The inability of the Office to keep up with the searching of O.H.I.M. applications arose as a result of the reduction in the Office's authorised number of search staff from six staff to two under the Business Process Re-engineering (BPR) exercise referred to earlier. (The 44109 CTM applications was itself also a significant increase in the volume of such applications). In the circumstances, and in order not to neglect the processing (including searching) of national applications it was agreed with the Intellectual Property Unit of the Department that searching of C.T.M. applications should cease for the time being in favour of national trade mark applications. The cessation became operative from 7 January 1999 and O.H.I.M. was advised accordingly. At the end of 1999 this work remained suspended. The Office is awaiting the outcome of the business case for additional searchers to carry out this work which it

made to the Department. Until the situation is addressed, significant search income from O.H.I.M. is being foregone. In 1998 such income amounted to over £890,000/€1,130,000. O.H.I.M. has notified the Office that from January 2000 the expected volume of search requests will be 800 – 850 per week

The Office is also pursuing, with the Department's IT Unit, IT-based solutions to assist in the performance of this work. Funding for this was not available out of the 1999 Budget. However, provision has been made in the IT Unit's 2000 Budget for the enhancement of the Office's new computerised search system, with a view to re-commencing searching C.T.M. applications.

Receipts in respect of search fees received from the O.H.I.M. during 1999 amounted to £98,136.89/€124,608.15. The Office made a refund of £9,551.76/€12,128.23 in respect of an adjustment of the amount paid to the Office by O.H.I.M. for 1998. The refund arose as a result of a change in the rate of payment of search fees from 1 January 1998.

## **Licences/Registered Users**

During the year, 278 applications under Section 29 of the 1996 Act were dealt with, leaving 21 applications pending at the end of the year

Of the applications to register registered users of marks which were pending on 1 July 1996, 110 such applications were pending at the end of the year.

## **Register of Trade Mark Agents**

At the end of the year under review, there were 115 individuals and six partnerships entered on the Register.

# COPYRIGHT

## **Disputes Referred under Section 31 of the Copyright Act, 1963**

Under this Section, disputes between persons using sound recordings in public, and the owner of the copyright subsisting in the recordings, regarding the equitable remuneration payable to the copyright owner, may be referred to me for determination. In the period September 1989 to December 1995, 62 references were made by establishments using sound recordings.

Early in 1991, while the procedures preliminary to hearings of the earliest referred disputes were in train, the licensing body (the respondent in the proceedings) put the legal basis upon which the references had been made (i.e. Section 31) at issue. My finding that such references had properly been made under Section 31 gave rise to Judicial Review proceedings before the High Court being initiated by the licensing body; the respondents in these proceedings included certain of the establishments who had made references to me. The Court found, in October 1992, that the references should have been made under Section 32 of the Act, not Section 31, and, by Order, prohibited me from proceeding further in determining applications made to me by way of reference under Section 31 of the Act.

The judgement of the High Court was appealed to the Supreme Court by one of the respondents in the Judicial Review proceedings. In a judgement delivered on 1 October 1995, the Supreme Court reversed the decision of the High Court, which meant I was then free to proceed with the references on hand. Following the delivery by the Supreme Court of its Judgement the licensing body

involved in the proceedings proposed to me that I might consider appointing an arbitrator to deal with the cases referred to me (I have authority to do so under Section 41 of the Act). This proposal was put to the legal representative of the establishments involved in the references and both sides subsequently agreed upon the name of an arbitrator whom I then duly appointed on 15 July, 1996. The awards of the arbitrator were originally expected before the end of 1998. The matters were, however, still pending at the end of 1999.

## **New Copyright Legislation**

In April 1999, the Copyright and Related Rights Bill, 1999 was published. This Bill is designed to put in place a modern, comprehensive, and technology-neutral regime of statutory protection for copyright and related rights. When enacted, it will also transpose into Irish law certain EU Directives in the field of copyright and related rights, provisions in the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) and provisions in the copyright and related rights treaties established under the auspices of the World Intellectual Property Organisation (WIPO). The new legislation will also assign a range of new and additional functions to the Controller of Patents, Designs and Trade Marks. I have informed the Department of Enterprise, Trade and Employment that particular staff resources will be required for the discharge of these functions.

Initiated in the Seanad, the Bill passed all Stages there in October 1999. At the end of 1999 the Bill had passed the second stage in the Dail and the committee stage is expected to be taken early in 2000.



# INTERNATIONAL MATTERS

## European Patent Organisation

The Office continued to participate in the work of the major decision making organ of the European Patent Organisation, (E.P.O.) viz. The Administrative Council, and in the activities of a number of its subsidiary committees and working parties. An interesting development which took place during 1999 was the establishment of a special committee comprising representatives of the national patent offices of the member states and officials of the EPO to consider the development of EPOLINE. EPOLINE is to be the standard secure INTERNET process by which the EPO will conduct its business with applicants, national offices and the public. The EPOLINE Committee is currently considering the structure of the proposed system with particular emphasis on the use of the best available encryption technologies in order to ensure secure access for filing of patent applications, fee payments and other communications. Wide scale external user testing of the on-line filing aspect of EPOLINE is at present underway and full, legally valid, on-line filings at the E.P.O. via EPOLINE are envisaged by the end of 2000.

In the year under review I continued as Chairman of the Administrative Council of the EPO. In the previous year, the Council recognised the need to revise certain provisions of the European patent Convention (EPC). During 1999 this task received greater attention, with a large number of proposed amendments being referred to the EPO's Patent Law Committee for examination and opinion. The issues considered for revision action include – the criteria for patentability of inventions; provisions allowing for participation of national judges in the work of the E.P.O. Enlarged Board of Appeal; amendments to facilitate electronic filing of european patent applications; and other provisions to enhance the effectiveness and user friendliness

of the convention for patent applicants. The meeting of the Administrative Council which took place in Dublin in February 2000 decided to convene a diplomatic conference to revise the EPC; this conference will take place from 20 to 29 November 2000 in Munich.

## Inter-Governmental Conference

In a parallel with the deliberations of the Admin. Council of the E.P.O. on the revision of the EPC, another initiative aimed at enhancing the patents system in Europe was taken during 1999. The French Government organised an Intergovernmental Conference (IGC) in Paris from 24 – 25 June 1999, with the aim of agreeing upon a number of measures to increase the attractiveness and cost-effectiveness of the European Patent system to applicants. That conference resulted in the following actions:

- a working group was established and mandated to draw up, before 31 December 1999, a report containing proposals to be submitted to the Governments of the Contracting States and to the EPC Revision Conference with the aim of reducing translation-related costs by 50%.; and to draw up an optional protocol in relation to the language of european patent specifications.
- the IGC invited the EPO to undertake every possible effort to shorten application processing procedures, so as to bring the average time it takes to grant a European patent down to three years, whilst maintaining the level of quality.
- a recommendation was made that the Contracting States consider restricting the number of national courts dealing with patent litigation. Also, a working party was mandated to draft the text of an optional protocol to

the EPC with regard to litigation concerning European patents – this was to envisage an integrated judicial system, including uniform rules of procedure and a common court of appeal.

These matters will require careful consideration as the work of the Working Parties proceeds. Potential legal/constitutional problems may militate against Ireland's ratification of these protocols depending on their final shape and content.

The IGC also invited the European Patent Organisation to put forward proposals aimed at improving the decision making process, promoting transparency and maintaining fair treatment of all the Member States in anticipation of the accession of new Member States to the Convention within the next few years. A follow-up intergovernmental Conference is scheduled to take place in London in October 2000.

### **European Union**

The Debate on a system of grant of Community patents was revived with the June 1997 publication of the E.U. Commission Green Paper on the patent system in Europe. This initiative was part of the follow-up to the First action plan for innovation in Europe. Following receipt of the opinions of the Economic and Social Committee and the European Parliament the Commission has indicated its intentions to submit a proposal for establishment of

a Community Patent System by means of a Regulation based on Article 235 of the EC Treaty. The draft regulation is expected to be published in the Summer of 2000 and may be expected to have regard to the conclusions reached by the working groups established by the IGC.

### **The World Intellectual Property Organisation (WIPO)**

The Office also participated in a number of meetings of technical committees of the World Intellectual Property Organisation. These mainly concerned proposals for updating and improving various technical standards including those concerned with the development of a secure method of communicating patent data using the INTERNET and also the updating and improvement of the International Patent Classification system (IPC).

On July 6, 1999 the diplomatic conference on the revision of the Hague Agreement concerning the international deposit of industrial designs and models was successfully completed at WIPO headquarters in Geneva. The Hague Agreement is an international treaty which allows depositors to obtain protection for their designs and models in the contracting states using a single application. The provisions of the treaty are being considered by the Intellectual Property Unit of the Department of Enterprise, Trade and Employment in the context of new design legislation which the Unit is preparing.

# INFORMATION TECHNOLOGY

Responsibility for the provision of IT services at the Office, and the funding of the expenditure involved, rests with the Department of Enterprise, Trade and Employment.

Throughout 1999 the Office's IT Unit was dedicated to two principle tasks – the implementation of the new Trademark and Patent administrative system (Ptolemy); and ensuring that all computer services and applications were fully Year 2000 compliant.

The Ptolemy system uses state-of-the-art Web technologies in conjunction with the most up to date Relational Database Management Systems. Due to the fact that Ptolemy was in no way compatible with the Office's Advanced Revelation system, exhaustive work was carried out in order to migrate successfully from one to the other. It was necessary to check and verify that the data on the existing system was both complete and accurate prior to it being transferred to the new databases. A team of external consultants carried out a data capture exercise to ensure the completeness of the information held on the old system and the Office then validated this information against paper records.

The new system went live in December 1999 and it will provide the Office with most of the business

tools it requires in order to carry out its statutory obligations. Some of the new features include the automatic production of the Office Journal, a workflow management system and a Patents Search facility. Further developments are to come on-line during 2000 and the Office will continue to enhance and refine the system over the next two years.

By mid 1999, the Office completed all outstanding work associated with the potentially disastrous 'Millennium Bug'. All hardware and software was either replaced or upgraded and full roll-over testing was carried out. I am happy to report that the Office did not experience any difficulties as a result of the date change to the Year 2000.



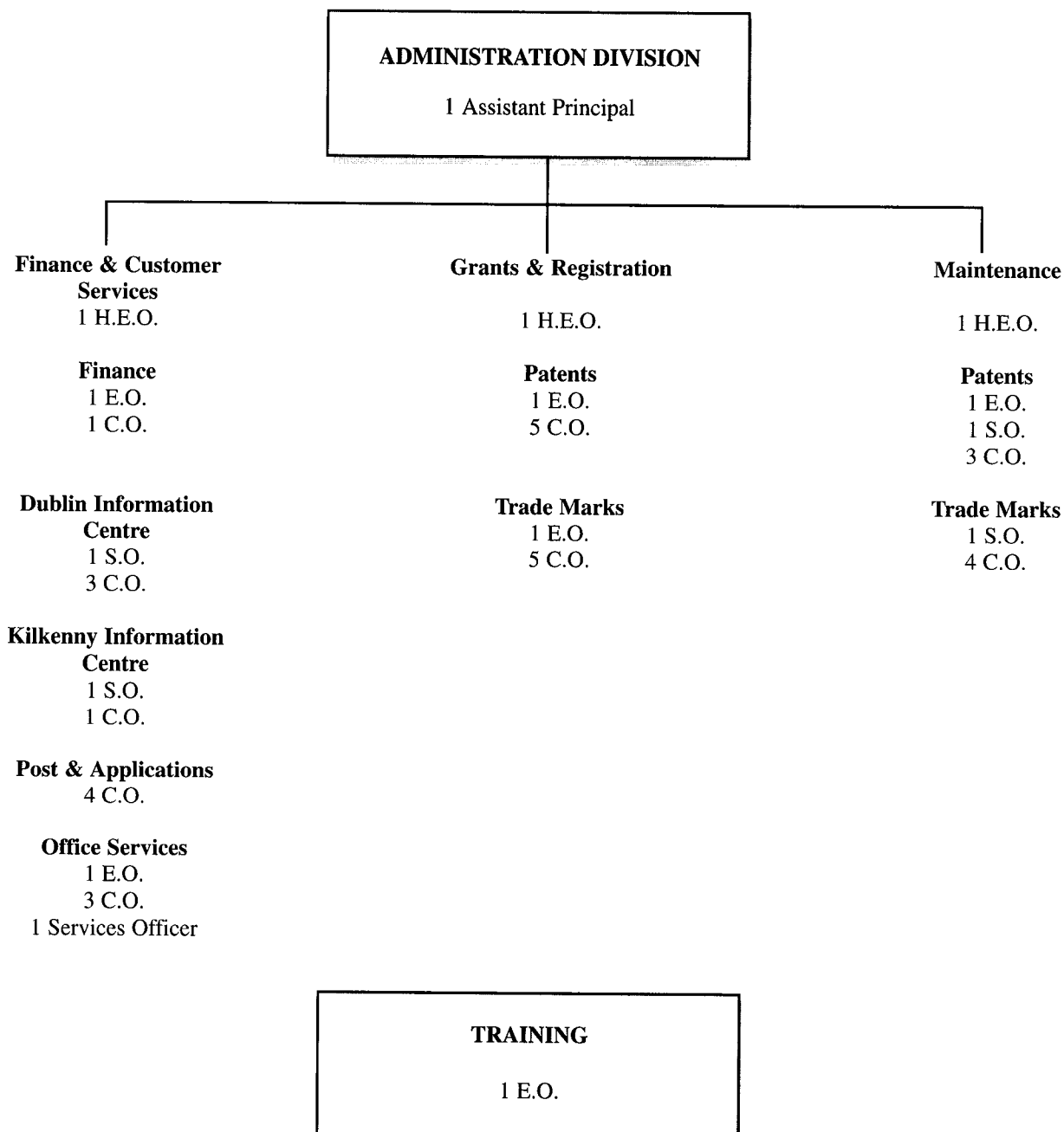
**S. FITZPATRICK,**

**CONTROLLER.**

*Dated this 31st day of May 2000.*

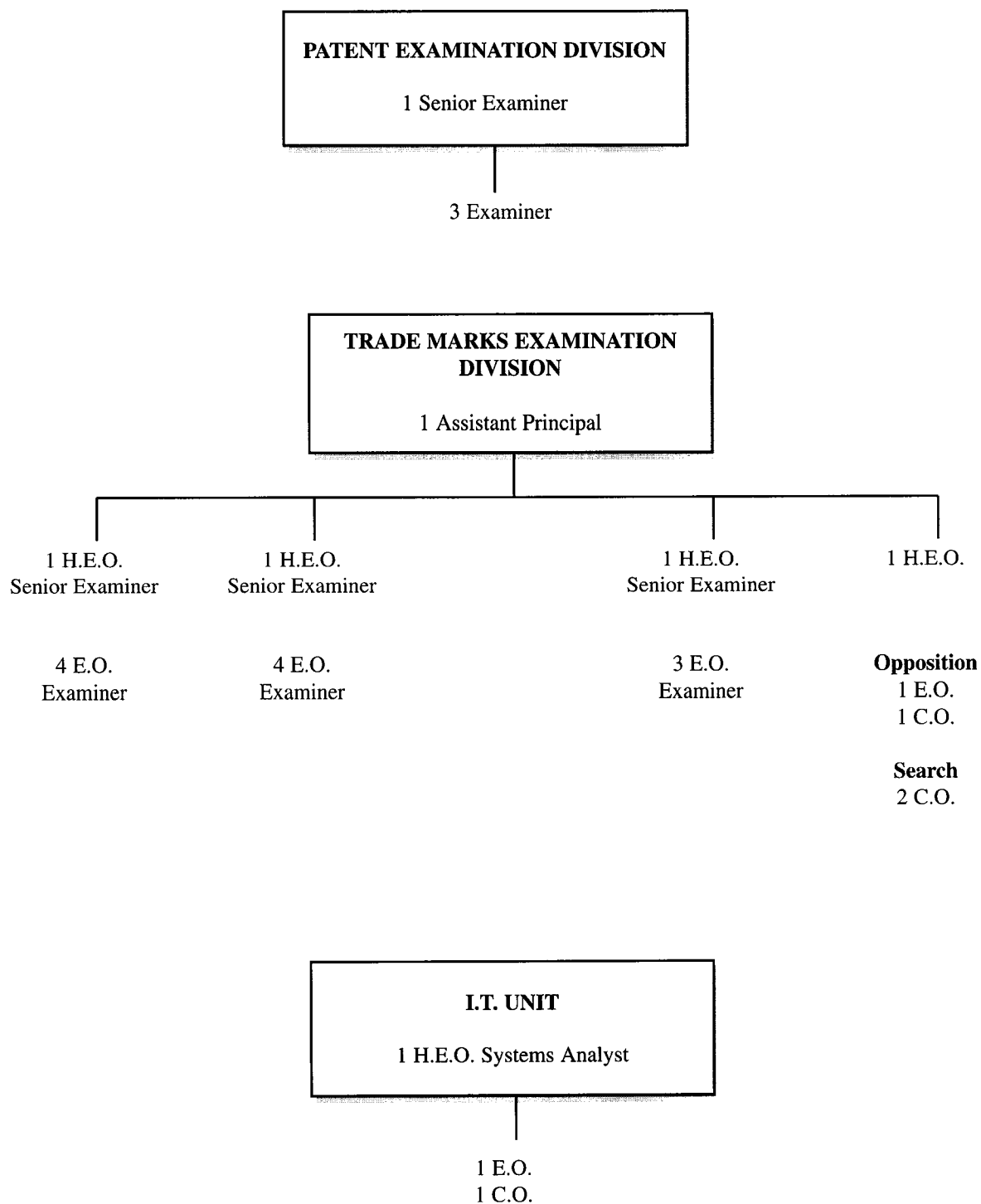
# APPENDIX A (contd.)

STAFF SERVING AT 31 DECEMBER 1999



# APPENDIX A (contd.)

STAFF SERVING AT 31 DECEMBER 1999



# APPENDIX B

## RECEIPTS AND EXPENSES - YEAR ENDED 31 DECEMBER 1999

### RECEIPTS

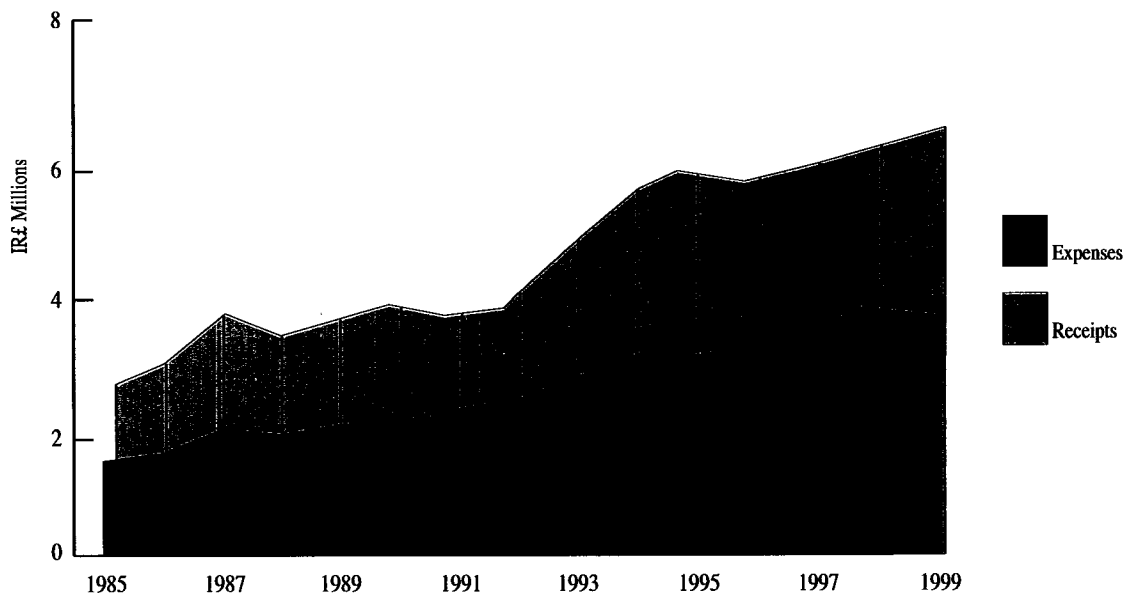
	£	€
Patent Fees	3,185,722.91	4,045,033.69
Design Fees	88,657.43	112,571.71
Trade Mark Fees	2,798,582.86	3,553,467.22
Registration of Patent Agents	2,729.99	3,466.37
Registration of Trade Mark Agents	1,300.00	1,650.66
Sales of Stationery Office Publications	6,758.94	8,582.08
SPC Applications	1,200.00	1,523.69
PCT Search Fees received for transfer to EPO, Munich	112,010.23	142,223.65
PCT Basic and Designation Fees received for transfer to WIPO, Geneva	145,441.16	184,672.18
Fees received for searching of Community Trade Mark applications	88,585.13	112,479.91
<b>Total</b>	<b>6,430,988.65</b>	<b>8,165,671.17</b>

### EXPENSES

	£	€
Salaries	1,607,589.09	2,041,217.08
Superannuation Charges	51,639.93	65,569.19
Cost of services rendered by the Department of Enterprise, Trade and Employment	185,413.00	235,425.95
Printing, Binding, etc.	31,797.21	40,374.13
Telephones	64,837.75	82,326.96
Postal Services	12,225.47	15,523.14
Refunds made in respect of Patents and Trade Mark fees paid in error	28,152.75	35,746.62
Subscriptions to Industrial Property Unions	249,061.83	316,243.29
Expenses of Representation at International Meetings and Travelling Expenses	46,790.74	59,411.98
Law Reporting and Legal Costs	18,639.11	23,666.79
Maintenance of Buildings, Rents, Rates, Heating, Furniture, etc.	146,852.01	186,463.59
Office Machinery, Computer Equipment, Stationary, etc.	323,178.91	410,352.57
Miscellaneous Payments	28,890.93	36,683.91
PCT Search Fees transferred to EPO, Munich	109,990.06	139,658.57
PCT Basic and Designation Fees transferred to WIPO, Geneva	144,843.74	183,913.61
Proportion of Renewal Fees for European Patents transferred to EPO	430,345.00	546,425.43
<b>Total</b>	<b>3,480,247.53</b>	<b>4,419,002.81</b>

## APPENDIX B (contd.)

### Receipts and Expenses 1985 - 1999



# APPENDIX C

## APPLICATIONS ACCORDING TO COUNTRY OF ORIGIN OF APPLICANT

COUNTRY	PATENTS		TRADE MARKS		DESIGNS	
	No. of Applications	Percentage of total No.	No. of Applications	Percentage of total No.	No. of Applications	Percentage of total No.
REP. OF IRELAND	996	89.40	1123	24.86	227	34.56
ARGENTINA	-	-	2	.04	-	-
AUSTRALIA	-	-	10	.22	9	1.37
AUSTRIA	-	-	14	.31	-	-
BARBADOS	-	-	2	.04	-	-
BAHAMAS	-	-	1	.02	-	-
BELGIUM	1	.09	46	1.02	1	0.15
BERMUDA	-	-	2	.04	-	-
BRAZIL	-	-	2	.04	2	0.3
BRITISH VIRGIN ISLANDS	-	-	2	.04	-	-
BULGARIA	-	-	2	.04	-	-
CAYMAN ISLANDS	-	-	1	.02	-	-
CANADA	5	.45	27	.60	-	-
CHILE	-	-	12	.27	-	-
CHINA	-	-	7	.16	-	-
CYPRUS	1	.09	-	-	-	-
CZECH REP.	-	-	3	.07	-	-
DENMARK	5	.45	16	.35	6	0.91
DOMINICAN REPUBLIC	-	-	4	.09	-	-
FINLAND	1	.09	3	.07	5	0.76
FRANCE	3	.27	457	10.12	49	7.46
GERMANY	3	.27	580	12.84	38	5.78
GIBRALTAR	1	.09	5	.11	-	-
HONG KONG	-	-	3	.07	-	-
HUNGARY	-	-	2	.04	-	-
ICELAND	1	.09	2	.04	2	0.3
INDIA	-	-	1	.02	-	-



# APPENDIX C (contd.)

## APPLICATIONS ACCORDING TO COUNTRY OF ORIGIN OF APPLICANT

COUNTRY	PATENTS		TRADE MARKS		DESIGNS	
	No. of Applications	Percentage of total No.	No. of Applications	Percentage of total No.	No. of Applications	Percentage of total No.
ISRAEL	-	-	1	.02	-	-
ITALY	2	.18	56	1.24	8	1.22
JAPAN	3	.27	54	1.20	7	1.07
KOREA (Republic)	-	-	9	.20	-	-
KOREA (Dem.Peoples Rep)	-	-	2	.04	-	-
LIECHTENSTEIN	-	-	5	.11	-	-
LUXEMBOURG	-	-	21	.46	12	1.83
MAURITIUS	-	-	1	.02	-	-
MEXICO	-	-	1	.02	-	-
MONACO	-	-	9	.20	-	-
MOROCCO	1	.09	-	-	-	-
NETHERLANDS	1	.09	189	4.18	24	3.65
NEW ZEALAND	1	.09	1	.02	-	-
NORWAY	-	-	25	.55	1	0.15
PORTUGAL	-	-	12	.27	-	-
PUERTO RICO	-	-	1	.02	-	-
SINGAPORE	-	-	3	.07	-	-
SLOVENIA	-	-	1	.02	-	-
SOUTH AFRICA	-	-	18	.40	-	-
SPAIN	1	.09	50	1.11	11	1.67
SWEDEN	1	.09	48	1.06	31	4.72
SWITZERLAND	7	.69	190	4.21	6	0.91
TAIWAN	-	-	3	.07	-	-
THAILAND	-	-	1	.02	-	-
TURKEY	-	-	3	.07	-	-
UNITED KINGDOM	42	3.32	793	17.55	91	13.85
USA	43	3.9	692	15.33	127	19.34
<b>TOTAL</b>	<b>1114</b>	<b>100%</b>	<b>4518</b>	<b>100%</b>	<b>657</b>	<b>100%</b>

# APPENDIX D

## PATENTS GRANTED AND DESIGNS AND TRADE MARKS REGISTERED ACCORDING TO COUNTRY OF ORIGIN OF PATENTEE OR PROPRIETOR

COUNTRY	PATENTS		TRADE MARKS		DESIGNS	
	No. of Grants	Percentage of total No.	No. of Registered	Percentage of total No.	No. of Registered	Percentage of total No.
REP. OF IRELAND	214	66.89	837	15.32	159	27.6
ANDORRA	-	-	10	0.18	-	-
ANTILLES (Netherlands)	-	-	3	0.05	-	-
ARGENTINA	-	-	4	0.07	-	-
AUSTRALIA	1	.31	27	0.49	9	1.56
AUSTRIA	-	-	19	0.35	2	0.35
BAHAMAS	-	-	9	0.16	-	-
BARBADOS	-	-	3	0.05	-	-
BELGIUM	3	.94	55	1.01	-	-
BERMUDA	-	-	9	0.16	-	-
BRAZIL	-	-	2	0.04	-	-
BRITISH VIRGIN ISLS.	-	-	1	0.02	-	-
CANADA	-	-	21	0.38	5	0.87
CAYMAN ISLS.	-	-	2	0.04	-	-
CHILE	-	-	2	0.04	-	-
CHINA	-	-	16	0.29	-	-
CROATIA	-	-	1	0.02	-	-
CUBA	-	-	4	0.07	-	-
CYPRUS	-	-	4	0.07	1	0.17
CZECH REP.	-	-	1	0.02	-	-
DENMARK	-	-	25	0.46	8	1.39
FINLAND	-	-	18	0.33	4	0.7
FRANCE	8	2.50	504	9.22	29	5.03
GERMANY	3	.94	715	13.09	30	5.21
HONG KONG	-	-	8	0.15	1	0.17
HUNGARY	-	-	13	0.24	-	-
ICELAND	-	-	-	-	1	0.17
INDIA	-	-	2	0.04	-	-
ISRAEL	-	-	1	0.02	3	0.52

# APPENDIX D (contd.)

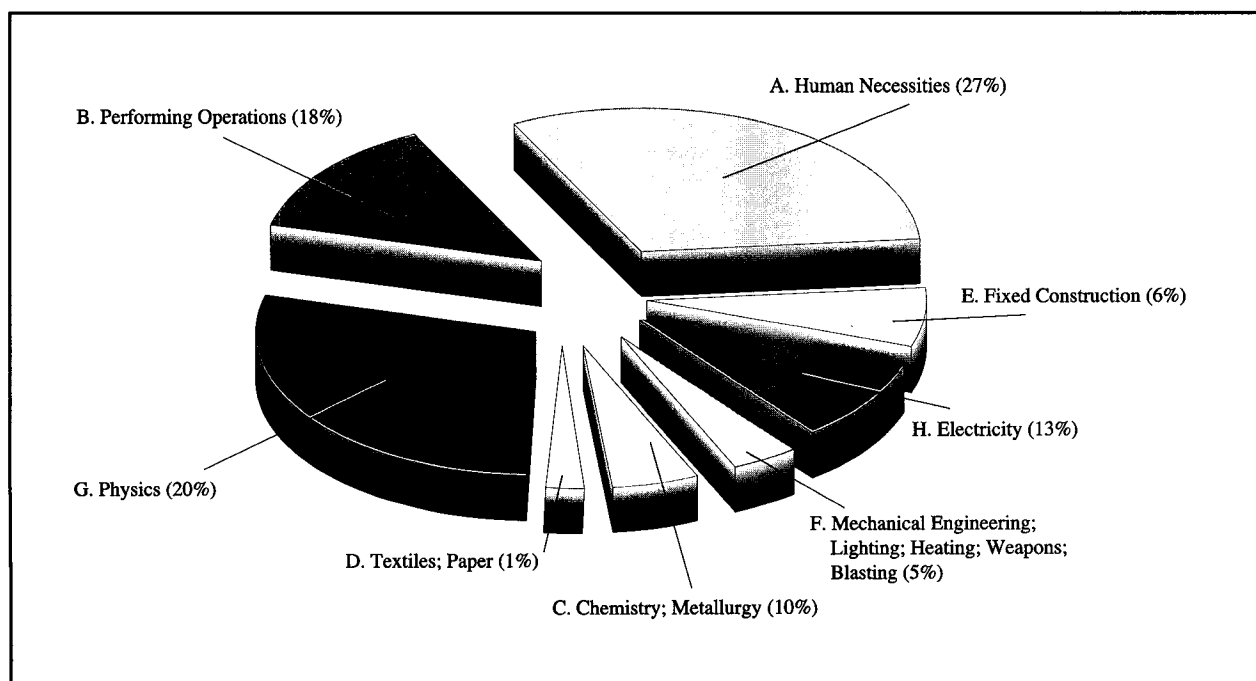
## PATENTS GRANTED AND DESIGNS AND TRADE MARKS REGISTERED ACCORDING TO COUNTRY OF ORIGIN OF PATENTEE OR PROPRIETOR

COUNTRY	PATENTS		TRADE MARKS		DESIGNS	
	No. of Grants	Percentage of total No.	No. of Registered	Percentage of total No.	No. of Registered	Percentage of total No.
ITALY	2	.62	99	1.81	18	3.13
JAMACIA	-	-	1	0.02	-	-
JAPAN	1	.31	92	1.68	2	0.35
KOREA (Democratic Peoples Republic of)	-	-	1	0.02	-	-
REPUBLIC OF KOREA	-	-	37	0.68	-	-
LIECHTENSTEIN	-	-	18	0.33	-	-
LITHUANIA	-	-	1	0.02	-	-
LUXEMBOURG	-	-	26	0.48	7	1.22
MEXICO	-	-	3	0.05	-	-
MONACO	-	-	20	0.37	-	-
NETHERLANDS	-	-	182	3.33	17	2.95
NEW ZEALAND	-	-	2	0.04	-	-
NORWAY	1	.31	13	0.24	-	-
POLAND	-	-	3	0.05	-	-
PORTUGAL	-	-	12	0.22	-	-
ROMANIA	1	31	-	-	-	-
SINGAPORE	-	-	2	0.04	-	-
SLOVENIA	-	-	2	0.04	-	-
SLOVAKIA	-	-	1	0.02	-	-
SOUTH AFRICA	-	-	7	0.13	-	-
SPAIN	1	.31	49	0.90	10	1.74
SWEDEN	6	1.86	59	1.08	34	5.9
SWITZERLAND	12	3.75	319	5.84	2	0.35
THAILAND	-	-	2	0.04	-	-
TURKEY	-	-	2	0.04	-	-
UNITED ARAB EMIRATES	-	-	1	0.02	-	-
UNITED KINGDOM	24	7.50	1091	19.97	84	14.58
USA	43	13.45	1102	20.17	150	26.04
VENEZUELA	-	-	1	0.02	-	-
<b>TOTAL</b>	<b>320</b>	<b>100%</b>	<b>5464</b>	<b>100%</b>	<b>576</b>	<b>100%</b>

# APPENDIX E

## PATENTS GRANTED DURING THE YEAR ENDED 31 DECEMBER 1999 CLASSIFIED ACCORDING TO THE INTERNATIONAL CLASSIFICATION

CLASSIFICATION	PATENTS GRANTED
A. HUMAN NECESSITIES	86
B. PERFORMING OPERATIONS	56
C. CHEMISTRY; METALLURGY	33
D. TEXTILES; PAPER	4
E. FIXED CONSTRUCTIONS	19
F. MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING	17
G. PHYSICS	65
H. ELECTRICITY	40
TOTAL	320



# APPENDIX F

## RENEWAL FEES PAID TO KEEP PATENTS IN FORCE FOR YEARS ENDED 31 DECEMBER 1990 TO 1999

Year ending 31 December										
Year for which paid	1990	1991	1992	1993	1994	1995	1996	1997	1998	1999
3rd year*	—	—	41	1,241	1,924	3,463	1,803	1,520	293	232
4th year*	—	—	41	1,238	1,882	3,424	2,142	2,019	848	486
5th year	836	855	684	1,296	1,874	3,097	2,026	2,955	1,924	1218
6th year	836	853	683	1,296	1,831	2,635	1,606	2,253	2,644	1840
7th year	828	861	668	1,303	1,698	1,817	1,560	1,550	1,726	1847
8th year	799	848	666	1,384	1,188	1,362	1,280	1,446	1,140	637
9th year	1,130	982	643	1,254	756	1,032	1,143	1,216	1,171	639
10th year	938	945	944	885	641	879	880	1,052	994	667
11th year	773	731	856	756	565	742	769	814	915	563
12th year	642	648	684	643	490	666	678	696	725	550
13th year	551	522	589	520	420	579	602	627	623	408
14th year	481	437	448	447	321	503	504	555	550	357
15th year	446	371	416	370	288	370	439	466	495	275
16th year	318	328	321	295	239	312	319	413	411	271
17th year*	—	—	113	248	169	281	281	300	362	239
18th year**	—	—	—	93	165	221	246	247	270	198
19th year***	—	—	—	—	55	185	183	220	217	151
20th year****	—	—	—	—	—	64	158	164	185	114
<b>Total</b>	<b>8,578</b>	<b>8,381</b>	<b>7,797</b>	<b>13,269</b>	<b>14,506</b>	<b>21,632</b>	<b>16,619</b>	<b>18,513</b>	<b>15,493</b>	<b>10,746</b>

\* Patent renewal fees not payable in respect of 3rd, 4th and 17th years prior to 1st August 1992

\*\* Patent renewal fees not payable in respect of 18th year prior to 1st August 1993.

\*\*\* Patent renewal fees not payable in respect of 19th year prior to 1st August 1994.

\*\*\*\* Patent renewal fees not payable in respect of 20th year prior to 1st August 1995.

# APPENDIX G

## TRADE MARKS REGISTERED DURING THE YEAR ENDED 31 DECEMBER 1999 LISTED ACCORDING TO THE INTERNATIONAL CLASSIFICATION

Class	Classification of Goods	Trade Marks Registered
01	Chemical Products, etc.	183
02	Paints, etc.	44
03	Bleaching Preparations, etc.	571
04	Industrial Oils, etc.	62
05	Pharmaceutical Substances, etc.	1089
06	Unwrought and Partly Wrought Common Metals and their Alloys	82
07	Machines and Machine Tools, etc.	77
08	Hand Tools and Instruments, Cutlery, etc.	30
09	Scientific Apparatus and Instruments, etc.	519
10	Surgical Instruments, etc.	223
11	Installations for Lighting, etc.	97
12	Vehicles; Apparatus for Locomotion by Land, Air or Water	180
13	Firearms, Ammunition and Projectiles; Explosive Substances; Fireworks	2
14	Precious Metals and their Alloys, etc.	89
15	Musical Instruments (other than talking machines and wireless apparatus)	10
16	Paper, etc.	338
17	Gutta Percha, India Rubber, etc.	52
18	Leather, etc.	122
19	Building Materials, etc.	93
20	Furniture, etc.	71
21	Small Domestic Utensils, etc.	133
22	Ropes, etc.	13
23	Yarns, Threads	7
24	Tissues (piece goods), etc.	58
25	Clothing, including Boots, Shoes and Slippers	388
26	Lace and Embroidery, etc.	25
27	Carpets, etc.	22
28	Games, etc.	97
29	Meat, Fish, Poultry and Game, etc.	272
30	Coffee, Tea, Cocoa, Sugar, Rice, etc.	406
31	Agricultural Products, etc.	120
32	Beer, etc.	139
33	Wines, Spirits and Liqueurs	124
34	Tobacco, etc.	57
35	Advertising, Business Management, etc.	276
36	Insurance, Financial Affairs, etc.	344
37	Building Construction, Repair, Installation Services.	176
38	Telecommunications	189
39	Transport, Packaging and Storage of Goods, etc.	203
40	Treatment of Materials	63
41	Education, Entertainment, etc.	351
42	Providing of Food & Drink, Legal Services, Services that cannot be Classified in Other Classes	538

# APPENDIX I

The following new legislation came into force in 1999.

## **Statutory Instruments**

Patent and Trade Mark (Fees) Rules, 1999 (S.I. No. 403 of 1999)

Patent and Trade Mark (Fees) Rules, 1999 (S.I. No. 434 of 1999)

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