



## Practice Note

concerning

# The nomination of evidence of novelty in respect of Part II patent applications submitted under the provisions of Section 127A of the Patents Act.

### Legislation

- Patents Act 1992, as amended: Ss 29(1), 30(1) & 127A
- Patent Rules, 1992, as amended: Rs 24(1), 27(1) & 87A(7)  
*See the appendix for the relevant provisions.*

### Overview

Where a Request is made under Section 127A for a PCT application to be treated as a patent application under Part II of the Patents Act, the Controller will accept statements according to Section 30 of intent to submit evidence in lieu of the provision or commissioning of a search report and written opinion, and allow said application, where the Request has been allowed, to proceed in accordance with Section 30 of the Act.

## **Introduction**

Section 127A of the Patents Act allows an applicant for a patent under the Patent Cooperation Treaty (PCT) to request that their application under the Treaty be treated by the Controller as an application under Part II of the Patents Act. Rule 87A sets out the requirements for such requests, and the conditions under which they are allowed.

In particular, the Rules explicitly allow the applicant to submit a search report and written opinion performed either in connection with the Treaty application or in accordance with Rule 27(1) to be admitted as evidence under Section 30, and failing that require the Controller to cause a search report under Section 29.

The question has arisen as to whether an applicant under Section 127A can nominate evidence not yet available, in accordance with Section 30 and Rule 27.

Having considered the matter the Controller is of the view that such a course is open to the applicant, under certain conditions.

## **Rationale**

The purpose of Section 127A is to allow a person or persons to make a Request for an application for a patent made under the PCT that their application be treated as an application made under Part II of the Patents Act.

To ensure the novelty and inventiveness of such an application, Rule 87A requires *inter alia* that unless the Request is accompanied by a search report and written opinion as specifiable under Rule 27, the Controller to cause the application to proceed in accordance with Section 29 and Rule 24. On a first reading, this is disadvantageous to an applicant who has reasonable expectation that evidence specifiable under Rule 27(1) will be forthcoming at a later date.

Since the application is to be treated as a Part II application, such an application should not be unduly disadvantaged in comparison to an application made directly under Part II, once the differences in circumstance of the Section 127A request are taken into account.

Section 30 sets out that it may be invoked for applications under Part II in lieu of Section 29 (the commissioning of a search report and written opinion). Since the application under Section 127A, once accepted, is treated like a patent application made under Part II, it would be unfair to deny this important aspect of a patent applicant's rights under Part II.

Equally, neither should an application for a patent made through Section 127A relying on nominated evidence of novelty be unduly advantaged, either in comparison to an application made directly under Part II, nor to an application under Section 127A using either a commissioned or provided (PCT) search report and written opinion. It is noted that an Section 127A Request may be made up to 31 months from its priority date. However, irrespective of when within that period the Request is made, the applicant must either

submit a search report and written opinion with the Request, or proceed within two months of same to commission a search report, without regard to the 21 months allowed to a direct Part II applicant under Rule 24. The Controller therefore requires that just as a search report and written opinion must be submitted at the time of filing, where available, so must a statement according to Section 30, if that is the applicant's intent.

Depending on the circumstances, the Controller may request, under Rule 87A(9), that the applicant furnish documents to support the statement. The Controller also reserves the right under Section 30(2) and Rule 25 to require information concerning foreign applications.

### **Conclusion**

**The Controller will, in lieu of a search report and written opinion submitted in accordance with Rule 87A(7)(d) or (e), accept a statement in accordance with Section 30 that indicates the intention to submit evidence in accordance with Rule 27(1). Such a statement must accompany the Section 127A request, and may not be made thereafter. Where no statement is submitted, and in the absence of a valid search report and written opinion submitted under Rule 87A(7)(d) or (e), the Controller shall cause the application to proceed according to Rule 87A(7)(c). The Controller may, using the powers provided under Rule 87A(9) or Section 30(2) request documents to support the reasonable likelihood of such evidence becoming available to the applicant.**

**22 December 2021**

## **Appendix – Cited legislation**

### **Patents Act (extracts)**

#### **Search report.**

29. – (1) If a patent application under this Part has a date of filing, includes one or more claims and is not withdrawn or deemed to be withdrawn the Controller shall, on the request of the applicant made within the prescribed time, accompanied by the prescribed fee (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.

#### **Use of foreign specification or search report.**

30. – (1) In lieu of making the request provided for in section 29 (1), an applicant for a patent under this Part may, within the time, prescribed for the purpose of section 29 (1), submit a statement to the Controller that an application for a patent for the same invention has been made in a prescribed foreign state or under the provisions of any prescribed convention or treaty and where such a statement is submitted the applicant shall submit, within the prescribed period, such evidence as may be prescribed of either—  
( 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 ) the grant of a patent in pursuance of the said application.

(2) The applicant shall, if so required by the Controller, also furnish to the Controller within the prescribed time such information as may be prescribed with regard to the filing of foreign applications for protection of the invention for which a patent is sought.

#### **Circumstances in which international application for patent designating State shall be treated as application for patent under Part II**

**127A.** – (1) If an international application for a patent which designates the State is refused a filing date under the Treaty and following a request made in the prescribed manner and within the prescribed period, the Controller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application shall be treated as an application under Part II, having such date of filing as he may direct.

(2) Subject to compliance with the prescribed conditions, an international application for a patent which designates the State shall be treated as an application under Part II if—

(a) the applicant withdraws the international application at any time prior to the expiration of 31 months from the filing date or the priority date of the application, whichever is the earlier, and the international processing procedures in the international phase are discontinued,

(b) the International Bureau determines, for any reason, that the international application or the designation of the State in it, is withdrawn or considered withdrawn,

(c) the international application is considered to be withdrawn on the ground that it has not, within the period prescribed by Article 20 (as that Article is construed in accordance with Rule 47 of the Treaty Regulations), 22(1) or 39(1) of the Treaty, been received by the European Patent Office, or

(d) the applicant decides, at any time prior to the expiration of 31 months from the filing date or the priority date of the international application designating the State, whichever is the earlier, to request the Controller to treat the international application as a patent application under Part II.

(3) Subject to compliance with the prescribed conditions, an international application for a patent designating the State which has, under subsection (1) or (2), ceased to be deemed to be an application for a European patent designating the State shall, upon that cesser taking effect, be treated as an application under Part II.

(4) Subsection (5) applies to an international application for a patent designating the State which is treated as an application for a patent under Part II.

(5) An application for an international patent designating the State which has been published by the International Bureau in accordance with the Treaty in a language other than Irish or English shall be treated, for the purposes of sections 56 and 66(3), as published under section 28 when a translation into Irish or English of the claims of the application have been filed and published by the Office.

(6) Article 2 of the Treaty shall apply to the interpretation of this section as that Article applies to the interpretation of the Treaty.

(7) In this section, 'Treaty Regulations' means the Regulations under the Treaty as such Regulations are in force from 1 July 2016.

## **Patent Rules (extracts)**

### **Request for search.**

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

### **Corresponding applications abroad.**

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

### **Evidence under section 30.**

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

( a ) where an application for a patent is also made under the provisions of the European Patent Convention, a copy of the published European patent application and the related Extended European Search Report which is accompanied by a written opinion as to patentability or a copy of the published specification of the granted European patent in respect of the said invention; or

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

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

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

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

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

(3) The time for submitting evidence shall be—

( a ) in the case of the evidence referred to in paragraph (1) (a), within two

### **An international application as an application for a patent under Part II**

87 – (7) (a) A request made to the Controller to treat the international application as a patent application under Part II, pursuant to sections 127A(2) and (3), shall be made within three months of the date of withdrawal of the international application or the date of the notification by the International Bureau or Receiving Office that the application is withdrawn or is considered withdrawn, whichever is applicable, and no later than 31 months from the filing date or the priority date of the international application, whichever is later.

(b) The request shall be made in writing or in electronic form and shall be accompanied by: -

(i) a copy of the international application as filed,

(ii) a copy of the request to the International Bureau or Receiving Office to withdraw the application, if applicable,

(iii) a copy of the acknowledgement of the International Bureau or Receiving Office of the withdrawal, if applicable,

(iv) a completed Form No. 1 as prescribed under Rule 8,

(v) the filing fee as prescribed under Rule 8B, and

(vi) any other documents which the applicant wishes to submit.

(c) Within two months of filing a request under paragraph (a), the applicant may submit amendments they wish to have considered prior to the commencement of search and examination pursuant to Section 29 or Section 30.

(d) If it appears to the Controller that the international application which is the subject of a request under paragraphs (6) and (7) satisfies the formal requirements of the Act and Rules, but is not accompanied by an international search report and written opinion, the Controller shall, unless the application is withdrawn within a period of two months from the filing of the request under paragraph 6(a) or 7(a), cause the application under Part II to proceed in accordance with Section 29 and Rule 24.

(e) Where the request under paragraphs (6)(a) or (7)(a) is accompanied by evidence in the form of a search report and written opinion as specified in Rule 27(1), the Controller shall allow that evidence to meet the requirements of Section 30.

(9) The Controller may, by notice in writing or by electronic means, require an applicant who has submitted a request under paragraph (6) or (7), to provide such additional documents as he or she considers appropriate, within the period as is specified in the notice.