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*Number 36 of 2014*

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**Intellectual Property (Miscellaneous Provisions) Act 2014**

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ACTS REFERRED TO

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Competition and Consumer Protection Act 2014 (No. 29)

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*Number 36 of 2014*

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## **INTELLECTUAL PROPERTY (MISCELLANEOUS PROVISIONS) ACT 2014**

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An Act to amend the Patents Act 1992; to give effect to Article 19(2) of the Singapore Treaty on the Law of Trademarks done at Singapore on 27 March 2006; to amend the Trade Marks Act 1996; to amend the Competition Act 2002; and to provide for related matters.

[23rd December, 2014]

**Be it enacted by the Oireachtas as follows:**

### **Definitions**

1. In this Act—

“Act of 1992” means the Patents Act 1992;

“Act of 1996” means the Trade Marks Act 1996.

### **Amendment of section 42 of Act of 1992**

2. (1) Section 42 of the Act of 1992 is amended—

(a) in paragraph (g) (inserted by Regulation 2(b) of the European Communities (Limitation of Effect of Patent) Regulations 2006 (S.I. No. 50 of 2006)) of subsection (1), by the substitution of “appropriate;” for “appropriate.”,

(b) by the insertion of the following paragraph after paragraph (g) of subsection (1):

“(h) insofar as paragraph (g) does not apply, acts done in relation to the subject matter of the relevant patented invention which consist of—

(i) acts done in conducting studies, tests, experiments and trials (including clinical trials and field trials) with a view to satisfying the application requirements for a marketing authorisation or similar instrument (howsoever described) that is required by the law of the State or of any other state in order to sell or supply or offer to sell or supply—

(I) a medicinal product for human use, within the meaning of subsection (2), or

(II) a veterinary medicinal product, within the meaning of subsection (2),

or

- (ii) any other act done which is required as a consequence of the acts referred to in subparagraph (i) for the purposes specified in that subparagraph, as appropriate.”,

and

- (c) by the insertion of the following subsection:

“(2) In this section (other than paragraph (g) of subsection (1))—

‘medicinal product for human use’ means—

- (a) any substance or combination of substances having or purporting to have properties for treating or preventing disease in human beings, or
- (b) any substance or combination of substances which may be used on or be administered to human beings with a view either to restoring, correcting or modifying physiological functions by exerting a pharmacological, immunological or metabolic action, or to making a medical diagnosis;

‘substance’ means any matter of—

- (a) human origin (including human blood and human blood products),
- (b) animal origin (including micro-organisms, whole animals, parts of organs, animal secretions, toxins, extracts and blood products),
- (c) vegetable origin (including micro-organisms, plants, parts of plants, vegetable secretions and extracts), or
- (d) chemical origin (including elements, naturally occurring chemical materials and chemical products obtained by chemical change or synthesis);

‘veterinary medicinal product’ means—

- (a) any substance or combination of substances having or purporting to have properties for treating or preventing disease in animals, or
- (b) any substance or combination of substances which may be used on or be administered to animals with a view either to restoring, correcting or modifying physiological functions by exerting a pharmacological, immunological or metabolic action, or to making a medical diagnosis.”.

- (2) Section 42 of the Act of 1992 as it stood immediately before the passing of this section shall be referred to as subsection (1) of the said section 42 and, accordingly, references in any enactment passed before the passing of this Act to section 42 of the Act of 1992 shall be construed as references to subsection (1) of section 42 of that Act.

**Amendment of section 29 of Act of 1996**

3. (1) Section 29 of the Act of 1996 is amended—

(a) by the substitution of the following subsection for subsection (3):

“(3) Until an application has been made to enter the particulars of a registrable transaction in the register pursuant to subsection (1), the transaction shall be ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of that transaction.”,

and

(b) by the substitution of the following subsection for subsection (4):

“(4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction and the trade mark is infringed—

(a) on or after the date of the registrable transaction, and

(b) at a time when no application has been made to enter the particulars of the registrable transaction in the register pursuant to subsection (1),

the Court shall not award the person his or her costs in proceedings for such an infringement of the trade mark unless—

(i) an application for registration of the particulars of the registrable transaction was made not later than 6 months from the date of the transaction, or

(ii) the Court is satisfied that it was not practicable for such an application to be made in the period referred to in paragraph (i) and that an application was made as soon as practicable after the expiry of that period.”.

(2) (a) The amendments to the Act of 1996 effected by this section shall not apply to any infringement of a registered trade mark that occurred before the commencement of this section.

(b) In this subsection—

“infringement of a registered trade mark” shall be construed in accordance with section 14 of the Act of 1996;

“registered trade mark” shall be construed in accordance with section 7 of the Act of 1996.

**Amendment of Act of 2002**

4. (1) The Act of 2002 is amended—

- (a) in subsection (4B) (inserted by section 59 of the Act of 2014) of section 22, by the insertion of “and paragraph (b) (inserted by *section 4* of the *Intellectual Property (Miscellaneous Provisions) Act 2014*) of section 28B(2)” after “section 28A(1)”,
  - (b) in section 28B (inserted by section 74 of the Act of 2014), by the substitution of the following paragraph for paragraph (b) of subsection (2):
    - “(b) notwithstanding paragraph (a), shall not be made before whichever of the following dates is applicable:
      - (i) the date of a determination by the Commission under paragraph (a) of section 21(2) or under paragraph (a) or (c) of section 22(3);
      - (ii) the day after the period specified in subsection (2) of section 21 has elapsed without the Commission having informed the undertakings that made the notification concerned of the determination (if any) it has made under paragraph (a) or (b) of that subsection (2);
      - (iii) where the Commission has made a determination under section 21(2)(b), the day after—
        - (I) 120 working days have elapsed after the appropriate date within the meaning of section 19(6), or
        - (II) where a requirement or requirements referred to in section 22(4A) were made under section 20(2), 120 working days and any period of suspension that applied pursuant to section 22(4A) have elapsed after the appropriate date within the meaning of section 19(6),without the Commission having made a determination under section 22;
      - (iv) the date of a decision of the European Commission under Article 6(1)(b) or Article 8(1) or (2) of the Council Regulation;
      - (v) the date that Article 10(6) of the Council Regulation comes into effect.”,
- and
- (c) in section 28E (inserted by section 74 of the Act of 2014), by the substitution of “subsection (7)” for “subsection (8)” in paragraph (b) of subsection (13).
- (2) Where a media merger was notified under Part 3A (inserted by section 74 of the Act of 2014) of the Act of 2002 before the commencement of this section, then, upon such commencement, the Act of 2002 shall apply to the media merger as if the amendments effected by *paragraphs (a) and (b) of subsection (1)* had not been made.
  - (3) In this section—



“Act of 2002” means the Competition Act 2002;

“Act of 2014” means the Competition and Consumer Protection Act 2014.

**Short title, collective citations and construction**

5. (1) This Act may be cited as the Intellectual Property (Miscellaneous Provisions) Act 2014.
- (2) The Patents Acts 1992 to 2012 and *section 2* may be cited together as the Patents Acts 1992 to 2014.
- (3) The Competition Acts 2002 to 2014 and *section 4* may be cited together as the Competition Acts 2002 to 2014 and shall be construed together as one Act.