

2005

PATENT ATTORNEYS

EXAMINATION

PAPER C

Foreign Law

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

1. Describe the advantages and disadvantages of seeking patents in foreign jurisdictions by filing a PCT application instead of filing multiple convention applications.[4]{4}

2. (a) A client has a PCT application claiming convention priority from a New Zealand application dated 1 January 2003. He calls today and says he has ascertained his markets for the product incorporating his invention are in the US, Mexico, Taiwan, United Kingdom, Germany, France and Italy. Advise him how to proceed.[6]

(b) He also advises a key employee has left him and is now working for a UK company called Fox plc. He has information that Fox is endeavoring to copy his product and wants a patent in the UK as soon as possible. Advise what steps should be taken to achieve this.[2]

(c) Your client is concerned Fox may oppose some of his patent applications. He is particularly worried about Europe, UK and USA. Advise him whether opposition proceedings are available in each of these jurisdictions and if so whether they are available pre-grant or post-grant. Advise if any corresponding proceedings are available if you believe opposition proceedings as such are unavailable. [6]
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3. You have today been instructed by your client company to file a PCT international application claiming priority from its New Zealand application.

(a) What documents must be filed at the PCT receiving office?[2]

(b) You have designated AU as the Searching Authority. What is the nature of the report you will receive from them and when will it issue?[3]

(c) For cash flow reasons your client does not want to proceed into national phase before 30 months from its New Zealand application. What is the minimum it needs to do and what time limits apply? What substantive documents will be received during the international phase and what further options are then available? [4]
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4. (a) Explain what is meant by the statement that the US is a “first to invent” country and explain how it is determined who is the first person to invent.[4]

(b) Your client has filed a US application on 31 May 2003 claiming convention priority from a New Zealand application dated 31 May 2002. In the first office action the USPTO examiner has rejected all claims under section 102 and cited US patent 5,123,456 as prior art. This patent had a filing date of 1 April 2002, although it was not issued until 31 December 2004. You verify that the ‘456 patent does in fact disclose all material aspects of your client’s invention. Is there anything that can be done to give your client a chance of obtaining a patent on his application? If so, what?[3]

(c) Since 1995 the US has allowed for the filing of provisional applications. Are there any advantages for New Zealand clients to first file a US provisional rather than a New Zealand application with a provisional specification?[3]

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5. Write brief notes on five of the following US practices[3 each]:

- (a) doctrine of equivalents;
- (b) file wrapper estoppel
- (c) restriction
- (d) reissue patents
- (e) interference proceedings
- (f) continuation-in-part applications

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6. The Australian Patents Act and Regulations differ from their New Zealand counterparts. Discuss the differences in relation to standard patents only with reference to each of the following [2 each]:

- (a) Novelty;
- (b) Examination;
- (c) Amendment after acceptance;
- (d) Date by which divisional applications may be filed;
- (e) Who may file an opposition;
- (f) Reexamination;
- (g) Contributory infringement.

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7. Convert the following claim which has been drafted for New Zealand into two-part form for Europe and into a Jepson claim for the US. Assume integer (v) distinguishes the invention claimed from the prior art.

Two copies of the claim are attached to this paper for you to annotate and return with your answer paper.[10]

A latch assembly including,

- (i) a casing,
- (ii) a latch bolt mounted on the casing so as to be movable relative thereto between an extended latching position and a retracted release position,
- (iii) a first actuator operable from an inner side of the assembly to cause movement of the latch bolt to said release position,
- (iv) locking means operable from said inner side of the assembly to adopt an active condition and thereby render said first actuator inoperable,
- (v) a second actuator operable from an outer side of the assembly to cause movement of the latch bolt to the release position, and
- (vi) lock release means which is responsive to said operation of the second actuator so as to thereby render said locking means inactive.

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8. (a) You have filed a standard Australian patent application with a complete specification on 11 August 2004 with a complete specification for a process of “bottling” wine in aluminium cans. Your client has now discovered that an Australian wine company has started selling canned wine which appears to fall within at least one independent claim in its complete specification. What course of action can you recommend to your client to enable it to obtain legal rights to sue upon in Australia at the earliest possible date. You should itemize each step which must be taken.[6]

(b) Your client’s competitor has just obtained an innovation patent in Australia on an application filed 5 January 2005 for a tear-top mechanism for an aluminium wine can. Your client’s own diligent research has uncovered a prior publication in a 1992 Italian language wine journal and a test sale made at Christmas 2004 by the competitor on the New Zealand market of five pallets of cans incorporating the tear-top invention. What action can be taken by your client to invalidate the innovation patent and is it likely to be successful on the evidence so far obtained?[6]

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9. (1). For patent applications in both the European Patent Office and Japan answer each of the following [2 each]:

- (a) In what language will the patent specification be examined?
- (b) What is the deadline for paying the examination fee?
- (c) What can you do if the examiner maintains a rejection after you have filed a response to the initial examination report?
- (d) Are either or both pre or post grant oppositions available?
- (e) What standard of novelty is required?

(2) For Europe explain what must be done to obtain enforceable patent rights in each national jurisdiction after a European patent has been granted. [2]

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