

**2007**

**PATENT ATTORNEYS**

**EXAMINATION**

**PAPER A2**

**The New Zealand Law and Practice  
relating to Patents and Designs**

**Regulation 158 (1) (a)**

**Duration: 3 hours (plus 10 minutes for reading)**

### Question 1 (10 marks)

Sparky is a university student studying computer software engineering and electronics. To help pay his way, he works as a supervisor at a local supermarket during the university holidays. On his shift he has to supervise the checkout operators, the restocking of the supermarket shelves and the collection of the shopping trolleys used by customers. This last job annoys him. Some customers leave trolleys anywhere, out on the streets and in neighbouring properties. Sparky thinks that having to use staff for continually finding and collecting trolleys is a waste of his and their time.

Sparky talks of the trolley problem with Will Worth, the owner of the supermarket. Will is amused; it's always been a problem. Will laughs and says, "Fix it if you can."

Sparky needs a research project for his third year university course. He discusses the problem with his professor at the university and gets permission to adopt it as his project. That gives Sparky the use of the engineering school facilities for working on the project and periodic input from the professor.

Sparky has a GPS (Global Positioning System) receiver that he uses in his car for planning routes and for identifying his location. His experiences with the receiver lead him to think that he can use GPS to solve his trolley problem.

While working at the university and at the supermarket, Sparky devises a small trolley locator unit (TLU) that comprises a GPS tracking device and a radio modem. One TLU is discreetly and securely attached to each trolley. The GPS tracking device records the position of the trolley at frequent intervals. The position data is sent by the radio modem to an internet-connected computer in the supermarket's office. The position of all trolleys is thereby displayed on the computer screen against a backdrop of a general map of the area in which the supermarket is located. Sparky has written a computer program enabling the detail of the supermarket building and parking area to be superimposed on the map of the area. That makes it much easier to see the precise position of the trolleys relative to the location of the supermarket itself. With a view to future commercial opportunities, Sparky has made the program able to be adapted for use with any other supermarket in any other area.

In tests at the supermarket, Sparky's trolley locating system works well. Will Worth is delighted. So is the professor, who gives Sparky's project report an A grade. But when Sparky tells them that he intends filing a patent application, Will claims ownership of the invention and so does the professor (on behalf of the university). Sparky asks your advice.

- (a) On the information given above, who owns the invention and who is entitled to apply for a patent? Give reasons. (3 marks)
- (b) Assuming the dispute over who is entitled to be applicant cannot be settled before an article about the trolley locating system is to be published in the local newspaper, in which name or names should the patent application be filed? (2 marks)

- (c) On the information given above, what aspects of the trolley tracking system are potentially patentable? Give reasons. (5 marks)

**Question 2 (12 marks)**

Fred Dagg is an inventive farmer. He invents a tractor-towed potato harvester. The harvester has a wheeled chassis. The chassis has a tow bar and a power-take-off at one end for connection to the tractor. The chassis carries plough-like tines, comb-like scoops and a hopper. The tines are adapted to penetrate the ground and are shaped to pass under potatoes in the ground and lift them to the surface. The potatoes are then collected by the scoops and are conveyed to the hopper. The key to the success of the harvester is the design of the tines so that there is minimal cutting or bruising of the potatoes as they are lifted. The tines eventually wear and are therefore replaceable.

Fred does the following things (a) to (e) with his harvester. Then he decides that he wants to protect the harvester, and particularly its tines, and comes to you for advice. For each thing that he has done, advise him whether that thing is a bar to his filing valid patent and design applications. In each case, advise Fred of any other information you might need to advise him fully and any time limit that might apply.

- (a) In developing the harvester, Fred tests it on several occasions in his potato paddock. That paddock lies adjacent State Highway 1, south of Hamilton. (2 marks)
- (b) Fred invites his neighbouring potato-growing farmer friend, Frieda Hogg, to have a look at his harvester. She is impressed with its construction and operation. She tells Fred it's a goer and he ought to get it protected. (2 marks)
- (c) Fred offers to make another harvester and sell it to Frieda – but at a high price (there being no economies of scale here). She says she'll be interested if she expands her potato-growing operation enough to make it economically worth-while buying such a harvester. (2 marks)
- (d) In testing the harvester, Fred digs up most of his potatoes. Of course he doesn't want to waste them as he is dependent on the income he can get from selling them. So he sends them to market and receives payment for them. (2 marks)
- (e) Fred is encouraged by Frieda's enthusiasm. He writes to the Ministry of Agriculture & Forestry for advice as to the best way forward for him. He sends in a description and photographs of the harvester and its tines. A man from the Ministry replies. The man says that he will be at the Fieldays that are soon to be held at Mystery Creek, near Hamilton, and can meet Fred there. (2 marks)
- (f) Fred enters his harvester in the inventions competition at the Fieldays. He wins a prize and he and his harvester feature in the Waikato Times the next day. The man from the Ministry does meet Fred at the Fieldays, is as impressed as Frieda was, and also tells Fred to get the harvester protected – though he doesn't offer any financial help from the Ministry. (2 marks)

### **Question 3 (8 marks)**

You receive instructions from Ajax, Inc., a corporate client in the United States, to have a PCT international application enter the national phase in New Zealand. Ajax, Inc. is the international applicant. The PCT international application claims priority from a US patent application. You notice with interest that the inventor is a New Zealander whose address is given as a New Zealand address.

- (a) What problem related to the inventor might there be? (2 marks)
- (b) If there is a problem, what, if anything, can be done about it? (2 marks)

You ask for information to help you establish that Ajax is entitled to be the applicant in New Zealand. You are told that the inventor is an employee of Ajax.

- (c) Could an employment agreement between the inventor and Ajax give Ajax the right to be the applicant in New Zealand? Give reasons. (2 marks)
- (d) Can anything be done to ensure Ajax's right to be the applicant in New Zealand? If so, what can be done? (2 marks)

### **Question 4 (12 marks)**

- (a) Why might an applicant for a patent application want to delay acceptance of the patent application? Give reasons. (3 marks)
- (b) In what ways can an applicant delay acceptance of a patent application? (3 marks)
- (c) Why might an applicant for a patent application that has been accepted want to delay grant of the patent? (1 mark)
- (d) In what ways can an applicant delay grant of an accepted and published patent application? (1 mark)
- (e) Why might an applicant for registration of a design want to delay registration? Give reasons. (2 marks)
- (f) How can an applicant for registration of a design delay registration? (2 marks)

### **Question 5 (8 marks)**

Ms Taka Chance owns a successful chain of toy shops. She has returned from a business trip to Europe where she attended a toy fair. She brought back a sample of one of the toys that she saw at the fair and particularly liked. She wants to sell the toy through her shops. A problem is that the German manufacturer's price is too high. So she wants to make the

toy in New Zealand - but it is a toy that could easily be made by competitors who would undercut her market. She says that a business friend told her that she could protect the toy herself to hold competitors back. She asks for your advice.

Assume that the toy in its construction and operation is a patentable type of invention and in its appearance is a registrable design.

- (a) Can Ms Chance validly protect the toy in New Zealand and, if so, how? (2 marks)
- (b) What complicating factors could Ms Chance face in getting valid protection and in selling the toy in New Zealand? (6 marks)

**Question 6 (9 marks)**

- (a) In respect of examination of a New Zealand patent application, what information may the Commissioner require about corresponding patent applications overseas and in what circumstances? (2 marks)
- (b) Acting on instructions from a US patent attorney you have filed a PCT application into the national phase in New Zealand. The application has four claims. Claim 1 is an independent claim, claim 2 is dependent on claim 1, claim 3 is dependent on claim 2 and claim 4 is dependent on claim 3.

A year later, but before examination of the application, the US patent attorney sends you a copy of the Information Disclosure Statement that the applicant has filed on the corresponding US patent application, a copy of the Notice of References Cited by the US examiner and a copy of the Office Action on the US application.

The Information Disclosure Statement lists five US patents A, B, C, D and E and two articles X and Y. Article X was published in the magazine *Scientific American*. Article Y was published in an obscure US technical journal you've never heard of before. The Notice of References Cited lists US patents A and B and article Y. The US Office Action alleges that claim 1 is prior published by US patent A, claim 2 is obvious in view of patent A and article X, and claim 3 is obvious in view of patent A and articles X and Y.

Advise the US patent attorney as to what should be done and when. Give your reasons why you recommend a particular course of action or not. (7 marks)

**Question 7 (10 marks)**

- (a) What is meant by 'article' as used in the Designs Act 1953? (1 mark)
- (b) Your client, Leo Pard, a golf coach, has designed a distinctive head for a golf putter. Leo enthuses how the shape of the head means that the centre of mass is concentrated behind the striking surface to minimise any tendency for the putter to

twist in use. A patent search shows that this concept is not new and is not patentable. A design search finds no relevant prior art. So Leo asks you to protect his putter head by way of a design application.

- (i) What issues relevant to the registrability of the design of the putter head should you resolve with Leo before filing a design application? (4 marks)
- (ii) What statement of novelty would you draft? (2 marks)
- (c) Two months after you filed a design application for Leo, he comes back to you with the golf putter head. He has modified the design of the head, though not in any substantial way. It is the modified design that he definitely intends using and he wants the modified design protected. He is not so concerned about the original design and wouldn't mind dropping it to avoid future expense.

Advise Leo of his options for protecting the modified design of the putter head. (3 marks)

#### **Question 8 (6 marks)**

- (a) What is necessary for a group of articles to qualify as a 'set of articles' within the meaning of the Designs Act 1953? (2 marks)
- (b) For a group of articles that qualifies as a set, what advantages are there in obtaining registration as a set as opposed to registering each article separately? (3 marks)
- (c) For a group of articles that qualifies as a set, are there any disadvantages in obtaining registration as a set as opposed to registering each article separately? (1 mark)

#### **Question 9 (8 marks)**

- (a) What provisions are there in the Designs Act 1953 and Designs Regulations 1954 for correcting or amending a design application? (2 marks)

Are the following types of amendment likely to be allowable or not? In each case give a reason for your answer.

- (b) Addition of a perspective view to design representations originally showing only a plan view and four side views. (1 mark)
- (c) Addition of a disclaimer to a statement of novelty. For example, the original statement of novelty claims novelty in the shape of the whole article. The added disclaimer says that novelty is not claimed in respect of a specific part of the article. (2 marks)

- (d) Amendment of the name of the article from 'a container' to 'a container with lid' when the representations show a container with a lid. (1 mark)
- (e) Changing the statement of novelty from a claim to novelty in the shape of an article to a claim to novelty in the pattern applied to the article. (2 marks)

#### **Question 10 (8 marks)**

Section 15 of the Designs Act 1953 provides for cancellation of the registration of a design. Section 28 provides for the register of designs to be rectified.

For each section:

- (a) To whom must the application for cancellation or rectification be made? (1 mark)
- (b) Who can apply for cancellation or rectification? (2 marks)
- (c) On what grounds can the application for cancellation or rectification be made? (3 marks)
- (d) Is there any right of appeal under section 15 and, if so, to where and for whom? (2 marks)

#### **Question 11 (9 marks)**

Your client, Sue Venire, is in the business of making mementos for special events. She is preparing for the Rugby World Cup to be held in France later in 2007. She has designed a series of logos. There is one logo for the national team of each country taking part in the Rugby World Cup. Each logo consists of a background and a foreground superimposed on the background. The background of each logo is the same, being the French flag in an oval shape to symbolise a rugby football. The foreground of each logo includes a central motif, which is the symbol representing the particular national team. For example, the motif for the New Zealand All Blacks is the well-known silver fern symbol. The foreground of each logo also includes the words "Rugby World Cup 2007" under the motif. Sue intends using the logos on caps, tee-shirts, windbreakers, drinking mugs, and postcards for sale in New Zealand. She also wants to license her logos to others to use on their products in New Zealand. Sue wants to protect her logos but has limited funds. She seeks your advice.

- (a) What protection can Sue get for her logos in New Zealand under the Designs Act 1953? Explain any limitations to the protection available under the Act, including any problems that Sue might face and how she might deal with them. (7 marks)
- (b) Sue is considering relying on copyright under the Copyright Act 1994 for protection of her logos in New Zealand. What advantages and disadvantages are there in relying on copyright compared with registered design protection? (2 marks)