

2007

PATENT ATTORNEYS

EXAMINATION

PAPER C

**The New Zealand Law and Practice
relating to Foreign Law**

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

- 1 You are just about to file a PCT application for a New Zealand client in which the priority of an earlier New Zealand patent application filed with a provisional specification is to be claimed. You have just realised that the 12-month priority period has passed because the patent application was filed 12 months and two weeks ago on 20 June 2006. Advise your client of its options. (10 marks)
- 2 Please describe what is meant by the following terms used in US practice.
- file-wrapper estoppel (2 marks)
 - statutory invention registration (2 marks)
 - petition to make special (2 marks)
 - patent prosecution highway (2 marks)
 - doctrine of equivalents (2 marks)
- 3 Your client recently entered national/regional phase applications derived from PCT application PCT/NZ2005/101023 in the following countries:
- i. Canada,
 - ii. Europe (designating all available European states, including the extension states),
 - iii. Australia
 - iv. United States of America,
 - v. The Peoples Republic of China,
 - vi. Republic of Korea,
 - vii. India,
 - viii. Taiwan and
 - ix. Japan.

Your client's co-pending New Zealand complete patent application has just been examined and a piece of relevant and previously unknown prior

art was raised by the examiner. Advise your client of any obligations that exist to record this prior art against the recently filed national/regional phase applications. (12 marks)

- 4 You act for a New Zealand client who has invented a new type of kayak and you filed a New Zealand patent application with a provisional specification in his name. Your client is presently negotiating a deal with a Canadian company that wants to invest in your client's business. Your client believes there is a market for his invention in numerous countries but only has a budget to file convention applications in Canada, Australia and New Zealand and possibly the US. Your client's application needs to be completed in New Zealand and overseas shortly.

a) Advise your client on his options including what applications should be filed and where. Include details of your reasoning. (4 marks)

b) How would you tailor your advice in a) if the client provided instructions at 4.55pm NZ time on the convention deadline to incorporate details of the latest preferred embodiment? (2 marks)

c) Would this advice in b) be different if the Canadian company is to become a co-applicant at the time of filing? (2 marks)

- 5 A large Japanese Corporation has recently learned of the possibility that an Australian competitor might be about to launch an allegedly infringing product in Australia. The Japanese Corporation has a pending Australian national phase application that has not yet been examined and has sought your advice on what options are available to it to obtain a granted patent in Australia. Discuss the pros and cons of each of the options that are available to your client. (9 marks)

- 6 Your New Zealand based client plans to secure patent protection in Hong Kong and currently has a pending European application designating the United Kingdom and a Chinese application. Advise your client on what is involved in securing patent protection in Hong Kong and outline any issues with registering the European application or Chinese application as the basis for the Hong Kong patent. (5 marks)

7 A client has developed an important innovation and thinks that Taiwan is going to be a very important market. As yet no filings of any sort have been made for the innovation, the nature of which has not been disclosed to anyone, not even to yourself. Advise your client on the following:

(a) What categories of patent are available in Taiwan based on a New Zealand patent application? (2 marks)

(b) Devise a filing strategy for your client to secure patent protection in Taiwan, while deferring costs for as long as possible. (2 marks)

8 Describe what provisions and processes are available in China for challenging a patent or patent application. (8 marks)

9 You have been reviewing a new client's patent portfolio. You note that a New Zealand patent application with a provisional specification and subsequently a complete after provisional specification have been filed for its "solar panel" technology. Your review identifies that the client decided not to file a PCT application nor any corresponding overseas patent applications. The New Zealand patent application was filed more than 15 months ago. Your client has advised that:

(a) "for about the last 7 months" it has disclosed the invention in detail on its website and is actively seeking business partners in Europe, Australia and the United States; and

(b) "we are working on a second generation of solar panel innovations that have not been disclosed at all".

Advise your client of its options for protection in the key markets of Europe, Australia and the United States. Your answer should include discussion of the novelty and inventive step standards that apply in each of these key markets. (12 marks)

10 You have a client that has a granted Canadian patent and your client has recently received a notice of re-examination from the Canadian

Commissioner of Patents. A third party has sought re-examination. Explain to your client what this notice means and the steps involved in a re-examination process in Canada. (6 marks)

- 11 Explain the key steps involved with the progress of a convention European application filed claiming priority from a New Zealand patent application through to grant and validation. [It is not necessary to detail the opposition steps] (8 marks)**
- 12 You have a client who is interested in entering national phase in the Republic of Korea. Inform your client of the requirements for entering a national phase patent application in the Republic of Korea and advise of any potential pitfalls. (8 marks)**