

2008

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)

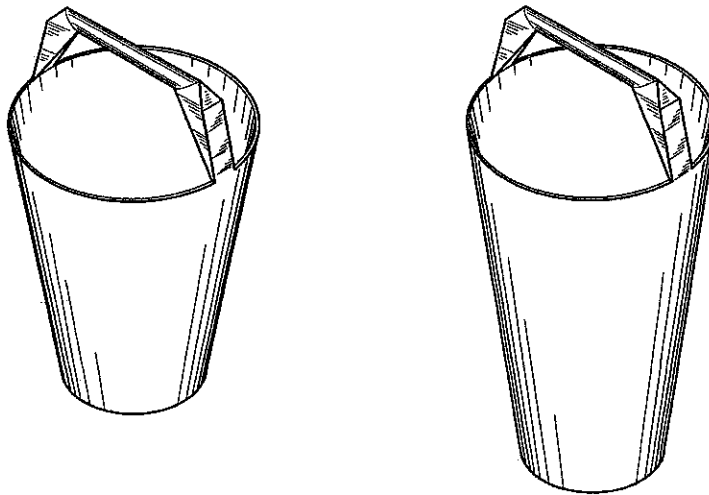
Question 1 (9 marks)

Write brief notes on the following:

- (a) What constitutes a design that may be registered under the Designs Act? (5 marks)
- (b) The section 8 design (sometimes referred to as a “design of addition”). (4 marks)

Question 2 (14 marks)

Your client, Mr Money Tight, has created new bucket designs, as illustrated below. The two buckets have the same handle design. Other than the different proportions and sizes, the bucket bodies are the same. Your client advises that the sizes and proportions of the bucket bodies are commonplace. The handles are permanently attached to the buckets, and he considers the handles to be novel.



- (a) Explain the requirements for obtaining design protection for a set of articles. (3 marks)
- (b) Applying the requirements you have referred to in part (a), advise whether you believe the buckets would qualify for registration as a set of articles. Explain your reasoning. (3 marks)
- (c) Irrespective of your answer to part (b), draft a statement of novelty for an application to register the buckets as a set of articles. (1 mark)
- (d) Would it be possible to obtain a single design registration covering both buckets but not as a set? If so, please draft a suitable statement of novelty. If not, explain why not. (2 marks)
- (e) Living up to his name, Mr Tight decides that he doesn't wish to spend money on filing a design application. He mentions his understanding that he can rely on copyright protection

instead, to prevent competitors from making similar buckets. Please advise Mr Tight whether this is correct, and if so of the requirements for obtaining copyright protection, and of any limitations over registered design protection. (5 marks)

Question 3 (5 marks)

You are approached by your local client, Cool Car Co, that manufactures aftermarket car parts. They have developed a lightweight carbon fibre car boot lid and spoiler. Cool Car Co intends to sell a number of different models for different popular car models. The shape of the boot lid will in each case be the same as that of the standard metal boot lid of the car model. The spoiler is fixed to the top of the car boot lid at its rear edge, and has a novel appearance. Your client says that the spoiler doesn't give any performance benefit, but "makes the car look like it is moving fast even while it's not moving!" The client has filed a design application showing only the spoiler and name the article "a boot spoiler". You receive an examination report including an objection that the design cannot be registered as the spoiler is not an article as defined in the Designs Act.

- (a) Comment on whether the examiner's objection has any merit. (1 mark)
- (b) What questions would you ask of your client to determine how to address the examination report. (2 marks)
- (c) Assume that the examiner's objection has merit. What amendments would you suggest to allow the application to proceed to registration?" (2 marks)

Question 4 (10 marks)

Provide your comments on the following, with reference to relevant case law or the Patents Act where applicable:

- (a) What actions amount to infringement of a New Zealand patent? (2 marks)
- (b) Whether the importation into New Zealand of a product that is produced overseas by a process, will infringe a granted New Zealand patent having a claim that covers the process. Would the position change if a product-by-process claim was included in that patent? (2 marks)
- (c) Outline the steps of the analysis that would be performed in determining whether there is infringement of a product claim in a granted New Zealand patent that has integers A, B, C and

D, by the unauthorised sale in New Zealand of a product having integers A, B, C and E?
Assume E is a variant of D. (4 marks)

- (d) The benefit of marking a patented invention with the patent details, and what form that marking should take. (2 marks)

Question 5 (8 marks)

Is it possible to obtain a design registration in New Zealand for the following items? Assume the designs are novel. Please provide your reasoning with reference to case law or relevant provisions of the Designs Act or Designs Regulations as applicable.

- (a) A building (2 marks)
- (b) A painting (2 marks)
- (c) A electrical switch for use in an appliance, that has a design that enables it to operate in a desired manner (2 marks)
- (d) A hand-made sculpture of a dog (2 marks)

Question 6 (10 marks)

- (a) What is the maximum term of copyright in a registered design? (1 mark)
- (b) When must renewal fees for a registered design be paid? (1 mark)
- (c) Your client did not instruct you to pay one of the renewal fees. They come to you in a panic a few months later, realising their oversight and saying they did intend to renew the design registration. What remedial action can be taken, if any? (2 marks)
- (d) Your client has become aware of a new product on the market that they say is a “rip off” of their product. Your client had allowed their NZ design registration covering that product to lapse by not paying the first renewal fee, and it is now two years after the date of lapse. They ask whether they could use copyright to take action. Advise your client, including about any defences that may be available to the party that released the other product. (5 marks)
- (e) What is the term of copyright in an artistic work relating to a design for a mass produced chair? (1 mark)

Question 7 (9 marks)

Your client is a local designer and manufacturer of sporting apparel. She returns from an overseas trip, very excited about a ski jacket she saw in Europe. She purchased one, and brought it back to New Zealand with her. The ski jacket has features that function in a new way to absorb impact and add extra safety for the wearer, and that also give the jacket an unusual and distinctive external appearance. She has a good knowledge of the industry, and says she has “never seen anything like this”, especially in New Zealand. She wants to start manufacturing and selling the jacket in New Zealand, but wants to obtain some IP protection to stop others from competing here.

(a) Advise, with your reasoning, on the following:

- (i) Whether she can apply for valid patent protection in New Zealand for the functional features of the jacket. *(3 marks)*
- (ii) Whether she can apply for valid design protection in New Zealand. *(3 marks)*

(b) You conduct a search of the IPONZ databases, and cannot find any record of existing NZ patent or design applications filed relating to this product. Is your client free to manufacture and sell the product here? If so, why? If not, why not? *(3 marks)*

Question 8 (13 marks)

You have filed a New Zealand convention patent application (application B) for an overseas client. The application claims priority from a United States patent application (application A) filed a year before the New Zealand filing date. You receive an email from your overseas associate, saying they have just been made aware that the applicant had self-filed an earlier United States provisional application (application P) two months before the filing date of application A.

(a) What implication does this have for the validity of the convention priority claim for application B, if:

- (i) All the claims of application B are fairly based on the disclosure of application A, but not application P. *(2 marks)*
- (ii) Broader claims in application B are fairly based on the disclosures of both application P and application A, and narrower claims in application B are fairly based on only the disclosure of application A. *(2 marks)*

- (iii) Broader claims in application B are fairly based on the disclosures of both application P and application A, and narrower claims in application B are fairly based on only the disclosure of application A, but application P was withdrawn prior to application A being filed. (2 marks)

(b) Assume your investigations under at least one of the scenarios above show that there is a validity issue in relation to the claim to convention priority for some of the claims of application B. Is it necessary to take any action to ensure the validity of the patent as a whole? What action would you take? Would the position be different if you became aware of the issue post-grant? (4 marks)

(c) With reference to case law, outline the steps of a test you could use to determine whether a claim is fairly based on a priority application. (3 marks)

Question 9 (10 marks)

Comment on the patentability in New Zealand of the following inventions.

- (a) A new device that can be fitted by a user for reducing dental decay in the mouth, that could separately be used for whitening of teeth for cosmetic purposes only. (2 marks)
- (b) A method of interactive advertising that invites a response via text messaging, when similar methods exist that require a response by telephone. Assume text messaging is separately known. (2 marks)
- (c) A new board game. (2 marks)
- (d) A new pharmaceutical compound for treating heart defects. (2 marks)
- (e) An access ticket for an event that has seating information printed on it so the ticket can be torn in any way and the attendee will be able to see their seating allocation on the remaining ticket. (2 marks)

Question 10 (12 marks)

Your client Ones and Twos Limited, is a toilet designer and manufacturer. A director of the company came up with an idea for a toilet that functions in an unusual way. As their draughtsman was unavailable at the time, they approached an external draughtsman John Designer and commissioned him to create a suitable design that incorporated the functional features. Your client agreed to pay John Designer for his work, but there was no written agreement. While designing the toilet, John Designer incorporated additional features that improve the functioning of the toilet. The features are unrelated to those created by your client, and do not affect the appearance of the toilet. Your client is very positive about the new features created by John Designer, and has constructed a prototype incorporating those features. As they want to market test the toilet in the next few weeks, they come to you and ask you to file both a patent and design application.

(a) Advise on the following:

(i) Your client's right to file a design application. *(2 marks)*

(ii) Your client's right to file a patent application. *(3 marks)*

(iii) John Designer realises that the functional modifications he came up with are very significant.

He comes to your client and demands additional payment for those features. Your client refuses. What options are available to your client as far as a patent application goes? *(3 marks)*

(b) Discuss generally the provisions of the New Zealand Patents Act in relation to co-ownership of patents. *(4 marks)*