

2008

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)

Patent Attorneys Examination 2008

Paper C – Foreign Patent Law

1. Your client filed a European patent application approximately 3 years ago. The application has not yet been granted. She has read a little about the London Agreement and seeks your advice on what this means for her currently pending European patent application. Advise your client, contrasting any differences before and after implementation of the London Agreement, in Germany, the United Kingdom, the Netherlands and Switzerland (10 marks).

2. You filed a New Zealand patent application with a provisional specification for your client on 1 June 2007. Despite your reminders, your client does not provide you with instructions to file any corresponding overseas patent applications. Early this morning, your client contacted you in a panic, wanting to file a PCT application. He mentions that he has been overseas promoting the invention and also moved recently. Mail had been delivered incorrectly hence he did not receive your reminders. Your client also tells you that one day after filing the provisional, he published the invention in a newspaper article. Advise your client on the options, if any, he has for filing a PCT application using New Zealand as the receiving office and, if possible, what deadlines exist and what criteria must be met. Include advantages or disadvantages associated with each option (8 marks).

3. Your client has a granted New Zealand patent and has filed corresponding convention patent applications in Australia, the USA and via the European Patent Office. None of these applications have yet been examined. A search report has just issued for the European application. Two references are cited against claim 1 of your client's application. The search report indicates that these references are highly relevant and the claim cannot be considered to be novel or involve an inventive step when each document is read alone. Your client's application has a total of 5 claims pending, with claims 2 to 5 being dependent on claim 1.

(a) Explain to your client the implications of the search report and what the next steps are likely to be in processing your client's European patent application through to grant. Include any deadlines to do each step (it is not necessary to detail any steps of the validation or opposition process but candidates should include the time period, if any, that applies to validating or filing an opposition before the EPO) (9 marks).

(b) What do you need to consider in relation to your client's corresponding USA patent application (3 marks)?

(c) What do you need to consider in relation to your client's corresponding Australian patent application? Would your answer be any different if our client's Australian standard patent application had been accepted for grant on 1 June 2007 (4 marks)?

4. Your client has received an Office Action for its USA patent application. The Office Action is marked 'Final'. Explain what this means and the options available. Include any time limits that your client has to meet (10 marks).

5. You are acting on behalf of a large client who has recently filed a national phase standard patent application in Australia. No examination request has been filed yet. Your client has approached you concerned that a competitor is launching an infringing product in Australia. Advise your client on options available to enable your client to take action against the infringer. Discuss any advantages or disadvantages associated with each option (9 marks).

6. Your client has a pending PCT application. The application was filed on 29 January 2007 and claims a priority date of 29 January 2006. Your client has approached you for advice on options for obtaining patent protection in France, Great Britain, Ireland, Germany, Hong Kong, Japan, South Korea, Australia, Canada, the USA, China, Taiwan, and India. Advise your client on whether or not patent protection can be validly obtained in each of these countries. Include any filing deadlines and extensions available on payment of a late fee (8 marks).

7. Explain the meaning of the following terms under US patent law:

(a) File Wrapper Estoppel (3 marks)

(b) Interference Proceedings (2 marks)

(c) Restriction Requirement (3 marks)

(d) Doctrine of Equivalents (3 marks)

(e) Difference between a 'rejection' and an 'objection' in an Office Action (4 marks)

8. A client comes to see you. He is very excited as his new product, which he believes no one else has made before, is 'selling like hot cakes' in his small store in Auckland. He now feels ready to protect his idea. He explains that he has only sold the product to people walking into his shop since November 2007 and has not advertised the product apart from putting it in his shop window. He has big plans for the product and wants to protect it in Great Britain, Canada, Europe, Australia, the USA, China, Republic of Korea, India, Hong Kong, Taiwan and Japan. Can your client obtain valid patent protection and if so, what deadlines apply (5 ½ marks)?

9. Your client is planning to file patent applications in the USA and Europe. Assuming that the primary claim (claim 1) has one novel and inventive feature which distinguishes it from the prior art, explain how you might format the USA and the European primary claim to clearly show this key feature (3 marks).

10. A client has asked for your advice on whether a request for examination will need to be filed. Limit your advice to the EPO and the countries of Great Britain, Canada, Australia, the USA, China, Republic of Korea, India, Hong Kong, Taiwan and Japan. Advise your client of any relevant time limits (5 ½ marks).

11. Your client has filed a PCT application, which has now entered European regional phase. Filing details for your client's PCT application are as follows:

- Priority Date: 27 May 2003
- International Filing Date: 26 May 2004
- Publication Date: 30 November 2004

Your client has become aware of a granted European patent, EP 1 and another PCT application, WO 2004/1234567. You review EP 1 and WO 2004/1234567 and in your opinion these documents are likely to anticipate many of your client's pending claims in Europe. Your searching confirms that WO 2004/1234567 has also entered the European regional phase and has been assigned European application number EP 2. You consider the filing details of EP 1 and WO 2004/1234567 (now EP 2) which are as follows:

	Priority Date	Filing Date	Publication date
EP 1	17 June 2001	17 June 2002	28 December 2002
EP 2 (from WO 2004/1234567)	21 March 2003	19 March 2004	30 September 2004

Comment on any issues in respect to novelty of your client's European claims in view of these documents. Would your advice be any different if EP 1 and EP 2 were owned by your client (5 marks)?

12. IP Australia has issued a Direction to Request Examination for your client's Australian standard patent application. Assuming your client wants to proceed with the application, advise your client on the options to respond, what these involve and what deadlines apply. Explain any advantages or disadvantages of each option (5 marks).