

PATENT ATTORNEYS EXAMINATION 2004

Persons wishing to present themselves for examination in any subject of the above examination must notify the Commissioner of Patents in writing and pay the prescribed fee per paper not later than the 3rd day of May 2004 (Regulation 157 of the Patents Regulations 1954 as substituted by regulation 2 of the Patents Regulations 1954, Amendment No. 2).

Please direct any queries to the Client Services team by e-mail at mail@iponz.govt.nz or by telephone at (04) 560-1600.

PATENT ATTORNEY EXAMINATION SYLLABUS FOR 2004 EXAMINATIONS

Reg. 158(1)(a)

THE NEW ZEALAND LAW AND PRACTICE RELATING TO PATENTS AND DESIGNS

The subject requires the candidate to have a good understanding of the Patent and Design Laws of New Zealand and the practice associated with the implementation and interpretation of the law by the New Zealand Patent Office. In the main, the law is codified in the New Zealand Patent, Design and Copyright Acts and associated Regulations.

Candidates should be familiar with the following Acts and Regulations:

- Patents Act 1953
- Patents Amendment Act 1992
- Patents Amendment Act 1994
- Patents Regulations 1954
- Patents (Patent Co-operation Treaty) Regulations 1992
- Designs Act 1953; Designs Regulations 1954
- Patents, Designs and Trade Marks Convention Order 2000
- Copyright Act 1994
- Fair Trading Act 1986
- All amendments of each of the above in force at the date of the examinations.

The inclusion of the Copyright and Fair Trading Acts is in respect of their effect on the Patent and Design Laws of New Zealand. A candidate should also have a basic understanding of the law in New Zealand relating to confidential information. Examination questions will test a combination of a candidate's knowledge of relevant legislation and case law, and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Patent Office.

Source Material

- The Acts and Regulations listed above.
- Practice Rulings issued by the New Zealand Commissioner of Patents and Designs.
- Information Library on IPONZ website at www.iponz.govt.nz.

Reference Books

- British Patent Office Manual of Office Practice (Patents) (1949 Act).
- Patent Law of the United Kingdom by the Chartered Institute of Patent Agents (1949 Act) - Sweet & Maxwell 1975 (with 5th cumulative supplement).
- Terrell on the Law of Patents.
- Patents for Inventions - T A Blanco-White.
- The Law of Intellectual Property in New Zealand - Brown and Grant.
- PCT Applicants Guide - WIPO.
- Russell-Clarke on Copyright in Industrial Designs - Michael Fysh.
- Design: The Modern Law and Practice - Morris and West.

- The Modern Law of Copyright and Designs - Laddie, Prescott & Vitoria.
- Copinger & Skone James on Copyright.

Other Reference Books

- The Law of Intellectual Property - Ricketson.
- Fair Trading in New Zealand - Hill and Jones.
- Passing Off - David Young.
- Misrepresentation and the Fair Trading Act - Trotman.
- The Law of Trade Secrets - Dean.
- Industrial Design Law in Australia and New Zealand - Puri.
- Intellectual Property in New Zealand – Frankel and McLay, 2002.

Reg.158(1)(b)

THE NEW ZEALAND LAW AND PRACTICE RELATING TO TRADE MARKS

The subject requires a good understanding of New Zealand Trade Mark Law and the practice associated with the implementation and interpretation of the law by the New Zealand Patent Office.

Candidates should be familiar with the following Acts and Regulations:

- Trade Marks Act 2002
- Trade Marks Regulations 2003
- Patents, Designs and Trade Marks Convention Order 2000
- Fair Trading Act 1986
- Flags, Emblems and Names Protection Act 1981
- Plant Variety Rights Act 1987 (s.22)
- All amendments of each of the above in force at the date of the examinations

Candidates should also be aware of the nature and protection of common law trade marks particularly as far as these may conflict or co-exist with registered trade marks. The inclusion of the Fair Trading Act is in respect of its effect on the Trade Mark Law of New Zealand.

Examination questions will test a combination of a candidate's knowledge of relevant legislation and case law and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Patent Office.

Source Material

- The Acts and Regulations listed above.
- Practice Guidelines issued by the New Zealand Commissioner of Trade Marks
- Information Library on IPONZ website at www.iponz.govt.nz.

Reference Books

- Kerly's Law of Trade Marks and Trade Names, 13th edition, 2001.
- The Law of Intellectual Property in New Zealand - Brown and Grant.
- Service Marks: A Guide to the New Law - Morcom.
- Misrepresentation and the Fair Trading Act - Trotman.
- Passing Off: Law and Practice - Drysdale and Silverleaf.
- Fair Trading in New Zealand: - Hill and Jones.

Other Reference Books

- The Law of Trade and Merchandise Marks - Venkataswaran.
- Elements of Trade Mark Law and Practice - Faulkner.
- Trade Mark Cases (Volumes 1 and 2) - P Narayanan.
- The Law of Passing Off - C Wadlow.
- Passing Off - David Young.

- Australian Law of Trade Marks and Passing Off – Shanahan, 3rd edition, 2003.
- "A Practical Guide to Trade Mark Law" by Amanda Michaels, London, Sweet & Maxwell 2002.
- Intellectual Property in New Zealand – Frankel and McLay, 2002.

Reg.158(1)(c)
FOREIGN PATENT LAW

The subject requires a knowledge of Patent Law and Practice in, or pursuant to, the following countries, Treaty and Conventions:

Australia
 Great Britain
 Canada
 Japan
 European Patent Convention
 United States of America
 Paris Convention
 Patent Co-operation Treaty (PCT)
 People's Republic of China
 Mexico
 Taiwan
 Malaysia
 Germany
 South Africa

For each country, Treaty and Convention, the candidate should have a thorough knowledge of:

- (a) Kinds of patents available.
- (b) Novelty provisions governing the right to obtain patent protection.
- (c) Who may apply for a patent.
- (d) The general form of the specification, and any required format of the claims.
- (e) Any international arrangement under which patent applications may be filed.
- (f) A general outline of examination procedures.
- (g) Date or dates of publication of documents relating to the application.
- (h) The major countries presently included in the Treaty and Convention.
- (i) The operation of the Treaty and Convention.

Examination questions will test a combination of a candidate's knowledge of the above matters and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the relevant Patent Offices.

A detailed knowledge of forms and fees is not required.

Candidates will be required to demonstrate a detailed knowledge of the law and practice of Australia and the manner in which it is distinguished from the law and practice of New Zealand.

Candidates should be able to prepare claims which will be acceptable in the countries concerned or pursuant to the Treaty or Convention but will not be called upon to draft specifications. A candidate may however be required to discuss the actual form of the specification in so far as it differs from a New Zealand specification.

Candidates should be aware of any other international arrangements which could have a bearing upon where a New Zealand applicant should file overseas applications.

Source Material

- The Acts and Regulations of the specified countries.
- The Treaties (EPC, PCT, Paris Convention).

Reference Books

- World Patent Law and Practice - Baxter.
- Manual for the handling of applications for Patents, Designs and Trade Marks throughout the world - Octrooibureau Los en Stigter.
- Patents Throughout the World - Jacobs.
- Manual on Industrial Property all over the World - Katzarov.
- PCT Applicants Guide - WIPO.
- Patent Trademark and Copyright Laws - Samuels.
- Canadian Patent Act Annotated - Barrigar.
- European Patents Handbook - C.I.P.A.
- C.I.P.A. Guide to the Patents Acts.
- Intellectual Property: The New Law - Flint.
- Encyclopedia of United Kingdom and European Patent Law.
- Japanese Patent Law - Tanabe and Wegner, 1979 A.I.P.P.I.
- Australian Industrial and Intellectual Property - C.C.H.
- Intellectual Property in Australia, Patents, Designs and Trade Marks Law - Butterworths.

Reg.158(1)(d)

THE PREPARATION OF SPECIFICATIONS FOR NEW ZEALAND PATENTS

NOTE: To be eligible the candidate must have already passed "The New Zealand Law and Practice relating to Patents and Designs".

The candidate will be required to prepare:

- (1) A provisional patent specification based upon information supplied which will normally be in the form of a technical description provided by a client.
- (2) A complete patent specification and/or a set of claims for a complete patent specification based upon full technical details of the invention and a statement of the prior art.

Examination questions will test the knowledge of the candidate as to the form and function of the provisional and complete specifications and to demonstrate a competence in understanding technical information both in the form of a written description and drawings.

Reference Books

- Terrell on the Law of Patents.
- Patents for Inventions - T A Blanco-White.
- Patent Claim Drafting and Interpretation - Kemp.
- Patent Law of the United Kingdom by the Chartered Institute of Patent Agents (1949 Act) - Sweet & Maxwell 1975 (with 5th cumulative supplement).

Reg.158(1)(e)

PATENT ATTORNEY PRACTICE IN NEW ZEALAND

NOTE: To be eligible the candidate must have already passed "The New Zealand Law and Practice Relating to Patents and Designs".

The subject is intended to be the final test of a candidate's ability to practice before the public and a good understanding of all aspects of New Zealand Patent Attorney Practice is the primary requirement.

Candidates should be familiar with the following Acts and Regulations:

- Patents Act 1953
- Patents Amendment Act 1992
- Patents Amendment Act 1994
- Patents Regulations 1954
- Patents (Patent Co-operation Treaty) Regulations 1992
- Designs Act 1953
- Designs Regulations 1954
- Copyright Act 1994
- Fair Trading Act 1986
- Trade Marks Act 2002
- Trade Marks Regulations 2003
- Patents, Designs and Trade Marks Convention Order 2000
- Commerce Act 1986
- Flags, Emblems and Names Protection Act 1981
- Plant Variety Rights Act 1987
- Layout Designs Act 1994
- All amendments of each of the above in force at the date of the examinations

The Copyright, Fair Trading, Commerce, Plant Variety Rights and Layout Design Acts are included only in respect of their interface with intellectual property commonly handled by a New Zealand Patent Attorney.

Candidates should also be aware of any common law rights which may be relevant, particularly in the area of passing-off and confidential information.

The examination questions will test a combination of a candidate's knowledge of the relevant legislation and the types of problems which a practising patent attorney would expect to encounter in dealing with clients and the Patent Office. The questions will however be directed primarily to the interpretation and criticism of patent specifications. In their answers candidates must also be able to demonstrate their knowledge of matters relating to:

- Practice before the New Zealand Patent Office and the Courts in respect of Patent Applications and Patents;
- The validity and infringement of Patents; and
- The application of the various Acts and Regulations set out above.

Reference Books and Source Material

- As specified in respect of papers (a), (b) and (d).
- Strategy in the Use of Intellectual Property - Momberg & Ashton.