

2018

**PATENT ATTORNEYS
EXAMINATION**

PAPER A1

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

Regulation 158(1)(a)

Duration: 3 hours (plus 10 minutes for reading)

QUESTION ONE (17 Marks)

- a) Explain which Act applies for the following New Zealand patent applications and whether a divisional application can be filed. Please provide basis for your conclusions.
- i. A patent application filed on 15 July 2015 claiming priority to a provisional application filed on 15 July 2014. (2 marks)
 - ii. An accepted divisional patent application filed on 28 June 2017 with an antedated filing date of 9 July 2014 and a priority date of 9 July 2013. (2 marks)
 - iii. A Treaty application, which entered the national phase in New Zealand on 1 October 2014, having a filing date of 1 March 2013 and a priority date of 1 March 2012. (2 marks)
- b) Discuss the following terms used in patent practice:
- i. Swiss type claim (3 marks)
 - ii. Interim injunction (3 marks)
 - iii. Unity of invention (3 marks)
- c) What is required for a claimed invention to be considered useful according to the New Zealand Patents Act 2013? (2 marks)

QUESTION TWO (5 marks)

You have received urgent instructions from an overseas attorney to file a patent application in New Zealand claiming priority to a Swiss application filed on 22 May 2017. The attorney says that New Zealand was accidentally omitted from the client's list of countries where a patent application was desired, and they have only now realised their mistake. Attached to her email is a copy of the original French language specification.

Explain to the overseas attorney the procedure for filing this application in New Zealand and adding the priority claim, mentioning any deadlines. Identify the information and documents (if any) you require.

QUESTION THREE (17 Marks)

Your client, Lucy, comes to you for advice on a patent filing strategy. You previously filed a provisional patent application for Lucy with the Intellectual Property Office of New Zealand on 16 August 2017 for a tennis racket handle grip. Lucy's tennis grip was used by Roger Federer when he won the Australian Open on 28 January 2018 and has attracted a lot of interest.

- a) Discuss alternative strategies and timelines which will delay examination and grant in New Zealand for as long as possible, including any important dates or deadlines Lucy needs to be aware of and the documents required. Please recommend a preferred approach, explaining the reasons for the recommendation. (12 marks)

Lucy calls you to say that she has just received reliable information that counterfeit versions of her tennis grip are turning up in stores in New Zealand from Chile.

- b) Propose a strategy and timeline of steps required to be taken at IPONZ to put Lucy in a position to enforce her patent rights in New Zealand as quickly as possible. (5 marks)

QUESTION FOUR (8 marks)

With reference to statute and case law, compare and contrast "fair basis" and "support" as these terms relate to a patent application.

QUESTION FIVE (20 marks)

Your client Akiko has developed and begun selling a jetpack which is able to be worn like a backpack and creates downwardly directed thrust, lifting the wearer vertically into the air.

Akiko tells you that she has just seen the publication of the Notice of Acceptance for New Zealand patent application number 856789 for a jetpack rocket engine with similar features to her own. Reviewing NZ856789, you and Akiko agree that the MOTHRA jetpack includes all of the features of claim 1.

Akiko considers that the claimed rocket engines are very similar to engines Akiko has been importing from Japan for several years. It is these engines that Akiko uses in her jetpack. Akiko understands that the Japanese rocket engines she imports are described in Japanese patent JP123456 and in New Zealand patent application NZ850001.

The details of NZ856789 are as follows:

Priority date: 26 January 2014

Filing date: 26 January 2015

Publication date of application: 26 July 2015

Acceptance date: 20 May 2018

JP123456 has the following details

Priority date: 12 June 2012

Filing date: 12 June 2013

Publication date of application: 12 December 2013

NZ850001 has the following details:

Priority date: 15 December 2013

Filing date: 15 December 2014

Publication date: 15 June 2015

- a) Advise Akiko of the steps and timeframes of the opposition process in New Zealand and in what circumstances extensions of time are available. (8 marks)
- b) Based on what Akiko has told you, advise Akiko of the relevant grounds on which she can oppose the grant of NZ856789. (10 marks)
- c) You proceed with filing an opposition for Akiko including an exchange of evidence. The day before the substantive hearing on the opposition, you receive notification from the Intellectual Property Office of New Zealand and the owner of NZ856789 that NZ856789 has been withdrawn. What are the remedies available to Akiko or action that Akiko can take against the owner of NZ856789? (2 marks)

QUESTION SIX (7 marks)

Olivia has received notification that New Zealand patent number 812345 has just been granted, in the name of her company Bananas Ltd, for a widget invented by employees Alan and Petra.

- a) In reviewing the patent details of NZ812345 on the register, Olivia noticed that Petra's name was missing from the register and Alan was named as the only inventor. Going back over her files, Olivia noticed that she had forgotten to include Petra's name in her instructions to the patent attorney who filed the application. What can be done so that the patent shows both Alan and Petra as inventors? Include discussion of the process for possible approval of the request. (3 marks)

- b) In reviewing the granted specification of NZ812345, Olivia was horrified to see that the specification was missing some claims pages, including what was supposed to be the patent's broadest independent claim. What action can Olivia take to remedy this situation? Note any further information you require. (4 marks)

QUESTION SEVEN (12 marks)

Your client Lexi has a business selling special insoles for netball shoes in New Zealand. Lexi imports the insoles from an Australian company "Netball Research Pty Ltd", who own New Zealand patent application number NZ823456 which covers features of the insoles and their method of manufacture. The insoles include ribs on their undersides depicting netballs. The ribs are recited in a dependent claim and provide improved cushioning.

The details of NZ823456 are as follows:

Filing date: 20 September 2015

Date of request for examination: 15 December 2016

First examination report issue date: 14 November 2017

Yesterday, Lexi reviewed the IPONZ register, and noticed that the status of NZ823456 is "ABANDONED".

- a) Why may NZ823456 have become abandoned? (2 marks)

- b) The price of the insoles charged by Netball Research Pty Ltd is very high. Lexi realises that the insoles can be cheaply manufactured in New Zealand according to the method described in NZ823456. As NZ823456 has been abandoned, Lexi believes that she is now free to manufacture the insoles. Advise Lexi on the risks of this approach, and any safeguards she may be able to rely on if she chooses to work the method described in NZ823456. (10 marks)

QUESTION EIGHT (14 marks)

Metal roofing tiles need to be painted or otherwise coated, not only for aesthetic reasons, but to protect them from corrosion. Before a metal tile can be painted it needs to be treated to remove any grease or other dirt.

Your client, RoofTech, has New Zealand patent number NZ834567, with the first claim reading:

- 1) *A method for coating a metallic roofing tile, including the steps of:*
 - a) *treating the metallic roofing tile with a composition including ABC; and*
 - b) *applying a layer of polymer XYZ to the treated metallic roofing tile of step (a).*

RoofTech has just carried out some forensic testing on a metal tile product sold by TileCo and found traces of a composition including ABC between the metal tile and an outer layer of the polymer XYZ.

RoofTech tells you that they sent a letter to TileCo in which they allege that TileCo has infringed their patent and that RoofTech intend to sue TileCo if they do not halt all business activity in ten days. RoofTech also tells you that they have informed customers that TileCo are infringing NZ834567 and that the customers should not buy tiles from TileCo.

TileCo have replied denying infringement. They concede that they apply polymer XYZ to metal tiles, but they purchase tiles which come pretreated with ABC from another company in New Zealand, CoatCo. Your checks reveal that CoatCo and TileCo have the same parent company, RoofCo. TileCo, CoatCo and RoofCo all have several common directors.

- a) Have RoofTech opened themselves up to any liability? (2 marks)
- b) Discuss whether NZ834567 has been infringed. (9 marks)
- c) What action can RoofTech take to enforce NZ834567 and what remedies are available to RoofTech? (3 marks)