

**2014**

**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 1**

- a) You received instructions today from an overseas associate to file a national phase application in New Zealand based on a PCT application with a priority date of 25 November 2011. Outline to the associate what needs to be done to make this national filing including a discussion on IPONZ procedures and any relevant deadlines (4 marks)
  
- b) You also receive separate instructions today from a New Zealand client to file a PCT application at IPONZ as Receiving Office, based on a New Zealand priority date of 28 June 2013. Outline the procedure for filing the PCT application, along with any relevant deadlines (3 marks)

(7 marks total)

## **Question 2**

How do the provisions of the Patents Act 2013 (the 2013 Act) differ from those of the Patents Act 1953 (the 1953 Act) in respect of the following:

- 1) Examination of a patent application (4 marks)
- 2) Prior Art Base (4 marks)
- 3) Utility (2 marks)
- 4) Infringement exemptions (4 marks)
- 5) Third party challenges before the Commissioner (4 marks)
- 6) Deadlines for maintenance and renewal fees (5 marks)

(23 marks total)

### Question 3

(i) You conduct a general enquiry meeting with John, a manager of an R&D company StartupTech Ltd. You obtain instructions to draft a complete specification in the first instance for the company's improved trailer hitch, and file as part of a New Zealand patent application. John says that the employee most closely involved in devising the trailer hitch is unavailable to sign any documents or provide input to a patent specification until September. He also says the invention won't be disclosed until a patent application is filed.

Discuss the law relating to who may apply for a patent in New Zealand, and advise John under both the Patents Act 1953 and the Patents Act 2013. (6 marks)

(ii) On further questioning John lists the members of the research team:

- a) A research assistant who devised a novel feature of the working prototype.
- b) A research director who directed the general direction of the research and development.
- c) A technician who carried out safety testing of the trailer hitch.
- d) A person present at a brain storming session in which the idea for the trailer hitch was conceived.

For each team member discuss with reasoning whether or not he/she should be listed as an inventor on the patent application. (2 marks for each part-8 marks total)

(iii) What are the implications for wrongly naming inventors? (2 marks)

(iv) You file the application and receive an examination report. In the examination report the examiner has raised a unity of invention objection. Advise your client on what this objection is and the recommended options to respond to the objection. (2 marks)

(v) What are the implications of filing a divisional application in relation to inventorship? (2 marks)

(20 marks total)

#### **Question 4**

Discuss the patentability of the following inventions with reference to the relevant provisions of both the Patents Act 1953 and the Patents Act 2013.

- a) A new type of tomato which has fruit with better flavour and which stays fresh longer after harvest. (3 marks)
- b) A computer program to implement a novel method of betting. (3 marks)
- c) A new composition and its use in a method for treating Alzheimer's Disease (3 marks)

(9 marks total)

### Question 5

You received a telephone call from a Wendy Brown yesterday who tells you that she has been importing and selling a walk-through boot cleaning machine made by Brush Brothers Ltd for use in the food industry. More recently she has designed and had made her own boot cleaning machine which she now sells. She tells you that she recently received a letter from Brush Brothers Ltd informing her that her machine infringes the apparatus and method claims of their New Zealand patent NZ 456789 for a footwear sanitising apparatus, and to stop selling her machine immediately. Wendy tells you she was selling the Brush Brothers Ltd machine covered by patent NZ 456789, but she did not think it similar to her boot cleaning machine.

- i) Advise Wendy on the preliminary steps you would recommend she take. (5 marks)
- ii) On review of a sample of the Brush Brothers Ltd apparatus you notice the marking 'Patent Pending'. Advise Wendy how this marking may have an influence on her rights. (2 marks)
- iii) After your assessment of the situation you come to the conclusion that Wendy is likely to infringe at least claim 1 of NZ 456789. Advise Wendy of her options. (5 marks)
- iv) On further investigation of the IPONZ database entry for NZ 456789 you notice that this patent had lapsed through non-payment of a renewal fee before Wendy began selling her machine but that the patent had since been restored and is now current. Advise Wendy of the implications of this situation. (4 marks)

(16 marks total)

### **Question 6**

Discuss the below with reference to the legislation and case law where appropriate.

- a) Collocation of integers. (3 marks)
- b) Cognate application. (3 marks)
- c) Amendment after acceptance by way of correction. (6 marks)

(12 marks total)

## Question 7

Your client Robert from Bait Co. Ltd has a granted and current New Zealand patent for a collapsible fishing container for holding bait (NZ 499999). The collapsible fishing container comprises a net structure, and a closure.

Robert tells you that he is aware that his friend Jack of Whitebait Ltd has also filed a New Zealand patent application NZ 625000 for a collapsible fishing container which was accepted on 16 May 2014.

Robert tells you that he believes Jack's container is not patentable in light of his collapsible fishing container which he has been selling for years from his website. He further tells you that the closure disclosed in NZ 625000 is very similar to that of other very well-known fishing containers used in the industry, and the net structure disclosed in NZ 625000 is described in a magazine article published in 1960.

i) Advise Robert of the steps and timeframes of the opposition process and the most relevant grounds on which Robert can oppose the grant of NZ 625000. (11 marks)

ii) You prepare and file a notice of opposition and statement of case. Within 5 days you receive a counterstatement and an assurance from Jack that he will not try to stop Robert selling his fishing container if your client agrees to withdraw from the opposition process. Robert tells you that he wants to withdraw from the opposition. Advise your client on the withdrawal procedure and its consequences. (2 marks)

(13 marks total)