

2014

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)

Question 1**(6 marks total)**

A client comes to see you about obtaining patent protection for a test to diagnose disease X. The test involves taking a sample of blood from a patient and measuring the levels of a marker called ABC2, a naturally occurring protein. Levels of ABC2 above 20mg/ml indicate that the patient is at risk of developing disease X. Levels of ABC2 above 50mg/ml indicate that the patient has disease X.

Discuss with reference to relevant cases what patent protection is available in the US and through the EPO for:

- a) Isolated ABC2 protein **(2 marks)**
- b) The diagnostic test **(2 marks)**

The USPTO have this year issued new guidelines regarding the patent eligibility of products of nature. What is the main impact of these guidelines for your client? **(2 marks)**

Question 2**(10 marks total)**

Your client has a number of patent applications around the world which are in the examination stage. All are approaching a final due date for filing a response with current extensions of time being used up. You have sent various reminders and your client now advises that they wish to delay prosecution if possible as they are carrying out further tests of their invention to make sure the results in the patent application are reproducible. The invention is highly commercial, however, some doubt has been thrown on the initial experiments. Your client wants to maintain the patent applications pending at minimum cost. Advise what options are available for:

- a) Europe
- b) US
- c) Australia
- d) China
- e) Japan

(5 marks)

For each of the above countries, if an applicant becomes aware of a potential infringer, how can examination and grant be accelerated in each of the above jurisdiction? **(5 marks)**

Question 3**(10 marks total)**

Your client's accepted standard Australian patent application was opposed on 10 September 2012. The opponent filed their evidence in support of their statement of grounds on 20 April 2014.

- a) When is your client's evidence in answer due? **(1 mark)**
- b) What are the next steps in the opposition proceedings? **(2 marks)**
- c) Your client's main witness has been taken ill and cannot complete his Statutory Declaration. What are your options? **(2 marks)**
- d) The client is worried about the protracted nature of the opposition and has a granted innovation patent. The opponent is about to launch an infringing product – discuss enforcement of the innovation patent. **(2 mark)**
- e) Your client has made a change to the patented product that is not claimed in their previous filings – what can they do to protect the change? **(3 marks)**

Question 4**(10 marks total)**

A client filed a standard patent application in Australia on 1 October 2011 claiming priority from an Australian provisional application dated 1 October 2010. A direction to request examination issued and an examination request was filed on 10 April 2013. Four documents have been cited against the novelty and/or inventive step of all of the claims as follows:

	Priority date	filing date	publication date
D1	12 Jan 2000	12 Jan 2001	12 July 2001
D2	20 Aug 2009	20 Aug 2010	20 Feb 2011
D3			3 Feb 2008
D4			2 Oct 2010

D1 is from a field that is not directly related to the client's invention. D2 is a PCT International application in the relevant art field. D3 is a trade journal published in Spain in the relevant art field and D4 is the inventor's own scientific publication disclosing the invention.

- a) Advise the client on the relevance of each document D1-D4. **(4 marks)**
- b) Would your answer be different if the request for examination was filed on 16 May 2013? **(4 marks)**
- c) Your client has an equivalent US pending patent application. What are the disclosure requirements? **(2 marks)**

Question 5

(14 marks total)

A number of changes to US Patent law came into effect on 16 March 2013 (America Invents Act). One such change was from first to invent to a first to file system. With respect to US law, answer the following with explanations where appropriate:

- a) Will the first to invent provisions continue to apply to all patent applications filed before 16 March 2013? **(1 mark)**
- b) Do the first to file provisions apply to all patent applications filed after 16 March 2013? **(1 mark)**
- c) If an applicant filed a US patent application on 1 April 2013 claiming priority to an earlier filed US provisional patent application (filed 1 April 2012) and added new claims not supported by the provisional application, will the patent application be subject to the first to file system? **(1 mark)**
- d) Would someone who copies another's idea and files a US patent application before the original inventor be entitled to a patent? **(1 mark)**
- e) Under the first to file provisions, does a public use or sale activity by the inventor or another party have to occur in the USA to qualify as prior art? **(2 marks)**
- f) What is the effective prior art date of a US patent or published US or PCT patent application designating the US? **(1 mark)**
- g) What is the effective prior art date in the US of a Japanese patent application that was filed on 12 December 2013 and was published on May 12 2015? **(1 mark)**
- h) Explain what is meant by derivation proceedings and what the requirements are for seeking derivation proceedings. **(3 marks)**
- i) Explain what is meant in US law by:
 - micro entity **(1 mark)**
 - small entity **(1 mark)**
 - large entity **(1 mark)**

Question 6**(6 marks total)**

Your client has very recently been granted a patent in the US. Corresponding patent applications are pending in China, Taiwan, Korea, Australia, India and Europe – none have yet been examined.

- a) The priority application was filed at the USPTO. Can you use your client's granted US patent to assist in prosecution in the other countries in which patent applications have been filed? Explain the procedure. **(4 marks)**
- b) Would it make any difference to your answer if the priority application was filed in Australia and the client's Australian patent was granted first – if so, explain why. **(2 marks)**

Question 7**(8 marks total)**

Your client has a pending PCT application that was filed on 10 December 2012 claiming priority from a New Zealand patent application filed on 10 December 2011. Despite numerous reminders you did not hear until today that they want to pursue patent protection in France, UK, Ireland, Germany, Hong Kong, Japan, South Korea, Canada, Australia, the USA, Taiwan, China and India.

Advise your client whether or not patent protection can be validly obtained including deadlines and extensions that may be available. **(8 marks)**

Question 8**(8 marks total)**

You filed a New Zealand patent application for your client with a provisional specification on 15 June 2013. Despite your reminders you did not receive instructions to file any corresponding overseas patent applications. Early this morning your client contacts you in a panic wanting to file a PCT application. He mentions that he recently moved to Australia to promote his invention and did not receive any reminders as his mail has been forwarded to the wrong address. You check your file and note that the invention was published in a newspaper three weeks after the provisional application was filed. Advise your client on the options, if any, he has for filing the PCT application using New Zealand as the receiving office including any deadlines applicable and what criteria must be met. Include advantages and disadvantages associated with each option. **(8 marks)**

Question 9**(8 marks total)**

Your client, an Australian pharmaceutical company, conducted secret pre-clinical trials of a compound (compound X) on a small number of patients in August 2013. Compound X has been previously used to treat patients with asthma when inhaled. Your client's trials have shown that compound X is useful to treat skin disease when applied topically to the skin. The results were presented at a scientific conference in February this year. They have now come to see you to seek advice on how to obtain patent protection. The key markets will be Australia, the US, Canada, Europe, Japan and China. Advise them of their options for obtaining protection in these markets. **(4 marks)**

After filing for patent protection, the company reviewed the clinical trial data and noted a common serious side effect that they think can be cured by co-administration of compound Y. Compound Y is known to reduce the same side effect in other treatment regimes. They plan to carry out a new trial of a combination of X and Y soon. Advise the client what claim format could be pursued in each country of interest and how they can obtain patent protection for the combination. **(4 marks)**

Question 10**(8 marks total)**

- a) Your client has received a restriction requirement for its US patent application which also includes an election of species requirement. Explain to the client what this means and what the options are to reply, including time limits. **(4 marks)**
- b) Your client later receives an Office Action marked "Final". Explain to the client what this means and the options available. Include any time limits that your client has to meet. **(4 marks)**

Question 11**(12 marks total)**

- a) A client comes to you at 5pm on the last day for filing a PCT application. The client/inventor is a Canadian citizen who is resident in New Zealand. Which of the following receiving offices would you choose to file the PCT application in and why: IP Australia, IPONZ, USPTO or directly at WIPO? **(4 marks)**
- b) You file a PCT application but erroneously forget to claim priority. You don't notice until 6 weeks after the PCT filing date. Can the priority claim be restored? What is the procedure? **(4 marks)**
- c) Your client's countries of interest are Europe, Australia, the US, China, Japan, Korea and India – what approach would each country take to a restored priority date? **(4 marks)**