

**2016**

**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 (6 marks)**

You have received an examination report for a patent application filed under the Patents Act 2013.

- (a) The examiner objects that the claims are not concise. Explain what this objection means and how it may be addressed. Refer to any relevant case law. (3 marks)

The examination report includes a deadline for responding as well as a deadline for placing the application in order for acceptance.

- (b) Explain what must be done before the expiry of the response deadline and mention the consequences, if any, of failing to act by the deadline for responding set by the examiner. What is the deadline for placing the application in order for acceptance? (3 marks)

## Question 2 (13 marks)

- (a) An overseas attorney contacts you for assistance in filing a patent application in New Zealand claiming priority to a French application filed on 30 June 2015. 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 mention any deadlines. Identify the information and documents (if any) you require to obtain a filing date. (4 marks)

- (b) The same attorney has asked you about entering the national phase from a PCT application with a priority date of 4 December 2013. The PCT specification is published in French. Explain the procedure for filing this application in New Zealand including any deadlines. Identify the information and documents (if any) you require to enter the national phase. (3 marks)

- (c) After providing the requested information for (b), the attorney contacts you again. Unfortunately, the PCT application's priority date was incorrectly entered in her firm's case management system and the priority date was actually 4 November 2013.

(i) The attorney informs you that the PCT application was filed on 4 December 2014 as a result of this error. Advise the attorney what, if anything, can be done. (2 marks)

(ii) What if the PCT application was filed on 4 November 2014 but your instructions to enter the national phase in New Zealand were only received now? Explain what, if anything, can be done and any procedural requirements. (4 marks)

### **Question 3 (10 marks)**

According to the Patents Act 2013, briefly discuss what does and does not constitute infringement of a granted patent. Please do not refer to any case law. (10 marks)

### **Question 4 (15 marks)**

You report to your client Stan that a patent application filed by a competitor company has just been accepted. The application has a complete specification filing date of 30 October 2014. The claims are directed to a combination of two herbicides in a specific ratio. Stan's company has been making a similar product since July 2014 which you consider to fall within the scope of the accepted claims. He is concerned about the patent impacting on his business.

What options does Stan have? What are the advantages and disadvantages of each and which would you recommend? What further information may be required? (15 marks)

### **Question 5 (7 marks)**

Your client Francine runs a pharmaceutical business that formulates various medicines and cosmetics. Francine has read glowing reviews on the internet about a new composition for eliminating wrinkles and firming skin. She is very interested in manufacturing this product because she believes that there is a big market for it in New Zealand and she has not been able to find the product for sale anywhere in New Zealand.

Francine has done some research and finds that the composition is covered by a New Zealand patent owned by Excelsior Skin Ltd. The patent was granted on 10 April 2013 and is in force. She has tried to contact Excelsior Skin Ltd with no success. From your own review, you find no grounds to challenge the validity of the patent.

Advise Francine what, if anything, she can do in this situation. Include any relevant deadlines, the steps she needs to take and any restrictions she may need to be aware of. (7 marks)

### Question 6 (9 marks)

Your firm is handling a patent application for which examination was recently requested. You have now received the first examination report. The application claims priority from a German patent application.

The examiner has cited a patent document against claim 1 which has a priority date earlier than the filing date of the German patent application, but the cited document became open to public inspection after the filing date of the German patent application. You note no amendment was made to claim 1 and claim 1 is identical to claim 1 in the German patent application.

- (a) Explain the relevance of this citation to your application with reference to the relevant section of the Act and inform your client of any criteria set out in the Act for such citations. (5 marks)
- (b) How does this differ from the corresponding Patents Act 1953 provision? (2 marks)
- (c) Further embodiments were added to the specification forming the basis of your client's New Zealand application. Does this information affect your answer to (a)? (2 marks)

### Question 7 (18 marks)

Are the following inventions patentable subject matter under the Patents Act 2013? Please explain your answer:

- (a) A method of diagnosing glaucoma by applying a composition to a human's eye that changes colour to indicate increased pressure in the eye. (2 marks)
- (b) A method of treating skin cancer in dogs and cats by applying a topical ointment to the animal. (2 marks)
- (c) A peach tree variety that produces larger fruit with sweeter flesh. (2 marks).
- (d) A process for altering human embryonic stem cells. (2 marks)
- (e) A process to calculate an optimal time to exchange foreign currency based on market fluctuations which is preferably implemented using a computer program. (2 marks)
- (f) A computer program that improves the fuel efficiency of a motor vehicle. (2 marks)
- (g) A motor that allegedly powers itself through its own motion without the need for an external power source. (2 marks)
- (h) A new type of can opener that has been imported into New Zealand. The can opener has not been seen in New Zealand before but has been advertised and sold overseas. (2 marks)
- (i) A novel mixture of drugs for euthanasia of farm animals such as cows and pigs. (2 marks)

### Question 8 (9 marks)

You filed a patent application for your client Steve last month. The patent application relates to a new type of hay baler. Steve comes to see you in a panic because he has just seen what appears to be an identical hay baler described in detail in promotional material on display at his local farming supply store. The store manager told Steve that the promotional magazine describing the hay baler was supplied by a company called Hay-ley Limited and that they first received a copy at the beginning of the year.

- (a) How might the magazine be relevant to Steve's patent application? (1 mark)
  
- (b) You find out that the owner of Hay-ley Limited is a Hayley Smith. Steve tells you that he had spoken in confidence to Hayley some time ago when he was developing his hay baler. He had shown Hayley detailed working drawings of the hay baler because he thought her company might be able to help him produce and market the hay baler later. How does this information affect your answer to (a)? (3 marks)
  
- (c) Steve tells you he is working on another invention, a safety cage for a quad bike. The safety cage uses a new type of fastener for fixing the cage to the bike under the chassis of the quad bike. He has been testing the safety cage on his farm for the last two months, and sometimes rides the quad bike with the safety cage along the boundary of his property which is adjacent to the main road.

Steve is satisfied that the safety cage works and is a real improvement on previous safety devices. He wants to file a patent application. Advise Steve regarding any potential issues he should be aware of if he files an application. (5 marks)

### Question 9 (13 marks)

You filed a patent application with a complete specification for your client Roger on 9 September 2014. The invention is directed to a new reel for a fishing rod which makes it easier to land large fish without losing the line. The application has now proceeded to acceptance. Roger comes to you as he is concerned about a magazine article he has found. The article was published in an English magazine in the late 1990s and describes a very similar reel to that defined by the main claim of Roger's application. However, the magazine article does not describe some of the features found in Roger's dependent claims. Roger wants to know what, if anything, he should do.

- (a) Advise Roger regarding what action he may want to take. What are the benefits of acting; is there anything he should be aware of if he acts and are there any consequences if he chooses not to act? Reference any relevant case law. Is there any other information you need in order to advise Roger? (5 marks)
- (b) Roger decides to act to address the issue and instructs you to proceed. What do you need to do and what requirements need to be met? (5 marks)
- (c) How would your answer to (a) and (b) change if the application had already proceeded to grant? (3 marks)