

2017

PATENT ATTORNEYS

EXAMINATION

PAPER A2

The New Zealand Law and Practice relating to Patents and
Designs

Regulation 158 (1) (a)

Duration: 3 hours (plus 10 minutes for reading)

1. Your client provides you with a copy of a competitor's Registered Design NZ123456 which includes a single drawing showing a perspective view of a crane hook, and the following statement of novelty:

"The design is to be applied to a crane hook and the novelty in the design resides in the shape and/or configuration of the article as shown in the accompanying drawing."

Your client mentions that, in their opinion, the shape shown in NZ123456 would be very useful in helping prevent a load from slipping from the crane hook during lifting.

NZ123456 was filed on 10 May 2011 and names a single proprietor, Derek Crane.

Your client explains that in early 2016 they designed a crane hook which also helps prevent a load from slipping from the crane hook during lifting. Your client began marketing their crane hook in July 2016 and says that interest has been very positive.

Your client informs you that she has recently received a cease and desist letter from Crane Hooks Limited, which encloses a copy of NZ123456. The letter alleges that your client infringes NZ123456 and any associated copyright, and states that Crane Hooks Limited will take formal steps to enforce their rights if your client does not cease production of your client's crane hook immediately. Your client tells you that she has stopped selling her crane hook after receiving the letter.

A search of the Companies Office records shows that Derek Crane is the sole director and shareholder of Crane Hooks Limited.

With reference to the Designs Act 1953, the Copyright Act 1994, and relevant case law, please answer the following.

- a. What is the test for infringement of a registered design under the Designs Act 1953? **(3 marks)**
- b. Would there be any copyright in relation to the crane hook under the Copyright Act 1994? What is the test for infringement of copyright in a work? **(3 Marks)**
- c. In what respects (if any) does the test for copyright infringement differ from the test for infringement of a registered design? **(2 marks)**
- d. Outline the main grounds that could be used to invalidate NZ123456. **(4 marks)**

On checking the IPONZ designs Register you see that a renewal fee was due to be paid on NZ123456 on 10 May 2016. This renewal fee has not been paid.

e. Please advise your client as to the implications of this. **(11 Marks)**

(23 marks)

2. With reference to the Patents Act 2013 and relevant case law please answer the following:
- a. What is included in the 'prior art base'? **(3 marks)**
 - b. When can a prior disclosure be ignored for the purposes of assessing novelty? **(3 marks)**
 - c. What is the test for assessing whether claimed subject matter has an inventive step? What prior art can be used to challenge inventive step? **(4 marks)**

(10 marks)

3. Advise whether the following can be protected under the Designs Act 1953 and the Designs Regulations 1954, and also whether the following would be subject to copyright protection under the Copyright Act 1994:
- a. A dashboard for a bus (**3 marks**)
 - b. The image of the face of a famous Maori chief. (**4 marks**)
 - c. A vehicle tyre (**4 marks**)
 - d. An electrical connection for a clothes dryer (**3 marks**)
 - e. A fabric with a distinctive repeating pattern for which an order has already been taken. (**3 marks**)

(17 marks)

4. You have been asked by your client to conduct some due diligence on a business that your client is considering purchasing. The business makes a connector for connecting pre-fabricated walls of a building together. Your client's initial instructions state that the business includes as assets an incorporated New Zealand Company, Clever Connections Limited, and granted New Zealand Patent No. 123456 ("NZ123456").

The NZ Companies Office lists two directors of Clever Connections Limited, Mr A and Mrs B. Mr A and Mrs B are married. Your client has told you that Mr A is the technical brains of the operation and Mrs B handles the commercial side of the operation.

The relevant details of NZ123456, which was filed as a complete after provisional application, are as follows:

- An Application accompanied by a provisional specification filed: 12 February 2012
- An Application accompanied by a complete specification filed: 12 February 2013
- Notice of Acceptance: 12 March 2015
- Date of grant: 12 August 2015

Both the provisional and the complete applications name Mrs B as owner and Mr A as the sole inventor.

Your client provides you with a copy of NZ123456. It includes some drawings of the connector that is protected by the patent. Your client also provides you with a brochure which you notice also includes some photographs of the connector sold by Clever Connections Limited.

Please answer the following questions that your client has asked you:

- (a) When is the next renewal fee due on NZ123456? What are the consequences if the renewal fee is not paid? Can it be paid late? **(3 marks)**
- (b) I have thought of some changes that could be made to the connector to make it easier to manufacture. Can these changes be protected at this stage? If so, please outline a brief strategy for doing so. **(3 marks)**
- (c) Based on the above facts, was NZ123456 validly filed? **(5 marks)**

Your client has noticed that the connector in the photographs in the brochure appears to include a different connector to that shown in the drawings of NZ123456.

(d) Your client has asked you whether they are free under patent law to use the different connector shown in the photographs if your client does not buy Clever Connections Limited. Advise. **(2 marks)**

(e) Your client also asks you whether they would be able to obtain any protection for the different connector shown in the photographs if they do buy Clever Connections Limited. Advise **(2 marks)**.

Your client finally asks:

(f) Based on the above facts are there any forms of protection other than patent rights available for the connector described and illustrated in NZ123456. If so, what are they and who owns / may seek to protect them? **(2 marks)**

(17 marks)

5. Outline with reference to the Patents Act 2013 (“the 2013 Act”) and the Patents Regulations 2014:

- a) Contributory or indirect infringement of a patent granted under the 2013 Act **(3 marks)**
- b) When damages can accrue for a patent filed and granted under the 2013 Act and at what stage can action be taken to recover them **(3 marks)**
- c) The exceptions to infringement under the 2013 Act **(3 marks)**
- d) Innocent infringement under the 2013 Act **(2 marks)**
- e) The provisions for obtaining a declaration of non-infringement under the 2013 Act **(2 marks)**

(13 marks)

6. Your client writes to you enclosing a drawing, Drawing A (**attached**), of an outdoor tap that they have designed. Your client explains as follows:

We have been working on a range of new outdoor taps which we would like to sell in New Zealand and Australia. The basic design is as shown in sketch form in the enclosed Drawing A. We have labelled the key parts of the tap for reference. The tap comprises:

- *a curved tap body*
- *an inlet for connection to a water supply pipe*
- *an outlet which can optionally be connected to a garden house*
- *a handle for turning the tap on and off*

The inlet and outlet are provided with screw threads for connection to a standard size water supply and standard garden hose fitting respectively.

We are planning a range of five different taps, all based on the tap body of Drawing A. The main difference between each tap will be the handle. The handle shown in Drawing A is the first variant. The other four variants have more aesthetically appealing handles that we have spent some time designing. Each tap works like a standard tap, but we think it looks nicer.

We would like to delay costs if we can as the five taps have not yet been launched. We are considering putting Drawing A on our website to try to generate some interest in this range of products.

Please answer the following questions:

- a) Can we get a design registration for the first variant of our tap? Is this the broadest protection we can get? **(3 marks)**
- b) Please prepare a statement of novelty for including in a New Zealand design application for the first variant of our tap. **(2 marks)**
- c) Can we protect the various handles? If so, how? **(3 marks)**
- d) The taps can be supplied in different finishes including brass, brushed metal, and stainless steel. Can we deal with this in a design application? If so how? **(2 marks)**
- e) We can provide CAD drawings showing all of the shading of each variant and the internal workings. Will these be suitable for including in a design application? **(3 marks)**
- f) As all of the taps use the same body do we need multiple design applications in New Zealand? **(2 marks)**

- g)** We would like to include some written explanation on some of the features in the design application to highlight the design features of our taps. Will this be ok? **(2 marks)**
- h)** We might make some further changes as we go along. These should be quite small changes. If these types of changes are made, would we have to abandon any existing application and/or file a new application? **(3 marks)**

(20 Marks)

DRAWING A

