

**2017**

**PATENT ATTORNEYS**

**EXAMINATION**

**PAPER C**

Foreign Patent Law

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

**Question 1****(6 marks total)**

Your client has a pending PCT application filed on 11 February 2016 which claims priority from a New Zealand patent application filed on 13 February 2015. Your client wishes to enter the PCT application into the national or regional phase in Canada, China, the European Patent Office, Japan, Singapore and Taiwan.

- (a) Excluding any extension of time, what is the due date for filing each national or regional phase application?

**(3 marks)**

- (b) Including any extension of time, what is the final date on which each national or regional phase application could be filed?

**(3 marks)****Question 2****(9 marks total)**

The table below contains the particulars of your client's patent portfolio as at 6 July 2017.

Country or Region	Patent or Patent Application No.	Status	Priority date	Filing date
Australia	Australian Innovation Patent Application No. 2014604361	Granted on 11 September 2014	28 August 2013	26 August 2014
Australia	Australian Standard Patent Application No. 2014604362	Filed	28 August 2013	26 August 2014
Canada	Canadian Patent Application No. 2,948,122	Filed	28 August 2013	26 August 2014
China	Chinese Patent Application No. 20148060312.1	Filed	28 August 2013	26 August 2014
Europe	European Patent No. 2,153,481	Granted on 2 November 2011 and validated in the UK	12 August 2008	11 August 2009
United States	United States Patent No. 9,208,194	Granted on 8 December 2015	30 November 2011	12 November 2012

- (a) For each patent or patent application, state when payment of the next maintenance or renewal fee is due and whether any extension of time for payment is available.

**(6 marks)**

- (b) Your client does not instruct you to pay the maintenance or renewal fees in Canada, China and the United States. As a result, your client's patent or patent application in each of these countries lapses due to non-payment of the fee. Advise your client on what, if anything, can be done to revive them.

**(3 marks)**

**Question 3****(12 marks total)**

Your client is interested in obtaining patent protection for her latest invention in Australia, India and the United States.

She tells you about the following three disclosures of the invention:

- (i) a New Zealand patent application published on 26 August 2016 that was filed by your client's former partner after he unlawfully obtained the invention by hacking her email account;
- (ii) a description of the invention in a paper written by your client and published in the transactions of a learned society with your client's consent on 9 September 2016; and
- (iii) public use of a prototype of the invention by your client in New Zealand on 19 November 2016 in order to show potential customers.

(a) Explain to your client whether disclosures (i), (ii) and (iii) can be excluded from consideration in determining the novelty of the invention in each country and what filing strategy she could follow.

**(9 marks)**

(b) How would your answer to disclosure (iii) change if, instead of showing potential customers, the use of the invention had been in public because the invention was a hot air balloon and it was reasonably necessary to test the invention in public?

**(3 marks)****Question 4****(10 marks total)**

You recently filed a New Zealand patent application accompanied by a provisional specification on behalf of your client for a device called the 'Eggstractor' which hard boils and then removes the shell of an egg. Your client has now become aware of an almost identical device which is being made and sold in Australia by an Australian company, Bad Egg Pty Ltd.

(a) Advise your client on how he might obtain patent protection for the Eggstractor in Australia which is enforceable against Bad Egg Pty Ltd.

**(5 marks)**

(b) You have discovered that Bad Egg Pty Ltd filed an Australian patent application for its device shortly before you filed your client's New Zealand patent application for the Eggstractor. Your client mentions that he vaguely described an early prototype of the Eggstractor in his online blog. Advise your client on his options in Australia.

**(5 marks)**

**Question 5****(6 marks total)**

In G1/15, the Enlarged Board of Appeal of the European Patent Office issued a decision relating to partial priority dates (which can give rise to so-called "poisonous divisionals").

- (a) What was the outcome of the decision?  
**(3 marks)**
- (b) How likely is the outcome of the decision to influence practice in relation to divisional patent applications in New Zealand and Australia?  
**(3 marks)**

**Question 6****(11 marks total)**

You receive an office action for your client's United States patent application from your United States associate which raises a restriction requirement and an election of species.

- (a) Explain to your client what issues are raised in the office action and what options are available.  
**(4 marks)**
- (b) Your client informs you that she has made improvements to her invention that are not described in the patent application. Advise your client on her options.  
**(3 marks)**
- (c) You receive a further office action marked "Final". What does this mean and what options does your client have?  
**(4 marks)**

**Question 7****(10 marks total)**

You have filed a New Zealand patent application with a provisional specification that contains 150 pages and 120 claims. Your client wants to file a PCT application with the intention of entering the national or regional phase in Australia, Brazil, Canada, China, the European Patent Office, India, Japan, Korea, Singapore, and the United States.

Your client's preference is to receive a written opinion of an International Searching Authority which assesses the novelty and inventive step of all 120 claims in the New Zealand application. However, your client is also concerned to control costs on entering the national or regional phase. Bearing in mind the intended national or regional phase filing countries, what action would you recommend and why?

**(10 marks)**

**Question 8****(8 marks total)**

You forwarded your client (MyBad Ltd) examination reports for its Australian and United States patent applications. However, despite email reminders and a telephone call to the secretary of MyBad Ltd, your client does not give you instructions and both applications are marked-off as abandoned. In the telephone call you learnt that the secretary had received your email reminders but believed they were a scam as she had received scam renewal reminders in the past. Your telephone call with the secretary was not acted upon because it happened on the day before she got married and she forgot to mention it to her boss.

You report the abandonment of the applications to your client who is horrified by the events and asks if the applications can be revived.

- (a) What options are available to revive each application and what additional information will you need from your client?

**(4 marks)**

- (b) It's a year later and MyBad Ltd has again failed to provide instructions, this time for a response due, last month, to an extended European search report for a European patent application. What are your client's options and what further information, if any, will you require?

**(4 marks)****Question 9****(20 marks total)**

Your client (company A) is a New Zealand motor manufacturer which works with another New Zealand motor manufacturer (company B) on joint projects. Company B filed a PCT application for a motor which was published last week by WIPO. Company A considers that the motor claimed by the PCT application lacks novelty and is obvious over prior art. Company A wants to prevent company B from obtaining a patent for the motor claimed in the PCT application but "wishes to do so anonymously" as it does not wish to jeopardise its relationship with company B.

- (a) Advise company A on its options, if any, regarding the PCT application during the international phase.

**(2 marks)**

- (b) The relationship has broken down and company A no longer needs to be anonymous. The PCT application has entered the national or regional phase in Australia, Brazil, Canada, China, the European Patent Office, India, Japan, Korea, Singapore, and the United States. For each country or region, state what mechanisms exist to challenge the patent application in the relevant Patent Office before and after grant.

**(10 marks)**

- (c) Your client is particularly concerned about the possibility of a patent for the motor being granted in Australia. You check and find that an Australian application for the motor was published at acceptance on 6 May 2017. Advise your client on the grounds available to challenge it and the basic steps involved in an opposition.

**(8 marks)**

**Question 10****(8 marks total)**

Your client has an unpublished PCT application that was filed on 10 February 2017 claiming priority from a New Zealand patent application filed with a provisional specification on 10 February 2016. Your client informs you that she has noticed that one of the pages in the description of the PCT application includes data that was given to your client by a third party in confidence under a non-disclosure agreement. Your client tells you that the data cannot be published as doing so would breach the non-disclosure agreement.

- (a) Explain to your client what amendment options exist under the Patent Cooperation Treaty and whether any of these options do not involve the publication of the data.

**(5 marks)**

- (b) Explain what other options may be available to your client, indicating any additional information you may need.

**(3 marks)**