

2018

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. Outline with reference to the relevant parts of the Patents Act 1953 (“the 1953 Act”), the Patents Act 2013 (“the 2013 Act”), the Patents Regulations 1954 (“the 1954 Regulations”) and the Patents Regulations 2014 (“the 2014 Regulations”) how a third party can challenge a granted patent.. Your answer should briefly list the grounds available under each Act, explain when each such ground may be raised, and briefly summarise the main advantages and disadvantages of each. **(8 marks)**

2. You receive an enquiry from an overseas agent enclosing US Design Application No. 123456 filed 10 February 2018. The design relates to a breakfast cereal product, and the cardboard packaging in which the cereal product is sold. US Design Application No. 123456 contains only two drawings:
- i. Figure 1 – a black and white line drawing of one view of the packaging showing the shape of the packaging together with an arcuate stripe which is printed on the front and rear of the packaging; and
 - ii. Figure 2 – a black and white line drawing of one view of the cereal product.

The overseas agent has a number of enquiries about design law in New Zealand. Please answer each enquiry, providing reasons and referring to case law and/or legislation where appropriate:

- a. Would any of the aspects of the packaging and cereal shown in the drawings be registrable as a registered design in New Zealand? Our client would like a cost-effective strategy to protect every feature disclosed in the drawings which might be registerable. It does not need to delay costs. However, whilst the cereal product is near production, the packaging has not yet been signed off and could change. In particular, the colour of the packaging could change – currently the packaging is blue with a yellow stripe, but this could be changed to use less vibrant colours. Please recommend a filing strategy. **(5 marks)**
- b. US Design Application No. 123456 has not yet been published. Our client is keen to ensure that details of the design are kept confidential for as long as possible. Please advise whether and, if so, how this can be achieved in New Zealand and for how long. **(2 marks)**
- c. What are the general requirements for representations suitable for filing in New Zealand? Are there any particular considerations that we should bear in mind with the representations supplied? **(2 marks)**
- d. Our client is concerned that there may have been a public disclosure of the shape of the cereal by an employee in early February 2018. How does this affect our client's position in New Zealand? **(4 marks)**
- e. Our client has become aware of a competitor in New Zealand who is offering a cereal product for sale on the competitor's website that looks very similar to the cereal product included in its US Design Application No. 123456. The competitor's website states that their cereal product will be available from 1 August 2018 in New Zealand. Please advise whether our client can take action against the competitor, when it can write to the competitor and on what basis, what liability the competitor has to our client (if any), and what risks to our client there may be in writing to the competitor. **(8 marks)**

(21 marks)

3. You are approached by one of your contacts in a European company which has filed a European Patent Application on 1 January 2018. The Patent Application relates to a commercial greenhouse which has an X-shaped frame construction where each wall of the greenhouse includes a frame in the form of an X to which polythene sheeting is attached. This is attractive to look at. Further the X configuration of the frame reduces flex in the greenhouse, particularly during windy conditions, and thus enables a thin polythene sheeting to be used, reducing the cost of manufacture and assembly. Whilst the greenhouse is designed for commercial use for very large-scale greenhouses extending over many acres, as is common in mainland Europe, your contact mentions that the X-shaped frame could be used in smaller domestic greenhouses too.

Your contact explains that EU regulation for this type of product is surprisingly rigorous, and that a version of the greenhouse with the X-shaped frame had to be tested for at least the last six months in Spain. The tested greenhouse covered about an acre in a field accessible by a dirt track. The dirt track is on private property and is entered via a locked gate. The field can nonetheless be seen from a public road some distance away.

The European company would like to seek protection for the greenhouse and the method of making the greenhouse in New Zealand.

- a) Please prepare a note of advice to the company advising whether a valid patent can be obtained in New Zealand, the options for doing so, and any issues that may arise from the above fact scenario. **(10 marks)**

- b) Please also advise on whether any other types of protection might be available in New Zealand. **(3 marks)**

Refer to relevant case law and/or legislation where appropriate.

(13 marks)

4.

- a. Advise whether the following can be protected under the New Zealand Designs Act 1953 and, if so, how:
- i. The user interface on a new app for a smartphone; **(2 marks)**
 - ii. A coin with an image of a queen's head on it; **(2 marks)**
 - iii. A wine glass made from a shatter resistant plastic; **(2 marks)**
 - iv. A replacement brake disc for a sports car; **(2 marks)**
 - v. A set of barbeque utensils which each incorporate a unique copper loop with which to hang the utensil from a hook; **(2 marks)**
 - vi. A medal. **(1 mark)**
- b. On what grounds may a registered design in New Zealand be challenged and what is the procedure for doing so? Refer to legislation where appropriate. **(3 marks)**

(14 Marks)

5. Advise whether the following acts if committed by a third party in New Zealand would be an infringement of a granted patent in New Zealand, and the main factors to consider in each case:
- a. Supplying bottles for use in a carbonated drinks machine where there are patent claims only for the machine. The bottle has a particular shaped neck and opening configured to fit into the patented machine. **(2 marks)**
 - b. Supplying bottles for use in a carbonated drinks machine where there are patent claims only for the machine. The bottle is a conventional bottle having a standard neck and standard opening. **(2 marks)**
 - c. Use of a patented container locking device for securing containers to the deck of a ship, on a Singaporean container ship moored in Tauranga docks. **(1 mark)**
 - d. Use of a patented invention where the registered proprietor had failed to pay the renewal fee but has now applied for an extension to pay it. **(2 marks)**
 - e. Use of an invention after the earliest possible priority date of the claims of a patent by someone who had also used the invention before the earliest possible priority date. **(2 marks)**

(9 marks)

6. Mrs Smith has set up a company producing unique designs of wallpaper. She has recently produced a new design comprising a pattern of primary colours and has been selling wallpaper featuring this design for some months.

Last week, Mrs Smith received an email from a large Australian textile producer (Company A) alleging infringement of New Zealand Design Registration No. 789101 dated 1 May 2016 and demanding immediate withdrawal of this wallpaper design from the market.

As bright colours are very popular at the moment, sales are good and she is reluctant to stop selling the wallpaper design if she can avoid it.

You check the NZ Designs Register and note that NZ 789101 is registered in the name of a Mr Jones. The design covers a textile the pattern of which is similar but not identical to that of Mrs Smith.

- a) Mrs Smith asks you what considerations the Court would take into account when determining whether the sale of her wallpaper will infringe Company A's registered design rights. Advise with reference to case law. **(8 marks)**
- b) Describe how the considerations in (a) differ from the Court's approach to infringement in copyright law. **(2 marks)**
- c) Mrs Smith points out that she came up with her wallpaper design independently and had never seen the design shown in NZ 789101 or any textiles produced by Company A until she received their letter last week. She asks whether this means she can keep making and selling her wallpaper. Advise. **(3 marks)**
- d) You notice that the representations in NZ 789101 show the design in purple and green only. You also notice that the Statement of Novelty simply states that "The design is to be applied to a textile and the novelty resides in the design as shown in the accompanying representations".

Mrs Smith asks you if this has any effect on the test for infringement of Company A's registered design. Advise. **(3 marks)**
- e) Advise Mrs Smith on any implications of NZ 789101 apparently being owned by Mr Jones. In particular, advise whether Company A has any rights to NZ 789101, and whether or not Company A can bring infringement proceedings in respect of the design shown in NZ 789101. **(3 marks)**
- f) Because Mrs Smith is a small producer, she is concerned about the cost of dealing with this matter and would prefer to resolve any issues with Company

A. However, at the same time, she wants to keep producing her wallpaper using her bright colours. She asks you what her options are for doing so. Advise. **(5 marks)**

(24 marks)

7. You receive instructions to have a PCT international application enter the national phase in New Zealand.

The instructing letter you receive gives the following information:

- International Application No.: PCT/US2016/009385
- International Filing Date: 10 November 2016
- International Publication Date: 20 May 2017
- Priority Application: United States Patent Application 13/794045
- Priority Date: 20 November 2015
- International Applicant: Exam Enterprises Inc.
- Inventor: Mr A Exam

a) What is the due date for entering national phase in New Zealand from this patent application? What steps can you take to ensure that the national phase is validly entered? **(3 marks)**

b) The following paragraph appears in the published specification:

“This application is a continuation-in-part of utility application number US 12/123,456 filed in the US Patent and Trade Mark Office on 4 November 2015 by Mr An Exam, the contents of which are incorporated herein by reference in their entirety.”

What issues of New Zealand patent practice does this raise, and what should you ask your instructor in respect of those issues? **(6 marks)**

c) The instructions you receive also include a copy of an assignment of “the invention described in US patent application Serial No. 13/794045” from Mr A Exam to Exam Enterprises Inc., which is dated 25 November 2016.

What additional issue(s) arise and what advice would you give? **(2 marks)**

(11 marks)

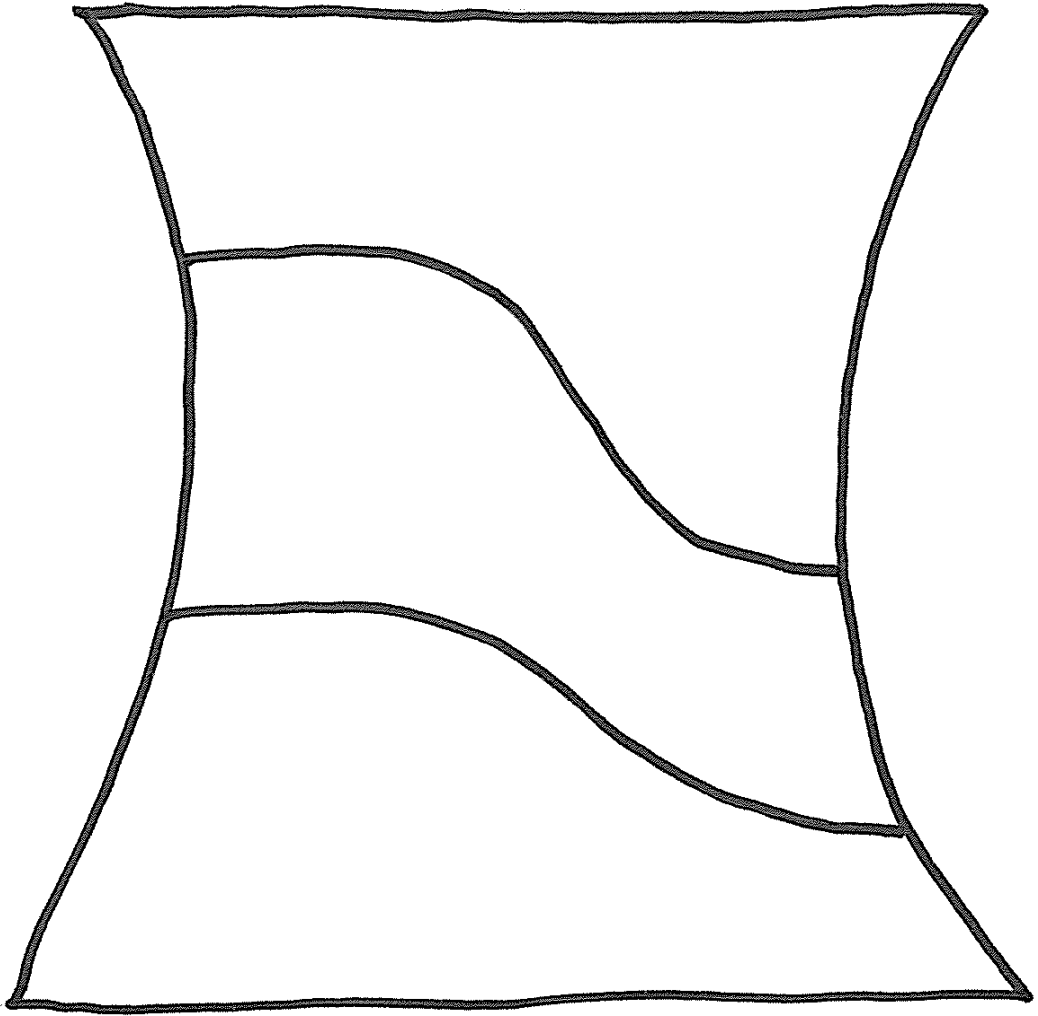


Figure 1

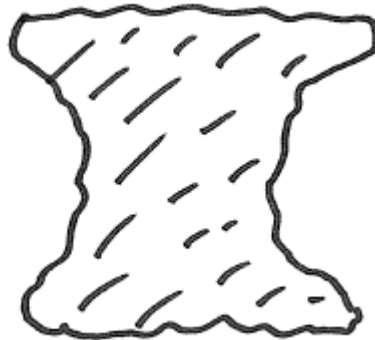


Figure 2