

2018

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 18 April 2017 which claims priority from a New Zealand patent application filed on 22 April 2016. Your client wishes to enter the PCT application into the national phase in Australia, Canada, China, Hong Kong, Singapore and the United States of America.

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

(3 marks)

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

(3 marks)**Question 2****(7 marks total)**

Your client is the inventor of an eating utensil combining a spoon and chopsticks. She has asked you to file non-convention patent applications in China, Japan, Singapore and Taiwan directed to the utensil and informs you that she believes there may have been sales of her utensil in some of these countries for the last eight months.

Advise your client of any relevant grace periods in these countries (including, where applicable, any actions that need to be taken) and whether or not these sales would prejudice your client's ability to obtain valid patent protection in these countries.

Question 3**(9 marks total)**

Your client is using, in New Zealand, a long standing efficient technology for the disposal of detergents and other products from household water and now intends to license the technology to a company in the Republic of Korea to use. You do a search and unfortunately locate a granted Korean patent directed to the same technology. Use of the disposal technology in Korea would infringe at least one claim of the granted patent. A full description of your client's technology has been published in New Zealand newspapers in the early 2000's. The patent was filed on 16 June 2014 and was granted on 10 April 2017. Advise your client on any possible options available to her for challenges to the validity of this Korean patent before the Korean Intellectual Property Office and the general procedure for each of these.

Question 4**(7 marks total)**

A New Zealand Member of Parliament has asked you to explain the features, benefits and limitations of an Australian Innovation Patent compared with an Australian Standard Patent.

Question 5**(7 marks total)**

Your associate, a European Patent Attorney, entered a PCT patent application into the European regional phase on 4 May 2018. The European specification has the same claims as the PCT application. The PCT search and examination was carried out by IP Australia. The claims are directed to two inventions, namely, a mousetrap in claims 1-8 and bait in claims 9-15. Your client chose not to pay an additional search fee when invited to do so by IP Australia and the International Preliminary Report on Patentability (IPRP) prepared by IP Australia was restricted to the mousetrap in claims 1-8. The IPRP asserts that claims 1-8 lack novelty and an inventive step in light of three cited documents.

Your client says that the mousetrap is more important, but that she wishes you to pursue all the claims.

- (a) What actions can be expected from the European Patent Office after entry into the regional phase and what deadlines will be set before any response on behalf of the applicant is required?

(4 marks)

- (b) Describe whether the answer to (a) would be different if the European Patent Office had carried out the PCT search and examination instead of IP Australia.

(1 mark)

- (c) If claims 9-15 are allowable but claims 1-15 are not allowable after examination of the European patent application, describe a way of gaining acceptance of the allowable claims in Europe while still pursuing those not allowable? Indicate any deadlines.

(2 marks)**Question 6****(13 marks total)**

Your client is the director of a New Zealand start-up lighting company with patent applications pending in China, India and the United States of America relating to its new energy-saving lightbulb. Despite these patent applications having been filed in 2014, none of the patent applications have yet been examined.

Your client is concerned that by the time the patents are granted on the applications, the company will have little time to recoup its costs and make a profit before the patents expire and competitors move in.

- (a) For each jurisdiction, advise your client how, for each application, they could get a first examination report as soon as possible and any conditions upon doing so.

(8 marks)

- (b) For each jurisdiction, advise your client whether the term of patent protection can be extended to compensate for the delay and what the length of the extension might be.

(5 marks)

Question 7**(13 marks total)**

Discuss the use of the patent prosecution highway to accelerate prosecution of an Australian patent application. Include details of the different routes available and any relevant requirements and procedures.

Question 8**(11 marks total)**

You have a PCT application for a client ready for entry into the national or regional phase in Australia, Europe (EPO), Japan, the United Kingdom and the United States of America. The PCT application contains 127 pages (including 6 claim pages, 20 drawing pages and 1 abstract page). The IPRP has issued and notes that all 70 claims (including 6 independent claims) are novel, inventive and industrially applicable.

Advise your client on the ramifications of entering the PCT application into the national or regional phase and any strategies for avoiding pitfalls. Note any applicable limits but do not indicate any actual costs.

Question 9**(10 marks total)**

Your client's accepted standard Australian patent application was opposed on 10 September 2015. The opponent filed their evidence in support of their statement of grounds on 20 April 2018.

- (a) What are the next steps in the opposition proceedings and when are they due?
(3 marks)
- (b) Your client's main witness has been taken ill and cannot complete his Statutory Declaration. What are your options?
(2 marks)
- (c) Your client is worried about the protracted nature of the opposition and learns that the opponent is about to launch an infringing product in Australia. Your client has a granted innovation patent containing the same independent claims as the standard patent application. Discuss the steps that should be taken before IP Australia.
(2 marks)
- (d) 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 10**(17 marks total)**

You filed a New Zealand patent application accompanied by a provisional specification on 6 June 2017 for your client. The invention relates to a method of detecting contaminants in ground water. You obtained an assignment from the sole inventor to his company and filed the New Zealand patent application in the name of the company.

You have just filed a PCT international patent application on 1 June 2018 claiming priority from the New Zealand application. You are about to report the filing of the PCT application to your client.

- (a) Outline the timeline your client's PCT application will follow from the filing date through to the national phase and/or regional phase entry. Include any deadlines for performing the required tasks. Advise your client of any options available to him and the advantages of those options.

(9 marks)

- (b) Explain the circumstances under which a Power of Attorney may or may not be required.

(2 marks)

- (c) Assume that 3 months after filing the PCT application, an International Search Report (ISR) and written opinion issues citing 5 prior art documents, two category A citations, one category X citation and two category Y citations against all of the claims. Report this to your client and advise what options are available and the time frames.

(4 marks)

- (d) Would your advice in (c) be different if the ISR issued 11 months after the filing of the PCT application?

(2 marks)