

2015

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 (12 marks)

Are the following inventions patentable subject matter in New Zealand? Please explain your answer:

- (a) A local restaurant comes up with a new tasty sauce for its hamburgers. (2 marks)
- (b) The same restaurant has also come up with a new additive for the same sauce. The additive, while not altering the flavour, prevents the sauce becoming runny when not refrigerated. (2 marks)
- (c) A doctor finds that patients being treated with a known cancer drug also stop having migraine headaches. (2 marks)
- (d) The same doctor has also developed a software program for keeping track of when her patients are due for renewed prescriptions. (2 marks)
- (e) A local beautician has noted that a very popular make-up remover also causes dry skin. She has the great idea of repackaging the make-up remover with a container of skin moisturiser. (2 marks)
- (f) A local rocket hobbyist started adding compound X to his rocket fuel. Compound X is known to make green smoke, and the hobbyist decided to add it to the rocket fuel to help him track his rockets in the sky. However, he has found that when he adds compound X the rockets go up to 20% higher, and do so in a much shorter time. (2 marks)

Question 2 (15 marks)

A potential client, George, comes to see you. He is about to launch a new folding chair product that his company has been developing. He has just discovered a recently accepted patent application, NZ654321. Some of the claims of NZ654321 appear to read on George's folding chair product, and the drawings of NZ654321 look very similar to the new folding chair product. George explains that he cannot see how NZ654321 can be valid. He places a magazine article and a photograph from a catalogue in front of you and explains that his device was made according to these documents, but with a few simple modifications.

George also explains that he has spent all of his money developing his new product, and there is no way he could afford to fund a challenge to NZ654321 before the Courts.

- (a) Explain the options available to George for challenging NZ654321, outlining the advantages and the disadvantages of each. (7 marks)

You obtain full details of NZ654321, and while looking over your shoulder George spots the names of the inventors, Sam and Joe. George stares in disbelief.

"Sam used to work for my company" George explains, "he wasn't directly working on this project, but he did work very closely with the same team. I always encouraged my guys to work together to solve problems. That is the main thing I employed them for, to look for solutions to problems". George also explains that Sam suddenly quit about a month ago with no explanation.

Joe is a designer whom the project team consulted. He provided input on the appearance of the new folding chair product. He was never employed by George's company.

- (b) Explain to George the possible relevance all the foregoing facts have to his rights, and what, if any, remedies are available. (5 marks)

On searching the IPONZ database, you discover that Sam has filed a patent application for a second invention, which is another furniture product. Sam acknowledges that he often came back to George's business premises at night to develop the second invention.

- (c) Explain whether George has any claim to the second invention. (3 marks)

Question 3 (24 marks)

Your firm is handling an application that entered national phase in New Zealand on 12 December 2014, on the instructions of an overseas agent.

You have now received the first examination report in which an objection has been raised that the claims are not unified and comprise four different inventions. The agent tells you that it is not familiar with New Zealand's unity of invention rules.

- (a) Outline how unity of invention is assessed in New Zealand, and what would need to be shown in order to overcome the unity of invention objection? (3 marks)

The agent advises that they may not be able to overcome the unity of invention objection and asks whether the filing of a divisional application is possible.

- (b) Advise the agent of any changes in the law in respect of divisional applications in the New Zealand Patents Act 2013, and what strategy might be best for the agent to recommend to its client. (4 marks)

The agent now advises you that when the PCT application was filed, a new example was added to the specification. This example is not in the original application from which the PCT application claims priority under the Paris Convention, and was contributed by one of the named inventors without input from the other inventors. The new example is the subject of one of the four inventions identified by the examiner. The agent has now attempted to draft a broad claim that covers all the examples disclosed in the PCT application as filed and asks you to advise whether this claim can be included in a divisional application for the new example.

- (c) Advise the agent. (7 marks)

In another objection, the examiner cites two publications. Claims 1 and 2 are considered to lack novelty, and all claims are considered to lack inventive step, either when each publication is read alone, or in combination.

- (d) Outline the test for novelty in New Zealand, with reference to any relevant case law or statutory provisions. (3 marks)
- (e) Outline the test for inventive step in New Zealand, with reference to any relevant case law or statutory provisions. (3 marks)
- (f) When considering inventive step, can the New Zealand examiner consider the two publications together? Explain your reasoning. (2 marks)

In response to the inventive step objection, the agent sends you a new set of data showing how well the invention works, and asks if the new data can be used in any way.

- (g) Advise what, if any, options there are for using the data to address the inventive step objection. Are there any risks involved? (2 marks)

Question 4 (8 marks)

An overseas agent sends you an urgent email. In this email she explains that her client has a PCT application, the national phase entry deadline for which was last month. Unfortunately, her email was “playing up” at the time and she did not receive the instructions from her client to proceed. While she was aware of the problem, she has only now checked the deadlines that fell over that time period and contacted her client.

- (a) Advise if it is still possible for the PCT application to enter national phase in New Zealand, and what would be required. (3 marks)

The agent explains that as a result of her email issues, she also missed instructions on filing a PCT application within the Paris Convention deadline. She filed the PCT application together with a request for restoration of the right of priority at the International Bureau (IB). The IB has granted the request for restoration of priority on the criterion of unintentionality, but refused the request on the criterion of due care.

- (b) Advise what effect the restoration of priority for the PCT application will have when the application enters national phase in New Zealand, and what would be required. (5 marks)

Question 5 (10 marks)

Explain the following terms, with reference to case law where appropriate:

- (a) Claim-by-result. (2 marks)
- (b) Purposive construction. (3 marks)
- (c) Dreyfus situation. (2 marks)
- (d) Experimental use exception to infringement. (3 marks)

Question 6 (20 marks)

Sally comes to see you with the results of some paint trials she has been doing. She has found that when she adds copper to the paint formulation it provides far superior rust protection. Sally is keen to get this into the market, especially as she is worried that her competitor, Greg, may also be onto the idea. Greg has been seen surreptitiously buying large quantities of copper sulphate and Sally is concerned that Greg may already be producing a copper based paint. Therefore Sally instructs you to file a patent application accompanied by a complete specification in the first instance.

Sally asks, "If Greg is making the same paint, I will be able to stop him once this patent is granted right"?

- (a) Assuming Greg has started making a copper based paint, advise Sally. (5 marks)

You file a patent application accompanied by a complete specification, and request examination. While awaiting the first examination report, Sally contacts you and says "I think that my paint formulation will work with any of the transition metals, at least cobalt, nickel and zinc, which all behave very similar in paint formulations". "Since I have shown that copper works, I can claim all of them can't I?" asks Sally.

- (b) Advise Sally on whether claims that cover the other metals would be valid, and whether there is any practice followed by IPONZ when examining such claims? (5 marks)

Sally has now tested some of the other metals. She has decided that she would like to include the results for the other metals into the specification. Furthermore, she has been talking to some overseas buyers, and now wants to get protection in other countries.

- (c) What options are open to Sally? Discuss the advantages and disadvantages of each. (10 marks)

Question 7 (11 marks)

Your firm is the address for service of a granted New Zealand patent. The overseas agent that instructed your firm writes to you advising that a new prior publication has been raised by the examiner for the corresponding application in Japan, and that as a result they have made some amendments to the claims to ensure the claims are inventive. The agent asks your advice on the following points:

- (a) Is there an obligation on the patentee to disclose the new document to IPONZ? (1 mark)
- (b) Irrespective of your answer in (a), should the patentee consider making the same amendments in New Zealand? Discuss the advantages or disadvantages of doing so now. (2 marks)
- (c) The agent has heard that there have been some changes to the law in respect to amendments after acceptance in New Zealand. Explain the law prior to the Patents Act 2013 making reference to any relevant case law, and explain how the law has changed under the Patents Act 2013. (4 marks)
- (d) When translated into English, the amendments, as made in Japan, do not have the exact same wording in the New Zealand specification. If the agent instructs you to make the same amendments in New Zealand, then what issues does this raise, and how would you recommend they are addressed? (4 marks)

END