

2003

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)

PAPER A2

Q1. Your client wants to manufacture and market in New Zealand a product which she has brought back with her from an overseas trip. The product features an overseas design number and you conduct a search in order to determine whether there is any equivalent New Zealand design. Advise your client fully with reference to any relevant sections of the Patents Act, Designs Act or Copyright Act as to what she may have to do if:

(a) Your search reveals no relevant New Zealand patents or designs. You note that the overseas design was lodged in the overseas country some 18 years ago;

4 marks

(b) Your search finds a New Zealand design registration in the same name as the overseas design. This has lapsed upon non-payment of the fifth year renewal fee. The lapsing took place two years ago;

4 marks

(c) You find instead *a* New Zealand design registration which has ceased and, although this features the exact product, it is in a totally different name from the overseas proprietor;

4 marks

(d) Further investigation reveals that the overseas product has only been in the marketplace in the USA for some 7 years. Does this change any of the advice you have given in answer to the above, and if so, how does your advice differ?

4 marks

Q2. Your client is the owner of a registered design for an article. She has now modified the design and seeks your advice as to what options she may have for obtaining further design protection in view of her earlier registration. Your client also intends to use the modified design on another article. What design registration options are available to your client in this instance? In your answer please advise your client as to the term of any new design registration and if and when any annuities are payable. Would your advice be any different depending on whether your client has already been selling the original design in New Zealand? What if a friend owned the original design registration and not your client?

8 marks

Q3. Please advise your client as to the registrability in New Zealand of the following items:

(a) A fork featuring a recently published photograph of the Sky Tower on its handle;

(b) A boat hull which improves boat performance in rough seas and which is integral with the rest of the boat;

(c) A sculpture of the Wellington Bee Hive;

(d) An icon for a computer screen that appears when the computer is switched on. **8 marks**

Q4. You have been asked by your client to investigate the validity of a New Zealand registered design in the name of a competitor company. The New Zealand registered design is dated 10 July 1998 and does not rely on any form of convention priority. Your client has provided you with a copy of an article in a UK trade magazine which shows the identical article in all respects to that contained in the representation of the New Zealand registered design that your client is concerned about. The name of the company promoting the article in the UK trade magazine is entirely different to that which appears as the registered proprietor of the New Zealand registered design. The UK trade magazine has never been received in New Zealand as far as you or your client can ascertain.

(a) What issues arise in relation to the validity of the New Zealand registered design as a result of the above fact scenario? **6 marks**

(b) What else might you do in order to assess your client's position? Are there any specific issues which you would have in mind when conducting that assessment? **6 marks**

Q5. You receive instructions from one of your major clients, a United States multinational corporation, to file for registered design protection in New Zealand based on a US filed design patent application. The US design patent application was filed five months ago and you therefore realise you have some time in which to protect your client's interest to its best advantage. You review the US design patent application and note that it relates to a toothbrush in a number of embodiments. All the embodiments are linked in that the handle of the toothbrush is identical in all embodiments but the head of the toothbrush, including the bristles, are of four different designs. The toothbrush heads are not intended to be interchangeable on a single toothbrush handle but rather the toothbrush as a whole (handle plus bristles) will be sold as a single unit. The four different toothbrush head shapes are stylised representations of a hippopotamus, a cat, a penguin, and a teddy bear. Your client's instructions clearly state that there is nothing unique about the bristles which will extend from one face of the toothbrush head although the shape of the bristles is clearly shown in the representations attached to the US design patent application and appear to you to be of a standard look.

(a) When filing applications in NZ for registered design protection for your client, how would you structure your approach to obtaining the best coverage for your client's toothbrush options? Give your reasons for the strategy you adopt. **10 marks**

(b) Draft statements of novelty for each of the options you have identified in (a) above. (One full statement of novelty should be given and, where subsequent statements of novelty simply repeat portions of the full version, the repeated portion may simply be indicated as such if you wish.) **10 marks**

Q6. One of your old friends from school calls you to ask your advice about protecting a product that he is sure will be a world-beater. The product is a nail having a spiral groove running along its length. He explains that the groove allows the nail to be driven into very hard wood products with a minimum of effort. He has never seen anything like it and its success is assured because when he exhibited it at the Mystery Creek Field Days this year the response was phenomenal.

(a) Has your friend messed up his options for protection? **2 marks**

Q7. Your friend from Question 6 above then tells you that, due to the considerable interest, he has accepted a huge amount of orders for his nails. He hasn't delivered them yet as they still need to be made, but he has got lots of money from the purchasers so he can meet the orders.

(a) Does your advice to your friend change from Question 6. Why? **3 marks**

(b) Fuelled with enthusiasm from early commercial success, your friend expresses interest in filing a PCT application. What further issues does this raise? **2 marks**

Q8. Your friend from Question 6 proceeded to invest in patent protection for his nail product. A PCT International application was filed. This was published about a month ago and his product is a roaring success. He approaches you with an interesting modification to his nail that he says a friend of his developed while messing around in his home workshop. The modification is essentially just the placement of a single cross-cut in the head of the nail which allows it to be screwed out if desired. Your friend doubts it is inventive once you have read the content of his PCT International application but he says it is certainly new.

(a) With reference to relevant case law, how might you assist your friend to protect the modification to his nail? Are there any advantages or disadvantages in the option you present? **9 marks**

(b) Your friend tells you that he would like his friend Bob, the inventor of the modification, to be listed on any patent application that may be filed as an owner along with himself. Advise your client what this might mean should he and his friend have a falling out over business direction. What problems may arise if Bob is not acknowledged as an inventor? **12 marks**

Q9. Your client is the patentee of a granted New Zealand patent directed to a product for the manufacture of a high-grade sewing machine oil. His patent has been in force for 10 years and he has enjoyed an effective monopoly in his market because his process allows him to produce an oil with excellent properties at a price that others cannot really compete with. He has now found that a competitive product is available that is identical to his (he has had this confirmed by chemical analysis). The product was made in China, a country in which he does not have any patent protection, but he does not know how it was made and therefore cannot determine if his process was used.

(a) Advise your client on his options. What further information may he require?

3 marks

(b) Whatever your advice in 9(a) above, you note that your client's New Zealand patent does not have any "product-by-process" claims. Can there be a case for infringement in New Zealand in the absence of such a claim in the circumstances described in question 9 above? Please refer to any relevant case law to support your answer.

5 marks