

**2004**

**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**

[25 marks total]

On 22 January 2003 you filed a patent application with a provisional specification on behalf of your client, DEF Medical Limited. Jim Nobody is the sole director and shareholder, and the inventor of the invention covered by the application. The invention relates to a new composition for the treatment of odorous feet.

- a) It is now February 2004. Despite your reminders Jim has only just contacted you. Advise him of the options, at that time, regarding the New Zealand patent application.  
(3 marks)
- b) Jim advises that the composition has changed a little since the patent application was filed. In November 2003 he discussed the treatment at a natural healing conference, and gave away a few samples of the new composition for people to try. Advise Jim how this might affect the patent application.  
(3 marks)

Regardless of your answer to part b) above, assume that you eventually file a complete specification on 15 March 2004. The specification now also describes a web based diagnosis and prescription system for the new composition. There are claims to:

- (i) the composition (claims 1 to 6),
- (ii) the use of the composition for treating odorous feet (claims 7 to 18),
- (iii) a programmed computer system which performs diagnosis and customises a composition for the user (claims 19 to 26), and
- (iv) a method of diagnosis and customisation (claims 27 to 38).

You have now received an examination report.

- c) Part of the examination report reads: "The claims relate to more than one invention." Explain the options to Jim.  
(3 marks)
- d) The examination report goes on to add the following observation: "Claims 7 to 18 appear to relate to a method of treating humans." Briefly advise Jim of the present position, and the options available.  
(5 marks)
- e) The examination report further says: "Claims 27 to 38 appear to relate to a business method per se." How does this reflect published IPONZ practice?  
(1 mark)

- f) The examination report further says: “A search has been conducted in relation to Claims 1 to 6. At least claim 1 appears to be anticipated by each of the following:
- (i) US 5,638,573 granted on 23 April 1995 and available from 20 May 1995
  - (ii) NZ 325235 published 27 July 2003
  - (iii) Reviews of Russian Olfactory Society, 2002, vol.1, 25-28.
  - (iv) US 1,987,547 granted 15 July 1953 and available from 20 April 1954.”

Advise Jim.

(4 marks)

The examination report concludes: “The date for having this application in order for acceptance is hereby extended until 16 September 2005.”

- g) It is now 30 September 2005 and you still have no instructions from your client. Jim is in two minds about the product and is waiting on some market testing results before committing any further money to it. What are the options available?

(3 marks)

- h) You received no instructions and despite many unanswered reminders Jim finally contacts you on 10 January 2006. The market testing was overwhelmingly positive and he has started selling product. He wants to proceed with the patent application. He says he moved premises in August and hasn't received your recent reminders. Explain the position of the application, the current options, and what needs to be done.

(3 marks)

## **Question 2**

[20 marks total]

It is Friday 2 July 2004. You receive the following instructions from clients overseas. For each, identify any issues, describe the immediate actions you would take, and what subsequent steps will be required to complete the filing of the application including meeting formal requirements.

- a) A facsimile letter dated 30 June 2004 requesting entry into the national phase of a PCT application filed 10 December 2002 in the name of ABC Corporation. The PCT application claims priority from a US patent application filed 11 December 2001. According to the letter the US patent application was filed in the names of the inventors. The letter adds that one priority claim (from another US patent application filed July 2002) was accidentally omitted from the PCT application and, if at all possible, they would like to add the priority claim now.

(4 marks)

- b) An e-mail instruction from a US client asking you to file a patent application claiming priority from a US patent application filed 20 July 2003. The US patent application was a continuation-in-part of an earlier US patent application, for which you have previously filed an equivalent application in New Zealand. Your client says the patent application to be filed is in relation to an improvement, and that they would like you to file the application as an extension of the earlier New Zealand application if that is possible.

(4 marks)

- c) A courier package including a specification, drawings and a letter dated 16 June 2004 requesting you to file a convention application based on a patent application filed in the United Kingdom on 30 June 2003.  
(4 marks)
- d) A facsimile letter dated 30 June 2004 requesting entry into the national phase, if possible, of a PCT application filed 1 October 2002, claiming convention priority from a Brazilian patent application filed 15 November 2001. The tone of the letter suggests that the Brazilian attorney instructing you may have accidentally overlooked his client's instructions to proceed in New Zealand.  
(4 marks)
- e) A facsimile letter dated 30 June 2004 requesting you to file a convention application claiming priority from an EP patent application filed 4 July 2003. In the facsimile, one page of the detailed description is illegible.  
(4 marks)

### **Question 3**

[25 marks total]

Your client manufactures garden tools. The designers have generally considered themselves to be quite innovative and the company has a number of registered designs but no patent portfolio. Recently a new brand of tool has come on the market. It is manufactured by an Australian company, Newtool Pty Ltd. Newtool sells its tools in sets. One of the tools in each set is a special form of trowel that does an excellent job of sifting oxalis bulbs out of the garden soil.

Your client's designers have subsequently developed a similar product by making a smaller version of one of their garden rakes. Your client commenced selling it about six months ago under the "Oxarid" mark.

Your client has now received a letter that reads:

*"We would like to bring New Zealand patent 500010 to your attention. We consider that sale of your "Oxarid" tool is an infringement of our patent, and recommend you seek advice from a reputable patent attorney. If you do not recall your products and stop manufacture within 7 days, we will initiate direct contact with retail sellers of your tools."*

You have conducted a register search on the IPONZ database with the following result:

**Patent Details**

**Patent Number (11)** 500010      **Current Status** *Granted and Sealed*  
**Patent Type** *Patent Convention*  
**Patent Title (54)** *Garden Tool*

**Filed (22)** 9-OCT-2002

<b>Convention</b>	<b>Date (320)</b> 14-DEC-2001	<b>Country (330)</b> Australia	<b>App No:</b> 2001 035606
-------------------	----------------------------------	-----------------------------------	-------------------------------

**Applicant / Patentee: (71)** NEWTOOL PTY LTD . Sardinia House, Sardinia Street,  
Towoomba, Queensland, Australia

<b>Action</b>	<b>Completed</b>	<b>Due</b>	<b>Journal</b>	<b>Published</b>
Registered	09-NOV-2003		1493	30-NOV-2003
Application Accepted	22-JUN-2003		1489	27-JUL-2003
Filed	11-OCT-2002		1482	29-NOV-2002

**Inventors (72)**

Ingham, Philip W  
 McMahan, Andrew P  
 Tabin, Clifford J

The managing director of your client says that he was not aware of the patent until his company received the letter.

He wants you to advise on the following:

- a) When will the patent expire?  
(1 mark)
- b) What can the company do to stop its competitor threatening the retailers?  
(3 marks)
- c) If the company's tool does infringe the patent, what is the company's liability and what factors should be taken into account?  
(4 marks)

You review a copy of the patent specification and your client's product. It appears your client's product will infringe independent claim 1 and dependent claims 2, 5, and 7 to 9. However, claim 1 is so broad that it seems that it covers your client's existing garden rake, which it has been making and selling for 10 years. Claims 2 and 5, which are both dependent on claim 1, only add limitations of size. The designers of your client's company think these additional limitations are obvious. You mention the possibility of belated opposition and of revocation.

- d) What is the deadline for filing a belated opposition under section 42?  
(1 mark)
- e) For the benefit of the managing director, explain “prior use” as a ground of invalidity. What evidence will you need?  
(4 marks)
- f) With reference to claims 2 and 5, discuss the relative merits of opposition and revocation.  
(4 marks)
- g) The designers think minor modifications can be made to the tool to avoid the limitations added by claims 7 to 9. The managing director asks you to confirm that that will be okay.  
(4 marks)
- h) The managing director subsequently discovers that Philip Ingham was an employee designer in his company's Australian office. Philip left on 10 December 2001. Does this help? Discuss with reference to the grounds of opposition and revocation.  
(4 marks)

#### **Question 4**

[30 marks total]

- a) NZ patent 253456 lapsed on 5 September 2003 due to failure to pay the third renewal fee. Your client asks whether it is now clear to make a product. You had previously advised that the product was covered by the patent. Advise your client.  
(3 marks)
- b) Where in the Act or Regulations do you find a definition of infringement?  
(1 mark)
- c) What actions amount to infringement of a New Zealand patent?  
(2 marks)
- d) Under what circumstances is it a defence to infringement to have a patent of your own?  
(1 mark)
- e) Discuss whether a kitset manufactured in New Zealand for assembly overseas would infringe a New Zealand patent for the complete product. Would it make any difference if some vital parts were not supplied in the kitset?  
(3 marks)

- f) Discuss the following situation with respect to the provisions of section 79. A helicopter is chartered into New Zealand to conduct some aerial spraying. The spray equipment is covered by a valid, in-force, New Zealand patent.  
(2 marks)
- g) According to section 40(1), each proposed amendment after acceptance must fall into one of three categories. Identify and briefly discuss each category.  
(3 marks)
- h) What is the requirement if an amendment after acceptance will result in a claim broader than any existing claim?  
(2 marks)
- i) Are the requirements of section 40(1) the only consideration in allowing an amendment after acceptance?  
(1 mark)
- j) Can an amendment after acceptance be challenged after it has been advertised and the opposition period has expired? If so, how?  
(1 mark)
- k) You inform a client of acceptance a competitor's patent application. Acceptance was advertised in the Patent Office Journal of 27 April 2004. Your client believes the patent application may cover one of her products. She has provided a document that you believe prior publishes the claims of the patent application. Explain the options available to your client.  
(2 marks)
- l) The Catnic case is well known for a particular legal test. What is the test and under what circumstances would you apply that test?  
(3 marks)
- m) The Windsurfer case is well known for a particular legal test. What is the test and under what circumstances would you apply that test?  
(3 marks)
- n) The Mond Nickel case is well known for a particular legal test. What is the test and under what circumstances would you apply that test?  
(3 marks)