

2004

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)

Question 1

[8 marks total]

(a) Ruby Software Ltd develops air traffic control software. In 1990 it filed a patent application for its then version of software which ran on Unisys mainframe computers. This was rejected by the IPONZ as not being an invention within the meaning of section 2. Ruby did not pursue a hearing against the examiner's decision. Ruby has now developed new software for air traffic control which runs on Windows XP, incorporating many new innovative algorithms.

Give Ruby a brief opinion on whether a patent application for their XP software will now be rejected under section 2.

(4 marks)

(b) A Ruby subsidiary company, Emerald Software Ltd, develops online purchasing software for retail web sites and has conceived a technique whereby purchasers register once with the site and for all subsequent online purchases need only click on a "confirm order" button to complete the purchase, make payment and initiate delivery of their orders.

Assuming Emerald's "one click" technique is both novel and inventive, discuss whether the High Court would be likely to find valid any patent granted by IPONZ for the technique?

(4 marks)

Question 2

[10 marks total]

(a) You are instructed by a US associate to file a convention application claiming priority from a US continuation-in-part (CIP) application filed 11 months ago. The parent application to the CIP was filed more than 12 months ago.

What advice would you give your associate and why?

(5 marks)

(b) Your client has been sued for infringement of a patent granted on an application filed 1 February 2000 which claims convention priority from a US complete application filed 1 February 1999. Your review of the file history of the corresponding US patent reveals the US complete application claimed priority from a US provisional application filed 1 February 1998.

What ground of revocation might be established by this priority sequence and why?

(3 marks)

(c) Is there anything that the patentee could do to defeat any ground of revocation that might be asserted based on this priority sequence?

(2 marks)

Question 3

[10 marks total]

(a) Discuss with reference to case law the degree of disclosure necessary to invalidate a patent claim in a document published in New Zealand before the priority date of the patent. (3 marks)

(b) You have sent a letter to a competitor of your client drawing attention to the existence of your client's patent for a device for measuring the acidity in olive oil which the client has trade marked OLIVOMETER. You have advised your client that this patent is being infringed by the competitor. In reply to your letter, the attorneys acting for the competitor advise that they have evidence that your client sent an OLIVOMETER to a chemistry lecturer as a gift for an antioxidant analysis she made on olive oil produced by your client's brother fully one week before your client applied for his patent.

Advise your client on the significance of this evidence. (3 marks)

(c) A notice of opposition and statement of case alleges prior publication based on publication on a web site hosted in the United States. Discuss the chances of success. (4 marks)

Question 4

[10 marks total]

You act for Milano SpA, a leading Italian manufacturer of electric light fittings. The New Zealand distributor of Milano's "Barolo" light, Latin Imports Ltd, has just been served with an ex parte interlocutory injunction obtained by George Sharp restraining Latin from further imports of the Barolo in view of a patent for a light fitting owned by Sharp. Milano says it applied for a patent at the European Patent Office (EPO) and did not bother about New Zealand, but after it had filed at the EPO Sharp had visited Milano and sought a licence. Milano had given Sharp a copy of its unpublished EPO application, but the licence discussions broke down. On his return to New Zealand Sharp had Milano's patent specification translated and filed it with a patent application naming himself as inventor. It is the patent granted on this application that has been asserted against Latin.

Answer the following questions asked by Milano:

(a) Because the inventor named in Milano's European patent is Georgio Armani, can it have Sharp's patent revoked? (4 marks)

(b) Milano would like to go on the attack and wants to know if it has any other rights under New Zealand law it can assert against Sharp. (2 marks)

(c) What might be the legal outcome of Milano's dispute with Sharp?
(2 marks)

(d) If Sharp was suing for infringement of a registered design it had obtained on an application using Milano's patent drawings as representations, would your advice given under (a) above be different?
(2 marks)

Question 5

[10 marks total]

Patent attorneys drafting patent specifications must bear in mind the three grounds for revocation under section 41 known as "inutility", "lack of fair basis" and "insufficiency" as well as the requirements for novelty and non-obviousness.

(a) Explain the two ways the courts have recognised that a patent claim may be successfully challenged on the ground of inutility.
(3 marks)

(b) Explain the requirement that claims in a patent specification must be fairly based on the disclosure given in that specification.
(2 marks)

(c) Explain the degree of disclosure required to ensure that the disclosure of an invention is sufficient.
(2 marks)

(d) Are the three grounds of invalidity referred to in (a), (b) and (c) respectively able to be raised by:
(i) IPONZ during examination?
(ii) an opponent in opposition proceedings under section 21?
(iii) an opponent in belated opposition proceedings under section 42?
(3 marks)

Question 6

[12 marks total]

Ashburton Ltd decided not to pay the 13th year renewal fee (due on 1 January 2000) on its patent for a centre-pivot field irrigator (a very large and expensive machine) because of a history of poor sales ever since it was first released when the complete-after-provisional specification was filed.

- (a) Advise Geraldine Ltd on whether it can now copy Ashburton's irrigator design.
(6 marks)
- (b) Would your answer for (a) be different if it was the 7th year renewal fee which Ashburton decided not to pay in January 2000?
(4 marks)
- (c) Assuming you are now acting for Ashburton and while it deliberately lapsed its patent, Ashburton had intended to keep in force a design registration for its improved mark II irrigator. The reason Ashburton did not was because it had changed its address and its patent attorney's renewal reminders for the second renewal due in January 2004 did not reach it. The registered design has now lapsed. Can Ashburton do anything to address Geraldine's threat to copy their irrigator?
(2 marks)

Question 7

[10 marks total]

Write brief notes on the following:

- (a) the test for assessing infringement of a registered design;
(4 marks)
- (b) what constitutes a design which may be registrable under the Designs Act 1953, assuming it is new and original?
(3 marks)
- (c) the extent of the right given by registration of a design
(3 marks)

Question 8

[6 marks total]

Some of the features of the new Australian Designs Act which came into force on 17 June 2004 include:

- (a) a design must be “new and distinctive” to be registrable;
- (b) the prior art base against which “new and distinctive” is evaluated includes designs published overseas, including but not limited to overseas registered designs and designs for different types of articles;
- (c) the maximum term of protection is 10 years; and
- (d) registration will follow a formalities check.

Explain the extent to which the above features of the Australian Act differ from the New Zealand Designs Act 1953.

[2 marks for (a) and (b) and 1 mark each for (c) and (d)]

Question 9

[9 marks total]

You act for Coin Minters Ltd (“CML”) of Dunedin, whose main business is the manufacture of coins. CML has recently diversified into making medals and trophies. It has received an order from the US government for a new military medal, the “Iraq Star” as a result of a successful tender where CML submitted a design by a famous US medal and coin designer, Irell Dezinem to whom CML paid \$1000 to do the work.

CML believes the US troops are likely to be active in Iraq for some time and is concerned to have IP protection for its medal so that the US government cannot reorder from its notorious Auckland competitor.

- (a) Advise CML on what IP rights it can obtain in New Zealand.
(4 marks)
- (b) Would your answer to (a) differ if instead of medals CML had contracted to supply bronze figurines in the form of a militarised version of the Oscars?
(2 marks)
- (c) Assuming the bronze figurines made and sold by CML were designed by Irell Dezinem for the same fee, would CML be legally entitled to the IP protection you recommended for CML in your answer to (b) above?
(3 marks)

Question 10

[15 marks total]

Section 2 of the Designs Act 1953 defines “design” as something “applied to an article”.

- (a) Explain what constitutes an “article” within the meaning of the Act.
(2 marks)
- (b) Discuss whether new and original designs for the following spare parts for S Type Jaguar cars could be validly registered in New Zealand?
- (i) wing mirrors;
 - (ii) bonnets;
 - (iii) the face for the speedometer
- (6 marks)
- (c) Pineapple Computers Inc has designed six new funky icons to be displayed continuously on the desktop screen of its yet to be launched iChunk computer once the computer is powered up. Each icon has an associated caption such as “Recycle Bin” etc.
- (i) Can each icon/caption combination be registered under the Designs Act?
(2 marks)
- (ii) Would you file a single application to register all icon/captions?
(2 marks)
- (iii) In any application you filed how would you name the article to which the designs are to be applied? Select two from the following options which you believe would satisfy IPONZ practice:
- an icon,
 - a user interface,
 - a computer screen,
 - a computer,
 - icon generating software.
- (2 marks)
- (iv) Of the two you select which would you use out of an abundance of caution bearing in mind the statutory definition of “design”?
(1 mark)