

2004

PATENT ATTORNEYS

EXAMINATION

PAPER C

Foreign Law

Regulation 158 (1) (d)

Duration: 3 hours (plus 10 minutes for reading)

QUESTION 1

(7 marks total)

You filed a New Zealand patent application accompanied by a provisional patent specification on 25 June 2003 for your client. The invention relates to a method of building suitable for application to dry stone walls. You obtained an assignment from the sole inventor to his company and filed the NZ patent application in the name of the company.

You have just filed a PCT patent application on 24 June 2004 claiming priority from the New Zealand application. You are about to report the filing of the PCT application to your client.

(a) Outline the general procedure your client's application will follow from the filing date through to national phase and/or regional phase entry. Include any deadlines for performing certain tasks. Advise your client of any options available to him and the advantages/disadvantages of those options. (4 marks)

(b) Explain the circumstances under which a Power of Attorney may or may not be required (3 marks)

QUESTION 2

(8 marks total)

Your client is proposing exporting a long standing efficient method for the disposal of detergents and other products from household wastewater. You do a search and unfortunately locate a granted Japanese patent directed to the same technology. Use of the disposal method in Japan would literally infringe at least one claim of the granted patent. A full description of your client's method has been published in NZ newspapers in the early 1990's. The patent was filed 15 June 2000 and was granted 9 April 2004. Advise your client on any possible options available to her for challenges to the validity of this Japanese patent and the general procedure for each of these.

QUESTION 3

(12 marks total)

You filed a patent application in New Zealand accompanied by a provisional patent specification on 2 June 2003 for your client. The invention relates to a cage type possum trap designed to ensnare and contain live animals. Your client believes there is a substantial market for the invention throughout the Asian region and other countries in the housing of other small mammals.

You filed applications in Japan, China, Taiwan, Malaysia and Mexico for your client's invention, claiming priority from the NZ application under the Paris convention for Japan, China, Malaysia and Mexico. You claimed priority in Taiwan under the agreement concluded with that country on recognition of priority. The applications have each been filed on 27 May 2004.

(a) Outline the examination procedures in each of these countries. (10 marks)

(b) Indicate the date or dates of publication of documents relating to the application. (2 marks)

QUESTION 4
(13 marks total)

You filed a patent application in New Zealand on 15 November 2002 accompanied by a provisional patent specification (the New Zealand application). You filed a CAP on this application on 14 November 2003. An examination report issued on 28 November 2003 and one prior art document (document 1) has been cited against claim 1.

You have also filed convention patent applications in Australia (the Australian application), the European Patent Office (the European application) and the USA (the US application) on 14 November 2003 claiming priority from the New Zealand application.

You received a direction from IP Australia to request examination by 1 July 2004 and a Section 45(3) request. Neither the search report on the European application nor the first Office Action on the US application have issued. Your client wants to proceed with normal rather than modified examination on the Australian patent application, which is a standard patent application.

(a) Advise whether or not it is necessary to disclose document 1 to IP Australia and deadline for doing so. (2 marks)

(b) The European search report is received after the Australian patent application has been accepted. The European search report raises a further prior art document (document 2). Do you have any recommendations for your client, and are there any deadlines for action in respect of any recommendation. (2 marks)

(c) The first Office Action on the US application issues after the Australian patent application has proceeded to grant. The Action raises a further prior art document (document 3). Do you have any recommendations for your client, and are there any deadlines for action in respect of any recommendation. (2 marks)

(d) Your client advises you it has always been aware of a piece of prior art (document 4). Advise your client on the consequences of not disclosing with respect to the granted Australian patent. (2 marks)

(e) Outline any extensions of time available for disclosing search results to IP Australia in connection with the Australian application. (5 marks)

QUESTION 5
(3 marks total)

Your client is involved in a business in North America in which he farms hogs in Canada and transports them to Nebraska, USA for slaughter. He owns a fleet of trucks and stock trailers. Hogs are loaded on to the stock trailers in Canada and transported to a central depot in Nebraska using his trucks. From there the stock trailers are decoupled from his trucks and towed to different destinations within Nebraska by trucks owned by the various slaughterhouse proprietors. The empty trailers are then returned to the depot for towing back to Canada by your client's trucks.

There is an emerging market in the United Kingdom for your client's product. He has recently transported loaded stock trailers to a port in Boston. The trucks and trailers are loaded on to a cargo vessel that sails regularly between Boston and Holyhead in the UK.

U-Haul Inc is the owner of a US patent and a corresponding UK patent directed to an improved structure for stock trailers. It is clear that your client's stock trailers fall within the literal scope of the claims. There is no corresponding patent in Canada. U-Haul has alleged infringement of its patent by virtue of your client's use of these stock trailers in the USA.

Advise your client on any safe harbour defences available in the US and the UK.

QUESTION 6
(8 marks total)

You have filed a non-convention PCT patent application in New Zealand for your client on 22 January 2004. It is the intention of your client to enter national phase in Canada, the USA, Germany and South Africa. You have recently become aware of the following documents each describing subject matter closely related to the subject of the PCT application:

Document 1 - A European patent application designating the UK, Italy and Spain filed 21 February 2003 and published 28 October 2003.

Document 2 – A US patent application filed 23 June 2003 and published 26 April 2004.

Document 3 – A South African patent filed 8 December 2003, advertised as accepted in the South African Patent Journal on 22 January 2004, and granted 31 March 2004.

Advise your client, for each country, which documents are likely to affect the novelty of the national phase entry application in that country and why.

QUESTION 7
(17 marks total)

You have filed a non-convention Australian patent application on 10 April 2003. You have just filed US and European region patent applications claiming priority from the Australian application. You are about to report the filing of these applications to your client.

(a) Outline the general procedure your client's US application will follow. At your client's request you are asked to include an outline of the possible routes through to grant and any possible post grant procedures that could alter the scope of the granted claims (8 marks).

(b) Outline the general procedure your client's European application will follow. At your client's request you are asked to include an outline of the possible routes through to grant and any possible post grant procedures that could alter the scope of the granted claims (9 marks)

QUESTION 8
(3 marks total)

Briefly outline the differences between PCT-EASY and PCT-SAFE.

QUESTION 9
(20 marks total)

Outline the differences between the innovation patent system, the petty patent system and the standard patent system in Australia. Outline the circumstances in which you would recommend one system ahead of the other systems and the factors you would take into account in making the recommendations.

QUESTION 10
(9 marks total)

You have a PCT application for a client ready for entry into national phase in Australia, Europe, South Africa, the United States and Japan. The claim set currently has 45 claims, 5 of which are independent claims (two for a process, one for a (known) intermediate chemical compound from the process and two for the final products of the process). Discuss possible strategies for amending of the claim set for filing in each country, outlining your reasons for the recommendations made to the client.