

2005

PATENT ATTORNEYS

EXAMINATION

PAPER A2

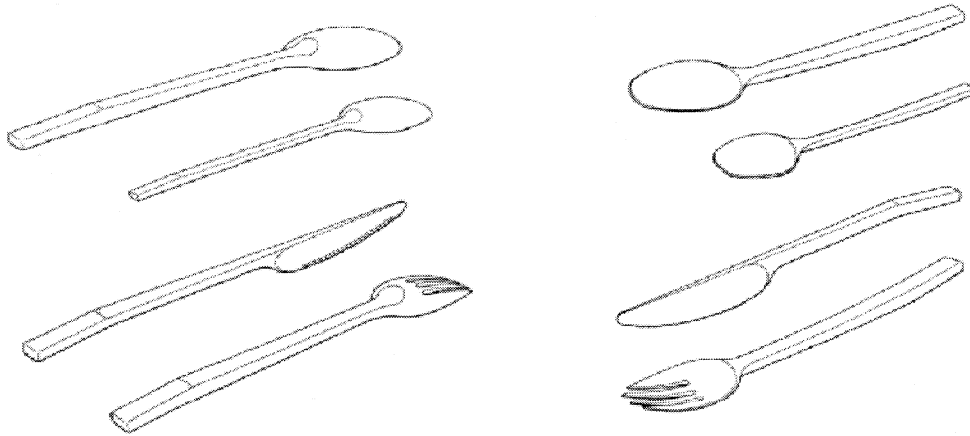
The New Zealand Law and Practice
relating to Patents and Designs

Regulation 158 (1) (a)

Duration: 3 hours (plus 10 minutes for reading)

Question 1 (5 marks)

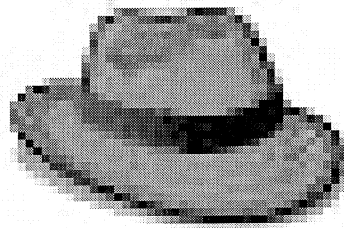
Your client comes to you with a design for cutlery, as illustrated below:



Comment on the registrability of the cutlery design assuming it is new and original and draft an appropriate statement of novelty for a design application. (5 marks)

Question 2 (5 marks)

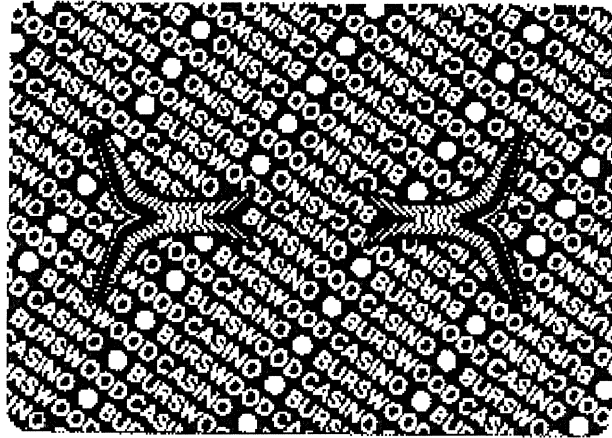
Your client comes to you with the design for a computer icon, as illustrated below:



Comment on the registrability of the design assuming it is new and original and draft an appropriate statement of novelty for a design application. (5 marks)

Question 3 (5 marks)

Your client comes to you with a new image for the back of playing cards that it uses in its casino. The card back is illustrated below:



Comment on the registrability of the design assuming it is new and original and draft an appropriate statement of novelty for a design application. (5 marks)

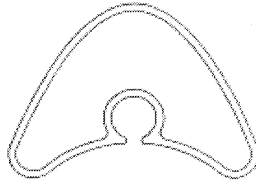
Question 4 (15 marks)

Your client comes to you with a design for an extrusion. Lengths of the extrusion are used for masts for small sailing boats. The extrusion has a cross section illustrated below:



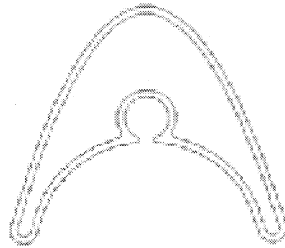
a) Comment on the registrability of the design assuming it is new and original and draft an appropriate statement of novelty for a design application. (5 marks)

Your client registers the design with the statement of novelty you have drafted. Your client has now become aware of an extrusion for sale by a competitor, Masts R Us. A brochure for this extrusion includes the cross section illustrated below:



b) Comment on the enforceability of your client's design registration against Masts R Us. (5 marks)

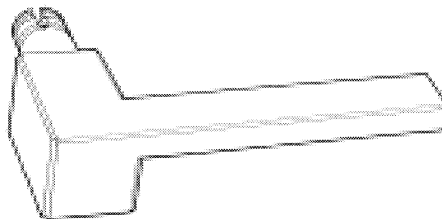
When you file proceedings against Masts R Us, the distributor of that product supplies you with a brochure for a mast extrusion he says was available in New Zealand in 1980. You investigate and find several independent boat chandlers that corroborate this assertion, and that this design predates your client's design.



c) How does this affect your answer in part b)? (5 marks)

Question 5 (10 marks)

Your client, Hot Grips Ltd (HGL), comes to you with a design for a door handle, illustrated below:



a) Comment on the registrability of the design assuming it is new and original and draft an appropriate statement of novelty for a design application. (3 marks)

HGL proceeds to file the design application and the design is duly registered. It is now seven years later. HGL comes to you again. It has discovered a handle being imported by Nancy's Knobs Ltd (NKL) which is identical to the handle of HGL's design registration. However, you discover that HGL's design registration lapsed when the first renewal fee was not paid.

b) Discuss fully the options available to HGL. (6 marks)

c) You discover that HGL marked its product "NZ design registered". How does this affect your advice? (1 mark)

Question 6 (4 marks)

An Australian company, Big Sinkers Pty Ltd (BSL), filed a design application in Australia on 2 February 2005, for a new design for a fishing float. BSL began selling the float in New Zealand in April 2005.

a) Can BSL still obtain a valid design registration in New Zealand? If so, what would be required? (2 marks)

b) If BSL applies for a design registration, when will the first fee for extending the term of the registration be due, and how much later will the design expire (assuming all extension fees are paid)? (2 marks)

Question 7 (6 marks)

How can a design registration be challenged once registered and on what grounds? (6 marks)

Question 8 (5 marks)

Your client, Camo Clothing Ltd (CCL), has designed a new printed fabric with a repeating pattern incorporating an overlapping arrangement of fluorescent orange and dark purple maple leaves. The effect is quite striking.

a) Assuming the fabric design is novel, discuss the protection that a design registration would offer for CCL's fabric pattern. (2 marks)

b) What is required for the application? (2 marks)

c) Discuss a statement of novelty for the application. (1 mark)

Question 9 (10 marks)

Your client, King Dairy Ltd (KDL), has discovered by accident an improved product for cleaning its milk vats. The new product seems to require half the rinsing required by other products used in the industry. KDL stumbled across the new product formulation entirely by chance when one of its researchers accidentally mixed up the usual cleaning product in a bucket with a substantial residue for citrus oil. This batch of cleaner was particularly effective and the staff member noticed how well it cleaned and how easily it rinsed away. She recalled that there was some citrus oil still in the bucket. Researchers at KDL have since replicated this by adding small amounts of citrus oil to batches of cleaning product. They have only tried two formulations but they have achieved impressive results.

- a) Discuss the advantage to KDL of filing a patent application with a provisional specification, rather than a patent application with a complete specification at first instance. (2 marks)
- b) Discuss what KDL can do after filing the patent application with a provisional specification to maximise its position when it comes to file the complete specification. (2 marks)

Assume KDL filed the patent application with a provisional specification on 1 October 2004.

KDL has continued testing and has discovered a minimum concentration of citrus oil that it believes is effective. KDL is still testing to determine an optimum concentration.

- c) What should KDL do now? (1 mark)
- d) When is the latest time KDL can file the complete specification? (1 mark)
- e) What options does KDL have if testing continues to take longer than it anticipates? (4 marks)

Question 10 (12 marks)

You enter national phase in New Zealand from a PCT patent application on behalf of a French client. The PCT application was filed 7 March 2002 and claims priority from a French patent application filed 10 March 2001. You have now received an examination report from IPONZ.

The examiner has objected that the claims of the application relate to more than one invention. You look at the claims and find an independent claim for a method, an independent claim for an apparatus, and an omnibus claim.

a) Under what circumstances can a claim to an apparatus and a claim to a method be considered a single invention? (2 marks)

b) Explain what options your client has if it wishes to retain full patent coverage. (2 marks)

c) Your client's application is eventually accepted. A competitor lodges a Notice of Opposition and Statement of Case without professional advice. The opponent objects that the invention claimed is anticipated by each of publications (i) to (iii) below. The opponent also says that, in view of US patent 4,007,269 published 7 June 1975, available in New Zealand from August 1976, the invention claimed is not an invention within the meaning of "invention" in s2 of the Patents Act 1953. Discuss any obvious flaws in the opponent's case. (8 marks)

(i) US patent 2,567,456, published 3 May 1952, available in New Zealand from August 1955.

(ii) New Zealand patent 353353 (acceptance advertised in April 2002 Journal).

(iii) Japanese published patent application 6/130040, abstract published June 1994, and available in New Zealand from January 1995.

Question 11 (11 marks)

Your client, Peabody's Blow Up Toys Inc (Peabody), has a New Zealand patent dating from 1993 for an inflatable costume worn by each participant in a popular pub game of wrestling. Peabody's costumes are imported from USA and sold to entertainment companies throughout New Zealand. One of Peabody's customers has recently started buying costumes from Sumo Suits Pty Ltd (Sumo), a company in Australia. These costumes are exactly the same as Peabody's suits. Your investigators believe that Sumo started producing suits in 2000 (but it may have started in 1997), and have found that Sumo has been selling the suits by mail order and through a website since then. Sumo sends the suits to New Zealand customers by 2-day courier.

a) Discuss whether Sumo is liable for the sale of its suits to customers in New Zealand. (3 marks)

You subsequently discover that Peabody's patent lapsed on 3 June 2003. Your records indicate that you were instructed to allow the patent to lapse by Peabody's CEO.

b) Assuming that Sumo is liable for sales to New Zealand customers, discuss what remedies are available to Peabody for infringement of its patent. (3 marks)

Peabody sends you a sample of its suit. In between bouncing on your colleagues, you check the suit and the packaging. You note that the packaging is marked "Patent Granted", but nothing more.

c) Does this affect your answer in b)? If so, how? (2 marks)

d) Discuss copyright infringement proceedings as an option for Peabody. (3 marks)

Question 12 (12 marks)

Your client, James “Acid” Humperdink (JAH), comes to your office all excited about a product, FUZZGLOW, that he tried while on holiday in USA. He says it was originally sold as a tooth ache remedy, TOOTHEASE, but has taken off recently as a “legal high”. He found an article about it in a Los Angeles high school newspaper. The newspaper article provides a complete formulation for the product.

JAH wants to set up a manufacturing plant in New Zealand and sell the product here and maybe export some. But first he wants some advice.

- a) Assuming there has been no publication or use of the product in New Zealand, discuss whether JAH can obtain a valid patent in New Zealand. (4 marks)
- b) Would your advice be different if the Los Angeles high school newspaper is available for download on the internet? Why? (3 marks)

You eventually do a patent search and find a New Zealand patent in the name of Dental Therapy Products Inc. (DTP) covering the product. The patent was granted 5 years ago. JAH decides to buy the product from DTP and contacts them. However DTP refuses to supply the product, either TOOTHEASE or FUZZGLOW. They say: “No way. We're selling all we can make at home”. JAH is still very keen to set up a business around this product. He thinks its going to be “really big”.

- c) Discuss whether JAH can make and sell the product in New Zealand and how this might be achieved? (5 marks)