

2006

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 (10 marks)

Discuss the requirements that must be met before a document can be deemed to be “published” when considering prior publication for lack of novelty in New Zealand. Illustrate your discussion with reference to any applicable case law and to any proof that may be required.

Question 2 (16 marks)

On behalf of your client, New Schemes Ltd (“NS”), you filed a patent application accompanied by a provisional specification (NZ 600606) eleven months ago. The managing director of NS has been working intensively on further developments and comes to your office full of enthusiasm. He has made a major advance which yields a superior product. He is keen to launch his improved product on the market at the earliest opportunity but he thinks there might be a need for some further refinement. The original product has not yet been sold. NS only requires patent protection in New Zealand.

- (a) Advise NS of its options for patent protection, and the advantages and disadvantages of those options? (11 marks)

- (b) Would your advice differ if NS had sold some of the original products 9 months ago, and if so explain how it would differ? (1 mark)

Now assume NS’ major advance is a new method of producing the product that is disclosed in NZ 600606. No sales or disclosure have occurred. This method has wider possibilities than just producing the product disclosed in NZ 600606.

- (c) What options are now open to NS where they might differ from those under (a)? Discuss the advantages and disadvantages of those options where they are different than (a). (4 marks)

Question 3 (16 marks)

Your client, Jim Dusty of Henry Spark Ltd ("HS"), is most upset. He has obtained through you New Zealand Patent No. 110110 for his vacuum cleaner. Sales have been excellent and have been growing. He has just learnt that his main competitor Jumping Jack Flash Ltd ("JJF") is about to launch a competing product. HS has managed to surreptitiously obtain one of JJF's products. Jim wants to write to JJF to tell JJF to desist from launching its product or else HS will sue for patent infringement.

Jim informs you that prior to filing his New Zealand patent application he had filed United States patent application No. 218789 in 1999 for the same invention dealing directly with a US patent attorney. He had received a first examination report from the USPTO which had raised some objections. He provides a copy. You note the citation of US Patent No. 8,100,100 granted in 1985. Jim tells you the cost of continuing in the US was proving prohibitive and so he had assigned all rights in US patent application No. 218789 to a US company. He is not aware of what then happened in the US. You have not previously been aware of the existence of US 8,100,100. You note NZ 110110 was filed in 2000 with a complete specification in the first instance with no claim to priority under the Paris Convention. The patent was granted 9 months ago. You are asked to take any action to stop JJF from launching.

- (a) What advice do you immediately give to your client? (8 marks)
- (b) What further enquiries should you make and why? (8 marks)

Question 4 (12 marks)

A client, GRAPES-4-U Ltd, writes:

"You recently filed for us Patent Application No. 900909 with a complete-after-provisional specification on my grape harvester. I was browsing through a recent Patent Office Journal and noted with dismay the publication of an abstract of Patent Application No. 800808 with a drawing showing a very similar view of one of the drawings in our Patent No. 900909. The Applicant for No. 800808, TOOLS-R-US, was shown in the strictest confidence initial drawings of our machine before we

filed our patent so that they could advise us on tooling requirements for our harvester. As a result of our discussion some minor adjustments were made by me and we commissioned them ultimately to make the tools for production of our device. We would be grateful for your urgent advice.”

On investigation you find NZ 800808 was published 3 months ago today. It was filed with a priority date earlier than your client’s patent NZ 900909 but after they had had the confidential discussion with TOOLS-R-US on the tooling requirements. The claims of NZ 800808 are directed in substance to the invention in NZ 900909. All the drawings in NZ 800808 are substantially the same as the initial drawings GRAPES-4-U showed to TOOLS-R-US, but do not include the subsequent modifications that were incorporated into the final design of the grape harvester produced by your client.

Advise your client on its rights under the Patents Act 1953 and what steps it can take.

Question 5 (12 marks)

Discuss all of the following with reference to any relevant case law:

1. Fair Basis – Internal (i.e. of a claim on the complete specification) (3 marks)
2. Fair Basis – External (i.e. of a claim on a priority document) (3 marks)
3. Anticipation (3 marks)
4. Mere collocation (3 marks)

Question 6 (13 marks)

- (a) What are the reasons that require a patent attorney to consider unity of invention, when is it necessary to do so, and what are the criteria to apply? (5 marks)

- (b) A divisional application can be filed by dividing subject matter out of a complete – after – provisional specification, a Paris convention application, a PCT Application that claims Paris convention priority and one that does not. Discuss the requirements for filing a divisional application in each of the 4 scenarios. (8 marks)

Question 7 (10 marks)

Discuss procedure, documents and evidence (if any) needed to undertake the following:

- (a) Late entry into the national phase in New Zealand of a PCT Application. (5 marks)
- (b) Late filing of a Paris convention application in New Zealand. (5 marks)

Question 8 (11 marks)

- (a) In considering the ground of insufficiency of the description in a patent specification, what is the normal test, at what date is it assessed, and what category of person is deemed to assess the adequacy or not of the description? Illustrate your answer with reference to any relevant case law. (6 marks)
- (b) In considering obviousness and lack of inventive step, from the viewpoint of what person is obviousness and lack of inventive step assessed, and at what date? Illustrate your answer with reference to any relevant case law. (5 marks)