

2006

PATENT ATTORNEYS

EXAMINATION

PAPER C

**The New Zealand Law and Practice
relating to Foreign Law**

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

Question 1

Describe what opportunities are available for amending a PCT specification and what parts of the specification can be amended during the international phase and upon national phase entry (6 Marks)

Question 2

Discuss the options available for securing patent protection in Hong Kong. (4 Marks)

Question 3

Describe the features of an Australian Innovation Patent and explain the benefits, limitations and processes involved in obtaining an enforceable Australian Innovation Patent. (10 Marks)

Question 4

a) What significant amendment relating to official fees was brought about by section 78.6 of the Canadian Patents Act, which came into force on 1 February 2006? (2 Marks)

b) What are the implications for existing applicants and patentees of section 78.6 of the Canadian Patents Act? (2 Marks)

(4 Marks)

Question 5

Your client is familiar with the process involved in filing a New Zealand patent application and the examination of the application by IPONZ. Explain to your client the main differences that exist in the Australian examination process from filing to grant of the standard patent application and matters considered during examination when compared to New Zealand practice. (10 Marks)

Question 6

Assume that you are the IP counsel of a large New Zealand company involved in many areas of scientific research. You have recently developed a policy to protect the intellectual property of the company.

You have been asked to present your IP policy at a lunchtime seminar to the research leaders of your company. These research leaders regularly attend and present at conferences. In this regard outline the key features of your policy including what types disclosures, if any, are allowed prior to the filing of a patent application in the following situations:

a) Presentations by researchers of new technology at important conferences where the US is the only market for the technology? (4 Marks)

b) Would your policy in a) differ for disclosures at conferences being held outside the US. (2 Marks)

c) Presentations by researchers of new technology where the key markets of interest include New Zealand, Australia and Europe. (4 Marks)

(10 Marks)

Question 7

A client approaches you about a fastening (nut and bolt) innovation that she displayed at a major trade exhibition in Munich three weeks ago. A lot of interest was shown in her innovation and it occurs to her that she should have perhaps sought your advice before displaying the fastening innovation. You establish with your client that the following markets are of importance.

The United Kingdom,
 Canada,
 Europe,
 Australia,
 United States of America,
 The Peoples Republic of China,
 Republic of Korea,
 India,
 Hong Kong,
 Taiwan, and
 Japan.

a) Where is it still possible to file valid applications and by what time do applications need to be filed? (11 Marks)

b) Your client wants to file a PCT application. Develop a filing strategy for your client that will ensure protection and will delay filing costs for your client. Your answer will need to describe in detail the novelty requirements and any grace period provisions upon which you will rely, as well as detail what applications you would file and when. (10 Marks)

(21 Marks)

Question 8

Explain the following terms in relation to US practice:

- | | |
|-------------------------------------|-----------|
| i. Information disclosure statement | (2 Marks) |
| ii. First-to-invent | (2 Marks) |
| iii. Issue fee | (2 Marks) |
| iv. Re-examination | (2 Marks) |
| v. Restriction requirement | (2 Marks) |
| vi. Terminal disclaimer | (2 Marks) |

(12 Marks)

Question 9

What opportunities exist to oppose patent applications and revoke patents in:

- a) India; (2 Marks)
 b) Japan; (2 Marks) and
 c) Korea? (4 Marks)

(8 Marks)

Question 10

Your client has just received the notice of allowance for a European patent application. Explain the process to obtain a validated patent in the United Kingdom, France and Portugal.

(5 Marks)

Question 11

Your client has a granted New Zealand patent and corresponding pending applications in Australia and the US for a product it has been marketing for approximately 2 years in New Zealand and Australia. Your client has made a minor improvement over what is covered by the claims of their NZ patent and for which it now wants patent protection in NZ, Australia, the US and the UK. Your client informs you that they have not disclosed the improvement and upon checking you determine the improvement is not detailed in the NZ, Australian, or US patent specifications.

- a) What options exist, if any, to protect this improvement with a patent in New Zealand, Australia, the US and the UK? (5 Marks)
- b) Would any options you identify in a) still be available in New Zealand, Australia, the US and the UK if the improvement had been on the market in Australia for 8 months. (2 Marks)
- c) Could the improvement be patented in New Zealand, Australia, the US and the UK if it had been confidentially offered for sale in New Zealand 2 weeks ago but not yet delivered, assuming a patent application can be filed today? (3 Marks)

(10 Marks)

END