

2007

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 (29 marks)

Your client is a local pharmaceutical company, Osteofix Limited ("Osteofix"). For the last 10 years, Osteofix has been making and selling in New Zealand a drug having the chemical name bonbonate, for use in preventing and treating osteoporosis or bone loss. Osteofix has a patent covering bonbonate but this patent is due to expire in 6 months.

At present Osteofix sells bonbonate in the form of tablets containing 10 mg of bonbonate, with instructions to take one tablet three times a day with food. This treatment regime is rather inconvenient, especially for elderly patients who might have difficulty remembering to take all their tablets. However, this treatment regime was thought to be necessary. Based on what was known from the published literature, it was thought that giving a larger dose less frequently would cause unpleasant side effects including severe stomach upsets.

Scientists employed by Osteofix have now found, most surprisingly, that bonbonate can be administered in a single dose of 150 mg to 200 mg, once a week, without causing any significant side effects. They have also found that the once-a-week dosage is just as effective as taking 10 mg three times a day.

The CEO of Osteofix asks you if the company can get a patent to protect its new treatment regime. She advises that the new treatment regime has been kept confidential so far.

(a) Is Osteofix's new dosage regime a patentable invention under Section 2 of the Patents Act? Discuss with reference to any relevant case law, and give an indication of the form of claims, if any, that may be allowable. (6 marks)

Assume that Osteofix's new dosage regime is a patentable invention and your client instructs you to proceed with filing a patent application. You prepare a provisional specification covering the invention. Your client wants the patent application to be filed in the name of the company.

(b) What, if any, further information do you need and what, if any, action do you need to take, to be able to file the patent application in the name of Osteofix Limited? (2 marks)

You file a patent application with a provisional specification for Osteofix's invention on 17 March 2005. On 17 August 2005 Osteofix starts selling bonbonate to doctors in the form of 150 mg tablets, with instructions for patients to take one tablet once a week.

You file a complete-after-provisional specification for Osteofix's invention on 17 March 2006. Assume that all claims in the complete specification are fairly based on the

provisional specification. IPONZ issues an examination report in December 2006. Only one objection is raised. The objection raised is as follows:

“As a result of investigation under section 14, it appears that the invention as claimed in all claims has been prior claimed in NZ patent application 444444. Application 444444 has been accepted and was published on 21 September 2006. It has a filing date of 17 October 2005, and claims priority from US patent application 10/666,666 filed on 17 October 2004.

Unless the applicant complies with the provisions of section 14(2)(a) or (b), a reference to NZ patent 444444 will be inserted in the applicant’s specification by way of notice to the public, when NZ patent 444444 is granted.”

- (c) Explain the following to your client:
- (i) what an objection of “prior claiming” is;
 - (ii) how a prior claiming objection can be overcome using the provisions of section 14(2); and
 - (iii) the effects of not addressing a prior claiming objection.
- (5 marks)**

You obtain a copy of the cited NZ patent application 444444 and a copy of its priority document US 10/666666. Application 444444 was filed in the name of a US company. The claims of NZ patent application 444444 are identical in substance to the claims of Osteofix’s application. The following sentence appears on the first page of the specification of US 10/666666.

‘This application is a continuation-in-part of US patent application serial number 10/555555, having a filing date of 17 August 2004.’

You obtain a copy of US patent application 10/555555, and find that the claims are identical to the claims of both US patent application 10/666666 and NZ patent application 444444.

- (d) How could this information help you to overcome the prior claiming objection to Osteofix’s application? **(5 marks)**

Understandably, Osteofix is very concerned about the existence of NZ patent application 444,444. The CEO asks you if there is anything they can do to challenge the patent application before it is granted. The date is now 21 December 2006.

- (e) Can Osteofix oppose NZ patent application 444444 before grant? If so, what grounds are available, given all of the information above? **(5 marks)**

(f) Briefly explain the opposition procedure to your client. In particular, advise of the documents each party must file during the proceeding and the timing of the filing of these documents. Also advise your client what evidence you will need to file to make out the particular ground or grounds you intend to plead (as in your answer to (e) above). (6 marks)

Question 2 (7 marks)

Your client Tom and his friend Margot have together invented an electrical device for cooking boiled eggs individually. The device has a cut-off mechanism that turns the power off at a particular time depending on the level of runniness desired in the cooked egg. Tom and Margot have a granted New Zealand patent for the egg cooker. Tom and Margot are named as both co-inventors and co-patentees.

Unfortunately, Tom and Margot have fallen out and are no longer speaking to each other. Tom wants to press on with trying to commercialise the egg-cooker himself, without any involvement with Margot. He is thinking about approaching a manufacturer with a view to either licensing or selling his rights in the patent to the manufacturer. Tom asks you if he can do this.

(a) Advise Tom. (3 marks)

Tom continues to work on his egg cooker by himself. There is a small problem in that the device is not completely consistent in delivering the desired level of runniness. He finds that this can be fixed by using a different type of rubber seal for the body of the egg cooker. Tom would like to protect this development if he can. This type of rubber seal is not disclosed in the provisional or complete specifications, but the rubber has been used in seals in other kitchen appliances sold in New Zealand, such as electric frying pans.

(b) Advise Tom of his options, if any, for obtaining patent protection for the egg cooker with the different type of rubber seal. Also advise who you would name as the inventor(s) on any patent application you would file. (4 marks)

Question 3 (5 marks)

On 4 July 2007 you receive instructions from an overseas client to enter a PCT international application into New Zealand under Chapter II of the Patent Cooperation Treaty. The PCT application claims priority from a French application filed on 4 November 2004. Your client apologises for the late notice for the instructions, but advises that due to an error in entering the priority date into their docketing system, the national phase entry deadline has only just come to their attention today.

Advise your client whether they can enter the national phase in New Zealand. If so, advise of the procedure for doing so and the documentation in support that you would need to file.

Question 4 (5 marks)

Your client Paris has filed a provisional specification for her invention. The invention is an improved process of manufacturing a pesticide compound useful for treating tapeworm in horses. The provisional specification describes, as an essential step of the process, mixing two precursor compounds together in water and maintaining the temperature at 40 °C to no more than 50 °C until the compounds have reacted together. Eleven months have gone by since the provisional was filed, and Paris has now asked you to prepare a complete specification. She informs you that she has now found that the water temperature can be kept as high as 65 °C, without the final product decomposing. The higher temperature also speeds up the reaction.

- (a) If you draft a claim specifying a temperature range of 40 °C to 65 °C, what priority date does the claim take, and why? (3 marks)

Paris described her original process (i.e. with the 40 °C to 50 °C temperature range) in a trade journal that was published in New Zealand two months after the provisional specification was filed.

- (b) Does this affect the validity of the claim in (a) above? Why/why not? (2 marks)

Question 5 (23 marks)

Your client Jim has a patent for a nutcracker. The patent has two claims only, an independent claim 1 and dependent claim 2. Jim rings you up and says that he has been doing some literature searching relating to a new project, and by chance has come across a German article that seems to describe a nutcracker similar to the one he has patented. However, he doesn't read German very well so he isn't absolutely sure what the article describes. You can read German and you find that the article does indeed disclose a nutcracker that falls within the scope of claim 1. However, it doesn't appear to disclose the subject matter of claim 2. You do some investigations and find that the German article was available from a library in Wellington before the filing date of the provisional specification. Jim asks you if he needs to amend his patent because of the German article.

- (a) Describe the types of amendment that are allowable when amending a patent after grant. (2 marks)

- (b) Advise Jim whether he can and should amend his patent in light of the German article, and why. (3 marks)
- (c) Would your answer to (b) be different if the German article was not available in any library in New Zealand, but was available on the internet before the priority date? (3 marks)
- (d) Outline the procedure involved in amending a patent under Section 38, including the information that you need to supply to IPONZ. (3 marks)

Assume you have advised Jim that claim 1 is prior published and invalid and that he should amend it by limiting its scope to the feature of claim 2. However, Jim now tells you that he has decided he would prefer not to make any amendments at the moment. He is aware of several potential competitors and he wants to keep the patent as broad as he can to try to scare them off. He also says that if he becomes aware of anyone infringing his patent, he intends to sue them but only alleging that claim 2 (that he is confident is valid) is infringed.

- (e) Advise Jim. (8 marks)

Jim changes his mind. He agrees to apply to IPONZ to amend claim 1 to include the feature of claim 2. Claim 2 specifies the arrangement and shape of the teeth of the nutcracker jaws. At the same time Jim asks whether he can add two extra dependent claims, directed to some specific features of the invention that are disclosed in the complete specification. These features relate to:

- (i) more precise details of the shape of the teeth of the nutcracker jaws; and
- (ii) the particular shape of the handles of the nutcracker.

- (f) Advise Jim whether adding claims to features (i) and (ii) will be possible. (4 marks)

Question 6 (4 marks)

Your client Company Y has exclusively licensed a patent from its US parent company. The licence has not been recorded on the register of patents. Company Y has become aware of another NZ company (Company X) that it thinks is infringing the patent and wants to bring proceedings against Company X in Company Y's own name. Advise your client whether it can do this, and of any possible difficulties that could arise and how you could avoid them.

Question 7 (5 marks)

You are handling a New Zealand patent application for an overseas client. The application has not yet been examined. Your client writes to you advising that an objection of lack of unity of invention has been raised against the corresponding application in the USA and she has had to amend the claims of the US application to address the objection. She asks you the following questions (a) and (b). Advise her.

- (a) How does IPONZ apply the requirement that the claim or claims of a complete specification must relate to a single invention? **(2 marks)**
- (b) Is it advisable to amend the claims of the NZ application to ensure the claims relate to a single invention, even if the examiner does not raise an objection of lack of unity of invention? **(1 mark)**

The NZ application is eventually examined. The examiner objects that the claims relate to 3 separate inventions.

- (c) Advise your client of her options for obtaining protection for all three inventions and any time limits involved. **(2 marks)**

Question 8 (10 marks)

- (a) Describe the main differences between the grounds of opposition under Section 21 and the grounds of revocation under Section 41. **(7 marks)**
- (b) Briefly outline the relative advantages and disadvantages of the procedures of Section 21 and Section 41. **(3 marks)**

Question 9 (14 marks)

Briefly discuss each of the following, with reference to case law if appropriate:

- (a) the provisions of the section 68B exception to patent infringement **(2 marks)**
- (b) the test for prior publication **(2 marks)**
- (c) purposive construction **(4 marks)**
- (d) selection invention **(4 marks)**