

2008

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 (9 marks)

On 24 December 2008 at 2 p.m. you receive a courier package from a client in China.

The courier package contains instructions to file two new unrelated patent applications.

- The first application is for a rice cooker and is to be a New Zealand application claiming priority from a Chinese application filed on 24 December 2007. You receive an English-language specification and the required details of the priority-forming application and the applicant and inventor.
- The second application is for a medicine and is to be a PCT national phase entry in New Zealand. The PCT application was filed on 24 May 2007, claiming priority from a Chinese patent application filed on 25 May 2006. You receive a Chinese-language PCT specification, a copy of the priority-forming application certified by the Chinese patent office and the required details of the applicant and inventor.

Assume that the Intellectual Property Office of New Zealand is closed on 25 December 2008 and does not reopen until 5 January 2009. China is a Paris Convention country.

- (a) List the minimum that must be filed at the Intellectual Property Office of New Zealand to obtain a filing date for each application. (3 marks)
- (b) State the last day by which each application must be filed. (1 mark)
- (c) Separately list anything that must be filed at IPONZ to complete the filing requirements for each of the applications and indicate by when each item must be filed. (5 marks)

Question 2 (7 marks)

You filed a New Zealand patent application with a complete specification in the first instance on 1 October 2007 for Jim Jameson. At the time Jim was keen to get a patent as quickly as possible. The application has been examined and you are about to file a response to the relatively minor objections raised by the examiner.

Jim has now decided that he is no longer concerned with getting protection quickly. Instead he wants the expiry date of his patent to be as late as possible.

Jim is only interested in protection in New Zealand.

Jim disclosed his invention in trade journals on 2 March 2008.

- (a) Briefly describe a strategy that will delay the expiry of the patent protection as long as possible. (4 marks)
- (b) Estimate the final date of the patent term. (1 mark)
- (c) Comment on any disadvantages your strategy introduces to the protection of the invention. (2 marks)

Question 3 (9 marks)

Wiremu Williams has filed a New Zealand patent application for a mouse trap that uses a small cage to trap a mouse. A cage door drops into place when the mouse enters the open cage.

Wiremu has now made an alternative version that does not fit within the wording of the description of the patent application. In this version the cage door shoots upward into place to trap the mouse. It is an obvious variation on the invention originally described.

Wiremu has been selling the original version since the day after he filed the patent application.

Provide answers for each of Questions (a), (b) and (c) for each of the Circumstances (i), (ii) and (iii).

Circumstances

- (i) He filed the application with a provisional specification on 16 June 2008.
- (ii) He filed the application with a complete specification in the first instance on 1 February 2007. That application has not yet been accepted.
- (iii) His application went to grant on 27 June 2008.

Questions

- (a) Advise whether IPONZ should permit an amendment to the existing specification on file at IPONZ (giving reasons). (3 marks)
- (b) If in any of circumstances (i), (ii) and (iii) above an amendment is possible, advise in each case whether making such amendment is advisable in relation to the protection of both the original and alternative versions of the invention. (3 marks)
- (c) Advise of any alternative strategy for protecting the new version (as well as maintaining the protection of the original version). (3 marks)

Question 4 (25 marks)

Discuss the following, preferably referring to relevant case law. No marks will be given for answers that are simply yes or no.

- (a) Can a claim in a patent to a novel ergonomic handle be invalid on the ground of prior claiming by a claim to a gun having the same handle in a patent with an earlier priority date? (3 marks)
- (b) An inventor shows a device to a customer in confidence without fully showing how it works. The customer is impressed and immediately places an order which is then accepted. A week later the inventor files a patent application. A further day later the inventor delivers the device to the customer. Have the inventor's actions affected the patentability of her invention? (3 marks)
- (c) Five years ago, a manufacturer mixed a new flour-based ingredient into dry cake mixes. His cake mixes are sold in supermarkets. The new ingredient could not be detected in the cake mixes. Is such use of the ingredient "prior use", "secret use" or neither in the context of New Zealand patent law? (3 marks)
- (d) Could an omnibus claim be valid and useful in the following context? A patent is directed to a process of making an alloy. The claims of the patent consist of claim 1, claims 2-9 (all depending from claim 1), and independent claim 10, an omnibus claim. Evidence presented to the court is likely to persuade the court that claims 1-9 are invalid because the temperature range in claims 1-9 includes temperatures that clearly do not work. Claim 10 has no reference to a temperature. (4 marks)
- (e) A surgeon files a patent application for a new surgical tool in 2007. A patent specification was published in New Zealand in 1984 describing a garden implement having exactly the same integers (features) listed in the surgeon's claim 1. That claim begins "A surgical tool comprising...." Is claim 1 prior published? (2 marks)
- (f) A watchmaker has found that an arterial clamp used by surgeons is useful for certain watch repair procedures. Can he obtain a valid New Zealand patent for the known clamp with claims in the following format: "A clamp for use in watchmaking comprising [the features of the known clamp]"? (2 marks).
- (g) Where a New Zealand application is filed as a convention application with a missing page of disclosure, are there circumstances in which the missing page can be re-inserted a week after filing, while retaining convention priority? (4 marks)
- (h) Are the patent revocation grounds of insufficiency and inutility substantially the same? (2 marks)
- (i) Is a patent claim having a known desirable result as one of its features inevitably invalid in New Zealand? (2 marks)

Question 5 (14 marks)

On 1 March 2007 JJ Limited (JJL) was granted a New Zealand patent for a remote control device. The only disclosure of the device is in the New Zealand patent specification.

Janet Janssen, the managing director of JJL arrives in your office on 1 July 2008. On 7 April 2008 a New Zealand patent application for a very similar invention was published. She describes it as a rip-off. She tells you that the applicant Kiwi Remotes Limited (KRL) is her main competitor.

KRL's device has the features of JJL's device but also an additional feature that is clearly not described or claimed in the JJL patent specification. This feature is, however, known in other remote control devices and is described in brochures describing these devices. The brochures have been distributed publicly in New Zealand for at least 3 years. Janet says that anyone in the industry could have seen that the additional feature might be useful in her device.

The KRL patent application was filed 3 days before the JJL patent was granted.

Janet wants you to "knock out the KRL patent".

- (a) Describe the option(s) available and any deadline(s) that apply. (6 marks)
- (b) Describe advantages and disadvantages of the option(s) of (a). (7 marks)
- (c) Name the ground under New Zealand patent law, which on these facts, appears to be most useful for attacking the KRL patent application, and explain why. (1 mark)

Question 6 (10 marks)

Floripham, Inc a Florida corporation filed a New Zealand patent application derived from a PCT application filed on 1 July 2005.

The claims are directed to a novel family of 4 related anticancer drugs, A1, A2, A3 and A4. The specification describes in general terms a method for the chemical synthesis of all four drugs, but only specifically describes the preparation and properties of A1.

The application was examined on 1 March 2007. The examiner has not allowed claim 1, which claims an anticancer drug selected from A1, A2, A3 and A4. The examiner asserts that claim 1 is not fairly based because of lack of exemplification of the drugs other than A1. The examiner has no objection to claim 2 which claims A1. There are only two claims.

Floripham's new patent manager, Frank Franklin, tells you that he does not agree that there is a lack of fair basis for drugs A2, A3, and A4. However he

also suggests that it may be appropriate to (i) delete claim 1 and have the application go to acceptance and (ii) file a divisional application with existing claim 1 to all four anticancer drugs.

(a) Advise Frank of the likely consequences if Frank's suggestion is followed. (2 marks)

(b) Discuss the usefulness of alternative strategies that might maximise the potential for Floripharma to obtain the broadest protection for the four anticancer drugs. (7 marks)

(c) If a divisional application is to be filed, what is the deadline for filing the divisional application. (1 mark)

Question 7 (10 marks)

In 1998 Greeneyes Limited (Greeneyes) filed a New Zealand patent application for a process for manufacturing tinted contact lenses. The New Zealand patent was granted in 2000.

One step in the claimed process is to heat a tinted mixture to a temperature between 100°C-300 °C. The patent specification states that temperatures of 100°C-300 °C are used in the invention with the preferred temperatures being in the range, 110 °C-170 °C. The specification describes specific examples of the process where the heating step is carried out at 120°C and 150°C.

The process has not been used commercially because after the New Zealand patent was granted, Greeneyes found that the products of its process had a major problem. After a few weeks, the contact lenses started going opaque.

Since then Greeneyes has tried many modifications to its process. Until recently it was unable to overcome the problem.

The company has now determined that the solution was to carry out the heating step at 230°C-270°C. Why the use of a temperature in this range overcomes the problem is not known. Previously it was believed that high temperatures might adversely affect the colour of the lenses. Above 270°C, it was found that lens colour was poorer and the problem with opaqueness returned.

Greeneyes is now in a position to launch products of the process. There has been no disclosure of the use of the the 230°C-270°C temperature range.

(a) Advise Greeneyes in relation to protection of its modified process Include discussion of relevant case law in your discussion and the basis of your conclusion. (8 marks)

(b) Comment on the validity of the existing Greeneyes patent (2 marks)

Question 8 (16 marks)

LLA, Inc, an Alaskan corporation was granted its first New Zealand patent on 1 February 2008. LLA refer to the patent as the Goldengreen patent.

LLA's patent manager, Leanne Lee has telephoned you to discuss later filed patent applications. In passing she mentions that she is having difficulty with the Goldengreen patent applications in other countries. She goes on to tell you that competitors opposing the Goldengreen patent applications have forced LLA to drop some of the Goldengreen claims in those countries.

Claims 1 and 2 are anticipated by a scientific paper in *The Ukraine Journal of Agriculture*. Claims 1, 3 and 4 are anticipated by a paper published in the *New Zealand Journal of Agricultural Research*. She tells you that the two papers were published 10 years before the Goldengreen patent's priority date.

As yet, LLA has not found a licensee in New Zealand. Leanne tells you that LLA does not want to spend any money other than the renewal fees until she finds a licensee and that will probably take years. If there is a need for amending the claims in New Zealand she proposes to delay this until any infringement proceedings, if necessary. She likes her present New Zealand claim set as a 'useful deterrent' especially to KiwiBetta Limited (KBL), a New Zealand company. Leanne says that LLA will only grant a licence to KBL "over my dead body".

(a) Comment on whether the relevant amendments could be made during infringement proceedings and on the appropriateness of Leanne's proposal to delay amendment. (3 marks)

(b) Leanne changes her mind and decides to "get any amendments that are really necessary filed by the end of the month while she remembers what needs to be done." While you are talking, Leanne emails you copies of the two articles and a set of claims that is novel and inventive over both scientific papers. Describe both (i) the steps you need to take and (ii) what you need file by the end of the month. (4 marks)

(c) Describe for Leanne the procedural steps that will follow the filing of the application for amendment in the circumstances of (b) and any deadlines that will apply. Do not assume that the procedure will necessarily proceed smoothly. (6 marks)

(d) Advise Leanne how she can minimise the possibility that KBL can get a licence against LLA's wishes, including mention of any relevant date(s). (3 marks)