

**2009**

**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)

When considering answers to the questions in this year's examinations, no account is to be taken of any provisions of the Patents Bill, the Trade Marks (International Treaties and Enforcement) Amendment Bill, the Regulatory Improvement Bill (as it relates to amendment of the Designs Act 1953), or any other bill that may be before the New Zealand Parliament.

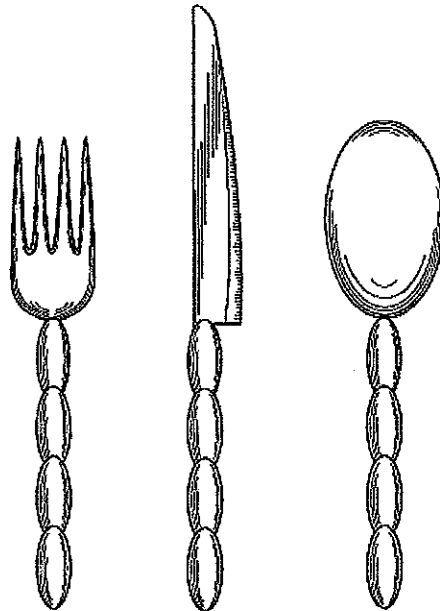
**Question 1 (6 marks)**

Write brief notes on each of the following:

- (a) What is meant by an “article” under the Designs Act 1953? (2 marks)
- (b) Your client has a registered design. Your client has been told of another party using an item identical to that shown in your client’s design registration. The other party is using the item in their own yard, for their own use. Advise whether there is any infringement of your client’s design registration and, if so, by whom. (4 marks)

**Question 2 (13 marks)**

Your client, Tablewarez, has created new cutlery consisting of a knife, fork, and spoon. The knife, fork, and spoon have the same handle design.



- (a) Advise your client whether the cutlery will qualify as a “set of articles” within the meaning of the Designs Act 1953, and why it may wish to file an application for a set of articles instead of protecting the articles separately. Presuming your client wishes to file an application for a set of articles, propose a title and draft a statement of novelty for an application to register the knife, fork, and spoon as a set of articles. (7 marks)
- (b) Is it possible to obtain a single registration that protects the knife, fork, and spoon, but not as a set? If so, explain how that can be done, and propose a title and draft a suitable statement of novelty. (2 marks)
- (c) You file the application as a set of articles, and the design is registered. Soon after registration, another party starts selling a carving knife having a very similar visual appearance to the knife of your client’s cutlery. Advise whether selling the carving knife would infringe your client’s registration for a set of articles. (1 mark)

- (d) You bring your client's design registration to the other party's attention. In response, the other party provides you with a copy of an advertisement that was published before your client's design application date. The advertisement shows a serving spoon having a very similar overall appearance to the spoon of your client's cutlery. Advise how the advertisement affects your client's position. Would the position be different if your client had filed separate applications for the knife, spoon, and fork? (2 marks)
- (e) Can a design registration for a set of articles be attacked by a third party on the basis that the articles were not registrable as a set of articles? Explain your reasoning. (1 mark)

### **Question 3 (10 marks)**

Your local client Joanne Dressmaker, has developed a new textile. The textile is a standard weave, but is printed with a distinctive pattern. She would like to file a design application.

- (a) What are the minimum requirements to obtain a filing date, and what can be filed subsequently to achieve registration? (4 marks)
- (b) Your client asks whether the application can be filed with actual samples of the textile rather than images. What are the requirements? (2 marks)
- (c) Your client advises that she has accepted an order for the textile, prior to approaching you about filing a design application. Are you still able to obtain a valid design registration? Explain your reasoning. (2 marks)
- (d) Assume now that your client has not disclosed her design. She wants to obtain design protection, but is concerned with the details of the design being made public by registration of the design as she may not be ready to release her design for a year or two. Please explain to your client when the details of the design application will be publicly available, and how you might delay registration. (2 marks)

### **Question 4 (6 marks)**

How can a design registration be challenged and on what grounds? Who may challenge the registration?

### **Question 5 (9 marks)**

- (a) Your client is the applicant for a pending design application for product A. The design application has not yet been registered. Six months after filing the design application, your client contacts you with a new product B that is a different type of

product to A, but which carries the same design. He asks whether it is possible to file a New Zealand design application for product B.

(i) What would you advise your client? How would you go about filing an application if that can be validly done? (3 marks)

(ii) Would your advice differ if there has been a publication of product A by your client? (1 mark)

(iii) If your client doesn't wish to incur the cost of an additional design application, will their product B be covered by the existing application for product A once that is registered? Is there any other protection your client may be able to rely on, which doesn't require an application to be filed? Are there any limitations in that? (3 marks)

(b) The Designs Act 1953 determines the date of registration of a design. When is the date of registration? Is it possible to take action against an alleged infringer from that date of registration? (2 marks)

#### **Question 6 (17 marks)**

(a) You file a provisional specification for your client. Your client only had time for a cursory review of the specification before filing, but he told you to go ahead. He has launched onto the market the product protected by the patent application filed. After filing, your client advised that he has found some sections of the specification that he considers to not be entirely clear. He has also decided that he would have preferred to keep some of the information in the provisional specification secret instead of including it in the specification. Please advise your client whether you can achieve what he wants, any limitations, and potential difficulties. (3 marks)

(b) You file a complete-after-provisional specification for your client, and the specification is examined and accepted by IPONZ. After acceptance, you become aware of prior art that renders the scope of the accepted claims too broad. You also note some other issues in the specification that may require amending. Advise your client of the conditions that must be met for amendment of the specification, and any restrictions. Also advise your client on what process the amendment request will go through at IPONZ, and whether any validity issues can arise from either making or not making the amendments. (8 marks)

(c) Presuming you limit the scope of an independent claim in the amendment. Are you allowed to add new dependent claims to the claim set? Provide your reasoning. (2 marks)

(d) You filed a patent application accompanied by a provisional specification for another client 11.5 months ago. Despite several reminders to the client, she only called you yesterday and advised she would prefer to have some more time to work on her invention before a complete specification is filed. What options are available to your client? Would your advice differ depending on whether your client was

intending to file a complete specification only in New Zealand, or also overseas? Presume your client disclosed her invention in a publication 3 months after the provisional application was filed. (4 marks)

**Question 7 (15 marks)**

- (a) Your client has instructed you to maintain a watch for published patent applications that are filed by one of your client's competitors. You forward a copy of an accepted complete specification to your client, and he expresses concern at the scope of the claims. Advise your client (with reference to case law) who may oppose, what must be filed to trigger the opposition procedure, and time limits. (5 marks)
- (b) You begin an opposition procedure for your client. Immediately after you take the initial steps, your client changes his mind and advises he does not wish to incur any further costs. Advise your client what will happen to the opposition proceeding if no further action is taken. (2 marks)
- (c) What is the bare minimum that the applicant must do to continue with the patent application, and what is the time limit? (1 mark)
- (d) Your client has reviewed the accepted claims and believes they seem obvious. Assume that is the only ground your client has to challenge the patent application. Discuss, only in relation to the ground of obviousness, the differences between revoking a patent through the court and opposing the grant of a pending application. Additionally, you are doubtful that your client fully understands what is meant by "obvious" in the context of patent law. Outline, with reference to case law, the steps for analysing obviousness. (4 marks)
- (e) Your client decides he does not have sufficient funds to oppose the patent application at this time, but he is interested to know if he can challenge the patent some time soon after grant. You advise him that it is possible to apply to the Commissioner to revoke a patent. Discuss the provisions relating to revocation of the patent by the Commissioner, including time limits and any advantages or disadvantages compared to the provisions under section 21 of the Patents Act 1953. You do not need to discuss the available grounds in any detail. (3 marks)

**Question 8 (10 marks)**

- (a) You arrive at work on a Thursday morning, and find an email in your inbox with instructions for filing a New Zealand national phase entry from a PCT application. The email has been sent from the United States, and states that the date that was 31 months from the priority date was Wednesday (yesterday). Discuss whether you can still enter the national phase in New Zealand, what the IPONZ practice is in this situation, including any considerations that are taken into account by IPONZ, and the procedure that must be followed. (7 marks)

- (b) Would the considerations be any different if the instructions were for filing a non-PCT convention patent application in New Zealand, and the instructions were received one day after the date that was 12 months from the priority date? (3 marks)

**Question 9 (5 marks)**

Five months ago, you filed a New Zealand patent application with a provisional specification on behalf of your client company. The patent application listed two inventors. As you had a pre-filing assignment from the inventors to your client company completed, the application was filed in the client company name. Your client has just contacted you and advised it made an error when instructing the application initially. Your client has realised that a third inventor from a different company was involved in creating the invention. Your client wants the patent application to stand in the client company name. Discuss what needs to be done, including any implications of doing nothing. (5 marks)

**Question 10 (9 marks)**

Your client is a local retailer of electronic equipment. He has just returned from Japan, very excited about a hand held radio he saw in Japan. He has pulled the radio apart, and believes it has functionality that he has never seen before. Additionally, the radio has a distinctive appearance that he believes will make it a “keen seller” in New Zealand. He entered into preliminary discussions with the Japanese inventor about becoming his New Zealand distributor. However, he was not able to agree on suitable terms with the Japanese inventor. On the way back to New Zealand he visited a manufacturer colleague in China, and the manufacturer advised he could readily manufacture and supply the same product at a very low cost. Your client wants to start selling the product in the New Zealand market, and also wants to stop others from selling here. At his request you conduct a search of New Zealand patents and designs, but don’t find relevant results. Advise, with your reasoning, on the following:

- (a) Whether your client can apply for valid protection in New Zealand. (6 marks)
- (b) Whether your client might be prevented from selling the product in New Zealand. (3 marks)