

2009

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)

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.

Paper C - 2009 – Foreign Patent Law

1. You have a client with a PCT application which has a priority date of 7 February 2007 and an international filing date of 7 February 2008. Your client advises you that they would like to file national phase applications in France, Australia, Great Britain, Canada, Japan, USA, China, Korea, India, Taiwan, Hong Kong and Brazil.

Advise your client on their options including whether national/regional phase applications are possible, the final due date for filing applications where possible and any extensions of time that might be possible beyond this due date (assume that it is the client's intention to file and that there have not been any undue delays).

7 Marks

2. On 1 January 2009 a new PCT rule came into effect termed a supplementary international search (SIS) service. Discuss this service, when it might be used and any advantages of using the SIS service.

4 Marks

3. You are acting on behalf of a client who has filed an Australian patent application.

- (a) Explain the terms 'nominated person' and 'eligible person' and how is this information formally relayed to IP Australia?
- (b) The application progresses and a direction to request examination has been issued by IP Australia. Explain what this means to your client, response options and any deadlines.
- (c) Your client becomes aware of a competitor patent that they consider could influence their freedom to operate in Australia. They consider that the competitor patent is not valid and provide you with prior art relevant to the validity of the competitor patent. They also consider that the competitor patent is 'rough as guts' and doesn't properly explain how to work the invention. On the basis of the information provided, advise your client on options under Australian patent law to challenge the validity of a patent.

15 Marks

4. Your client has filed a USA patent application.

(a) Your client's application has a restriction / election office action issue. Explain what this means and options to respond.

(b) Your client's application has been examined by a USPTO examiner. You are having problems overcoming the examiner's concerns and your latest examination report has been made final. What are your options?

(c) You have been informed by your client that the inventor has just turned 80 and is becoming concerned about the length of time it is taking to get through the examination process. What option or options are available to address this concern?

14 Marks

5. XYZ Ltd, a company having 20 employees, asks you about filing for patent protection in the USA and Canada. The patent application that XYZ Ltd wishes to claim priority from lists a single person as applicant and inventor. XYZ Ltd is now the applicant by way of assignment. XYZ Ltd wants to license its patent rights to one of New Zealand's largest companies but also has interest from a New Zealand University. XYZ Ltd is keen to keep its patent costs as low as possible. Advise XYZ Ltd how this might be achieved and any issues that may arise in the future.

7 Marks

6. Your client, a commodities trader, questions you about a recent US case they have read about termed *In re Bilski*. Briefly explain what this case was about and the implications of the case for US patent applicants.

6 Marks

7. You are acting on behalf of a client who has recently been granted a US patent. Your client has corresponding unexamined patent applications in Australia, Europe and Japan, China, Korea and Taiwan.

Assuming that the priority filing was a US provisional application, is there a procedure by which your client's US granted patent can be used to assist prosecution in the other countries where corresponding applications have been filed? If so, how?

Would your answer be different if the priority application was filed in New Zealand?

6 Marks

8. You are acting on behalf of a client that has filed a European patent application. Your client approaches you as they have become aware of a potential infringing party in Great Britain and want to take action. Advise your client. In particular, advise what options exist to speed grant of the European application. Assume that the European application has only been filed 2 months ago claiming priority from a NZ application.

10 Marks

9. Your client has a single NZ patent application accompanied by a provisional specification. They have approached you noting that their key markets are in Asia and in particular your client confirms that they only want protection in India, China, Hong Kong, Taiwan and the Republic of Korea. You can assume that 10 months have elapsed since filing of the NZ patent application and that your client published the invention on the internet not long after filing. Also assume that your client does not want to file a PCT application.

- (a) Advise your client on its options and any deadlines to file applications in these countries via the Paris Convention or other treaties but not the PCT.
- (b) Are translations required in the countries specified by your client? If so, what extensions of time are available within which to file the translation?
- (c) Your client advises that they used the invention in public approximately 1 month prior to filing the NZ patent application but did not publish the invention in NZ or elsewhere. Advise what options if any that your client has to obtain valid patent protection in the countries identified.

13 Marks

10. You are an NZ based patent attorney and have been approached by a visiting Japanese tourist who has asked you to assist him with filing a PCT application to protect his new idea that he has conceived while on holiday in New Zealand.

(a) Besides seeking details about the tourist's invention, what other details would you need to obtain from him to ensure that the PCT application is valid?

(b) You proceed to file the PCT application and five days after filing realise that the official fee was not paid. What implications does this have for the PCT application and can extensions of time be applied for to pay the application fees.

(c) Assuming the above issue regarding fees is addressed, explain to the tourist the PCT process post filing and any key deadlines. Do not explain procedures post national phase entry.

12 marks

11. The Republic of Korea Patent Office has implemented a three track system. Explain what this means.

6 marks