

2010

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)

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: (7 marks)

You arrive at work on Tuesday, 6 July 2010 to see that you have received instructions from an overseas agent to file a national phase application in New Zealand. The PCT application was filed on 1 December 2008 and claims priority from an application filed on 1 December 2007 in the name of Rodney Smith. The PCT application was filed in the name of Sam Jones and lists Rodney Smith as the sole inventor. You note the instructions to file the application were received by your office at 4pm on Friday, 2 July 2010, however you have only just been made aware of them. Advise the agent of the requirements for filing the application in NZ and what further information you require, if any. There is no need to inform the agent of the forms that must be filed.

Question 2: (13 marks)

Your client John has developed a new sipper cap for a drink bottle. You have just finished drafting a provisional patent specification for the invention and it is with John for final approval before filing. John originally instructed you to prepare and file a patent application without doing any prior art searching. John now contacts you saying he is reconsidering searching as he wants some reassurance of the patentability of the invention. John believes he has developed his invention to the point where it is in a near final form but there is a possibility of further development. John is cost sensitive. He intends to launch the first generation product on the market in 5 days at a Gazetted Exhibition.

Advise John of his options and the pros and cons of each.

Question 3: (5 marks)

You act for an international electronics company. The company filed a patent in the US on 2 August 2009 and then filed a PCT application (claiming priority from the US application) on 2 July 2010. The company's attorney has asked you to file a patent application in New Zealand urgently. It wishes to gain grant of the New Zealand patent as soon as possible. Advise your client of the options available to it to help ensure expedited processing of the New Zealand application, outlining any advantages and disadvantages of such options. Is there any further information you need from your client?

Question 4: (21 marks)

Eric has a large patent family for an actuator consisting of a New Zealand patent and a number of patents and pending patent applications in other countries. Eric's patents/patent applications have a priority date of 7 November 2005 (NZ547588). He filed a complete after provisional specification in New Zealand and convention applications in other countries on 7 November 2006.

Eric's European patent application has recently been examined. It has claims that are identical in scope to the claims of his New Zealand patent. A unity objection along with novelty and inventive step objections have been raised against the European patent application, citing three patents Eric was not previously aware of. The first patent is GB456978 filed 28 May 1956 and published 11 October 1959. The second is US5,996,445 filed 15 February 2000 and published 30 April 2005. The third is EP12346999 filed 17 August 2005 and published 17 February 2007. All three patents were available in New Zealand as of their publication date.

Referring to the Patents Act 1953 and any relevant case law, advise Eric in respect of his New Zealand Patent, including any action(s) he should take and when, any limitations placed on those actions, and any associated risks.

Question 5: (8 marks)

Discuss each of the following, referring to any relevant sections of the Patents Act 1953 and case law to support your answer:

- a) Claims to the same invention in separate applications filed by the same applicant and having the same priority date. (4 marks)

- b) Applications filed with a complete specification (non-PCT) are typically examined within a week of filing. If IPONZ has no objections then an application will quickly proceed to acceptance. A client has asked you to explain the advantages and disadvantages of this and advise on options (if any) for delaying examination and/or acceptance of an application. If applicable, refer to relevant sections of the Patents Act 1953 and any deadlines for taking such actions. (4 marks)

Question 6: (16 marks)

Your client, Light Source Limited has a patent application NZ456789, directed to a new lighting system. The patent application was filed in 2007, a notice of acceptance issued on 14 April 2010 and the acceptance of the application was published in IPONZ official journal on 29 April 2010. The patent application includes claims to an assembled lighting system and a method of assembling the lighting system. Darren, the director of Light Source Limited, has just contacted you to advise that he believes a competitor, First Light Ltd, is infringing NZ456789. For the past 12 months First Light Ltd has been selling a kit of parts with assembly instructions, which allow an electrician to assemble and install the product onsite. You review First Light's lighting system and are of the opinion that the assembled product is the same as that covered by NZ456789, as is the method of assembly.

(a) Darren is extremely agitated by the activities of First Light Ltd and wants to give them a piece of his mind. He wants First Light to stop selling its lighting kit. Assuming First Light Ltd would infringe NZ456789 if granted, advise Darren what he can/can not do, and when. (4 marks)

(b) Advise Darren whether or not Light Source Limited could take infringement action against First Light Ltd once the patent is granted, explaining your reasoning. (4 marks)

(c) Advise Darren what action First Light Ltd may take to defend its position and establish freedom to operate in the marketplace, outlining the steps it would need to take to initiate such actions and the deadlines for doing so. (8 marks)

Question 7: (11 marks)

Alex has invented a novel clothes peg which holds clothes in an open position when hanging on the line (for example, it holds open the legs of trousers). Alex would like to file a patent application. Alex has conducted extensive testing of the clothes peg in the yard at home for the past 6 months and notes it allows clothes to dry twice as fast and is extremely durable under New Zealand weather conditions.

- (a) Is Alex able to file a valid patent application? (3 marks)
- (b) Assuming Alex can file a valid patent application, explain the patent application processes (from filing to grant) including time limits, and opportunities others have to challenge the patent application. (4 marks)
- (c) Alex would like to obtain protection for the following claim: "A clothes peg which is adapted to reduce the drying time of clothes." Discuss the allowability of such a claim. (4 marks)

Question 8 : (10 marks)

Discuss the following, referring to the provisions of the Patents Act and any relevant case law, to support your answer.

- (a) Discuss the significance of *NRDCs Application 1961 RPC 135* to the development of the law relating to patentable subject matter. (3 marks)
- (b) Discuss the patentability of methods that include steps which are purely intellectual. (4 marks)
- (c) What is an omnibus claim, what is its purpose, and how are such claims interpreted? (2 marks)

Question 9: (9 marks)

One of your clients, Kelly Brown, has contacted you to advise she has just noted that her ex-business partner (Sam Clarke) has filed a patent application accompanied by a complete specification. The application was filed five months ago. From the title of the application, Kelly believes that the invention is a copy of something she invented and disclosed to Sam in confidence a year ago, when they were jointly running a company called BC Enterprises Ltd. Sam left the company 6 months ago. Kelly would like advice on any action she could take to remedy this situation. Advise Kelly of the actions she could take under the Patents Act 1953 and the deadlines for doing so.