

2010

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

- a) New Zealand patent application 123456 finally proceeded to acceptance and was subsequently granted and sealed. A late sealing reminder issued 13 November 2008. The IPONZ e-database lists the following dates:

| | |
|------------------------|-------------|
| Convention date: | 02-Jan-2001 |
| Filed date: | 02-Jan-2002 |
| National phase date: | 02-Jul-2003 |
| Accepted: | 31-Jul-2008 |
| Late sealing reminder: | 13-Nov-2008 |
| Registered: | 13-Nov-2008 |

Despite numerous reminders to your overseas associate, including a late sealing renewal reminder, the status of NZ 123456 is presently listed as “Expired and Not Renewed”. Also listed under “actions” on the IPONZ e-database is that the application lapsed on 14-Sep-2009.

You have now received correspondence from a new associate who explains that she is now acting for the applicant. Emails are exchanged and you are instructed to restore the application.

Please comment on whether it is possible to restore NZ 123456 and if so what is required for restoration.

(3 Marks)

- b) You have just received correspondence from IPONZ that NZ patent application 654321, which is a divisional to NZ 123456, has recently been granted and sealed. The correspondence also includes a late sealing renewal reminder.

The application has the following dates:

| | |
|---------------------------|-------------|
| Convention date: | 02-Jan-2001 |
| Filed date: | 02-Jan-2006 |
| Registration action date: | 27-Nov-2009 |
| Late sealing reminder: | 12-Nov-2009 |

What is the last date on which this patent may be renewed?

What is the renewal term (or terms) that apply?

(1 Mark)

- c) New Zealand Design 444444 is listed as Registered with the following relevant dates:

Filed date: 13-Jan-2000
Convention date: 13-Aug-1999
Registration action date: 28-Jul-2000

What are the renewal due dates for this registered Design? - and when will Design copyright expire, assuming all renewal fees have been paid?

(1 Mark)

- d) New Zealand Registered Design 488888 is listed as being associated (S8) with above New Zealand Registered Design 444444.

NZ 488888 has a filing date of 18 August 2006.

What are the renewal due dates for NZ 488888? - and when will Design copyright expire, assuming all renewal fees have been paid?

(2 Marks)

- e) Due to a number of office errors where a bring-up date was inadvertently omitted, the renewal fee for above Registered Design 488888 went unpaid. The errors occurred in the office of the attorney responsible for renewing the Registered Design.

What remedial action is available, if any, to reinstate this Design?

Please cite any case law and/or IPONZ published office practice guidelines that might assist you in this regard.

(3 Marks)

- f) Referring to part e) above, assume now that the errors were instead made by IPONZ.

What remedial action is available, if any, to reinstate this Design?

Please cite any case law and/or IPONZ published office practice guidelines that might assist you in this regard.

(2 Marks)

QUESTION 2

Your client, somewhat distressed, requests an urgent appointment and thrusts a letter into your hand.

The letter reads:

*“Legal Department
PO Box 12345
Petone
Wellington 5000*

***Re: Unauthorised Use of Chameleon Images’ Computer Image
Reference Number 12345 67890***

It has come to our attention that you are using a computer image (or images) represented by Chameleon Images for online promotional purposes. This image has been afforded NZ Design 400999, Registered on 6 June 2003, details from the IPONZ e-database Registry for Designs are attached.

We have searched our records and have not found a valid license for the use of the Registered Design NZ 400999 to the computer image(s). Attached for your reference is a copy of the computer image(s) and its use on your website. We have also attached a settlement demand representing the amount owed for unauthorized use of the computer image(s).

As you may know, use of an image without a valid license is considered copyright infringement in violation of the Copyright Act 1994.

The following action must be taken within 21 days of the date of this letter:”

After a brief discussion it becomes apparent that the image in question is an icon which can be found on the home page of the client’s website. The website, was designed on the client’s behalf by a web design company at a cost of NZ\$ 2,000 and has been in continuous use since April 2004. The website allows viewers to purchase golfing equipment on-line.

Please advise your client what steps they can take to ameliorate their situation.

Cite any case law or sections of the Patents or Copyright Act that you think might be relevant.

(10 Marks)

QUESTION 3

Your client recently filed a patent application with a complete specification directed to a travelling irrigator having a single irrigation arm adapted to move in an oscillating motion.

The inventor has now determined that motion does not necessarily need to oscillate between a first and second position – but may be adapted without too much difficulty to rotate 360° or more.

A simple modification eliminates the need for oscillating motion as is claimed in the claims of your client's patent application. The reference to oscillating motion is found in all of the claims in the patent application.

Your client explains that he is worried that this modification is not covered by the patent application – and wishes to protect this aspect to exclude potential competitors from designing around the claims of the present application.

- a) Please advise your client of his options, citing any relevant case law.

(4 Marks)

- b) You find that acceptance has in fact already occurred – does this change your answer to (a) above and if so how?

(3 Marks)

QUESTION 4

- a) In an examination report an IPONZ examiner raises an objection under section 7(2), stating that -

“The present application which is dated 18 March 2006 claims priority from Application A filed in the USA on 18 March 2005 and Application B filed in the USA on 17 August 2005. Application A was subsequently abandoned – however, Application B proceeded to grant as Patent B. Application B also claims priority from Application C filed on 30 April 2004. Please note that Application C was not abandoned and became granted as Patent C.”

The examiner objects that Application A was not the first application filed in a convention country, but rather he believes that Application C was the first Application.

Please advise your client on what is covered by section 7(2) and how this objection might be overcome?

(5 Marks)

- b) In the same examination report the examiner has also referred to a New Zealand convention application, Application D, which claims priority from Application C. The examiner has required that a reference to Application D be included in the present application under s14(4).

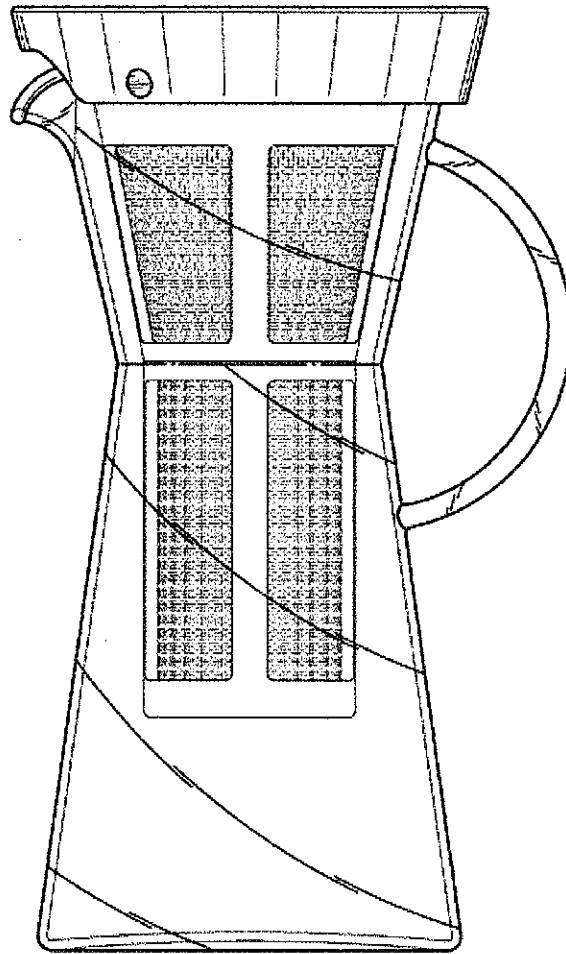
Explain the nature of this requirement to your client and suggest how it may be overcome.

(5 Marks)

QUESTION 5

With reference to the Designs Act 1953 and the Designs Regulations 1954 and, where relevant, applicable case law:

- a) What is the definition of a Design?
(2 Marks)
- b) Your client has designed a commemorative medal for the Rugby World cup. Advise your client as to registrability.
(1 Mark)
- c) What is meant by “industrially applied”?
(2 Marks)
- d) Can Design registration be gained for part of an article? What is required in such an application?
(1 Mark)
- e) Your client has a new design for a jug, a representation of which (marked “Representation A”) is shown below. Your client advises you that the handle has an old, well known shape and he does not want to protect that. Draft a statement of novelty for your client’s design. Another copy of Representation A (marked “Further Copy of Representation A”) is attached to this paper so that you may use it as part of your answer, if you so wish.
(2 Marks)



Representation A

- f) What is meant by “new or original”? (2 Marks)
- g) Your client has designed a new drink bottle and made some prototypes which he has sold to some friends. He has also placed some photographs of the bottle on a website. He filed an application with the Intellectual Property Office of New Zealand (IPONZ) to register the design under the Designs Act. He now has an examination report from IPONZ which objects that the design has been published on the website. Advise your client. (2 Marks)
- h) Your client has developed a new mobile telephone faceplate with a new surface pattern. The faceplate is designed to replace an existing faceplate made by a competitor.

- a. Advise your client on registrability of the design and any other issues that may be relevant. (2 Marks)
- b. Draft a statement of novelty for the faceplate. (1 Mark)
- i) Your client from h) above has also designed a protector that will be sold with the faceplate. Advise your client as to whether this design concept may be protected and if so, how. (2 Marks)
- j) Who may apply to register a Design? (1 Mark)
- k) Specify the available grounds for cancellation of a Registered Design? (5 Marks)

QUESTION 6

A designer develops a new style of ceramic handle for a tap. The designer lodges an application to register the Design. A Certificate of Registration subsequently issues and the designer then marks all tap handles to which the design is applied as "Registered" along with the registration number. The statement of novelty for the Design reads:

"The design is to be applied to a tap handle and the novelty of the design resides in the features of shape and/or configuration of the article as shown in the accompanying representations"

- a) A few months later a furniture manufacturer uses similar handles on its bedroom suite. However, they are made of wood and are of a different size.

Discuss whether or not these handles infringe the designer's registered Design.

(4 Marks)

- b) Another tap manufacturer, who has no knowledge or understanding of Intellectual Property, sees the designer's tap handles, likes them and reproduces them to add to its product range.

What remedies are available to the ceramic designer against the competing manufacturer?

What defense does the competitor have against infringement?

(6 Marks)

QUESTION 7

Your client designed a chair and contracted a Chinese company to manufacture the chair in China. Your client has been importing the chair into New Zealand for sale to New Zealand customers for the last two months. Your client comes to you seeking advice in relation to a letter he has just received from a German patent attorney.

The letter reads:

“Dear Sirs

We are writing to you on behalf of Seathausen GmbH, Industriestrasse 11, 91217 Hersbruck, Germany.

- 1 Our client is a well-known manufacturer of high-quality seats.*
- 2 Our client is the owner of, International Design DM/071 294 filed on 1 February 2010. A copy of the representations are enclosed for your convenience.*
- 3 Our client has come to know that you are producing and offering for sale the above mentioned chair.*
- 4 Please let us know why you believe that you can leave the Intellectual Property rights of our client and unfair competition law aside.*
- 5 As deadline for your response, we noted down*

July 10, 2010”

Your client reviews the representations that accompany the letter and states that they show a chair which appears to be identical to the product he is selling in New Zealand.

Advise your client of his options, including any further information that may be required.

(4 Marks)

QUESTION 8

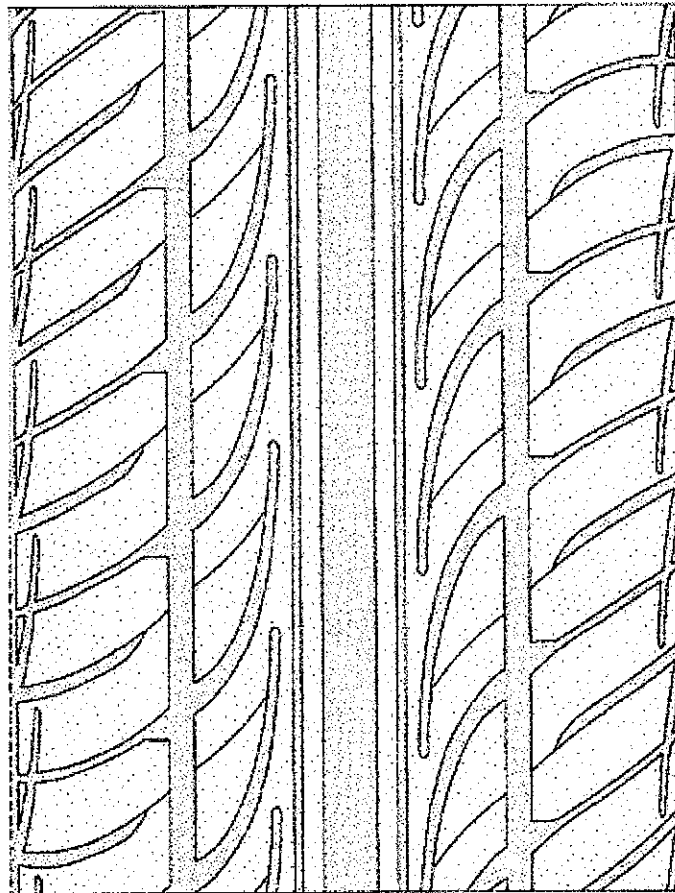
- a) You receive instructions from an overseas associate to file a convention design application in New Zealand. Upon reviewing the instructions and the priority document you see that there are many representations which your associate refers to as showing various “embodiments” of the design.

Advise the associate of the options available for protecting the design in New Zealand.

(2 Marks)

- b) You have filed a convention design application with the single representation shown below. The article to which the design relates is a tyre and the novelty relates to the tread as shown in the representation. The examiner has made an objection under regulation 25 that the representation is insufficient and has requested additional views. Explain how the objection may be overcome, making reference to relevant case law.

(4 Marks)



- c) The examiner also makes an objection that the design referred to in b) above does not satisfy the requirements of the Act as it is purely functional. Explain the objection to your client, and advise your client making reference as appropriate to relevant case law.

(5 Marks)

QUESTION 9

Your client owns a current New Zealand patent claiming a unique machine for washing cars, which has considerable advantages in terms of water conservation and providing a cleaner car.

Your client has granted a non-exclusive, royalty-free license to a number of operators to the use of the machine. Moreover, as a condition of the royalty-free license your client has verbally agreed with each operator that they will only acquire chemicals for use with the car wash machine from you client. The chemicals are not the subject of any patent rights belonging to your client.

It has recently come to your client's attention that a competitor is making overtures to a number of those operators to supply them with chemicals for use in their car washes. Your client has heard that competitor is also interested in producing a car washing machine that is very similar to your client's machine. Your client considers that such overtures infringe, or have the potential to infringe, his exclusive rights.

Advise to your client, with reference where appropriate to any relevant provisions of the Patents Act.

(8 Marks)

QUESTION 10

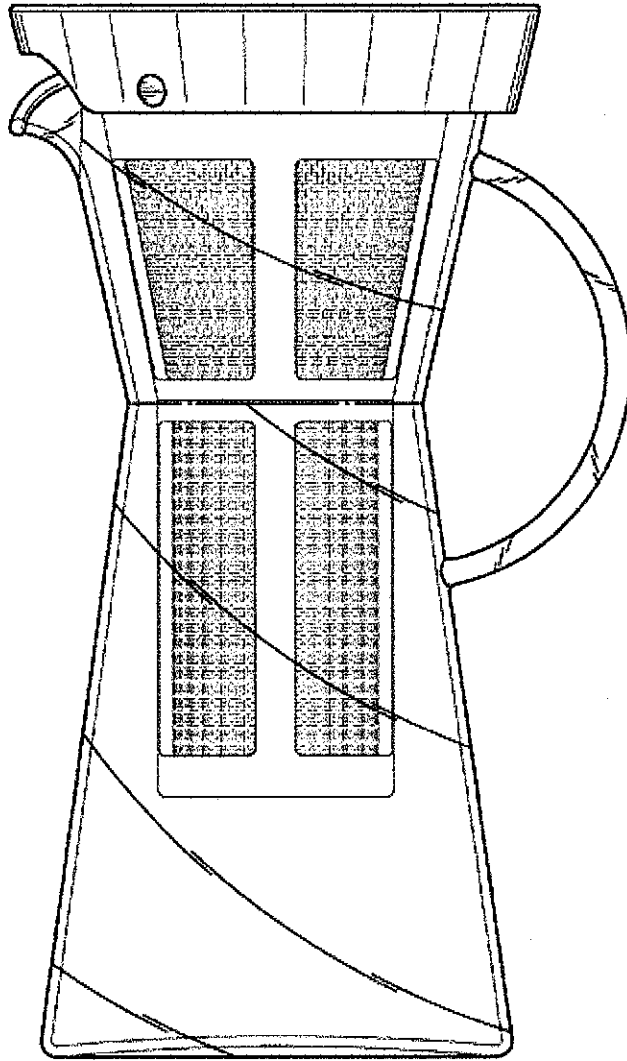
Your client has been secretly using a materials processing method in New Zealand.

She has now received notification that a competitor has recently obtained acceptance of a New Zealand patent application for the processing method. She has obtained a copy of the publication notice in the Patent Office Journal and notes that the named inventor is one of her former staff members. Publication occurred less than three months ago.

She has come to you seeking your advice as to whether she can patent her process, and whether the patent application filed by her competitor is a significant threat to her business.

Advise your client making reference to the Patents Act.

(5 Marks)



Further Copy of Representation A