2010

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.

Question 1 (9 marks)

KiwiGenes Limited (KGL) is a New Zealand company that files patent applications around the world. It obtains patent rights by funding research in genetic engineering in exchange for the intellectual property developed.

KGL has contracted with two organisations to develop a genetically engineered wheat rich in vitamins. The organisations are:

- New Australian University (NAU) an Australian university
- BigGenes, Inc (BGI) a Californian corporation

The two scientists who are the inventors for this project are:

- Professor Luigi Blue, an employee of NAU, an Australian citizen and resident
- Dr Brad Burger, an employee of BGI, a US citizen and resident

Both inventors have been involved with the invention solely in their own countries.

On 13 August 2009, you arranged filing of an Australian provisional patent application in the name of Professor Blue, who was the sole inventor at the time. Since then the invention has been substantially and inventively improved by Dr Burger.

KGL instructs you to draft and file a PCT application with IPONZ as the Receiving Office. This PCT application will include Dr Burger's improvements.

The new application is to claim priority from the Australian patent application.

No assignments of the invention have been signed. There are agreements between KGL and both NAU and BGI relating to funding in exchange for the intellectual property to be generated through use of the funding.

Apart from preparing and filing the complete specification, claims, figures and sequence listings by 13 August 2010, what other actions should you take to complete filing of the PCT application? Include any relevant deadline(s) for actions that can be attended to within 5 months of filing?

Question 2 (8 marks)

Buzza Limited has filed a New Zealand patent application for a new type of chainsaw. The application was accompanied by a provisional specification.

Buzza has now decided to abandon the application. Buzza has decided not to manufacture the chainsaw at least in the next few years. Buzza, however, would like to have it published to prevent a competitor from patenting the same invention.

(a) Comment on the advantages and disadvantages of filing an Australian innovation patent application to publish the invention relative to completing the New Zealand application to publish it. (2 marks)

(b) Comment on the effectiveness of filing an Australian innovation patent application for the purpose of preventing a competitor from subsequently patenting the same invention in the USA, Canada, Australia and at the European Patent Office. For each country or region, indicate the date from which the innovation patent application would be effective as novelty-destroying prior art, if applicable. (6 marks)

Question 3 (4 marks)

Your client has a pending US patent application for a food product.

The US Patent and Trademark Office issued a final office action dated 1 March 2010. On 28 May 2010 your US associate filed a response to that office action.

The associate has now advised that the examiner has rejected all the claims in an advisory action dated 1 July 2010.

You discover that your client is happy to limit the food product claims to specify a particular low sugar content. None of the rejected claims is currently limited in that way. You believe that the examiner would accept the claims if they were so amended.

Describe to your client the actions that you and your US attorney should now take to put the amended claim set before the examiner. Include in your answer any deadlines for the actions (and any extensions).

Question 4 (10 marks)

Your client, Wellypharm Limited recently entered the National Phase in the USA and at the Regional Phase in Europe from their PCT application. The relevant dates are:

- New Zealand priority date –1 October 2007
- PCT filing date – 1 October 2008
- US National Phase entry – 1 April 2010
- European Regional Phase entry – 1 April 2010

You recently became aware of another family of patent applications filed in the name of Bondipharm Limited.

- Australian priority date – 1 November 2007
- PCT filing date – 1 September 2008
- US National Phase entry – 25 March 2010
- European Regional Phase entry – 25 March 2010

The subject matter of both patent applications is drugs.

Wellypharm's patent application describes and claims Drug A, Drug B and Drug C. These drugs are described as useful in the treatment of schizophrenia.

Bondipharm's patent application describes and claims Drug C, Drug D and Drug Z. These drugs are described as useful for treating gout.

Drug C is described and claimed in both applications.

Drug Z is also described in both applications. It is described in Wellypharm's application only as an intermediate in the preparation of Drug A. There was no suggestion in Wellypharm's application that Drug Z has pharmaceutical properties.

Wellypharm's provisional specification describes Drug A, Drug B and Drug Z but not Drug C. Bondipharm's provisional and PCT specifications are essentially identical.

(a) Both European applications have a claim reading "Drug C". Comment on the validity of the claim for Drug C in each of the two **European** applications. (2 marks)

(b) Will Bondipharm be able to get a grant of a claim reading "Drug Z" at the **European** Patent Office? Give reasons (2 marks)

(c) Assuming that one or both companies are unsuccessful in gaining a claim reading "Drug C", draft an alternative claim for one of the **European** patent applications that is probably available on the present facts. (1 mark)

(d) Both US applications have a claim reading "Drug C". Comment on the validity of the claim for Drug C in each **US** application. (2 marks)

(e) Will Bondipharm be able to get a grant of a claim reading "Drug Z" in the **USA**? Give reasons. (2 marks)

(f) Assuming that one or both companies are unsuccessful in gaining a claim reading "Drug C", draft an alternative claim for one of the **US** applications that is probably available on the present facts. (1 mark)

Question 5 (12 marks)

Your client, Singenz Limited, a New Zealand company filed an Australian standard patent application with a complete specification on 28 July 2009 for its new product. The Australian application has now been accepted.

Singenz's IP Manager tells you that the new product is first to be sold in Singapore – and that he wanted to obtain protection there as soon as possible. But he noted that he would like to take advantage of any further searching that did not delay grant significantly.

You are to file a PCT application, claiming priority from the Australian application. You are also going to arrange filing of a Convention application in Singapore on 27 July 2010.

(a) Describe the fast track examination procedures and amendment options available for Singenz's Singaporean Convention application, up to grant (include any deadlines). (8 marks)

(b) A competitor believes that the invention covered by Singenz's Singaporean application is obvious over a prior art document. Describe any opportunity available to the competitor to oppose or seek reexamination or revocation of the patent/application in Singapore and any major limitation of one of these. (4 marks)

Question 6 (8 marks)

Your client filed a PCT application on 21 October 2008, claiming priority from an application dated 15 November 2007. On 10 May 2010 your client decided to continue with the application only in two countries – USA and Australia. Today your client calls you to see if he can now continue with the PCT application in the following countries:

- Brazil
- Canada
- Hong Kong
- India
- Japan
- People's Republic of China
- Republic of Korea,
- Singapore
- Taiwan

Advise your client whether the opportunity to enter the national phase still exists for each country. For each country where there is still an opportunity, also advise how you should proceed and any deadlines. For any country where the opportunity is no longer available, very briefly indicate the reason.

Question 7 (7 marks)

Your European associate has advised that she has received a Communication under Rule 71(3) indicating that your client's application is acceptable. The communication was issued by the European Patent Office dated 25 June 2010. Advise your client what is now required to obtain grant of a European patent - and for the patent to be enforceable in Great Britain, France, Germany and Italy and any deadlines.

Question 8 (4 marks)

Your client has a recently granted US patent and a US patent application under examination. The client also has a Japanese application corresponding to the US application. The US application is the subject of a non-final office action dated 4 May 2010.

The Japanese application has been examined and it cites a Japanese document that is novelty-destroying for the claims of both the US application and the US patent. Your client was previously unaware of the Japanese document.

Advise your client of any options available regarding the US patent application and the US patent. Assume that the claims can be amended. Discuss the consequences of taking no action.

Question 9 (9 marks)

Your client wishes to protect a new method of investment. It involves buying and selling shares in different countries in response to changes in share indexes, currency movements and in the prices of certain commodities and gold. The key to the invention is a formula used to decide the relative allocation of funds in shares between the different sharemarkets. The invention is conveniently carried out on a computer.

Discuss whether the invention is patentable in **Australia**, the **USA** and at the **European Patent Office**, referring to any relevant statutes or case law.

Question 10 (14 marks)

(a) Discuss and compare modified examination and standard examination in Australia. (5 marks)

(b) Briefly describe the options to challenge the grant of an Australian patent application and to revoke a granted Australian patent.
(5 marks)

(c) Your client has recently had its European patent revoked following an opposition before the European Patent Office. The opponents relied on the combination of a published European patent specification and a published Japanese patent application. Comment on whether the differences in the law relating to obviousness between Australia and at the European Patent Office could lead to a different result in Australia. (4 marks)

Question 11 (8 marks)

Your European associate entered the European regional phase from a PCT patent application on 4 May 2010. The PCT search and examination was carried out at IP Australia. The European specification has the same claims as the PCT application. The invention is a novel mousetrap. There are two embodiments. Claim 1 covers both embodiments. Claims 2-8 cover one embodiment and the International Preliminary Report on Patentability (IPRP) prepared by IP Australia indicates that those claims are novel and non-obvious. The second embodiment is covered by claims 9-15. The IPRP alleges that these claims are not inventive relative to three cited documents.

Your client says that the first embodiment is more important, but that she wishes you to pursue all the claims.

(a) What actions can be expected from the European Patent Office and what deadlines will be set before any response on behalf of the applicant is required? (4 marks)

(b) Describe whether the answer to (a) would be different if the European Patent Office had carried out the PCT search and examination instead of IP Australia. (1 mark)

(c) If claims 2-8 are acceptable but claims 1 and 9-15 are not acceptable after examination, describe a way of gaining acceptance of the acceptable claims while still pursuing those not accepted? Indicate any deadlines. (3 marks)

Question 12 (7 marks)

Today, you are meeting your new client. She has just one patent application – a US non-provisional application filed on 20 May 2009.

She shows you the following:

- copy of her US patent specification
- the claims as amended during prosecution
- a copy of the Notice of Allowance dated 15 June 2010

She tells you that the issue fee has not yet been paid.

On reviewing the claims you see that all claims are for a high temperature process that requires a cooling step to a temperature of 0-20°C.

Your client tells you that she has just discovered that the process can also be carried out with cooling down only to 25°C. Using the different cooling step makes no difference to how the invention works. You check the specification and note that there may be basis for suggesting that the cooling step is not limited to a maximum of 20°C but may be cooled at up to 25°C.

Your client now wishes to protect the process with cooling to 25°C.

(a) Discuss the feasibility of protecting the process in the USA with a cooling step to 25°C using the existing application, referring to any relevant case law. (3 marks)

(b) Your client may decide to file a new US application to protect the process with the different cooling step. Name the type of application that you would recommend, giving reasons. (2 marks)

(c) Describe the further information that you need to assist in making a recommendation on how to proceed. (2 marks)