

2013

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)

This examination will be conducted on the basis of the law under the New Zealand Patents Act 1953, as at 1 May 2013, and will not take into account any provisions of the Patents Bill currently before the New Zealand Parliament, as might be enacted by the time of the examination, or any other Bill before Parliament.

Question 1 (6 marks total)

Your client, Dave, has a granted New Zealand patent for bar code scanners which is due to expire in 2018. Under the terms of a proposed joint venture with another company, DIC Limited, he must surrender his rights to the patent and allow the technology to fall into the public domain. This is so that some of DIC's customers who recently installed their own versions of the bar code scanners do not infringe Dave's intellectual property rights. While Dave's scanners were initially a commercial success, partly due to their distinctive housing, increasing competition meant that the product was not commercially viable for Dave and he is happy to surrender his rights and requests you to proceed in doing so.

- a)** Advise Dave what issues need to be considered and how they would be dealt with to action his request. **(4 marks)**
- b)** After discussing the potential surrender of his patent, Dave then tells you there is an associated Patent of Addition. He wants to know what will happen to the Patent of Addition if the main patent is surrendered. **(2 marks)**

Question 2 (6 marks total)

- a)** Sharon and her brother Bill are Australians that have moved to New Zealand. While living in New Zealand, they co-invented a new office stapler and wish to file a patent application. They would prefer to file in Australia as they consider it to be a bigger market for their product than New Zealand. Advise on action required before proceeding with the filing. **(3 marks)**
- b)** On review, Sharon and Bill decided to file in New Zealand only and a New Zealand patent has now been granted naming Sharon and Bill as patentees and inventors. However, Sharon informs you that she has grown tired of Bill's lack of contribution in the marketing of the stapler and no longer wants anything to do with him. Advise Sharon of her rights and what action she may take. **(3 marks)**

Question 3 (13 marks total)

a) You act for AMC, which is a large plastics moulding company that produces automotive accessories. It recently purchased a patent for a utility truck deck liner from a competitor, DMX. The patent, which is several years old, lists two inventors, Jon and Don. Don is the managing director of DMX, while Jon now works for AMC. Jon mentions to you that he was the only inventor of the deck liner that is the subject of the newly purchased patent. On further questioning Jon tells you that Don felt that as managing director of the company he was entitled to have his name added as an inventor. Reviewing the file, you note that the patent was originally filed with Jon and Don named as applicants and inventors before being assigned to DMX (and then to AMC as part of the sale of the patent). What are the ramifications of this and what can be done to correct it? **(5 marks)**

b) On inspecting the patents register, you note that Jon's surname is spelt incorrectly. Advise Jon what can be done to correct this. **(2 marks)**

c) Jon further wishes to discuss a separate project relating to a tie down mechanism for use in a utility truck bed. A complete specification in the first instance for the invention was filed earlier this year and given application number NZ555666. However, AMC has found that the mechanism is not particularly robust and some refinement is needed. It has decided to take a go-slow approach to the patent application while it refines the mechanism (which was disclosed in a trade publication shortly after NZ555666 was filed). Advise AMC on its options for delaying progress of the patent application in New Zealand while retaining its priority date. **(3 marks)**

d) Jon tells you that AMC have made some changes to the tie down mechanism which was described in the complete specification of NZ555666. The changes have improved the mechanism's overall strength by using a one piece extrusion rather than the two separate components of the prototype. However, it is the addition of a latch which has significantly reduced the risk of failure of the mechanism, which was vital in meeting relevant safety standards. Unfortunately, while the use of a single extrusion was envisaged at the time of filing NZ555666, the latch was not described. Advise AMC on its options for protecting the improved tie down mechanism. **(3 marks)**

Question 4 (22 marks total)

Your client Roger has designed and is about to launch a new adhesive tape dispenser. He alerts you to an accepted New Zealand patent application (which claims priority from a German patent application) for an adhesive tape dispenser. From a review of the specification, published on 29 April 2013, you consider there is a strong likelihood that Roger's adhesive tape dispenser will infringe the claims of the patent application if they are granted in their present form. Notably, Roger's dispenser includes a cutting blade shaped in substantially the same way as claimed in allowed claim 1.

Roger is surprised that the claims had been allowed since he got the idea for the shape of his blades from cutters widely used by carpet fitters to cut carpets.

- a)** Advise on the options open to Roger including discussion of their merits and a brief outline of the relevant processes including timelines. **(18 marks)**

- b)** Roger then tells you that he sold some early prototypes of his adhesive tape dispenser in early 2010. He says that while the design is now more stylish, it functions in the same way. Discuss the implications of this and what further information may be required. **(4 marks)**

Question 5 (12 marks total)

Discuss and explain the following, with reference to the Patents Act and case law where appropriate:

- a)** The Mond Nickel test and when it is used. **(3 marks)**

- b)** A Dreyfus situation. **(3 marks)**

- c)** A compulsory licence. **(3 marks)**

- d)** A selection invention. **(3 marks)**

Question 6 (8 marks total)

On arriving at work today, you find instructions to enter the national phase in New Zealand based on a French language PCT application filed at the French Patent Office. The PCT application claimed priority from an earlier French national patent application and the deadline for entering the national phase was yesterday. You determine that the French agent had not taken proper account of the time difference and so you did not receive the instructions until 8pm yesterday, some time after you had gone home. The instructions included an English translation of the claims and a request to add omnibus claims at the time of filing the application.

- a)** Advise what, if any, action can be taken to file the application with the requested claim amendments, including detail of any other filing formalities and the relevant deadlines. **(6 marks)**
- b)** Assume that the process in part **(a)** was successful. The French agent then informs you that they want examination to proceed as soon as possible. Explain what would be required to action this request. **(2 marks)**

Question 7 (8 marks total)

Murray, a pharmacist, tells you about a recent discovery he has made and wants to protect. Last Sunday, when cleaning his shop, he got some medicine (a cough mixture containing composition XYZ) on his arms. He did not clean his arms until several hours later and when he did so he noticed that the hair on his arm had been dyed orange. Murray was even more surprised a few days later when he discovered that the eczema patches on his arms had disappeared after plaguing him for some years. Murray believes that both effects were due to the contact with the composition XYZ and he wants to know if he can protect his discoveries.

- a)** Advise Murray on the patentability of his invention(s). **(2 marks)**
- b)** Prepare outline independent claim(s) for the invention(s) on the assumption Murray only wants to protection in New Zealand. **(6 marks)**

Question 8 (10 marks total)

It is 21 June 2013. You have been contacted by Jim of Kiwi Farm Co-op (KFC). KFC sell an attachment for a spade. It clips onto the blade and has spikes that extend downwards from the blade when fitted. The spikes may be used to create small holes in the ground to aerate plugged up pasture.

In December 2012, Jim filed a New Zealand patent application (a complete specification in the first instance). Several ways in which the attachment is secured to the spade were described and claimed. The application is currently pending and clarity objections need to be addressed to bring the application into order for acceptance.

Jim displayed his attachment at a trade fair in January 2013. He says this was attended by everyone locally within the industry.

Jim shows you a brochure produced by a small engineering firm Tools'r'Us (TRU). Jim points you to a device in the brochure that looks strikingly similar to his own spade attachment. You note from the brochure that TRU manufacture the tools shown but that they are sold via a distributor, Vendigo Ltd. Furious at the perceived threat to KFC's business, Jim wants to take action immediately.

a) Advise Jim what action he could take to bring a halt to the marketing of TRU's product, including your reasons for doing so and any concerns. **(4 marks)**

b) After making contact with TRU, you receive several documents from their lawyer relating to garden tools. On a superficial review, you realise some are possibly relevant to KFC's patent application but Jim had no previous knowledge of them. Comment on the potential applicability of the following as prior art:

- i)** A letter from an employee of KFC, dated 10 November 2012, addressed to a Dannevirke electroplater requesting an estimate for electroplating 100 units of the spade attachment. **(2 marks)**
- ii)** New Zealand patent application 888999 published on 4 April 1962 and a farming catalogue published on 2 July 1963, the catalogue containing illustrations identical to those in NZ888999. **(2 marks)**
- iii)** A newspaper article dated 20 November 2012 advertising the trade fair Jim later displayed his attachment at in January 2013. The article includes a picture of Jim's product. On checking, you determine that the trade fair was a gazetted exhibition for the purposes of s60 of the Patents Act. **(2 marks)**

Question 9 (15 marks total)

You have received a void notice from IPONZ dated 28 June 2013 on patent application number NZ456789 relating to an improved kettle, the shape of which provides improved ease of pouring. On inspecting the file, you see that an examination report issued on 20 November 2011 but there do not appear to be any instructions from the client.

a) Advise your client what, if any, action can be taken in the following circumstances including comments on the chances of success and the process involved. **(12 marks)**

- i)** The client changed address after you reported the examination report and he did not receive any of your reminders of the deadline;
- ii)** The client received your reminders but was unable to instruct the preparation and filing of a response due to financial reasons;
- iii)** The client sent you instructions on 20 January 2013 but the letter was put on the wrong file by an inexperienced office assistant;
- iv)** Your client contact instructed you to allow the application to lapse but on receiving the void notice, the managing director informs you that the contact had no authority to give the instruction;
- v)** 6 weeks after notifying the client of the void notice, you receive instructions to restore the application. It appears that the reminders had been directed to a contact no longer employed by your client and they had not been passed to the new contact. The void notice was, however, passed to the new contact.

b) You apply for restoration of NZ456789 today but your client tells you that a competitor received a shipment of kettles last week that are similar to those in the patent application. They are concerned they won't be able to take action. Advise. **(3 marks)**