

2012

PATENT ATTORNEYS

EXAMINATION

**PAPER A2**

**The New Zealand Law and Practice  
relating to Patents and Designs**

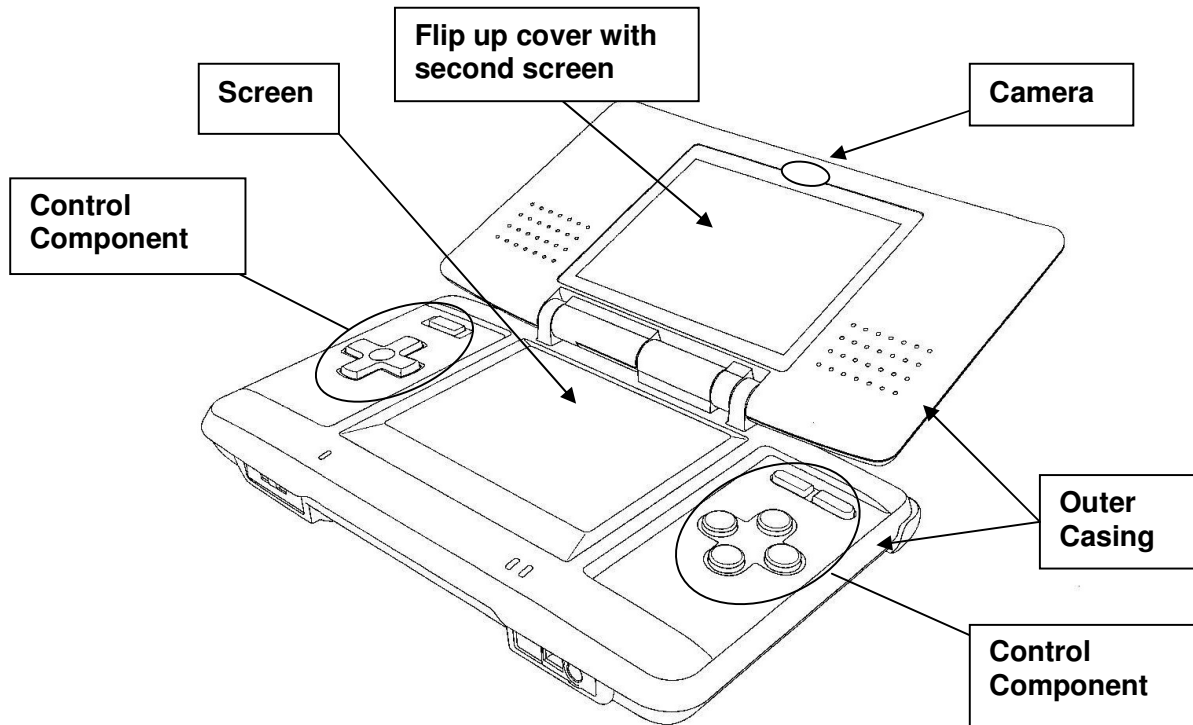
**Regulation 158 (a)**

**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, or any other Bill that may be before the New Zealand Parliament.

### Question 1 (23 marks total)

Your client Nishiki Gaming Limited (“Nishiki”) comes to you with their latest electronic hand held game product. The hand held game has not been publicly disclosed and will not be until launch. A picture of the product is shown below.



Nishiki tell you the product has many parts including, as shown in the picture, the control components, the outer casing (with flip up cover), camera, as well as the software that runs the hand held game.

#### Part A (9 marks)

You are told that the shape and layout of the control components is completely new. Nishiki used independent designer John Smith, an ergonomics specialist, to design the control components. The user manipulates these control components with their fingers to, in part, control the hand held game. John was given some pointers on some of the features for the control components, for example the size and approximate location Nishiki wanted, but largely was given free rein to design the shape, location, dimensions configuration and layout. Smith was paid for his work.

Nishiki seek your advice on how they can protect these control components.

- i) What protection is available to Nishiki for the control components and why? (6 marks)

- ii) Outline any questions you would ask Nishiki about their relationship with designer Smith, and what else, if anything, needs to be done. (3 marks)

Include in your answer references to any relevant statute and case law.

**Part B (6 marks)**

Nishiki tells you they had the outer casing for the hand held game made by an unrelated company Casein Plastics Limited (“Casein”). Casein has several core employees, but also contracted an external independent designer Sonya Spark to contribute to the shape of the outer casing.

Nishiki supplied Casein a design brief that included critical dimensions of the screen and of the control components designed by Smith.

Sonya suggested the added feature of the flip up cover containing the second screen. Flip-up covers are known for game products, but Sonya’s proposal for the inclusion of the second screen is completely new.

Casein supplied Nishiki with a prototype and drawings of the final form of the game product including the flip up cover containing the second screen. Casein will make the game product and supply it to Nishiki. Nishiki will pay Casein on a per unit basis for the game products they supply.

What protection is available for the outer casing and second screen, who is likely to be the owner and why, and what would you advise Nishiki to do to confirm ownership? (6 marks)

Include in your answer references to any relevant statute and case law.

**Part C (8 marks)**

The camera (which is a known feature) can be used to capture facial expressions of the user. This has led to Nishiki developing two new features:

Feature 1 - the user can use facial expressions to control the movement of their character on either screen (in addition to the control components).

Feature 2 – the user can use facial expressions to control the emotion of their character on either screen. As a result of the emotion adopted by their character, one or more distinctive icons appear on the screen background in various colours, for example a red icon for anger, green for affection, purple for fear.

Both features are enabled by software code present in the game product.

- i) What protection is available for Features 1 and 2, and why? (6 marks)
- ii) What protection is available for the software code and how long would this protection last? (2 marks)

Include in your answer references to any relevant statute and case law.

**Question 2 (10 marks total)**

Your client, Geeks Love Us Games Limited (“GLUG”), is a well known game design and illustration company.

GLUG explains they have redesigned one of their existing board games. The existing board game has been sold in New Zealand for some time. The rules are unchanged but the board shape, the board markings and the playing pieces have been redesigned. The redesigned board has an unusual and different shape with new pathways marked out for the playing pieces to move on.

A set of game pieces of a different colour is provided for each player. The redesigned game pieces each have the same shaped base. The shape of the base is newly designed. Permanently attached to the top of the base for each game piece is a new character styled to identify the game piece. The bases are made by a machine, but the characters are made by hand.

What intellectual property rights may be available for the board game in New Zealand, and what are the advantages and disadvantages for each of those rights? (10 marks)

**Question 3 (16 marks total)**

Briefly discuss **any four** of the cases listed below:

a) *Lucas v Peterson Portable Sawing Systems Ltd* [2006] 3 NZLR 721 (SC)

(4 marks)

b) *Pharmaceutical Management Agency Ltd v Commissioner of Patents & Others* [2002] 2 NZLR 529 (CA)

(4 marks)

c) *Ancare New Zealand Ltd v Cyanamid of NZ Ltd* [2000] 3 NZLR 299 (CA)

(4 marks)

d) *Amp Inc v Utilux Pty Ltd* [1972] R.P.C. 103 (HL)

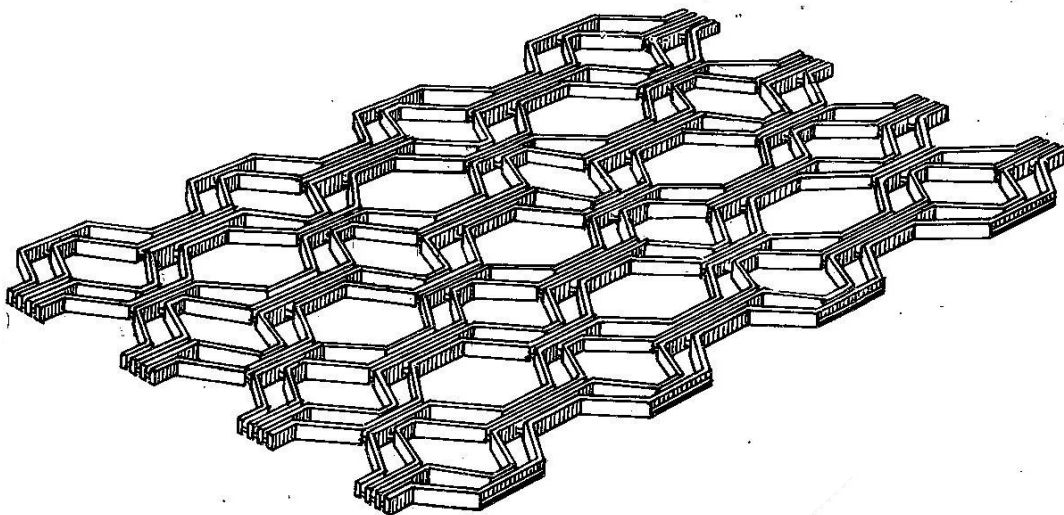
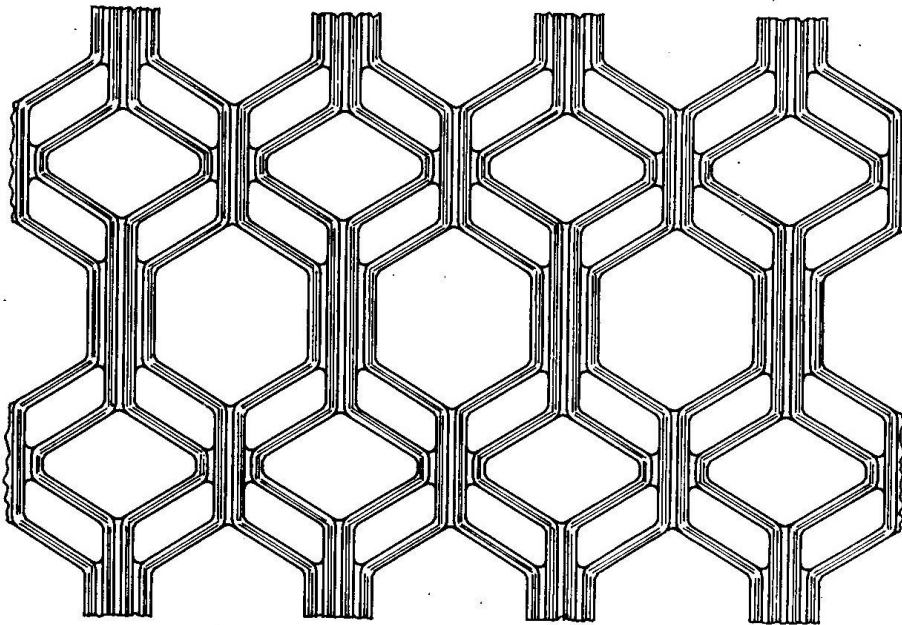
(4 marks)

e) *Improver Corporation v Remington Consumer Product Limited* [1990] F.S.R. 181

(4 marks)

**Question 4 (18 marks total)**

Your client has designed a new panel for a security door, shown below. The first drawing is a front view of a part of the panel as would be seen from the outside (it is the same when viewed from the other side). The second drawing is an isometric view of a larger part of the panel.



Although your client designed the panel for use in a security door, it could have other security grill applications. Despite the panel having a more decorative appearance than plain bars used in known security grills, your client says that she designed it purely for strength.

Your client wants to file an application for a registered design.

- a) Prepare a statement of novelty, identify the article to which the design is to be applied, and briefly explain your reasons for drafting the statement of novelty and title in the manner that you have done so. A further copy of the drawings is attached at the end of the exam paper in case you wish to use them in providing your answer. (7 marks)
- b) Advise your client on:
  - i) any potential validity issues; (2 marks)
  - ii) the minimum requirements for obtaining a filing date for an application for a registered design; (2 marks)
  - iii) the process in New Zealand after the application is filed through to registration (include any relevant time limits); (3 marks)
  - iv) when renewals are due; (2 marks)
  - v) what, if anything, she should write on products and marketing materials associated with the panel. (2 marks)

**Question 5 (11 marks total)**

Your client comes to you after having been in hospital for some time. He has a worried look on his face and is holding renewal reminder letters which appear to be the source of his concern.

Your client tells you that he has three commercially important New Zealand registered designs for which the first renewal fee has not been paid. The due date for payment of the first renewal fee for each of these designs is listed in the Table below.

<b>Design Registration Number</b>	<b>Due Date for First Renewal Fee</b>
56789	1 February 2012
45678	1 September 2011
23456	1 February 2011

For **each** design, advise your client:

- i) whether he can pay the renewal fee late, and if so what you have to do for him to pay it; (5 marks)
- ii) how the circumstances surrounding each of the registered designs will affect his ability to enforce his intellectual property rights in future. (6 marks)



**Question 6 (10 marks total)**

Explain what is meant by each of the following grounds, what is required for a successful challenge on each of these grounds, and when such a challenge can be made:

- a) "inutility" (5 marks)
- b) "insufficiency" (5 marks)

**Question 7 (7 marks total)**

You receive an urgent communication from a European patent attorney instructing you to file a New Zealand application for a registered design. Priority is to be claimed under the Paris Convention from a Community Design application.

The European patent attorney explains that the Community Design application was filed six months after the day that the design was exhibited at a trade fair in Europe.

Upon reviewing the representations you note that they include at least nine different designs. A careful review of the representations reveals that one of the designs differs slightly from that shown in the priority document.

- a) Explain the options available for obtaining registered design protection in New Zealand including the advantages and disadvantages for each. (5 marks)
- b) The designs are to be registered in respect of trophies. One of the designs appears to include a portrait of Sir Edmund Hillary. What issues of registrability, if any, does this raise? (2 marks)

**Question 8 (5 marks total)**

- a) Explain what is meant by a Certificate of Contested Validity in the Patents Act 1953, and how such a Certificate is obtained. (2 marks)
- b) What are the advantages of a Certificate of Contested Validity for a patentee? (2 marks)
- c) Are Certificates of Contested Validity available under the Designs Act 1953, and if so how do the provisions differ from that of the Patents Act? (2 marks)

