

2013

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)

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 (10 marks in total)

You receive instructions to have a PCT international application enter the national phase in New Zealand. The instructing letter you receive gives the following information:

International Application No.:	PCT/US2012/007654
International Filing Date:	10 January 2012
International Publication Date:	29 July 2012
Priority Application:	United States Patent Application 13/789,123
Priority Date:	25 January 2011
International Applicant:	Smith Enterprises Inc.
Inventor:	A. B. Smith

- a) The following paragraph appears in the published specification:

“This application is a continuation-in-part of utility application number US 12/123,456 filed in the US Patent and Trade Mark Office on 4 January 2011 by A. B. Smith, the contents of which are incorporated herein by reference in their entirety.”

What issues of New Zealand patent practice does this raise, and what should you ask your instructor?

(7 marks)

- b) The instructions you receive also include a copy of an assignment of “the invention described in US patent application Serial No. 13/789,123” from A. B. Smith to Smith Enterprises Inc., which is dated 25 January 2012.

What additional issue(s) arise and what advice would you give your instructor?

(3 marks)

Question 2 (26 marks total)

Your client wishes to market in New Zealand a new tablet computer it has been developing. A drawing of the product is shown below, marked “Product A”.

You perform a search of the New Zealand Designs Register and locate Design Registration No. 123456. There is a single representation for Design Registration No. 123456, being a Front View, which is shown below marked “Front View Design Registration No. 123456”.

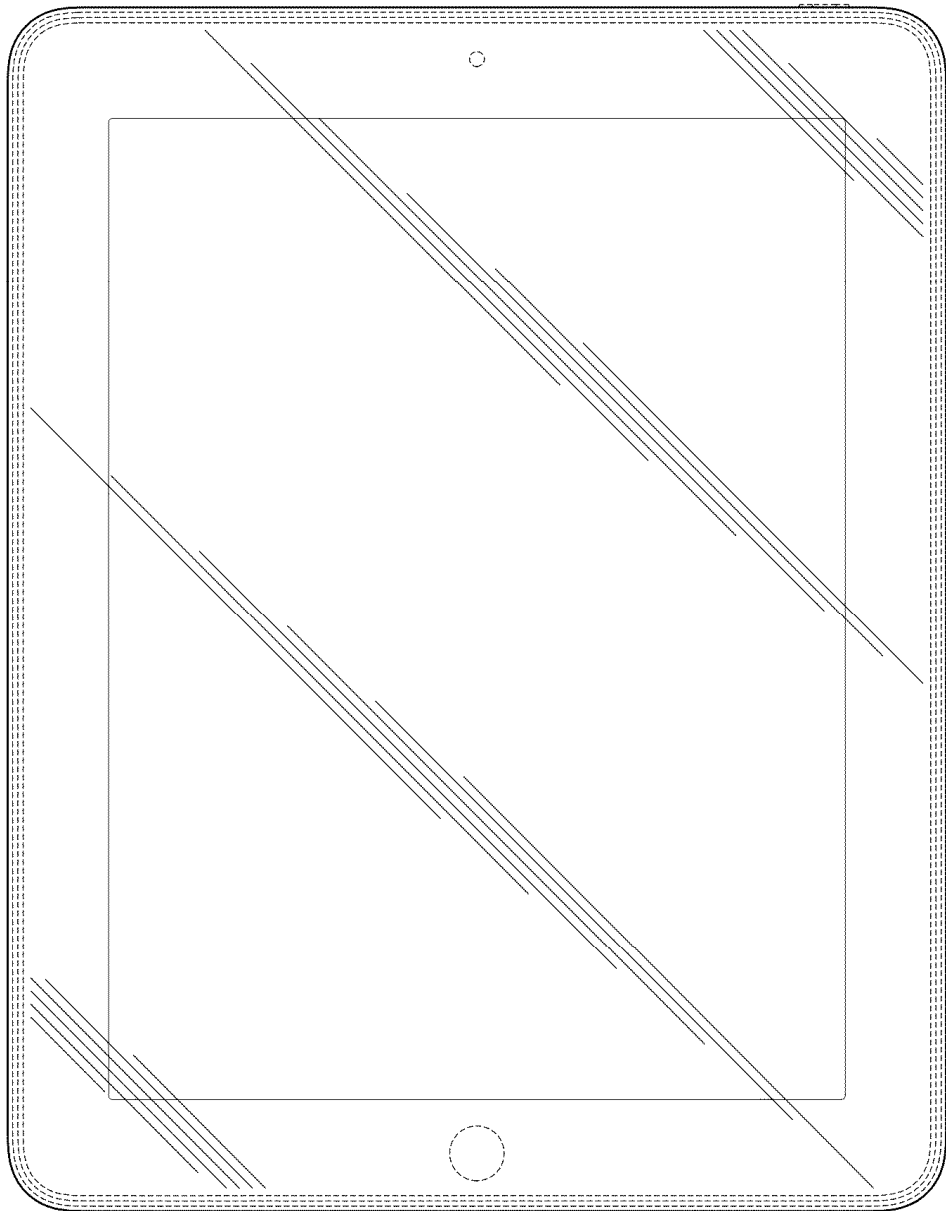
Design Registration No. 123456 is entitled “Display”.

Your client comments that display screen products having rectangular shapes and borders were available in New Zealand well before the earliest priority date of Design Registration No. 123456. Your client produces a drawing of a digital photo frame, shown below marked “Digital Photo Frame”,. Your client also says there is limited design freedom given standard screen sizes.

Assume for the purposes of answering this question that the drawing marked “Digital Photo Frame” is the only relevant prior art and was publicly available in New Zealand before the earliest priority date of Design Registration No. 123456.

- a) Briefly discuss the scope of Design Registration No. 123456. (6 marks)
- b) Advise your client as to whether its new product may infringe any rights owned by the proprietor of Design Registration No. 123456. Your advice should include a discussion on the law relating to infringement in New Zealand, with reference to relevant legislation and case law where appropriate. (15 marks)
- c) Explain to your client the remedies available to the proprietor of Design Registration No. 123456 should your client be found to infringe any rights discussed in your answer to part b) above. Comment on the advantages and disadvantages of the available remedies. (5 marks)

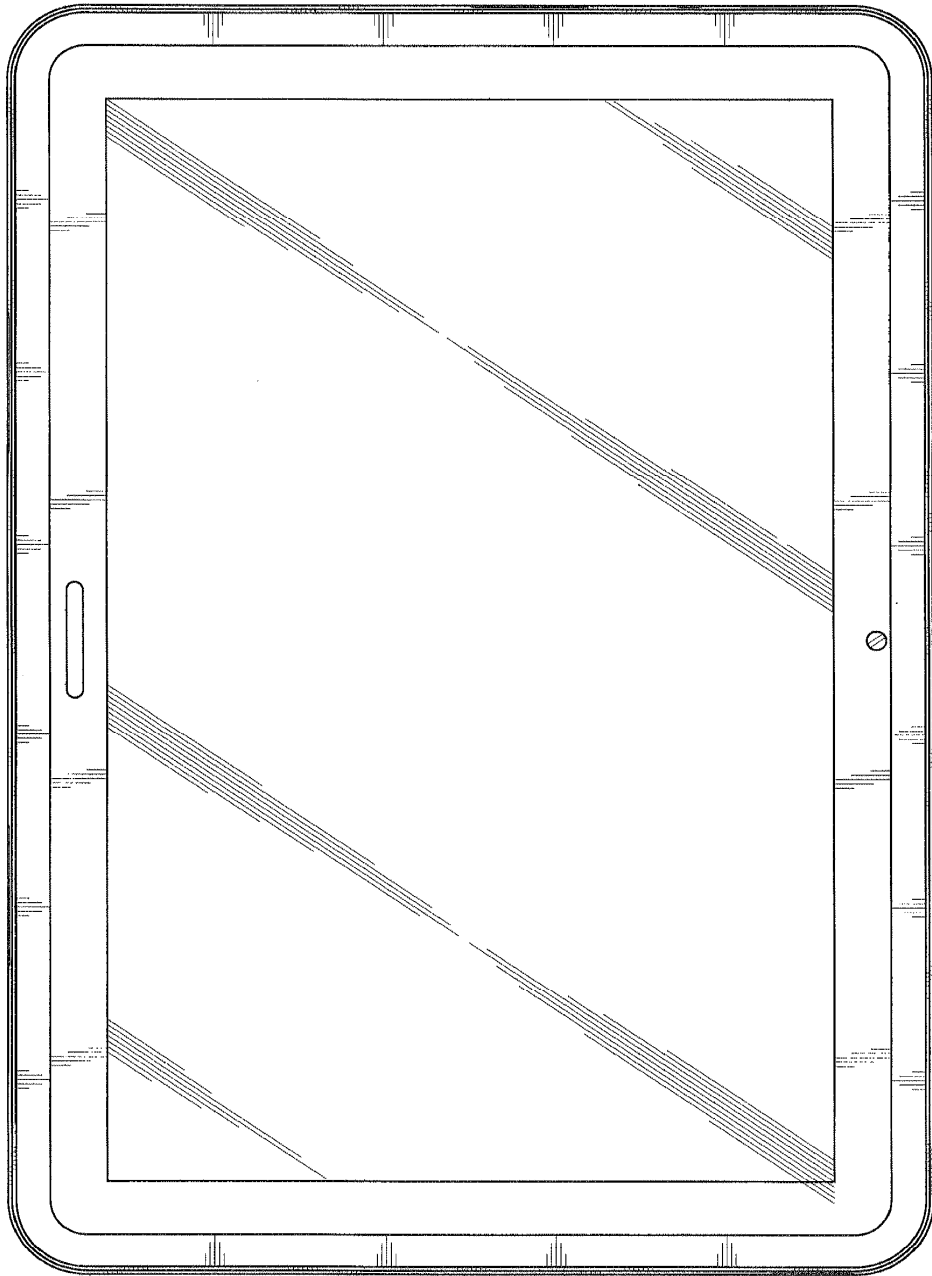
Question 2 continued



Front View

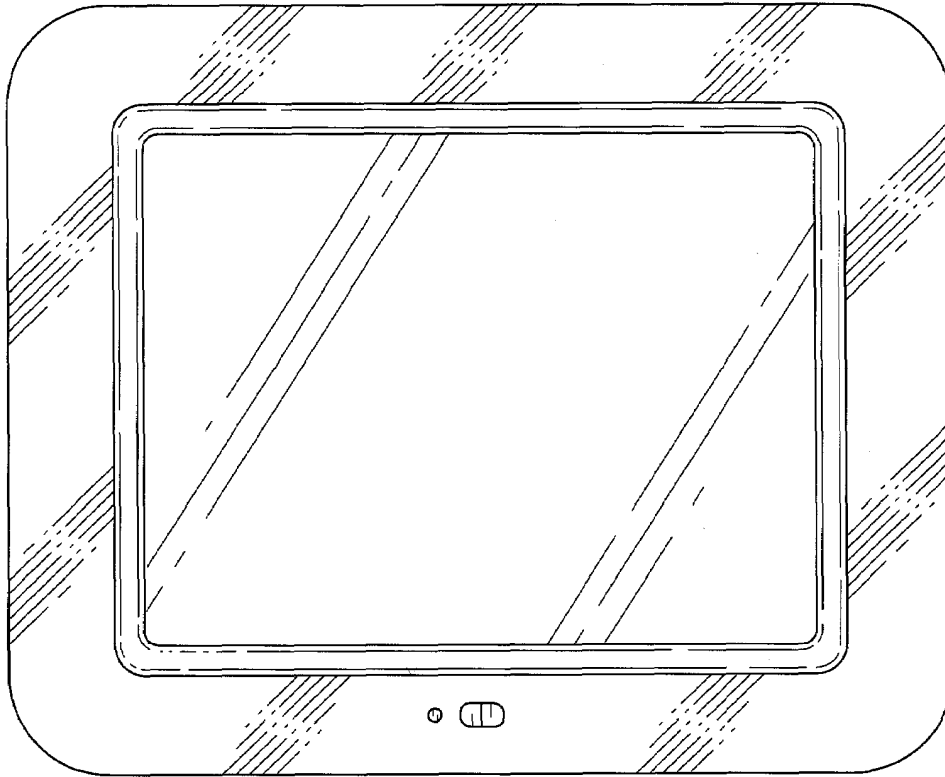
NZ Design Registration 123456

Question 2 continued



Product A

Question 2 continued



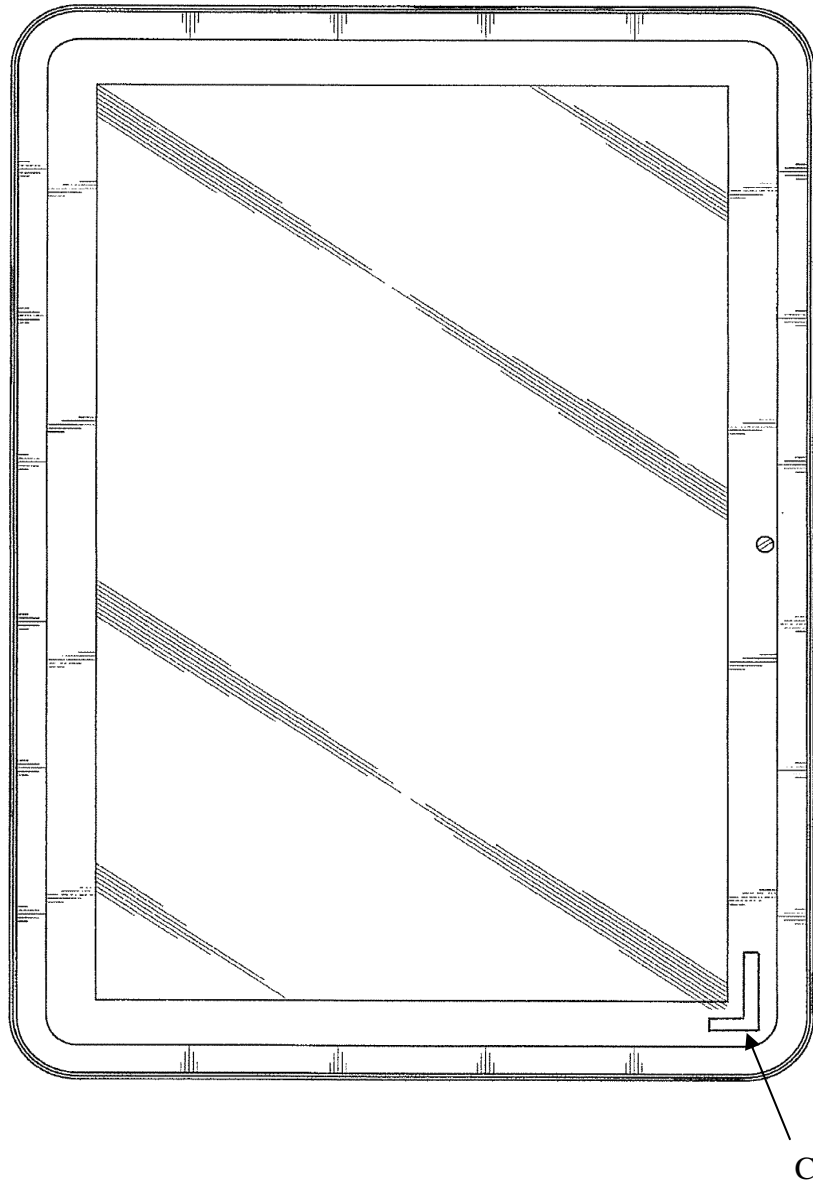
Digital Photo Frame

Question 3 (7 Marks Total)

Your client (from Question 2) considers the shape of the button labeled “C” on the representation of its alternative proposed tablet computer Product B (representation attached) differs from buttons on other tablet devices, and it wants to protect it.

- a) Your client instructs you to file a design application to protect the button feature. To what article will the design be applied and why, and what other information may you need? (4 marks)
- b) Draft a statement of novelty. You may detach the further representation of Product B which appears on the last page of this paper, and include it as part of your answer should you wish to do so. (3 marks)

Question 3 continued



Product B

Question 4 (13 Marks Total)

Your client has a new development relating to an Icon that it wishes to use with a mobile telephone. The Icon pops up on the screen of the telephone in use whenever an SMS message is received. A key new feature is that the colour of the Icon changes depending on who has sent the SMS message. Your client states that no other product has this feature, and that the graphic design of the Icon is also new. A representation of the Icon is shown below.

- a) Ignoring any trade mark issues, advise your client on what protection is available in New Zealand for the new development. (5 marks)
- b) Your client informs you that it used an unrelated entity to perform the software development for the mobile telephone, and that entity came up with the design of the Icon, possibly using an independent designer. What issues does this raise and what do you advise your client to do? (8 marks)



Question 5 (12 Marks in total)

Are the following designs validly registrable in New Zealand? Give reasons for your answer. Assume that the designs are novel.

- a) A known dress of a new combination of colours (2 marks)
- b) A known lampshade having a new pattern which is applied by hand (2 marks)
- c) A wall hanging having a novel texture (2 marks)
- d) A projectile designed by a computer to minimise air resistance (2 marks)
- e) A pre-formed, portable building (2 marks)
- f) A pack of playing cards, the cards having a novel logo on the back (2 marks)

Question 6 (10 marks total)

Briefly discuss any two only of the following four matters, referring to any relevant statutory provisions and/or case law that you consider may be relevant.

1. Amendment of a patent after acceptance (5 marks)
2. Sufficiency (5 marks)
3. Functionality, in the context of Registered Designs (5 marks)
4. Purposive construction (5 marks)

Question 7 (10 marks total)

Your client has a granted New Zealand patent. Your client also has a number of corresponding foreign patent applications which are now under examination. An examination report for one of the foreign applications has recently been received which cites a previously uncited Thai patent specification published in the Thai language as anticipating the invention and rendering it obvious. Your client wishes to know whether this development has any bearing on the granted New Zealand patent.

- a) Briefly explain the law on anticipation and obviousness in New Zealand to your client, and how the newly cited publication may be relevant. (7 marks)

- b) Assuming the newly cited publication is very relevant to claim 1 of the New Zealand patent, advise your client on what, if anything, your client should do, how and why. (3 marks)

Question 8 (12 marks total)

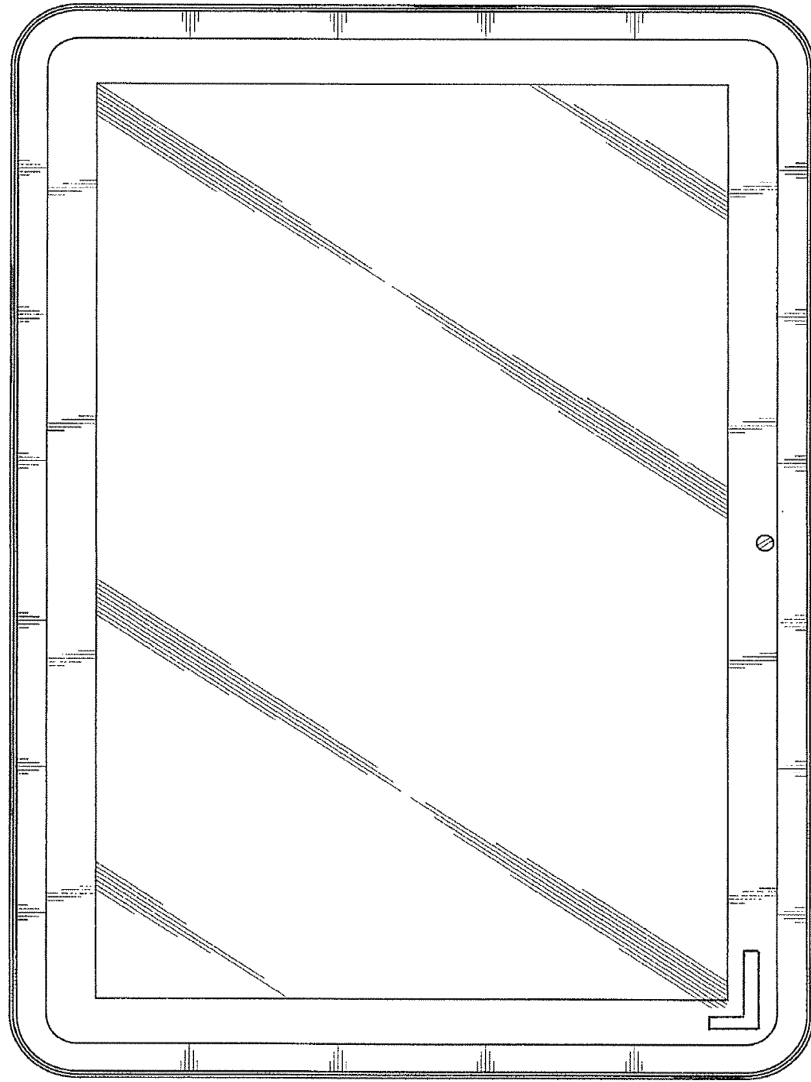
Your client has received a letter from an Australian company alleging infringement of its New Zealand registered design and its New Zealand patent. An inspection of the New Zealand Registers of patents and designs shows that the registered design and the patent, which were in force, have lapsed due to non-payment of renewal fees due almost three years ago. Your client was not aware of the existence of the registered design and patent.

Last year your client established a factory for manufacturing the product, and the product has recently been put on the market. Demand is far outstripping the capacity of the factory to supply the product.

The product has some differences in appearance from the features shown in the representations of the Registered Design, but the product looks identical to one of the drawings of the lapsed patent. The claims of the lapsed patent relate to a machine for manufacturing the product and a method of manufacture.

- a) What would you advise your client and why? (9 marks)

- b) Your client has now discovered its product designer had seen a copy of a drawing of the product from the patent specification of the lapsed patent. The product designer based her design of the product being marketed by your client on that drawing. Does this change your answer to part a) and if so, how? (3 marks)



Further copy of representation for Product B (from Question 3)