

**2012**

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

### **Question 1**

**(8 marks total)**

Your client comes to you in a panic about her PCT application which was filed claiming priority from a New Zealand patent application filed with a provisional specification on 20 December 2009. She has just returned from a business trip to China to find your letters and phone messages advising of the need for her to provide instructions for national phase entry of the PCT application.

Knowing that a national phase application needed to be filed in New Zealand 31 months after the priority date of the PCT application, she did not realise that the deadline for national phase entry differed in some countries. She wishes to enter national phase in Australia, Canada, Europe, Japan, the US, the People's Republic of China, the Republic of Korea and India.

Advise your client which jurisdictions she can still gain protection in, the time limits for this and what actions will need to be taken.

### **Question 2**

**(13 marks total)**

Your client has patent applications pending in the US, Australia and Korea relating to his water purification invention. Despite applications having been filed in 2008, no patents have been granted yet.

Your client is concerned that by the time the patents are granted on the applications, he will have little time to recoup his costs and make a profit before the patents expire and competitors move in.

**(a)** For each jurisdiction, advise your client how examination could be sped up. **(8 marks)**

**(b)** For each jurisdiction, advise your client whether the term of patent protection can be extended and what the length of the extension might be. **(5 marks)**

### Question 3

(17 marks total)

Your client is a German national whose principal place of residence is now New Zealand. He comes to you seeking advice regarding a European patent application that he filed with the European Patent Office on 30 July 2011 while living in Europe. His European application was the first application for protection filed. He now wishes to seek patent protection in the People's Republic of China, India, Korea and Japan.

(a) Advise your client of his options for doing so.

(2 marks)

(b) What would your advice be if your client's European patent application had been filed in March of 2011?

(2 marks)

(c) Your client has just learned that in December of 2011 a competitor had a European patent application granted for a similar and competing invention. You have located two earlier European patents that may disclose the competitor's invention. Neither of these patents was published before the priority date of the competitor's European patent but one of them claims an earlier priority date.

How could your client challenge his competitor's patent? Set out the basic process including relevant grounds?

(6 marks)

(d) How would your answer differ if the competitor's European patent had been granted a year ago, and validated in Germany and the UK?

(1 mark)

(e) It is now 2013 and your client's European patent application was examined some time ago. Your client is considering filing a divisional application. Advise him whether he can still do so and the latest date by which he can do it.

(2 marks)

(f) It is now 2014 and the European Patent Office has issued a notice of intention to grant your client's patent application. Assuming no law changes, advise your client of the actions he'll need to take to ensure it is granted.

(2 marks)

(g) Your client decides to validate his European patent application in Germany, France and Italy only. What translations will he need?

(2 marks)

#### Question 4

(18 marks total)

A client comes to you for advice regarding an anti-obesity drug her team has developed. The drug is a compound the team have designated "NoFat4U". While the invention has huge commercial potential, your client has only the budget to draft and file one patent application.

Your client's key markets are the US, Europe, Canada, Australia and Japan. Your client suspects that others have patented similar drugs but she has not performed any patent searching. She wishes to file a patent application as soon as possible so she can talk to potential investors.

(a) Assuming that the first application for protection will be filed in one of the markets identified, advise your client of any advantages or disadvantages associated with making a first filing in each of the countries listed. (5 marks)

(b) You discover that your client has just published a journal article describing NoFat4U and its amazing properties before coming to you. Advise your client on how the publication will affect her filing options. (3 marks)

(c) An application for patent protection was filed in one of the key market countries, followed by a PCT application one year later with five types of claims, as set out below:

- (i) claims to the compound NoFat4U,
- (ii) claims to the pharmaceutical composition comprising NoFat4U,
- (iii) claims to NoFat4U for treating obesity
- (iv) claims to the use of NoFat4U in the manufacture of a medicament for treating obesity, and
- (v) claims to a method of treating obesity using NoFat4U.

There are 65 claims in total. Your client wants to proceed with national phase filings in each of the markets identified in the most cost effective way possible. Advise your client of factors to consider when framing the claim set for each jurisdiction. (10 marks)

**Question 5****(16 marks total)**

- (a) In March 2013 the US is changing to a “first to file” patent system. Explain what a “first to file” system means, and how it differs from the present US patent system. **(5 marks)**
- (b) Discuss US patent derivation proceedings and when you might use them. **(3 marks)**
- (c) Other changes to US patent law relate to ways in which a US patent or application can be challenged before the USPTO. Once these changes take effect there will be four main proceedings that can be used to challenge a US patent or patent application. Discuss each of the four proceedings including when in the life of the patent/application they can be used. **(8 marks)**

**Question 6****(7 marks total)**

Your client filed an Australian standard patent application last year directed to an electric hairbrush and is now awaiting the direction to request examination. To save money, your client drafted a brief patent specification himself. He conducted only a brief search of IP Australia's patent database for inventions similar to his electric hairbrush prior to filing.

Your client is aware that the Intellectual Property Laws Amendment (Raising the Bar) Act 2012 has been passed.

- (a) Discuss how the new Act may impact on examination of your client's patent application. Advise him of any steps he can take to increase the likelihood of gaining protection for the new hairbrush. **(5 marks)**
- (b) If your client's invention was directed to a new gene sequence, are there any other provisions in the Raising the Bar Act that might need to be considered? **(2 marks)**

**Question 7****(6 marks total)**

Your client runs a small company which manufactures and sells pet accessories and toys. The company employs five people. The company has developed an automatic dog exercising device that is covered by a PCT application due to enter national phase next week. The PCT application has been assigned to the company. The company is currently in negotiations with the SPCA and the Wellington Institute of Technology (WIT), who are interested in using the device in their Animal Health course.

Your client is aware that small businesses may be entitled to reduced filing fees in the US and Canada provided they meet certain criteria.

Advise your client whether her company meets the criteria and whether it should take advantage of the fee reduction in each jurisdiction. **(6 marks)**

**Question 8****(9 marks total)**

You have a client who is about to move to China to start a new business there. He has developed a device that can detect common contaminants in milk and other dairy products. The device is intended for home use. You drafted and filed a New Zealand patent application accompanied by a provisional specification in July of 2011. Your client is now only interested in pursuing patent protection for the device in China.

**(a)** Advise him of the documents he will need to file in China and when they are required. **(2 marks)**

**(b)** Advise your client on the examination process he can expect in China from filing the patent application up until grant. **(4 marks)**

**(c)** Your client enquires about extending patent protection to Hong Kong. How can this be done after the Chinese patent application has been filed? **(3 marks)**

## Question 9

**(6 marks total)**

An Australian-based client has developed a kit for testing hormone levels that can be used to predict the likelihood of baldness. She wishes to manufacture and sell the kits in Australia but is wary of infringing a competitor's Australian patent, which you have determined covers these types of kits. The patent is due to expire next year.

Discuss whether the following actions, if performed by your client now, would constitute infringement of the patent:

- (a) obtaining clinical evidence of the efficacy of her kits for the purpose of registering the kit on the Australian Register of Therapeutic Goods. **(2 marks)**
  
- (b) investigating the efficacy of her competitor's kits for comparison with her own. **(2 marks)**
  
- (c) performing market research to determine whether customers will switch to her kit. **(2 marks)**