

2013

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)

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**(9 Marks Total)**

You filed a PCT application for your client claiming priority from a NZ application filed with a provisional specification on 23 December 2010. Your client has just responded to your earlier letter setting out the National Phase entry time limits and asking for instructions. They are interested in delaying costs where possible.

Your client has today asked you to file into Australia, Japan, China, Taiwan, Hong Kong, USA, France, Germany and Canada.

Advise your client of whether or not protection is available in each of the jurisdictions, and why. Mention any relevant time limits.

Question 2**(12 Marks Total)**

You are acting for one of your local corporate clients who have an idea for a new product. They have asked you to do a search and you have found some quite relevant prior art.

You believe that one family of patents presents a significant infringement risk to your client's proposed product.

- a) The patent family in question has pending applications in the following countries and your client intends to sell their product there. Advise your client on the procedures available for challenging applications in:
- China (1 Mark)
 - Republic of Korea (1 Mark)
- b) The patent family in question also has granted patents in the following countries and your client intends to sell their product there. Advise your client on the procedures available to challenge these granted patents before the relevant patent office in:
- Brazil (2 Marks)
 - Japan (4 Marks)
- c) What options are available for challenging an application or a granted patent under the European Patent Convention? (4 Marks)

Question 3**(13 Marks Total)**

All of the subsections in this question relate only to Australia.

a) Explain, the relevant entitlement provisions in Australia and the categories of entitlement. Explain any recent changes in the law that may be relevant.

(3 Marks)

b) You have now filed a patent application for your client in Australia listing him as the only inventor and applicant. When must you request examination?

Is there anything else you must do when requesting examination, and if so, explain.

(2 Marks)

c) During examination, what prior art information can the examiner consider and on what grounds?

Explain any other relevant considerations that may affect the prior art information that may be available to be cited.

(3 Marks)

d) You have very recently reported the receipt of a notice of acceptance for your client's patent application in Australia. Your client has just called you and told you that he has heard that his main competitor intends to oppose granting of the patent. Advise your client of any pre-emptive measures you might take and any applicable time limits.

(2 Marks)

e) Your client's patent has now been granted. Your client has called you and told you that although he said he was the only inventor, actually the only inventor was a friend of his who helped him out. Advise your client on the implications of this situation and what he can do to remedy the situation. Assume that your client's friend has now assigned his rights to your client.

(3 Marks)

Question 4**(16 Marks Total)**

a) Discuss, compare and contrast Post Grant review and Inter Partes review procedures in the USA, including eligibility and grounds.

(8 Marks)

b) Discuss the "false marking" provisions in USA.

(2 Marks)

c) Discuss the new "First-to-file" system in the USA under the Leahy-Smith America Invents Act (AIA) and the interaction with the grace period available. Your answer should detail what is (and isn't) citable prior art as well as any relevant time periods and dates.

(6 Marks)

Question 5**(8 Marks Total)**

You filed an application in New Zealand with a provisional specification for your long time client Advanced Widget Manufacturing Ltd (AWM) on 20 January 2011.

You recall that the application had only one inventor, Mr. Smith, the owner of AWM. You filed the application naming Mr. Smith as inventor, and the applicants were Mr. Smith and AWM.

You sent Mr. Smith a deed of assignment (assigning all rights to AWM) immediately after filing the provisional application, and it was duly executed and returned to you shortly after the provisional was filed.

On 10 October 2011 you filed another application in New Zealand (again with a provisional specification) containing some improvements that were made by Mr. Smith and a Mr. Jones. Mr. Jones is an industrial designer friend of Mr. Smith and gave Mr. Smith some clever ideas. The applicants of the second application were the inventors and AWM.

On 20 January 2012 you filed a PCT application designating all states and claiming priority from both New Zealand applications. The PCT specification included all the improvements that were made by Mr. Jones and Mr. Smith.

While you sent both inventors a deed of assignment (assigning all rights in the improvements to AWM) immediately after filing the second provisional application, only Mr. Smith has signed his.

a) The PCT application was filed in the name of AWM. What are the implications of this? (3 Marks)

b) Mr. Smith told you that progress on commercializing the invention has been a bit slower than expected and AWM can't afford to file any national phase applications right now. They have a big order coming up in September and they will be much better positioned then. He tells you that the US, Japan and China are now the only countries of interest.

Advise Mr. Smith of his options, including details of implementation, any relevant consequences, deadlines or requirements. (5 Marks)

Question 6**(7 marks Total)**

In late July last year your client, Adam Farmer, approached you to protect his invention. He explained at the time that he had disclosed his fencing invention at an exhibition in Hamilton (also in late July 2012) that was declared to be an industrial exhibition by the New Zealand Commissioner of patents.

You filed a patent application in New Zealand accompanied by a complete specification for Mr. Farmer on 12 November 2012.

Mr Farmer now wants to protect his invention in at least the following countries:

- USA
- Australia
- Japan
- Singapore
- Taiwan
- India
- China
- Republic of Korea
- Brazil
- Canada
- Hong Kong
- Great Britain

Advise your client which countries he can proceed in, which countries he cannot proceed in, and note any relevant deadlines and requirements that apply.

Question 7**(10 Marks Total)**

Your client has contacted you for advice about protecting their new product in Australia and China. In particular, your client has heard that there are different types of patents and wants to know all the differences as well as the advantages and disadvantages associated with the process of getting each of them, and having each of them.

Advise your client.

Question 8**(9 Marks Total)**

Explain the meaning of the following terms:

- a) Intermediate generalization (3 marks)
- b) File wrapper estoppel (3 marks)
- c) Doctrine of equivalents as applied in relation to claim amendments. (3 marks)

Question 9**(8 Marks Total)**

Discuss the use of the patent prosecution highway to accelerate prosecution of an Australian patent application. Include details of the different routes available and any relevant requirements and procedures.

Question 10**(8 Marks Total)**

Your client has a PCT application that is nearing the National Phase entry due dates. The IPRP has issued and notes that all 70 claims (including 6 independent claims to the product) are novel, inventive and industrially applicable.

Your client has given you instructions to file into USA, Europe, Australia, Japan and China.

Advise your client on the ramifications of the PCT claim set and any strategies for avoiding pitfalls. Note any applicable limits, but do not indicate any actual costs.