

2011

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, the Trade Marks (International Treaties and Enforcement) Amendment Bill, or any other bill that may be before the New Zealand Parliament.

Question 1

Your client filed a PCT application on 20 December 2009 claiming priority from a New Zealand patent application accompanied by a provisional specification filed 20 December 2008.

Your client had previously indicated that the PCT application was to be abandoned due to lack of funds but today tells you that a major investor is willing to finance the project if patent protection is still available in markets of interest.

Your client asks if he can still get patent protection in Australia, the USA, Canada, Great Britain, India, People's Republic of China, Japan, Taiwan, Brazil, Hong Kong, Republic of Korea and Singapore. Advise your client.

6 marks

Question 2

You are prosecuting equivalent patent applications in Australia and Europe on behalf of your client. The applications each claim a new product and process of making it. In Australia, an examination report issued on 1 November 2009. In Europe, an examination report issued on 20 August 2009.

No objections have been raised to the process claims in either jurisdiction but the examiners of both countries are not convinced that the product is new. Your client is in the process of comparing the properties of the product with the properties of the prior art products, to demonstrate that her product is in fact distinguishable from the prior art. Unfortunately, this is likely to take a couple of months at least. Your client is very keen to get protection for both the

process and the product itself. She would also like to add the results of the comparative testing to the specifications in Australia and Europe, if possible.

Advise your client how best to proceed to achieve her aims. Provide time limits for any actions advised including payment of fees.

8 marks

Would your answer be different if the examination report that issued in Europe included a lack of unity objection asserting that the product claims and process claims related to different inventions?

2 marks

Question 3

Your client has just been granted patents in India and the People's Republic of China relating to a small, superefficient electricity generator. Publicity about the generator has created a lot of interest in these countries. Despite this, the generators are not yet being made or sold in either country because your client hasn't had time to identify appropriate local manufacturers and/or distributors. He has also refused a couple of potential licensees, as he wants to keep tight control over the technology.

Your client was told by an acquaintance operating businesses in Asia that he could be heavily fined if he didn't start selling the generators soon. He is worried and comes to you for clarification.

Advise your client about his situation in China (**3 marks**) and India (**5 marks**).

Question 4

You meet with a new client to discuss patent strategy around his invention of a new low carbon dioxide emission fuel. Your client believes the new fuel could play a major role in reducing global warming. Your client filed an application accompanied by a complete specification on 9 March 2011, claiming priority from a New Zealand application accompanied by a provisional specification dated 10 March 2010.

Unfortunately, your client did not seek professional advice before filing the applications and thought that filing the complete specification in New Zealand would give him world-wide protection for his new fuel. Since 1 February 2011 he has been show-casing his new fuel on his website, and in TV infomercials.

Advise your client about his options for obtaining patent protection in the key markets of Europe, Australia, USA and Japan.

4 marks

Question 5

You have filed an Australian patent application claiming priority from a European application on behalf of your client. The Australian patent application has not yet been examined. Now it seems a competitor is selling copies of your client's product in Australia. Your client is eager to get the Australian patent granted as soon as possible.

Advise your client of the options available for obtaining enforceable patent protection quickly in Australia.

10 marks

Question 6

Your client's PCT application has just entered national phase in the USA and Canada. Explain to her the main events that will occur during prosecution of each application up until grant, and any obligations she has during this period. Include any deadlines for examination requests, responses to office actions and extensions available.

10 marks

Also advise when maintenance/renewal fees must be paid for each jurisdiction.

2 marks

Question 7

Your client filed a provisional patent application in the USA on 2 August 2010 relating to a new product. As your client is only interested in gaining patent protection in the USA and Europe you suggest filing

(i) a non-provisional utility application claiming priority from the USA provisional patent application, and

(ii) an application under the European Patent Convention (EPC) designating all European states which also claims priority from the USA provisional application.

(a) Briefly describe the filing and prosecution process for the EPC application up until grant.

In particular, specify deadlines for each major action including payment of fees, responding to office actions and any extensions available.

6 marks

(b) Your client proposes a claim set of 65 claims including 5 independent claims to the product, defined in different ways. Advise your client on the consequences of filing this claim set in Europe and in the US. **5 marks**

(c) Explain to your client any obligations regarding providing the EPO with search results. **3 marks**

(d) Briefly discuss any advantages your client may have gained by filing the first application for protection in the USA, rather than in NZ. **3 marks**

(e) Your client is aware that after grant, a validation process takes place in each European country that the patent is to be granted in. Your client also knows that the English language specification and/or claims may need to be translated into the official language of some of the European countries. Advise your client of the translation requirements for validation in Germany, France, Italy and Sweden. **4 marks**

(f) Assume the US application is accepted before the European application is examined. What could you do to speed up prosecution and grant of the European application? **3 marks**

Question 8

Your client is the sole inventor for a PCT application which has entered national phase in Europe, the USA, Australia and Japan. The filing details for the application are as follows:

- Priority date: 8 April 2008
- International filing date: 8 April 2009
- Publication date: 10 October 2009

Your client becomes aware of six documents that may anticipate the invention as claimed in his PCT application. Your client understands that some of the documents might be citable prior art against one or more of his four national phase applications. The details of these documents are given below.

		Priority date	Filing date	Publication date
		(Country of filing)		
(D1)	JP 4992840	10 Sept 2006	10 Sept 2007	14 March 2008
		Japan		
(D2)	EP 06854391	20 April 2008	20 April 2009	2 Nov 2009
		Germany		
(D3)	US 6,342,983	12 Jan 2008	11 Jan 2009	5 Aug 2009
		USA		

(D4)	US 5,928,730	8 Nov 2007	8 Nov 2008	12 May 2009
		USA		
(D5)	US 5,835,929	25 Sept 2007	24 Sept 2008	30 March 2009
		New Zealand		
(D6)	AU 2004900343	16 Feb 2008	16 Feb 2009	25 Sept 2009
		Australia		

D4 is an earlier patent by your client. None of the other documents are known to him. As shown in the Table, D1 to D4 and D6 claim priority from earlier applications filed in the same jurisdiction. D5 claims priority from a New Zealand application.

Advise your client which documents can be cited as prior art against which of his four national phase applications.

12 marks

Question 9

A new client, Ideas Ltd, has a PCT application filed 18 April 2010 due to enter national phase this year. The PCT application, filed in the name of Ideas Ltd, claims priority from a New Zealand application accompanied by a provisional specification filed on 18 April 2009 in the name of the inventor. Ideas Ltd believe they were entitled to be named as the applicant for the PCT application.

The technology claimed in the PCT application is in a very competitive field, and Ideas Ltd is aware of several scientific publications published not long after the priority date. Ideas Ltd have not yet finalised the list of national phase countries but know that the UK is top of the list.

Discuss any potential problems Ideas Ltd may face regarding the national phase entry into the UK with reference to any relevant case law and discuss any further information you need to obtain from Ideas Ltd to advise them properly.

6 marks

Question 10

Your client is preparing to launch a new product throughout Asia. Unfortunately, he has recently learned that a competitor filed patent applications in Japan, Taiwan, Singapore and the Republic of Korea that his product is likely to infringe, if these patent applications were granted.

Your client does not yet know the status of these applications and whether any have been granted yet but wishes to challenge them on the basis of prior art published years before the earliest patent application was filed.

Advise your client on how he could go about challenging his competitor's patents/patent applications in each jurisdiction.

8 marks