

## Patent Attorney Examiner Comments 2014

### Paper A1

Overall candidates scored well with questions 4, 5 and 6 and relatively poorly on questions 1, 2, 3 and 7.

#### Question 1

Candidates were expected to comment on the procedure set out in IPONZ Practice Note 1413 and 1953 Patents Act s 93A, s 7(2) and s 9(2); PCT Article 48(2)(b), PCT Rule 26 bis.3.

#### Question 2

While most candidates had a good knowledge of the 1953 Act some candidates had only a general understanding of the 2013 Act, especially in relation to statutory infringement exceptions and distinguishing annual maintenance fees from annual renewal fees.

#### Question 3

While most candidates knew the person entitled to apply for a patent, few picked up the option to delay the filing until after the 2013 Act comes into effect having the advantage that it is possible to file in the company name only and perfect the chain of title later but with the disadvantage of a later priority date in part (i).

Most candidates distinguished those persons who carried out non-routine research (iia) or who conceived the inventive step (iid) from those who provide general direction which did not lead to subject matter in the complete specification for the invention (iib) or who carried out general assistance (iic).

Most candidates did mention the relevant 1953 Act grounds of invalidity under obtaining (s21(1)a or s41(1)b&c) or false suggestion/misrepresentation (s41(1)j).

Most candidates stated the unity of invention objection issued by IPONZ under s10(4) but did not state options to respond to such an objection (such as amendment, argument, deletion and/or filing a divisional application for the subsequent invention(s)).

Most candidates did not state the two approaches to determining inventorship based on whether that person developed/conceived the inventive step in one or more claims or the contrary approach (as argued by IPONZ) that the inventors are all those for the “..invention disclosed in the complete specification...” as per the Declaration of Inventorship.

#### Question 4

Most candidates had a reasonable understanding of the differences in patentable subject matter between the 1953 Act and the 2013 Act (such as the exclusion of plant varieties from 2013 Act and computer programs “as such” if the only novel aspect is the computer program itself).

#### Question 5

Most candidates had a good understanding of parts i), ii) and iv) but did not give a range of options to Wendy in part iii) such as do nothing (risky); approach BB Ltd for license and/or check the IPONZ Register for licenses of right; make improvements to the client’s current apparatus that does not infringe the claims of NZ 456789; lodge caveat as request for information affecting a patent at IPONZ to help in determining validity of NZ 456789 with a

view to a possible counterclaim under s70 1953 Act, or belated opposition if still within 1 year from grant or revocation; determine whether Wendy can be exempt from infringement under a statutory exclusion.

#### Question 6

Most candidates knew generally the legislation surrounding parts a) to c) but did not state options to overcome the relevant IPONZ objection under parts a) and b).

#### Question 7

Most candidates understood the process of opposition in part i) but did not always consider the applicability of the facts to the various grounds. Candidates did not answer part ii) well concerning the withdrawal procedure (e.g. advise the client that the opposition will be decided in the public interest as it has been launched; write to the other side proposing to withdraw on the basis that costs lie where they fall).