

PATENT ATTORNEY EXAMS 2004
PAPER (a)(ii)

EXAMINER'S COMMENTS ON CANDIDATES' ANSWERS

General & Exam technique

- (i) Where a section of the Act was quoted at the start of a question it was a good clue as to the area of law the answers would come from. Many candidates did not accept this clue and repeatedly gave answers based on non relevant parts of the Act.
- (ii) Another clue overlooked was where candidates were asked if their answer would differ in view of an altered fact situation. This was a clue that the answer may well be different.
- (iii) Preferring to support answers with Commissioner's decisions rather than case law
- (iv) Having little knowledge beyond the opposition period
- (v) Even when knowing the law, not actually applying it to answer the hypothetical problem – a bit like sending the client photocopies of the relevant cases instead of telling him what he can do.

Common deficiencies on Particular Questions

- 1.
 - a Despite knowing the Commissioner's decision in *Hughes Aircraft* not applying it to the facts given, even though they were essentially the same facts. Not reading the question to appreciate it was dealing with section 2.
 - b Not picking this was a method of doing business. Not mentioning the English case law holding mere schemes unpatentable
- 2.
 - a One of the most poorly addressed questions. Apparently the validity of priority claims under the section 7(2) proviso was not studied. Many thought the situation in (a) could be saved by an extension of time under section 93A!?
 - b the grounds of revocation were not sufficiently well known or could not be applied to the facts given
 - c Most erroneously thought priority could be abandoned after grant
- 3.
 - a Most knew the tests for adequacy of disclosure in prior art documents
 - b The *Formento* case was not well known and candidates could not see beyond prior use
 - c Few traversed the opposing cases on both sides of the issue
- 4.
 - a very few, if any, knew that the first importer was the inventor under NZ and English case law
 - b the copyright issue was frequently missed and those who got it saw only the infringement by copying the specification (2D to 2D copying)
 - c the legal stalemate (copyright answer v patent answer) was not spotted.

- d the reference to “design” triggered many to at last see there was a copyright issue in this question
- 5.
 - a this whole question was intended to be a “gift” question, but it seems these grounds for revocation were not well known
 - b most tried to apply the tests for “external” fair basis (ie *Mond Nickel*) to this “internal” fair basis problem
- 6.
 - a candidates dwelt on section 74, but missed the applicability of section 75; the copyright issues were missed completely by some, while the implication of the dates was overlooked and restoration of the patent recommended by many
- 8.
 - d this part of this easy question tripped up many who thought there was no provision for substantive examination in NZ
- 10 A classic example of not picking up the clue given. Despite being asked to cite the definition of “article” in part (a) candidates failed to see that the following problems all involved asking whether the designs were applied to ‘articles’ Many did not accurately know the statutory requirements for a set of articles.