

Examiner's comments – Patent Attorney Examinations Paper A1 2007

General comments

I thought the overall standard of the papers was good. My comments on each of the questions and candidates' answers are below.

Question 1(a)

Most candidates understood that methods of medical treatment are not patentable in NZ, but that a Swiss-type claim format could be used to protect Osteofix's invention. Some candidates gave examples of claims, eg "The use of bonbonate in the preparation of a medicament to treat or prevent osteoporosis, wherein the medicament provides for a once weekly dosage of 150 mg to 200 mg of bonbonate", or similar.

The detail of the case law surrounding Swiss type claims was less well understood. Only a handful of candidates gave a good discussion of the UK Bristol-Myers (*Taxol*) decision, in which it was held that a Swiss type claim had to be for a new therapeutic purpose, and the Assistant Commissioner's decisions in *Merck v Arrow* and *Genentech* that departed from the strict approach in *Taxol* and held that Swiss-type claims to new dosage regimes are allowable in NZ.

Only one candidate mentioned another possibility for protecting Osteofix's invention – a composition claim directed to a novel unit dosage amount containing 150 to 200 mg of bonbonate.

Question 1(b)

The information I was looking for in this question was straightforward – the names of the inventors and whether they had assigned their rights in the invention to Osteofix Limited. If not, then it would be necessary to get the inventors to sign an assignment to Osteofix before the application could be filed in Osteofix's name alone (Section 7(1)(b)). However, many candidates listed the documents that needed to be actually filed with the application, and a number did not mention the need for an assignment.

Question 1(c)

This question was moderately well done, with most candidates managing to describe a prior claiming objection, and noting that such an objection could be overcome under Section 14(2) by amendment or by establishing that the claim has an earlier priority date than the cited claim. Most candidates also recognised if a prior claiming objection is not addressed during examination, then the Commissioner can direct that a reference to the cited specification is inserted in the applicant's specification. A reference is undesirable as it flags invalidity of the claim.

A number of candidates confused Sections 14 and 16, stating that prior claiming relates to the risk of infringement of another patent.

Question 1(d)

I was surprised how well this question was done. Most candidates recognised that the priority claim for NZ 444444 was not valid, because the priority application 10/666666 was not the first application for protection of the invention in a convention country. The first application for protection was made in 10/555555. This allows Osteofix to argue that the priority date of the claims of NZ 444444 defaults to the NZ filing date, 17 October 2005, which is after the priority date of Osteofix's claims (that are fairly based on the NZ provisional filed on 17 March 2005).

A number of candidates did not realise that the above argument could be used during the examination process. They thought that the priority claim issue could only be raised in opposition proceedings.

Question 1(e)

Most candidates recognised that it was still possible to oppose NZ 444444, or to obtain a one month extension for doing so – the 3 month opposition period expires today. Most also identified the ground of opposition that a convention application was not filed within 12 months of the first application for protection of the invention in a convention country (Section 21(10(h))).

A number of candidates incorrectly identified prior claiming as a possible ground of opposition. Osteofix's application is not granted and Section 21 requires the cited specification to be granted.

Remarkably few candidates mentioned the ground of prior use, based on Osteofix's sale of tablets with instructions for use in August 2005 – this use is before the priority date of the claims of NZ 444444 (17 October 2005 as the priority claim is not valid).

Question 1(f)

The first part of this question (outline of the opposition procedure) was done moderately well, although a surprising number of candidates did not have a good grasp of the exact procedure and timing of filing of the various documents in the opposition procedure.

The candidates who had identified prior use as a ground of opposition generally did the second part of the question reasonably well, recognising the need to file statutory declarations/affidavits establishing Osteofix's sale of the 150 mg bonbonate tablets in NZ with instructions for once a week administration.

Very few candidates mentioned the IPONZ practice note that sets out details of what evidence in support of prior use in opposition proceedings must show – ie that the use was not secret use, what was used, where it was used, by whom it was used, the dates it was used and where apparatus still extant may be inspected.

Most candidates recognised the need to file a certified copy of US 10/555555 in support of the false claim to convention priority ground.

Question 2(a)

This question was generally well done. Most candidates understood that Tom can make and sell the egg cooker without accounting to Margot, but that he cannot license the patent to a third party without Margot's consent (Sections 63(2) and (3)).

Some candidates also mentioned Section 64, which gives the Commissioner power to resolve disputes between co-owners.

Question 2(b)

I was looking for recognition that it could be difficult to obtain patent protection for the egg cooker with the rubber seal. The development would likely be obvious in view of the disclosure of the original egg cooker in the granted patent. Because of this, filing an application for a patent of addition should be considered. A surprising number of candidates did not mention these key points, or display a sound understanding of the effect of a patent of addition – ie that the development must be novel but need not be inventive over the invention of the main patent.

Most candidates correctly said that Tom was the only inventor of the new egg cooker.

Question 3

This question was reasonably well done, with most candidates understanding that IPONZ allows late entry into the national phase under Article 48(2)(b) (there is a practice note) and showing knowledge of the procedure. However, a number of candidates seemed to confuse the requirements for late national phase entry to be allowed (failure to enter national phase unintentional, no undue delay in applying for late entry), with the much stricter requirements under Section 93A (requirement for diligence). Late national phase entry would likely be allowed in this case as the failure to enter national phase was caused by a docketing error and therefore unintentional, and the error was only just discovered.

Question 4(a)

Most candidates got the right answer here (the claim takes the filing date of the complete specification) and mentioned the *Mond Nickel* test for fair basis. However, surprisingly few candidates attempted to apply the legal test to the facts, ie discussing whether the

claimed invention is broadly described in the provisional, or inconsistent with the provisional, or includes a feature on which the provisional is wholly silent. The provisional is both inconsistent with and wholly silent as to the broader temperature range claimed in the complete specification.

Question 4(b)

This question was done poorly. Again, most candidates instinctively got the right answer, ie the disclosure of the process with the original temperature range does not affect the validity of the claim. But no-one mentioned the correct reason why: Section 61(1) provides that disclosure of matter in the provisional specification after the provisional filing date does not invalidate the patent.

Question 5(a)

Most candidates said correctly that any amendments after acceptance must be by way of disclaimer, explanation or correction. However, a surprisingly large number of candidates made the mistake of saying that only **obvious** mistakes could be corrected. This shows a misunderstanding of a key part of section 40(1). Both non-obvious and obvious mistakes can be corrected, but corrections that broaden the scope of the claims are only permitted for the purpose of correcting obvious mistakes.

Question 5(b)

Once again most candidates got the right answer – yes, Jim should amend and can amend. But few candidates gave a complete and logical answer as to why – ie the German article was publicly available in NZ before the priority date; it is immaterial whether it is in the English language; claim 1 is therefore anticipated and invalid; Jim should amend to cure the invalidity; an amendment to limit claim 1 to the scope of claim 2 should be allowed as it is by way of disclaimer.

Question 5(c)

This part of the question was generally well done. Most candidates were aware of the decision of the Assistant Commissioner relating to internet publication (*Molecular Plant Breeding Nominees Limited* (2005)), in which it was held that if a document was accessible on the internet from NZ before the priority date, it satisfies the definition of publication in Section 2. But only a few candidates mentioned that this decision has not yet been tested by the Courts, meaning that the point could possibly be argued at that level, rather than it being mandatory for Jim to amend.

Question 5(d)

Most candidates gave a reasonable outline of the procedure under Section 38, including the need to give full reasons for the amendment and details of the prior art.

Question 5(e)

Most candidates recognised correctly that this strategy is a risky one, but few gave a good explanation as to why. I was looking for an answer that made some of the following points:

- If Jim sued an infringer asserting claim 2 only, the infringer would almost certainly counterclaim for revocation of the whole patent, ie claim 2 as well as claim 1.
- If the Court found claim 1 invalid and claim 2 valid, then the Court has discretion whether to order revocation of the whole patent because of the invalid claim 1, or allow the patent to stand with just the valid claim 2.
- It is possible that the Court could exercise its discretion against Jim because he has allowed claim 1 to remain unamended knowing it is invalid.
- Also, even if the Court did allow the patent to stand with just claim 2, the onus then falls on Jim to show that the invalid claim 1 was framed in good faith and with reasonable skill and knowledge (Section 71).
- Even if that was done, the Court still has discretion as to costs and the date from which damages should be reckoned.
- For these reasons, it is better to try to amend before bringing an infringement proceeding. Also, it is generally easier to get amendments through IPONZ, and hopefully without attracting the attention of a third party, than to deal with amendment as part of an infringement proceeding.
- It is also advisable not to delay amendment, or permission to amend could be refused (*PDL v Jackson* etc).

A significant number of candidates made the mistake of saying that if claim 1 was found invalid, dependent claim 2 would be invalid as well. Surprisingly few understood that claim 2 could be valid regardless of whether claim 1 is valid, or mentioned the Court's discretion to uphold claim 2.

Question 5(f)

This question was answered very poorly. Only one candidate was aware of the case law relating to the ability to add dependent claims to a main claim where a main claim is amended after acceptance by way of disclaimer. The relevant UK decisions are *Davidson's Patent* and *ICI (Whyte's) Patents*, in which it was held that if a main claim is amended by way of limitation it is allowable to add new dependent claims relating to features added to the main claim. IPONZ has followed these decisions (eg *Sherman v Merck* (4/2006)).

Feature (i) relates to the shape of the teeth of the jaws, ie the same feature as that being added to claim 1. Adding a dependent claim to this feature should be allowable.

Feature (ii) relates to the handle and not to the feature being added to claim 1. IPONZ will probably object to adding a dependent claim to this feature.

Question 6

Most candidates were aware that an exclusive licensee can bring infringement proceedings in its own name (Section 72), and that the patentee (the US parent company) must be joined as plaintiff or added as defendant.

Few candidates showed a good understanding of the consequences of the licence not being registered – ie that Company Y must give company X one month's notice of its intention to bring proceedings, and that Company Y can then require the licence to be registered (Section 85). No-one mentioned the possibility that Company X could use Section 85 as a mechanism to stall the infringement action, and that this problem can be avoided by registering the licence before bringing proceedings.

Question 7

This question was well done. Most people showed a good understanding of unity of invention and the ability to file divisional applications and the timing for filing them.

Question 8(a)

This question was reasonably well done, although rather inelegantly. Most candidates presented full lists of the grounds available under Sections 21 and 41 and then gave a summary of the differences once they had figured these out from their lists. Few candidates showed a level of understanding of sufficient depth to produce a paragraph-type answer straight off.

Question 8(b)

This question was well done.

Question 9(a)

Not many candidates were familiar with Section 68B – the “regulatory review” exception to patent infringement, which provides that it is not an infringement to make, use, exercise or vend the invention solely for uses reasonably related to the development and submission of information required under New Zealand law or the law of any other country that regulates the manufacture, construction, use or sale of any product.

Question 9(b)

I thought this question was straightforward, but a surprisingly large number of candidates did not mention the “inevitable infringement” test from *General Tire* for whether a prior art document anticipates a claim. Those candidates instead mentioned the requirement for a prior art document to be publicly available.

Question 9(c)

This question was done fairly well, with most candidates noting that purposive construction refers to the interpretation given when determining the scope of the claims, and setting out the test from *Catnic*.

Question 9(d)

This question was just adequately done. Most candidates recited the requirements for a selection invention from *I G Farbenindustrie A.G.'s Patents*. However, few gave a good explanation in their own words of what a selection invention is – ie an invention where the inventive step lies in the discovery that one or more members of a class previously disclosed have some special advantage for some particular purpose. Few candidates also mentioned the key requirement that the selected members must not have been specifically disclosed in the earlier document.